

# State of Intellectual Property

*Presented by*

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## District Court Patent Litigation

- Courts are still open, and cases are still being filed and litigated
- Trends (per Lex Machina as of June 1)
  - How does 2020 compare to 2019?
  - What are the busiest venues?
  - Who are the busiest judges?



## District Court Patent Litigation

- Expect delays
  - Trials are generally continued
  - Other deadlines generally unaffected, but courts are delayed
  - Restrictions on travel for parties, attorneys
  - Business disruptions
  - Many litigants are agreeing to scheduling order extensions



## Work-Arounds for Clients

- Alternative dispute resolution
- Video depositions
- Video / telephonic court hearings
- Video trials



## How has COVID-19 Affected the USPTO?

- Coronavirus Aid, Relief, and Economic Security Act (CARES Act) signed on March 27 granted extensions for certain filings and fees due between March 27 and May 31
  - Can be filed on or before **June 1, 2020**
  - Requires statement that delay in filing or payment was *materially* due to COVID-19 outbreak
  - Petition fee waived, but any regular USPTO fee still due
- What types of filings are eligible?
  - Responses to Office Actions
  - Statements of Use or Extensions
  - Declarations of Use/Renewal Applications
  - Extensions of time to oppose/Notices of Opposition



## How has COVID-19 Affected the USPTO?

- Trademark Trial and Appeal Board proceedings
  - For all other filings before the Board, requests to extend *ex parte* appeal deadlines or motions can be filed
  - For *inter partes* proceedings, the parties can agree to extensions or suspensions
- Similar relief available for patent-related filings and fees
  - Responding to Office actions
  - Payment of issue fees or maintenance fees
  - PTAB proceedings
  - Pilot program to fast track certain patent applications related to COVID-19



## How has COVID-19 Affected the USPTO?

- Looking at Filing Deadlines related to Use in Commerce
  - Registrations: Is a grace period available?
  - Registrations: Declaration of Excusable Nonuse
  - Pending Applications: Extension of Statement of Use deadline
  - Pending Applications: if no additional SOU extensions are available, consider filing new intent to use application



## How has COVID-19 Affected the Copyright Office?

- Expanded capabilities to receive electronic submissions
  - Most applications could already be filed electronically
  - Other submissions previously required to be physically mailed are now available electronically
    - Requests for Reconsideration of Refusals
    - Notices of Termination
- Relief from certain physical deposit copy requirements
  - Option of uploading an electronic copy of the work in addition to mailing the required physical copies.
  - Deposits Must be identical (supported by statutory declaration); physical copy must still be mailed to the CO



# *USPTO v. Booking.com, B.V.*

A broadcast graphic for a C-SPAN Supreme Court live event. The background is a teal and gold image of the Supreme Court building. In the top right corner, the word "LIVE" is displayed in white. Two portrait photos are shown side-by-side: Justice Thomas on the left and Lisa Blatt on the right. Below each photo is their name. A central banner reads "TRADEMARKING GENERIC TERMS". Below that, a dark blue box contains the text "Oral Argument" in yellow and "U.S. Patent & Trademark Office v. Booking.com BV" in white. The "SUPREME COURT" logo is on the bottom left, and the "C-SPAN" logo is on the bottom right. A bottom banner reads "SUPREME COURT LIVE | First Time in History".

LIVE

Justice Thomas

Lisa Blatt

TRADEMARKING GENERIC TERMS

Oral Argument  
U.S. Patent & Trademark Office v. Booking.com BV

SUPREME COURT

C-SPAN

SUPREME COURT LIVE | First Time in History



*Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S.Ct. 1492 (2020)

- Supreme Court held rejected categorical rule that a plaintiff can be awarded profits only after proving willful infringement. Willfulness can be considered in analysis, but may not be an absolute precondition.



*Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp.*, No. 18-108  
(2020)

- Unanimous opinion
- Court held that because the trademark action at issue challenged raised different claims than an earlier action between the parties, the defendant was not precluded from raising new defenses that it had not pursued in the earlier suit



## Recent Supreme Court Copyright Decisions

- *Allen v. Cooper*, 140 S. Ct. 994 (2020)
  - Striking down Copyright Remedy Clarification Act (CRCA) of 1990 as unconstitutional. 11<sup>th</sup> Amendment prohibits Congress from using its Article I powers to remove states' sovereign immunity from copyright infringement suits.
- *Georgia v. Public.Resource.Org, Inc.*, 140 S. Ct. 1498 (2020)
  - Non-binding annotations to state's official code, prepared in the course of legislative duties, are ineligible for copyright protection, under government edicts doctrine.



