



2020 SUMMER NEWSLETTER

TABLE OF CONTENTS

SUPREME COURT

- *U.S. Supreme Court Year in Review* – Decisions related to utility patents, design patents, and trademarks are reviewed.

FEDERAL CIRCUIT

- *Akeva L.L.C. v. Nike, Inc.* - The Akeva decision, though non-precedential, reinforces the proposition that comments made in an application may limit the scope of the claims.
- *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC* – Federal Circuit uses *Alice/Mayo* analysis to invalidate a mechanical patent.
- *Godo Kaisha IP Bridge 1 v. TCL Commc'n Tech.* – Juries can decide whether asserted claims of a patent are essential to an industry standard.

USPTO PATENT AND TRADEMARK NEWS

- USPTO Fast-Track Appeals Pilot Program
- USPTO Fees Final Rule
- USPTO Issue Fee Amounts
- USPTO 2020 Update on U.S. Women Inventor-Patentees

S&H PRACTICE TIP

- 30-Day IDS Option - Benefit of Additional Patent Term Adjustment Days

FIRM NEWS

- S&H Continuing Uninterrupted in view of COVID-19
- S&H Going Paperless



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SUPREME COURT

U.S. SUPREME COURT YEAR IN REVIEW – UTILITY, DESIGN, TRADEMARK

1. *Romag Fasteners, Inc. v. Fossil, Inc.* – Recovering profits for trademark infringement.

In 2002, Fossil and Romag entered into an agreement to use Romag fasteners in Fossil's products. Fossil agreed to instruct its manufacturers to purchase Romag fasteners. However, in 2010, Romag discovered that Fossil had purchased counterfeit Romag fasteners to implement in Fossil products and therefore, infringed Romag's intellectual property.

On November 22, 2010, Romag Fasteners, Inc. ("Romag") sued Fossil Inc., and several of its retailers (collectively, "Fossil") in the U.S. District Court for the District of Connecticut for patent and trademark infringement. A jury ruled in favor of Romag by finding Fossil liable for both patent and trademark infringement, but it did not willfully infringe. The District of Connecticut, located in the Second Circuit, barred Romag from collecting any of Fossil's profits incurred during its infringement. Romag subsequently appealed.

On appeal, the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") affirmed the district court. The Federal Circuit noted that the Second Circuit had not explicitly analyzed the most recent statutory language of section 35 of the Lanham Act, 15 U.S.C. § 1117(a), but rejected the idea of overturning two decades worth of precedent.

In response to the Federal Circuit's affirmance of the district court, Romag filed a writ of certiorari in the Supreme Court. Accordingly, the question before the Supreme Court is whether under section 35 of the Lanham Act, 15 U.S.C. § 1117(a), willful infringement is a prerequisite for an award of an infringer's profits for a violation of section 43(a). The U.S. Supreme Court unanimously held that willfulness is not required for trademark owners to recover damages from infringers, settling the circuit split on the matter.

2. *Peter v. NantKwest, Inc.* – Recovery of attorneys' fees by the USPTO under 35 U.S.C. § 145 judicial review.

This case stems from a § 145 proceeding brought by NantKwest, Inc. ("NantKwest") against the USPTO. During the proceeding, the district court found in favor of the USPTO, and the USPTO moved for reimbursement of \$111,696.39 in expenses under § 145, of which \$78,592.50 pertained to personnel costs for the time two USPTO attorneys and a paralegal had spent over the course of the proceedings. The district court granted the USPTO's request for reimbursement except for personnel expenses. The USPTO subsequently appealed.

In response to the Federal Circuit's denial of personnel expenses, the USPTO filed a writ of certiorari in the Supreme Court. The USPTO argues that it is statutorily permitted to collect personnel expenses by Congress's Leahy-Smith America Invents Act. Further, the USPTO relies on the assertion that "both in modern usage and when § 145's first statutory antecedent was enacted, the 'ordinary meaning of 'expenses' encompasses expenditures for personnel.'"

Accordingly, the question before the Supreme Court is whether the phrase "[a]ll the expenses of the proceedings" in § 145 encompasses the personnel expenses the USPTO incurs when its employees, including attorneys, defend the agency in § 145 litigation. The Supreme Court ruled in favor of NantKwest by finding § 145 does not permit the USPTO to collect attorneys' fees recover attorney's fees under 35 U.S.C. § 145 judicial review.

