

LAIPLA BULLETIN

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November 8, 2011

President's Message

by Brian G. Arnold

Greetings and welcome to LAIPLA's 2011-12 fiscal year, our 78th year of serving the Southern California intellectual property community. Before I highlight the many events that LAIPLA has hosted in the first two months of this year, I ask you to mark your calendars for some upcoming events that you won't want to miss:

- **November 8, 2011:** LAIPLA Dinner Event at The California Club – featuring Adrian and Erica Pruetz of the Pruetz Law Group discussing their recent U.S. Supreme Court case, *Stanford v. Roche*
- **December 6, 2011:** Joint LAIPLA/LACBA Event at the Ronald F. Deaton Civic Auditorium – featuring Central District Judges Audrey B. Collins, Andrew J. Guilford, Samuel James Otero, Otis D. Wright II and George H. Wu discussing the New Patent Litigation Pilot Program in the Central District of California: What Every Patent Litigator Needs to Know
- **June 8-10, 2012:** LAIPLA Spring Seminar at The Lodge at Torrey Pines

Your LAIPLA Board and Committees have been busy during the first two months of the 2011-12 year, arranging numerous events for our members. We started the year with a free Networking Social in September, providing our members an opportunity to catch up after our summer break, and allowing us to meet some new members. We thank Fulwider Patton LLP and Christie Parker Hale LLP for their generous sponsorship of this event, and Bitu Rahebi and Lauren Schneider for organizing the event. Our monthly dinner meetings kicked off in October, with Hal Wegner providing a primer on the America Invents Act. Thanks to Hal for his spirited performance, and to Mark Treitel, Diane Hutnyan and Darren Franklin for bringing this outstanding event to our members. The following week, LAIPLA jointly hosted a Trademark Boot Camp in Century City. Alex Schlee and Keith Newbury were instrumental in allowing LAIPLA to co-host this event for a second consecutive year.

The Law School Outreach Committee, chaired by Vision Winter and assisted by Bitu Rahebi and Darren Franklin, has preached the wonders of intellectual property law to hundreds of local law students over the past month. So far, we have visited USC, Loyola, UCLA, and Southwestern, with Pepperdine and Whittier to follow. We were delighted to offer free admission for law students at our October monthly meeting, and we will continue to invite students to future meetings at reduced rates.

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Event Notice: November 8, 2011 Dinner

The U.S. Supreme Court Addresses Patent Ownership Issues: *Stanford v. Roche*
November 8, 2011
The California Club
538 S. Flower Street, Los Angeles

LAIPLA is pleased to announce our next monthly meeting will be held on Tuesday November 8, 2011 at The California Club in Los Angeles beginning at 6:00 p.m. Adrian and Erica Pruetz of Pruetz Law will discuss their recent U.S. Supreme Court case of *Stanford v. Roche*. The event flyer and registration form are attached to this Bulletin. Register today and don't miss out on this great event. We look forward to seeing you on the 8th.

President's Message

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We look forward to bringing many more events to the membership, including our annual Washington in the West and Judges' Night events in the first few months of 2012.

If you have not yet renewed your membership for 2011-12, please take this opportunity to visit www.laipla.org and complete the member or firm application. Remember that a firm application grants membership privileges to an unlimited number of listed individuals from your firm or company, and that all members enjoy reduced rates at LAIPLA events.

Finally, if you have any interest in getting involved with LAIPLA, please contact me at 310-282-2160 or barnold@loeb.com. We have several opportunities available. We still are seeking chairs for the Spring Seminar, In-House Outreach, Sponsorship and Marketing committees. In addition, we always welcome new committee members for these and other committees, including Washington in the West, Judges' Night, Monthly Meetings, Membership, Website, and Social Networking. Get involved and join us as we craft an informative and entertaining year for all LAIPLA members.

