

HIGHLIGHTS

**Mere Implementation of Abstract Idea With Computer Not Patent-Eligible**

A method, a computer system, and a computer-readable medium to carry out a method for ensuring that a party to a contract has sufficient funds in its account are drawn to a patent-ineligible abstract idea, the U.S. Supreme Court holds. Affirming a ruling by the U.S. Court of Appeals for the Federal Circuit, the high court echoes a 2010 ruling that killed a patent on a computer algorithm for hedging investment risks. *Alice Corp. Pty Ltd. v. CLS Bank Int'l.* **Page 513**

**TTAB Again Finds 'Redskins' Disparaging, Orders Registrations Cancelled**

The various trademark registrations used by the Washington Redskins "must be cancelled because they were disparaging to Native Americans at the respective times they were registered, in violation of Section 2(a) of the Trademark Act of 1946," the Trademark Trial and Appeal Board holds in a split decision. The board's ruling strips away the team's ability to rely on certain federal laws to enforce its trademark rights, which, if the registrations are cancelled, will subsequently have to be grounded in common law. *Blackhorse v. Pro-Football, Inc.* **Page 516**

**7th Cir.: Characters From First Sherlock Holmes Stories Are Public Domain**

The fact that a few of the original Sherlock Holmes stories are still under the protection of copyright law does not prevent an author from using material from the stories that have fallen into the public domain without the authorization of the copyright holder, the Seventh Circuit rules. The court rejects the copyright holder's attempt to distinguish "simple" or "flat" characters from "complex" or "round" characters, which do not fall into the public domain until all the original works featuring them are in the public domain. *Klinger v. Conan Doyle Estate, Ltd.* **Page 517**

**Patent Community Saddened, But Not Surprised, By Rader's Retirement**

Judge Randall R. Rader's last day on the bench will be June 30, according to an announcement by the U.S. Court of Appeals for the Federal Circuit. Rader, therefore, will retire exactly one month after resigning as chief judge—a move that was precipitated by admissions of impropriety going to Rader's off-the-record emails to an attorney who had argued before the court. "The bottom line is that I was not happy after leaving the Chief position and it hit me that I need to leave while I am young and full of energy to change the world," Rader said. **Page 529**

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**COPYRIGHT:** The author says the Supreme Court's final judgment in the *Aereo* case could clarify or further muddy the nation's copyright laws in a manner not seen since the days of the player piano. **Page 565**

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**COPYRIGHTS:** Technology is changing distribution channels and business models of viewing content and recent court decisions are creating uncertainties about intellectual property rights, according to participants at a Stanford University Law School conference. **Page 522**

**TRADE DRESS:** Snack bar company Kind failed to establish a likelihood of success on the merits of its claim that Clif Mojo bars infringed Kind's trade dress, the Southern District of New York rules. *Kind LLC v. Clif Bar & Co.* **Page 531**

**COPYRIGHTS:** An online publishing platform cannot claim DMCA copyright immunity over images published on its website before it designated a DMCA-related agent with the U.S. Copyright Office, the Northern District of California holds. *Oppenheimer v. Allvoices, Inc.* **Page 521**

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# News

## Supreme Court/Patents

### Mere Implementation of Abstract Idea With Computer Not Patent-Eligible

■ **Key Holding:** *The Supreme Court affirms the Federal Circuit's ruling that a method, a computer system, and a computer-readable medium to carry out a method for ensuring that a party to a contract has funds in its account to fulfill the contract is a patent-ineligible abstract idea.*

A method, a computer system, and a computer-readable medium to carry out a method for ensuring that a party to a contract has funds in its account to fulfill the contract are drawn to a patent-ineligible abstract idea, the U.S. Supreme Court held June 19 in a unanimous decision (*Alice Corp. Pty Ltd. v. CLS Bank Int'l*, U.S., No. 13-298, 6/19/14).

Affirming a ruling by the U.S. Court of Appeals for the Federal Circuit, the high court echoes a 2010 ruling that killed a patent on a computer algorithm for hedging investment risks.

The court's opinion was authored by Justice Clarence Thomas. Justice Sonia M. Sotomayor filed a brief concurring opinion—that was joined by Justice Ruth J. Bader Ginsburg and Justice Stephen G. Breyer—stating that business methods in general should be considered unpatentable.

In *Bilski*, the concurring justices numbered four—Sotomayor, Ginsburg, and Breyer joined a concurring opinion by John Paul Stevens, who retired in 2010. Stevens's successor, Justice Elena Kagan, did not join the concurrence this time, suggesting that the balance of justices who believe that all business methods should be unpatentable has shrunk.

Matthew J. Dowd of Wiley Rein LLP, Washington, D.C., told Bloomberg BNA that this was at least a sign that “there may yet be life in business method claims.”

*Bilski v. Kappos*, 130 S. Ct. 3218, 2010 BL 146286, 95 U.S.P.Q.2d 1001 (2010) (80 PTCJ 285, 7/2/10), ruled that a computer algorithm by itself was not patent eligible under Section 101 of the Patent Act. However, it did not answer whether including implementation by a computer in the claims would have made it patentable.

**Some Questions Answered, Some Not.** Observers told Bloomberg BNA that this decision seemed to definitively answer at least one broad question, whether simply reciting application by a computer could render an abstract idea patentable.

Stuart P. Meyer of Fenwick & West LLP, Mountain View, Calif., said that the court “once again resorts to the ‘abstract idea’ analysis” while giving “virtually no guidance as to how one could tell what qualifies as an ‘abstract idea.’”

“We are all left wondering,” Meyer told Bloomberg BNA, “how anyone is supposed to undertake this analy-

sis, with such little guidance being provided. The Court tells us to ignore computer implementation unless it does more than ‘apply the abstract idea . . . using some unspecified generic computer.’ Accordingly, the potential impact of this case on other software patents is large but significant further litigation will be needed before we see the contours of what is considered ‘abstract’ by courts.”

John F. Murphy of Baker & Hostetler LLP, Philadelphia, also noted that the court had explicitly avoided offering a strict definition of an abstract idea

Furthermore, he said, in saying that recitation of the use of a computer that could be applied by taking “purely conventional” steps was not transformative, the court also did not specify “what makes the computer aspects of a claim more than merely conventional?”

“These questions have been, and still are, of profound interest to the computer software industry,” Murphy said.

Adam Mossoff, a law professor at George Mason University, Arlington, Va., agreed that it was a concern that there was “little to no legal guidance” regarding application of the decision in the future.

However, he said, “the one ray of hope in this decision is that, similar to its affirmation of the patentability of business methods in *Bilski*, the Court in *Alice Corp.* expressly holds that ‘many computer-implemented claims are formally addressed to patent-eligible subject matter.’ Thus, innovative software inventions in the high-tech industry are now definitively deemed patentable.”

***Bilski* Loophole Seems to Be Closed.** This ruling seems to close that loophole, blocking any attempt to get around *Bilski* by including computer implementation in the claims.

The court said “there is no meaningful distinction between the concept of risk hedging in *Bilski* and the concept of intermediated settlement at issue here. Both are squarely within the realm of ‘abstract ideas’ as we have used that term.”

*Mayo Collaborative Servs. v. Prometheus Labs. Inc.*, 132 S. Ct. 1289, 2012 BL 66018, 101 U.S.P.Q.2d 1961 (2012) (83 PTCJ 727, 3/23/12), required that a claim that begins with an abstract idea must incorporate an “inventive concept” that is “sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.”

According to the court, “The introduction of a computer into the claims” was insufficient to meet this requirement. The court said:

There is no dispute that a computer is a tangible system (in § 101 terms, a “machine”), or that many computer-implemented claims are formally addressed to patent-eligible subject matter. But if that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept. Such a result would make the determination of patent eligibility “depend simply on the draftsman’s art,” . . . thereby eviscerating the

rule that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” . . . .

**Patents Related to Risk-Management Contracts.** The dispute began with four patents held by Alice Corp. (U.S. Patent Nos. 5,970,479, 6,912,510, 7,149,720, and 7,725,375) related to the formulation and trading of risk management contracts. It sued CLS Bank International, alleging patent infringement. Before the Federal Circuit sitting en banc, the method claims fell in a 7-3 decision, but the appeals court was split 5-5 on the system claims (86 PTCJ 120, 5/17/13).

The Supreme Court granted a writ of certiorari in the case on the following questions:

Whether claims to computer-implemented inventions—including claims to systems and machines, processes, and items of manufacture—are directed to patent-eligible subject matter within the meaning of 35 U.S.C. § 101 as interpreted by this Court?

The court’s opinion began with the assertion that 35 U.S.C. § 101—which states what subject matter is patent-eligible—had “for more than 150 years” been subject to an exception that “Laws of nature, natural phenomena, and abstract ideas are not patentable.”

“At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law,” the court said.

**Court Applies Two-Part Test From *Mayo*.** *Mayo* established a two-part test for application of this principle, the first step being to determine “whether the claims at issue are directed to a patent-ineligible concept.” The second step was whether the claims incorporated any “inventive concept,” or “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’”

*Bilski* found that a “method for hedging against the financial risk of price fluctuations” was directed at the abstract idea of hedging. Similarly, the patent at issue in the instant case was also “directed to an abstract idea.”

“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk,” the court said. “Like the risk hedging in *Bilski*, the concept of intermediated settlement is “a fundamental economic practice long prevalent in our system of commerce.” . . . .”

The court rejected Alice’s argument that “the abstract ideas category is confined to ‘preexisting, fundamental truth[s]’ that ‘‘exis[t] in principle apart from any human action.’” . . . .” The court said:

*Bilski* belies petitioner’s assertion. The concept of risk hedging we identified as an abstract idea in that case cannot be described as a “preexisting, fundamental truth.” the patent in *Bilski* simply involved a “series of steps instructing how to hedge risk.” . . . Although hedging is a long-standing commercial practice, . . . it is a method of organizing human activity, not a “truth” about the natural world “that has always existed,” . . . .

The court concluded that there was “no meaningful distinction between the concept of risk hedging in *Bilski* and the concept of intermediated settlement at issue here.”

**No ‘Inventive Concept’ Found.** Thus, having found that the claims had described an abstract idea under the first *Mayo* step, the court moved to the second step, and con-

cluded that Alice’s method claims “fail to transform that abstract idea into a patent-eligible invention.”

The court found no “inventive concept” that might constitute such transformation.

“The introduction of a computer into the claims does not alter the analysis at *Mayo* step two,” the court said.

More specifically, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ ’ is not enough for patent eligibility,” the court said. “Nor is limiting the use of an abstract idea ‘to a particular technological environment.’” . . . .”

Indeed, the court said, applying an abstract idea by specifying only that it be done with a computer “simply combines those two steps” of *Mayo*.

The method claims in this case simply amounted to directing the application of an abstract idea with an “unspecified, generic computer,” the court said. There was no inventive step that transformed this into an invention.

The claims to the computer system and computer-readable medium failed under the same reasoning, the court said, after concluding that “the system claims are no different from the method claims in substance.”

BY ANANDASHANKAR MAZUMDAR

Text is available at <http://pub.bna.com/ptcj/13298SupCtAlice20140619.pdf>.

## Patents/Supreme Court

### Alice Offers Some Guidance, But Some Important Questions Are Left Unanswered

**T**he *Alice* decision spurred a range of concerns on the part of experts consulted by Bloomberg BNA.

Brett A. Krueger of Honigman Miller Schwartz & Cohn LLP, Bloomfield Hills, Mich., said that the decision represented a “clear stance that patent claims reciting a method of implementing an abstract idea on a generic computer are not patentable.”

He noted that the “abstract idea” concept “has been in flux” since 1853.

“While the Supreme Court spent over 100 years refining the concept on ‘an abstract idea’ ” since then, the *Alice* decision “succeeded in providing patent practitioners today with clear guidance on how to apply it for software related patents,” namely, that “simply limiting use of an abstract idea to use on a computer does not make the abstract idea patentable.”

Paul M. Schoenhard of Ropes & Gray LLP, Washington, D.C., told Bloomberg BNA that the decision “represents a necessary and important step towards certainty regarding what is patentable.”

Schoenhard said that he expected the decision would “be well received by the high-tech and software communities, which have yearned for certainty and stability in this area of law.”

“Throughout, the Court emphasized the need to find balance—to ensure that the patent system provides broad enough protections to promote innovation without providing protections that are so broad they may stifle further innovation,” he said.

### Computer Software Not Generally Held Unpatentable.

Some experts contacted by Bloomberg BNA noted that this decision was little more than an application of the *Mayo* decision.

"Alice isn't a dramatic shift," Baldassare Vinti of Proskauer Rose LLP, New York, told Bloomberg BNA. "It's more of a reaffirmation of the Supreme court's holding in *Mayo v. Prometheus*."

Indeed, Vinti noted that the decision did not hold unpatentable all computer software. "It simply held that otherwise unpatentable concepts don't become patentable by saying 'this time, do it on a computer.'"

Matthew J. Dowd of Wiley Rein LLP, Washington, D.C., agreed that "the opinion itself is rather non-controversial" in that "it does not add much beyond what *Bilski* and *Mayo* provided."

He told Bloomberg BNA that the decision "removed any doubt that the two-prong *Mayo* analysis applies to computer-based claims."

**Court Leaves Important Questions Unanswered.** While the court seems to have answered the narrower question of whether reciting application of a computer can transform an abstract idea into a patentable claim, some experts consulted by Bloomberg BNA expressed regret that the court seemed to have failed to answer a more fundamental question that was presented by the case.

The matter went to the Supreme Court "based on the Federal Circuit's inability to answer the question 'What constitutes an abstract idea?'" Robert R. Sachs of Fenwick & West, San Francisco, said. "It leaves the Court without any answer."

Sachs pointed out the decision's statement that the court "need not labor to delimit the precise contours of the 'abstract ideas' category in this case."

"This Court continues to avoid making a positive statement of what counts as an abstract idea, or what counts as a sufficient 'transformation,' and instead approaches all of these cases . . . by saying what does not count, what is 'not enough.' That leaves considerable uncertainty for patent holders now, and more importantly for innovators going forward," Sachs told Bloomberg BNA.

The decision did plug a hole left by *Bilski*, according to Richard Bone of the VLP Law Group LLP, Palo Alto, Calif., "But all that means for practitioners is that the debate has shifted back to whether the underlying invention is merely an 'abstract' idea."

"The Court has offered little concrete guidance in this area beyond its concern that patent claims should not pre-empt the use of the invention in all fields by simply claiming the 'building block of human ingenuity,'" he told Bloomberg BNA. "Nevertheless, it seems inevitable that patentees will face greater struggles to secure patent protection for computer-implemented inventions now, particularly in the area of financial transactions."

Alan J. Heinrich of Irell & Manella LLP, Los Angeles, told Bloomberg BNA that "The Federal Circuit is badly fractured" on the question of "how to determine whether a claim is directed to an 'abstract idea' in the first place" and "the Supreme Court (once again) side-stepped it today."

**Specific Application to Computer-Based Claims Still Unsure.** A similar concern was expressed by Jennifer Lane Spaith of Dorsey & Whitney LLP, Seattle.

"While we now know that implementation of a 'fundamental economic principle' on a computer will likely be insufficient to confer patent eligibility, we are without guidance as to how to apply this to other significant industries developing intangible innovation today—collection and analysis of Big Data that is poised to revolutionize the wearable tech, security, and systems control spaces, cloud computer services, social media applications that are changing how people communicate, collaborate, and work," Spaith said. "The Supreme Court did not offer tools for identifying patentable subject matter in these other intangible areas, so patentees will continue to battle uncertainty in these spaces."

John F. Murphy of Baker & Hostetler LLP, Philadelphia, agreed that the failure to address the definition of an abstract idea was a significant open question.

Furthermore, he said, in saying that recitation of the use of a computer that could be applied by taking "purely conventional" steps was not transformative, the court also did not specify "what makes the computer aspects of a claim more than merely conventional?"

"These questions have been, and still are, of profound interest to the computer software industry," Murphy said.

Indeed, the word "software" did not appear in the court's decision at all.

Nevertheless, Murphy said that there was some helpful guidance offered by the decision, "because it confirms that the framework of *Mayo v. Prometheus* also applies to computer-related claims."

Similarly, Wiley Rein's Dowd told Bloomberg BNA that the decision "did not offer any meaningful guidance as to how much specificity is needed to permit a computer-based invention to be patent-eligible."

"The business community, the patent community, and the PTO were hoping for more guidance about the scope of the 'abstract idea' exception to patent eligibility," he said. "The court fell short here, almost certainly by intention to allow the Federal Circuit and the PTO to develop the law and fill in gaps."

Dowd predicted that this was not "the last battle about the scope of patentable subject matter, particularly with respect to computer-related inventions."

Stuart P. Meyer of Fenwick & West LLP, Mountain View, Calif., said that the court "once again resorts to the 'abstract idea' analysis" while giving "virtually no guidance as to how one could tell what qualifies as an 'abstract idea.'"

"We are all left wondering," Meyer told Bloomberg BNA, "how anyone is supposed to undertake this analysis, with such little guidance being provided. The Court tells us to ignore computer implementation unless it does more than 'apply the abstract idea . . . using some unspecified generic computer.' Accordingly, the potential impact of this case on other software patents is large but significant further litigation will be needed before we see the contours of what is considered 'abstract' by courts."

**Some Software Inventions Definitely Patentable.** Adam Mossoff, a law professor at George Mason University, Arlington, Va., agreed that it was a concern that there was "little to no legal guidance" regarding application of the decision in the future.

However, he said, "the one ray of hope in this decision is that, similar to its affirmation of the patentability

of business methods in *Bilski*, the Court in *Alice Corp.* expressly holds that ‘many computer-implemented claims are formally addressed to patent-eligible subject matter.’ Thus, innovative software inventions in the high-tech industry are now definitively deemed patentable.”

By ANANDASHANKAR MAZUMDAR

## Trademarks/Cancellation

### **TTAB Again Finds ‘Redskins’ Disparaging Under § 2(a), Orders Registrations Cancelled**

■ **Key Holding:** *The board, in a 2-1 ruling, says that the Redskins registrations, owned by Pro-Football Inc., were disparaging to Native Americans when they were registered and therefore must be cancelled*

■ **Key Takeaway:** *The fractured opinion provides the team with ample fodder for an appeal, which the team said will be filed in the Eastern District of Virginia.*

The various trademark registrations used by the Washington Redskins “must be cancelled because they were disparaging to Native Americans at the respective times they were registered, in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a),” the Trademark Trial and Appeal Board held June 18 in a 2-1 ruling that spanned 177 pages (*Blackhorse v. Pro-Football, Inc.*, T.T.A.B., No. 92046185, 6/18/14).

In a decision that was highly anticipated, if not altogether surprising, the board noted that it could not prevent the team from using the marks in the future. Rather, the ruling strips away the team’s ability to rely on certain federal laws to enforce its trademark rights, which, if the registrations are cancelled, will be grounded in common law.

The majority said the evidence conclusively demonstrated that a substantial composite of the Native American population believed that the term was disparaging when each of the six subject registrations issued between 1967 and 1990.

“The opinion is remarkably thorough and is ultimately grounded in what appear to be mountains of carefully sifted, weighed and analyzed factual evidence developed through years of litigation,” Ronald D. Coleman of Goetz Fitzpatrick LLP, New York, told Bloomberg BNA.

The team said it would appeal the decision and the dissent gives them a roadmap for how to attack the board’s decision. An attorney representing the team told Bloomberg BNA that the appeal would go to the U.S. District Court for the Eastern District of Virginia. By forging the Federal Circuit, the team—and the petitioners—will be able to introduce additional evidence that was not considered by the board.

The team has already embraced the dissenting opinion. “We think the dissent made a much more compelling argument than the majority did,” Todd Anten of Quinn Emanuel Urquhart & Sullivan, New York said.

But, by chiseling away at nearly all of the evidence that the majority had painstakingly set forth in support of its holding, some argued that the dissent’s standard was unattainable.

“Without a time machine, his legal standard is all but impossible,” Christine Haight Farley, a law professor at American University, Washington, D.C., told Bloomberg BNA.

**A Record Frozen in Time.** However, although the dissent lambasted the record, accusing the board of employing “gyrations” in order to “make petitioners’ case have some semblance of meaning,” it stopped short of opining on whether the term was disparaging today. That issue, Administrative Judge Marc A. Bergsman noted, was neither relevant nor before the board.

The issue before the board was whether the registrations were disparaging under Section 2(a), which prohibits the registration of any trademark that “consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

But Section 2(a) only applies to applications. A challenge to a registered mark must take place under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3). That provision allows any petitioner at any time to seek cancellation of a registration that the petitioner believes was registered in violation of Section 2(a). To prevail in a Section 14(3) challenge, a petition must demonstrate that a substantial composite of the relevant population considered the term to be disparaging at the time that it was registered.

Thus, Bergsman said that it was important to clarify that this case has nothing to do with “the controversy, currently playing out in the media, over whether the term ‘redskins,’ as the name of Washington’s professional football team, is disparaging to Native Americans today.” Rather, the relevant standards:

require us to answer a much narrower, legal question: whether the evidence made of record in this case establishes that the term “redskins” was disparaging to a substantial composite of Native Americans at the time each of the challenged registrations issued.

The evidence in the instant case was the same as was the evidence in 1999 when the board first determined that the registrations were disparaging in *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999) (57 PTCJ 470, 4/8/99).

*Harjo* was overturned by the U.S. District Court for the District of Columbia on evidentiary grounds (66 PTCJ 633, 10/10/03). In two separate rulings, the U.S. Court of Appeals for the District of Columbia Circuit affirmed the dismissal of the claims on laches grounds after it found that the petitioners had waited too long to challenge the marks (70 PTCJ 358, 7/22/05; 78 PTCJ 83, 5/22/09).

During the March 2013 hearing in this case (85 PTCJ 598, 3/8/13) it appeared that Blackhorse had remedied the laches problem by including younger petitioners, including Amanda Blackhorse, who turned 18 in 2000, and another petitioner who did not turn 18 until just before the instant proceeding was initiated. Indeed, the majority found laches inapplicable and the defense never mentioned the equitable doctrine.

**Majority ‘Guided by the Record.’** The disagreement between Bergsman and the majority was on whether the evidence supported a finding that a substantial composite of the Native American population believed the term to be offensive between 1967 and 1990.



The board assessed two different categories of evidence relating to that time period. The first category focused on the “general analysis of the word” during the relevant time period. The second category of evidence focused on how Native Americans in particular viewed the term during the relevant time period.

The board’s determination that the term was generally considered disparaging at the time the marks were registered was informed in part by dictionary definitions from the time that labeled the term offensive, disparaging and contemptuous. Expert testimony, expert reports, news articles and reference books also supported the board’s conclusion that the term was generally considered to be disparaging during the relevant time period.

The primary piece of evidence that the board looked at to ascertain Native American perceptions of the mark was a 1993 resolution that was passed by the National Congress of American Indians. The NCAI resolution, which stated that the term was historically disparaging, was relevant and admissible, the board said. Moreover, since the NCAI represented 30 percent of the Native American population at that time, the resolution “is clearly probative of the views of Native Americans held at the referenced time period,” the board said.

The board then cited vast amounts of other evidence, such as deposition testimony and letters of protest, that it said also demonstrated that Native Americans viewed the term as disparaging through the relevant time period.

After finding the burden met, the majority said it was immaterial that some Native American groups did not find the term offensive.

“[O]nce a substantial composite has been found, the mere existence of differing opinions cannot change the conclusion,” the board said.

“The ruling is guided by the evidence of record, and based on the evidence of record it seems that the petitioners made their case,” Mark Sommers of Finnegan, Henderson, Farabow, Garrett & Dunner LLP, Washington, D.C., told Bloomberg BNA.

Indeed, the board appeared to methodically cite evidence in the record that supported its disparagement conclusion.

“I’m not surprised that the TTAB was a little more focused on the evidentiary standard both in the majority opinion and the dissent,” Farley said. “That was one of the things to respond to from the district court’s reversal in *Harjo*.”

Bergsman’s dissent, however, attacked nearly every piece of evidence that the board relied on. But he reserved his most scathing criticism for the board’s treatment of the NCAI resolution.

“There is no reliable evidence to corroborate the membership of National Council of American Indians,” Bergsman said. The board’s determination that the NCAI represented 30 percent of Native Americans during the relevant time period was the result of “gyrations the majority employed to establish the membership of the National Council of American Indians,” Bergsman said.

As to the dictionary definitions, Bergsman noted that the relevant publications stated that the term was “often” considered offensive, “meaning that it is not always offensive and leaving open the possibility that ‘Redskins’ is not considered offensive when used in connection with the name of a football team.”

On the balance Bergsman said the petitioners did not present sufficient evidence to justify cancelling the registration, which he noted even the majority agreed should only be done with “due caution.”

**Want to Work at the PTO? Lean to Time Travel.** Coleman, after praising the board for sifting through the mountains of evidence, pointed out that the record “presents the sort of careful evidentiary record that ought to form the basis of a section 2(a) denial.” But even with such a rich record, “it is significant that the dissenting judge came to a different conclusion from that of the majority about the key issue factual issue as determined by the panel, i.e., whether the registration ran afoul of section 2(a) at the time the mark was registered,” Coleman said. He said:

The question of going back in time to make such determinations is inherently rife with problems, and the TTAB did not really wrestle with them. Arguably it was not within their scope of review to do so. While the goal of avoiding offense by government actions such as trademark registration is a laudable goal, achieving that goal seems more than ever to embroil agencies and judges in deciding highly-politicized and sensitive issues that are arguably not appropriately determined by either. Adding “time travel” to their task only makes it more onerous.

Farley disagreed with Coleman on whether it was properly within the board’s scope of review to cancel the registrations. “This is an area of law where there is an opportunity for the public to step up and—for the greater good—ask the PTO to correct itself,” Farley said.

However, she also brought up the time travel theme. Specifically, she said Bergsman appears to be requiring the petitioner “to go back in time to produce a survey detailing what an uncertain composite of a very small minority population felt about the term” from the 1960s through the 1990s. Such a standard “is unreasonably demanding,” she said.

Administrative Judge Peter W. Cataldo joined the board’s opinion.

Blackhorse was represented by Jesse A. Witten of Drinker Biddle & Reath LLP, Washington, D.C.

BY TAMLIN H. BASON

Text is available at <http://pub.bna.com/ptcj/TTABBlackhorseJune18.pdf>.

## Copyrights/Public Domain

### **7th Cir. Affirms That Characters From First Sherlock Holmes Stories Are Public Domain**

■ **Key Holding:** *The Seventh Circuit affirms a federal district court’s granting of summary judgment in favor of a writer and editor involved in the publication of new Sherlock Holmes stories.*

■ **Key Takeaway:** *The fact that the last 10 Sherlock Holmes stories are still protected under U.S. copyright law does not prevent an author from using the characters, elements, and other material from the stories that have fallen into the public domain without the authorization of the copyright holder.*

The fact that a few of the original Sherlock Holmes stories are still under the protection of copyright law does not prevent an author from using material from the stories that have fallen into the public domain without the authorization of the copyright holder, the U.S. Court of Appeals for the Seventh Circuit ruled June 16 (*Klinger v. Conan Doyle Estate, Ltd.*, 7th Cir., No. 14-1128, 6/16/14).

Affirming an award of summary judgment in favor of a party who was planning to collect and publish an anthology of new Sherlock Holmes stories by current writers, the court rejected the copyright holder's attempt to distinguish "simple" or "flat" characters from "complex" or "round" characters, which do not fall into the public domain until all the original works featuring them are in the public domain.

The court emphasized that such a notion would seem to allow an author to extend copyright protection over characters indefinitely.

**Ruling Does Not Surprise Experts.** Experts consulted by Bloomberg BNA expressed no surprise at the court's ruling in this matter.

"It seems to me that this was a totally predictable decision," David O. Carson, former general counsel to the Copyright Office, told Bloomberg BNA. "Based on the facts related in the opinion, it would have been shocking if the court had reached any other result. In describing the plaintiffs' claims as 'quixotic' and as '[l]acking any ground known to American law, the court was being gentle."

"From the start I was astonished that the Conan Doyle estate would bring such an apparently meritless claim," Carson said.

Roger E. Schechter, a professor at George Washington University Law School, was even more critical of the estate. He told Bloomberg BNA:

The Doyle estate's arguments seem so contrived and so clearly against established law in this case that their demands on Klinger's publisher seemed almost extortionate. They seemed to have believed that because Sherlock Holmes was such an enduring and successful fictional creation that they were entitled to continue to squeeze licensing revenues out of him for a longer period than is granted to other more pedestrian fictional creations. It puts one in mind of "double patenting"—seeking to elongate the term of copyright by pointing to minor tweaks in the character in subsequent stories. Its nice to seem them called out, and by no less a judge than Posner.

Ralph Oman, former register of copyrights, told Bloomberg BNA that he found the "opinion entirely persuasive. Mickey Mouse will eventually fall into the public domain, as will complex characters like James Bond, Scarlett O'Hara, and Anne of Green Gables."

Another scholar saw language in the court's opinion that she saw as good news for fan fiction authors and enthusiasts.

Betsy Rosenblatt, a law professor at Whittier College, Costa Mesa, Calif., noted that the opinion recognized "that there's a value—an independent, cultural, social value—in the creation of derivative works that build on pre-existing works and that extending rights can be at least as chilling as it would be incentivizing."

"This isn't the first court that said it, but it's a significant statement that the law should encourage the creation of works built on pre-existing works," Rosenblatt told Bloomberg BNA.