SUPREME COURT

U.S. SUPREME COURT YEAR IN REVIEW – UTILITY, DESIGN, TRADEMARK (cont.)

3. *United States Patent and Trademark Office v. Booking.com* – Obtaining a U.S. federal trademark registration for domain names.

Booking.com operates a website where customers can book travel and hotel accommodations. In 2012, Booking.com filed a U.S. trademark application for the use of BOOKING.COM as a word with the United States Patent and Trademark Office (“USPTO”). During prosecution of the trademark application, the examiner rejected the mark as being generic and therefore, not protectable. In the alternative, the examiner determined that even if the mark was found descriptive, Booking.com had failed to establish it had acquired secondary meaning as required for trademark protection. The Trademark Trial and Appeal Board (“TTAB”) upheld the examiner’s rejection and Booking.com appealed the decision by filing an action in the U.S. District Court for the Eastern District of Virginia (“District Court”) against the USPTO.

The District Court reversed the TTAB decision, finding that the term BOOKING.COM, as a whole, was a descriptive mark. Further, the district court found Booking.com had demonstrated the mark had achieved secondary meaning through a survey in which 74.8% of consumers indicated they recognized BOOKING.COM as a brand rather than a generic service. The USPTO appealed to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), which affirmed the district court’s holding. The USPTO timely petitioned for a writ of certiorari with the Supreme Court (SCOTUS) of the U.S.

In its petition for certiorari, the USPTO primarily contended the long standing precedent that the addition of entity designations like “Company,” to an otherwise generic term, is not protectable under trademark law, is similarly applicable to the top-level domain “.com.” Specifically, the USPTO argued “.com” only denotes an online business, like entity designations, such as “Company,” only indicates the type of business, association, or partnership. Additionally, with respect to the finding that BOOKING.COM achieved secondary meaning, the USPTO asserted that “it has long been established that, no matter how successful ‘the user of a generic term’ is ‘in securing public identification’ between the term and its commercial user, the term cannot be federally registered in the U.S.

In an 8-1 decision released on June 30th, 2020, the Supreme Court of the U.S. (SCOTUS) affirmed the decision of the Court of Appeals for the Fourth Circuit that “Booking.com” is eligible for trademark registration.

SCOTUS held that adding “.com” to a generic term does not per se result in a generic term. Looking to the principles of the Lanham Act, Justice Ginsburg emphasized the importance of consumer perception in deciding the generic character of a term. Here, the district court found that consumers did not find “Booking.com” to be a generic term. The appellate court affirmed, finding no error in the district court’s assessment. SCOTUS agreed, rejecting the argument that adding “.com” to a generic term can convey no source-identifying meaning, and concluding that “Booking.com” is not a generic name to consumers.

Given that only one entity can occupy an internet domain at a time, SCOTUS found that consumers may associate a particular website with an entity. SCOTUS also rejected the PTO’s arguments that internet domain owners have existing competitive advantages and that other remedies exist outside of trademark law on the grounds that no basis exists to deny them benefits accorded to other non-generic terms.

SUPREME COURT

U.S. SUPREME COURT YEAR IN REVIEW – UTILITY, DESIGN, TRADEMARK (cont.)

4. Google LLC v. Oracle America, Inc. – U.S. copyright protection for software interfaces.

In 2008, Google LLC (“Google”) released Android, “an open-source platform designed to enable mobile devices such as smartphones and tablets. The Android platform was built using the Java programming language developed by Sun Microsystems, which was later acquired by Oracle American, Inc. (“Oracle”). Prior to Oracle’s acquisition of Sun Microsystems, Google replicated the syntax and structure of the Java application programming interface (“API”) within the Android platform to ensure third-party developers could utilize the prewritten methods and declarations known within Java’s API libraries. Google replicated “37 Java API libraries that were determined by Google to be ‘key to mobile devices,’” which attributed to only 3% of the Android environment. Google independently wrote the remainder of the code to “accommodate the unique challenges” of the mobile device environment. Upon its acquisition of Sun Microsystems, Oracle sued Google in the U.S. District Court for the Northern District of California (“District Court”), alleging copyright infringement for the replicated code.

