



2019 SUMMER NEWSLETTER

TABLE OF CONTENTS

SUPREME COURT

1. *Mission Product Holdings, Inc. v. Tempnology, LLC* – Trademark license survives licensor's breach in bankruptcy court
2. *Return Mail, Inc v. United States Postal Service* – The U.S. Government cannot participate in AIA USPTO post-grant procedures
3. *Iancu v. Brunetti* – Ban on scandalous trademarks found unconstitutional

FEDERAL CIRCUIT

1. *Forum US, Inc. v. Flow Valve, LLC* – Original patent must clearly support broadening patent reissue claims
2. *Gold Value International Textile, Inc v. Sanctuary Clothing, LLC* – Knowingly submitting inaccurate information in a U.S. copyright application may invalidate registration
3. *Automotive Body Parts Association v. Ford Global Technologies, LLC* – Protecting product parts with U.S. design patents

PATENT NEWS & TRENDS

1. Congress Taking Action to Reform 35 U.S.C. § 101
2. UPDATE: PTAB Reversals Under USPTO 2019 § 101 Revised Guidance
3. The USPTO's Expanded Collaborative Search Pilot ("CSP") Program
4. 2018's Top PCT Applicants

FIRM NEWS

1. European Union's General Data Protection Regulation
1. Summer in Washington, D.C.
2. Historic Patent: The Statue of Liberty



1201 NEW YORK AVENUE, N.W.
WASHINGTON, D.C.

SUPREME COURT***Mission Product Holdings, Inc. v. Tempnology LLC***

Following up on our Winter 2019 Newsletter, on May 20, 2019, the Supreme Court reversed the U.S. Court of Appeals for the First Circuit's decision in *Mission Product Holdings, Inc. v. Tempnology, LLC*, holding that a licensor's rejection of a trademark license in bankruptcy constitutes a breach, but does not terminate the license under § 365 of the Bankruptcy Code ("§ 365").

Consistent with its precedent, the Supreme Court first analyzed the text of § 365. In doing so, the Supreme Court noted that § 365(g) makes clear that a "rejection" in bankruptcy law is the equivalent of a "breach of an executory contract" in contract law. Since the Bankruptcy Code did not provide a definition of the term "breach," the Supreme Court relied on § 365(g) to apply the generic contract law definition. Accordingly, the Supreme Court stated that in an executory contract under contract law, the executor gives continuing rights which cannot be unilaterally revoked. In other words, a breach in contract gives the non-breaching party the choice to terminate or continue the agreement.

Applying its findings of contract law to § 365 as a whole, the Supreme Court reasoned if a licensor breaches a trademark license, the breach does not revoke the license. Rather, the licensee has the option to continue performing its remaining obligations or to terminate the license. The Supreme Court further noted that maintaining the license after the licensor's rejection is consistent with the Bankruptcy Code's general goal to prevent licensors from undermining the bankruptcy process.

The Supreme Court next turned to Tempnology's argument that the unique features of trademark law require termination of the trademark license when a licensor breaches the contract due to bankruptcy. For example, Tempnology relied on the trademark licensor's duty to monitor and "exercise quality control over the goods and services sold" under a license. Therefore, Tempnology argued that unless rejection of a trademark licensing agreement terminates the licensee's rights to use the mark, the debtor will have to choose between expending limited resources on quality control and risking the loss of a valuable asset.

In response, the Supreme Court first observed that Tempnology's trademark-specific construction was at odds with its reading of § 365. Specifically, Tempnology's reading of § 365 required treating "trademark agreements identically to most other contracts." Nonetheless, the Supreme Court noted § 365 was a general provision directed to all executory contracts, but Tempnology's argument was trademark-specific. Further, the Supreme Court pointed out that § 365 did not even mention trademarks. Therefore, the Supreme Court found that a trademark-specific construction of § 365 was inappropriate.

Thus, the Supreme Court found that under § 365, a licensor's rejection of an executory contract in bankruptcy has the same effect as a breach outside bankruptcy. Accordingly, the Supreme Court held that a licensor's rejection under § 365 cannot revoke the trademark license previously granted.

SUPREME COURT

Return Mail, Inc. v. United States Postal Service

Following up on our Winter 2019 Newsletter, on June 10, 2019, the Supreme Court reversed the U.S. Court of Appeals for the Federal Circuit's decision in *Return Mail, Inc. v. United States Postal Service*, holding the U.S. Government is not a "person" capable of instituting AIA USPTO review proceedings – inter partes reviews, covered business method reviews, and post-grant reviews.