## PTAB / TTAB Litigation

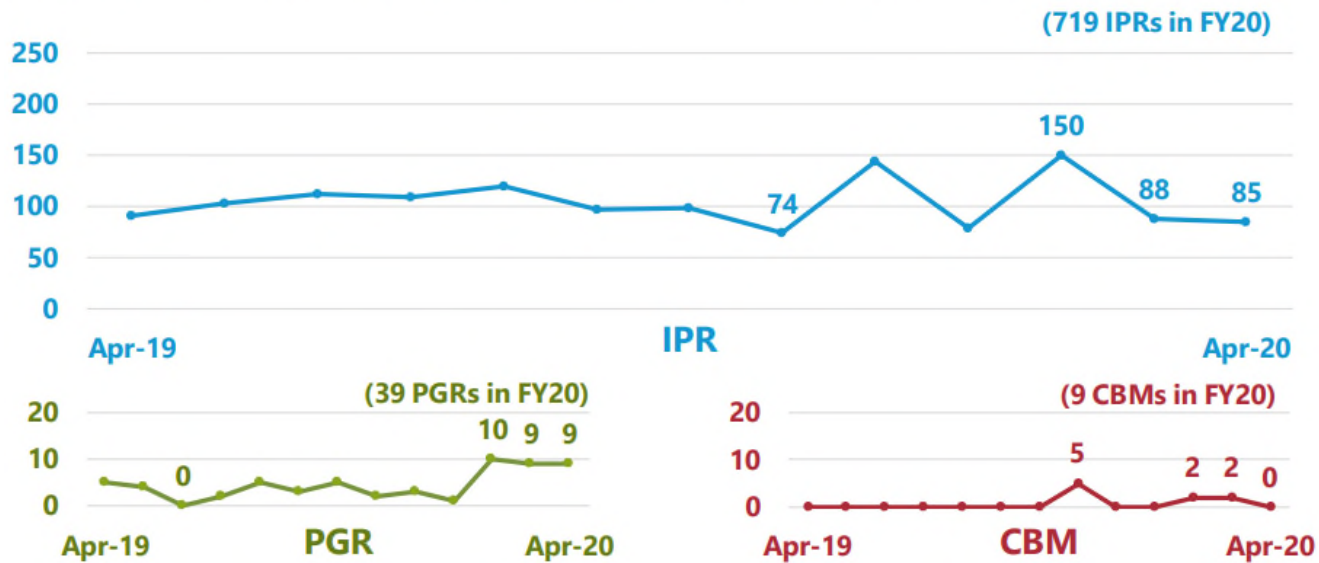
- Oral hearings and examining attorney interviews conducted by video or telephone since mid-March
- Otherwise business as usual

# PTAB Statistics (as of April 30)

- Filings (IPR, PGR, CBM) remain steady through April 2020

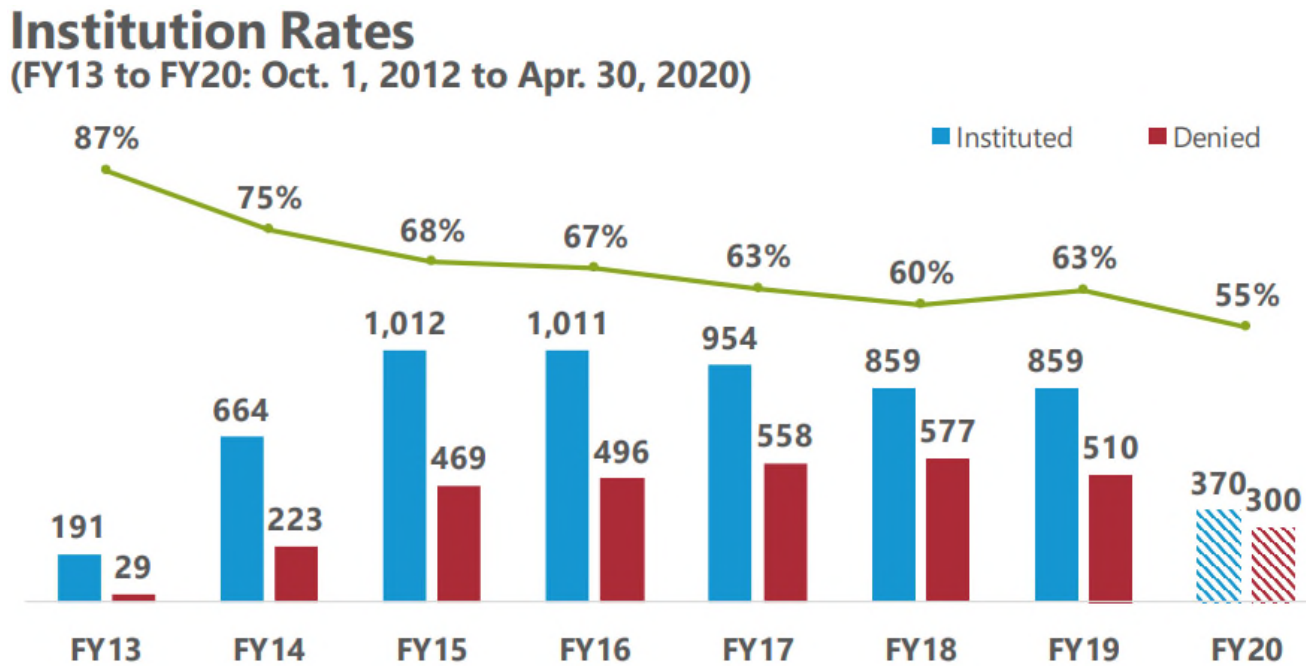
## Petitions Filed by Month

(Apr. 2020 and Previous 12 Months: Apr. 1, 2019 to Apr. 30, 2020)