At the end of trial, the District Court held the Java API was not copyrightable and rejected Google’s fair use defense, which permits the unlicensed use of copyright-protected works in certain circumstances. On appeal, the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) reversed and remanded the district court’s decision. Specifically, the Federal Circuit found the Java API was subject to copyright protection and remanded the case because there was a lack of sufficient factual findings to resolve the fair use issue raised by Google in the District Court. On remand, the jury concluded Google’s use of the Java API constituted fair use. Oracle timely appealed. Once again on appeal in the Federal Circuit, the court overturned the jury’s verdict, finding Google did not engage in fair use as a matter of law. Google subsequently petitioned for certiorari, which the Supreme Court granted.

As noted, the questions before the Supreme Court are whether copyright protection extends to a software interface, and whether Google’s use of a software interface in the context of creating a new computer program constitutes fair use. In its petition for certiorari, Google asserts that if the Federal Circuit’s approach is allowed to stand, “developers will be forced to abandon their traditional building-block approach to software interface development,” and in turn, “would have a devastating impact on the development of computer software.” Nevertheless, Oracle asserts that a finding in favor of Google would penalize software developers for simply creating a software interface popular enough since that would allow other companies to use it without consequence under the fair use doctrine.

5. Automotive Body Parts Association v. Ford Global Technologies. – Petition for Certiorari denied in design patent case.

The U.S. Supreme Court denied the Automotive Body Parts Association’s petition for certiorari from the Federal Circuit’s decision upholding Ford design patents for “new, original and ornamental design” headlamp and hood designs on certain models of Ford’s F-150 trucks.

The Federal Circuit had rejected the argument presented by the Automotive Body Parts Association (ABPA) at the district court level that Ford’s design patents were primarily functional and therefore invalid. The Federal Circuit held that ABPA’s argument that “Ford’s hood and headlamp designs are functional because they aesthetically match the F-150 truck”... “was inadequate to render that design functional”.

SUPREME COURT***U.S. SUPREME COURT YEAR IN REVIEW – UTILITY, DESIGN, TRADEMARK (cont.)***

The Federal Circuit rejected the ABPA argument to limit the enforcement of Ford's design patents to "the initial marked for sale of the F-150 and not in the market for replacement parts". The Federal Circuit also rejected ABPA's argument that Ford's patent rights were unenforceable under the related doctrines of exhaustion and repair. As Ford's design patents claimed designs as applied to portions of particular components rather than in conjunction with the whole truck, the Federal Circuit upheld the district court's decision that purchasing a vehicle does not permit the purchaser to have new auto parts made covered by Ford's design patents.





FEDERAL CIRCUIT

Akeva L..L.C. v. Nike, Inc. (non-precedential)

On July 16, 2020, the U.S. Court of Appeals for the Federal Circuit (CAFC) affirmed a district court's grant of summary judgment against Akeva's footwear patents where the district court (1) construed the claim term "rear sole secured" to exclude conventional fixed rear soles (the accused products) and (2) concluded that Akeva's Continuation Patents are not entitled to claim priority to an earlier patent.

Claim Construction

Akeva's U.S. Patent No. 5,560,126 ('126 patent) describes improvements to athletic shoe rear soles and midsoles. The "Background of the Invention" portion of the specification of the '126 patent describes the problem of rear sole wear in which "One of the principal problems associated with athletic shoes is outsole wear ... the heel typically wears out much faster than the rest of the athletic shoe, thus requiring *replacement of the entire shoe* even though the bulk of the shoe is still in satisfactory condition."

The "Summary of the Invention" portion of the '126 patent describes "a rear sole *detachably secured* or rotatably mounted to the heel support". The "Abstract" of the '126 patent describes a shoe including "a heel support for receiving a *rotatable and replaceable rear sole* to provide longer wear". Claim 25 of the '126 patent recites, in part, "A shoe comprising: an upper having a heel region; a *rear sole secured* below the heel region of the upper..."

The CAFC stated "given the ['126] patent's disparagement of conventional fixed rear sole shoes which suffer from rear sole wear, its characterization of the invention as a removable and/or rotatable rear sole, and its uniform, lengthy disclosure of such rear soles, we agree with the district court's construction of 'rear sole secured' to mean 'rear sole selectively or permanently fastened, but not permanently fixed into position'" which excludes conventional fixed rear soles including the accused products sold by Nike, Adidas, New Balance, Asics, and Puma.