With Justice Sotomayor delivering the majority opinion for this case, the Supreme Court first noted the AIA did not define the term "person." In the absence of a definition, the Supreme Court applied the longstanding interpretative presumption that the term "person" does not include the Government and its agencies. Further, the Supreme Court recognized the Dictionary Act's definition of the term "person" did not include the Government. However, the Supreme Court noted the definition could be superseded by the statutory context of the AIA review proceedings.

Subsequently, the Supreme Court discussed the United States Postal Service's ("Postal Service") arguments that the AIA's reference to a "person" includes the Government in the context of AIA review proceedings because: (1) several patent statutes include the Government as a "person," (2) federal agencies have previously been allowed to participate in the patent system, and (3) the Government is subject to liability for infringement.

First, the Supreme Court explained the Postal Service's primary argument failed because the patent statutes did not consistently include the Government as a "person." Moreover, the Supreme Court noted the several patent statutes which included the Government as a "person," had no bearing on AIA review proceedings. Therefore, contrary to the Postal Service's argument, the Supreme Court did not find that the mere existence of some Government-inclusive references were sufficient to overcome the longstanding presumption that Congress did not intend to include the Government as a person.

With respect to the Postal Service's second argument, the Supreme Court reasoned that Government involvement in the patent system in the past "[did] not speak to whether Congress meant for the Government to participate as a third-party challenger in AIA review proceedings." Additionally, the Supreme Court explained there was no "settled" meaning of the term "person" with respect to the newly established AIA review proceedings. Accordingly, the definition of a "person" in prior patent statutes could not be incorporated into the new AIA review proceedings.

Lastly, the Supreme Court determined the Postal Service's third argument was unpersuasive due to procedural and monetary restrictions placed on patent owners who sue the Government for infringement. For example, a patent owner who sues the Government for infringement cannot seek an injunction, demand a jury trial, or ask for punitive damages. Therefore, the Supreme Court concluded it was reasonable for Congress to treat the Government differently.

SUPREME COURT***Return Mail, Inc. v. United States Postal Service (cont'd.)***

In addition, the Supreme Court determined excluding federal agencies from the AIA review proceedings avoids the awkward situation that might result from forcing a civilian patent owner to defend its patent in an adversarial, adjudicatory proceeding initiated by one federal agency (such as the Postal Service) and overseen by a different federal agency (the USPTO).

Accordingly, the Supreme Court found the Government was not a “person” capable of instituting AIA review proceedings. Thus, patent owners may have an advantage when suing a government agency for patent infringement in the early stages of litigation.



SUPREME COURT

Iancu v. Brunetti

Following up on our Winter 2019 Newsletter, on March 4, 2019, the U.S. Supreme Court affirmed the U.S. Court of Appeals for the Federal Circuit's ("Federal Circuit") holding in *Iancu v. Brunetti*. Accordingly, the Supreme Court held that the portion of § 2(a) of the Lanham Act ("§ 2(a)") which bars the federal registration of "immoral" or "scandalous" trademarks ("the scandalous bar"), is a violation of the First Amendment's free speech clause.

In its opinion, the Supreme Court first noted its decision in *Matal v. Tam* ("*Matal*") where it held the Lanham Act's bar on the registration of "disparaging" trademarks ("the disparagement bar") unconstitutional. In *Matal*, the Supreme Court explained that if a trademark registration bar is viewpoint-based, it is unconstitutional. The Supreme Court reasoned the disparagement bar allowed a trademark owner to register a mark if it was positive about a person, but not if it was demeaning. Accordingly, the Supreme Court held the disparagement bar was viewpoint-based, and therefore, unconstitutional.

Subsequently, the Supreme Court turned to the plain meanings of "immoral" and "scandalous" to determine if the scandalous bar was viewpoint-based. Upon analyzing the dictionary definitions of "scandalous" and "immoral," the Supreme Court found that the scandalous bar "distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them." Therefore, the Supreme Court found the scandalous bar, like the disparagement bar, was unconstitutional for being viewpoint-based.

To further support its conclusion, the Supreme Court noted several instances where some trademarks were granted federal registration but others were not, despite containing similar subject matter. For example, when determining whether a trademark relating to drugs was subject to federal registration, the U.S. Patent and Trademark Office ("USPTO") denied federal registrations for "YOU CAN'T SPELL HEALTHCARE WITHOUT THC" for pain-relief medication, and "MARIJUANA COLA" and "KO KANE" for beverages because they inappropriately glamorized drug abuse. However, the USPTO granted federal registration to "SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE." Despite understanding why the USPTO rejected certain "immoral" or "scandalous" marks, the Supreme Court concluded the USPTO was, nonetheless, discriminating based on viewpoint.

