U.S. IP Updates (2020)

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Overview

1. COVID-19 Outbreak Relief to Patent Applicants
2. Trademark Modernization Act (H.R. 6196/S. 3449)
3. *Arthrex, Inc. v. Smith & Nephew, Inc.*, (Fed. Cir. 2019)
4. *United States PTO v. Booking.com B.V.*, (U.S. 2020)

1. COVID-19 Outbreak Relief Relating to Restoring the Right of Priority or Benefit to Patent Applicants

Announced June 12, 2020

1. Non-provisional seeking priority to a prior foreign application or U.S. provisional application, for which the 12-month period (or 6 months for design) ends between **March 27** and **July 30, 2020,** USPTO will:
    1) Extend the two-month grace period to the later of: a) July 31, 2020; or b) the original expiration date of such two-month grace period; and
    2) waive the petition fee.
2. PCT application seeking priority to a prior patent application, for which the 12-month period ends between **March 27** and **July 30, 2020**, USPTO will waive the petition fee provided that such application is filed within the two-month grace period.

In both cases, the application seeking priority must be accompanied by 1) a petition requesting the deadline to be extended and 2) a statement that the failure to timely file the application was due to COVID-19 outbreak.

2. Trademark Modernization Act (H.R. 6196/S. 3449)

- March 11, 2020, introduced to the House and Senate.
- Provides streamlined proceedings against fraudulent trademark filings due to "non-use."

1) Pending applications - Letter of protest with evidence
2) Registered Marks - *ex parte* procedures
   a) 3rd party expungement – after 3 years of reg.
   b) 3rd party re-examination – within 5 years of reg.
   c) Director may initiate on his own
3) "Irreparable harm" presumption for obtaining injunctive relief

3. *Arthrex, Inc. v. Smith & Nephew, Inc.*, (Fed. Cir. 2019)

Decided by CAFC on October 31, 2019

1) Administrative patent judges (APJs) are *de fecto* principal officers and therefore must be appointed by the U.S. President and confirmed by the Senate;
2) Because they are not, the current structure of the Board violates the Appointments Clause of the U.S. Constitution;
3) The application of 5 U.S.C.S. § 7513's removal protections is unconstitutional and must be severed.

Aftershocks

1) Over 100 decisions vacated and remanded;
2) March 23, 2020, CAFC denied petitions for rehearing *en banc;*
3) Currently petitioned the Supreme Court for *certiorari.*

4. *United States PTO v. Booking.com B.V.*, (U.S. 2020)

1. Strength of Marks
    1) Fanciful (KODAK, Exxon)
    2) Arbitrary (Apple, Camel)
    3) Suggestive (Microsoft, Netflix)
    4) Descriptive (American Airlines, SHARP)
    5) Generic (Watch, Belt)
2. Generic marks can never be trademarks.
3. PTO's "nearly *per se* rule"

    Whenever a generic term is combined with a generic top-level domain like ".com," the resulting combination must also be generic.

4. *United States PTO v. Booking.com B.V.*, (U.S. 2020) - Continued

June 30, 2020, SCOTUS held that adding ".com" to a generic term can create a protectable trademark:

1) A "generic" term names a "class" of goods or services, not any particular feature of the class;
2) For a compound term, the distinctiveness inquiry trains on the term's meaning as a whole, not its parts in isolation;
3) The relevant meaning of a term is its meaning to consumers;
4) Evidence can include consumer surveys, dictionaries, usage by consumers and competitors, and any other source of evidence.

Takeaways

1. USPTO has provided relief to patent applicants for restoring priority rights affected by the COVID-19 outbreak.
2. Trademark Modernization Act provides streamlined proceedings against fraudulent trademark filings due to “non-use.
3. *Arthrex* - APJs are now at-will employees and the ball is in Supreme Court’s court.
4. *Booking.com* - Adding ".com" to a generic term can create a protectable trademark – consumer’s perception is the key and various types of evidence are now admissible.

Questions?

问题？

THANK YOU!

感谢您的参与!

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