Article: Protecting Your Trademarks From .XXX

By: R. Parrish Freeman Jr.
Workman Nydegger

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

Law360, New York (October 14, 2011, 12:36 PM ET) — One thing all Internet domain names (e.g., yourbusiness.com) have in common is the necessity of a top level domain, or "TLD," such as .com, .net, .us or any of over 250 other country-code and generic TLD extensions. As of September 2011, a new TLD, .xxx, has been added. The new .xxx TLD is, as the name suggests, a TLD dedicated to Internet-based adult entertainment. It is a "sponsored" TLD, meaning the public at large cannot register .xxx domain names, only members of the "Sponsored Community," namely, persons and entities affiliated with providing Internet-based adult entertainment content. But this by no means guarantees that a trademark owned by a nonadult entertainment provider is safe from becoming part of a .xxx domain name. The same force that has driven piracy of domain names for years — the ability of high-value trademarks to draw Internet traffic — will no doubt drive adult entertainment providers to try to register high-value trademarks as .xxx domain names. An adult entertainment provider might thus try to register a .xxx domain name featuring your valuable trademark simply because of its notoriety, hoping to co-opt the fame of your mark into increased traffic to its website.

Cognizant of this risk, the Internet Corporation for Assigned Names and Numbers, the governing body for Internet domain names, has placed additional conditions on the initial allocation of .xxx domain names. Chief among these is the opportunity for nonadult entertainment providers to reserve their trademarks during a "sunrise" period that is presently underway or, failing that, to register them later as nonresolving domain names incapable of linking to websites. In either instance, you can act now to decrease the likelihood that your trademarks will appear in .xxx domain names and thereby link your mark and your company to adult entertainment.

Rules for .xxx Domain Name Initial Allocation

The initial allocation of .xxx domain names will take place over the next several months, divided into a "sunrise" phase and a "landrush" phase. The sunrise phase, which began Sept. 7 and closes Oct. 28, consists of a "Sunrise A" for adult entertainment providers and a "Sunrise B" for trademark owners who are not providers of adult entertainment and who wish to reserve the .xxx domain name forms of their trademarks to prevent unwanted registrations. Stated differently, Sunrise A is for registration requests from providers of adult entertainment, whereas Sunrise B is for reservation (i.e., blocking) requests by owners of trademarks who are not adult entertainment providers.

If an adult entertainment provider registers a domain name, it becomes the listed owner. If a nonadult entertainment provider reserves a domain name, it removes that domain name from the pool of potential .xxx domain names (subject to an exception discussed below). The cost of reserving a domain name runs between \$200 and \$300 (not including attorney fees), depending on the registrar providing the service. You can choose from any of the multitude of registrars listed at the .xxx registry operator's website, www.icmregistry.com.

If you pursue a Sunrise B reservation, you should understand your rights and those of the competing Sunrise A applicants. To register a .xxx domain name, a Sunrise A applicant must (1) be a provider of adult entertainment and (2) own either a registered trademark or an existing and commercially active domain name under another TLD (e.g., .com, .net, etc.). In other words, during the Sunrise A period, an adult entertainment provider cannot register a .xxx domain name for which it does not already own a trademark or commercially active domain name. In contrast, a nonadult entertainment provider cannot reserve or block a .xxx domain name unless it already owns a registered trademark for that name. The trademark

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registration can be a registration anywhere in the world, but use of a commercially active domain name is not enough. The framework of this process gives rise to serious potential for conflict because all Sunrise A and B applications are being processed together, not in order of application. At the close of the sunrise period, Oct. 28, conflicts will be assessed and announced to the concerned parties.

Registration conflicts among adult entertainment providers will go to auction. Conflicts between nonadult entertainment providers reserving domain names will result in the domain being reserved, or blocked, from registration. Neither reserving party will receive a refund in this instance but everyone will still receive what they paid for, namely the blocking of the .xxx domain name version of their trademark.

Importantly, a successful reservation by a nonadult entertainment provider does not result in a domain name registration, only a reservation, so there is no "Whois" information identifying the reserving party as the owner of a .xxx domain name. Rather, the domain will resolve to a site that advises that the domain is reserved from use as a .xxx domain, and the Whois information will reflect that of the registrar or the registry operator. This provision allows trademark owners to block registration without having their marks associated with a .xxx domain.

Sunrise A vs. Sunrise B

If there is a conflict between registration by an adult entertainment provider and reservation by a nonadult entertainment provider, notice of the conflict will be provided to both. The adult entertainment provider will be given priority and may choose to proceed with its registration. From a practical point of view, however, the adult entertainment provider will be deemed to have notice of the conflicting mark. The fact of notice to the adult entertainment registrant can be significant. If the owner of the trademark decides to proceed against the adult entertainment provider under the Uniform Dispute Resolution Policy (UDRP) to recover the domain name, the fact that the adult entertainment provider knew of the existence of the trademark makes it more likely that the nonadult entertainment provider will be able to prevail.