Lastly, the Supreme Court rejected the USPTO's argument that the scandalous bar is constitutional because it only prohibits marks that are "vulgar" – meaning lewd, sexually explicit, or profane – which cannot be discriminated against based on viewpoint. The Supreme Court noted that while it may interpret ambiguous statutory language to avoid an unconstitutional reading, the language of §2(a)'s scandalous bar was plain and unambiguous, and not limited to "vulgar" marks. Therefore, the Supreme Court reasoned that Congress clearly enacted §2(a)'s scandalous bar with the intent to encompass subject matter that is subject to viewpoint-based discrimination.

SUPREME COURT

lanu v. Brunetti (cont'd.)

Accordingly, the Supreme Court held the “scandalous” trademark statutory provision was a violation of the First Amendment’s free speech clause. While this decisions permits the federal registration of previously prohibited marks, trademark applicants are still required to satisfy all other trademark requirements (i.e., use in commerce, and distinctiveness).



FEDERAL CIRCUIT

Forum US, Inc. v. Flow Valve, LLC

On June 17, 2019, the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) decided *Forum US, Inc. v. Flow Valve, LLC*. In doing so, the Federal Circuit held that the claimed invention of a broadening reissue application must be clearly and unequivocally disclosed in the original U.S. patent.

Briefly, Flow Valve, LLC (“Flow Valve”) owned U.S. Patent No. RE45,878 (“the Reissue Patent”), a broadening reissue patent of U.S. Patent No. 8,215,213 (“the ‘213 patent”), which was directed to supporting assemblies for holding workpieces during machining. The ‘213 patent provided that the “workpieces” were machined pipe fittings supported by multiple axles. During prosecution of the Reissue Patent, the claims were broadened to include embodiments that did not use axels to support the workpieces, yet the written description remained the same.

On April 28, 2017, Forum US, Inc. (“Forum”) filed a declaratory judgment action seeking a declaration of invalidity of the Reissue Patent on the basis that the added reissue claims did not comply with the original patent requirement under 35 U.S.C. § 251. In response, Flow Valve contended that a person of ordinary skill in the art would understand that the original patent disclosed the multiple inventions claimed in the Reissue Patent. The district court found in favor of Forum on the basis that the written description of the original patent did not “explicitly and unequivocally” support the reissued claims. Flow Valve appealed to the Federal Circuit.

On appeal, Flow Valve did not dispute that the ‘213 patent failed to explicitly disclose the claimed invention of the Reissue Patent. Instead, it maintained that a person of ordinary skill in the art would understand from the patent specification that the axels were an optional feature of the disclosed invention. In support of its argument, Flow Valve relied on an expert declaration stating that a worker of ordinary skill would understand that not every embodiment of the ‘213 patent required axels.

In response, the Federal Circuit began its analysis with the language of 35 U.S.C. § 251 (“§ 251”). The Federal Circuit focused on the portion of § 251 which states that the USPTO may “reissue the patent for the *invention disclosed in the original patent.*” Further, the Federal Circuit took note of the well settled principle that for broadening reissue claims, “it must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original [patent].” Accordingly, the Federal Circuit determined that the original patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.”

FEDERAL CIRCUIT

Forum US, Inc. v. Flow Valve, LLC (cont'd.)

The Federal Circuit emphasized that the essential inquiry under § 251 is whether one skilled in the art, reading the patent specification, would *identify* subject matter of the new claims as invented and disclosed by the patentee. In other words, whether a person of ordinary skill in the art would simply understand the newly claimed invention could be possible is insufficient to comply with the disclosure requirement set forth in § 251. Therefore, the Federal Circuit found Flow Valve's expert declaration unpersuasive because it did not identify where the '213 patent disclosed an axel-less embodiment.

Turning to the '213 patent, the Federal Circuit did not find support for the axel-less embodiment. Moreover, the Federal Circuit stated "the boilerplate language that modifications can be made to the original disclosed invention does not even suggest an [axel-less] embodiment of the disclosed [reissue] invention." Thus, the Federal Circuit concluded that the written description of the '213 patent failed to "clearly and unequivocally" disclose the axel-less embodiment.

In conclusion, the Federal Circuit upheld the principle that a claimed invention of a broadening reissue patent must be "clearly and unequivocally" disclosed in the original patent. Further, it is important to note the Federal Circuit's conclusion that boilerplate language stating modifications can be made to a claimed invention, is insufficient to support a specific non-disclosed embodiment.



FEDERAL CIRCUIT

Gold Value International Textile, Inc. v. Sanctuary Clothing, LLC

On June 4, 2019, the U.S. Court of Appeals for the Ninth Circuit (“Ninth Circuit”) decided *Gold Value International Textile, Inc. v. Sanctuary Clothing, LLC*, holding filing inaccurate information in a U.S. copyright application may invalidate the U.S. copyright registration.