In this case, the other end of the incentive—the incentive to the original author to continue creating—was absent because Doyle is long dead. However, she said, "I think the principal stands even for creators who are alive. Derivative works that don't compete for the market for the original, for example, add tremendous social value.

Another part of the opinion raised some questions in her mind, however. In dicta, the court noted that the defendant in this case had asserted that he would not use any elements of the Holmes and Watson characters that were original in those stories that were still under copyright protection.

"I think it's a great result, but one thing that it sort of highlights that there is a line drawing exercise that has to be done now when you have a character that is partly in copyright and partly outside of copyright as to what is an original element that rises to the level of protectability," Rosenblatt said.

However, the particular examples offered by the court were puzzling. For example, the court noted that in the earlier, public domain Sherlock Holmes stories, Holmes did not like dogs. In the later, still protected works Holmes had changed his mind and had learned to like dogs.

"Certainly the abstract idea detective who loves dogs is not protectable; no one would dream that that was protectable," she said. "So does the transformation of Holmes from non-dog-liker to dog-liker . . . How is that any different from a detective who loves dogs?"

"I think to the extent that there are problems with this outcome, the opinion implies that there might be something protectable about the later versions of these characters when there in fact might not be anything protectable about the later versions of these characters," she said. "It's dicta, but the implication is that there might be something protectable about the later versions of these characters, and I'm not sure if that premise were tested if that would come out in favor of the estate. Maybe it would but I think maybe it shouldn't."

Schechter was not so sure. "If the last 10 Sherlock Holmes stories introduced new details about Holmes—that he loved to eat chocolate ice cream while sitting in his bath, perhaps, or that he became faint at the smell of bacon frying in a pan—those details could not be used until those stories fell into the public domain," he said. "On the other hand, those details that were set out in the earlier stories—that he smoked a pipe, or that he was prone to saying 'Elementary, my dear Watson'—clearly would be in the public domain."

Another possibly puzzling portion of the opinion was pointed out by Zahr K. Said, a law professor at the University of Washington, Seattle.

Late in the opinion, the court drew an analogy between the estate's assertion of control in characters that were not "complete" until the last work and trademark dilution law. The court dedicated several paragraphs to describing dilution law and concluded that it had no parallel in copyright law.

However, Said told Bloomberg BNA that this was "sort of a weird and unnecessary thing to talk about here because we have a copyright way to talk about this here."

Namely, Said was referring to the concept of moral rights, which are broadly applied under European copyright law, but exist only in a limited extent in U.S. law,

in the form of the Visual Artists Rights Act of 1990, 17 U.S.C. § 106A.

“We don’t have those here,” she said, referring to moral rights, “And in my experience with character case law, what parties are most often fighting over is that the original author just doesn’t like what the subsequent users have done.”

In this case, the estate’s claims were about “controlling downstream market and not about outrage or scandal,” Said noted, but in general, she said that such character disputes are more of a moral rights issue, and she said that the court could have addressed that issue squarely and made a statement saying that “we don’t have moral rights” under U.S. law.

“Ultimately the presence of the discussion of trademark dilution is kind of a red herring,” she said.

According to Allison S. Brehm of Kelley Drye & Warren, Los Angeles, the court’s decision was notable in that it preserved the idea of protecting characters as creative works.

She said that it did “not threaten and in fact reinforces the notion that characters may be independently subject to copyright protection. However, that protection will not continue indefinitely until the final use of that original character in a series.”

**Estate Threatens to Block New Holmes Book.** The dispute began with Leslie S. Klinger of Malibu, Calif., who is an editor and writer who concentrates much of his work on literature, analysis, and trivia regarding the 19th century stories of Sherlock Holmes by Arthur Conan Doyle (1859-1930) and Dracula by Abraham “Bram” Stoker (1847-1912).

Between 1887 and 1927, Doyle wrote four Sherlock Holmes novels and 56 short stories. The first Holmes novel, “A Study in Scarlet,” was published in the United States in 1890.

Klinger has worked on 27 books and numerous articles about mystery and thriller literature, the largest [portion of it focusing on the Sherlock Holmes stories. In 2004 and 2005, Klinger published “The New Annotated Sherlock Holmes” and he also advised the creators of Guy Ritchie’s motion pictures “Sherlock Holmes” (2009) and “Sherlock Holmes: A Game of Shadow” (2011), featuring Robert Downey Jr. and Jude Law.

In 2011, Klinger and Laurie E. King published “A Study in Sherlock,” an anthology of new Sherlock Holmes stories by current writers.

The Conan Doyle Estate Ltd. of Southampton, England, was established by Doyle’s heirs and it administers the licensing of Doyle’s works. In 2010, the estate contacted Klinger’s publisher, claiming that they must purchase licenses in order to use the characters and story elements originally created by Doyle.

Klinger’s publisher agreed to enter into a licensing agreement with the estate for a fee of \$4,000.

In 2012 and 2013, Klinger and King were preparing another such anthology for publication by a new publisher, “In the Company of Sherlock Holmes.” Similar demands were made by the estate in 2012 with respect to the second anthology. Klinger’s new publisher declined to publish “In the Company of Sherlock Holmes” under threat of litigation from the estate.

**District Court Awards Summary Judgment.** Klinger then filed a declaratory judgment action against the estate, seeking a declaration that the “characters, character

traits, dialogue, settings, artifacts, story lines and other story elements” from Doyle’s original Sherlock Holmes stories published prior to 1924 had entered into the public domain in the United States and, thus, Klinger could use such creations without seeking authorization from the estate.

Klinger argued that only 10 of Doyle’s Sherlock Holmes short stories, published between 1924 and 1927, were still subject to copyright claims under U.S. law and, thus, anything that had appeared in the pre-1923 works were free for him to use without authorization from the estate.

Chief Judge Rubén Castillo of the U.S. District Court for the Northern District of Illinois determined that there was a case in controversy, making the matter ripe for adjudication

On the substantive question, the court agreed with Klinger that the characters and elements of the pre-1923 stories were in the public domain and could be freely used. The estate appealed.

**Case in Controversy Found.** The appeals court largely affirmed the trial court’s rulings, first agreeing on the question of jurisdiction. The court rejected the estate’s argument that the matter was not ripe for adjudication.

According to the court, the estate had made “twin threats” to Klinger, the first being a threat to interfere with the distribution of the book once it had been completed and published, and also a threat to bring a copyright infringement claim against him.

Indeed, the court pointed out that Klinger’s publisher had already acceded to the threat and had told Klinger that the book would not be published unless Klinger were to secure a license from the estate. This could be grounds for a tortious interference claim by Klinger against the estate, the court said, and thus the matter was “an actual rather than merely a potential controversy.”

The estate also argued that there could not be a ripe controversy, because Klinger had not even finished the book, so there was yet no way to know whether it would infringe the copyright interests that the estate laid claim to. The court said:

That would be a good argument in many cases but not in the present one, because the only issue presented by Klinger’s quest for a declaratory judgment is one of law: whether he is free to copy the characters of Holmes and Watson as they are depicted in the stories and novels of Arthur Conan Doyle that are in the public domain. To answer that question requires no knowledge of the contents of the book.

Because Klinger had asserted that the forthcoming book would not use protectable elements that were original to the 10 books still under protection, there was no need to wait for the book to be completed, the court said.

Furthermore, denying Klinger the opportunity to have this matter adjudicated would have constituted a discouragement to authors to create such works, because their publishers could be intimidated by such threats of legal action or threats of interference with distribution.

**No Legal Support for Extending Protection.** Turning to the substantive question, the court found no support in the law for the estate’s proposition: “We cannot find any basis in statute or case law for extending a copyright beyond its expiration,” the court said. “When a

story falls into the public domain, story elements—including characters covered by the expired copyright—become fair game for follow-on authors.”

To allow otherwise would disturb the balance established by the law to give incentives to the original author to create the original work and to give incentives to new authors to create derivative works.

The court also noted that most “copyrighted works include some, and often a great deal of, public domain material” and that use of the public domain is important to ongoing creativity.

The court rejected the estate’s attempt to draw a distinction between “flat” or “simple” characters—who are complete from the beginning and fall into the public domain when the original work does—and “round” or “complex” characters—who are not completed until the final work in the series. The court said:

What this has to do with copyright law eludes us. There are the early Holmes and Watson stories, and the late ones, and features of Holmes and Watson are depicted in the late stories that are not found in the early ones . . . Only in the late stories for example do we learn that Holmes’s attitude toward dogs has changed—he has grown to like them—and that Watson has been married twice. These additional features, being (we may assume) “original” in the generous sense that the word bears in copyright law, are protected by the unexpired copyrights on the late stories. But Klinger wants just to copy the Holmes and Watson of the early stories, the stories no longer under copyright.

The court rejected the estate’s claim that there was no way for Klinger to separate the early, unprotected, elements of Holmes and Watson from the later, protected, elements. The court said:

From the outset of the series of Arthur Conan Doyle stories and novel that began in 1887 Holmes and Watson were distinctive characters and therefore copyrightable. They were “incomplete” only in the sense that Doyle might want to (and later did) add additional features to their portrayals. The resulting somewhat altered characters were derivative works, the additional features of which that were added in the ten late stories being protected by the copyrights on those stories. The alterations do not revive the expired copyrights on the original characters.

The court analogized the estate’s argument to trademark dilution—which expands the exclusive rights of a trademark owner beyond those impacting infringement itself. However, the court said, such a doctrine did not exist in copyright law, which permitted noninfringing parodies.

Labeling the estate’s appeal as “quixotic,” the court rejected this argument as harboring a “spectre of perpetual, or at least nearly perpetual” copyright protection, especially since the estate was essentially seeking a 135-year copyright term for the original Sherlock Holmes character.

The court noted that the district court had granted only partial summary judgment in Klinger’s favor on the grounds that should Klinger use original, protectable material from the 10 newest books, then the estate could have a cause of action.

However, the court said, this was a mistake on the part of the district court, because Klinger had already declared that no such material would be used and was not seeking a declaration with the scope of covering such material. Thus, the lower court’s ruling with respect to those 10 would could be “ignored,” the court said and the award of summary judgment in Klinger’s

favor represented a resolution to all the outstanding claims in the proceeding.

The court’s opinion was authored by Judge Richard A. Posner and joined by Judge Joel M. Flaum and Judge Daniel A. Manion. Klinger was represented by Polsinelli P.C., Chicago. The estate was represented by Zieske Law, Woodstock, Ill.

By ANANDASHANKAR MAZUMDAR

*Oman and Schechter are members of this publication’s board of advisors.*

*Text is available at [http://www.bloomberglaw.com/public/document/Leslie\\_Klinger\\_v\\_Conan\\_Doyle\\_Estate\\_Ltd\\_Docket\\_No\\_1401128\\_7th\\_Cir](http://www.bloomberglaw.com/public/document/Leslie_Klinger_v_Conan_Doyle_Estate_Ltd_Docket_No_1401128_7th_Cir).*

## Copyrights/DMCA

### **Photobucket Entitled to Safe Harbor Protections Under DMCA, 2nd Cir. Affirms**

**T**he photo-sharing service Photobucket.com Inc.’s entitlement to the safe harbor provisions of the Digital Millennium Copyright Act did not hinge on it scouring its website for infringing materials, the U.S. Court of Appeals for the Second Circuit ruled June 17 in a nonprecedential opinion (*Wolk v. Photobucket.com, Inc.*, 2d Cir., No. 12-420-cv, 6/17/14).

The appeals court said that the district court properly granted Photobucket summary judgment on the grounds that the plaintiff’s copyright infringement claims were barred by Section 512(c) of the DMCA, 17 U.S.C. § 512(c) (83 PTCJ 330, 1/13/12). Sheila Wolk, a professional artist, argued that the district court erred in finding the safe harbor protections applicable despite the fact that Photobucket could have done more to prevent infringing materials from appearing on its servers.

The court said that argument was effectively foreclosed by *Viacom International, Inc. v. YouTube, Inc.*, 676 F.3d 19, 102 U.S.P.Q.2d 1283 (2d Cir. 2012) (83 PTCJ 864, 4/13/12). *Viacom*, the Second Circuit noted, clarified that a service provider will be protected by Section 512(c) so long as it removes infringing content that it has subjective knowledge of, bans repeat offenders and does not financially benefit from infringing activity that it had a right and ability to control.

“This case falls within these parameters,” the court said.

The per curiam opinion was on behalf of Judges Raymond J. Lohier Jr., Gerard E. Lynch and Reena Raggi.

Wolk represented herself. Photobucket was represented by Mark A. Lerner of Satterlee Stephens Burke & Burke LLP, New York.

*Text is available at [http://www.bloomberglaw.com/public/document/Wolk\\_v\\_Kodak\\_Imaging\\_Network\\_Inc\\_Docket\\_No\\_1200420\\_2d\\_Cir\\_Jan\\_30](http://www.bloomberglaw.com/public/document/Wolk_v_Kodak_Imaging_Network_Inc_Docket_No_1200420_2d_Cir_Jan_30).*

## Copyrights/DMCA

### Safe Harbor Does Not Protect Infringing Acts Preceding Copyright Office Registration

**A**n online publishing platform cannot claim DMCA copyright immunity over images published on its website before it designated a DMCA-related agent with the U.S. Copyright Office, the U.S. District Court for the Northern District of California held June 10 (*Oppenheimer v. Allvoices, Inc.*, N.D. Cal., No. 3:14-cv-00499, 6/10/14).

Magistrate Judge Laurel Beeler said the plain language of the Digital Millennium Copyright Act, 17 U.S.C. § 512(c), provides a safe harbor is only available on the predicate, express condition that a registered agent has been designated, and thus registering a DMCA agent does not have retroactive effect.

The court also found that the plaintiff had sufficiently pleaded direct, contributory and vicarious copyright infringement theories.

**Safe Harbor** The DMCA provides a safe harbor for service providers against monetary relief for copyright infringement based on material stored by a third party user on its system or network. The safe harbor applies to service providers without knowledge of the infringing activity who expeditiously remove material once infringement is known, so long as they do not receive a direct financial benefit. The safe harbor only applies, however, if the service provider has designated with the U.S. Copyright Office an agent to receive notification of infringement claims.

Plaintiff David Oppenheimer is a professional photographer who discovered in February 2011 that 20 photographs for which he had obtained copyright registrations had been reproduced on Defendant's Allvoices's website allvoices.com by site users. In March 2011 Allvoices filed with the Copyright Office a DMCA registration designating an agent to receive infringement notifications. In August 2011 Oppenheimer sent a cease-and-desist letter asking Allvoices to remove the infringing images. In his January 2014 complaint Oppenheimer said alleged that Allvoices "eventually removed access to the works," but that it had not terminated the accounts of known repeat infringers.

The court held that Allvoices's March 2011 DMCA registration did not create a safe harbor for images published prior to registration. Allvoices argued that once it filed a DMCA registration, it enjoyed safe harbor protections for all infringements and not just those occurring after that date. It argued that nothing in the text of the DMCA carved out or preserved liability for infringements that pre-dated registration.

The court disagreed, saying that prior authority—including a case in which Allvoices was the defendant with the same counsel as the current litigation—clearly determined that DMCA protection does not apply to infringement that pre-dates registration. *Nat'l Photo Group, LLC v. Allvoices, Inc.*, No.: C-13-03627 JSC, 2014 BL 23693 (N.D. Cal. Jan. 24, 2014). Rather, the court found that registration was a "predicate, express condition" of DMCA protection and that the safe harbor applies "only if" an agent has been designated.

**Direct, Contributory and Vicarious Infringement.** Absent safe harbor protection, the court found that Oppenheimer had successfully pled direct, contributory and vicarious copyright infringement theories.

As for direct infringement, the court said Oppenheimer had successfully pled ownership of a copyright and violation of an exclusive right under the Copyright Act, 17 U.S.C. § 106. Direct infringement, the court said, does not require any particular state of mind.

Allvoices argued that a copyright plaintiff must also show that volitional conduct by the defendant caused the infringement. The court found that the Second and Fourth Circuits have adopted that requirement, but that the Ninth Circuit has not ruled on the issue and trial court opinions have split on the issue. Nevertheless, the court said Oppenheimer did not merely allege that Allvoices users had infringed their copyrights. Instead, it alleged that Allvoices reproduced and displayed the images without permission. Allvoices's argument that only its users directly infringed Oppenheimer's copyrights was better addressed at the summary judgment stage, the court said.

Contributory infringement requires knowledge of third-party infringing activity and inducing, causing or materially contributing to infringing conduct. Allvoices argued that Oppenheimer merely restated the elements in his complaint. Oppenheimer placed a copyright registration notice on the images, however, and sent the August cease-and-desist. He also alleged that Allvoice had the ability to disable access between its own systems and sites containing copyrighted material and failed to do so. Thus Oppenheimer successfully pled contributory infringement.

Allvoices argued that Oppenheimer had conceded that it removed the images promptly upon receiving the cease-and-desist letter. The allegation that Allvoices "eventually" removed the images, however, did not concede that Allvoices "promptly" removed the images, the court found.

Vicarious infringement requires the right and ability to supervise the infringing conduct and direct financial interest in the infringing activity. The first element require both the legal right as well as the practical ability to cut off or limit the infringing conduct. The second element requires a causal relationship between the infringement and the benefit received by the defendant, which may include the availability of infringing material acting as a draw for customers.

The court found that Oppenheimer sufficiently pled the right and ability to supervise infringing conduct by alleging that Allvoices maintained the right to screen posts, promote articles and maintained internal software to screen submitted content for copyright infringement. Allvoices argued that its site is unmediated, but the court said that did not refute Oppenheimer's allegations and was more appropriately raised on summary judgment.

As to the direct financial interest element, Oppenheimer argued that Allvoices benefitted from the avoidance of licensing fees for the copyrighted works, and Allvoices did not respond to that argument. Allvoices did challenge Oppenheimer's argument that increased web traffic resulted from the infringed content and led to greater revenue. The court disagreed that any existing authority foreclosed on the argument that advertising revenue is a sufficient financial interest for vicarious infringement.

Allvoices also argued that Oppenheimer failed to plead pervasive participation in infringement as required under *Fonovisa, Inc. v. Cherry Auction, Inc.*, 76 F.3d 259, 263-64, 37 U.S.P.Q.2d 1590 (9th Cir. 1996) (51 PTCJ 446, 2/1/96). The court found that under *Fonovisa*, pervasive participation in infringing conduct may be evidence of vicarious infringement, but it is not an element of or prerequisite for vicarious infringement liability.

Accordingly, the court denied Allvoices's motion to dismiss Oppenheimer's copyright claims.

The court dismissed without prejudice Oppenheimer's claims under the Lanham Act, 15 U.S.C. § 1125(a), because the court could not adduce whether they were brought under the false designation of origin or false advertising prong of the statute.

Winston & Strawn represented Allvoices. Eco Tech Law Group PC and Wessels Arsenault LLC represented Oppenheimer.

Text is available at [http://www.bloomberglaw.com/public/document/OPPENHEIMER\\_v\\_ALLVOICES\\_C\\_1400499\\_LB\\_Re\\_ECF\\_No\\_23\\_2014\\_BL\\_160484\\_](http://www.bloomberglaw.com/public/document/OPPENHEIMER_v_ALLVOICES_C_1400499_LB_Re_ECF_No_23_2014_BL_160484_).

## Copyrights/Conferences

### Panelists: New Technologies, Court Decisions Muddle Copyright, E-Commerce Landscape

Technology is changing distribution channels and business models of viewing content while recent court decisions are creating uncertainties about intellectual property rights both online and offline, according to participants at the Stanford University Law School e-commerce best practices conference.

Central to the June 16 discussions were recent decisions involving Google Inc. and a bit actress who the U.S. Court of Appeals for the Ninth Circuit said held copyright interest in her performance in a controversial movie and a pending U.S. Supreme Court case pitting broadcast giants against a technology startup backed by IAC/InterActive Corp. and its chairman Barry Diller, a former studio and television head.

In *Garcia v. Google Inc.*, a 2-1 Ninth Circuit panel granted actress Cindy Garcia's request for a preliminary injunction requiring Google to take down from YouTube.com an amateur anti-Islamic film in which she appeared for seven seconds. *Garcia v. Google, Inc.*, 2014 BL 51739, 109 U.S.P.Q.2d 1799 (9th Cir., 2/26/14) (87 PTCJ 929, 2/28/14).

Tom Rubin of Microsoft Corp. called it "one of the most surprising, shocking, interesting cases that I've seen in my career studying copyright law."

"Bad facts do make bad law, and that's where we are at right now," said Rubin.

The Ninth Circuit is considering Google and YouTube's request for en banc review (87 PTCJ 1140, 3/21/14).

Amici include Netflix Inc.; Facebook Inc.; Twitter Inc.; Adobe Inc.; Pinterest Inc.; California Broadcasters Association; 20 IP law professors; the Electronic Frontier Foundation; and documentarian Morgan Spurlock from "Super Size Me."

With the case still pending, Rubin said that the "best advice one can have right now is sit tight and pay attention."

**Covering All Bases.** Mark Lemley, a law professor at Stanford Program, said the court "struggled mightily to achieve the results it achieved."

"I think one thing that would have clearly made its work much harder is a signed contract from anyone who encounters your film in any way that expressly grants a set of rights," Lemley said. "One best practice from the content creation side is, get contracts from absolutely anyone that assign rights," something studios already do, he said.

Google's Fred von Lohmann emphasized the challenges to "get a signed contract from every human being who appears in any scrap of video" for a broad array of parties including independent user-created videos that are an increasingly important segment of the 100 hours of video uploaded every minute to YouTube.

"Some of my colleagues have said that this is a *Bush v. Gore* of copyright law," referring to the Supreme Court's decision that decided the 2000 presidential election in favor of George W. Bush, and is intended as a one-shot decision, von Lohmann said. "But I'm not nearly so confident."

The decision is enough to convince people to bring a copyright claim based on an on-camera appearance, von Lohmann said.

**Focusing on the Cloud and Aereo.** Turning to the cloud, the panel discussed IAC's Aereo, which streams broadcast network programming to subscribers using thousands of dime-sized antennas that individually pick up a broadcast signal, make a copy and send the unique copy to a single subscriber.

During oral argument in *Am. Broad. Cos., Inc. v. Aereo, Inc.*, No. 13-461 (U.S. argued April 22, 2014), Justice Stephen G. Breyer admitted to Aereo's attorney that he was concerned about unintended consequences to "all kinds of other technologies" in the court's ultimate opinion in the copyright infringement case (87 PTCJ 1517, 4/25/14).

Elizabeth Valentina of Fox Entertainment Group Inc. said there's "no blanket liability for a whole sector of businesses just because you call it cloud. It depends what you're doing. It depends on the function."

"The reason this matters for cloud computing is there are a lot of companies out there whose business model is, 'let me provide a storage platform for information and then have that information downloaded to individual users,' " such as Box.com or Dropbox Inc., Lemley said.

"If those individual acts are in fact themselves private transmissions, copyright law doesn't care. But if it's a public transmission, then a lot of companies engaged in cloud computing suddenly have a whole new front of copyright liability they have to worry about," Lemley said.

Lemley and Joseph Gratz of Durie Tangri LLP in San Francisco and vice chair of the American Bar Association IP Section's Committee on Copyright and New Technologies, represent Aereo.

**Far-Reaching Impact.** "What happens if Aereo loses? It depends," Valentina said. "If they want to keep going the case still goes," she said. Other claims such as reproduction are unanalyzed and remain to be litigated, she said. The issue before the court is about over-the-air programming, so a result could be sports programs move to cable, Valentina said.

The issues are far bigger and reach to the future of cloud computing, von Lohmann said. Aereo, he said, "is a DVR in a cloud."

"The reason it is so important is it demonstrates a real fundamental mismatch in copyright law today as that transition takes place" from storage on devices to storage in the cloud, he said. "There's no reason the law should treat those things differently, and yet the arguments being made in the *Aereo* case by copyright owners would treat those drastically differently," von Lohmann said.

The risk is creating a lack of parity in copyright law, where for purely legal reasons it becomes more sensible to do stuff not in the cloud but in boxes in living room, closing the door on the cloud approach, he said.

**DMCA No Answer.** Von Lohmann disagreed that the Digital Millennium Copyright Act could solve problems created in cloud storage.

Under the statute, a copyright owner can't send a DMCA takedown notice to works stored in a file on a hard drive. "How does that cloud product compete with the hard drive in your laptop if you can't trust that the files that you put in there will still be there when you come back and you need them? That's the difference between the DMCA and the situation that applies to the hard drive sitting in your laptop," he said.

"I love the DMCA. Don't get me wrong. But it was not intended to be an all-purpose fix for everything that could conceivably happen in the cloud," von Lohmann said.

By JOYCE E. CUTLER

### Copyrights/Conferences

## Will Licensing Expand to Physical Goods Before First Sale Expands to Digital Goods?

■ **Key Holding:** *An intended panel discussion on the application of the first sale doctrine to digital goods becomes a discussion about the application of licensing models to tangible goods.*

"In the future, consumers may own certain kinds of essential things that they use very often, but things that they only use on certain rare occasions—dancing shoes, most jewelry, that pizza-making set that you have—those types of things are going to be licensed," Keith Kupferschmid, general counsel and vice president of the Software & Information Industry Association said June 13 at an event convened by the Congressional Internet Caucus.

Kupferschmid and other panelists gathered to discuss whether the first sale doctrine should be extended to digital goods. But his comments on licensing dancing shoes were typical of the discussion. Indeed, the panelists were as interested in discussing how licensing models, developed to serve customers in the software and Internet markets, were being adapted to the brick and mortar world as they were in discussing digital first sale.

"Licensing is much more interesting these days than ownership," Sandra Aistars, CEO of the Copyright Alliance, said. "Innovation is happening in the digital economy more by services that are based on providing access to goods rather than sales of goods."

Such innovation is not confined solely to entertainment products and digital goods, Aistars said, noting the rising popularity of services like Zipcar and bike share. In these examples, consumers pay a fee not to own the tangible goods but to take part in an experience, Aistars said. "And in the online world, consumers are likewise demonstrating a preference for acquiring subscriptions to streaming services rather than downloads."

### **The Day the Music Died Was When Your Access Lapsed.**

The notion—advocated by Aistars and Kupferschmid—that consumers are perfectly willing to license rather than buy was countered by the other two panelists: James Grimmelmann of the University of Maryland School of Law and Jonathan Band of the Owners' Rights Initiative. Moreover, even if consumers are comfortable with licensing in general, that does not excuse the fact that many licensing models are presented to consumers as purchasing models, Grimmelmann and Band argued.

"One of the reasons that streaming services like Spotify feel fair to people is that they understand that when you stop paying the monthly fees, your access stops," Grimmelmann said. "Expectations around buying digital goods aren't as clear."

Band agreed. "When you get the Zipcar for a day you know you are not buying the car. That is very clear to the consumer," he said.

It is less clear if a customer who hits a "buy" button to get a song on iTunes or a book on Amazon understands that they may in fact only be licensing the product.

Even Aistars and Kupferschmid agreed that more should be done to alleviate consumer confusion about whether they are licensing or buying a product. They argued, however, that consumer protection law, not copyright law, should serve as the backdrop for any efforts to dispel customer confusion.

**Digital Textbooks: Innovative or Restrictive** The starkest disagreement on the panel was about whether domestic textbooks should be subject to the first sale doctrine. International text books, like those at issue in *Kirtsaeng v. John Wiley & Sons Inc.*, 133 S. Ct. 1351, 2013 BL 72102, 106 U.S.P.Q.2d 1001 (U.S. 2013) (85 PTCJ 802, 4/5/13), were only discussed enough to reveal that Band supported the Supreme Court's ruling and Kupferschmid did not.

Domestic text books, of course, have traditionally fallen under the first sale doctrine, which is why secondhand textbook stores flourished even before Internet sites allowed students to easily sell their used textbooks. This trend did not go unnoticed, Grimmelmann said.

"Textbook publishers have long resented the pressure that first sale puts on their business models," he said. "And so the publishers have been very aggressive in trying to push digital copies," which cannot be resold. Grimmelmann said students have "largely resisted buying digital books" because the prices are too high and because they are unable to recoup any of the cost by selling the book on the secondary market.

Band noted that in addition students have limited choices in the marketplace once a book has been assigned.

"This is the Washington, D.C. spin machine," Kupferschmid said. "These new e-textbooks are dramati-

cally reducing the costs and we can't ignore all the bells and whistles, which are beneficial to not only students but to teachers and the universities as well," he said of all of the additional features embedded in the e-books. The argument that these innovations are intended to restrict access to information ignores the fact that "we are giving the students and the consumers what they want," he said.

**What Should Congress Do?** At the beginning of the event, Tim Lordan, executive director of the Internet Caucus, promised a discussion about whether Congress should clarify whether a consumer can dispose of a lawfully purchased digital good under the first sale doctrine. That issue was recently taken up by the House Judiciary Subcommittee on Courts, Intellectual Property and the Internet during a hearing in New York, (88 PTCJ 366, 6/6/14), and was also discussed during a multi-stakeholder meeting in December that was convened by the Commerce Department's Internet Policy Task Force (87 PTCJ 375, 12/20/13).

But since the June 13 panelists were largely focused on the emergence of licensing models, especially as they are applied to tangible goods, Lordan was able to ask just one question about what, if anything, Congress should do about digital first sale. In response, the panelists said:

- "There is nothing that Congress should do at all with the digital first sale doctrine. If there is something that Congress should do it is look at the *Kirtsaeng* case," Kupferschmid said.

