



2017 WINTER NEWSLETTER

TABLE OF CONTENTS

SUPREME COURT

1. [Apple v. Samsung heads back to the District Court](#)
2. [Impression Products, Inc. v. Lexmark International, Inc.: Post Sale Restriction on Patented Goods](#)
3. [TC Heartland LLC v. Kraft Foods Group Brands LLC: Supreme Court to Review Patent Venue](#)

FEDERAL CIRCUIT

1. [John D'Agostino v. MasterCard International, Inc.: Claim Construction](#)
2. [Sonix Tech. Co. v. Publ'ns Int'l, Ltd.: Federal Circuit Clarifies Claim Definiteness Inquiry](#)
3. [Phigenix, Inc. v. ImmunoGen, Inc.: Lack of Standing for Judicial Review](#)

USPTO

1. [USPTO Patent Trends: Fiscal Year 2016 v. Fiscal Year 2015](#)

TRADEMARK

1. [USPTO Trademark Trends](#)
2. [USPTO Raises Trademark Fees](#)

FIRM NEWS

1. [S&H 45th Anniversary Event](#)
2. [S&H Attending May 2017 INTA Annual Meeting in Barcelona, Spain](#)
3. [Winter in Washington, D.C.](#)
4. [Celebrity Patent Inventor: Prince](#)



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



SUPREME COURT

***Apple v. Samsung* heads back to the District Court**

On December 6, 2016, the United States Supreme Court (“Supreme Court”) issued its opinion in *Apple v. Samsung*, reversing the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) ruling that 35 U.S.C. § 289 (“the design patent damages statute”) requires that, in cases of U.S. design patent infringement, total infringer’s profits from sales of the entire end product be paid.

Apple sued Samsung for infringement of several of its design patents related to the iPhone. One of Apple’s design patents covered the rectangular face of the phone being black with rounded corners, another included the front face having a raised rim, and another was for the graphical display including a grid of app icons against a black screen. After Samsung was found to have infringed Apple’s design patents, a U.S. district court jury awarded Apple \$400 million for Samsung’s total profit in the sale of their smart phones embodying Apple’s patented designs.

The design patent damages statute provides in relevant part that “Whoever...applies the patented design...to any *article of manufacture* [emphasis added] for the purpose of sale...shall be liable to the owner to the extent of his total profit.” On appeal to the Federal Circuit, Samsung argued that it should not be liable for damages resulting from its total profits on their entire smart phones because Apple’s design patents covered only a portion of the phones. Specifically, Samsung argued that the relevant “article of manufacture” for damages purposes was not the entire phone, but only the portion of the phone that incorporates the patented design. The Federal Circuit however, affirmed the jury damages, finding that, because the internal components of the smart phone could not be purchased by consumers separately from the smart phones themselves, the relevant “article of manufacture” was the entire smart phone.

In its reversal of the Federal Circuit, the Supreme Court held that an “article of manufacture is broad enough to encompass both a product sold to a consumer as well as a component of that product.” However, the Supreme Court explicitly refused to set out a test for determining what the relevant article of manufacture should be, noting that the parties did not brief that issue. Instead, the Supreme Court remanded the case back to the Federal Circuit for a determination on how to classify an article of manufacture.

On remand, Apple maintained the position that the Federal Circuit should affirm the damages award. Samsung’s position however, was that the Federal Circuit should vacate the initial judgment and remand the case back to District Court for a new determination of damages. Samsung argued that in light of the Supreme Court’s opinion, the original jury instruction on the design patent damages statute was erroneous.

On February 7, 2017, the Federal Circuit remanded the case to the district court for a determination as to whether a new damages trial is necessary. In doing so, the Federal Circuit noted that “If the [District] court determines that a new damages trial is necessary, it will have the opportunity to set forth a test for identifying the relevant article of manufacture for purposes of § 289, and to apply that test to this case.”

SUPREME COURT***Impression Products, Inc. v. Lexmark International, Inc.*: Post Sale Restrictions on Patented Goods**

On December 2, 2016, the United States Supreme Court (“Supreme Court”) granted certiorari in *Impression Products, Inc. v. Lexmark International, Inc.* to consider whether violations of post-sale use restrictions or resale restrictions on patented articles constitutes patent infringement.

