




JULY 17, 2023

USPTO UPDATES

USPTO Releases Updated Trademark Datasets

BY GRACE E. KIM

The USPTO's Office of Chief Economist has released the 2022 updates to its **Trademark Case Files Dataset** and **Trademark Assignment Dataset**. The Trademark Case Files Dataset contains detailed information on 12.1 million trademark applications filed with or registrations issued by the USPTO between January 1870 and February 2023. The Trademark Assignment Dataset contains 1.29 million trademark assignments, involving 2.28 million unique trademark properties, recorded by the USPTO between March 1952 and January 2023. For more information, visit the [research datasets webpage](#) on the USPTO website.



JPO UPDATES

**USPTO-JPO PPH Program**

BY KASUMI KANETAKA

Since 2008, the JPO and USPTO have collaborated to further improve their **PPH programs**. In order to further improve the user experience under the PPH program, the two Offices each set a target deadline for issuing office actions for PPH applications and strived to meet the target as they examined each application, making it easier for users to predict the timing of examination. The Table below (data obtained [here](#)) shows the target set by the JPO, and demonstrates that this target was met in the year of 2022.

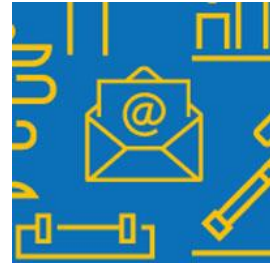
Based on this Table, the JPO has met the target deadline for issuing office actions for PPH applications. Utilizing the PPH programs in filing patent applications is one of the important choices applicants consider and make. Understanding that patent offices from various countries are collaborating to improve the programs, we can also help counsel each of our clients to make the best decision when filing an application. Please also see [here](#) for information on all filers in Japan for PPH.

KIPO UPDATES

[Korea-Japan Heads of IP Office Meeting Resumed](#)

BY GRACE E. KIM

For the first time in six years, the Korea-Japan Heads of IP Office Meeting was held on May 31, 2023 in Tokyo. Commissioner Lee Insil of the Korean Intellectual Property Office (KIPO) met with Commissioner Hamano Koichi of the Japan Patent Office (JPO) to discuss current issues in the IP field and future cooperation. Both the Commissioners of the KIPO and the JPO recognized the need for mutual cooperation to further develop the IP system in an environment with rapidly developing new technologies, including AI, IoT, and extended reality, and increasing importance of innovation to achieve sustainable development goals. Commissioner Lee and Commissioner Koichi agreed to 1) resume a working-level committee in trademark and design examination, trials, digitization, and enhancement of examiner capabilities, 2) exchange examiners between both IP offices, and 3) share experience to establish a classification system for green technology. They also agreed to continue working-level discussions and exchange information regarding the Collaborative Search Program (CSP) to provide efficient and accurate patent examination services to applicants in both countries. Commissioner Lee formally invited Commissioner Koichi to attend the TRIPO Heads Meeting among Korea, Japan, China which will be hosted by KIPO later this year.



AI UPDATES



[Updated EU Regulations on AI Trigger Industry Reaction](#)

BY SAMEER GOKHALE

European Union lawmakers agreed on June 14, 2023 to changes to a draft on artificial intelligence (AI) rules, originally announced two years ago, to include a ban on the use of the technology in biometric surveillance and for generative AI systems like ChatGPT to disclose AI-generated content. European Union lawmakers want to require that any company using generative tools must disclose copyrighted material used to train the tool. Applications, such as ChatGPT, would need to disclose that the content was generated by AI, help distinguish “deep-fake” images from real images, and ensure safeguards against illegal content.

However, the updated the rules will potentially negatively impact innovation incentives in the area of AI. An [open letter](#) signed by 150 business executives and submitted on June 30th, warned of potential risks, stating that “*the draft legislation would jeopardize Europe’s competitiveness and technological sovereignty without effectively tackling the challenges we are and will be facing.*”

The letter specifically identified the risks to generative AI, writing “[u]nder the version recently adopted by the European Parliament, foundation models, regardless of their use cases, would be heavily regulated, and companies developing and implementing such systems would face disproportionate compliance costs and disproportionate liability risks.”

While the rules are not directly related to patent laws for AI inventions, the indirect impact on patents will be significant since the rules may affect investment in research and innovation in the area of AI. Therefore, patent practitioners should keep a close eye on regulation of AI as it may discourage investment in certain types of AI tools, which may suppress the volume of applications filed in the regulated jurisdictions.