- "The *Kirtsaeng* ruling came out just right. That is the last thing Congress should do," Band said.

- "We should not be sacrificing the unprecedented options that consumers have under licensing models to try to make the Internet world act like the analog world," Aistars said.

- "Congress should make sure that first sale of physical goods remains and should protect consumer expectations for virtual goods," Grimmelmann said.

BY TAMLIN H. BASON

### Copyrights/Foreign Laws

## Iceland's Domain Registry Considered 'Hostile' to Copyright by Stakeholders

Iceland's national domain name registry (ISNIC) could potentially face prosecution if it does not become more receptive to complaints from copyright holders, an official at the Performing Rights Society of Iceland told Bloomberg BNA. In a June 11 statement, STEF General Manager Gudrun Bjork Bjarnadottir said that her organization was concerned over the number of sites registered under the Icelandic domain name .is that facilitate copyright infringement.

Bjarnadottir's comments follow the file sharing site Putlocker.bz's June 3 announcement that it was moving its registration from a .bz registry to Iceland, which it described as a "safe haven for freedom of speech". The nation has previously hosted major torrent sites such as Deildu.net and The Pirate Bay, which left in April 2013 after Swedish authorities filed a motion in Stockholm

demanding the seizure of both the Swedish and Icelandic domain names. In August 2013, former Megaupload boss Kim Dotcom announced via Twitter that he was considering relocating his new venture, Mega, to Iceland.

While private prosecutions for copyright infringement are possible, Bjarnadottir said, ISNIC was not currently accountable to any state body and did not have a policy of taking down domain names after a complaint from a copyright holder. "We are a little worried about how this is developing," she said. "The government and in particular the Ministry of the Interior needs to develop a more decisive strategy or standpoint on this matter and improve the legal environment."

"ISNIC is a private company that sets its own rules," she said. "And in its rules there are no provisions that allow it to deny a registration even if it can be proven that a site is acting illegally. If it wanted to, it could block domain names. But in my view, the people that run it, their whole view towards copyright is a bit of a hostile one. There is not much willingness to tackle the problem."

"What makes it more complicated is that unlike most other countries, which have laws that allow public bodies to intervene and set some ground rules for domain name bodies, there are currently no laws on domain names in Iceland," she said. "I do know that some years ago the ministry was working on a proposal but nothing has ever been presented to parliament. The current Minister of the Interior has set up a working committee on illegal streaming and downloads. I do hope that the current minister will actually make some changes."

Together with three other copyright holders organizations, she said, STEF was in the process of applying for injunctions against two sites, Deildu.net and The Pirate Bay, under the nation's Copyright Act. "It might even be possible to take out a prosecution against ISNIC itself if it can be shown that it willingly or knowingly allows illegal file sharing — though this has not been attempted as yet," she said.

"The government is very keen on promoting free speech and creating an environment that puts emphasis on that," she said. "But at the same time I don't think that they want to be a free haven for torrent sites. In this respect, all lobbying and all pressure definitely has a bearing. The Pirate Bay left Iceland after just two or three weeks after pressure from Swedish prosecutors, not the Icelandic state. Of course it would be helpful if other countries were to make their opinion known in this matter."

In a June 11 statement provided to Bloomberg BNA, Iceland's Ministry of Education, Science and Culture confirmed that ISNIC was a private entity that operates under assignment from the Internet Assigned Numbers Authority and the Internet Corporation for Assigned Names and Numbers and issues .is domain names in accordance with its own procedural rules.

"For some years the Minister of the Interior has tried to get passed by parliament a bill of law for regulation of .is domain names [but] so far no law has been passed," the statement read.

"Article 59a(2) of the Icelandic Copyright Act stipulates that rights holders may obtain an injunction against dissemination by an internet service provider irrespective of his responsibility for the data, including the blocking of access to illegal file sharing websites," the statement said. "To the ministry's knowledge there



are no court cases where rights holders have submitted blocking requests against ISNIC”.

“Case law on illegal file sharing is scarce,” it continued. “The Icelandic Copyright Act provides that damages may be awarded for illegal file sharing as well as up to two years imprisonment. The most recent Supreme Court case is Istorrent (Case 214/2009) where liability for damage was accepted, but the sum of the damages are yet to be decided in a separate case”.

In a June 8 statement provided to Bloomberg BNA, ISNIC said that its recent growth in registrations was typical for a small country code top-level domain, or ccTLD. “We are an Icelandic company under Icelandic laws,” the statement read. “We do not remove registered .is domains without a court order. ISNIC has never been prosecuted in twenty years of registration history of .is. Iceland will never be a ‘haven’ for file sharing sites due to its fragile/limited connectivity to the rest of the world”.

Iceland’s government broadly supports a 2010 legal initiative from the Icelandic Modern Media Initiative that aims to “assemble the best laws to make Iceland [a leader] in freedom of expression and information.” IMMI’s goals include the provision of digital anonymity for journalists, internet publishers and whistleblowers from other nations.

By MARCUS HOY

### *Intellectual Property/Foreign Laws*

## **China’s Antitrust Authority Proposes Regulation to Bar Abuse of IP Rights**

**C**hina’s antimonopoly authority would prohibit companies from using intellectual property rights to restrict market competition and would penalize violators for up to 10 percent of annual sales, according to a draft regulation open for public comment until July 10.

The State Administration for Industry & Commerce (SAIC) on June 10 issued the draft regulation on its website, and the Legislative Affairs Office of the State Council on June 11 re-released it on its website. The proposed rule is needed to strengthen the anti-monopoly law and enhance the transparency of anti-trust enforcement, the government maintained.

The draft regulation provides that an operator with a dominant market position cannot use intellectual property rights to eliminate or restrict competition and that such abuse of IP rights would be considered a monopoly agreement. The draft defines terms and goes into detail about what would constitute misuse of patents and copyrights. Penalties include confiscation of illegal income and a penalty of between 1 to 10 percent of the company’s annual sales, according to the draft regulation.

**More than 300 Comments** The SAIC in 2012 started working on draft guidelines, surveyed and visited a number of IP-intensive enterprises in major cities and provinces, and held seminars to collect views before writing the first draft of the regulation, according to an accompanying explanatory document from the SAIC.

Since March 2013, the SAIC has held seminars five times to get input on the draft, and it gathered com-

ments from other ministries and departments—including the National People’s Congress, the Supreme People’s Court, the Legal Office of the National Development and Reform Commission, the Ministry of Commerce and others.

The SAIC also consulted with private companies including China Telecom, Huawei, Qualcomm, Samsung, and 19 other IP-intensive enterprises; business institutions such as the U.S. Chamber of Commerce; scholars and foreign experts of competition law such as the American Bar Association; and competition enforcement agencies—including the European Commission’s Competition Directorate General, the Canadian Competition Bureau, and the U.S. Department of Justice and Federal Trade Commission.

More than 300 comments and suggestions were collected and used to improve the draft regulation, the SAIC document said.

By LESLIE A. PAPPAS

*The notice about the draft regulation and accompanying documents is available in Chinese at [http://www.saic.gov.cn/gzhd/zqyj/201406/t20140610\\_145803.html](http://www.saic.gov.cn/gzhd/zqyj/201406/t20140610_145803.html).*

### *Intellectual Property/International Trade*

## **U.S. Calls for End to WTO Moratorium Covering Non-Violation TRIPS Disputes**

**T**he U.S. called for an end to the moratorium on “non-violation” disputes in connection with the Trade Related Aspects of Intellectual Property Rights (TRIPS) at a meeting of the World Trade Organization’s TRIPS Council June 11, according to a WTO official.

At the same meeting, Ecuador’s delegation said it would prepare a revised proposal to ease patent restrictions and strengthen TRIPS flexibility for the transfer of environmentally sound technologies—a proposal that was criticized by a number of developed countries including the U.S. and the EU, the official said,

**U.S. Proposal Faces Opposition.** In a WTO non-violation case, one country challenges the legality of another’s actions if it feels it is deprived of an expected benefit, such as market access, even if no actual agreement or commitment has been violated. Non-violation disputes are allowed for goods and services, but a moratorium on such disputes in the field of intellectual property has been extended several times.

Prior to the TRIPS Council meeting, the U.S. circulated a paper saying that non-violation cases are an “exceptional remedy” but are fully consistent with the WTO’s TRIPS Agreement, the General Agreement on Tariffs and Trade and the Dispute Settlement Understanding. The paper also said such cases would not upset the balance of rights obligations between intellectual property holders and users, and would not infringe upon members’ sovereign rights because it would not infringe upon their ability “to implement legitimate social, economic development, health, environmental and cultural policies.”

Switzerland’s delegation supported the U.S. position, according to the WTO official. However, the EU and Japan said they needed more time to study the issue, and

a number of other countries—including South Africa, Brazil, China, India, Russia and Canada—said they still consider non-violation cases to be inappropriate in the context of intellectual property.

**Green Technologies Transfer.** The TRIPS Council also discussed Ecuador's proposal to ease patent terms and strengthen TRIPS flexibilities to ease the transfer of environmentally sound technologies, the WTO official said.

Some developing countries, including Cuba, El Salvador and Peru, continued to support Ecuador's proposal, but others, including Chile, stressed that the flexibilities and other tools that already exist in the TRIPS Agreement should be used.

A number of developed countries pushed back against Ecuador's proposal, arguing that intellectual property protection does not hinder innovation and technology transfer in developing countries. The EU said that only a tiny percentage of green technologies are patented in developing countries, meaning these countries use the technologies and see how they work from the descriptions in patents in developed countries.

The developed nations said other obstacles, such as lack of resources, high investment costs, subsidies and import duties, inhibit the adoption of green technologies, according to the WTO official.

Ecuador said it is preparing a revised proposal for the next TRIPS Council meeting, scheduled for Oct. 28-29. It also called for a short information session on the subject, with the participation of outside experts, before that meeting.

BY BRIAN FLOOD

*The full text of the U.S.'s report on non-violation complaints is available at <http://op.bna.com/itr.nsf/r?Open=bfld-9kzm6q>.*

*The full text of Ecuador's environmentally sound technologies proposal is available at <http://op.bna.com/itr.nsf/r?Open=bfld-9kznmf>.*

## Intellectual Property/International Trade

### **Vilsack Says U.S., EU Must Find 'Sweet Spot' To Overcome Differences On GIs in TTIP Talks**

**T**he key to finding a compromise in the Transatlantic Trade and Investment Partnership negotiations between the U.S. and the European Union on the controversial issue of geographical indications involves finding a "sweet spot" that reconciles the differences between the U.S. trademark system and the EU approach to awarding exclusive use of GIs, U.S. Agriculture Secretary Tom Vilsack said June 17.

Following a meeting with EU Agriculture Commissioner Dacian Ciolos and another in the European Parliament, Vilsack also insisted that if an agreement is not reached on geographical indications as part of an overall deal on agriculture issues it will be politically impossible for TTIP to get approval in the U.S. Congress or the European Parliament.

### **"I appreciate that we need to better explain the approach we take on GIs."**

EU AGRICULTURE COMMISSIONER DACIAN CIOLOS

"We need to be creative and innovative if we are going to find a solution," Vilsack said when asked how the two sides can overcome differences on geographical indications. "It is important for each side to understand the differences and find the common aspects. Or the sweet spot if there is one."

As a result of the meeting, Ciolos said the U.S. and the EU would meet to examine the different ways the two sides address GIs before the issue is negotiated in TTIP.

"I appreciate that we need to better explain the approach we take on GIs," said Ciolos. "And we have made a commitment to do that today."

**Exclusive Use of 'Generic Terms.'** U.S. food producers oppose the EU geographical indications system because they say it gives exclusive use of common food names such as "feta" or "parmesan" that have become generic terms over the past century.

"Parmesan, feta and other commonly used terms that the EU is seeking to lay sole claim to are in fact used by numerous other industries around the world and have been for many years," Shawna Morris, a trade policy specialist with the U.S. Dairy Export Council, told Bloomberg BNA. Noting that the U.S. trademark system has granted rights to some European GIs, Morris said that "what many in the U.S. have long expressed concerns about is the EU's desire to have other countries adopt their specific methods for granting protection as well as the EU's view that many generic terms are not in fact generic."

The EU's chief negotiator Ignacio Garcia Bercero has noted that the EU and the U.S. have reached agreement on the use of GIs related to wine in an EU-U.S. agreement and says he is confident that a similar compromise could be reached in TTIP on food-related GIs.

**Tariffs, Regulatory Differences Remain.** The issue of GIs is one of a number of agriculture-related disputes that separate the two sides in the TTIP talks. There are differences on tariffs in addition to regulatory issues involving hormone treated beef and chlorine-treated poultry, both of the which the EU bans, and GM crops.

Dan Mullaney, assistant U.S. trade representative and chief negotiator for the TTIP talks, has made it clear that the U.S. sees the TTIP as a way to boost U.S. agriculture exports to the EU to overcome a trade imbalance. Therefore the U.S. insists TTIP is a commitment to eliminate agriculture tariffs while the EU insists there should be tariff-rate quotas that will protect some sensitive EU agriculture goods.

Speaking after his meeting with Vilsack, the European Parliament's Agriculture Committee Chairman Paolo De Castro insisted that TTIP "must lift barriers and new opportunities to EU producers to export their products across the ocean but at the same time ensure the high EU standards that our farmers must meet and our consumers currently enjoy."

“Neither must it compromise our views on issues such as use of hormones, cloning and GMOs,” De Castro said.

BY JOE KIRWIN

### *Intellectual Property/International Trade*

## **Vilsack Holds ‘Frank Discussions’ With EU Ministers; Geographical Indication a Focus**

U.S. Department of Agriculture Secretary Tom Vilsack held “frank discussions” June 16 with European Union ministers in Brussels that touched on ongoing points of disagreement on the Transatlantic Trade and Investment Partnership, including the issue of “geographical indications,” the secretary said during a June 16 conference call with reporters.

Vilsack described the session with 28 agricultural ministers as a “strong start to a very important but difficult discussion.” The ministers met over a working lunch with each participant given the opportunity to respond to Vilsack’s opening comments.

Vilsack said his presentation to the EU ministers at the start of the June 16 meeting was “very candid” regarding the need for a “real commitment to agriculture” in the TTIP agreement, in order for a final agreement to have any chance of being passed by the U.S. Congress. The U.S. and the EU are working to complete negotiations on the free trade agreement amid ongoing concerns about the use of biotechnology for genetically modified organisms, pesticide regulations, meat and poultry production and processing methods, and dairy.

Topics addressed during the discussions included phytosanitary issues, biotechnology, cloning, regional simplification and geographical indications, but the one addressed by all ministers speaking at the session was geographical indications, the secretary said.

Vilsack is on a tour of four European capitals aimed at expanding trade, with stops in Brussels, Luxembourg City, Paris and Dublin. He will begin one-on-one meetings with EU ministers on June 17.

Vilsack’s engagement on the agricultural issues related to TTIP come as U.S. market share continues to shrink due to foreign trade barriers faced by U.S. producers and exporters. The TTIP negotiation offers an opportunity to address these barriers and expand market access for U.S. farmers and ranchers.

**At Odds Over Geographical Indications.** The U.S. and EU have been at odds over the contentious issue of geographical indications, or GIs, which involve intellectual property rights. GIs are names of places or historical names used with food, such as “feta” cheese and Parmigiano Reggiano, that describe a process. They are more widely used in Europe and could put restrictions on U.S. dairy producers who make similar food products with these generic names.

Vilsack said the discussions did not touch on the “opt-out” provision and that the officials more generally talked about the need for diversity among production processes. Vilsack said the U.S. has not “specifically taken a position” on the opt-out provision, but when it does the position it takes will be “guided by science.”

The EU’s Council of Environment Ministers voted June 12 to back a proposal that allows EU member

states to opt out of EU-wide provisions on genetically modified organisms and ban the cultivation of genetically modified crops for reasons other than science.

U.S.-EU discussions have been “complicated” by the fact that the EU and Canada have entered into a trade agreement and agreed to a process that does not “fit particularly well” with the U.S. trademark system, Vilsack said.

“We need to find that sweet spot where value can be protected but market access is not denied,” the secretary said, adding that he is “optimistic” that ultimately producers will realize the trade agreement benefits all sides in the long term.

BY STEPHANIE COHEN

### *Patents/Obviousness*

## **Choice of Lead Compound for Hepatitis Drug Baraclude Was Obvious, Fed. Cir. Affirms**

■ **Key Holding:** *The Federal Circuit affirms that Bristol-Myers Squibb’s patent for its hepatitis B drug, Baraclude, is invalid for obviousness.*

■ **Key Takeaway:** *Teva will now be able bring a generic version of the drug to market.*

By the time Bristol-Myers Squibb Co. filed a patent application in 1990 that included a claim for entecavir, a compound that is sold to treat Hepatitis B under the brand name Baraclude, researchers had already begun to use a lead compound similar to entecavir in antiviral treatments, rendering the claim obvious, the U.S. Court of Appeals for the Federal Circuit held June 12 (*Bristol-Myers Squibb Co. v. Teva Pharm. USA, Inc.*, Fed. Cir., No. 2013-1306, 6/12/14).

The prior art that doomed Bristol’s patent was 2’-CDG, which had been synthesized in 1984 and had been the focus of extensive research in the late 1980s. Given the promising results of much of that research, a person of ordinary skill in the art would have selected 2’-CDG as a lead compound for further development before Bristol filed its patent application, the Federal Circuit said. From that point, a “minor modification” was all it took to arrive at entecavir from 2’-CDG, the Federal Circuit said.

The appeals court thus affirmed an obviousness ruling in favor of Teva Pharmaceuticals USA Inc., whose abbreviated new drug application for a generic version of entecavir had promoted Bristol’s patent infringement claim.

**Claim 8 Invalid for Obviousness; No Inequitable Conduct.** Claim 8 of Bristol’s patent (U.S. Patent No. 5,206,244) is directed to a viral compound, entecavir, which itself is comprised of two regions: a carbocyclic ring and a guanine base.

Like entecavir, 2’-CDG is similar to the natural nucleoside deoxyguanosine. The synthesis of 2’-CDG was disclosed by Dr. Y. Fulmer Shealy in 1984, and she later obtained a patent on 2’-CDG and related compounds to treat viral infections.

After the Shealy reference was published, other researchers began working with 2’-CDG as an antiviral, and there were numerous reports hailing 2’-CDG as a promising lead compound.

Bristol's failure to disclose the 2'-CDG reference during the prosecution of the '244 patent led to Teva tacking an inequitable conduct challenge onto its argument that claim 8 was invalid due to obviousness. In 2012, following the tightening of the inequitable conduct standard in *Therasense Inc. v. Becton, Dickinson and Co.*, 649 F. 3d 1276, 99 U.S.P.Q.2d 1065 (Fed. Cir. 2011) (82 PTCJ 140, 6/3/11), the U.S. District Court for the District of Delaware ruled that contradictory testimony in the record prevented it from ruling on Bristol's motion for a ruling of no inequitable conduct at the summary judgment stage (84 PTCJ 520, 7/27/12). However, in that same order the district court acknowledged that the now-tightened standards for asserting an inequitable conduct defense would make it difficult for Teva.

The district court's final opinion, which found claim 8 invalid for obviousness, found that the claim was not unenforceable due to inequitable conduct. The inequitable conduct ruling was not appealed. Accordingly, the Federal Circuit had only to determine whether the district court obviousness ruling was clearly erroneous.

**Unexpected Results Argument Rejected.** After noting the substantial amount of research that was taking place on the 2'-CDG compound at the time that Bristol filed its patent application, the Federal Circuit affirmed the obviousness ruling. "[W]e see no clear error in the district court's finding that the modification required to transform 2'-CDG into the structurally similar entecavir is a minor one," Judge Raymond T. Chen said.

The court also dismissed Bristol's argument that claim 8 was nonobvious on the basis of unexpected results. Such an argument is probative only if the patentee can "establish that there is a difference between the results obtained and those of the closest prior art, and that the difference would not have been expected by one of ordinary skill in the art at the time of the invention," the court said.

In this case, before Bristol ever filed its patent "it was already known in the prior art that 2'-CDG was effective against hepatitis," the court said. It accordingly declined to disturb the district court's ruling that the unexpected results of entecavir did not overcome an obviousness ruling based on 2'-CDG.

Rejecting Bristol's remaining arguments, the appeals court affirmed the ruling that claim 8 was invalid due to obviousness.

Chief Judge Sharon Prost and Judge S. Jay Plager joined the court's opinion.

Teva was represented by George C. Lombardi of Winston & Strawn LLP, Chicago. Bristol was represented by William F. Lee of Wilmer Cutler Pickering Hale and Dorr LLP, Boston.

BY TAMLIN H. BASON

Text is available at [http://www.bloomberglaw.com/public/document/BristolMyers\\_Squibb\\_Company\\_v\\_Teva\\_Pharmaceuticals\\_USA\\_Inc\\_Docket](http://www.bloomberglaw.com/public/document/BristolMyers_Squibb_Company_v_Teva_Pharmaceuticals_USA_Inc_Docket)

## Patents/Indefiniteness

### Patent Asserted Against Nintendo Wii Remote Held Invalid for Indefiniteness

■ **Key Holding:** *The Federal Circuit affirms a federal district court's ruling that a patent relating to a remote controller that could detect motion in three dimensions asserted against Nintendo's Wii Remote was invalid for indefiniteness.*

A patent asserted against Nintendo's Wii Remote was invalid for indefiniteness, the U.S. Court of Appeals for the Federal Circuit ruled June 13 (*Triton Tech of Tex., LLC v. Nintendo of Am., Inc.*, Fed. Cir., No. 2013-1476, 6/13/14).

Affirming a federal district court's ruling, the court found that the claims had failed to set forth an algorithm for specifying a means for performing a function.

**Patent Claims 3D Controller.** Triton Tech of Texas LLC of Marshall, Texas, was the assignee of a patent (U.S. Patent No. 5,181,181), titled a "Computer Apparatus Input Device For Three-Dimensional Information," relating to communication by a computer user with a computer by moving a device in three dimensions.

Triton sued Nintendo Co.'s U.S. subsidiary, Nintendo of America Inc. of Redmond, Wash., alleging that the use of Nintendo's Wii Remote with another accessory infringed the '181 patent.

Judge Richard A. Jones of the U.S. District Court for the Western District of Washington construed a term in the '181 patent—"integrator means"—in a manner that rendered the relevant claims indefinite. Triton appealed.

**Algorithm Not Disclosed.** The relevant portion of the patent claimed an "input device for providing information to a computing device" whose components included an "integrator means associated with said input device for integrating said acceleration signals over time to produce velocity signals for linear translation."

The appeals court cited *Aristocrat Techs. Austr. Pty. Ltd. v. Int'l Gaming Tech.*, 521 F.3d 1328, 86 U.S.P.Q.2d 1235 (Fed. Cir. 2008) (75 PTCJ 595, 4/4/08), for the proposition that 35 U.S.C. § 112, para. 6, allowed for an element of a claim to be written in the form of a means for performing a function, but:

If the function is performed by a general purpose computer or microprocessor, then the specification must also disclose the algorithm that the computer performs to accomplish that function.

The court agreed with the district court that Triton's patent had failed to disclose any algorithm "for performing the claimed integrating function of the 'integrator means.'"

Referring to "numerical integration" by itself was insufficient to disclose an algorithm, because it was not a "step-by-step procedure—for performing the claimed function," the court said. The court agreed with the district court's conclusion that "numerical integration is not an algorithm but is instead an entire class of different possible algorithms used to perform integration."

The court concluded:

Disclosing the broad class of "numerical integration" does not limit the scope of the claim to the "corresponding struc-

ture, material, or acts” that perform the function, as required by section 112. Indeed, it is hardly more than a restatement of the integrating function itself. Disclosure of a class of algorithms “that places no limitations on how values are calculated, combined, or weighted is insufficient to make the bounds of the claims understandable.”

Triton’s remaining arguments were found to have been waived because they had not been properly preserved for appeal.

The court’s opinion was authored by Judge Kimberly Ann Moore and was joined by Judge Jimmie V. Reyna and Judge Todd M. Hughes. Triton was represented by Heninger Garrison Davis LLC, Atlanta. Nintendo was represented by Perkins Coie LLP, Los Angeles.

By ANANDASHANKAR MAZUMDAR

Text is available at [http://www.bloomberglaw.com/public/document/Triton\\_Tech\\_of\\_Texas\\_LLC\\_v\\_Nintendo\\_of\\_America\\_Inc\\_Docket\\_No\\_1301](http://www.bloomberglaw.com/public/document/Triton_Tech_of_Texas_LLC_v_Nintendo_of_America_Inc_Docket_No_1301).

## Patents/Obviousness

### Feature That Displayed Users’ Names In Website’s URL Was Obvious, CAFC Says

A method to display a customer’s name in a URL as a way to encourage Internet traffic to a merchant’s website was obvious in light of the prior art, the U.S. Court of Appeals for the Federal Circuit affirmed June 12 in a nonprecedential opinion (*In re Wirth*, Fed. Cir., No. 2014-1075, 6/12/14).

The Patent Trial and Appeal Board found claim 1 of an application (U.S. Patent App. No. 10/277,162) invalid under 35 U.S.C. § 103(a). The application, which described a method for sending a customer a personalized mailing that included a URL containing the customer’s name, was obvious in light of two patents (U.S. Patent Nos. 5,792,972; 6,014,634), the board found.

“The use of a person’s name as a particularized suffix in a URL would have been obvious to a person of ordinary skill in the art from the ‘972 patent’s disclosure of a unique personal identification number as a suffix in a URL,” Judge Kathleen M. O’Malley said. The court therefore affirmed the obviousness rejection. The Federal Circuit, however, disagreed with the board’s expansive claim construction and the board’s application of the printed matter doctrine.

Judges Todd M. Hughes and Jimmie V. Reyna joined the opinion.

The applicants, John Wirth, Jr. and Todd C. Nelson, were represented by Jeffrey Howard Nelson of Nixon & Vanderhye P.C., Arlington, Va. Molly R. Silfen, Associate Solicitor of the Patent and Trademark Office, represented the agency.

Text is available at [http://www.bloomberglaw.com/public/document/In\\_re\\_Wirth\\_Docket\\_No\\_1401075\\_Fed\\_Cir\\_Nov\\_12\\_2013\\_Court\\_Docket](http://www.bloomberglaw.com/public/document/In_re_Wirth_Docket_No_1401075_Fed_Cir_Nov_12_2013_Court_Docket)

## Patents/Courts

### Patent Community Not Surprised By Rader’s Retirement But Many Still Sad to See Him Go

■ **Summary:** Judge Randall Rader’s June 13 announcement that he will soon retire from the Federal Circuit may have been foreshadowed by recent developments, but some in the patent community say those issues shouldn’t overshadow his decades of public service and his leadership on patent issue

Judge Randall R. Rader’s last day on the bench will be June 30, according to an announcement issued June 13 by the U.S. Court of Appeals for the Federal Circuit. Rader, therefore, will retire exactly one month after resigning as chief judge—a move that was precipitated by admissions of impropriety going to Rader’s off-the-record emails to an attorney who had argued before the court.

“The bottom line is that I was not happy after leaving the Chief position and it hit me that I need to leave while I am young and full of energy to change the world,” Rader said in a statement sent to—and published by—Jeff Wold of IAM Magazine. In the same statement Rader said he looked forward to teaching more, particularly at international universities.

Bloomberg BNA reached out to members of the patent community for comment and the result was an outpouring of support for the retiring jurist.

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**“[Rader] leaving the court will create a void that will be difficult to fill.”**

—NANCY J. LINCK, ROTHWELL FIGG ERNST & MANBECK

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“Judge Rader’s resignation is a significant loss to the Federal Circuit,” Scott A.M. Chambers of Squire Patton Boggs (US) LLP, said. “I believe he will continue to shape and influence patent law in the US and abroad through his teaching, but I was saddened to see he was leaving the court.”

Former Patent and Trademark Office Solicitor Nancy J. Linck, now with Rothwell Figg Ernst & Manbeck, echoed Chambers. “His leaving will be a huge loss to the court,” she said. However, Linck was not entirely surprised by the announcement. “I do not think his leaving was that unexpected,” she said.

**Rader Spent 24 Years on Federal Circuit.** Rader, 65, was appointed to the Federal Circuit by President George H. W. Bush in 1990 after a two-year stint on what is now the U. S. Court of Federal Claims. He became chief judge on May 30, 2010.

He came to the appeals court after years of service in Congress. As chief counsel to the Senate Judiciary Committee in the early 1980s, Rader had a hand in the Federal Courts Improvement Act of 1982, which created the Federal Circuit and gave it exclusive jurisdiction over patent law.

Linck noted that the patent system was being threatened in the 1980s and 1990s before Rader joined the Federal Circuit. She said:

Judge Rader did not come from the patent community, yet he understood the value of a strong patent system and the necessity to maintain that value. Given his understanding, in spite of the ongoing attack on the system, Judge Rader endeavored to and has made a huge, positive impact on the Federal Circuit.

Q. Todd Dickinson, executive director of the American Intellectual Property Law Association—who served as director of the Patent and Trademark Office from 1998 to 2001—told also stressed Rader’s leadership.

“Judge Rader is the exemplar of a judge who strives to understand the patent system thoroughly, while ensuring that those who litigate in it are treated fairly,” Dickinson said.