Lexmark sold printer and toner cartridges embodying their patented technology throughout the United States and internationally. Further, Lexmark offered two pricing mechanisms for the cartridges. Purchasers could either pay full price for the cartridges or receive a discount on the cartridges with the condition that they not reuse or resell the cartridges. Impression purchased Lexmark’s cartridges at the discounted rate and resold them throughout the United States. Lexmark sued Impression, claiming that Impression’s resale of the cartridges infringed Lexmark’s patents. The U.S. district court granted Impression’s motion to dismiss and held that the patent rights had been exhausted by Lexmark’s initial sale of the cartridges.

In *Quanta Computer, Inc. v. LG Elecs., Inc.*, 553 U.S. 617, 625 (2008), the Supreme Court held that the doctrine of patent exhaustion provides “that the initial authorized sale of a patented item terminates all patent rights to that item.” At issue in *Lexmark* was whether a patent owner could include a clearly communicated post-sale restriction on the use of a patented good or resale restriction against the purchaser engaging in subsequent sales of a patented good, without exhausting the patent right.

The U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) reviewed the case *en banc* and reversed the district court’s ruling. Turning to the text of 35 U.S.C. § 271, the Federal Circuit noted that, to infringe a patent, the infringer must be acting “without authority” of the patent owner. The Federal Circuit then held that, while a sale of a patented good will normally presumptively grant this authority, clearly communicated restrictions on post-sale use by the purchaser do not exhaust the patent right. The Federal Circuit also held that Lexmark’s sale of the cartridges internationally did not authorize Impression to import the cartridges into the United States because those sales were conditioned on the purchaser’s agreement not to resell the cartridges.

On appeal to the Supreme Court, the *amicus* brief filed by the Solicitor General of the United States argued that the Supreme Court should reverse the Federal Circuit and hold that restrictions on post-sale use or resale are unenforceable under patent law.

SUPREME COURT

TC Heartland LLC v. Kraft Foods Group Brands LLC: Supreme Court to Review Patent Venue

On December 14, 2016, the United States Supreme Court (“Supreme Court”) granted certiorari in *TC Heartland LLC v. Kraft Foods Group Brands LLC* to determine whether the definition of corporate residence, as used in the general venue statute, 28 U.S.C. § 1391(c), applies to the patent venue statute, 28 U.S.C. § 1400(b).

TC Heartland (“TC”) is a limited liability company with a principle place of business and registration in Indiana. Kraft Foods, is incorporated in Delaware and has a principle place of business in Illinois. Kraft Foods sued TC in the United States District Court for the District of Delaware (“District Court”) for selling water enhancer products that Kraft claimed infringed its patents. TC moved to dismiss the complaint for lacking personal jurisdiction under the Federal Rules of Civil Procedure Rule 12(b)(2). Specifically, TC argued that even though it sold some of the allegedly infringing products in Delaware, under the patent venue statute, it did not “reside” in Delaware. The District Court disagreed, however, and found that it had personal jurisdiction over TC. TC appealed the ruling.

The U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) affirmed the District Court’s ruling. In doing so, the Federal Circuit also reaffirmed its prior precedent, which held that the definition of corporate residence used in the 28 U.S.C. § 1391(c) (“the general venue statute”), also applied to 28 U.S.C. § 1400(b) (“the patent venue statute”). The patent venue statute states that “Any civil action for patent infringement may be brought in the judicial district where the defendant resides...” The general venue statute further provides that corporate entities reside “in any judicial district in which such defendant is subject to the court’s personal jurisdiction with respect to the civil action in question.”

TC argued that amendments made to the general venue statute in 2011 were intended to separate the definition of corporate residence used in the general venue statute from the patent venue statute. Specifically, one of the amendments made to the general venue statute added that the section was applicable “[e]xcept as otherwise provided by law.” TC therefore argued that inclusion of that provision showed Congress’ intent that Federal common law precedent be used to define corporate residence under the patent venue statute. However, the Federal Circuit did not find this argument persuasive, noting that there was no other definition of corporate residence in the patent venue statute or established Supreme Court common law in 2011 for Congress to have been codifying.

If the Supreme Court were to reverse the Federal Circuit, it could have potentially significant impact on a patentee’s ability to select a forum for a patent infringement suit. Forum shopping in patent litigation has been a topic of policy debate in recent years, with the U.S. District Court for the Eastern District of Texas receiving a disproportionate share of total U.S. patent cases.