# PTAB Statistics (as of April 30)

- Steady decline of institution rates continues, and accelerates





## Recent Notable Decisions Impacting PTAB Litigation

- *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752 (PTAB Sept. 12, 2018)
  - Discretionary denial of *inter partes* review (IPR) based on pending district court litigation involving similar parties, patent, prior art
  - Possible impact on accelerated decline of IPR institution rate from FY2019 to FY2020





## Recent Notable Decisions Impacting PTAB Litigation

- *Thryv, Inc v. Click-To-Call Techs., LP*, 140 S. Ct. 1367 (2020)
  - Reaffirming non-appealability of PTAB decisions regarding institution of IPR, under 35 U.S.C § 314(d), including timeliness decisions under § 315(b).
- *ESIP Series 2, LLC v. Puzhen Life USA, LLC*, No. 2019-1659 (Fed. Cir. May 19, 2020)
  - Extending *Thryv* to bar appeal of PTAB real-party-in-interest determination under § 312(a)(2).



## Protecting IP from Bad Actors

- Dramatic shift to online shopping has created fertile ground for infringers
- Large increase in knock-off products, both in industries that were hard hit before (apparel, luxury goods) and the “new” essentials (pharmaceuticals, medical products, health and safety items)
- Even legitimate products are being sold at outrageous mark-ups
  - 3M lawsuits to fight N95 mask price gouging



# Fresh Perspectives on Intellectual Property Portfolios

- Internal “Brand Audit”
  - What is registered now
  - What is not registered
  - Prioritize what needs protection
- Register Key IP Rights
  - Geographic coverage
  - Enforcement coverage, i.e., what online platforms require a registration to submit complaints?



# Fresh Perspectives on Intellectual Property Portfolios

- Identify gaps in goods/services coverage
  - Shifting to a virtual world
  - Expanding into new technology
- Forward-looking portfolio questions
  - Any brands that will be phased out?
  - Licensing or cross-marketing opportunities?
  - Selling brands?



## Protecting IP from Bad Actors

- Shifting to New Policing Strategies
  - Educate consumers about online traps
  - Test buy products from unfamiliar sources
  - Various take-down procedures
  - Review of social media platforms for unauthorized accounts
  - Continue to rely on customs enforcement, but may be slowed or stalled

# Social Media Good Housekeeping



Chicago Bears  
@ChicagoBears

Just Kidding!

Hi, we're OurMine.

We are here for 2 things:

- 1) Announce that we are back
- 2) Show people that everything is hackable

to improve your accounts security

Contact us: [contact@ourmine.org](mailto:contact@ourmine.org)

For security services visit: [ourmine.org](http://ourmine.org)

Follow [@OurM1ne](https://twitter.com/OurM1ne) for news.

[#OurMineBack](https://twitter.com/OurMineBack)

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7 Retweets 10 Likes



Kansas City Chiefs [@Ch...](#) now

Hi, we're Back (OurMine).  
We are here to Show people that  
everything is hackable

to improve your accounts  
security

Contact us: [contact@ourmine.org](mailto:contact@ourmine.org)

For security services visit:  
[ourmine.org](http://ourmine.org)

Follow [@OurM1ne](https://twitter.com/OurM1ne) for news.  
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McDonalds in a hood near you [@DFNCTSC](#)

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3,642  
RETWEETS

572  
FAVORITES



9:01 AM - 18 Feb 13



## **Social Media Good Housekeeping**

- Secure your social media accounts with two or three-factor authentication
- Create and enforce appropriate corporate policies
- Accounts registered in company's name
- Limit persons with administrative control

## Non-Infringing Gripe Sites/ Fans

NETFLIX

August 23, 2017

Emporium Arcade Bar  
% Danny and Doug Marks  
2363 N. Milwaukee Ave  
Chicago, IL 60647

Via email 

Danny and Doug,

My walkie talkie is busted so I had to write this note instead. I heard you launched a *Stranger Things* pop-up bar at your Logan Square location. Look, I don't want you to think I'm a total wastoid, and I love how much you guys love the show. (Just wait until you see Season 2!) But unless I'm living in the Upside Down, I don't think we did a deal with you for this pop-up. You're obviously creative types, so I'm sure you can appreciate that it's important to us to have a say in how our fans encounter the worlds we build.

We're not going to go full Dr. Brenner on you, but we ask that you please (1) not extend the pop-up beyond its 6 week run ending in September, and (2) reach out to us for permission if you plan to do something like this again. Let me know as soon as possible that you agree to these requests.

We love our fans more than anything, but you should know that the demogorgon is not always as forgiving. So please don't make us call your mom.

Thanks,





# Thanks from Lathrop GPM!



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