**Will Focus on Teaching International Students.** Rader is an adjunct law professor at George Washington University, where he teaches patent law and other intellectual property courses. He has taught related courses at the University of Virginia, Georgetown University, the Munich Intellectual Property Law Center and other university programs overseas.

As chief judge, Rader often focused on relations with members of foreign courts who specialized in patent law. His statement then, that he hopes to teach IP courses all of the globe, is not altogether surprising.

**“Judge Rader is the exemplar of a judge who strives to understand the patent system thoroughly, while ensuring that those who litigate in it are treated fairly.”**

—Q. TODD DICKINSON, AIPLA

“Judge Rader’s decision to focus on teaching in his post-Federal Circuit life is commendable,” Harold C. Wegner of Foley & Lardner, Washington, D.C., told Bloomberg BNA. “He has been a preeminent patent professor at George Washington law school for more than a generation and also taught literally thousands of students in Asia and Europe.”

Linck said teaching is “a calling I know he loves and does extremely well.” She added, “Certainly, he can provide his students with a unique perspective on patent law, both in our country and abroad. That said, his leaving the court will create a void that will be difficult to fill.”

Dickinson said:

He cares deeply about what intellectual property means for the good of mankind and works hard to bring that understanding to others around the world. While his work on the Court will be missed, we are confident that this broader mission will endure through his teaching and travel.

**Improper Email Results in Late Recusal.** The May 23 announcement that Rader was stepping down as chief judge came in the wake of reports explaining why Rader had recused himself after an opinion—with him in the dissent—had already been published. *Microsoft Corp. v. DataTern, Inc.*, 2014 BL 93378, 110 U.S.P.Q.2d 1411 (Fed. Cir. April 4, 2014) (87 PTCJ 1358, 4/11/14).

At the time, news reports said Rader recused himself for sending a laudatory email to one of the attorneys in-

involved in the case, Edward R. Reines of Weil, Gotshal & Manges LLP, Redwood Shores, Calif., The opinion was reissued May 5 as a two-judge panel decision without the dissent (88 PTCJ 100, 5/9/14).

In an open letter to his colleagues, dated May 23, Rader acknowledge subject case and other recusals and tried to “create a public record concerning the circumstances that led to those recusals.”

He then apologized for “conduct that crossed the lines established for the purpose of maintaining a judicial process whose integrity must remain beyond question.” Specifically, Rader said that the email “constituted a breach of the ethical obligation not to lend the prestige of the judicial office to advance the private interests of others.”

BY TAMLIN H. BASON

*Chambers, Dickinson and Linck are members of this journal’s advisory board.*

### Patents/ITC

## **ITC Commissioners Broadbent, Pinkert Step Up As Chairman, Vice Chairman**

International Trade Commissioner Meredith Broadbent began a two-year term as ITC chairman, while commissioner Dean Pinkert stepped up to the vice chairman’s seat, the ITC said June 17.

Broadbent has been an ITC commissioner since Sept. 10, 2012, and Pinkert has served since Feb. 26, 2007. President Barack Obama designated them to their new positions.

The ITC—a quasi-judicial federal agency—provides expertise on trade issues to Congress and the executive branch, maintains the U.S. tariff schedule, and makes determinations in proceedings involving claims that imports injured a U.S. industry or violate U.S. intellectual property rights.

Before Broadbent’s appointment, she held the William M. Scholl Chair in International Business at the Center for Strategic and International Studies. Previously, she also served as assistant U.S. trade representative for industry, market access, and telecommunications and worked as a trade advisor at the Global Business Dialogue, a multinational business association focused on trade and investment issues. Broadbent also served as a senior professional staff member serving Republicans on the House Ways and Means Committee, according to the ITC.

Pinkert served as a senior attorney in the Office of the Chief Counsel for Import Administration at the Commerce Department before being tapped as a commissioner. Earlier in his career, he was an attorney-adviser in the Office of the Chief Counsel for Import Administration. Previously he also served as the trade and judiciary counsel to former West Virginia Sen. Robert Byrd, the ITC said.

BY ROSSELLA BREVETTI

*The ITC press releases are available at [http://www.usitc.gov/press\\_room/news\\_release/2014/er0617mm1.htm](http://www.usitc.gov/press_room/news_release/2014/er0617mm1.htm) and [http://www.usitc.gov/press\\_room/news\\_release/2014/er0617mm2.htm](http://www.usitc.gov/press_room/news_release/2014/er0617mm2.htm).*

## Supreme Court/Orders and Petitions

### **No Review of Fed. Circuit's Split Decision In Patent Dispute Between State Universities**

The Supreme Court on June 16 denied a petition for certiorari in *Caret v. Univ. of Utah* (U.S. No. 13-947, review denied 6/16/14), and will not review a split decision by the U.S. Court of Appeals for the Federal Circuit related to jurisdiction when two states—through state universities—contest patent rights.

In *Univ. of Utah v. Max-Planck-Gesellschaft zur Förderung der Wissenschaften e.V.*, 734 F.3d 1315, 2013 BL 217754, 107 U.S.P.Q.2d 1989 (Fed. Cir. 2013) (86 PTCJ 843, 8/23/13), the Federal Circuit held that a state university that was assigned a patent has “no core sovereign interest in inventorship.”

The 2-1 decision affirmed a district court's judgment that it had jurisdiction over a case featuring two state universities' claims that only their respective employees can claim to have invented a development in the field of RNA interference (RNAi).

Under the dissent's view, the dispute would have been between the states, which can only be resolved by the U.S. Supreme Court, per Article II, § 2, cl. 2 of the Constitution, as codified at 28 U.S.C. § 1251(a).

The questions presented in the petition were:

1. Whether the Federal Circuit correctly held that a dispute between two States over ownership of patent rights may be adjudicated in a federal district court, despite this Court's exclusive jurisdiction over suits between States, as long as (1) the plaintiff-State sues only officials of the other State in their official capacity, and (2) the district court determines that the case does not implicate the core sovereign interests of the two States.

2. Whether a State can utilize the *Ex parte Young* doctrine to circumvent this Court's original and exclusive jurisdiction over controversies between States by amending its complaint to drop the defendant-State and add in its place state officials against whom the plaintiff-State seeks no relief, where the dispute concerns which State is the owner of disputed patent rights.

*Ex Parte Young*, 209 U.S. 123 (1908), identified an exception to sovereign immunity, allowing a lawsuit in federal courts against an official, acting on behalf of state, who takes an unconstitutional action.

Paul M. Smith of Jenner & Block LLP, Washington, D.C., filed the petition on behalf of UMass President Robert L. Caret, other UMass officials, Alnylam and the patent owners.

Mark S. Carlson of Hagens Berman Sobol Shapiro, Seattle, represented the University of Utah before the Federal Circuit

## Supreme Court/Orders and Petitions

### **Not So Fast: Supreme Court Won't Review Dismissal of Yeager's False Endorsement Suit**

The Supreme Court denied a petition for certiorari appealing an unpublished decision by the U.S. Court of Appeals for the Ninth Circuit that dismissed famed pilot Charles E. (Chuck) Yeager's claims of false endorsement, under Section 43(a) of the Lan-

ham Act, 15 U.S.C. § 1125(a), *Yeager v. Aviat Aircraft Inc.* (U.S. No. 13-1326, review denied 6/16/14).

The Ninth Circuit had affirmed a district court's determination that Yeager's claims were time-barred by California's two-year statute of limitations. No. 11-17910, 2014 BL 21965 (9th Cir. 2014). Yeager, who in 1947 became the first aircraft pilot to break the sound barrier, sued Aviat Aircraft Inc. for the unauthorized use of his name and images on its website. The originally published materials in 2001 and 2003, were, according to Yeager, republished since.

Yeager's pro se petition identified the question presented as:

Does California's two year statute of limitations single-publication rule govern the accrual of a Lanham Act claim arising from a web-based merchant's refusal to remove a celebrity's unauthorized endorsement from the merchant's website and if passed allow the merchant to continue to make money off celebrity's name forever?

Robert C. Gebhardt of Wilson Elser Moskowitz Edelman & Dicker LLP, San Francisco, represented Aviat before the Ninth Circuit

## Trade Dress/Injunctions

### **Kind Snack Bar Maker Fails to Obtain Preliminary Injunction Against Clif Mojo Bar**

■ **Key Holding:** A federal district court finds that snack bar company Kind has failed to establish a likelihood of success on the merits of its claim that Clif Mojo bars infringed Kind's trade dress.

Snack bar company Kind failed to establish a likelihood of success on the merits of its claim that Clif Mojo bars infringed Kind's trade dress, the U.S. District Court for the Southern District of New York ruled June 12 (*Kind LLC v. Clif Bar & Co.*, 2014 BL 163152, S.D.N.Y., No. 1:14-cv-00770-KMW-RLE, 6/12/14).

Denying a motion for a preliminary injunction, the court determined that even though there was some evidence that Clif had intentionally set out to copy certain elements of the Kind package design, that the resulting package overall created a very different impression.

**Snack Bar Makers Go Head-to-Head.** Clif Bar & Co. of Emeryville, Calif., founded in 1992, is a producer of snack bars targeting those interested in healthy snacks. It markets a range of different snack bars, including the Clif Mojo bar.

Kind LLC of New York, founded in 2004, is a competitor of Clif. Kind sued Clif, alleging that the packaging of the Mojo bar infringed its own trade dress and moved for a preliminary injunction.

**Packaging Not Inherently Distinctive.** Denying the motion, the court first determined that Kind's identified trade dress was a “common packaging design” and was not inherently distinctive. The trade dress elements claimed by Kind were:

(1) packaging with a transparent, rectangular front panel revealing a large portion of the bar itself; (2) a horizontal stripe bisecting the transparent front panel containing the flavor of the bar in text; (3) a text description of the product line (e.g. “Fruit & Nut,” “Plus,” or “Nuts & Spices”) in

line with the horizontal strip bisecting the transparent front panel; (4) a vertical black band, offset to the side of the package, containing a bulleted list of many of the bar's key healthful attributes; (5) opaque vertical bands, or end caps, at either edge of the product package; and (6) a 40g size, in a slender shape.

However, the court said that this package design was not generic; rather it was descriptive. Descriptive trade dress can become protectable if acquired distinctiveness can be shown in the form of secondary meaning.

However, the court said that it could not determine from the evidence currently before it whether any apparent distinctiveness could be attributed to the trade dress elements asserted by Kind or whether instead it was due to the use of Kind's own logo or the combination of the logo and the trademark.

Thus, the court determined that Kind had failed to establish secondary meaning for purposes of the preliminary injunction motion.

Applying a multi-factor test for likelihood of confusion, the court additionally found that Kind had failed to establish the Clif Mojo packaging creating a likelihood of confusion with Kind's packaging.

The claimed trade dress was weak, the court said. Furthermore, comparing the two companies' packaging designs, there were significant differences, particularly in the overall minimalist feel of the Kind package and the highly embellished Clif package.

Evidence of actual confusion proffered by Kind was weak, the court said, especially when the Clif Mojo had not been on the market long enough for such evidence to accumulate.

There was some evidence that Clif had intentionally set out to copy elements of Kind's trade dress in the form of an internal company slide presentation and internal electronic mail messages.

However, the court said that this did not support an inference of bad faith, because the overall impression of the packaging was very different.

The court thus denied the motion.

The court's opinion was authored by Judge Kimba M. Wood. Kind was represented by Debevoise & Plimpton LLP, New York. Clif was represented by Kilpatrick Townsend & Stockton LLP, San Francisco.

By ANANDASHANKAR MAZUMDAR

*Text is available at [http://www.bloomberglaw.com/public/document/KIND\\_LLC\\_Plaintiff\\_against\\_CLIF\\_BAR\\_COMPANY\\_Defendant\\_No\\_14\\_Civ\\_](http://www.bloomberglaw.com/public/document/KIND_LLC_Plaintiff_against_CLIF_BAR_COMPANY_Defendant_No_14_Civ_).*

## Federal Register

### Recent Notices

The following federal register notices have been recently issued relating to intellectual property matters:

#### Patent and Trademark Office

**Request for comments. 79 Fed. Reg. 34,291:** Request for Comments on Virtual Marking.

**Date:** June 16.

#### Comments Due: July 16.

**Summary:** Section 16 of the Leahy-Smith America Invents Act of 2011, 35 U.S.C. § 287(a), provides for "virtual marking." That is, instead of requiring that notice of a patent claim be made by the physical marking of an item with a patent number, a patent holder may offer a link to a freely accessible website.

The AIA directed the PTO to submit within three years a report to Congress, that included:

(A) an analysis of the effectiveness of "virtual marking" . . . ; (B) an analysis of whether such virtual marking has limited or improved the ability of the general public to access information about patents; (C) an analysis of the legal issues, if any, that arise from such virtual marking; and (D) an analysis of the deficiencies, if any, of such virtual marking.

Pursuant to that requirement, the PTO has initiated this request for comments. The PTO has set forth a specified series of questions for commenters to address:

1. Experiences with creating and maintaining adequate and effective virtual marking Web sites;
2. effectiveness of virtual marking, including experiences using virtual marking Web sites to locate relevant patent information;
3. challenges presented by virtual marking in providing sufficient notice to the public, including sufficiently associating patent numbers with the corresponding product within the virtual marking Web site;
4. economic impacts of virtual marking, including costs differences between physical marking and virtual marking;
5. advantages and disadvantages of virtual marking in comparison with physical marking;
6. identification of other practical or legal concerns with virtual marking; and
7. any other issues or experiences regarding virtual marking.

#### Patent and Trademark Office

**Notice of Proposed Rulemaking. 79 Fed. Reg. 34,681:** Changes to Patent Term Adjustment in View of the Federal Circuit Decision in *Novartis v. Lee*.

**Date:** June 18.

**Comments Due:** Aug. 18.

**Summary:** Patent term extensions are given for excess time taken by the PTO to approve the patents. In recent years, there have been numerous challenges to the PTO's interpretation of provisions of the Uruguay Round Agreements Act of 1994, 35 U.S.C. § 154(b), which was amended by the American Inventors Protection Act of 1999.

The PTO promulgated 37 C.F.R. § 1.703(b)(1), which stated that delays subject to Section 154(b)(1)(B)—delays caused by the PTO's failure "to issue a patent within 3 years after the actual filing date . . . not including . . . any time consumed by continued examination of the application requested by the applicant"—did not include days "in the period beginning on the date on which a request for continued examination of the application . . . was filed and ending on the date the patent was issued."

*Novartis AG v. Lee*, 740 F.3d 593, 2014 BL 106371, 109 U.S.P.Q.2d 1385 (Fed. Cir. 2014) (87 PTCJ 618, 1/24/14), ruled that the applicant is responsible for delays in patent allowance incurred by requests for continued examination. Accordingly, any patent term ex-



tension would not include the time from a request for continued examination to the date the PTO allowed the patented claims. However, any time between the allowance and the date the patent actually issued would be subject to an extension, contrary to the PTO's rule.

As a result, the PTO has initiated a rulemaking to make two changes to the relevant regulation to be consistent with the *Novartis* decision:

The Office is proposing changes to the rules of practice to provide that the time consumed by continued examination does not include the time after a notice of allowance, unless the Office actually resumes examination of the application after allowance. The Office also is proposing changes to the rules of practice to provide that the submission of a request for continued examination after a notice of allowance has been mailed will constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application and thus result in a reduction of any period of patent term adjustment.

The rules affected would be 37 C.F.R. §§ 1.703(b)(1) and 1.704(c). Comments on this proposal are due Aug. 18.

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*Text of 79 Fed. Reg. 34,291 is available at <http://pub.bna.com/ptcj/79FR2014140440616.pdf>.*

*Text of 79 Fed. Reg. 34,681 is available at <http://pub.bna.com/ptcj/79FR2014141860618.pdf>.*

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## Legal Moves

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### Personnel Changes at IP Law Firms, Organizations

The following changes in personnel and other news have been announced recently by prominent intellectual property law firms and other IP-related organizations:

■ IP lawyer **David W. Hannon** has left **Greenberg Traurig LLP**, Chicago, for a position as senior associate at IP boutique law firm **Bejin, VanOphem & Bieneman PLC**, Detroit. Patent lawyer **Christopher M. Francis** has left **Howard & Howard Attorneys PLLC**, Royal Oak, Mich., also for a position as senior associate at Bejin. IP lawyer **George T. Schooff** has left **Harness, Dickey & Pierce PLC**, Troy, Mich., for a position as of counsel at Bejin.

■ **Kerry Leonard** has accepted a position as patent agent at the **Saidman DesignLaw Group LLC**, Silver Spring, Md.

■ Patent lawyer **Neslihan I. Doran-Civan** has left **Nelson Mullins Riley & Scarborough LLP**, Boston, for a position as an associate in the software and electrical engineering team at **Kilpatrick Townsend & Stockton**, San Francisco.

■ IP lawyer **Michael A. Cicero** has left **Womble Carlyle Sandridge & Rice LLP**, Atlanta, for a position as of counsel at **Taylor English Duma LLP**, Atlanta.

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*Suggestions for items to be included in this section can be sent to [ptcj@bna.com](mailto:ptcj@bna.com)*

# Tables

## Supreme Court IP Case Developments

### Pending and resolved Supreme Court cert petitions as of June 19, 2014.

Case	Type	Action	Status
<b>GRANTED</b>			
Am. Broad. Cos., Inc. v. Aereo, Inc. No. 13-461	Copyright	Petition 10/11/13 Response 12/12/13 Granted 1/10/14 Petitioner brief 2/24/14 Respondent brief 3/26/14 Reply brief 4/14/14 Arguments heard 4/22/14 (87 PTCJ 1517, 4/25/14)	Waiting decision
Petrella v. Metro-Goldwyn-Mayer, Inc. No. 12-1315	Copyright	Petition 4/30/13 Response 8/2/13 Reply 8/20/13 Granted 10/1/13 Petitioner brief 11/15/13 Respondent brief 12/16/13 Arguments heard 1/21/14 Decision 5/19/14 (88 PTCJ 233, 5/23/14)	6-3 reversal of Ninth Circuit
Lexmark Int'l, Inc. v. Static Control Components, Inc. No. 12-873	False Advertising	Petition 1/14/13 Response 5/1/13 Reply 5/10/13 Granted 10/1/13 Petitioner brief 8/16/13 Respondent brief 10/15/13 Arguments heard 12/3/13 Decision 3/25/14 (87 PTCJ 1223, 3/28/14)	9-0 affirmance of Sixth Circuit
Alice Corp. v. CLS Bank Int'l No. 13-298	Patent	Petition 9/6/13 Response 11/6/13 Granted 12/6/13 Petitioner brief 1/21/14 Respondent brief 2/20/14 Reply brief 3/19/14 Argued 3/31/14 Decision 6/19/14 (88 PTCJ 513, 6/20/14)	9-0 affirmance of Federal Circuit
Highmark Inc. v. Allcare Health Mgmt. Sys., Inc. No. 12-1163	Patent	Petition 3/25/13 Response 6/13/13 Reply 6/25/13 Granted 10/1/13 Petitioner brief 12/2/13 Respondent brief 1/17/14 Arguments heard 2/26/14	9-0 reversal of Federal Circuit

**Pending and resolved Supreme Court cert petitions as of June 19, 2014. – Continued**

<b>Case</b>	<b>Type</b>	<b>Action</b>	<b>Status</b>
		Decision 4/29/14 (88 PTCJ 28, 5/2/14)	
Limelight Networks, Inc. v. Akamai Techs., Inc. No. 12-786	Patent	Petition 1/2/13 Response 4/3/13 Reply 5/20/13 SG brief 12/10/13 Granted 1/10/14 Petitioner brief 2/24/14 Respondent brief 3/26/14 Reply brief 4/22/14 Arguments heard 4/30/14 Decision 6/2/14 (88 PTCJ 371, 6/6/14)	9-0 reversal of Federal Circuit
Medtronic Inc. v. Mirowski Family Ventures, LLC No. 12-1128	Patent	Petition 3/14/13 Response 4/5/13 Reply 4/25/13 Petitioner brief 7/26/13 Respondent brief 9/16/13 Arguments heard 11/5/13 Decision 1/22/14 (87 PTCJ 625, 1/24/14)	9-0 reversal of Federal Circuit
Nautilus, Inc. v. Biosig Instruments, Inc. No. 13-369	Patent	Petition 9/19/13 Response 11/22/13 Reply 12/10/13 Granted 1/10/14 Petitioner brief 2/24/14 Respondent brief 3/26/14 Reply brief 4/14/14 Arguments heard 4/28/14 Decision 6/2/14 (88 PTCJ 373, 6/6/14)	9-0 vacating Federal Circuit opinion
Octane Fitness, LLC v. Icon Health & Fitness, Inc. No. 12-1184	Patent	Petition 3/27/13 Response 5/29/13 Reply 6/6/13 Granted 10/1/13 Petitioner brief 12/2/13 Respondent brief 1/17/14 Reply brief 2/18/14 Arguments heard 2/26/14 Decision 4/29/14 (88 PTCJ 28, 5/2/14)	9-0 reversal of Federal Circuit
Teva Pharm. USA, Inc. v. Sandoz, Inc. No. 13-854	Patent	Petition 1/16/14 Response 2/5/14 Reply 2/26/14 Granted 3/31/14 Petitioner brief 6/13/14 (87 PTCJ 1296, 4/4/14)	Respondent brief due 7/14/2014 (scheduled for next term)
Pom Wonderful LLC v. Coca-Cola Co. No. 12-761	Trademark	Petition 12/21/12 Response 2/22/13 Reply 3/7/13	8-0 reversal of Ninth Circuit

**Pending and resolved Supreme Court cert petitions as of June 19, 2014. – Continued**

<b>Case</b>	<b>Type</b>	<b>Action</b>	<b>Status</b>
		SG brief 11/27/13 Granted 1/10/14 Petitioner brief 2/24/14 Respondent brief 3/26/14 Reply brief 3/26/14 Arguments heard 4/21/14 Decision 6/12/14 (88 PTCJ 437, 6/13/14)	
<b>GRANTED, VACATED, REMANDED</b>			
Broadcom Corp. v. U.S. Dist. Court for the Eastern Dist. of Texas No. 12-1475	Patent	Petition 6/19/13 Response 7/22/13 Reply 8/6/13 GVR 12/9/13 (87 PTCJ 333, 12/13/13)	Remanded in light of <i>Atlantic Marine</i> (non-patent case)
Kobe Props. SARL v. Checkpoint Sys., Inc. No. 13-788	Patent	Petition 1/2/14 Response 3/17/14 Conference 4/18/14 GVR 5/5/14 (88 PTCJ 107, 5/9/14)	Remanded in light of <i>Octane</i> and <i>Highmark</i>
LG Elecs., Inc. v. InterDigital Commc'ns, LLC No. 13-796	Patent	Petition 1/3/14 IDC response waived ITC response 3/19/14 Reply 4/2/14 GVR 4/21/14 (87 PTCJ 1524, 4/25/14)	Remanded for mootness
<b>PENDING GRANTED CASES</b>			
Accenture Global Servs., GmbH v. Guidewire Software, Inc. No. 13-918	Patent	Petition 1/31/14 Response 4/2/14 Reply 4/14/14 Conference 5/2/14 (87 PTCJ 751, 2/7/14)	Pending decision in <i>Alice v. CLS Bank</i>
Bancorp Servs., LLC v. Sun Life Assurance Co. of Canada (U.S.) No. 13-584	Patent	Petition 9/8/13 Response 1/21/14 Reply 2/4/14 Conference 2/21/14 (87 PTCJ 118, 11/15/13)	Pending decision in <i>Alice v. CLS Bank</i>
WildTangent, Inc. v. Ultramercial LLC No. 13-255	Patent	Petition 8/23/13 Response 1/6/14 Reply 1/9/14 Conference 1/24/14 (87 PTCJ 688, 1/31/14)	Pending decision in <i>Alice v. CLS Bank</i>
<b>CALL FOR VIEWS OF SOLICITOR GENERAL</b>			
Cisco Sys., Inc. v. Commil USA, LLC No. 13-1044	Patent	Petition 3/5/14 Response 4/16/14 Reply 5/5/14 CVSG 5/27/14 (88 PTCJ 315, 5/30/14)	Waiting SG response

**Pending and resolved Supreme Court cert petitions as of June 19, 2014. – Continued**

<b>Case</b>	<b>Type</b>	<b>Action</b>	<b>Status</b>
Commil USA, LLC v. Cisco Sys., Inc. No. 13-896	Patent	Petition 1/28/14 Response 3/31/14 CVSG 5/27/14 (88 PTCJ 315, 5/30/14)	Waiting SG response
Kimble v. Marvel Enters. Inc. No. 13-720	Patent	Petition 12/17/13 Response waived 1/13/14 Response requested 2/23/14 Response 4/23/14 Reply 5/12/14 CVSG 6/2/14 (88 PTCJ 383, 6/6/14)	Waiting SG response
<b>CONFERENCE SCHEDULED</b>			
Gevo, Inc. v. Butamax Advanced Biofuels LLC No. 13-1286	Patent	Petition 4/24/14 Response 6/13/14 (88 PTCJ 36, 5/2/14)	Conference 6/26/14
Rudolph Techs., Inc. v. Integrated Tech. Corp. No. 13-1062	Patent	Petition 3/6/14 Response waived 4/1/14 Response requested 4/22/14 Response 5/22/14 (87 PTCJ 1088, 3/14/14)	Conference 6/26/14
Hana Fin., Inc. v. Hana Bank No. 13-1211	Trademark	Petition 4/8/14 Response 5/8/14 (87 PTCJ 1367, 4/11/14)	Conference 6/19/14
B&B Hardware, Inc. v. Hargis Indus., Inc. No. 13-352	Trademark	Petition 9/19/13 Response 11/20/13 Reply 12/5/13 Conference 1/10/14 CVSG 1/13/14 SG brief 5/23/14 (88 PTCJ 317, 5/30/14)	Conference 6/26/14
Petroliam Nasional Berhad v. GoDaddy.com, Inc. No. 13-1255	Trademark	Petition 4/17/14 Response waived 5/19/14 (88 PTCJ 109, 5/9/14)	Conference 6/19/14
<b>BRIEFING IN PROGRESS</b>			
Kirby v. Marvel Characters Inc. No. 13-1178	Copyright	Petition 3/28/14 Response waived 4/24/14 Response requested 5/14/14 (87 PTCJ 1297, 4/4/14)	Response due 7/14/14
Segal v. Rogue Pictures No. 13-1425	Copyright	Petition 5/28/14 (88 PTCJ 316, 5/30/14)	Response due 8/27/14
Advanced Biological Labs., SA v. SmartGene, Inc. No. 13-1299	Patent	Petition 4/28/14 Response waived 5/2/14 Response requested 6/2/14 (88 PTCJ 37, 5/2/14)	Response due 8/1/14
Jaffe v. Samsung Elecs. Co.	Patent	Petition 5/2/14	Response due 7/2/14

**Pending and resolved Supreme Court cert petitions as of June 19, 2014. – Continued**

<b>Case</b>	<b>Type</b>	<b>Action</b>	<b>Status</b>
No. 13-1324		(88 PTCJ 109, 5/9/14)	
Pronova BioPharma Norge AS v. Par Pharm. USA, Inc. No. 13-1251	Patent	Petition 4/17/13 Response 6/18/14 (87 PTCJ 1526, 4/25/14)	Pending
Elec. Arts Inc. v. Hart No. 13-376 Elec. Arts Inc. v. Keller No. 13-377 Nat'l Collegiate Athletic Assoc. v. Keller No. 13M54	Right of Publicity	Petition 9/24/13  Petition 9/24/13  Petition to intervene denied  Settlement proposed 5/30/14 (88 PTCJ 383, 6/6/14)	Responses due 12/31/14
Athena Cosmetics, Inc. v. Allergan, Inc. No. 13-1379	Unfair Competition	Petition 5/19/14 (88 PTCJ 248, 5/23/14)	Response due 7/18/14
<b>DENIALS / DISMISSALS</b>			
Bouchat v. Balt. Ravens Ltd. P'ship No. 13-1246	Copyright	Petition 4/15/14	Denied 5/19/14
Cariou v. Prince No. 13-261	Copyright	Petition 8/27/13	Denied 11/12/13
Dash v. Mayweather No. 13-867	Copyright	Petition 1/22/14	Denied 3/31/14
Fung v. Columbia Pictures Indus., Inc. No. 13-334	Copyright	Petition 9/16/13	Dismissed 11/12/13
Hobbs v. John No. 13-491	Copyright	Petition 10/18/13	Denied 1/13/14
Jaso v. Coca-Cola No. 13-1046	Copyright	Petition 3/3/14	Denied 5/5/14
Morris v. Atchity No. 13-1266	Copyright	Petition 4/18/14	Denied 6/2/14
Stan Lee Media, Inc. v. Conan Sales Co. No. 13-1141	Copyright	Petition 3/21/14	Denied 5/19/14
Mahmoodian v. Pirnia No. 13-1116	False Advertising	Petition 3/18/14	Denied 5/27/14
Accenture, LLP v. Wellogix, Inc. No. 13-1051	Trade Secrets	Petition 3/4/14	Denied 6/9/14
Akamai Techs., Inc. v. Limelight Networks, Inc. No. 12-960	Patent	Petition 2/4/13	Denied 6/9/14
Artesyn Techs., Inc. v. Synqor, Inc. No. 13-375	Patent	Petition 9/23/13	Denied 11/18/13
Arthrex, Inc. v. Smith & Nephew, Inc. No. 13-290	Patent	Petition 9/4/13	Denied 12/9/13
Baxter Int'l Inc. v. Fresenius USA, Inc. No. 13-1071	Patent	Petition 3/7/14	Denied 5/19/14
Caret v. Univ. of Utah No. 13-947	Patent	Petition 2/10/14	Denied 6/16/14 (88 PTCJ 531, 6/20/14)
Cephalon, Inc. v. Apotex, Inc. No. 13-441	Patent	Petition 10/9/13	Denied 12/16/13
Cheese Sys., Inc. v. Tetra Pak Cheese & Powder Sys., Inc. No. 13-804	Patent	Petition 1/8/14	Denied 3/24/14