FEDERAL CIRCUIT

***John D'Agostino. v. MasterCard International, Inc.:* Claim Construction**

On December 22, 2016, the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) issued its opinion in *John D’agostino v. MasterCard International, Inc.*, holding that the U.S. Patent and Trademark Office (“USPTO”) Patent Trial and Appeal Board’s (“PTAB”) claim construction was unreasonable.

John D’Agostino owned two patents directed to methods of effecting secure credit-card purchases by minimizing merchant access to credit card numbers. MasterCard filed two petitions with the USPTO requesting inter partes review of the two patents. The PTAB instituted review of various claims from each patent and cancelled all of the reviewed claims as unpatentable on the grounds of anticipation and obviousness.

Some of the claims under review were directed to limiting transactions to “one or more merchants,” while other claims were directed to transactions involving “a single merchant.” In finding both sets of claims unpatentable, the PTAB found that U.S. Patent No. 6,422,462 issued to Cohen (“Cohen”) disclosed the feature of the single merchant limitation through an embodiment that limits credit-card transactions to a particular chain of stores. D’Agostino appealed the PTAB’s decision.

The Federal Circuit agreed with the PTAB that the “broadest reasonable interpretation” standard is to be applied when reviewing claims in an inter partes review proceeding. However, the Federal Circuit held that the PTAB’s interpretation of the single-merchant claim limitation was unreasonable in light of the language of the claims and the specification. Specifically, the Federal Circuit found that the claim language required that the single merchant was not identified to the authorizing entity which receives the payment category.

In contrast to the claim language, the cited reference Cohen described a customer seeking a transaction code for an identified chain of stores, and then picking a specific store within the chain of stores. The Federal Circuit used an analogy involving the store Target to highlight the PTAB’s erroneous reasoning, stating that if Target is construed as a chain of stores, then such an interpretation falls outside of the single-merchant limitation. On the other hand, if Target is construed as one merchant, then telling the authorizing entity to limit transactions to “Target” falls outside the scope of the claim because the identity of the store is not withheld and the merchant is identified.

Accordingly, the Federal Circuit held that the PTAB’s construction of the claims and the application of the construction to Cohen was not reasonable. Therefore, the Federal Circuit vacated the PTAB’s claim construction and findings of anticipation and obviousness.

FEDERAL CIRCUIT

***Sonix Tech. Co. v. Publ'ns Int'l, Ltd.*: Federal Circuit Clarifies Claim Definiteness Inquiry**

On January 5, 2017, the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) issued its opinion in *Sonix Tech. Co. v. Publ'ns Int'l, Ltd.*, holding that the term “visually negligible”, as used in claim language relating to an improved barcode, was sufficiently definite under 35 U.S.C. § 112.

Sonix, an electronics manufacturer, sued various companies for infringing certain claims of U.S. patent 7,328,845 (the ‘845 patent) which describes a system and method for using a “graphical indicator” to encode information, similar to a barcode, on the surface of an object. An aspect of the ‘845 patent further provided that the graphical indicator was “visually negligible” by using “multiple graphical micro-units arranged in a layout” such that the graphical indicators would be negligible to human eyes and would be so tiny that only a microscope apparatus could detect it. The U.S. District Court for the Northern District of Illinois (“District Court”) found the claim term “purely subjective,” and determined that the written description did not provide a person of skill in the art “with a meaning that is reasonably certain and defines objective boundaries.” Therefore, the District Court concluded the claims were invalid as indefinite. Sonix appealed the District Court’s decision to the Federal Circuit.

35 U.S.C. § 112 requires that a patent specification “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The United States Supreme Court (“Supreme Court”) has interpreted this provision of § 112 to mean that “a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” The Federal Circuit reaffirmed the position that terms of degree are not inherently indefinite and that the “certainty” which is required is not greater than reasonable. The Federal Circuit stated that where the written description provides guidance as to the scope of the claims, such a term is not indefinite.

The Federal Circuit disagreed with the District Court that the term “visually negligible” was purely subjective because such a claim term referred to whether the graphical indicator could be seen by the normal human eye. As a result, the Federal Circuit held that the term was more than a matter of opinion and instead provided an objective baseline for interpreting the claims. Additionally, the Federal Circuit found that the written description of the ‘845 patent contained sufficient details and specific examples to provide guidance on how to create visually negligible indicators. Finally, the Federal Circuit cited to the prosecution history and litigation history as evidence that the claim term was not indefinite. Accordingly, the Federal Circuit reversed the decision of the District Court.