Priority Claim

Akeva's Continuation Patents claim priority to the '126 patent through a chain of intervening continuations, including a continuation-in-part of the '126 patent, U.S. Patent No. 6,604,300 ('300 patent) which, as discussed above, *excluded* an athletic shoe with a conventional fixed rear sole. However, in the Continuation Patents, Akeva amended the specifications to circumvent the disclaimer language of the '300 patent to *include* an athletic shoe with a conventional fixed rear sole. By doing so, the CAFC asserted the chain of priority was broken, and the asserted claims of the Continuation Patents cannot claim priority to the '126 patent for a shoe having a conventional fixed rear sole.

FEDERAL CIRCUIT

Akeva L.L.C. v. Nike, Inc. (non-precedential)

Additionally, the CAFC stated that a disclaimer regarding *claim scope* made during prosecution may be rescindable, but that a disclaimer in the specification often broadens the description which likely adds *new matter*.

Analysis

The Akeva decision, though non-precedential, reinforces the proposition that comments made in an application may limit the scope of the claims. In Akeva, elements that the CAFC referred to as “disparaging” of potentially infringing products when describing the problem solved by the invention in an original application may preclude claiming the disparaged elements. Furthermore, removing these statements in a continuation or continuation-in-part application may result in a finding of new matter, which could break a chain of priority to the original application. As a result, claimed features in the continuation-in-part application that rely on the new matter would only have priority to the filing date of the continuation-in-part application rather than to the filing date of the parent application. Therefore, Applicants may wish to take the Akeva decision into consideration when drafting a Specification, or making changes to the Specification when filing a continuation or continuation-in-part application.



FEDERAL CIRCUIT

American Axle & Manufacturing, Inc. v. Neapco Holdings LLC

The U.S. Court of Appeals for the Federal Circuit's decision in *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC*, invalidated claims for a patent directed to a driveshaft. This case is of interest, because the court used the Alice/Mayo analysis to invalidate a mechanical patent.

U.S. Patent 7,774,911

Independent claims 1 and 22 both recite a preamble of "*a method for manufacturing a shaft assembly of driveline system*".

The court in its analysis of claim 22, focused on the recited feature of "*tuning a mass and a stiffness of at least one liner*". The court agreed with the district court's finding that the recited claim language invokes a relation between frequency, mass, and stiffness as stated by Hooke's law. As such, the court found that claim 22 invoked a natural law, thus satisfying step one of the Alice/Mayo test.

In its step two Alice/Mayo analysis, the court stated that nothing in claim 22 qualified as an inventive concept which would transform the recited features into patent eligible matter. The court based its step two determination on the finding that the claims were merely reciting desired results. The majority appeared to be concerned about inhibiting future innovation by granting patents that tie up the use of laws of nature. The court concluded "that independent claim 22 of the '911 patent is patent ineligible under section 101 because it simply requires the application of Hooke's law to tune a propshaft liner to dampen certain vibrations".

Independent claim 1, however, was remanded back to the district court. Claim 1 recited the feature of "*tuning at least one liner*". The district court interpreted the term "*tuning*" to mean "controlling characteristics of at least one liner to match a relevant frequency". The specification stated that characteristics that can be tuned included variables other than mass and stiffness. The court held that since the specification stated that characteristics could include variables other than mass or stiffness, claim 1 was not solely directed to Hooke's law. However, the court determined that further analysis was required under step one of Alice/Mayo to determine if claim 1 was directed to an abstract idea and remanded the case back to the district court.

Implications of the Decision

In view of the Federal Circuit's decision, it is important to keep in mind when drafting claims, that simply reciting functional results may place claims at risk of ineligibility under 35 §USC 101. As such, it is vital to meet the requirements of the Alice/Mayo test when drafting claims in the mechanical arts, such as emphasizing utilization of a result of a calculation to perform an action.