**Pending and resolved Supreme Court cert petitions as of June 19, 2014. – Continued**

<b>Case</b>	<b>Type</b>	<b>Action</b>	<b>Status</b>
Cisco Sys., Inc. v. TecSec, Inc. No. 13-1165	Patent	Petition 3/25/14	Denied 6/2/14
Convolve Inc. v. Compaq Computer Corp. No. 13-547	Patent	Petition 10/31/13	Denied 12/9/13
CoreValve, Inc. v. Edwards Lifesciences AG No. 12-1325	Patent	Petition 5/6/13	Denied 10/7/13
DIRECTV v. K-Tech Telecomms., Inc. No. 13-618	Patent	Petition 11/20/13	Denied 1/27/14
Finjan, Inc. v. USPTO No. 12-1245	Patent	Petition 4/11/13	Denied 10/7/13
Fox Grp., Inc. v. Cree, Inc. No. 12-1378	Patent	Petition 5/21/13	Denied 10/15/13
Galderma Labs., LP v. Tolmar, Inc. No. 13-1350	Patent	Petition 5/7/14	Denied 6/9/14
Gordon v. Rea No. 13-844	Patent	Petition 1/15/14	Denied 2/24/14
Hyundai Motor Am., Inc. v. Clear with Computers, LLC No. 13-296	Patent	Petition 9/6/13	Denied 11/12/13
Intema Ltd. v. PerkinElmer, Inc. No. 12-1372	Patent	Petition 5/16/13	Denied 10/7/13
Maersk Drilling USA, Inc. v. Transocean Offshore Deepwater Drilling, Inc. No. 13-43	Patent	Petition 7/10/13	Dismissed 5/21/14
Metso Minerals Inc. v. Powerscreen Int'l Distribution Ltd. No. 13-565	Patent	Petition 11/7/13	Denied 1/13/14
Minemyer v. R-Boc Representatives, Inc. No. 13-708	Patent	Petition 12/13/13	Denied 5/5/14
Voda v. Medtronic, Inc. No. 13-992	Patent	Petition 2/18/14	Denied 5/5/14
Mirowski Family Ventures, LLC v. Medtronic Inc. No. 12-1116	Patent	Petition 3/14/13	Denied 1/27/14
Morsa v. USPTO No. 13-755	Patent	Petition 12/24/13	Denied 2/24/14
Nokia Inc. v. Int'l Trade Comm'n No. 12-1352	Patent	Petition 5/10/13	Denied 10/15/13
Novozymes A/S v. DuPont Nutrition Biosciences APS No. 13-865	Patent	Petition 1/22/14	Denied 3/3/14
Organic Seed Growers and Trade Ass'n v. Monsanto Co. No. 13-303	Patent	Petition 9/9/13	Denied 1/13/14
O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc. No. 13-848	Patent	Petition 1/16/14	Denied 3/24/14
Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc. No. 13-269	Patent	Petition 8/28/13	Denied 1/13/14
Public Patent Found. Inc. v. McNeil-PPC Inc. No. 13-161	Patent	Petition 8/5/13	Denied 10/7/13
Raylon, LLC v. Complus Data Innovations, Inc. No. 12-1354	Patent	Petition 5/10/13	Denied 10/7/13
Saffran v. Johnson & Johnson	Patent	Petition 10/1/13	Denied 1/27/14

**Pending and resolved Supreme Court cert petitions as of June 19, 2014. – Continued**

<b>Case</b>	<b>Type</b>	<b>Action</b>	<b>Status</b>
No. 13-405			
Sandoz Inc. v. Allergan, Inc. No. 13-889	Patent	Petition 1/27/14	Denied 3/31/14
SAP Am., Inc. v. Versata Software, Inc. No. 13-716	Patent	Petition 12/12/13	Denied 1/21/14
Sinclair-Allison, Inc. v. Fifth Ave. Physician Servs., LLC No. 13-709	Patent	Petition 12/13/13	Denied 2/24/14
Sony Computer Entm't Am. LLC v. 1st Media, LLC No. 12-1086	Patent	Petition 3/8/13	Denied 10/15/13
Soverain Software LLC v. Newegg Inc. No. 13-477	Patent	Petition 10/16/13	Denied 1/13/14
Tech. Patents LLC v. T-Mobile (UK) Ltd. No. 12-1292	Patent	Petition 4/26/13	Denied 10/7/13
Thomas v. Pippin No. 13-1151	Patent	Petition 3/21/14	Denied 4/21/14
USPPS, Ltd., v. Avery Dennison Corp. No. 13-1011	Patent	Petition 2/24/14	Denied 4/28/14
Stayart v. Google, Inc. No. 12-1417	Right of Publicity	Petition 6/3/13	Denied 10/7/13
Yeager v. Aviat Aircraft, Inc. No. 13-1326	Right of Publicity	Petition 5/2/14	Denied 6/16/14 (88 PTCJ 531, 6/20/14)
Abraham v. Alpha Chi Omega No. 12-1341	Trademark	Petition 5/8/13	Denied 10/7/13
City of Houston v. Rea No. 13-784	Trademark	Petition 12/31/13	Denied 2/24/14
Eastland Music Grp., LLC v. Lionsgate Entm't, Inc. No. 12-1501	Trademark	Petition 6/17/13	Denied 10/7/13
Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd. No. 13-685	Trademark	Petition 12/6/13	Denied 2/24/14
Stephen Slesinger, Inc. v. Disney Enters., Inc. No. 12-1404	Trademark	Petition 5/28/13	Denied 10/7/13
Von Drehle Corp. v. Georgia Pacific Consumer Prods., LP No. 13-41	Trademark	Petition 7/8/13	Denied 10/7/13



## Legislation Developments

### Pending and enacted intellectual property legislation in the 113th Congress as of June 19, 2014.

Bill Details	Summary / Status
<b>PATENTS</b>	
<p><b>Title or Subject:</b> Bill to Enhance Federal and State Enforcement of Fraudulent Patent Demand.  <b>Sponsor:</b> Terry.  <b>Introduced:</b> 5/16/14 (88 PTCJ 244, 5/23/14).</p>	<p><b>Summary:</b> Addresses bad-faith “demand letters,” attributed to so-called patent trolls.  <b>Last Action:</b> House subcommittee review 5/22/14 (88 PTCJ 307, 5/30/14).</p>
<p><b>Title or Subject:</b> Patent Fee Integrity Act (S. 2146).  <b>Sponsor:</b> Feinstein.  <b>Introduced:</b> 3/13/14 (87 PTCJ 1146, 3/21/14).</p>	<p><b>Summary:</b> Meant to remove PTO spending from the appropriations process.  <b>Last Action:</b> Bill introduced 3/13/14.</p>
<p><b>Title or Subject:</b> To curb unfair and deceptive practices during assertion of patents, and for other purposes. (S. 2049).  <b>Sponsor:</b> McCaskill, Rockefeller.  <b>Introduced:</b> 2/26/14 (87 PTCJ 1008, 3/7/14).</p>	<p><b>Summary:</b> Meant to curb unfair and deceptive patent assertion practices.  <b>Last Action:</b> Referred to Senate Committee on Commerce, Science, and Transportation 2/26/14.</p>
<p><b>Title or Subject:</b> Innovation Act (H.R. 3309).  <b>Sponsor:</b> Goodlatte.  <b>Introduced:</b> Discussion draft 5/24/13 (86 PTCJ 227, 5/31/13). Bill introduced 10/23/13 (86 PTCJ 1275, 10/25/13). Hearing held 10/29/13 (87 PTCJ 8, 11/1/13). Judiciary Committee approved 11/20/13 (87 PTCJ 161, 11/22/13).</p>	<p><b>Summary:</b> Covers wide range of patent issues, with emphasis on curbing abusive patent litigation.  <b>Last Action:</b> House approved 12/5/13 (87 PTCJ 259, 12/6/13).</p>
<p><b>Title or Subject:</b> Patent Transparency and Improvements Act (S. 1720).  <b>Sponsor:</b> Leahy, Lee, Klobuchar.  <b>Introduced:</b> 11/18/13 (87 PTCJ 164, 11/22/13).</p>	<p><b>Summary:</b> Parallels H.R. 3309 but with key provisions missing.  <b>Last Action:</b> Consideration cancelled 5/21/14 (88 PTCJ 304, 5/30/14).</p>
<p><b>Title or Subject:</b> Demand Letter Transparency Act (H.R. 3540).  <b>Sponsor:</b> Polis, Marino, Deutch.  <b>Introduced:</b> 11/19/13 (87 PTCJ 165, 11/22/13).</p>	<p><b>Summary:</b> Addresses patentees’ abusive behavior in sending licensing “demand letters” to small businesses and individuals.  <b>Last Action:</b> Referred to the House Energy and Commerce Committee. Related hearing held 11/14/13 (87 PTCJ 167, 11/22/13).</p>
<p><b>Title or Subject:</b> Patent Litigation Integrity Act (S. 1612).  <b>Sponsor:</b> Hatch.  <b>Introduced:</b> 10/30/13 (87 PTCJ 69, 11/8/13).</p>	<p><b>Summary:</b> Would require courts to shift fees to a prevailing party and would allow courts to require bonds to cover fees and expenses.  <b>Last Action:</b> Referred to the Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Innovation Protection Act (H.R. 3349).  <b>Sponsor:</b> Conyers.  <b>Introduced:</b> 10/28/13 (87 PTCJ 10, 11/1/13).</p>	<p><b>Summary:</b> Would fully fund the PTO, allowing it to retain all the fees it collects.  <b>Last Action:</b> Referred to the House Judiciary Committee.</p>
<p><b>Title or Subject:</b> Protect Advanced Communications for Emergency Services Act (S. 1478).  <b>Sponsor:</b> Cardin.  <b>Introduced:</b> 8/1/13 (86 PTCJ 748, 8/9/13).</p>	<p><b>Summary:</b> Would limit compensation for patent and copyright infringement by providers of enhanced 9-1-1 services to mobile devices.  <b>Last Action:</b> Referred to Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Patent Litigation and Innovation Act (H.R. 2639).  <b>Sponsor:</b> Jeffries, Farenthold.  <b>Introduced:</b> 7/10/13 (86 PTCJ 517, 7/12/13).</p>	<p><b>Summary:</b> Would revise patent infringement pleading, discovery, end-user defendant stays, and sanctions.  <b>Last Action:</b> Most provisions now incorporated into H.R. 3309.</p>

**Pending and enacted intellectual property legislation in the 113th Congress as of June 19, 2014. – Continued**

<b>Bill Details</b>	<b>Summary / Status</b>
<p><b>Title or Subject:</b> Patents and Trademarks Encourage New Technology Jobs Act (H.R. 2582).  <b>Sponsor:</b> Honda, Lofgren, Eshoo.  <b>Introduced:</b> 6/28/13 (86 PTCJ 515, 7/12/13).</p>	<p><b>Summary:</b> Would exempt the Patent and Trademark office from sequestration.  <b>Last Action:</b> Referred to House Budget Committee.</p>
<p><b>Title or Subject:</b> Manufacturing Innovation in America Act (H.R. 2605).  <b>Sponsor:</b> Schwartz.  <b>Introduced:</b> 6/28/13 (86 PTCJ 517, 7/12/13).</p>	<p><b>Summary:</b> Would set up a preferential corporate tax rate for patent-related profits.  <b>Last Action:</b> Referred to House Committee on Ways and Means.</p>
<p><b>Title or Subject:</b> Promoting Startup Innovation Act (H.R. 2236).  <b>Sponsor:</b> Chabot.  <b>Introduced:</b> 6/4/13 (86 PTCJ 286, 6/7/13).</p>	<p><b>Summary:</b> Would increase “micro entity” eligibility for 75 percent discount on most patent application fees.  <b>Last Action:</b> Referred to House Judiciary IP Subcommittee.</p>
<p><b>Title or Subject:</b> Patent Abuse Reduction Act (S. 1013).  <b>Sponsor:</b> Cornyn.  <b>Introduced:</b> 5/22/13 (86 PTCJ 229, 5/31/13).</p>	<p><b>Summary:</b> Would revise patent infringement pleading, discovery, and cost-shifting.  <b>Last Action:</b> Most provisions now incorporated into H.R. 3309.</p>
<p><b>Title or Subject:</b> End of Anonymous Patents Act (H.R. 2024).  <b>Sponsor:</b> Deutch.  <b>Introduced:</b> 5/16/13 (86 PTCJ 177, 5/24/13).</p>	<p><b>Summary:</b> Would require notice to PTO of real party in interest on issue and on every ownership transfer.  <b>Last Action:</b> H.R. 3309 took a different approach to the same issue, so this bill is unlikely to move forward.</p>
<p><b>Title or Subject:</b> Patent Quality Improvement Act (S. 866); Stopping the Offensive Use of Patents Act (H.R. 2766)  <b>Sponsor:</b> Schumer; Issa, Chu.  <b>Introduced:</b> S. 866 introduced 5/6/13 (86 PTCJ 71, 5/10/13); H.R. 2766 introduced 7/22/13 (86 PTCJ 632, 7/26/13).</p>	<p><b>Summary:</b> Would extend AIA’s covered business method challenge option to any management patent and eliminate the sunset provision.  <b>Last Action:</b> Provision removed from H.R. 3309 before committee vote, so H.R. 2766 is unlikely to move forward. Schumer’s prospects in Senate still open.</p>
<p><b>Title or Subject:</b> Promoting Automotive Repair, Trade, and Sales Act (H.R. 1663, S. 780).  <b>Sponsor:</b> Issa, Lofgren; Whitehouse, Hatch.  <b>Introduced:</b> 4/23/13 (85 PTCJ 992, 4/26/13).</p>	<p><b>Summary:</b> Would exempt automotive replacement parts manufacturers from design patent infringement liability 30 months after the first sale.  <b>Last Action:</b> Referred to House Judiciary IP Subcommittee and Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Patents for Humanity Program Improvement Act (S. 712).  <b>Sponsor:</b> Leahy.  <b>Introduced:</b> 4/11/13 (85 PTCJ 926, 4/19/13).</p>	<p><b>Summary:</b> Would allow recipients of the PTO’s Patents for Humanity awards to transfer or sell their acceleration certificates.  <b>Last Action:</b> Referred to Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Fair and Immediate Release of Generic Drugs Act (S. 504).  <b>Sponsor:</b> Franken.  <b>Introduced:</b> 3/7/13 (85 PTCJ 655, 3/15/13).</p>	<p><b>Summary:</b> Would allow generics firms to share Hatch-Waxman exclusivity.  <b>Last Action:</b> Considered in Senate Judiciary Committee antitrust subcommittee hearing 7/23/13 (see S. 214 below).</p>
<p><b>Title or Subject:</b> Saving High-Tech Innovators from Egregious Legal Disputes Act (H.R. 845).  <b>Sponsor:</b> DeFazio, Chaffetz.  <b>Introduced:</b> 2/27/13 (85 PTCJ 572, 3/1/13).</p>	<p><b>Summary:</b> Would force courts to award costs, including attorneys’ fees, to an alleged infringer that wins against a patent troll.  <b>Last Action:</b> Sponsors now co-sponsor H.R. 3309, so this bill is essentially abandoned.</p>

**Pending and enacted intellectual property legislation in the 113th Congress as of June 19, 2014. – Continued**

<b>Bill Details</b>	<b>Summary / Status</b>
<p><b>Title or Subject:</b> Preserve Access to Affordable Generics Act (S. 214).  <b>Sponsor:</b> Klobuchar.  <b>Introduced:</b> 2/4/13 (85 PTCJ 475, 2/8/13).</p>	<p><b>Summary:</b> Would make drug company pay-for-delay settlements presumptively illegal.  <b>Last Action:</b> Senate Judiciary antitrust subcommittee hearing held 7/23/13 (86 PTCJ 633, 7/26/13).</p>
<p><b>Title or Subject:</b> Seed Availability and Competition Act (H.R. 193).  <b>Sponsor:</b> Kaptur.  <b>Introduced:</b> 1/4/13 (85 PTCJ 379, 1/18/13).</p>	<p><b>Summary:</b> Would require persons who seek to retain seeds harvested from the planting of patented seeds to register with the Secretary of Agriculture and pay fees set by the Secretary for retaining such seeds.  <b>Last Action:</b> Referred to House Agriculture Subcommittee on Horticulture, Research, Biotechnology, and Foreign Agriculture.</p>
<b>COPYRIGHTS</b>	
<p><b>Title or Subject:</b> Satellite Television Extension and Localism Act (STELA) (S. 2454).  <b>Sponsor:</b> Leahy.  <b>Introduced:</b> 6/11/14 (88 PTCJ 443, 6/13/14).</p>	<p><b>Summary:</b> Would renew the nation's pay-TV laws for another five years and preserve current broadcast carriage rules.  <b>Last Action:</b> Referred to the Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Respecting Senior Performers as Essential Cultural Treasures ("Respect") Act (H.R. 4772).  <b>Sponsor:</b> Conyers.  <b>Introduced:</b> 5/29/14 (88 PTCJ 370, 6/6/14).</p>	<p><b>Summary:</b> Online services that make use of music recorded before 1972 would be subject to payment of royalties under a statutory licensing scheme.  <b>Last Action:</b> Referred to the House Committee on the Judiciary.</p>
<p><b>Title or Subject:</b> To amend title 17, United States Code, to secure the rights of visual artists to copyright, to provide for resale royalties, and for other purposes (H.R. 4103 and S. 2045).  <b>Sponsor:</b> Nadler; Baldwin, Markey.  <b>Introduced:</b> 2/26/14 (87 PTCJ 931, 2/28/14).</p>	<p><b>Summary:</b> Would amend title 17 of the U.S. Code relating to resale royalties and copyrights for visual artists.  <b>Last Action:</b> Referred to House Committee on the Judiciary and Senate Committee on the Judiciary.</p>
<p><b>Title or Subject:</b> Protect Advanced Communications for Emergency Services Act (H.R. 3736).  <b>Sponsor:</b> DeGette.  <b>Introduced:</b> 12/12/13 (87 PTCJ 382, 12/20/13).</p>	<p><b>Summary:</b> Would bring certain patent and copyright claims under the jurisdiction of the Federal Claims court.  <b>Last Action:</b> Referred to House Committee on the Judiciary.</p>
<p><b>Title or Subject:</b> Consumers Have Options in Choosing Entertainment Act (H.R. 3719).  <b>Sponsor:</b> Eshoo, Lofgren.  <b>Introduced:</b> 12/12/13 (87 PTCJ 383, 12/20/13).</p>	<p><b>Summary:</b> Would provide the Federal Communications Commission with greater control over retransmission consent disputes.  <b>Last Action:</b> Referred to House Committee on Energy and Commerce.</p>
<p><b>Title or Subject:</b> Next Generation Television Marketplace Act (H.R. 3720).  <b>Sponsor:</b> Scalise, Gardner.  <b>Introduced:</b> 12/12/13 (87 PTCJ 383, 12/20/13).</p>	<p><b>Summary:</b> Would repeal retransmission consent and compulsory license provisions.  <b>Last Action:</b> Referred to House Committee on the Judiciary.</p>
<p><b>Title or Subject:</b> Free Market Royalty Act (H.R. 3219).  <b>Sponsor:</b> Watt.  <b>Introduced:</b> 9/30/13 (86 PTCJ 1120, 10/4/13).</p>	<p><b>Summary:</b> Seeks to create a performance right for holders of rights in sound recordings.  <b>Last Action:</b> Referred to House Committee on the Judiciary.</p>
<p><b>Title or Subject:</b> Songwriters Tax Simplification Reauthorization Act. (H.R. 2731).  <b>Sponsor:</b> Blackburn.  <b>Introduced:</b> 7/18/13 (86 PTCJ 627, 7/26/13)</p>	<p><b>Summary:</b> Would make permanent a tax provision allowing five-year amortization of expenses related to creating or acquiring music or music copyrights.  <b>Last Action:</b> Referred to House Committee on Ways and Means.</p>

**Pending and enacted intellectual property legislation in the 113th Congress as of June 19, 2014. – Continued**

<b>Bill Details</b>	<b>Summary / Status</b>
<p><b>Title or Subject:</b> Innovation Through Trade Act (S. 660).  <b>Sponsor:</b> Hatch.  <b>Introduced:</b> 3/22/13 (85 PTCJ 771, 3/29/13).</p>	<p><b>Summary:</b> Would establish the position of Chief Innovation and Intellectual Property Negotiator in the Office of the United States Trade Representative.  <b>Last Action:</b> Referred to Senate Finance Committee.</p>
<p><b>Title or Subject:</b> Wireless Device Independence Act (S. 467); Wireless Consumer Choice Act (S. 481); Unlocking Consumer Choice and Wireless Competition Act (S. 517 and H.R. 1123); Unlocking Technology Act (H.R. 1892).  <b>Sponsor:</b> Wyden; Klobuchar; Leahy; Goodlatte; Lofgren.  <b>Introduced:</b> Respectively, 3/5/13 (85 PTCJ 598, 3/8/13), 3/8/13 (85 PTCJ 670, 3/15/13), 3/11/13 (85 PTCJ 654, 3/15/13; 85 PTCJ 709, 3/22/13); 5/8/13 (86 PTCJ 65, 5/10/13).</p>	<p><b>Summary:</b> Four different approaches (the Leahy and Goodlatte bills are identical) to overriding the Copyright Office's elimination of "unlocking" mobile phones as a DMCA exemption.  <b>Last Action:</b> House approved H.R. 1123 2/25/14 (87 PTCJ 930, 2/28/14).</p>
<p><b>Title or Subject:</b> Fair Access to Science and Technology Research Act (H.R. 708 and S. 350).  <b>Sponsor:</b> Doyle; Cornyn.  <b>Introduced:</b> 2/14/13 (85 PTCJ 542, 2/22/13).</p>	<p><b>Summary:</b> Would force free access to copyrighted articles based on government-funded research.  <b>Last Action:</b> Referred to House Committee on Oversight and Government Reform and Senate Committee on Homeland Security and Governmental Affairs.</p>
<b>TRADEMARKS, COUNTERFEITING, AND ENFORCEMENT</b>	
<p><b>Title or Subject:</b> Trade Protection Not Troll Protection Act (H.R. 4763).  <b>Sponsor:</b> Cardenas, Farenthold.  <b>Introduced:</b> 5/29/14 (88 PTCJ 369, 6/6/14).</p>	<p><b>Summary:</b> Would bar ITC import bans to patent owners whose licensing has not led to product development in the United States.  <b>Last Action:</b> Referred to the House Committee on Ways and Means.</p>
<p><b>Title or Subject:</b> Defend Trade Secrets Act of 2014 (S. 2267).  <b>Sponsor:</b> Coons; Hatch.  <b>Introduced:</b> 4/29/14 (88 PTCJ 41, 5/2/14).</p>	<p><b>Summary:</b> Would create a federal cause of action for misappropriation of trade secrets.  <b>Last Action:</b> Referred to Senate Committee on the Judiciary.</p>
<p><b>Title or Subject:</b> Registration of Marks Consisting of a Flag, Coat of Arms, or Other Insignia of the United States, or Any State or Local Government (H.R. 3713 and S. 1816).  <b>Sponsor:</b> Poe; Schumer, Lee.  <b>Introduced:</b> 12/12/13 (87 PTCJ 382, 12/20/13)</p>	<p><b>Summary:</b> Would allow local governments to register their seals and insignia as federal trademarks.  <b>Last Action:</b> Referred to House Judiciary Intellectual Property Subcommittee and Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Future of American Innovation and Research Act (S. 1770).  <b>Sponsor:</b> Flake.  <b>Introduced:</b> 11/22/13 (87 PTCJ 215, 11/29/13).</p>	<p><b>Summary:</b> Would allow a U.S. party whose trade secrets are stolen to bring a private right of action against the responsible party if that party is foreign or is acting on behalf of a foreign entity.  <b>Last Action:</b> Referred to Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Playing Fair on Trade and Innovation Act (H.R. 3167).  <b>Sponsor:</b> Terry.  <b>Introduced:</b> 9/20/13 (86 PTCJ 1070, 9/27/13).</p>	<p><b>Summary:</b> Would deny preferential trade status to countries that fail to adequately protect U.S. intellectual property rights.  <b>Last Action:</b> Referred to House Committee on Ways and Means.</p>

**Pending and enacted intellectual property legislation in the 113th Congress as of June 19, 2014. – Continued**

<b>Bill Details</b>	<b>Summary / Status</b>
<p><b>Title or Subject:</b> Private Right of Action Against Theft of Trade Secrets Act of 2013 (H.R. 2466).  <b>Sponsor:</b> Lofgren.  <b>Introduced:</b> 6/20/13 (86 PTCJ 470, 6/28/13).</p>	<p><b>Summary:</b> Would create a federal private civil action for misappropriation of trade secrets.  <b>Last Action:</b> Referred to House Judiciary Subcommittee on Crime, Terrorism, Homeland Security, and Investigations.</p>
<p><b>Title or Subject:</b> Cyber Economic Espionage Accountability Act (H.R. 2281 and S. 1111).  <b>Sponsor:</b> Rogers, Ryan; Johnson.  <b>Introduced:</b> 6/6/13 (86 PTCJ 330, 6/14/13).</p>	<p><b>Summary:</b> Would require federal agencies to develop and publish a list of cyber spies, and enforce visa restrictions and other penalties against them.  <b>Last Action:</b> Referred to House Judiciary Subcommittee on Immigration and Border Security and Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Deter Cyber Theft Act (S. 884).  <b>Sponsor:</b> Levin, McCain, Rockefeller, Coburn.  <b>Introduced:</b> 5/7/13 (86 PTCJ 80, 5/10/13).</p>	<p><b>Summary:</b> Would create a watch list of countries that gain access to U.S. trade secrets through cyber theft.  <b>Last Action:</b> Referred to Senate Finance Committee.</p>
<p><b>Title or Subject:</b> Trade Facilitation and Trade Reinforcement Act (S. 662).  <b>Sponsor:</b> Baucus.  <b>Introduced:</b> 3/22/13 (85 PTCJ 890, 4/12/13).</p>	<p><b>Summary:</b> Would establish a national Intellectual Property Rights Coordination Center that would be housed within the Department of Homeland Security.  <b>Last Action:</b> Referred to the Senate Finance Committee.</p>
<p><b>Title or Subject:</b> Non-Disparagement of Native American Persons or People in Trademark Registration Act (H.R. 1278).  <b>Sponsor:</b> Faleomavaega.  <b>Introduced:</b> 3/20/13 (85 PTCJ 765, 3/29/13).</p>	<p><b>Summary:</b> Would amend the Lanham Act to make explicit that use of the term “redskin” as a trademark is disparaging and not eligible for federal protection.  <b>Last Action:</b> Referred to House Judiciary IP Subcommittee.</p>
<p><b>Title or Subject:</b> No Stolen Trademarks Honored in America Act (H.R. 778 and S. 647).  <b>Sponsor:</b> Issa; Nelson.  <b>Introduced:</b> 2/15/13; 3/21/13 (85 PTCJ 826, 4/5/13).</p>	<p><b>Summary:</b> Would amend a statute that denies protection to the trademarks of businesses seized by the Cuban government.  <b>Last Action:</b> Referred to House Judiciary IP subcommittee and Senate Judiciary Committee.</p>
<p><b>Title or Subject:</b> Foreign Counterfeit Merchandise Prevention Act (H.R. 22).  <b>Sponsor:</b> Poe.  <b>Introduced:</b> 1/3/13 (85 PTCJ 380, 1/18/13).</p>	<p><b>Summary:</b> Would allow customs officials to share information with copyright and trademark holders.  <b>Last Action:</b> Referred to House Judiciary Subcommittee on Crime, Terrorism, Homeland Security, and Investigations.</p>

## Agency Developments

Proposed rule changes, final rules, and other noteworthy developments in fiscal year 2014 in the Patent and Trademark Office, Copyright Office, Federal Trade Commission, International Trade Commission, and U.S. Trade Representative as of June 19, 2014.