Under the UDRP, an adult entertainment provider who registers a domain name that is identical or confusingly similar to your trademark can be forced to transfer that domain name to you upon proof of bad faith registration and use, and if the adult entertainment provider does not otherwise have any colorable, legitimate interest in using the mark. Notice of the trademark goes a long way to proving the requisite element of bad faith registration and use. In other words, if you are not successful in reserving your trademark during the Sunrise B phase as a result of a conflict with a Sunrise A applicant, you will have an improved likelihood of prevailing against that same applicant under the UDRP. As a practical matter, however, this situation probably will not arise unless your registered trademark is identical or very close to a registered trademark or domain name belonging to an adult entertainment provider prior to its application for a .xxx domain name for that same mark.

Landrush — Nonadult Entertainment Providers Sidelined

The Sunrise phase is open to members and non-members of the Sponsored Community. The subsequent Landrush phase (Nov. 8 through Nov. 25, 2011) is open only to members of the adult entertainment community. Unlike the Sunrise A phase, Landrush is open to all adult entertainment providers regardless of whether they hold trademarks or domain names for the mark sought to be registered.

Nonadult entertainment providers are prevented from participation in the Landrush and Sunrise A phases by requiring applicants to proceed through a multistep membership application entailing telephone calls, PIN numbers and various attestations, including attesting to participation in the provision of online adult entertainment. This procedure is intended in part to prevent the mischievous or malicious registration of trademarks, celebrity names or public figure names as .xxx domain names for the sole purpose of defaming them by association with pornography. Landrush applications are not processed in order of receipt and conflicts are resolved by way of auction.

General Availability — Your Opportunity to Register if You Missed Sunrise B

Dec. 6, 2011 begins the "general availability" phase. It differs from the previous phases in that applications are processed in the order received, just as is the case with registering domains for any ordinary TLD. Only adult entertainment providers can apply for "resolving" domain names, i.e., domain names that actually access adult entertainment. Nonadult entertainment providers can apply to register nonresolving domain names, i.e., domain names that will not link to adult entertainment content. While Sunrise B was limited to nonadult entertainment providers having proof of issued trademarks, during the general availability phase nonadult entertainment providers may register any term, regardless of whether they have a trademark for that name, with the caveat that the resulting domain name will be incapable of resolving to an active website.

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Rapid Evaluation Service (RES)

Finally, the .xxx domain registry will be implementing a first-of-its-kind Rapid Evaluation Service (RES) under which domains constituting clear violations of famous marks or personal (i.e., celebrity) names will be suspended pending further action by the parties. This is something that may become more prevalent as other new TLDs come online, but it is yet unknown how it will play out in practice.

Conclusion

Whether you have a single registered trademark or an entire portfolio, it makes sense to look into reserving your marks during the initial sunrise period. An ounce of prevention is worth a pound of cure, as the saying goes. As with all new regulatory schemes, there will undoubtedly be some surprises and unforeseen issues that will need to be worked out. Nonetheless, the rules have been set and the most prudent course for now is to follow them as written. In this way you will have done everything you can on the front end to prevent your trademarks from becoming .xxx domain names.

Article: Debating Foreign Copyright Restoration

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

By: John Chatowski
Nixon Peabody LLP

Law360, New York (October 13, 2011, 1:17 PM ET) — Recently, the U.S. Supreme Court heard oral argument in *Golan v. Holder*, a challenge to Congress' 1994 amendments to the Copyright Act, which will have a significant impact on owners of foreign copyrighted works that formerly lapsed into the public domain in the United States, as well as those who have in good faith relied on their status as public works. The Supreme Court will decide whether Congress exceeded its powers when, in amending the Copyright Act to conform U.S. copyright law with the United States' treaty obligations under the Berne Convention, Congress restored copyright protection for certain foreign works that had fallen into the public domain in the United States. This article discusses the background of the case, as well as its implications.

The Copyright Act provides that the owner of a copyright has the exclusive right to distribute copies of its works, including by sale or other transfer of ownership. 17 U.S.C. § 106(3). However, once the term of a work's copyright protection ends, it enters the public domain. And once in the public domain, Americans generally may use these works without restriction. These rules may change, however, with respect to certain foreign works that, for one reason or another, have slipped into the public domain. In *Golan v. Holder*, the Supreme Court will decide whether Congress exceeded its powers when, in amending the Copyright Act to conform U.S. copyright law with the United States' treaty obligations under the Berne Convention for the Protection of Literary and Artistic Works and the Uruguay Round of Negotiations on the General Agreement on Tariffs and Trade, Congress restored copyright protection for certain foreign works that had fallen into the public domain in the United States.