On October 24, 2013, Gold Value International Textile, Inc., doing business as Fiesta Fabric (“Fiesta”), received U.S. Copyright Registration No. VAu 1-151-509 (“the ‘509 Registration”) for several designs, including a two-dimensional textile design entitled 1461-43 (“1461 Design”). Prior to the registration, Fiesta sold approximately 190 yards of fabric samples which showcased the 1461 Design. However, during the U.S. copyright registration procurement procedure, Fiesta’s president certified that none of the designs covered by the ‘509 Registration’s application had been published prior to the October 24, 2013 filing date. Interestingly, Fiesta filed an additional U.S. copyright application specifically for the 1461 Design, certifying the design was published on March 12, 2013.

In 2016, Fiesta brought suit for federal copyright infringement of the ‘509 Registration against Sanctuary Clothing, LLC (“Sanctuary”) in the U.S. District Court for the Central District of California (“district court”). During trial, the district court received information from the U.S. Copyright Office stating “had the [it] been aware that the 1461 Design had been previously published, the [Copyright] Office would have refused registration of that work using the unpublished collections option because the work was registered as unpublished when in fact it had been published.” Accordingly, the district court granted Sanctuary’s motion to dismiss, declaring Fiesta’s ‘509 Registration invalid. Fiesta subsequently appealed.

On appeal to the Ninth Circuit, Fiesta argued that its ‘509 Registration did not contain inaccurate information. Predominantly, Fiesta argued that the 1461 Design has not been published because it was a “limited” distribution for promotional activities and did not constitute publication as defined by law. In response, the Ninth Circuit first identified Fiesta’s second copyright registration for the 1461 Design which certified the design was published on March 12, 2013. Thus, the Ninth Circuit found Fiesta admitted that the 1461 Design was published. Yet, the Ninth Circuit continued its analysis and noted that a publication is “limited” when reproduction, redistribution, and reselling is prohibited. Finding Fiesta could not demonstrate that it distributed the 1461 Design without prohibiting further reproduction, distribution, or sale, the Ninth Circuit determined Fiesta published the 1461 Design. Therefore, the Ninth Circuit concluded the ‘509 Registration contained inaccurate information.

FEDERAL CIRCUIT

***Gold Value International Textile, Inc. v. Sanctuary Clothing, LLC
(cont'd.)***

Fiesta next argued that it did not “knowingly” submit inaccurate information because it did not know its sale of the 1461 Design constituted a publication. Therefore, Fiesta contended it did not have requisite knowledge or fraudulent intent. The Ninth Circuit noted that after Congress passed the “PRO IP Act” in 2008, a U.S. copyright application was not invalid for containing inaccurate information, unless: (1) the inaccurate information was included on the application for copyright registration with knowledge that it was inaccurate, and (2) the inaccuracy of the information if known would have caused the register of copyrights to refuse registration.

Discussing the first prong, the Ninth Circuit explained the PRO IP Act did not required a showing of fraudulent intent; rather, that the copyright applicant simply included inaccurate information on the application “with knowledge that it was inaccurate.” Thus, the Ninth Circuit concluded that Fiesta’s assertion that it did not act with fraudulent intent was immaterial. Moreover, the Ninth Circuit recalled Fiesta’s second U.S. copyright registration of the 1461 Design as proof that Fiesta had knowledge it submitted inaccurate information in the ‘509 Registration. Fiesta was also aware that it had sold 190 yards of fabric featuring the 1461 Design prior to registration. In accord with the PRO IP Act, the Ninth Circuit determined Fiesta submitted inaccurate information in the ‘509 Registration with knowledge that it was inaccurate. Turning to the second prong, the Ninth Circuit quickly found the U.S. Copyright Office would have refused the registration had it known that the statements regarding the 1461 Design were inaccurate based on the Copyright Office’s statement in the district court proceedings.

Accordingly, the Ninth Circuit held that because a valid registration is required to maintain a copyright infringement suit, the district court did not err in concluding Fiesta’s ‘509 Registration was invalid. Therefore, copyright registrants should carefully examine their applications for inaccurate information.



FEDERAL CIRCUIT

Automotive Body Parts Association v. Ford Global Technologies, LLC

On July 23, 2019, the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) decided *Automotive Body Parts Association v. Ford Global Technologies, LLC*, affirming validity of Ford Global Technologies, LLC’s (“Ford”) U.S. design patents related to the Ford F-150 pickup truck hood and headlamp.