<b>Patent and Trademark Office</b>			
<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Notice of Interim Patent Term Extension</b>	Order grants an interim extension of one year under 35 U.S.C. § 156(d)(5) to Cerus Corp. for a patent (5,593,823) relating to a medical device that is undergoing regulatory review at the Food and Drug Administration regarding permission to release the device commercially. Interim extension is granted on the basis that the regulatory review period will continue beyond the original expiration date of the patent, Jan. 14, 2014.	Interim patent term extended 1/16/14: 79 Fed. Reg. 2,821 (87 PTCJ 639, 1/24/14).	Extension for one year from original expiration date.
<b>Extension of the Extended Missing Parts Pilot Program</b>	PTO extends a program allowing patent applicants to extend the “provisional” period of their applications in limited circumstances.	Program extended 1/6/14: 79 Fed. Reg. 642 (87 PTCJ 495, 1/10/14).	First devised in 2010, is now extended until 12/31/14.
<b>Changes to Patent Term Adjustment in View of the Federal Circuit Decision in Novartis v. Lee</b>	PTO is proposing changes to the rules of practice pertaining to the patent term adjustment provisions in view of the decision by the Federal Circuit in Novartis AG v. Lee	Rulemaking proposed 6/18/14: 79 Fed. Reg. 34,681 (88 PTCJ 532, 6/20/14)	Comments due 8/18/14.
<b>Request for Comments on Virtual Marking</b>	PTO is seeking public comment on virtual marking, which was provided for by the AIA as an alternative to physically marking patented articles as a means to provide notice to the public that such articles are subject to patent protection.	Comments requested 6/16/14: 79 Fed. Reg. 34,291 (88 PTCJ 532, 6/20/14)	Comments due 7/16/14.
<b>Glossary Pilot Program</b>	PTO expedites computer and business method patent applications submitted with a glossary defining terms used in the patent claims.	Notice posted 3/26/14: 79 Fed. Reg. 17,137 (87 PTCJ 1221, 3/28/14).	Effective 6/2/14.
<b>Notice of Public Meetings on Copyright Policy Topics (as Called for in the Department of Commerce Green Paper, Copyright Policy, Creativity, and Innovation in the Digital Economy)</b>	PTO will convene roundtables on certain copyright topics, namely: the legal framework for the creation of remixes, the relevance and scope of the first sale doctrine in the digital environment, and the appropriate calibration of statutory damages in the contexts of individual file sharers and of secondary liability for large-scale infringement	Meetings announced 4/16/14: 79 Fed. Reg. 21,439 (87 PTCJ 1441, 4/18/14).	Meetings to be held 5/21/14.

**Patent and Trademark Office – Continued**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Changes in Requirements for Collective Trademarks and Service Marks, Collective Membership Marks, and Certification Marks</b>	Proposal to amend the rules related to collective trademarks, collective service marks and collective membership marks (together “collective marks”), and certification marks to clarify application requirements, allegations of use requirements, multiple-class application requirements, and registration maintenance requirements for such marks	Amendment proposed 2/20/14: 79 Fed. Reg. 9,678 (87 PTCJ 889, 2/21/14).	Comments due 5/21/14.
<b>Notice of Forum on the Guidance For Determining Subject Matter Eligibility of Claims Reciting or Involving Laws of Nature, Natural Phenomena, and Natural Products</b>	PTO is hosting a forum to receive public feedback from organizations and individuals on its guidance memorandum concerning the eligibility of patent claims involving laws of nature, natural phenomena, and natural products.	Forum announced 4/17/14: 79 Fed. Reg. 21,736 (87 PTCJ 1455, 4/18/14). Forum held 5/9/14 (88 PTCJ 179, 5/16/14).	Forum was held 5/9/14.
<b>Changes to Continued Prosecution Application Practice</b>	PTO promulgates an interim rule revising the rules pertaining to continued prosecution applications.	Interim rule promulgated 3/5/14: 79 Fed. Reg. 12,384 (87 PTCJ 1021, 3/7/14).	Comment period ended 5/5/14.
<b>Changes to Permit Delayed Submission of Certain Requirements for Prioritized Examination</b>	PTO expands the time periods for meeting requirements when filing a request for Track I prioritized patent application examination.	Rule promulgated 3/5/14: 79 Fed. Reg. 12,386 (87 PTCJ 1021, 3/7/14).	Comment period ended 5/5/14.
<b>Harmonization</b>	Request for patent community input, via Tegernsee Experts Group Survey, on international harmonization efforts resulting from the work of the so-called “Tegernsee Group.”	Consolidated report published 5/1/14.	Consolidated report published on May 1, 2014. PTO published report on results on Sept. 4 (86 PTCJ 937, 9/13/13).
<b>Request for Comments and Notice of Roundtable Event on the Use of Crowdsourcing and Third-Party Preissuance Submissions to Identify Relevant Prior Art</b>	PTO is hosting a roundtable event to solicit public opinions regarding the use of crowdsourcing and third-party preissuance submissions to identify relevant prior art and enhance the quality of examination as well as the quality of issued patents.	Notice posted 3/19/14: 79 Fed. Reg. 15,319 (87 PTCJ 1232, 3/28/14). Roundtable 4/10/14 (87 PTCJ 1432, 4/18/14).	Comment period ended 4/25/14.
<b>Notice of Public Hearings and Extension of Comment Period on the Proposed Changes To Require Identification of Attributable Owner</b>	Proposal to change the rules of practice to require that the attributable owner, including the ultimate parent entity, be identified during the pendency of a patent application and at specified times during the life of a patent.	Notice posted 2/20/14: 79 Fed. Reg. 9,677 (87 PTCJ 889, 2/21/14), Deadline extended 3/12/14: 79 Fed. Reg. 13,962 (87 PTCJ 1182, 3/21/14).	Oral testimony due 3/12/14, first hearing 3/13/14, second hearing 3/26/14, comment period ended 4/24/14.
<b>Notice of Proposed Rulemaking</b>	Proposed miscellaneous changes to trademark rules of practice and the rules of practice in filings pursuant to the protocol relating to the Madrid Agreement Concerning the International Registration of Marks. For the most part, the rules that the PTO is considering making would simply codify existing practice.	Changes proposed 1/23/14: 79 Fed. Reg. 3,750 (87 PTCJ 640, 1/24/14).	Comment period ended 4/23/14.

**Patent and Trademark Office – Continued**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Creation and Meeting of “Additive Manufacturing Partnership”</b>	PTO announced on March 5 that it had scheduled the first “Additive Manufacturing Partnership Meeting,” to be held April 9 at the office’s headquarters in Alexandria, Va.	Partnership announced 3/5/14: (87 PTCJ 1014, 3/7/14).	Meeting was held 4/9/14.
<b>National Medal of Technology and Innovation Call for 2014 Nominations</b>	PTO is accepting nominations for the National Medal of Technology and Innovation.	Notice and request for nominations 12/27/13: 78 Fed. Reg. 78,838 (87 PTCJ 497, 1/10/14).	Nominations period ended 4/1/14.
<b>Notice of Proposed Rulemaking</b>	Would require recording beneficial owners of applications and patents at specific times.	Rulemaking proposed 1/24/14: 79 Fed. Reg. 4,105 (87 PTCJ 686, 1/31/14).	Comment period ended 3/25/14.
<b>Notice of Public Meeting</b>	PTO is holding the first public meeting on the establishment of a multi-stakeholder forum on improving the operation of the notice and takedown system under the DMCA.	Notice posted 3/11/14: 79 Fed. Reg. 13,644 (87 PTCJ 1182, 3/21/14).	Meeting was held 3/20/14.
<b>Request for Comments and Notice of Roundtable Event on the Written Description Requirement for Design Applications</b>	The PTO is hosting a roundtable event to solicit public opinions regarding the written description requirement as applied to design applications in certain limited situations.	Notice and request for comments 2/6/14: 79 Fed. Reg. 7,171 (87 PTCJ 756, 2/07/14).	Roundtable 3/5/14, comment period ended 3/14/14.
<b>Request for Comments Regarding Prior Art Resources for Use in the Examination of Software-Related Patent Applications</b>	Requesting ideas on prior art search resources and techniques as related to software patent applications.	Request for comments 1/6/14: 79 Fed. Reg. 644 (87 PTCJ 496, 1/10/14).	Comment period ended 3/14/14.
<b>Guidance for Patent Examiners</b>	PTO issued new guidelines to examiners on March 4 on assessing patent eligibility under 35 U.S.C. § 101 in light of the Supreme Court’s recent <i>Myriad</i> ruling and related cases.	Guidance issued 3/4/14: (87 PTCJ 1034, 3/7/14)	Memo is available here .
<b>Methods for Studying the Diversity of Patent Applicants.</b>	Request for comments on AIA-mandated task for the PTO to gather information about the diversity of patent applicants.	Comments requested 12/2/13: 78 Fed. Reg. 72,064 (87 PTCJ 268, 12/6/13)	Comment period ended 1/31/14.
<b>Implementing the Hague Agreement Concerning International Registration of Industrial Designs.</b>	Notice of proposed rulemaking on amendments to 37 C.F.R. Parts 1, 3 and 11 pursuant to Title I of the Patent Law Treaties Implementation Act.	Proposed 11/29/13: 78 Fed. Reg. 71,870 (87 PTCJ 269, 12/6/13) Public forum scheduled 12/24/13: (87 PTCJ 437, 1/3/14) Comment period extended 1/17/14: 79 Fed. Reg. 3146 (87 PTCJ 639, 1/24/14).	Comment period ended 1/28/14; public hearing scheduled 1/14/14.



**Patent and Trademark Office – Continued**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Copyright Policy, Creativity, and Innovation in the Digital Economy</b>	Request for comments on Commerce Department/PTO “green paper” on intersection between copyright policy and the nation’s economy and culture.	Comments requested 10/3/13: 78 Fed. Reg. 61,337 (86 PTCJ 1189, 10/11/13). Pre- and post-meeting comment deadlines set 11/5/13: 78 Fed. Reg. 66,337 (87 PTCJ 73, 11/8/13). Pre-hearing comments filed (87 PTCJ 155, 11/22/13). Public hearing held 12/12/13 (87 PTCJ 375, 12/20/13). Post-hearing comment deadline extended 12/26/13: (87 PTCJ 437, 1/3/14).	Post-hearing comment period ended 1/17/14.
<b>Privacy Act of 1974; System of Records</b>	Proposes creation of a background investigations recording system.	Comments requested 11/22/13: 78 Fed. Reg. 70,020 (87 PTCJ 223, 11/29/13)	Comment period ended 12/23/13.
<b>Treaty Implementation</b>	Changes to Implement the Patent Law Treaty.	Comments requested 4/11/13: 77 Fed. Reg. 21,788 (85 PTCJ 892, 4/12/13).	Final rule 10/21/13: 78 Fed. Reg. 62,368 (86 PTCJ 1285, 10/25/13). Correction 12/11/13: 78 Fed. Reg. 75,251 (87 PTCJ 339, 12/13/13). New patent fee schedule published 12/18/13: (87 PTCJ 437, 1/3/14).
<b>Elimination of Patents Search Templates</b>	Would remove purportedly obsolete patents search templates from PTO’s website.	Comments requested 10/30/13: 78 Fed. Reg. 64,925 (87 PTCJ 18, 11/1/13).	Comment period ended 11/29/13.
<b>PTO Strategic Plan 2014-18</b>	Request for stakeholder input on five year strategic plan for patent and trademark operations.	Comments on draft requested 10/17/13 (86 PTCJ 1284, 10/25/13).	Public hearing 11/5/13. Comment period ended 11/25/13.
<b>Confirmatory Genetic Tests</b>	AIA-mandated report on whether Congress should act to ease patient access to a second opinion as to a genetic diagnostic test when the test is covered by a patent.	Comments requested 1/25/12: 77 Fed. Reg. 3,748 (83 PTCJ 409, 1/27/12). Three roundtables held (83 PTCJ 567, 2/24/12; 85 PTCJ 383, 1/18/13).	No consensus; report was due 6/16/12.
<b>Real Party in Interest</b>	Proposal that the PTO should be able to collect more information on the real party in interest to patent rights.	Comments requested 11/26/12: 88 Fed. Reg. 70,386 (85 PTCJ 139, 11/30/12). Roundtable discussion was held 1/11/13 (85 PTCJ 419, 1/25/13). Obama’s 6/4/13 “fact sheet” calls for rule making (86 PTCJ 274, 6/7/13).	Comment period ended 1/25/13. Final rulemaking expected.

**Patent and Trademark Office – Continued**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Requests for Continued Examination</b>	Investigation into the “root causes” for why patent applicants file requests for continued examination and on what the agency can do to curtail the need.	Comments requested 12/6/12: 77 Fed. Reg. 72,830 (85 PTCJ 231, 12/14/12). Five roundtables scheduled (85 PTCJ 508, 2/15/13).	Comment period ended 3/11/13. Report expected.
<b>Patent Application Preparation</b>	Changes in patent application drafting of claims and the specification “to facilitate examination and bring more certainty to the scope of issued patents.”	Comments requested 1/15/13: 78 Fed. Reg. 2,960 (85 PTCJ 388, 1/18/13). Extended 3/15/13: 78 Fed. Reg. 16,474 (85 PTCJ 728, 3/22/13). Obama’s 6/4/13 “fact sheet” calls for rule making (86 PTCJ 274, 6/7/13) .	Comment period ended 4/15/13. Report expected.
<b>Software Partnership</b>	Cooperative efforts between the agency and the members of the patent community “to enhance the quality of software-related patents.”	Announced 1/3/13: 78 Fed. Reg. 292 (85 PTCJ 363, 1/11/13). Comment period extended 3/15/13: 78 Fed. Reg. 16,474 (85 PTCJ 728, 3/22/13).	Comment period ended 4/15/13. Next meeting 12/5/13.
<b>Patent Small Claims Court</b>	Whether PTO should create a small claims proceeding for patent enforcement.	Comments requested 12/18/13: 77 Fed. Reg. 74,830.(85 PTCJ 275, 12/21/12). Extended: 78 Fed. Reg. 14,515 (85 PTCJ 676, 3/15/13).	Comment period ended 4/30/13. Report expected.
<b>Patent Term Adjustment</b>	Rules implementing AIA “Technical Corrections” for PCT applications.	Interim final rule 4/1/13: 78 Fed. Reg. 19,416 (85 PTCJ 816, 4/5/13). Final rule: 5/15/14: 79 Fed. Reg. 27,755 (88 PTCJ 189, 5/16/14).	Effective 5/15/14.
<b>After Final Consideration Pilot</b>	Authorizes extra time for examiners to consider responses filed after a final rejection.	Introduced 2012; AFCP 2.0 began 5/19/13: 78 Fed. Reg. 29,117 (86 PTCJ 182, 5/24/13). Extended 11/26/13 (87 PTCJ 268, 12/6/13).	Extended to 9/30/13.
<b>Provisional Applications</b>	A program that effectively allows patent applicants to maintain for one additional year applications deemed “provisional.”	First implemented 12/8/10: 75 Fed. Reg. 76,401 (81 PTCJ 227, 12/17/10). Extended 12/16/11: 75 Fed. Reg. 78,246 (83 PTCJ 270, 12/23/11). Extended again 1/10/13: 78 Fed. Reg. 2,256 (85 PTCJ 390, 1/18/13).	Program now set to expire 12/31/13.
<b>Trademark Fees</b>	Fee adjustment for trademark applications.	Comments requested 8/16/12: 77 Fed. Reg. 49,426 (84 PTCJ 717, 8/24/12). Extended 9/19/12: 77 Fed. Reg. 58,097 (84 PTCJ 927, 9/28/12).	Comment period ended 10/22/12. Final rulemaking expected.
<b>Trademark Declaration Deadline</b>	Amending the first filing deadline for affidavits or declarations of use or excusable nonuse.	Comments requested 8/16/12: 77 Fed. Reg. 49,425 (84 PTCJ 717, 8/24/12). Extended 9/19/12: 77 Fed. Reg. 58,097	Comment period ended 11/5/12. Final rulemaking expected.

### Copyright Office and Copyright Royalty Board

TOPIC	DESCRIPTION	ACTIONS	NOTES
<b>Notice and Recordkeeping for Use of Sound Recordings Under Statutory License</b>	The Board is extending the period for filing comments on Notice and Recordkeeping for Use of Sound Recordings Under Statutory License.	Comment period extended 6/11/14: 79 Fed. Reg. 33,491 (88 PTCJ 456, 6/13/14).	Comment period extended until 6/30/14.
<b>Music Licensing Study</b>	The office announces the initiation of a study to evaluate the effectiveness of existing methods of licensing music	Comments requested 3/17/14: 78 Fed. Reg. 14,739 (87 PTCJ 1182, 3/21/14); Public roundtables scheduled 5/5/14: 79 Fed. Reg. 25,626 (88 PTCJ 114, 5/9/14).	Roundtables to be held 6/4, 6/5, 6/16, 6/17, 6/23, and 6/24/14.
<b>Copyright Office Fees: Registration, Recordation and Related Services; Special Services; Licensing Division Services; FOIA Services</b>	The office is publishing a final rule establishing adjusted fees for its services.	Rule published 3/24/14: 79 Fed. Reg. 15,910 (87 PTCJ 1232, 3/28/14); Corrected 4/30/14: 79 Fed. Reg. 24,334 (88 PTCJ 44, 5/2/14)	Rule published 3/24/14
<b>Study on the Right of Making Available</b>	The office is undertaking a study at the request of Congress to assess the state of U.S. law recognizing and protecting “making available” and “communication to the public” rights for copyright holders.	Comments requested and roundtable announced 2/25/14: 79 Fed. Reg. 10,571(87 PTCJ 959, 2/28/14); Room change 4/29/14: 79 Fed. Reg. 24,019 (88 PTCJ 44, 5/2/14)	Comment period ended 4/4/14, roundtable held 5/5/14
<b>Orphan Works and Mass Digitization</b>	The agency will host public roundtable discussions and seeks further comments on potential legislative solutions for orphan works and mass digitization under U.S. copyright law.	Comments requested and roundtables announced 2/10/14: 79 Fed. Reg. 7,706(87 PTCJ 824, 2/14/14); Comment period extended 4/4/14: 79 Fed. Reg. 18,932 (87 PTCJ 1373, 4/11/14).	Roundtables held 3/11/14 and 3/12/14; comments due 5/21/14.
<b>Strategic Plan for Recordation of Documents</b>	The agency is requesting public comments on proposals to the process of recording copyright-related documents pursuant to 17 U.S.C. § 205. In a separate notice, the agency will announce a series of public hearings on the matter.	Comments requested 1/15/14: 79 Fed. Reg. 2696 (87 PTCJ 639, 1/24/14).	Comment period ended 3/15/14.
<b>Notice of Intent to Audit</b>	On Dec. 20, the board has received five notices of intent from SoundExchange Inc. to audit the statements of account of Sirius XM Radio Inc., IMUV Inc., Crystal Media Networks, Pandora Media Inc., and LoudCity LLC submitted from 2010-2012 regarding payments made by them pursuant to the statutory licenses set forth by 17 U.S.C. § 114 and 17 U.S.C. § 112.	Public notice published 1/15/14: 79 Fed. Reg. 2,699 (87 PTCJ 639, 1/24/14).	Notices received 12/20/13

**Copyright Office and Copyright Royalty Board – Continued**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Determination of Royalty Rates for New Subscriptions for New Subscription Services for Digital Performance Right in Sound Recordings and Ephemeral Recordings</b>	A proceeding to determine rates and terms for the use of sound recordings in transmissions made by new subscription services from Jan. 1, 2016 to Dec. 31, 2020.	Notice announcing commencement of proceeding with request for Petitions to Participate 1/3/14: 79 Fed. Reg. 410(87 PTCJ 492, 1/10/14).	Petitions to Participate were due 2/3/14.
<b>Determination of Royalty Rates for Digital Performance in Sound Recordings and Ephemeral Recordings (Web IV)</b>	A proceeding to determine rates and terms for digital performances of sound recordings from Jan. 1, 2016 to Dec. 31, 2020.	Notice announcing commencement of proceeding with request for Petitions to Participate 1/3/14: 79 Fed. Reg. 412(87 PTCJ 492, 1/10/14).	Petitions to Participate were due 2/3/14.
<b>Adjustment of Determination of Compulsory License Rates for Mechanical and Digital Phonorecords</b>	Sets rates and terms applying to the mechanical compulsory license known as the Section 115 license.	Final rule 11/13/13: 78 Fed. Reg. 67,938 (87 PTCJ 160, 11/22/13). Copyright Office seeks more comments on proposed changes to Section 115 license 12/26/13: (87 PTCJ 427, 1/3/14). Technical amendment to final rule issued 12/20/13: (87 PTCJ 425, 1/3/14)	Effective 1/1/14.
<b>Determination of Rates and Terms for Business Establishment Services</b>	Final regulations setting rates and terms for the making of an ephemeral recording of a sound recording by a business establishment service.	Notice 10/25/13: 78 Fed. Reg. 64,023 (87 PTCJ 7, 11/1/13). Final regulations 11/5/13: 78 Fed. Reg. 66,276 (87 PTCJ 59, 11/8/13).	Final regulations 11/5/13.
<b>Distribution of DART Musical Works Funds Royalties</b>	Request for comments on proposal to distribute 95 percent of the digital audio recording technology royalties for 2009-2011.	Notice 10/25/13: 78 Fed. Reg. 64,023 (87 PTCJ 7, 11/1/13).	Comment period ended 11/25/13.
<b>Orphan Works</b>	Inquiry into the question of orphan works in preparation for advising Congress.	Comments requested 10/22/12: 77 Fed. Reg. 64,555 (84 PTCJ 1053, 10/26/12).	Comment period ended 2/4/13. Followup expected.
<b>Fees</b>	Fee schedule for the filing of cable and satellite statements of account	Proposed 3/28/12: 77 Fed. Reg. 18,742 (83 PTCJ 815, 4/6/12). Revised 12/6/12: 77 Fed. Reg. 72,788 (85 PTCJ 252, 12/14/12). Extended 2/14/13: 78 Fed. Reg. 10,583 (85 PTCJ 555, 2/22/13).	Comment period ended 2/22/13. Final rulemaking expected.
<b>Visual Artists Resale Right</b>	Inquiry into the question of creating a federal resale royalty right for visual artists.	Comments requested 9/19/13: 77 Fed. Reg. 58,175 (84 PTCJ 851, 9/21/12). Extended 10/16/12: 77 Fed. Reg. 63,342 (84 PTCJ 1039, 10/19/12). Hearing scheduled 3/29/13: 78 Fed. Reg. 19,326 (85 PTCJ 805, 4/5/13).	Public hearing 4/23/13. Report expected.
<b>Information Technology Systems</b>	Seeking input on improving the office's IT support for registration and recordation of copyrights.	Comments requested 3/22/13: 78 Fed. Reg. 17,222 (85 PTCJ 774, 3/29/13).	Comment period ended 5/21/13. Report expected.

**Copyright Office and Copyright Royalty Board – Continued**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Verification of Statements of Account Submitted by Cable Operators and Satellite Carriers</b>	New regulation to allow copyright owners to audit Statements of Account and royalty fees for secondary transmission of broadcast programming.	Proposed 6/14/12: 77 Fed. Reg. 35,643 (84 PTCJ 321, 6/22/12). Extended 9/11/12 (84 PTCJ 869, 9/21/12). Extended again 10/3/12 (84 PTCJ 1011, 10/12/12). Revised proposal 5/9/13 (86 PTCJ 66, 5/10/13). Establishment of interim procedural rules 12/26/13: (87 PTCJ 427, 1/3/14).	Comment period ended 6/24/13. Final rulemaking expected.
<b>Electronic Signature Authentication</b>	Identity authentication process to facilitate electronic filing of statements of account by cable television service providers.	Proposed 6/26/13: 78 Fed. Reg. 38,241 (86 PTCJ 471, 6/28/13).	Comment period ended 7/26/13. Final rulemaking expected.
<b>Royalty Rates for Ephemeral Recordings of Sound Recordings by Business Establishments</b>	Rates for the licensing period of January 2014 until December 2018	Proposed rule 7/19/13: 78 Fed. Reg. 43,094 (86 PTCJ 628, 7/26/13).	Comment period ended 8/19/13. Final rulemaking expected.

**Federal Trade Commission**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Collection of Nonpublic Data on Patent Assertion Entities</b>	Soliciting public comments on questions for PAEs and other entities asserting patents in the wireless communications sector.	Comments requested 10/3/13: 78 Fed. Reg. 61,352 (86 PTCJ 1128, 10/4/13); Second notice posted 5/13/14: (88 PTCJ 166, 5/16/14).	Second comments period closes 6/13/14.
<b>Premerger Notification; Reporting and Waiting Period Requirements</b>	Clarifying when a transfer of exclusive rights to a pharmaceutical patent results in a potentially reportable asset acquisition under Clayton Act Section 7A.	Proposed rulemaking 8/20/12: 77 Fed. Reg. 50,057.	Final rule announced 11/6/13: 78 Fed. Reg. 68,705 (87 PTCJ 115, 11/15/13).

**International Trade Commission**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>Exclusion Order Review</b>	Interagency review aimed at strengthening enforcement of ITC exclusion orders.	Proposed 6/20/13: 78 Fed. Reg. 37,242 (86 PTCJ 458, 6/28/13).	Comment period ended 7/21/13. Report expected.

**U.S. Trade Representative**

<b>TOPIC</b>	<b>DESCRIPTION</b>	<b>ACTIONS</b>	<b>NOTES</b>
<b>2013 Special 301 Out-of-Cycle Review of Notorious Markets</b>	Request for public comment for USTR's review of foreign "notorious markets" that violate U.S. intellectual property rights.	Comments requested 9/23/13: 78 Fed. Reg. 57,924 (86 PTCJ 1068, 9/27/13).	Comment period ended 10/11/13. Report expected.

## Trademark Trial and Appeal Board Update

This table summarizes the precedential rulings of the Trademark Trial and Appeal Board between Jan. 1 and June 19, 2014.