FEDERAL CIRCUIT***Phigenix, Inc. v. ImmunoGen, Inc.*: Lack of Standing for Judicial Review**

On January 9, 2017, the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") issued its opinion in *Phigenix, Inc. v. ImmunoGen, Inc.*, holding that a party must have standing to seek review of an inter partes review decision from the U.S. Patent and Trademark Office ("USPTO") Patent Trial and Appeal Board ("PTAB").

Phigenix, a biotechnology, pharmaceutical, and biomedical research company, sought inter partes review by the USPTO of a patent directed to a method of treatment to combat a variety of cancers. The patent was owned by competitor ImmunoGen, and licensed to another competitor, Genentech. Phigenix had sought to license a patent it owned to Genentech, Phigenix's patent being directed to subject matter similar to ImmunoGen's patent. However, Genentech refused Phigenix's offer to license. The PTAB found the claims of ImmunoGen's patent nonobvious. Phigenix appealed the decision of the PTAB to the Federal Circuit. In response, ImmunoGen filed a motion to dismiss the appeal, arguing Phigenix lacked standing under Article III of the Constitution to appeal the PTAB's final written decision. Therefore, the issue presented in the appeal before the Federal Circuit was whether Phigenix had standing to seek judicial review before a federal court of a final decision by an administrative agency such as the USPTO.

The Federal Circuit first noted that Article III of the Constitution "confines the judicial power of federal courts to deciding actual 'Cases' or 'Controversies'." As outlined in the recent United States Supreme Court decision of *Spokeo, Inc. v. Robins*, 136 S. Ct. 1540, 1547 (2016), to establish standing, a party "must have (1) suffered an injury in fact, (2) that is fairly traceable to the challenged conduct of the [appellee – here ImmunoGen], (3) that is likely to be redressed by a favorable judicial decision." Standing under Article III of the Constitution is not necessarily required to appear before an administrative agency, and thus standing was not required for Phigenix to seek an inter partes review of ImmunoGen's patent before the USPTO. However, Phigenix was required to establish standing to seek review of the USPTO's final agency action before the Federal Circuit, a federal court. Further, the Federal Circuit stated that the party seeking to establish standing to appeal (the appellant) has the burden to produce evidence establishing standing, where such evidence can include affidavits or other evidence to demonstrate standing, and that such evidence must be presented in a timely manner.

Here, the Federal Circuit found that Phigenix did not provide sufficient evidence to establish that Phigenix had suffered an injury in fact. Phigenix was not at risk of infringing the patent owned by ImmunoGen and was not a prospective or actual licensee of the patent. Phigenix argued that it suffered an "actual economic injury" by virtue of the patent's existence because the patent increased competition between Phigenix and ImmunoGen.

However, the Federal Circuit found Phigenix did not substantiate these arguments with record evidence. Declarations submitted by Phigenix did not demonstrate an injury in fact because the alleged economic injuries were hypothetical, rather than actual. Accordingly, the Federal Circuit held that Phigenix lacked standing to seek review of the PTAB's final written decision, and dismissed the appeal.



USPTO

USPTO Patent Trends: Fiscal Year 2016 v. Fiscal Year 2015*

Recent statistics published by the United States Patent and Trademark Office (“USPTO”) showed a general increase in patent application filings and patent issuances across utility, design, and plant applications in fiscal year 2016. Additionally, the average time for a first office action to issue dropped from 17.3 months to 16.2 months. Finally, the number of Inter Partes Review (IPR) petitions filed decreased from 1,737 in 2015 to 1,565 in 2016. However, in that same period, the number of IPR decisions instituted increased from 801 to 871.