FEDERAL CIRCUIT

Godo Kaisha IP Bridge 1 v. TCL Commc'n Tech. (precedential)

On August 4, 2020, the U.S. Court of Appeals for the Federal Circuit (CAFC) affirmed a district court's infringement finding and its rulings regarding owed royalties, concerning the infringement of two patents directed to LTE technology owned by Godo Kaisha IP Bridge 1 (IP Bridge). In an apparent issue of first impression, the CAFC held that comparing the asserted claims of a patent against an industry standard to determine whether the claims are essential to the standard, is akin to an infringement analysis, and therefore is a fact issue decidable by a jury, and not a question of law that must be decided by the court.

Background

IP Bridge brought an infringement action against TCL Communication Technology (TCL) for infringement of claims of two patents which IP Bridge alleged were essential to the LTE standard. At trial, IP Bridge provided evidence that the asserted claims were essential to mandatory sections of the LTE standard, and that the accused devices sold by TCL were LTE-compatible. IP Bridge argued the accused devices necessarily infringed the asserted claims because the accused devices were LTE-compatible, arguing based on CAFC precedent that if the reach of the claims includes any device that practices a standard, then this can be sufficient for a finding of infringement.

A jury agreed with IP Bridge's arguments and awarded IP Bridge \$950,000 in damages. The court also awarded IP Bridge an ongoing royalty of four cents per patent for both accused products as well as certain non-accused products sold by TCL. TCL appealed the infringement verdict and the district court's rulings regarding royalties.

Determining the Standard-Essentiality of Asserted Claims is a Fact Issue, Not a Question of Law

On appeal, TCL argued that the district court had erred by allowing the jury to determine whether the asserted claims were essential to the LTE standard. TCL argued that the court, and not the jury, "must first make a threshold determination *as part of claim construction* that all implementations of a standard infringe the claims." IP Bridge argued that whether the asserted claims are essential to a standard is a classic fact issue, and is decidable by a jury.

The CAFC agreed with IP Bridge, and found that TCL had wrongly interpreted CAFC precedent by conflating the court's role with respect to claim construction and the court's role in determining the essentiality of the asserted claims of a patent. The CAFC stated that while claim construction is the role of the court, comparing the claims to a standard is akin to traditional infringement analysis by which claims are compared to an accused product, which is a fact issue, and not a question of law. The CAFC noted that "[e]ssentiality is, after all, a fact question about whether the claim elements read onto mandatory portions of a standard that standard-compliant devices must incorporate."

FEDERAL CIRCUIT

***Godo Kaisha IP Bridge 1 v. TCL Commc'n Tech. (precedential)
(cont.)***

Accordingly, the CAFC rejected TCL's argument and held that whether asserted claims are essential to all implementations of an industry standard is a question to be resolved by the trier of fact. The CAFC affirmed the jury's verdict and affirmed the award of royalties to IP Bridge, noting that TCL's own documents and marketing materials admitted the products were compliant with the LTE standard.

Analysis

The CAFC's decision reinforces and strengthens the role of a jury in an infringement action involving standard-essential patents. Rather than requiring a judge to decide as a matter of law whether claims of a patent are essential to an industry standard, such issues may be allowed to go to a jury as a factual issue. Some commenters believe the CAFC decision may be beneficial to patent owners, based on the perception that jurors tend to favor patent owners. Others believe the CAFC decision could lead to increased costs in litigation involving standard-essential patent disputes due to the increased involvement of juries.





USPTO

USPTO Fast-Track Appeals Pilot Program

On July 2, 2020, the United States Patent and Trademark Office (USPTO) launched the Fast-Track Appeals Pilot Program to speed up patent examination and ex parte appeals. The USPTO expects the average ex parte appeal to be decided within *six months* from the date a petition to request the fast-track appeal is granted.

The fee for a petition is \$400 and the number of granted petitions will be limited to 500 per program year or 125 per quarter (the first quarter beginning on the program start date of July 2, 2020). To maintain the fast-track schedule, Oral Hearings will be expedited and cannot be rescheduled or relocated. Ordinary Patent Trial and Appeal Board (PTAB) hearing procedures will be applied, but hearings are currently conducted only by telephone.

To qualify for fast-track status, four conditions must be met: (1) the application must be an original utility, design, or plant non-provisional application; (2) the appeal must be an ex parte appeal for which a Notice of Appeal has been filed and a PTAB Docketing Notice has been issued by the USPTO; (3) the appellant must file a petition under 37 CFR 41.3 electronically identifying the application and appeal number; and (4) the appellant must pay the \$400 fee.