### TTAB Precedential Rulings: Jan. 1, 2014 - June 19, 2014

Case Name	Type of Proceeding	Issue	Outcome	Rationale	Relevant Lanham Act Provision(s)
<i>Blackhorse v. Pro-Football Inc.</i> , (88 PTCJ 516, 6/20/14) (June 18, 2014).	Cancellation	Whether six “Redskins” marks should be cancelled for being disparaging to Native Americans.	Cancellation granted	“Redskins” was disparaging to Native Americans at the times of the marks’ registrations, and cancellation is appropriate.	Section 2(a), 15 U.S.C. 1052(a)
<i>In re Michalko</i> , 110 USPQ2d 1949 (88 PTCJ 386, 6/6/14) (TTAB 2014).	Registration	Whether the refusal to register an “Asshole Repellent” mark for being scandalous was appropriate.	Refusal to register upheld	“Asshole” is a vulgar term, and the refusal to register for scandalousness was appropriate.	Section 2(a), 15 U.S.C. 1052(a)
<i>Chanel Inc. v. Makarczyk</i> , (88 PTCJ 318, 5/30/14) (May 27, 2014).	Opposition	Whether Makarczyk’s “Chanel” mark for “real estate development” dilutes Chanel Inc.’s famous mark.	Opposition sustained	Registration of Makarczyk’s mark would cause dilution-by-blurring of Chanel’s mark.	Section 43(c), 15 U.S.C. 1125(c)
<i>In re Davia</i> , 110 USPQ2d 1810 (88 PTCJ 319, 5/30/14) (TTAB 2014).	Registration	Whether the refusal to register a “Chantico” logo for pepper sauce on the grounds that the registration would cause confusion with an existing “Chantico” registration for agave sweetener was appropriate.	Refusal upheld	The fact that the marks use an identical term and are both used on condiments dooms the application.	Section 2(d), 15 U.S.C. 1052(d)
<i>In re Hollywood Lawyers Online</i> , 110 USPQ2d 1852 (88 PTCJ 112, 5/9/14) (TTAB 2014).	Registration	Whether the refusal to register ‘Hollywood Lawyers Online’ as geographically descriptive was appropriate.	Refusal upheld	If the context of the mark’s use makes clear that Hollywood is a reference to the entertainment industry, rather than the place, then the mark may be registrable.	Section 2(e)(2), 15 U.S.C. 1052(e)(2)
<i>Inter-Ikea Sys. B.V. v. Akea LLC</i> , 110 USPQ2d 1734 (88 PTCJ 110, 5/9/14) (TTAB 2014).	Opposition	Whether there was a likelihood of confusion between nutritional supplement maker Akea and furniture retailer Ikea.	Opposition partially sustained	The proposed “Akea” registration did not create a likelihood of confusion with Ikea in the areas of nutritional supplements, but did create a likelihood of confusion in the area of information and educational programs on career development of the direct sales force.	Section 2(d), 15 U.S.C. 1052(d)

## TTAB Precedential Rulings: Jan. 1, 2014 - June 19, 2014 – Continued

Case Name	Type of Proceeding	Issue	Outcome	Rationale	Relevant Lanham Act Provision(s)
<i>In re Swatch Group Management Services AG</i> , 110 USPQ2d 1751 (87 PTCJ 1532, 4/25/14) (TTAB 2014).	Registration	Whether the refusal to register Swatch's "Tourbillon" trademark was appropriate.	Refusal upheld	Swatch's "Tourbillon" mark was "merely descriptive" of watches, and watches are part of the "jewelry" class in which Swatch attempted to register the mark.	Section 2(e)(1), 15 U.S.C. 1052(e)(1)
<i>Bayer Consumer Care AG v. Belmora LLC</i> , 110 USPQ2d 1623 (87 PTCJ 1531, 4/25/14) (TTAB 2014).	Cancellation	Whether Belmora's "Flanax" mark, registered in the U.S., misrepresented the source of its goods as originating from Bayer, which owns the "Flanax" mark in Mexico.	Cancellation granted	Belmora's mark affirmatively misrepresented the source of its products, and the U.S. registration was cancelled.	Section 14(3), 15 U.S.C. 1064(3)
<i>Hunter Industries Inc. v. Toro Co.</i> , 110 USPQ2d 1651 (87 PTCJ 1369, 4/11/14) (TTAB 2014).	Opposition	Whether there is a likelihood of confusion between the parties' "Precision" and "Precision Distribution Control" marks.	Opposition sustained	The two marks, used on partially identical and otherwise closely related goods whose trade channels and classes of purchasers overlap, create a likelihood of confusion.	Section 2(d), 15 U.S.C. 1052(d)
<i>SARL Corexco v. Webid Consulting Ltd.</i> , 110 USPQ2d 1587 (87 PTCJ 1299, 4/4/14) (TTAB 2014).	Cancellation	Whether a U.S. trademark registration can be issued when the applicant is not the owner of the underlying foreign registration.	Motion for summary judgment granted	A U.S. trademark registration may not be issued when the applicant is not the owner of the underlying foreign registration.	Trademark Rule 2.35(b)(1), 37 CFR 2.35(b)(1)
<i>Sterling Jewelers Inc. v. Romance &amp; Co.</i> , 110 USPQ2d 1598 (87 PTCJ 1300, 4/4/14) (TTAB 2014).	Opposition	Whether a photocopy of a pleaded registration is sufficient to establish a party's ownership of the registration.	Motion for involuntary dismissal granted	A photocopy of a registration is not sufficient to establish ownership of the registration.	Trademark Rule 2.122(d)(1), 37 CFR 2.122(d)(1)
<i>Lincoln National Corp. v. Kent G. Anderson</i> , 110 USPQ2d 1271 (87 PTCJ 1300, 4/4/14) (TTAB 2014).	Opposition	Whether there is a likelihood of confusion between the marks "Future" and "Hello Future" when used in the same class.	Opposition sustained	There is a likelihood of confusion between the two marks.	Section 1(b) and 2(d), 15 U.S.C. 1051(b), 15 U.S.C. 1052(d)
<i>Boi Na Braza LLC v. Terra Sul Corp.</i> , 110 USPQ2d 1386 (87 PTCJ 1370, 4/11/14) (TTAB 2014).	Concurrent use application	Whether the mark "Boi Na Braza" can be used in different geographic areas without confusion.	Concurrent use granted	There is no likelihood of confusion if the concurrent use is limited to different geographic areas.	Section 2(d), 15 U.S.C. 1052(d)

## TTAB Precedential Rulings: Jan. 1, 2014 - June 19, 2014 – Continued

Case Name	Type of Proceeding	Issue	Outcome	Rationale	Relevant Lanham Act Provision(s)
<i>In re Morrison &amp; Foerster LLP</i> , 110 USPQ2d 1423 (87 PTCJ 1300, 4/4/14) (TTAB 2014).	Registration	Whether the refusal to register the mark “Frankndodd” on the ground that it consists of the names of two living individuals was appropriate.	Refusal reversed	The mark would be understood by the relevant public as referencing the Dodd-Frank Act, not the Representatives themselves.	Section 2(c), 15 U.S.C. 1052(c)
<i>Couch/Braunsdorf Affinity Inc. v. 12 Interactive LLC</i> , 110 USPQ2d 1458 (87 PTCJ 1368, 4/11/14) (TTAB 2014).	Cancellation	Whether there is a likelihood of confusion between the “Perkspot,” “Perks,” and “Perkscard” marks, and whether the “Perks” mark is generic or merely descriptive.	Cancellation denied, respondent counterclaim to cancel granted	There was no likelihood of confusion, but the “Perks” mark was merely descriptive.	Section 2(e)(1), 15 U.S.C. 1052(e)(1)
<i>In re Cordua Restaurants LP</i> , 110 USPQ2d 1227 (87 PTCJ 1232, 3/28/14) (TTAB 2014).	Registration	Whether the refusal to register the mark “churrasco” as generic and merely descriptive was appropriate.	Refusal upheld	The mark was generic, and the use of the mark had not made it distinctive.	Section 2(e)(1), 15 U.S.C. 1052(e)(1)
<i>Hot Tamale Mama...and More LLC v. SF Investments Inc.</i> , 110 USPQ2d 1080 (TTAB 2014) (87 PTCJ 1231, 3/28/14) (Mar. 21, 2014).	Opposition	Whether an e-mail exchange between opposing counsels in a trademark opposition proceeding demonstrates the sort of “good faith effort” that is required prior to the filing of a motion to compel discovery	Motion to compel discovery denied	A brief e-mail exchange, on its own, does not demonstrate a “good faith effort” that justifies a motion to compel discovery.	Trademark Rule 2.120(e)(1), 37 CFR § 2.120(e)(1)
<i>Board of Regents University of Texas Sys. v. Southern Illinois Miners LLC</i> , 110 USPQ2d 1182 (87 PTCJ 1166, 3/21/14) (TTAB 2014).	Opposition	Whether there is a likelihood of confusion between two “Miners” marks used by two different sports teams.	Opposition sustained	The two marks were identical, and the circumstances of the sale of goods using the mark created a likelihood of confusion	Section 2(d), 15 U.S.C. 1052(d)
<i>In re Tsubaki, Inc.</i> , 109 USPQ2d 2002 (TTAB 2014) (87 PTCJ 1090, 3/14/14).	Registration	Whether advertisements that do not include information normally associated with ordering the advertised products are valid specimens of proper trademark use.	Refusal upheld	Advertisements that do not include ordering information are not valid specimens of trademark use.	Section 45, 15 U.S.C. 1127



**TTAB Precedential Rulings: Jan. 1, 2014 - June 19, 2014 – Continued**

<b>Case Name</b>	<b>Type of Proceeding</b>	<b>Issue</b>	<b>Outcome</b>	<b>Rationale</b>	<b>Relevant Lanham Act Provision(s)</b>
<i>Frito-Lay North America Inc. v. Princeton Vanguard LLC</i> , 109 USPQ2d 1949 (TTAB 2014) (87 PTCJ 1018, 3/7/14).	Opposition, Cancellation	Whether the term “pretzel crisps” is generic.	Cancellation granted	The term “pretzel crisps” is a generic term referring to pretzel crackers, and cannot be trademarked.	Section 2(e), 15 U.S.C. 1052(e)
<i>Patagonia Inc. v. Azzolini</i> , 109 USPQ2d 1859 (TTAB 2014) (87 PTCJ 1018, 3/7/14).	Cancellation	Whether a pro se litigant’s failure to attend a mandatory discovery conference, following a pattern of unprofessional behavior, is sufficient to justify a default judgment against him.	Default judgment entered	A pro se litigant’s failure to attend a mandatory discovery conference following a pattern of unprofessional behavior justified a default judgment against him, and his registration was cancelled.	Fed. R. Civ. P. 37(b)(2)(A)(v)
<i>In re Hitachi High-Technologies Corp.</i> , 109 USPQ2d 1769 (TTAB 2014) (87 PTCJ 957, 2/28/14)	Registration	Whether a refusal to register the “Opticross” mark for likelihood of confusion with Optimize Technologies’ marks within the same class was appropriate.	Refusal upheld	The refusal was appropriate and upheld by the board. Also, the “family of marks” doctrine does not apply in ex parte proceedings.	Section 2(d), 15 U.S.C. 1052(d)
<i>Covidien LP v. Masimo Corp.</i> , 109 USPQ2d 1696 (TTAB 2014) (87 PTCJ 887, 2/21/14)	Cancellation	Whether a claim under Trademark Act § 18 is the appropriate way to attempt restricting a color mark to a particular shade.	Motion to dismiss denied	A Section 18 claim is an appropriate claim for the attempted restriction.	Section 18, 15 U.S.C. 1068
<i>Weider Publications LLC v. D &amp; D Beauty Care Co.</i> , 109 USPQ2d 1347 (TTAB 2014) (87 PTCJ 638, 1/24/14)	Opposition	Whether there is a likelihood of confusion between a “Shapes” mark for beauty services and a “Shape” mark for a magazine dealing with health and fitness.	Opposition sustained	The marks and goods were similar enough to create a likelihood of confusion, even though applicant only intended to use the mark for beauty services and not media-related services.	Section 2(d) and 43(c), 15 U.S.C. 1052(d) and 1125(c)
<i>Turdin v. Trilobite Ltd.</i> , 109 USPQ2d 1473 (TTAB 2014) (87 PTCJ 691, 1/31/14)	Concurrent use application	Whether there is a likelihood of confusion between a “Trilobite” mark for film production and a “Trilobite” mark for audio recording and production.	Concurrent use registration denied	There is a likelihood of confusion between the similar marks and services in New York, Connecticut, and Ohio, and only Trilobite Ltd. can use this mark in these locations.	Section 2(d), 15 U.S.C. 1052(d)

**TTAB Precedential Rulings: Jan. 1, 2014 - June 19, 2014 – Continued**

<b>Case Name</b>	<b>Type of Proceeding</b>	<b>Issue</b>	<b>Outcome</b>	<b>Rationale</b>	<b>Relevant Lanham Act Provision(s)</b>
<i>In re Fiat Group Marketing &amp; Corporate Communications S.p.A.</i> , 109 USPQ2d 1593 (TTAB 2014) (87 PTCJ 754, 2/7/14)	Registration	Whether recitation of the name of an international class in a trademark registration application implies that all goods and services within that class are within the scope of the application.	Rejection affirmed	When submitting a trademark registration application, an applicant must specifically describe the goods or services for which the registration is sought. Simply reciting the title or name of the international class does not imply that all goods and services included in that class are within the scope of the application.	Section 66(a), 15 U.S.C. 1141f(a)

## PTAB Petition Update

The Patent Trial and Appeal Board (PTAB) was created by the America Invents Act of 2012, replacing the Board of Patent Appeals and Interferences within the PTO. The Board's duties are to review adverse decisions of examiners on written appeals from patent applicants, review appeals of reexaminations, conduct derivation

proceedings, conduct inter partes and post-grant reviews, and decide patent interferences.

Following are petitions filed with the PTAB collected during the period of June 12 - 19, 2014. For a comprehensive tool monitoring activities at the PTAB, ask your Bloomberg BNA sales representative about our PTAB Challenge Navigator.

### Recent PTAB Petitions

Matter	Case Type	Petitioner	Patent Owner	Basis of Claim	Patent Number	Patent Description
Intel Corp. v. Zond Inc., IPR2014-00945, filed 6/12/2014	Inter Partes Review	Intel Corp.	Zond Inc.	Obviousness	6,806,652	High-density plasma source using excited atoms
RPX Corp. v. ParkerVision Inc., IPR2014-00946, filed 6/12/2014	Inter Partes Review	RPX Corp.; Farmwald, Michael	ParkerVision Inc.	Anticipation	6,266,518	Method and system for down-converting electromagnetic signals by sampling and integrating over apertures
RPX Corp. v. ParkerVision Inc., IPR2014-00947, filed 6/12/2014	Inter Partes Review	RPX Corp.; Farmwald, Michael	ParkerVision Inc.	Anticipation	6,061,551	Method and system for down-converting electromagnetic signals
RPX Corp. v. ParkerVision Inc., IPR2014-00948, filed 6/12/2014	Inter Partes Review	RPX Corp.; Farmwald, Michael	ParkerVision Inc.	Anticipation	6,370,371	Applications of universal frequency translation
International Business Machines Corp. v. Olympus Optical Co., IPR2014-00949, filed 6/12/2014	Inter Partes Review	International Business Machines Corp.; Oracle America Inc.	Olympus Optical Co.	Obviousness	6,978,346	Apparatus for redundant interconnection between multiple hosts and raid
Branch Banking & Trust Co. v. EMG Technology LLC, CBM2014-00145, filed 6/13/2014	Covered Business Method Review	Branch Banking & Trust Co.	EMG Technology LLC	Obviousness	7,441,196	Apparatus and method of manipulating a region on a wireless device screen for viewing, zooming and scrolling internet content

## Recent PTAB Petitions – Continued

<b>Matter</b>	<b>Case Type</b>	<b>Petitioner</b>	<b>Patent Owner</b>	<b>Basis of Claim</b>	<b>Patent Number</b>	<b>Patent Description</b>
DealerSocket Inc. v. AutoAlert Inc., CBM2014-00146, filed 6/13/2014	Covered Business Method Review	DealerSocket Inc.	AutoAlert Inc.	Patent Ineligible	8,086,529	System and method for assessing and managing financial transactions
DealerSocket Inc. v. AutoAlert Inc., CBM2014-00147, filed 6/13/2014	Covered Business Method Review	DealerSocket Inc.	AutoAlert Inc.	Patent Ineligible	8,005,752	System and method for assessing and managing financial transactions
Cisco Systems Inc. v. Constellation Technologies LLC, IPR2014-00871, filed 6/13/2014	Inter Partes Review	Cisco Systems Inc.	Constellation Technologies LLC	Obviousness	6,845,389	System and method for broadband multi-user communication sessions
Reloaded Games Inc. v. Parallel Networks LLC, IPR2014-00950, filed 6/13/2014	Inter Partes Review	Reloaded Games Inc.	Parallel Networks LLC	Obviousness	7,188,145	Method and system for dynamic distributed data caching
Canon Inc. v. Intellectual Ventures I LLC, IPR2014-00952, filed 6/13/2014	Inter Partes Review	Canon Inc.	Intellectual Ventures I LLC	Anticipation, Obviousness	8,300,285	Scanning circuit structure
505 Games Interactive Inc. v. Babbage Holdings Inc., IPR2014-00954, filed 6/13/2014	Inter Partes Review	505 Games Interactive Inc.; Activision Blizzard Inc.; Capcom USA Inc.; Walt Disney Co.; Electronic Arts Inc.; Namco Bandai Games America Inc.; Sony Computer Entm't; Ubisoft Inc.; Take-Two Interactive Software Inc.; Square Enix Inc.; Riot Games Inc.	Babbage Holdings Inc.	Anticipation, Obviousness	5,561,811	Computer system

## Recent PTAB Petitions – Continued

<b>Matter</b>	<b>Case Type</b>	<b>Petitioner</b>	<b>Patent Owner</b>	<b>Basis of Claim</b>	<b>Patent Number</b>	<b>Patent Description</b>
Skechers USA Inc. v. Aura Technologies LLC, IPR2014-00955, filed 6/13/2014	Inter Partes Review	Skechers USA Inc.	Aura Technologies LLC	Obviousness	6,751,891	Article of footwear incorporating a shock absorption and energy return assembly for shoes
Boku Inc. v. Xilidev Inc., CBM2014-00148, filed 6/16/2014	Covered Business Method Review	Boku Inc.	Xilidev Inc.	Indefiniteness	7,273,168	Point-of-sale billing via hand-held devices
NHK Seating of America Inc. v. Lear Corp., IPR2014-00957, filed 6/16/2014	Inter Partes Review	NHK Seating of America Inc.	Lear Corp.	Anticipation, Obviousness	7,455,357	Active head restraint system for a vehicle seat
Ericsson Inc. v. Intellectual Ventures I LLC, IPR2014-00958, filed 6/16/2014	Inter Partes Review	Ericsson Inc.	Intellectual Ventures I LLC	Anticipation, Obviousness	5,602,831	Optimizing packet size to eliminate effects of reception nulls
Ericsson Inc. v. Intellectual Ventures I LLC, IPR2014-00963, filed 6/16/2014	Inter Partes Review	Ericsson Inc.	Intellectual Ventures I LLC	Anticipation, Obviousness	6,952,408	Method of baseband frequency hopping utilizing time division multiplexed mapping between a radio transceiver and digital signal processing resources
LG Electronics Inc. v. NFC Technology LLC, IPR2014-00959, filed 6/16/2014	Inter Partes Review	LG Electronics Inc.	NFC Technology LLC	Anticipation, Obviousness	6,700,551	Antenna signal amplitude modulation method
LG Electronics Inc. v. NFC Technology LLC, IPR2014-00964, filed 6/16/2014	Inter Partes Review	LG Electronics Inc.	NFC Technology LLC	Anticipation, Obviousness	7,665,664	Inductive coupling reader comprising means for extracting a power supply voltage

## Recent PTAB Petitions – Continued

<b>Matter</b>	<b>Case Type</b>	<b>Petitioner</b>	<b>Patent Owner</b>	<b>Basis of Claim</b>	<b>Patent Number</b>	<b>Patent Description</b>
Paramount Home Entertainment Inc. v. Nissim Corp., IPR2014-00961, filed 6/16/2014	Inter Partes Review	Paramount Home Entertainment Inc.; Twentieth Century Fox Home Entertainment LLC; Universal Studios Home Entertainment LLC	Nissim Corp.	Anticipation, Obviousness	6,304,715	Disc having a code for preventing an interference with a playing of a video segment
Paramount Home Entertainment Inc. v. Nissim Corp., IPR2014-00962, filed 6/16/2014	Inter Partes Review	Paramount Home Entertainment Inc.; Twentieth Century Fox Home Entertainment LLC; Universal Studios Home Entertainment LLC	Nissim Corp.	Anticipation, Obviousness	7,054,547	Disc having a code for preventing an interference with a playing of a video segment
AOL Inc. v. Coho Licensing LLC, IPR2014-00966, filed 6/17/2014	Inter Partes Review	AOL Inc.; Cloudera Inc.	Coho Licensing LLC	Anticipation, Obviousness	8,667,065	Distributed multiple-tier task allocation
Molex Inc. v. Bel-Fuse Inc., IPR2014-00969, filed 6/17/2014	Inter Partes Review	Molex Inc.	Bel-Fuse Inc.	Anticipation, Obviousness	7,123,117	LAN magnetic interface circuit
SanDisk Corp. v. Netlist Inc., IPR2014-00970, filed 6/18/2014	Inter Partes Review	SanDisk Corp.	Netlist Inc.	Obviousness	8,001,434	Memory board with self-testing capability
SanDisk Corp. v. Netlist Inc., IPR2014-00971, filed 6/18/2014	Inter Partes Review	SanDisk Corp.	Netlist Inc.	Anticipation, Obviousness	8,359,501	Memory board with self-testing capability
Gillette Co. v. Zond Inc., IPR2014-00972, filed 6/18/2014	Inter Partes Review	Gillette Co.	Zond Inc.	Anticipation, Obviousness	7,604,716	Methods and apparatus for generating high-density plasma
Gillette Co. v. Zond Inc., IPR2014-00973, filed 6/18/2014	Inter Partes Review	Gillette Co.	Zond Inc.	Anticipation, Obviousness	7,604,716	Methods and apparatus for generating high-density plasma

## Recent PTAB Petitions – Continued

<b>Matter</b>	<b>Case Type</b>	<b>Petitioner</b>	<b>Patent Owner</b>	<b>Basis of Claim</b>	<b>Patent Number</b>	<b>Patent Description</b>
Gillette Co. v. Zond Inc., IPR2014-00974, filed 6/18/2014	Inter Partes Review	Gillette Co.	Zond Inc.	Obviousness	7,604,716	Methods and apparatus for generating high-density plasma
Gillette Co. v. Zond Inc., IPR2014-00975, filed 6/18/2014	Inter Partes Review	Gillette Co.	Zond Inc.	Obviousness	7,604,716	Methods and apparatus for generating high-density plasma
International Business Machines Corp. v. Olympus Optical Co., IPR2014-00976, filed 6/18/2014	Inter Partes Review	International Business Machines Corp.; Oracle America Inc.	Olympus Optical Co.	Anticipation	6,978,346	Apparatus for redundant interconnection between multiple hosts and raid
Google Inc. v. PersonalWeb Technologies LLC, IPR2014-00977, filed 6/18/2014	Inter Partes Review	Google Inc.; YouTube LLC	PersonalWeb Technologies LLC; Level 3 Communications LLC	Anticipation, Obviousness	6,415,280	Identifying and requesting data in network using identifiers which are based on contents of data
Google Inc. v. PersonalWeb Technologies LLC, IPR2014-00978, filed 6/18/2014	Inter Partes Review	Google Inc.; YouTube LLC	PersonalWeb Technologies LLC; Level 3 Communications LLC	Obviousness	7,802,310	Controlling access to data in a data processing system
Google Inc. v. PersonalWeb Technologies LLC, IPR2014-00979, filed 6/18/2014	Inter Partes Review	Google Inc.; YouTube LLC	PersonalWeb Technologies LLC; Level 3 Communications LLC	Obviousness	6,928,442	Enforcement and policing of licensed content using content-based identifiers
Google Inc. v. PersonalWeb Technologies LLC, IPR2014-00980, filed 6/18/2014	Inter Partes Review	Google Inc.; YouTube LLC	PersonalWeb Technologies LLC; Level 3 Communications LLC	Anticipation, Obviousness	5,978,791	Data processing system using substantially unique identifiers to identify data items, whereby identical data items have the same identifiers

## Hatch-Waxman Litigation Update

The Drug Price Competition and Patent Term Restoration Act of 1984, more commonly known as the Hatch-Waxman Act, amended the Federal Food, Drug, and Cosmetic Act and the Patent Act in order to speed the introduction of lower-cost generic drugs into the marketplace, while at the same time preserving the rights of pharmaceutical patentees and compensating them for market time lost satisfying the U.S. Food and Drug Administration's (FDA) safety and efficacy requirements.

The Hatch-Waxman Act establishes a mechanism for prospective manufacturers of a generic drug to challenge an extant patent covering an FDA-approved drug

by filing an Abbreviated New Drug Application (ANDA) with a so-called "Paragraph IV" certification setting forth the basis for challenging the patent. See 21 U.S.C. §§ 355(j), 355(j)(2)(A)(vii)(IV). A Paragraph IV certification constitutes technical infringement of the patent (see 35 U.S.C. § 271(e)(2)), triggering a 45-day period during which the patentee can, by filing suit against the generic manufacturer, invoke a statutory 30-month stay of approval of the ANDA drug. 21 U.S.C. § 355(j)(5)(B)(iii).

Following are court complaints collected during the period of June 12 - 19, 2014.

### Recent Hatch-Waxman Filings

Matter	NDA Holder / Licensee(s)	ANDA Filer	Patent(s)	Brand Name
<i>Spectrum Pharmaceuticals Inc. v. Ben Venue Laboratories Inc.</i> , No. 2:14-cv-00980, Complaint (D. Nev. June 18, 2014)	Spectrum Pharmaceuticals Inc.; University of Strathclyde	Ben Venue Laboratories Inc.	U.S. Patent No. 6,500,829 (levoleucovorin)	FUSILEV (colorectal cancer)
<i>Bayer Pharma AG v. Par Pharmaceutical Inc.</i> , No. 1:14-cv-00761, Complaint (D. Del. June 17, 2014)	Bayer Pharma AG; Bayer Intellectual Property GmbH; Bayer HealthCare Pharmaceuticals Inc.	Par Pharmaceutical Inc.; Par Pharmaceutical Cos.	U.S. Patent No. 8,613,950 (vardenafil)	STAXYN (erectile dysfunction)
<i>Bayer Pharma AG v. Watson Laboratories Inc.</i> , No. 1:14-cv-00760, Complaint (D. Del. June 17, 2014)	Bayer Pharma AG; Bayer Intellectual Property GmbH; Bayer HealthCare Pharmaceuticals Inc.	Watson Laboratories Inc.; Actavis Inc.; Actavis Pharma Inc.	U.S. Patent No. 8,613,950 (vardenafil)	STAXYN (erectile dysfunction)
<i>Vander Pharmaceutuicals Inc. v. Roxane Laboratories Inc.</i> , No. 1:14-cv-00757, Complaint (D. Del. June 16, 2014)	Vander Pharmaceutuicals Inc.	Roxane Laboratories Inc.	U.S. Patent No. 8,586,610 (iloperidone)	FANAPT (schizophrenia)
<i>Gilead Sciences Inc. v. Mylan Inc.</i> , No. 1:14-cv-00099, Complaint (N.D. W. Va. June 9, 2014)	Gilead Sciences Inc.; Emory Univ.	Mylan Inc.; Mylan Pharmaceuticals Inc.	U.S. Patent Nos. 6,642,245; 6,703,396; 8,592,397 (tenofovir)	TRUVADA (HIV)
<i>Glenmark Generics Ltd. v. Ferring BV</i> , No. 3:14-cv-00422, Complaint (E.D. Va. June 9, 2014)	Glenmark Generics Ltd.; Glenmark Generics Inc.	Ferring BV	U.S. Patent No. 7,022,340 (desmopressin)	DDAVP (diabetes insipidus)



# BNA Insights

## Copyright

With the Supreme Court set to decide the case of *Am. Broad. Cos. v. Aereo*, the question arises: Will Congress respond? The author says the court's final judgment in the case could clarify or further muddy the nation's copyright laws in a manner not seen since the days of the player piano.

## New Technologies Are Once Again Blurring the Lines of Copyright Law

By FRANCISCO R. MONTERO

It seems like copyright law is always trying to catch up with new technology. That's not a new phenomenon. Take the player piano and the 1908 Supreme Court case of *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), in which the high court ruled that manufacturers of music rolls for player pianos did not have to pay royalties to the composers.

The composers were understandably worried that the player piano—then a burgeoning new technology—would make sheet music (and, more importantly, the copyright royalties they earned from the sale of sheet music) obsolete. In response, Congress, in the Copyright Act of 1909, created the compulsory license, allowing anyone to copy a composer's work without permission as long as they paid a predetermined license fee.

The same scenario is playing out today: New technological developments are outstripping decades-old copyright law, forcing changes in the law, challenging old models, and blurring long-established lines. The traditional "silo" mentality that addressed TV, radio, publishing, recording, cable—and now, the Internet—as separate and distinct areas cabined off from one another is eroding. Record companies are battling radio broadcasters. TV broadcasters are battling cable and satellite companies. Internet audio streamers are battling publishers. Publishers are battling record labels. Internet video streamers are battling Internet service providers.

A principal source of these issues: the Copyright Act's definition of the "public performance" of copyrighted work. The Copyright Act gives a copyright holder the exclusive right "to perform the copyrighted work publicly." In response to a couple Supreme Court decisions applying that provision to the then-burgeoning new technology of cable television (shades

of the player piano situation) Congress amended the Act in 1976. To ensure that cable retransmission of over-the-air television broadcasts were treated as "public performances," Congress expanded the definition of "[t]o perform . . . publicly." As a result, that definition now includes the transmission "to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times."

That provision underpins the right of TV broadcasters to negotiate retransmission consent agreements to receive payments from cable systems and other multi-channel providers that distribute the station's programming to paying subscribers, a system that has worked reasonably well for more than 20 years.

But new technology won't be denied. In the past two years a venture called Aereo Inc. has challenged that model by retransmitting to subscribers TV programming without paying copyright royalties. Aereo's technology involves small individual broadcast antennas (one for each subscriber) which pick up free broadcast TV signals over the air.

**Are Aereo's Streams 'Public Performances'?** According to Aereo (and the U.S. Court of Appeals for the Second Circuit, which sided with Aereo in a challenge by TV broadcasters, 712 F.3d 676, 2013 BL 87728, 106 U.S.P.Q.2d 1341 (85 PTCJ 799, 4/5/13)), the company is not engaging in a public performance of copyrighted material because it sends each of its subscribers an individualized transmission of a performance from a unique copy of each copyrighted program. As a result (so the argument goes), it is not transmitting performances "to the public." Rather, Aereo says that it is essentially renting its subscribers an "antenna farm" service that allows each subscriber to access a "private" performance much like they would if the antenna were on their roof and connected directly to their TV—only in this case, the antenna and the "roof" are off-site and owned by Aereo. (In an effort to bolster its claim—or maintain the illusion—that it is not a cable system, Aereo cuts off reception of its service beyond the perimeter within which a residential TV roof antenna could pick up over-the-air signals from TV stations.)

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TV broadcasters, of course, disagree. In their view, Aereo is engaged in a public performance of copyrighted material just like any multichannel video programming distributor (MVPD) and, therefore, Aereo should pay copyright royalties like any MVPD, whether the statutory amount associated with must-carry carriage or a privately negotiated amount, as with retransmission consent deals.

In April, the TV broadcasters and Aereo went head to head at the Supreme Court in *Am. Broad. Cos. v. Aereo*, U.S., No. 13-461, (*argued 4/22/14*) (87 PTCJ 1517, 4/25/14). Among the questions to be decided: Is Aereo a cable company essentially engaged in retransmission of copyrighted programming? Or it is really just an equipment supplier providing subscribers with the equivalent of a new-fangled antenna on each subscriber's "roof"? During oral argument, Chief Justice Roberts questioned the motives underlying the design of Aereo's system: "There's no reason for you to have 10,000 dime-sized antennas except to get around copyright laws."

Meanwhile, radio broadcasters are waging their own battle over copyright royalties and Internet distribution. Although radio stations pay royalties to publishers and songwriters through ASCAP, BMI and SESAC licensing fees, they have long been exempt from having to pay performance royalties for over-the-air broadcasts of recorded music. The theory underlying the exemption: Record companies reap a benefit from having their recordings played over the airwaves.

The recording industry has been trying to reverse this in recent years by urging Congress to act on their behalf (shades of player pianos and cable TV), but the broadcasting lobby has been able to thwart those efforts. Still, radio stations are required to pay royalties to the recording industry for simulcasts they stream over the Internet. That's the result of the 1998 Digital Millennium Copyright Act (DCMA). Back in the 1990s, when Internet access was shifting from dial-up to broadband, the volume of video and audio content streamed on the Internet increased. In the DCMA, Congress adopted a digital performance royalty for sound recordings.

The DCMA exempted over-the-air broadcast transmissions from that royalty, and it also exempted retransmissions of over-the-air broadcast transmission within a 150-mile limit. While broadcasters argued that streaming their own signals over the Internet should not be subject to the DCMA's digital performance royalty, the Copyright Office disagreed.