U.S. PATENT APPLICATION & ISSUED PATENT TRENDS† :

Patent		2015	2016	Δ%
Filings	Utility	578,121	607,753	5.13%
	Design	37,735	40,406	7.08%
	Plant	1,119	1,180	5.45%
	Reissue	1,087	1,072	-1.38%
Issued	Utility	295,460	304,568	3.08%
	Design	25,438	27,830	9.40%
	Plant	1,020	1,250	22.55%
	Reissue	531	459	-13.56%

**Average Application pendency to first Office Action: 2015: 17.3 months
2016: 16.2 months**

U.S. POST-GRANT PROCEEDING TRENDS‡ :

Inter Partes Review		
	2015	2016
Filed	1,737	1,565
Instituted	801	871
Joinders	116	77
Not Instituted	193	444
Covered Business Method		
	2015	2016
Filed	149	94
Instituted	91	51
Joinders	10	6
Not Instituted	43	45
Post Grant Review		
	2015	2016
Filed	11	24
Instituted	3	11
Not Instituted	0	7

* USPTO fiscal year: October 1 through September 30.

† All data comes from USPTO Performance and Accountability Report (Fiscal Year 2016)

‡ All data comes from USPTO Patent Trial and Appeal Statistics November 2016, available at https://www.uspto.gov/sites/default/files/documents/aia_statistics_november2016.pdf

TRADEMARK

USPTO Trademark Trends*

U.S. TRADEMARK APPLICATIONS AND REGISTRATIONS Fiscal Year 2016 v. Fiscal Years 1996-2015‡:

Trademarks Applications Filed			
Year	Registration	Renewal	§ 8 Affidavit
1996	200,640	7,543	22,169
1997	224,355	6,720	20,781
1998	232,384	7,413	33,231
1999	295,165	7,944	33,104
2000	375,428	24,435	28,920
2001	296,388	24,174	33,547
2002	258,873	34,325	39,484
2003	267,218	35,210	43,151
2004	298,489	32,352	41,157
2005	323,501	39,354	47,752
2006	354,775	36,939	48,444
2007	394,368	40,786	49,241
2008	401,392	42,388	68,470
2009	352,051	43,953	65,322
2010	368,939	48,214	61,499
2011	398,667	49,000	65,771
2012	415,026	63,636	76,646
2013	433,654	74,280	93,174
2014	455,017	67,865	107,823
2015	503,889	63,981	88,486
2016	530,270	72,744	87,447

Trademarks Registered and Renewed		
Regis. Issued	Renewed	Regis. (Inc. Classes)
78,674	7,346	91,339
97,294	7,389	112,509
89,634	6,504	106,279
87,774	6,280	104,324
106,383	8,821	127,794
102,314	31,477	124,502
133,225	29,957	164,457
143,424	34,370	185,182
120,056	34,735	155,991
112,495	32,279	143,396
147,118	37,305	188,899
150,064	47,336	194,327
209,904	42,159	274,250
180,520	42,282	241,637
164,330	46,734	221,090
177,661	44,873	237,586
182,761	59,871	243,459
193,121	63,709	259,681
206,555	56,166	279,282
208,660	58,284	282,091
227,407	62,604	309,188

* Except where otherwise noted, all data comes from USPTO Performance and Accountability Report (Fiscal Year 2016).

‡ USPTO fiscal year: October 1 through September 30.

TRADEMARK

USPTO Trademark Trends (Continued)

NON-U.S. ORIGIN APPLICATIONS:

Top 6 Foreign Countries to have Filed U.S. Applications in FY 2016	
Country	Number of Filings
China	28,779
United Kingdom	14,254
Germany	12,796
Canada	12,435
France	7,159
Japan	6,201

Residents of foreign countries filed 141,285 U.S. trademark and service mark applications in Fiscal Year (FY) 2016 – an increase of 12.6% over Fiscal Year 2015 numbers.

Residents of the United States** filed 388,982 U.S. trademark and service mark applications in Fiscal Year (FY) 2016 - an increase of 2.8% over Fiscal Year

TRADEMARK PENDENCY:

FIRST ACTION & TOTAL PENDENCY OF U.S. TRADEMARK APPLICATIONS (FISCAL YEARS 2006 - 2016)											
PENDENCY (Avg. Months Elapsed)	2006	2007	2008	2009	2010	2011	2012	2013	2014	2015	2016
Between Filing and Examiner's First Action	4.8	2.9	3	2.7	3.0	3.1	3.2	3.1	3.0	2.9	<u>3.1</u>
Between Filing and Notice of Allowance (including suspended and <i>inter partes</i> proceedings)	18	15.1	13.9	13.5	13.0	12.6	12	11.7	11.5	11.5	<u>11.3</u>
Between Filing and Notice of Allowance (excluding suspended and <i>inter partes</i> proceedings)	15.5	13.4	11.8	11.2	10.5	10.5	10.2	10.0	9.8	10.1	<u>9.8</u>