If you have any questions about the USPTO Fast-Track Appeals Pilot Program, please contact us.





USPTO

USPTO Fee Update Final Rule Effective October 2020

The USPTO has announced a Final Rule which sets or adjusts 296 patent fees for large, small, and micro entities. The Final Rule is effective October 2, 2020, except for a surcharge for non-DOCX filings effective January 1, 2022, and is available at <https://www.uspto.gov/about-us/performance-and-planning/summary-fy-2020-final-patent-fee-rule> .

Under the Final Rule, routine patent fees, including filing, search, examination, and issue fees, will increase by five percent. Exceptions, which may have increased by lower or higher than five percent, include maintenance fee surcharges, requests for expedited examination of a design application fee, utility and reissue patent issue and maintenance fees, and AIA trial fees. New fees include a non-DOCX filing surcharge fee and a pro hac vice admission fee.

The Final Rule maintains discounts for small entities and micro entities. Small entities receive a 50 percent discount and micro entities receive a 75 percent discount. Entities will qualify as small based on size or certain non-profit status. To qualify as micro, entities must be eligible according to Section 10(g) of the AIA.

The Final Rule was originally planned to take effect in July 2020, but the USPTO extended it to October in light of COVID-19.

The USPTO's reevaluation of its PTAB and patent fees took place over the last three years and included feedback from the public as well as comments from intellectual property organizations, law firms, corporations, and individual attorneys. The goal of the review was to address increasing fees, revenues associated with patent operations, and costs of implementing the USPTO 2018-2022 Strategic Plan. For further information, please contact Staas & Halsey LLP at info@s-n-h.com

**USPTO*****Issue Fee Amounts***

Notices of Allowance (NOA) mailed by the USPTO between September 9th and September 15th may list an incorrect issue fee amount that mistakenly incorporated the new fee rule. The new rule is effective October 2nd, 2020 and will only be reflected in Notices of Allowance sent on or after that date. In each affected case, the USPTO will mail a corrected NOA. The corrected NOA will contain the correct issue fee and reset the time period for payment. The USPTO will reach out to those who have already paid the issue fee with further guidance.

However, NOAs for international design applications that were mailed between September 9th and September 15th were not affected and the correct issue fee amounts were listed. Applicants are encouraged to respond to those NOAs normally.

As a reminder, the issue fees for Utility and Reissue applications will be increasing from \$1,000 to \$1,200 for undiscounted, \$500 to \$600 for small entity, and \$250 to \$300 for micro entity. Please see [here](#) for the current fee schedule and [here](#) for the schedule set to take effect on October 2nd, 2020.





USPTO

2020 Update on U.S. Women Inventor-Patentees

The USPTO recently released a 2020 update regarding U.S. women inventor-patentees, incorporating three years of new data and nearly one million issued patents to their previous 2016 report. The information was obtained via PatentsView, a free database supported by the USPTO Office of the Chief Economist.

The USPTO focused on two indicators to assess women's participation as inventor-patentees. The first is the share of patents that include at least one women inventor, which gives an output perspective. This increased from 20.7% in 2016 to 21.9% at the end of 2019.

The second indicator is the Women Inventor Rate (WIR), which calculates the share of women among all inventor-patentees in a given period of time - the input perspective. The WIR increased from 12.1% in 2016 to 12.8% in 2019. The District of Columbia topped the list of highest average WIR for 2007-2019 at 19.2%. The USPTO noted that although women's participation in science and engineering jobs have increased, this is not reflected proportionally in the number of inventor-patentees. However, there has been a 4% annual growth of new women inventors, compared to 2.5% growth of new men inventors.

The USPTO is committed to both bringing in new women inventor-patentees and keeping women inventor-patentees active in the patent system. Being active is defined as applying for another patent within five years of their first patent. Among new inventors who were issued patents, the percentage of women has increased from 16.6% in 2016 to 17.3% in 2019. Regarding whether women have remained active, only 28% of women remained active in 1980, but has risen to 46% in 2014. The gender gap has greatly decreased, as 52% of men inventors remain active.