In 1989, the United States joined the Berne Convention, which requires each signatory nation to provide the same basic copyright protections to authors in other member countries that it provides to its own members. Currently, 164 countries are parties to the Berne Convention. Article 18 of the convention provides that members restore copyright protection to certain unprotected foreign works whose copyright terms have not yet expired in their countries of origin. However, after the United States joined the Berne Convention, Congress, in its implementing act (the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988)) did not fully implement Article 18. See 102 Stat. at 2860 ("Title 17, United States Code, as amended by this Act, does not provide copyright protection for any work that is in the public domain in the United States.") It was not until six years later, in 1994, that Congress enacted the Uniform Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976-81 (1994) ("URAA"), which brought the United States into conformity with Article 18 of the Berne Convention. What this means is that as of the effective date of the URAA, Section 514 "'restores' copyrights in foreign works that were formerly in the public domain of the United States for one of three specified reasons: failure to comply with formalities, lack of subject matter protection, or lack of national eligibility." *Golan v. Holder*, 609 F.3d 1076, 1081 (10th Cir. 2010) (citing 17 U.S.C. § 104A(a), (h)(6)(C)) (holding that Section 514 of the URAA did not constitute an infringement of the plaintiffs' First Amendment rights.) Section 514 does not, however, "restore" copyright protection in the United States for foreign works that have entered the public domain through the expiration of

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their term of copyright protection, either under United States law or the law of the country of origin. 17 U.S.C. § 104A(h)(6)(B) and (C).

The URAA also provides certain protections for those persons who have used these restored foreign works. For example, to enforce a restored copyright against a “reliance party,” a foreign copyright owner must either file notice with the Copyright Office within 24 months after restoration, or serve notice on the reliance party. 17 U.S.C. § 104A(d)(A)(i) and (B)(i). During this reliance period, reliance parties may sell or dispose of these restored works, but they may not make additional copies, and they may be sued for infringing acts that occur after the reliance period. 17 U.S.C. § 104A(d)(2)(A)(ii)(I) and (B)(ii)(I) and 109(a). Finally, a reliance party that creates a derivative work based on a restored work — for example, a translation, an arrangement or a motion picture version — may continue to exploit those derivative works if they reach an agreement on “reasonable compensation” with the restored copyright owner. If no such agreement can be reached, a federal court will determine the amount of compensation. 17 U.S.C. § 104A(d)(3)(A) and (B). A restored work under Section 514, therefore, would include, for example, a book created and published abroad with a valid foreign copyright that previously would not qualify for protection under U.S. law because the author did not satisfy all of the formalities for copyright registration in the U.S.

In 2001, the plaintiffs in *Golan* challenged Section 514 of the URAA, claiming, among other things, that Congress exceeded its powers when it restored copyright protection for foreign works that had entered the public domain. While *Golan* was slowly weaving its way through the federal courts, the U.S. Supreme Court decided *Eldred v. Ashcroft*, 537 U.S. 186 (2003). There, the plaintiffs argued that Congress exceeded its powers under the Copyright and Patent Clause of the United States Constitution (Art. I, § 8, Clause 8) when it passed the Copyright Term Extension Act (“CTEA”) in 1988, which enlarged the duration of copyrights that had not yet fallen into the public domain by 20 years — now most copyrights run from creation until 70 years after the author’s death. Writing for a seven-member majority, Justice Ruth Bader Ginsburg held that the CTEA did not run afoul of the Copyright and Patent Clause, and was consistent with prior acts of Congress extending copyright protection. Regarding this last point, Justice Ginsburg explained that “Congress, from the start, has routinely applied new definitions or adjustments of the copyright term to both future works and existing works not yet in the public domain.” *Eldred*, 537 U.S. at 213.