** Includes residents of American Samoa, Guam, and miscellaneous U.S. Pacific Islands.

TRADEMARK

USPTO Trademark Trends (Continued)

U.S. TRADEMARK TRIAL AND APPEAL BOARD:

Activity	Ex Parte	Opposition	Cancellations	Concurrent Use	Total
Cases pending as of 9/30/2015 (Total)	1,284	5,250	1,760	37	8,331
Cases filed During FY 2016	3,121	5,881	1,848	24	10,874
Disposals During FY 2016 (Total)	3,089	5,895	1,914	25	10,923
Before oral hearing or briefing	2,561	5,779	1,871	24	10,235
After hearing (no oral hearing)	477	82	36	1	596
After oral hearing	51	34	7	-	92
Cases pending as of 9/30/2016 (Total)	1,361	5,236	1,694	36	8,282
Awaiting Decision	56	22	5	-	83
In process before hearing or final briefing	1,260	5,214	1,689	36	8,199
Requests for Ext. of Time to Oppose FY 2016	19,055	-	-	-	-

MADRID PROTOCOL^{##}

Year	2010	2011	2012	2013	2014	2015	2016
International Registrations Designating the U.S. Office	14,252	15,890	16,411	17,322	17,268	21,996	19,640
U.S. Origin International Applications	4,182	4,913	5,445	6,034	6,617	7,364	7,709

^{##} All data comes from the World Intellectual Property Organization Statistics Data Center.

TRADEMARK

USPTO Raises Trademark Fees

On January 14, 2017, the United States Patent and Trademark Office (“USPTO”) officially implemented its new trademark filing and processing fees which largely follow the proposed trademark fee increases reported in our Firm Fall Newsletter. These are the first USPTO trademark fee increases in years and even decades, in the case of Trademark Trial and Appeal Board fees. Continuing the trend to incentivize applicants to file electronically, all paper filing fees have increased significantly while many of the electronic filing fees remain unchanged. One commonly used fee was reduced--the fee per Class to electronically file a request for an extension of time to file the statement of use dropped from \$150 to \$125.

Most noteworthy, the regular electronic new application filing fee without authorization for the USPTO to send e-mail communications to the applicant has increased from \$325 to \$400 per Class. Additionally, the fees for filing a petition to cancel and a notice of opposition have each increased \$100 per class, to \$400 per Class.

In addition, the following fees have increased:

Electronic Filing Operation	Previous Fee	New Fee
Filing an Application through TEAS Regular, per Class	\$325	\$400
Additional Processing Fee under §2.22(c), per Class	\$50	\$125
Filing an Affidavit under §8 of the Act through TEAS, per Class	\$100	\$125
Filing an Affidavit under §71 of the Act through TEAS, per Class	\$100	\$125
Filing a Request under §1(d)(2) of the Act for a Six-Month Extension of Time for Filing a Statement of Use under §1(d)(1) of the Act through TEAS, per Class	\$150	\$125
Filing a Petition to Cancel through ESTTA, per Class	\$300	\$400
Filing a Notice of Opposition through ESTTA, per Class	\$300	\$400
Ex Parte Appeal to the Trademark Trial and Appeal Board Filed through ESTTA, per Class	\$100	\$200
Filing a Request for an Extension of Time to File a Notice of Opposition under §2.102(c)(1)(ii) or (c)(2) through ESTTA	n/a	\$100
Filing a Request for an Extension of Time to File a Notice of Opposition under §2.102(c)(3) through ESTTA	n/a	\$200

TRADEMARK

USPTO Raises Trademark Fees (Continued)