But, again, technology won't be denied. A new technology known as Geo-fencing now makes it possible to geographically limit the reach of an Internet webcast to a particular geographic area—say, 150 miles. So a Virginia broadcaster has sued, claiming that by limiting its Internet stream to within 150 miles using Geo-fencing, it should not have to pay DCMA performance royalties for those Internet simulcasts. This argument, of course, has faint echoes of Aereo's deliberate efforts to artificially limit subscriber reception to an area equal to the reach of residential TV roof antennas (even though Aereo is accessible via Internet). In both cases, Internet distribution is being limited to reach audiences within an area comparable to a broadcast station's over-the-air signals.

The goal in both cases is obvious: To use new technology to fit into traditional industry "silos" and thereby take advantage of laws based on that "silo" approach. And there is a further intersection. If the Su-

preme Court were to hold that Aereo's use of small antennas to retransmit over-the-air signals over the Internet does not violate the copyright of TV broadcasters, then you could arguably use small antennas to receive and simulcast a radio station's over-the-air signal over an Internet stream (in an Aereo-like model) to listeners without having to pay royalties to the recording industry. Bye, bye 150-mile limit.

In short, Aereo is trying to blur the line with TV broadcasting and radio broadcasters are trying to blur the line with pure Internet content providers like Pandora.

**Is Pandora a Broadcaster?** Meanwhile, Pandora wants to be treated like a broadcaster. Last year the pure play music provider purchased an FM radio station in South Dakota in order to blur the line with broadcasters for copyright purposes. Pandora currently pays royalties to composers and publishers to use songs for its service through license fees it pays to organizations like ASCAP and BMI. But similar online services offered by broadcasters, such as Clear Channel's iHeart Radio, pay lower ASCAP and BMI rates than Pandora. The difference between broadcasters and Pandora? Radio stations benefit from a January 2012 agreement between the Radio Music License Committee (which negotiates royalty rates for the radio industry) and ASCAP and BMI. So to bring itself under the terms of that agreement—and thereby relieve itself of considerable royalty obligations—Pandora bought a radio station and declared that it was now a radio broadcaster entitled to the benefits of the January 2012 agreement.

Finally, we come full circle to the licensing industries themselves. As mentioned earlier, radio stations currently pay copyright licensing fees to songwriters and publishing companies (primarily through payments to ASCAP, BMI and SESAC), but they are not required to pay recording companies (usually collected by SoundExchange) for over-the-air broadcasts of recorded performances.

Enter the Songwriter Equity Act recently introduced in the Senate, which aims to level the playing field between record labels and songwriters who claim they are not getting a fair piece of the pie. The legislation would broaden the pool of evidence that federal rate courts like the Copyright Royalty Board (CRB) could examine when setting songwriter compensation. The CRB would be able to set the fair market value of digital performance rates for composers. In so doing, it could also correct perceived inequities in the royalties received by songwriters and publishers on the one hand and artists and recording companies on the other.

The CRB would calculate fair market value when setting songwriter publishing rates on digital music services, in addition to four other considerations it already uses. For example, the CRB could consider the rates that are set between Sound Exchange (which collects royalties for recordings played over the Internet) and digital music service providers such as Pandora. Broadcasters are concerned because they fear that they will be stuck with the tab for correcting any inequities the CRB perceives between songwriters and artist rates.

The real issue at hand, however, is the fact that technologies are shifting faster than the law can adapt. In many ways, the copyright law, like many telecommunications laws and regulations, has historically been crafted around traditional industry "silo" models such

as radio vs. TV vs. cable vs. telephony vs. Internet vs. publishing vs. recording. But thanks to the continuing evolution of technology, those once-clearly delineated lines are blurring and will continue to blur. This may require a complete overhaul of the system.

There are already initial efforts underway to update the Communications Act to remove the traditional industry silos of broadcasting, cable, wireless and telephony. Such changes will have to be carefully crafted and interpreted to avoid unintended consequences. In 2008, for example, the Second Circuit's *Cablevision* decision—which held that Cablevision's remote storage DVR did not infringe on broadcasters' copyrights—led to

an unintended consequence we now know as *Aereo*, much like the 1908 player piano decision changed for the next century the law of how music is copied and licensed. *Cartoon Network LP v. CSC Holdings Inc.*, 536 F.3d 121, 87 U.S.P.Q.2d 1641 (2d Cir. 2008) (76 PTCJ 511, 8/8/08).

In the *Aereo* oral argument before the Supreme Court, the justices were clearly concerned about the impact their decision could have on other developing technologies such as cloud storage. We are a long way from player pianos, but lessons can be learned and old models need revising.

# Special Report

## Patents

The controversy concerning the Patent and Trademark Office's guidance on subject matter eligibility for materials related to nature has continued. The PTO held a forum on May 9 and afterwards indicated that it would consider making some changes in response to comments but rejected calls that it withdraw the guidance. Drew Hirshfeld, the PTO's deputy commissioner for patent examination policy, spoke by phone to Bloomberg BNA legal editor John T. Aquino on May 30, providing more details on the PTO's reasons for the guidance, its response to the criticism and its view on the guidance's future. Hirshfeld was joined by June Cohen, a legal adviser from the PTO's Office of Legal Patent Administration.

### PTO Officials Respond to Criticism of Section 101 Guidance

**BLOOMBERG BNA:** First question, at the PTO forum on May 9 (88 PTCJ 179, 5/16/14), you suggested that those with comments should get them in by June 30. Have you been receiving comments and what do you see happening after the end of June?

**Drew Hirshfeld:** Well, since the forum, comments have been coming in.

**June Cohen:** We've received about 20 so far, but historically we get the bulk of comments in the last two weeks before the date when we've asked for them. Again, comments on the guidance are welcome any time, but we've asked those who want to submit comments to try and do so by the end of June. So, we're expecting a good number by then. Comments can be submitted to [myriad-mayo\\_2014@uspto.gov](mailto:myriad-mayo_2014@uspto.gov). The comments we receive must be reviewed in accordance with government requirements including the Americans with Disabilities Act. But we will begin posting them on <http://www.uspto.gov/patents/announce/myriad-mayo.jsp> in the next few weeks, and we will continue to post them as we get them until they are all up.

**Hirshfeld:** What we will do then is go through the comments and try to find the right balance between staying true to the case law and addressing issues the public cares about. We're hoping that public comments will help us do that.

**BBNA:** Were you surprised by the reaction to the guidance? One thing we heard over and over from patent attorneys is, "I have great sympathy for the PTO and what they tried to do, but. ..." The PTO appeared to decide to take a bold, forceful approach to subject matter eligibility guidance as a result of the Supreme Court's opinions in *Ass'n for Molecular Pathology v. Myriad Genetics*, which held that composition claims for isolated DNA are patent ineligible as reciting laws of nature, and *Mayo Collaborative Servs. v. Prometheus*

*Labs., Inc.*, which held that claims for methods for administering a drug are patent ineligible as products of nature. The guidance goes beyond the *Myriad* ruling to suggest that claims for proteins, primers, peptides and even vaccines could be patent ineligible. You had an attendee at the PTO forum predicting that Congress was going to "hand you your head." In retrospect, was the strong, forceful response to *Myriad* and *Mayo* the right one?

**Hirshfeld:** I don't believe that we took a forceful approach. What I heard at the forum were some people who didn't get the message that we intended to convey. We look on that as being our fault, not theirs. We have to make our message clearer. We also heard some people who basically wanted us to ignore the case law. That we cannot do.

**BBNA:** At the PTO forum, in answer to the gentleman's prediction that Congress was going to "hand you your head" as a result of the guidance, you said, "One sure way a federal agency gets its head handed to it, is for it to ignore its own reasonable interpretation of Supreme Court precedent."

**Hirshfeld:** That is true. And then at the forum there were people who suggested that there was room in the Supreme Court's rulings from *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948), to *Diamond v. Chakrabarty*, 447 U.S. 303, 206 U.S.P.Q. 193 (1980), for some specific types of composition claims related to natural products to be considered patent eligible. We are looking into that.

**BBNA:** Related to that last point, Leslie Fischer, senior patent attorney for Novartis Pharmaceuticals, said at the PTO forum, in response to the guidance's focus on structure over function to determine if an invention offers something "significantly different" than a natural product, that in *Myriad* the Supreme Court's emphasis

on the information in DNA was an emphasis on function. And Courtenay Brinckerhoff of Foley & Lardner LLP said that there was functionality in *Funk Bros.* that you overlooked.

**Hirshfeld:** Even before the forum, the PTO staff had been addressing the issue of structure versus functionality. In fact, we worked the agenda of the forum so that speakers could talk about that. So, we were already on the issue. What we struggled with was the question, when can there be a functional change that doesn't change the structure? How can a product have a functional difference from one place to another if it is not changed structurally? We'll look to see if the comments give us examples of when this is so.

**BBNA:** Part of the reaction to the guidance is likely due to its timing. Venture capital investing in life sciences has plummeted, partly as a result of the sense among investors that the U.S. has become patent unfriendly. And now on top of that, the PTO prospectively indicates that vaccines, peptides, proteins and primers might also be patent ineligible.

**Hirshfeld:** My initial reaction is that it would not have been proper to limit the guidance to examiners to isolated DNA. Our guidance had to go beyond that. Yes, *Myriad* was only about DNA. But the way the Supreme Court got there was through *Funk Bros.* in which the court held that a claim for a facially trivial implementation of a natural principle or phenomenon of nature is not eligible for a patent. *Funk Bros.* was about species of bacteria. *Funk Bros.* had nothing to do with DNA. There was a question about whether *Funk Bros.* was a Section 101 [35 U.S.C. § 101 (patent eligibility)] case.

**BBNA:** Because it was decided four years before Section 101 (patent eligibility) was included in the Patent Act of 1952?

**Hirshfeld:** That's right. But the *Myriad* court indicated that it was a Section 101 case. And so with *Funk Bros.* leading the way to *Myriad*, we couldn't limit our guidance to DNA. What we were looking at were principles derived from the court's decisions that I outlined at the forum: case law prevents issuing patents to claims that cover judicial exceptions—laws of nature/natural principles, natural phenomena and/or natural products; there are two pathways to patent eligibility if there is a judicial exception: the "markedly different" pathway of *Chakrabarty* and the 'significantly more' pathway of *Mayo*; and there are no "bright line rules."

**BBNA:** A number of people at the forum contrasted the way this guidance was handled with the way the PTO guidance on the utility requirement was handled in 2000. And in looking at the BBNA articles covering the development of that guidance, the PTO did spread out the receipt of input over several months and the draft guidance was amended based on input from practitioners *before* it was put into effect. In contrast, the patent subject matter eligibility guidance is now in effect, comments were subsequently solicited, and claims are being rejected as a result of the guidance.

**Hirshfeld:** There was never the intent not to get comments from practitioners. But if you look at any of our recent guidances based on court decisions, such as *Bilski v. Kappos*, which was issued just four weeks after the Supreme Court's ruling (80 PTCJ 416, 7/30/10), for this guidance we did it exactly the way it has been done since 2009. I really don't know how it was done in 2000. Since 2009, we have been issuing proposed guidance when we have felt that examiners have had to make a change. If we required input before helping our examiners deal with this change, taking maybe 10 months, what were our 8,000 examiners going to do in the meantime? Were they going to say to themselves, we know what our bosses think we're supposed to be doing but we can't do it yet? We can't have a void. We had to go forward. But we are willing to take input and consider changes in the guidance as long as the changes are true to the case law.

**BBNA:** What are the major areas in the guidance where you think more clarification is needed?

**Hirshfeld:** One area concerns claims for isolated and purified products. I have been on panels where I have heard panelists say that the PTO is not going to issue patents for any isolated or purified claims. And nothing could be further from the truth. For each claim being examined, including those for isolated and purified products, the examiner will evaluate the claim to determine whether it recites or involves a judicial exception and if it does, he or she will evaluate the claim as a whole to determine whether it recites something significantly different than the judicial exception. We are also working to be clearer in our guidance about diagnostic and treatment claims and claims for combinations that include DNA as one component of the combination.

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The PTO guidance is at <http://pub.bna.com/ptcj/PTOMyriadMemo14Mar4.pdf>.

The PTO training slides are at [http://www.uspto.gov/patents/law/exam/myriad-mayo\\_slides\\_20140319.pdf](http://www.uspto.gov/patents/law/exam/myriad-mayo_slides_20140319.pdf).

# Calendar

Suggestions for events to be included in this section may be sent to [ptcj@bna.com](mailto:ptcj@bna.com).

**June-October, 2014.** EIA, Inventors Challenge for 2014, Go From Concept to Licensing in 30 Days, Workshops. The Edison and Ford Winter Estates Museum, Fort Myers, Fl.

Sponsored by the Edison Inventors Association Inc. For further information, e-mail [edisoninventors@gmail.com](mailto:edisoninventors@gmail.com), [pdavis@portablefarms.com](mailto:pdavis@portablefarms.com), or go to <http://edisoninventors.org>.

**June 2014.** Medical Devices Summit West: Reducing Risk and Increasing Return Through Cutting Edge Business Strategy and Technological Innovation, including Sessions, "Increasing Value by Rethinking Patent Filing Strategies in the Wake of the New First-Inventor-to-File System; and Procuring and Enforcing Patents in the U.S. and Internationally, Current and Future Considerations." San Francisco.

Sponsored by Opal Events, 10 East 38th St., New York, N.Y. Telephone: (212) 532-9898. For further information go to <http://www.opalevents.org>.

**June 20, 2014.** BPA Annual Judges Dinner in Honor of the Federal Judiciary. Aboard the Odyssey Harbor Cruise, Boston, Mass.

Sponsored by the Boston Patent Law Association, founded 1924. For further information call 617-507-5570, go to [president-elect@bpla.org](mailto:president-elect@bpla.org), <http://www.bpla.org>.

**June 22, 2014.** ACPC Summer Meeting. Chicago, Ill.

Sponsored by the Association of Corporate Patent Counsel. For further information go to [info@acpcnet.org](mailto:info@acpcnet.org), <http://www.acpcnet.org>.

**June 22, 2014.** AIPLA Trademark Boot Camp 2014. Westin Alexandria Old Town, Alexandria, Va.

Sponsored by the American Intellectual Property Law Association. For further information go to [www.aipla.org](http://www.aipla.org).

**June 22-26, 2014.** BIO 2014 International Convention. San Diego, Calif.

Sponsored by the BIO International Convention & the Biotechnology Industry Organization, Washington, D.C. Former Secretary of State Hillary Rodham Clinton Delivers the Keynote Address, Wed., June 25, Noon. Breakout Sessions and Specialty Forums, include, but are not limited to, "Intellectual Property: View from Director General Francis Gurry, World Intellectual Property Organization; Pursuing Biotechnology Patent Protection in the U.S. and Latin America; Patent Eligibility From the Trenches: Practical Implications of the Supreme Court's 'Prometheus' and 'Myriad' Decisions;

Navigating Patent Challenges Under the America Invents Act." For further information, call 202-962-6655, go to [convention@bio.org](mailto:convention@bio.org), <http://convention.bio.org>.

**June 25, 2014.** USPTO Roundtable on Copyright Internet Policy Topics. Cambridge, Mass.

Sponsored by the Department of Commerce Internet Policy Task Force: Copyright Policy, Creativity, and Innovation in the Digital Economy, and U.S. Patent and Trademark Office. Alexandria, Va. For further information call, 571-272-9300, email [Ann.Chaitovitz@uspto.gov](mailto:Ann.Chaitovitz@uspto.gov), Benjamin.Golant@uspto.gov, or go to <https://www.signup4.net/Public>, or <http://www.uspto.gov/news>.

**July 8, 2014.** Pitfalls in Trademark Prosecution. The Cincinnati Hotel, Cincinnati, Ohio.

Sponsored by the Cincinnati Intellectual Property Law Association: Featuring Mary Denison, USPTO Deputy Commissioner for Trademark Operations. For further information go to [secretary@cincyip.org](mailto:secretary@cincyip.org), or <http://www.cincyip.org>.

**July 9-11, 2014.** PLI Fundamentals of Patent Prosecution Seminar 2014: A Boot Camp for Claim Drafting and Amendment Writing. San Francisco, Calif.

Sponsored by the Practising Law Institute. San Francisco, Calif., and New York, N.Y. For further information go to [info@pli.edu](mailto:info@pli.edu), or <http://www.pli.edu>.

**July 17, 2014.** NYIPLA Hot Topics in Trademarks CLE Seminar. The Princeton Club, New York, N.Y.

Sponsored by the New York Intellectual Property Law Association. For further information go to [admin@nyipla.org](mailto:admin@nyipla.org), <http://www.nyipla.org>.

**July 17-19, 2014.** ICLE Intellectual Property Law Summer Institute: Solutions to Complex IP Law Issues, including "Extracting Maximum Benefit from the AIA," "Termination Tango," "Administrative Challenges in Patent Applications," "Around the Digital World of Brands in 60 Minutes," Plus a Relaxing CLE Getaway. Grand Hotel, Mackinac Island, Mich.

Sponsored by The Institute of Continuing Legal Education and The Intellectual Property Law Section, State Bar of Michigan. For further information, call 877-229-4350, go to [www.icle.org/ip](http://www.icle.org/ip).

**July 21, 2014.** AIPLA Patent Cooperation Treaty Seminar. Denver, Colo.

Sponsored by the American Intellectual Property Law Association. Washington, D.C. For further information email [aipla@aipla.org](mailto:aipla@aipla.org), or go to <http://www.aipla.org>.

**July 24-25, 2014.** AIPLA Patent Cooperation Treaty Seminar. Arlington, Va.

Sponsored by the American Intellectual Property Law Association. Washington, D.C. For further information email [aipia@aipia.org](mailto:aipia@aipia.org), or go to <http://www.aipia.org>.

**July 29, 2014.** USPTO Roundtable on Copyright Internet Policy Topics. Los Angeles, Calif.

Sponsored by the Department of Commerce Internet Policy Task Force: Copyright Policy, Creativity, and Innovation in the Digital Economy, and U.S. Patent and Trademark Office. Alexandria, Va. For further information call, 571-272-9300, email [Ann.Chaitovitz@uspto.gov](mailto:Ann.Chaitovitz@uspto.gov), [Benjamin.Golant@uspto.gov](mailto:Benjamin.Golant@uspto.gov), or go to <https://www.signup4.net/Public>, or <http://www.uspto.gov/news>.

**July 30, 2014.** USPTO Roundtable on Copyright Internet Policy Topics. Berkeley, Calif.

Sponsored by the Department of Commerce Internet Policy Task Force: Copyright Policy, Creativity, and Innovation in the Digital Economy, and U.S. Patent and Trademark Office. Alexandria, Va. For further information call, 571-272-9300, email [Ann.Chaitovitz@uspto.gov](mailto:Ann.Chaitovitz@uspto.gov), [Benjamin.Golant@uspto.gov](mailto:Benjamin.Golant@uspto.gov), or go to <https://www.signup4.net/Public>, or <http://www.uspto.gov/news>.

**August 7-8, 2014.** AIPLA Practical Patent Prosecution Training for New Lawyers. Arlington, Va.

Sponsored by the American Intellectual Property Law Association. Washington, D.C. For further information email [aipia@aipia.org](mailto:aipia@aipia.org), or go to <http://www.aipia.org>.

**August 7-12, 2014.** ABA Annual Meeting. Boston, Mass.

Sponsored by the American Bar Association. For further information go to [http://www.americanbar.org/calendar/annual/future\\_past\\_meetings.html](http://www.americanbar.org/calendar/annual/future_past_meetings.html).

**August 7-10, 2014.** ABA Annual Meeting: IPCentral. Boston Marriott Copley Place Hotel, Boston, Mass.

Sponsored by the American Bar Association. For further information go to [http://www.americanbar.org/groups/intellectual\\_property\\_law/events\\_cle.html](http://www.americanbar.org/groups/intellectual_property_law/events_cle.html).

**August 13-15, 2014.** Patent Law Seminar. Seattle, Wash.

Sponsored by Chisum Patent Academy. Telephone: 855-324-4786. For further information go to [info@chisum.com](mailto:info@chisum.com), <http://www.chisum-patent-academy.com>.

**August 18-20, 2014.** Patent Law Seminar. Seattle, Wash.

Sponsored by Chisum Patent Academy. Telephone: 855-324-4786. For further information go to [info@chisum.com](mailto:info@chisum.com), <http://www.chisum-patent-academy.com>.

**Sept. 7-9, 2014.** IPO Annual Meeting. Vancouver Convention Center, British Columbia, Canada.

Sponsored by the Intellectual Property Owners Association. Telephone: 202-507-4500, Fax: 202-507-4501. For further information go to [meetings@ipo.org](mailto:meetings@ipo.org), <http://www.ipo.org/AM2014>.

**Sept. 14-18, 2014.** AIPPI 44th World Intellectual Property Congress. Toronto, Canada.

Sponsored by the International Association for the Protection of Intellectual Property. For further information go to [mail@aippi.org](mailto:mail@aippi.org), <https://www.aippi.org>.

**Sept. 18-19, 2014.** Trademarks and the New Internet. JW Marriott Hotel, San Francisco, California.

Sponsored by the International Trademark Association. For further information go to [meetings@inta.org](mailto:meetings@inta.org), <http://www.inta.org>.

**Sept. 23-26, 2014.** MARQUES 28th Annual Conference, "Traditional Brands in a Digital Market." Tivoli Hotel, Copenhagen, Denmark.

Sponsored by MARQUES. For further information go to <https://www.facebook.com/marques.ip>, <http://www.marques.org/conferences>.

**Sept. 28-30, 2014.** AIPF 2014 Annual Meeting: IP Boutiques at the Crossroads of Legal Expertise and Client Value. Washington Plaza Hotel, Washington, D.C.

Sponsored by the Association of Intellectual Property Firms, Fort Lee, New Jersey. For further information go to [admin@aipf.com](mailto:admin@aipf.com), [www.aipf.com](http://www.aipf.com).

**Oct. 5-8, 2014.** LES 2014 Annual Meeting. San Francisco, Calif.

Sponsored by the Licensing Executives Society, USA and Canada, 1800 Diagonal Road, Suite 280, Alexandria, Va. 22314. Telephone: 703-836-3106, Fax: 703-836-3107. For further information go to [meetings@les.org](mailto:meetings@les.org), <http://www.lesusacanada.org/meetings>.

**Oct. 12-15, 2014.** Trademark Administrators and Practitioners Meeting. Hyatt Regency Hotel, Arlington, Va.

Sponsored by the International Trademark Association. New York City, New York. For further information go to [meetings@inta.org](mailto:meetings@inta.org), <http://www.inta.org/TMA/Pages/TMAPMeeting.aspx>.

**Oct. 17-18, 2014.** USPTO National Trademark Expo: Free and Open to the Public. USPTO Headquarters, Alexandria, Va.

Sponsored by the United States Patent and Trademark Office. "Designed to educate the public about trademarks and their importance in the global marketplace. . . . In addition, Expo features [at least 12] seminars and children's workshops and activities." For further information, call 571-272-9179, -9342, -9226, go to [TME expo@uspto.gov](mailto:TME expo@uspto.gov), <http://www.uspto.gov/trademarks>.

**Oct. 21-25, 2014.** ABA Section of International Law 2014 Fall Meeting, in Cooperation with ABA Section of Intellectual Property Law. Hilton, Buenos Aires, Argentina.

Sponsored by ABA Sections of International Law and Intellectual Property Law. For further information, call 800-285-2221, for Press Credentializing, contact [abanews@americanbar.org](mailto:abanews@americanbar.org); go to <http://shop.americanbar.org>, [http://www.americanbar.org/groups/intellectual\\_property\\_law](http://www.americanbar.org/groups/intellectual_property_law).

**Oct. 22, 2014.** AIPLA Partnering in Patents. Alexandria, Va.

Sponsored by the American Intellectual Property Law Association. Washington, D.C. For further information email [aipla@aipla.org](mailto:aipla@aipla.org), or go to <http://www.aipla.org>.

**Oct. 22-24, 2014.** IACC Fall 2014 Conference. Waldorf Astoria Orlando, Orlando, Fl.

Sponsored by the International Anti-Counterfeiting Coalition. Washington, D.C. For further information, call 202-223-6667, or go to [IACC@iacc.org](mailto:IACC@iacc.org), <http://www.iacc.org>.

**Oct. 23-25, 2014.** AIPLA Annual Meeting. Washington, D.C.

Sponsored by the American Intellectual Property Law Association, 241 18th St. South, Suite 700, Arlington, Va. 22202. Telephone: (703) 415-0780, fax: (703) 415-0786. For further information go to <http://www.aipla.org>.

**Nov. 4-6, 2014.** EPO Patent Information Conference. Warsaw, Poland.

Sponsored by the European Patent Office and the Polish Patent Office. For further information go to <http://www.epo.org>.

**Nov. 4-7, 2014.** The Sedona Conference "All Voices" Meeting, "including plenary sessions addressing cutting edge issues in litigation and intellectual property rights." Roosevelt New Orleans Hotel, New Orleans, La.

Sponsored by The Sedona Conference. Phoenix, Arizona. For further information go to [info@sedonaconference.org](mailto:info@sedonaconference.org), <https://thesedonaconference.org>.

**Nov. 5-7, 2014.** FICPI 15th Open Forum. Barcelona, Spain.

Sponsored by the International Federation of Intellectual Property Attorneys. For further information go to [contact@ficpi.org](mailto:contact@ficpi.org), <http://www.ficpi.org>.

**Nov. 20, 2014.** NYIPLA One-Day Patent CLE Seminar. The Princeton Club, New York, N.Y.

Sponsored by the New York Intellectual Property Law Association. For further information go to [admin@nyipla.org](mailto:admin@nyipla.org), <http://www.nyipla.org>.

**Dec. 4-5, 2014.** IP Summit 2014, Patents, Trademarks, Copyright. Brussels.

Sponsored by the Paneuropean Intellectual Property Summit, and Researched and Produced by Premiere Cercle. For further information go to [ipsummit@premiercercle.com](mailto:ipsummit@premiercercle.com), <http://www.premiercercle.com>.

**Dec. 8-9, 2014.** When Trademarks Overlap With Other IP Rights. Westin Grand Hotel, Munich, Germany.

Sponsored by the International Trademark Association. New York City, New York. For further information go to [meetings@inta.org](mailto:meetings@inta.org), <http://www.inta.org>.

**Dec. 9, 2014.** IPO Board Meeting. Hotel Monaco, Washington, D.C., and IPO Education Foundation Annual Awards Dinner, Smithsonian American Art Museum and National Portrait Gallery, Washington, D.C.

Sponsored by the Intellectual Property Owners Association, and IPO Education Foundation, Telephone: 202-507-4500, Fax: 202-507-4501. For further information go to Robin Muthig [rmuthig@ipo.org](mailto:rmuthig@ipo.org), <http://www.ipo.org>.

**April 29-May 1, 2015.** IACC 2015 Annual Spring Conference. Manchester Grand Hyatt, San Diego, Calif.

Sponsored by the International AntiCounterfeiting Coalition. Washington, D.C. For further information, call 202-223-6667, go to [IACC@iacc.org](mailto:IACC@iacc.org), <http://www.iacc.org>, <http://www.inta.org>.





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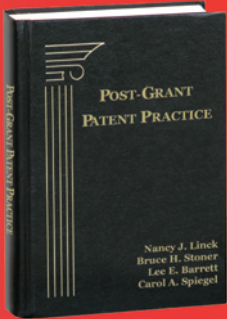
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By **Nancy J. Linck; Bruce H. Stoner, Jr.; Lee E. Barrett; and Carol A. Spiegel**

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**Post-Grant Patent Practice**, written by four former Administrative Patent Judges of the United States Patent and Trademark Office (USPTO), is an invaluable reference that provides guidance to patent professionals regarding all USPTO post-issuance procedures that are designed to address possible mistakes made during the prosecution of a patent application, including mistakes made by the USPTO. This new treatise from Bloomberg BNA marks a turning point between the ebb of the first-to-invent system and the flow of the “first-inventor-to-file” system, capturing the full nuance of the still-persisting “patent interference” practice before the USPTO and the now-superseded “*inter partes* reexamination.”

Post-grant practice has expanded significantly due to the availability of *inter partes* proceedings, particularly those introduced by the America Invents Act (AIA). **Post-Grant Patent Practice** analyzes the procedures introduced by the AIA beginning September 16, 2012, both in text and in charts, explaining them from pre-filing considerations through appeal to the U.S. Court of Appeals for the Federal Circuit, or, alternatively, to a district court and then the Federal Circuit. Analyzed procedures consist of *inter partes* and post-grant review, including the transitional program for covered business method patents; supplemental examination; and derivation practice.

The treatise also examines many other important procedures, including reissue, *ex parte* and *inter partes* reexamination, disclaimers, certificates of correction, and interference practice.

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## About the Authors

**Nancy J. Linck** formerly served as the Solicitor for the USPTO and as an Administrative Patent Judge on the Board of Patent Appeals and Interferences of the USPTO, currently the Patent Trial and Appeal Board. Judge Linck is now with the intellectual property law firm of Rothwell, Figg, Ernst & Manbeck in Washington, DC, where she focuses on post-grant practice before the Office and is a member of the firm's USPTO Trial Practice Group.

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**Lee E. Barrett** served as an Administrative Patent Judge on the Board of Patent Appeals and Interferences of the USPTO until he retired after 32 years of federal service. Judge Barrett is presently Of Counsel and a member of the Post-Grant Practice Group at Oblon, Spivak, McClelland, Maier & Neustandt, L.L.P.

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