Golan now presents the Supreme Court with an opportunity to either extend its reasoning in *Eldred* to works now in the public domain, or hold that Congress exceeded its powers under the Constitution when it brought U.S. copyright law into conformity with the Berne Convention. Today’s Supreme Court, however, differs significantly from the court that decided *Eldred*. Chief Justice William Rehnquist and Justices Sandra Day O’Connor and David Souter, who joined Justice Ginsburg’s majority opinion in *Eldred*, have been replaced by Chief Justice John Roberts and Justices Samuel Alito and Sonia Sotomayor. Justice John Paul Stevens, who along with Justice Stephen Breyer, dissented in *Eldred*, has been replaced by Justice Elena Kagan. Justice Kagan, however, has recused herself from *Golan* — likely because of her role as U.S. Solicitor General for the Obama administration. Thus, only eight members of the Supreme Court will decide *Golan*, leaving open the possibility of an affirmance of the Tenth Circuit by an equally divided court.

From a public policy perspective, proponents of Section 514 of the Copyright Act contend that it ensures legal protection for U.S. copyright owners abroad by evening the playing field with foreign copyright owners in other Berne member countries. On the other side of the debate, however, are those such as the *Golan* plaintiffs, who have in good faith relied on the fact that certain foreign works have entered the public domain in the U.S. Exactly how many foreign works may be affected by the Supreme Court’s decision is unknown, but some have suggested it is “probably ... in the millions.” See Brief for the Petitioners on Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit, Supreme Court Case No. 10-545, at p. 10 (quoting Marybeth Peters, *The Year in Review: Accomplishments and Objectives of the U.S. Copyright Office*, 7 *Fordham Intell. Prop. Media & Ent. L.J.* 25, 31 (1996)). Not surprisingly, therefore, *Golan* has been on the radar screens of many owners of foreign works that are in the public domain in the U.S., and many users of such works who are aware of Section 514 of the Copyright Act. However, there may be numerous companies or other entities in the U.S. who are using foreign works (either knowingly or unknowingly) that now may be exposed to potential liability depending on the outcome of the Supreme Court’s decision in *Golan*.

Article: Top 10 Provisions of the America Invents Act

By: Dean A. Pelletier

The view and opinions expressed in this article are those solely of the author(s) and are not of the Los Angeles Intellectual Property Law Association or its members.

McAndrews Held & Malloy Ltd.

Law360, New York (October 12, 2011, 1:16 PM ET) — On Sept. 16, 2011, President Obama signed into law the America Invents Act of 2011 (the “AIA”). The AIA makes a number of changes to U.S. patent law, and those changes will take effect on various dates. The wisdom of the AIA and its effect on U.S. patent applicants and owners, including U.S. businesses, ultimately can be assessed only after the U.S. Patent and Trademark Office and U.S. courts apply the amended and new laws to various circumstances and disputes. Nevertheless, there are 10 AIA provisions that this author currently expects to noticeably impact the U.S. patent landscape. Those “Top 10” provisions, in no particular order, are:

1) The U.S. patent system will change from a first-to-invent system to a first-inventor-to-file system.

As of March 16, 2013, the right to a U.S. patent depends on who first files his or her patent application with the PTO and no longer depends on who first invents the claimed invention(s). AIA § 3(b), (n); 35 U.S.C. § 102(a).[1] In other words, as of that date, an application or resulting patent that contains, or at any time contained, a claimed invention with an effective filing date of or after March 16, 2013, or a corresponding priority reference, is subject to the new first-inventor-to-file rule. Id. In short, an applicant will need to be more diligent in filing an application(s) with the PTO, as any delay in filing could result in a loss of patent rights.

2) There will be a revamped system to challenge applications and patents at the PTO, with interference proceedings (i.e., proceedings to determine who first invented the claimed invention(s)) being phased out and the revamped system to include:

Derivation Proceedings

“Derivation proceedings” are new PTO proceedings. As of March 16, 2013, derivation proceedings allow a person to correct the named inventor(s) on an application or patent. AIA § 3(i), (n); 35 U.S.C. § 135(b). That is, an applicant, i.e., petitioner, can correct the named inventor(s) if it can establish that “an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed.” AIA § 3(i); 35 U.S.C. § 135(a).