Paper Filing Operation	Previous Fee	New Fee
Filing an Application on Paper , Per Class	\$375	\$600
Request to Divide an Application Filed on Paper, per New Application Created	\$100	\$200
Additional Processing Fee under §2.22(c) or §2.23(c), per Class	\$50	\$125
Filing an Application for Renewal of a Registration of Paper, per Class	\$400	\$500
Additional Fee for Filing a Renewal Application During the Grace Period on Paper, per Class	\$100	\$200
Correcting a Deficiency in a Renewal Application via Paper Filing	\$100	\$200
Filing an Affidavit under §8 of the Act on Paper, per Class	\$100	\$225
Additional Fee for Filing a §8 Affidavit During the Grace Period on Paper, per Class	\$100	\$200
Correcting a Deficiency in a §8 Affidavit via Paper Filing	\$100	\$200
Filing an Affidavit under §15 of the Act on Paper, per Class	\$200	\$300
Filing to Publish a Mark under §12(c) on Paper, per Class	\$100	\$200
Issuing New Certificate of Registration upon Request of Registrant, Request Filed on Paper	\$100	\$200
Certificate of Correction of Registrant's Error, Request Filed on Paper	\$100	\$200
Filing a Disclaimer to a Registration, on Paper	\$100	\$200
Filing an Amendment to a Registration, on Paper	\$100	\$200
Filing an Amendment to Allege Use under §1(c) of the Act on Paper, per Class	\$100	\$200
Filing a Statement of Use under §1(d)(1) of the Act on Paper, per Class	\$100	\$200
Filing a Request under §1(d)(2) of the Act for a Six-Month Extension of Time for Filing a Statement of Use under §1(d)(1) of the Act on Paper, per Class	\$150	\$225
Certifying an International Application Based on a Single Application or Registration, Filed on Paper, per Class	\$100	\$200
Certifying an International Application Based on More Than One Basic Application or Registration Filed on Paper, per Class	\$150	\$250
Transmitting a Request to Record an Assignment or Restriction, or Release of a Restriction, under §7.23 or §7.24 Filed on Paper	\$100	\$200
Filing a Notice of Replacement under §7.28 on Paper, per Class	\$100	\$200
Filing an Affidavit under §71 of the Act on Paper, per Class	\$100	\$225
Surcharge for Filing an Affidavit under §71 of the Act During Grace Period on Paper, per Class	\$100	\$200
Transmitting a Subsequent Designation under §7.21, Filed on Paper	\$100	\$200
Correcting a Deficiency in a §71 Affidavit Filed on Paper	\$100	\$200
Filing a Petition to Cancel on Paper, per Class	\$300	\$500
Filing a Notice of Opposition on Paper, per Class	\$300	\$500
Ex Parte Appeal to the Trademark Trial and Appeal Board Filed on Paper, per Class	\$100	\$300
Filing a Request for an Extension of Time to File a Notice of Opposition under §2.102(c)(1)(ii) or (c)(2) on paper	n/a	\$200
Filing a Request for an Extension of Time to File a Notice of Opposition under §2.102(c)(3) on paper	n/a	\$300
Petitions to the Director Filed on Paper	\$100	\$200

Staas & Halsey LLP files electronically whenever possible so many USPTO fees will likely remain unchanged for our clients.



STAAS & HALSEY LLP 45TH ANNIVERSARY EVENT



**FOUNDING ATTORNEYS
MR. H.J. STAAS AND MR. JAMES D.
HALSEY, JR. CELEBRATING WITH THEIR
WIVES 45 YEARS OF STAAS & HALSEY
LLP SUCCESS**

**CELEBRATING 45 YEARS OF STAAS &
HALSEY LLP AT CARNEGIE INSTITUTION
FOR SCIENCE ON DEC. 2, 2016 ARE
GUESTS, ATTORNEYS AND STAFF**



**FIRM NEWS****William F. Herbert, Partner****Alexander H. Buttermann, Attorney****STAAS & HALSEY LLP ATTENDING MAY 2017 INTA ANNUAL MEETING IN BARCELONA, SPAIN**

Mr. William F. Herbert and Mr. Alexander H. Buttermann will be attending the 139th INTA Annual Meeting. This year the meeting will be held from May 20 to May 24, 2017 and will be located in the beautiful Catalonia city of Barcelona, Spain. The INTA Annual Meeting has become the premier event for networking, continuing legal education, and committee and client meetings. This meeting will be attended by over 10,000 individuals from over 140 countries. The event boasts over 300+ educational sessions, 30+ networking receptions, and over 100 exhibitors. As stated by INTA “the INTA Annual Meeting provides your global team a forum for connections, dialogue, and engagement on key business issues, including intellectual property and brand strategy.” Our firm attorneys look forward to attending this event and taking full advantage of all the meeting’s opportunities this year. Please contact Mr. Herbert and/or Mr. Buttermann at trademarks@s-n-h.com if you will be attending INTA and would like to meet our firm members.