Companies that produce healthcare products and pharmaceuticals consistently have the highest WIRs because there are higher rates of women in chemistry and biology compared to engineering fields. Proctor & Gamble remains the company with the highest average WIR at 29.3%. The 3M Company showed the largest improvement, with their average increasing from 15.2% to 16.6%.

**S&H PRACTICE TIP*****S&H Practice TIP: 30-Day IDS Option—Benefit of Additional PTA Days***

The USPTO is required to extend or reduce the 20-year patent term from the application filing date when the delay was caused by the USPTO under the patent term adjustment (PTA) system created by the U.S. Congress. The PTA also accounts for the Applicant's delay and reduces the PTA term (but not the original 20-year patent term) if any PTA term is granted.

37 C.F.R. § 1.704 governs what is considered the Applicant's delay that would cause a reduction in the PTA. For example, this includes an applicant's delay caused by submitting an IDS at certain timings, under 37 C.F.R. § 1.704(c)(6) or (c)(8)-(c)(10), which will be considered to cause a delay in the prosecution of the patent application, even when the IDS complies with the 3 month period to submit an IDS under 37 C.F.R. § 1.97. For example, the reduction of the PTA under 37 C.F.R. § 1.704(c)(6), (c)(9), or (c)(10), if any, may be up to 40 days.

However, if the IDS is to disclose a reference first cited in a foreign action, the patentee may obtain a benefit of avoiding the PTA reduction in these scenarios by utilizing the 30-day IDS rule under 37 C.F.R. § 1.704(d).

37 C.F.R. § 1.704(c)(6) and (c)(8)-(c)(10) indicate that submission of an IDS will count as the Applicant's delay if filed: (1) one month before the mailing of first OA or NOA (§ 1.704(c)(6)); (2) after a response was filed and prior to the next action (§ 1.704(c)(8)); (3) after PTAB's decision on an appeal (§ 1.704(c)(9)); or (4) after the mailing of the NOA (§ 1.704(c)(10)).

37 C.F.R. § 1.704(d) states that an IDS will not be considered a failure to engage in reasonable efforts to conclude prosecution if it is accompanied by a statement that each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart application and that it was not received more than 30 days prior to the filing of the IDS.

To apply for the benefits, patentees must (1) expressly request a waiver under 37 C.F.R. § 1.704(d), and (2) file an IDS containing the first foreign-cited reference or the first foreign action within 30 days of the foreign action date.

This rule is not to be confused with 37 C.F.R. § 1.97(e)(1) certification, which states that information in an IDS were cited in a communication from a foreign patent office not more than three months prior to the filing of the IDS.

FIRM NEWS

Continuing Uninterrupted In View of COVID-19

Staas & Halsey LLP (S&H) continues to monitor the rapidly changing circumstances surrounding COVID-19, the illness caused by a novel coronavirus. We have taken measures to continue to provide uninterrupted service to our clients during the COVID-19 outbreak in the USA and other countries.

Beginning Monday, March 16th 2020, we implemented the S&H business continuity plan that allows our attorneys and staff to work remotely when necessary. By adopting a document management system ten years ago and going completely paperless in early 2020, the transition to remote working has been relatively smooth.

The S&H remote work system for employees uses an encrypted tunnel to provide connectivity to the S&H servers storing the S&H document and docketing management software, and access to email servers. Staas & Halsey is in compliance with the UK Data Protection Act 2018, as amended in 2019; the European Union's General Data Protection Regulation (GDPR); and the California Consumer Privacy Act (CCPA).

The above mentioned business continuity plan is anticipated to continue until further notice, and may be updated, including any updates taking into consideration recommendations of U.S. local and federal governments and the World Health Organization.

We continue to ask that communication to our firm be electronic, via e-mail, facsimile, portals, or similar means. If physical items need to be sent to Staas & Halsey LLP, please provide S&H prior notification and at least inform Docketing@s-n-h.com of any such anticipated delivery of physical items so that S&H can make arrangement for receipt of such physical items. If we normally send you packages of physical items, like paper copies of communication, please note that at times these may be delayed.