The Automotive Body Parts Association (“ABPA”) sued Ford in the U.S. District Court for the Eastern District of Michigan (“district court”) seeking a declaratory judgment of invalidity or unenforceability of Ford’s U.S. Patent No. D489,299 and U.S. Patent No. D501,685 (collectively, “the design patents”), directed to the ornamental design of a vehicle hood and vehicle head lamp, respectively. In district court, the ABPA argued that the design patents were invalid for being functional and unenforceable under the doctrine of patent exhaustion in the replacement components market. The district court granted summary judgment in favor of Ford. The ABPA timely appealed.

U.S. Patent May 4, 2004 Sheet 1 of 2 US D489,299 S

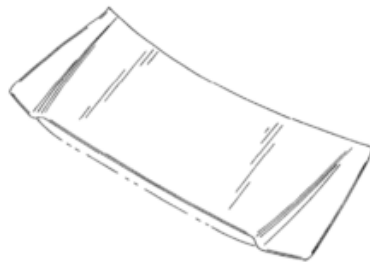


FIG. 1

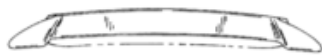


FIG. 2

U.S. Patent Feb. 8, 2005 Sheet 1 of 3 US D501,685 S

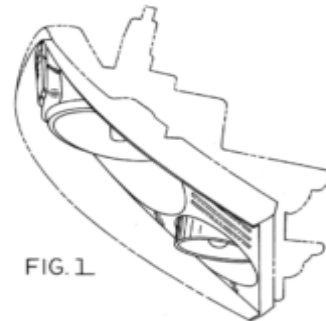


FIG. 1

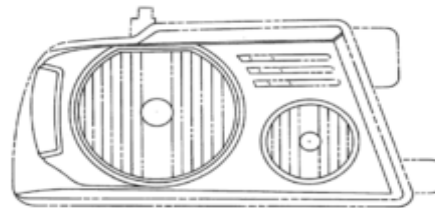


FIG. 2

FEDERAL CIRCUIT

***Automotive Body Parts Association v. Ford Global Technologies, LLC
(cont'd.)***

On appeal, the ABPA first argued that the design patents were functional and therefore invalid. According to Federal Circuit precedent, design patents must claim an “ornamental” design that is not primarily function. Simply, if a particular design is essential to use the article, then it cannot be the subject of a U.S. design patent. Therefore, the ABPA stated that the design patents are functional because they aesthetically match Ford’s F-150 truck. The Federal Circuit found the ABPA’s argument unpersuasive as it would run counter to the principles governing design patents. Specifically, the Federal Circuit stated, “[i]f customers prefer the ‘peculiar or distinctive appearance’ of Ford’s designs over that of other designs that perform the same mechanical or utilitarian functions, that is exactly the type of market advantage . . . contemplated by Congress in the laws authorizing design patents.”

Alternatively, the ABPA requested that the Federal Circuit should adopt the “aesthetic functionality” principle from trademark law, which prohibits a trademark from having any other significant function. Although the Federal Circuit acknowledged certain similarities between trademarks and design patents, it ultimately reasoned that trademarks and design patents served different purposes and were governed by different sets of laws. Therefore, the Federal Circuit, further noting no other court had applied the “aesthetic functionality” principle to design patents, declined to follow the ABPA’s request.

The ABPA next argued that the design patents were unenforceable under the doctrine of patent exhaustion. In response, the Federal Circuit noted that the doctrine applied to the components actually sold as part of the F-150 trucks, but not to the new replacement components sold by the ABPA member companies. The Federal Circuit determined the sale of the F-150 truck permits the purchaser to repair the designs as applied to the specific hood and headlamps sold on the truck; however, the purchaser may not create new hoods and headlamps using Ford’s patented designs.

Accordingly, the Federal Circuit affirmed the district court’s determination that the design patents were valid and enforceable. Therefore, potential design patent applicants should consider filing multiple individual design patents for specific designs of parts comprising the overall article of manufacture.

PATENT NEWS & TRENDS**Congress Taking Action to Reform 35 U.S.C. § 101**

On May 22, 2019, several members of the U.S. Senate and House of Representatives released proposed legislation that would reform patent subject matter eligibility under 35 U.S.C. § 101. The proposed legislation aims to provide the basis for a reformed 35 U.S.C. §101 which brings integrity, predictability, and stability to the U.S. patent system, while also preventing overly broad patents.

Although the proposed legislation is still in its early stages and subject to substantial changes, many believe Congress will sign a finalized bill into law before the end of the year. Specifically, Senator Tillis, one of the proposed legislation's authors, stated "I think we can review the record and make changes, garner consensus, and introduce a final bill sometime after the July 4 recess" in order to take it to the next legislative steps.