As of March 16, 2013, an application or resulting patent that contains, or at any time contained, a claimed invention with an effective filing date of or after March 16, 2013, or a corresponding priority reference, is subject to a possible derivation proceeding. AIA § 3(i), (n); 35 U.S.C. § 135(a). Importantly, a petitioner must seek to institute a derivation proceeding “within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention[.]” AIA § 3(i); 35 U.S.C. § 135(a);

Post-Grant Review

“Post-grant review” is a new type of PTO review. As of Sept. 16, 2012, post-grant review allows a person who is not the owner of a patent to seek “to cancel as unpatentable 1 or more claims of [the] patent[.]” AIA § 6(d), (f)(2); 35 U.S.C. § 321(a), (b). More specifically, within nine months after the patent is granted or reissued, that person can argue that the PTO should invalidate the challenged claim(s) because, for example, it is anticipated (i.e., not novel), obvious, indefinite or not properly supported by the patent specification. AIA § 6(d); 35 U.S.C. § 321. In a post-grant review, invalidity can be established through, for example, patents, printed publications and affidavits or declarations of supporting factual evidence or expert opinions, and the standard of proof is preponderance of the evidence. AIA § 6(d); 35 U.S.C. §§ 322(a), 326(e);[2] and

Inter Partes Review

“Inter partes review,” which is technically a new type of PTO review. That is, inter partes review is the same or similar in some respects to inter partes reexamination, which is being phased out. As of Sept. 16, 2012, inter partes review allows a person who is not the owner of a patent to seek “to cancel as unpatentable 1 or more claims of [the] patent[.]” AIA § 6(a), (c); 35 U.S.C. § 311(a), (b). More specifically, after the later of (a) the date that is nine months after the patent is granted or reissued or (b) the date of termination of a post-grant review (if instituted), that person can argue that the PTO should invalidate the challenged claim(s) because it is anticipated or obvious. AIA § 6(a); 35 U.S.C. § 311. In an inter partes review, anticipation or obviousness can be established through only prior art patents or printed publications, and the standard of proof is preponderance of the evidence, i.e., more likely than not. AIA § 6(a); 35 U.S.C. §§ 311(b), 316(e).[3]

3) A patent owner will be able to request that the PTO conduct a supplemental examination of its patent.

As of Sept. 16, 2012, “[a] patent owner may request supplemental examination of a patent in the [PTO] to consider, reconsider, or correct information believed to be relevant to the patent[.]” AIA § 12(a), (c); 35 U.S.C. § 257(a), (c). Through supplemental examination, a patent owner can attempt to eliminate issues that could render the patent unenforceable in a lawsuit, i.e., civil action. AIA § 12(a); 35 U.S.C. § 257(c)(1). However, if an accused infringer alleges unenforceability of the patent in a civil action before the patent owner has requested supplemental examination, then the patent owner cannot use supplemental examination to eliminate the accused infringer’s bases for the unenforceability allegations. AIA § 12(a); 35 U.S.C. § 257(c)(2)(A). Also, the patent owner cannot use

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supplemental examination to eliminate the bases for an accused infringer's unenforceability allegations if the patent owner commences a patent infringement lawsuit against the accused infringer before the supplemental examination and any resulting reexamination of the patent are concluded. AIA § 12(a); 35 U.S.C. § 257(c)(2)(B). In short, before a patent owner asserts its patent in a lawsuit, it should carefully consider whether a supplemental examination of its patent could eliminate issues that could render the patent unenforceable, i.e., issues that arose during the patent prosecution, i.e., application, process.

4) An accused infringer's "prior commercial use" defense to patent infringement is now broader.

For a patent issued on or after September 16, 2011, an accused infringer may be able to assert, as a defense to infringement, its prior commercial use of the patented subject matter in the United States, i.e., its prior domestic use "in connection with an internal commercial use or an actual arm's length sale or other arm's length commercial transfer of a useful end result of such commercial use[.]" AIA § 5(a), (c); 35 U.S.C. § 273(a). Whereas this defense was previously potentially available only where the accused subject matter was a method, now this defense may be available where the accused subject matter consists of a process (including a method), or consists of a machine, manufacture or composition of matter used in a manufacturing or other commercial process. AIA § 5(a); 35 U.S.C. §§ 100(b), 273(a).

5) Virtual patent marking is now available. In order to preserve the right to recover available damages in a patent infringement lawsuit, a patent owner may now give notice of its patent via the Internet. AIA § 16(a); 35 U.S.C. § 287(a).