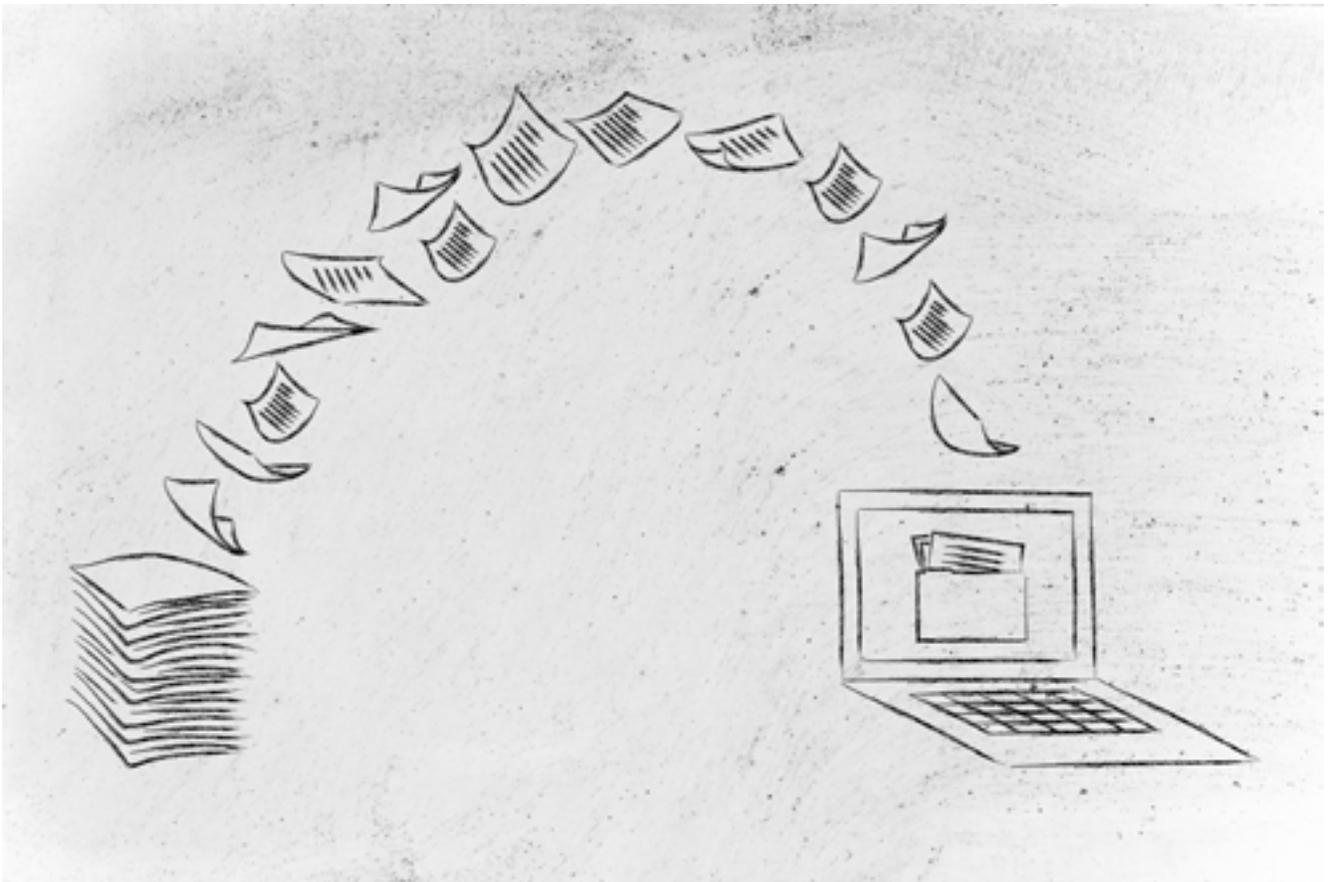
We have postponed all travel plans as a precaution based on the recommendation of the U.S. local and federal governments and the World Health Organization.

We send our best wishes and thoughts to everyone that have been affected by the COVID-19 virus and hope for a healthy tomorrow.

If you have any questions, please contact us at Docketing@s-n-h.com.

**FIRM NEWS*****StaaS & Halsey LLP Has Gone Paperless!***

Since about the year 2010, our firm has maintained duplicative paper and electronic “official” files for each of our client’s matters. Effective January 1, 2020, our firm discontinued maintenance and use of our “official” paper client files, and instead relies only on our electronic official client files. This change in procedure takes advantage of advances in technology to reduce costs and improve efficiency.



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