Currently, § 101 rejections are difficult to overcome, especially for software and computer claims. As of now, Congress seems to be drafting legislation that would make it easier for applicants to overcome § 101 rejections. For example, the proposed legislation incorporates a provision that § 101 must be construed in favor of eligibility. Further, the proposed legislation adds subsection (k) to 35 U.S.C. § 100 which states, "[t]he term "useful" means any invention or discovery that provides specific and practical utility in any field of technology through human intervention."

Critically, the proposed legislation abrogates all cases establishing or interpreting the judicially created exceptions to subject matter eligibility – abstract ideas, laws of nature, and natural phenomena. In doing so, the proposed legislation narrowly construes § 101 so that U.S. patent applications and patents previously thought to be directed to ineligible subject matter may now be allowable. Therefore, many believe this will help promote innovation, provide legal certainty, and overall welfare for consumers.

However, as noted above, this proposed legislation is still likely to change. In fact, Senator Tillis stated there was "more work to do." Nevertheless, the Senate hearings that took place on June 4, 5, and 11 showed strong support for changing current § 101 so that the scope of patent eligible subject matter is broadened. We will continue to monitor developments regarding the reform of § 101, and other relevant patent statutes.

PATENT NEWS & TRENDS

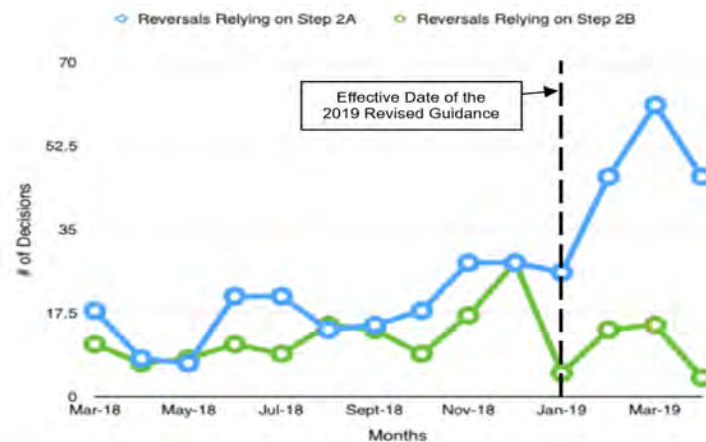
UPDATE: PTAB Reversals Under USPTO 2019 § 101 Revised Guidance

As discussed in our Spring 2019 Newsletter, on January 7, 2019, the U.S. Patent and Trademark Office’s (“USPTO”) revised guidance for patent subject matter eligibility under 35 U.S.C. § 101 took effect. As of March, 2019, the USPTO Patent Trial and Appeal Board (“PTAB”) has continued to use the revised guidance to reverse examiners’ § 101 rejections at unprecedented rates.

Briefly, the revised USPTO § 101 guidance added two additional steps to Step 2A of the two-step Alice/Mayo test for determining whether the claims are “directed to” any judicial exceptions. The new test under 2A is:

- 2A(1): evaluate whether the claim recites any judicial exception, or an abstract idea rooted in an abstract group (e.g. mathematical concepts, certain methods of organizing human activity, and mental processes); and
- 2A(2): evaluate whether the claim recites additional elements that integrate the judicial exception into a practical application.

According to a recent post from Anticipat Blog¹, the effect of the USPTO revised § 101 guidance can be clearly seen by the following graph:



As seen, more § 101 rejections were completely reversed at the earlier step 2A when compared to reversals prior to the 2019 USPTO revised guidance. However, we expect the overall number of decisions reversed by the PTAB will decrease in the future due to fewer examiners issuing § 101 rejections under the revised guidance in the first place. We look forward to updating you on future § 101 trends in the PTAB.

¹ The full post and accompanying data can be found at: <https://blog.anticipat.com/2019/07/01/if-congress-does-not-act-on-section-101-has-the-ptab-hinted-at-a-path-forward/>

PATENT NEWS & TRENDS

The USPTO's Expanded Collaborative Search Pilot ("CSP") Program

On November 2017, the United States Patent and Trademark Office ("USPTO"), the Japan Patent Office ("JPO"), and the Korean Intellectual Property Office ("KIPO") launched the Expanded Collaborative Search Pilot ("CSP") Program. When compared to the original CSP Program, the Expanded CSP Program removes the dependence on the First Action Interview program, eliminates the requirement to provide an incorporation of references cited by partner offices in the First Action on the Merits ("FAOM"), further reduces the time from petition grant to FAOM, and limits the requirement for claims correspondence to independent claims.