That is, as of Sept. 16, 2011, a patented product may be marked "by fixing thereon the word 'patent' or the abbreviation 'pat.' together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent[.]" AIA § 16(a)(1), (2); 35 U.S.C. § 287(a). This change in the law should make it easier for companies to mark patented products and ensure the accuracy of any such marking, and this change may also reduce certain manufacturing and tooling costs previously incurred in connection with marking patented products.

6) False marking lawsuits are now seriously curtailed.

As of Sept. 16, 2011, only the United States or "[a] person who has suffered a competitive injury" because of false patent marking may bring a false patent marking lawsuit. AIA § 16(b)(1), (2), (4); 35 U.S.C. § 292(a), (b). Previously, "any person" was entitled to bring a false patent marking lawsuit. 35 U.S.C. § 292(b) (former). Also, if a product is marked with a patent that previously covered the product, but has expired, such circumstances do not constitute false marking. AIA § 16(b)(3); 35 U.S.C. § 292(c).

7) An accused infringer's failure to obtain or present an attorney's advice will have minimized evidentiary consequences.

As of Sept. 16, 2012, "[t]he failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent." AIA §§ 17(a), 35; 35 U.S.C. § 298. Nevertheless, obtaining or presenting an attorney's advice (e.g., an opinion letter) on patent matters still is or may be appropriate in many circumstances.

8) From now on, the number of patent infringement lawsuits with multiple defendants and the number of defendants in patent infringement lawsuits should be reduced.

Generally speaking, for a patent infringement lawsuit commenced on or after Sept. 16, 2011, multiple accused infringers may be joined as defendants in the lawsuit only if (a) the patent owner seeks to hold the defendants jointly or severally liable, or relief from the defendants is sought with respect to the same transaction(s) or occurrence(s) relating to alleged acts of infringement involving the same accused product(s) or process(es), and (b) questions of fact common to all accused infringers will arise in the lawsuit. AIA § 19(d)(1), (e); 35 U.S.C. § 299(a).

9) Failure to disclose the best mode shall not result in a loss of patent rights.

The U.S. Patent Act requires a patent applicant to disclose "the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112. However, in a lawsuit commenced on or after Sept. 16, 2011, "the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable[.]" AIA § 15(a), (c); 35 U.S.C. § 282. As such, an accused infringer now has one less defense to patent infringement.

10) Are nonpracticing entities, a.k.a. patent trolls, an endangered species?

Pursuant to the AIA, the Comptroller General of the United States "shall conduct a study of the consequences of litigation by nonpracticing entities, or by patent assertion entities[.]" AIA, § 34(a). By Sept. 16, 2012, the Comptroller General shall "submit to the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate a report on the results of the study[.]" and that report will include "recommendations for any changes to laws and regulations that will minimize any negative impact of patent litigation that was the subject of such study." AIA, § 34(c).

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The U.S. Supreme Court Addresses Patent Ownership: *Stanford v. Roche*



Tuesday, November 8, 2011

Adrian Pruetz
and
Erica Pruetz
Pruetz Law Group



The California Club
538 S. Flower Street, Los Angeles, CA 90071

Member Host: Roger Wacker

Dress Code: Business Attire - Coat/Tie for Men

Registration/No-Host Reception - 6:00 p.m. * Dinner - 6:45 p.m. * Program - 7:15 p.m.

LAIPLA invites you to our next monthly dinner meeting on Tuesday, November 8, 2011 at 6:00 p.m. Our guest speakers, Adrian Pruetz and Erica Pruetz of Pruetz Law Group, will discuss their recent case, *Stanford v. Roche*.

On June 6, 2011, the Supreme Court issued a 7-2 opinion in favor of Roche in *Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems et. al*, bringing to a close a long-running dispute over the ownership of three groundbreaking patents on an assay used to measure HIV viral load. In its opinion, the Supreme Court clarified the interaction between the established law of patent assignments and the Bayh-Dole Act--a federal statute governing ownership of inventions created with the support of federal funding.

The program will focus on the patent assignment provisions at issue, the role of the Bayh-Dole Act in deciding patent ownership disputes when federal funding is involved, and the fact pattern that drove the decisions in favor of Roche in all three courts. The presenters were lead counsel for Roche from the inception of the case and counsel of record in the U.S. Supreme Court.

We encourage you to invite your colleagues to join you for this informative event and look forward to seeing you on the 8th!

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The U.S. Supreme Court Addresses Patent Ownership Issues: *Stanford v. Roche*

Tuesday, November 8, 2011

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