STAAS



HALSEY LLP

FIRM NEWS

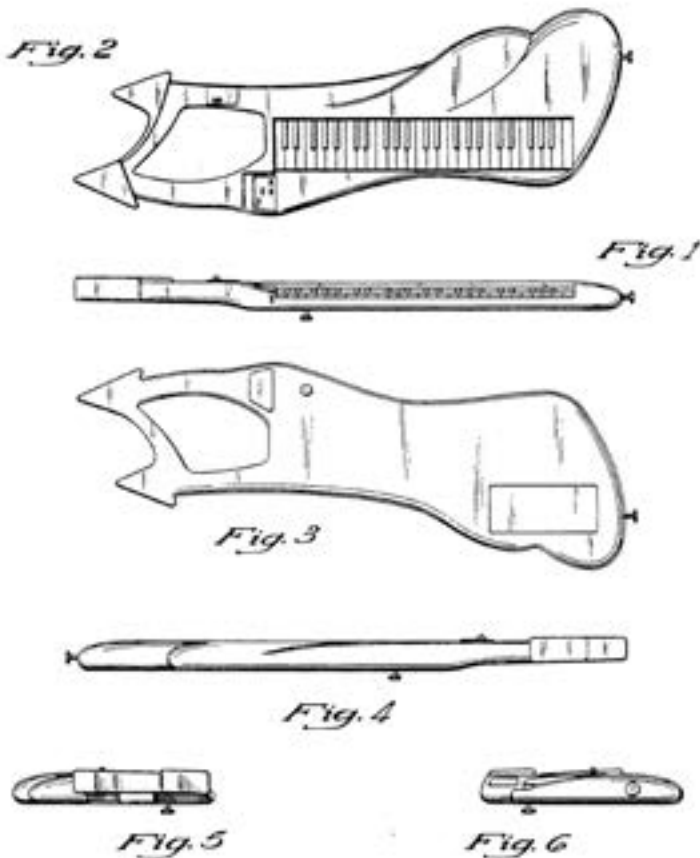
WINTER IN WASHINGTON, D.C.

Washington, D.C. in the winter is a sight to behold. Our winter season begins right after Thanksgiving in late November with various events to see and to attend. There is Christmas at George Washington's Mount Vernon. There is also the lighting of the National Christmas Tree on the Ellipse in December. In the evenings, Zoolights at the National Zoo, is a holiday treat of hundreds of thousands of twinkling lights in all shapes and colors, a National Zoo Choo-Choo and an opportunity to tube down an artificial snow hill.

For those who wish to go shopping, there is the Downtown Holiday Market on 8th and F Street, N.W. For the foodies among our tourist and visitors, there is Restaurant Week between January 30th and February 5th. This is an opportunity to taste all types of foods from around the world at really great restaurants and great prices. For those who want to have a little fun, the National Gallery of Art has its ice-skating rink open in their sculpture garden. For those who would rather be indoors, there are the myriad of museums and theatres sure to please everyone.



FIRM NEWS

**Celebrity Patent Inventor: Prince**

It's 1958 in Minneapolis, Minnesota, and one of the most amazing singers, songwriters, instrumentalists, and record producers of all times is born. He is known to many as Prince or The Artist Formerly Known as Prince or Jaime Starr or Joey Coco. But to the United States Patent and Trademark Office, he is known as Prince Rogers Nelson. In addition to his many artistic accomplishments, Prince was an inventor and patent holder of U.S. Patent 349,127, a "Portable, Electronic Keyboard Musical Instrument." Dubbed the "Purpleaxe," it is a hybrid between a guitar and a sitar. In the 1990's, Prince was known to have had the "Purpleaxe" used during concerts by his keyboardist, Tommy Barbarella. On April 21, 2015, Prince died in Chanhassen, Minnesota and left behind a legacy of music, art, talent, and U.S. Patent 349,127.

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. ©2017 Staas & Halsey LLP

Editor-In-Chief: David M. Pitcher

Contributor: Jeremy Stroh

To Unsubscribe Please Email unsubscribe@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 subscribe@s-n-h.com