The Expanded CSP Program, which ends on October 31, 2020, accelerates examination and provides an applicant with more comprehensive prior art by combining the search results of examiners at the USPTO, JPO, and KIPO before an office action is issued. Further, applications allowed entry into the Expanded CSP Program have expedited first actions on the merits at no additional cost to the applicant.

To gain entry into the USPTO's Expanded CSP Program, applicants must first consent to permit the USPTO, JPO, and KIPO to share information by filing a petition to make special under the Expanded CSP Program. Additionally, for an applicant's petition to be granted, the application must satisfy the following:

- (1) Be a U.S. application having an effective filing date on or after March 16, 2013;
- (2) The U.S. application and its respective counterpart application(s) must have a common earliest priority date no earlier than March 16, 2013;
- (3) The petition to make special must be filed before examination has started;
- (4) All requests for entry into the Expanded CSP Program made to the USPTO and selected partner IP office(s) must be filed within 15 days of each other;
- (5) The U.S. application's claims must be directed to a single invention;
- (6) The petition to make special must include a claim correspondence table establishing "substantial corresponding scope between all independent claims present in the U.S. application and its respective counterpart application(s) in the designated partner IP office(s);
- (7) The U.S. application must contain no more than 3 independent claims and 20 total claims, and must not contain multiple dependent claims.

The CSP Program provides an excellent opportunity for an applicant to receive an expedited first office action, improved prior art searches, and predictability of examination outcomes in partner IP offices at no additional cost, which leads to a stronger patent.

PATENT NEWS & TRENDS

2018’s Top PCT Applicants

Earlier this year, the World Intellectual Property Organization (“WIPO”) released its yearly Patent Cooperation Treaty (“PCT”) yearly review¹. According to the yearly review, a record setting 253,000 applications were filed at the PCT in 2018, roughly 4% more filings than in 2017. The top PCT applicants are as follows:

Top PCT Applicants in 2018			
Rank	Applicant	Country	Number of Applications
1	<i>Huawei Technologies</i>	<i>China</i>	5,405
2	<i>Mitsubishi Electric</i>	<i>Japan</i>	2,812
3	<i>Intel</i>	<i>U.S.</i>	2,499
4	<i>Qualcomm</i>	<i>U.S.</i>	2,404
5	<i>ZTE</i>	<i>China</i>	2,080
6	<i>Samsung</i>	<i>Korea</i>	1,997
7	<i>BOE Technology Group</i>	<i>China</i>	1,183
8	<i>LG Electronics</i>	<i>Korea</i>	1,697
9	<i>Ericsson</i>	<i>Sweden</i>	1,645
10	<i>Bosch</i>	<i>Germany</i>	1,524
11	<i>Microsoft</i>	<i>U.S.</i>	1,476
12	<i>Panasonic</i>	<i>Japan</i>	1,465
13	<i>Sony</i>	<i>Japan</i>	1,342
14	<i>Siemens</i>	<i>Germany</i>	1,211
15	<i>Hewlett-Packard</i>	<i>U.S.</i>	1,170

Top University PCT Applicants in 2018		
Rank	Applicant	Country
1	<i>University of California</i>	<i>U.S.</i>
2	<i>Massachusetts Institute of Technology</i>	<i>U.S.</i>
3	<i>Shenzen University</i>	<i>China</i>
4	<i>South China University of Technology</i>	<i>China</i>
5	<i>Harvard University</i>	<i>U.S.</i>
6	<i>University of Texas</i>	<i>U.S.</i>
7	<i>Tsinghua University</i>	<i>China</i>
8	<i>Seoul National University</i>	<i>Korea</i>
9	<i>Stanford University</i>	<i>U.S.</i>
10	<i>China University Of Mining and Technology</i>	<i>China</i>
11	<i>Osake University</i>	<i>Japan</i>
12	<i>Johns Hopkins University</i>	<i>U.S.</i>
13	<i>Korea Advanced Institute of Science and Technology</i>	<i>Korea</i>
14	<i>University of Tokyo</i>	<i>Japan</i>
15	<i>Hantang University</i>	<i>Korea</i>

The top 10 list comprises six companies from Asia, two from Europe, and two from the U.S. Further, according to the yearly review, 2018 was the first time Asian companies have contributed to more than half of all international patent applications. Moreover, 2018 marks the first time Chinese universities appeared on the top 10 list.

¹ The full PCT Yearly Review can be found here: <https://www.wipo.int/publications/en/details.jsp?id=4424>



45
plus
YEARS OF
EXCELLENCE
SINCE 1971

EUROPEAN UNION'S GENERAL DATA PROTECTION REGULATION

StaaS & Halsey LLP is pleased to announce that the firm is compliant with the European Union's ("EU") General Data Protection Regulation ("GDPR"). The GDPR was adopted to impose stricter data protection regulations on businesses, including those outside of the EU, that use and store data belonging to EU citizens. StaaS & Halsey LLP is dedicated to protecting our client's data and the firm will continue to comply with applicable data privacy laws.

