



Shimokaji IP specializes in the litigation and registration of patent and trademark matters. We serve start-ups, Fortune 100 companies, government entities, and universities. Our expertise and representation extends across the US and throughout Asia.

Keep in touch! Email us ClientServices@shimokaji.com and explore www.shimokaji.com

USPTO Reports on Patent Eligible Subject Matter

What is patentable subject matter continues to be elusive for patent owners, the courts, and the USPTO.

A July report by the USPTO summarizes the evolving case law from the US Supreme Court on what is patentable, especially in the life science and computer technologies. However, the report lacks suggestions on how patent owners can better address the patentability issues.

Also summarized in the report are public comments on the Supreme Court decisions. Some comments recommended legislative change. Others recommended administrative change in the USPTO by having greater consistency between examiners and patent rejections, as well as more guidance in the Manual of Patent Examining Procedure.

COMMENT:

Beyond the report bringing together a listing of the case law on patent eligibility, the report may not provide what the public wants - more clarity on the issue of patent eligibility. The report can be found [here](#).

Regeneron's Inequitable Conduct Bars its Patent Enforcement

Inequitable conduct during the prosecution of a patent application - even as to just one patent claim - bars enforcement of the entire patent. The withholding of a prior art reference may be inequitable conduct if there is materiality and intent.

A prior art reference is material if the patent office would not have allowed a claim had it been aware of the undisclosed reference.

Regeneron did not cite four prior art references during its US patent prosecution. However, it cited the references in the subject patent application immediately after the application was allowed by the PTO, and also cited the references in related US patent prosecution and in European patent proceedings.

The district court found that Regeneron engaged in discovery misconduct and sanctioned Regeneron by drawing an adverse inference of intent to deceive the patent office - vis-a-vis the withheld references.

The misconduct included discovery misrepresentations to the district court. Non-privileged documents were improperly withheld from production based on privilege. Importantly, the withheld documents were relevant to determining whether Regeneron intended to deceive the PTO by withholding the references.

The Federal Circuit affirmed the sanction of an adverse inference.

COMMENT:

This may be a warning to patent owners that even in the absence of intent to deceive the patent office, litigation misconduct by the patent owner may take the place of what was otherwise absent.

William Adams of the Black-Eyed Peas Cannot Register "I AM"

William Adams is the front man for The Black Eyed Peas. His company, i.am.symbolic, sought trademark registration of "I AM" for clothing, jewelry, sunglasses, cosmetics, and services. The trademark office rejected the application based on a likelihood of confusion with prior registrations for "I AM".

Symbolic then amended the description of goods in its application to read: "all associated with William Adams, professionally known as 'will.i.am'". According to Symbolic, the foregoing distinguished its mark from the registered marks by altering the former's connotation and commercial impression, as well as the channels of trade.

The Federal Circuit concluded that the "will.i.am" restriction did not "impose a meaningful limitation . . . for purposes of likelihood of confusion."

Therefore, the refusal of Symbolic's applications by the trademark office was affirmed by the Federal Circuit.

COMMENT:

Symbolic had a tough road. The prior registrations were essentially identical to Symbolic's mark - at least in words. Also, it seems that adding the name of the owner to the description of goods does not add anything beyond the name of the owner identified in the application.

Do You Have a Claim For Trademark Reverse Confusion?

Marketquest sold promotional products and owned registered trademarks for "All-in-One" and "The Write Choice".

BIC used the phrase "All-in-One" and "The WRITE Pen Choice for 30 Years". Marketquest sued for trademark infringement.

The Ninth Circuit explained that for trademark infringement, there can be forward consumer confusion and reverse consumer confusion.

Forward confusion is when consumers believe that goods having the latecomer's mark come from the prior owner of the conflicting mark.

Reverse confusion occurs when consumers do business with the prior owner but believe they are doing business with the latecomer.

The Ninth Circuit pointed out that BIC is "clearly the larger, more widely-known entity, and has acquired some smaller promotional products companies." Therefore, according to the Ninth Circuit, it is "plausible that consumers would associate Marketquest's marks with [BIC], or think that BIC had acquired Marketquest.

COMMENT:

The court did not decide the merits of the case, but only concluded that the case should not be dismissed at the early juncture.

Contact Us

SHIMOKAJI IP
8911 Research Drive
Irvine California 92618 USA
www.shimokaji.com
ClientServices@shimokaji.com
949-788-9961

You are subscribed to this mailing list as mshimokaji@shimokaji.com. Please [click here](#) to modify your mailings. We will respect all unsubscribe requests.