1201 NEW YORK AVENUE, N.W. | 7TH FLOOR | WASHINGTON, D.C. 20005 | P: 202.434.1500 | F: 202.434.1501 | INFO@STAASANDHALSEY.COM

Summer in Washington, D.C.



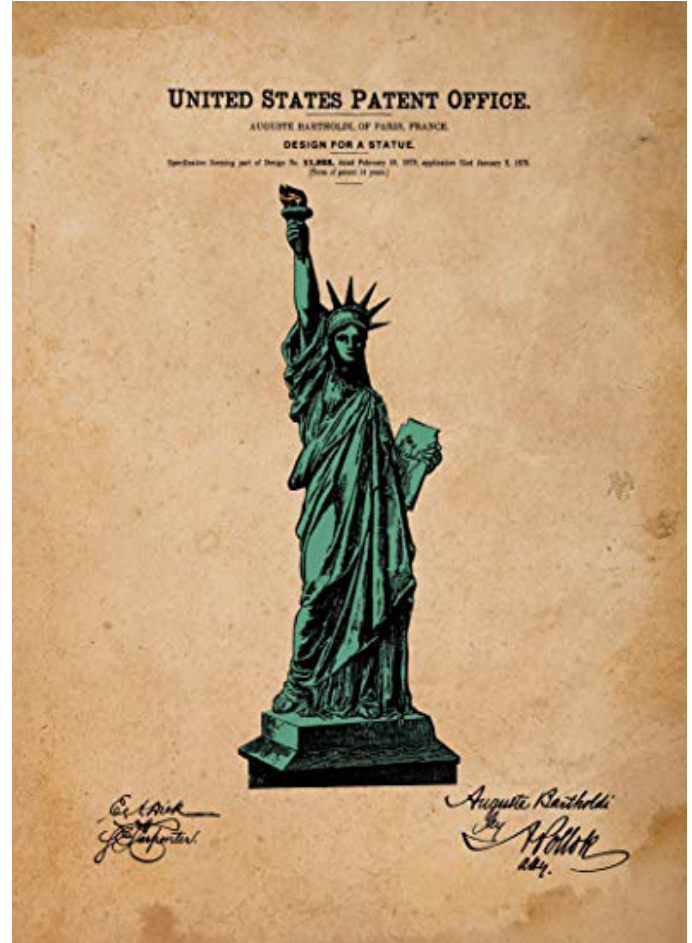
Sunny summer days make a perfect time to explore in Washington, D.C. The cultural events hosted throughout the city make D.C. a great place to visit in hotter months. Visit the National Mall, where festivals and museums attract tourists and locals alike. Many people also enjoy the exciting baseball action at Nationals Park or cooling down by having a drink at the District's waterfronts. Boats and boards from boathouses along the Georgetown waterfront and the Capitol Riverfront are available for rent, giving visitors a unique perspective on iconic structures such as the Kennedy Center and the Lincoln Memorial. Our firm's office is located in downtown Washington, D.C. If you are in the area, we welcome you to visit our office.

FIRM NEWS

Historic Patent: The Statue of Liberty

The Liberty Enlightening the World, or what is known as the Statue of Liberty, is a monument symbolizing the United States. The people of France gave the United States the statue to represent the friendship between the two countries that was established during the American Revolution. The statue commemorates the signing of the United States Declaration of Independence. It is placed on Liberty Island, near the entrance of the New York City harbor. Frédéric Auguste Bartholdi who designed the Statue of Liberty, was granted a U.S. design patent for his masterpiece in 1879 which would become a national monument.

**U.S. Patent No. 11,023
February 18, 1879**



Staas & Halsey LLP
1201 New York Avenue, N.W.
7th Floor
Washington, D.C. 20005
Telephone: 202.434.1500
Email: info@s-n-h.com
Fax: 202.434.1501
www.staasandhalsey.com

This material has been prepared by Staas & Halsey LLP for informational purposes only and is not legal advice. Consult with an attorney for legal advice pertinent to your circumstances before relying on any information contained herein or obtained from any other source. You may feel free to forward this email intact to anyone you wish, but any alteration of this email and its distribution, for remuneration, without the express written permission of Staas & Halsey LLP, are prohibited. ©2019 Staas & Halsey LLP
Editor-In-Chief: David M. Pitcher
To Unsubscribe Please Email info@s-n-h.com

If you received this e-mail from someone other than us and would like to be added to our distribution list, please email info@s-n-h.com