FEDERAL CIRCUIT UPDATES

[Joint Inventor Need Not Conceive of Entire Invention - Contribution of Elements of Invention Sufficient for Inventorship](#)

BY DONALD R. MCPHAIL



In *BLUE GENTIAN, LLC v. TRISTAR PRODUCTS, INC.*, No. 2021-2316 (June 9, 2023) (Prost*, Chen, and Stark), a panel of the Court addressed the requirements for co-inventorship of utility and design patents. Blue Gentian sued Tristar in 2012 for infringement of six patents, four utility patents and two design patents, all of which related to an expandable hose. Each of the asserted patents named a single inventor, Michael Berardi, who was Blue Gentian's principal.

Tristar counterclaimed to correct the inventorship of all six asserted patents by adding a co-inventor, Gary Ragner. Ragner was the named inventor on two other patents to expandable hoses that had been licensed by Tristar. Berardi had filed his first patent application for an expandable hose in November 2011. Significantly, however, three months prior to that filing, on August 23, 2011, Berardi had met with Ragner, who was the founder of Ragner Technology Corporation and had been seeking investors to help Ragner Tech. bring its first product — an expandable hose called the “MicroHose” — to market. At that meeting, Ragner had shown Berardi a document that detailed the manufacturing process of the MicroHose.

Following an evidentiary hearing, the district court concluded that Ragner should have been named as inventor on all six asserted patents. In particular, the district court found that Ragner conveyed three key elements of the hose to Berardi, *viz.* the fabric outer tube; the elastic inner tube; and attaching the tubes only at their ends, and that these key elements amounted to a significant contribution to at least one claim in each of the asserted patents. The district court therefore entered judgment in favor of Tristar and ordered correction of all six asserted patents under 35 U.S.C. § 256.

Blue Gentian then appealed. In an opinion by Judge Prost, however, the Federal Circuit rejected Blue Gentian's arguments and affirmed the district court. The panel rejected: 1) Blue Gentian's suggestion that the district court erred by failing to construe any of the claims of the asserted patents before finding that Ragner had contributed to the invention thereof; 2) Blue Gentian's attack on the district court's conclusion that Ragner has made a significant contribution to the claimed inventions, noting that Blue Gentian had relied on the elements attributed to Ragner in distinguishing the claimed invention from the prior art; and 3) Blue Gentian's argument that the district court erred by only requiring corroboration that Ragner conceived of the three key elements, and not requiring separate corroboration that he communicated those elements to Berardi. Finally, on the issue of collaboration, the panel agreed with the district court's conclusion that the information exchange between Ragner and Berardi at their single meeting was sufficient, noting the principal that a joint inventor need not conceive of the entire invention, and finding it was irrelevant that Ragner did not intend to invent the hose ultimately claimed in the asserted patents. The panel further noted that the meeting between Ragner and Berardi involved the requisite element of joint behavior, *viz.*, one inventor hearing another's suggestion at a meeting. The panel therefore concluded the district court had not erred. [Read our full article here.](#)

LIFE SCIENCES NEWS

[Determining Obviousness of Design Patents](#)

BY RICHARD D. KELLY

The Federal Circuit on June 30 granted a petition for re-hearing en banc of its per curiam decision in *LKQ Corp. v. GM Global Tch. Operations, LLC*. finding the PTAB had correctly decided that GM's design patent D797,625 was not unpatentable, *i.e.*, valid. The issue raised was whether the Federal Circuit's rulings in *Durling v. Spectrum Furniture Co., Inc.*, 101 F.3d



100 (Fed. Cir. 1996); *In re Rosen*, 673 F.2d 388 in(C.C.P.A. 1982) followed by the PTAB in its decision created a “rigid” rule for obviousness in design patents in violation of Supreme Court’s 2007 *KSR* decision overturning the Federal Circuit’s rigid rule for obviousness of utility patents, the “teaching, suggestion motivation” (TSM) test for obviousness.

While design patents are often overlooked in the pharma field, they are useful where drugs are administered by devices, such as inhaler and injectors. Further, where the device is a software product or controlled by software, design patents can be used to protect the graphical user interface given the rules regarding generic equivalents. A discussion of the application of obviousness to design patents and their impact on generics is found [here](#).

[Orphan Drug Exclusivity Under Attack from FDA](#)

BY RICHARD D. KELLY

The Orphan Drug Exclusivity was created to provide an incentive for companies to develop drugs for diseases which affect less than 200,000 individuals by providing a 7-year regulatory exclusivity. The exclusivity has been under attack by the FDA seeking ways of breaking the exclusivity. In May it made another attempt with the narcolepsy drug Xywav® owned by Jazz Pharmaceuticals where it has no statutory authority to break Jazz’ ODE. Read more [here](#).

[Lessons from Amgen v. Sanofi](#)

BY RICHARD D. KELLY

Amgen provides a window on the Supreme Court approach to patent issues – a look to history and established policy as our patent law is not code based but rather common law based. The Court noted that the “enablement requirement” is found essentially unchanged in every version of the patent law since 1790. While *Amgen* concerned the enablement provision, the same approach applies to patent eligibility, the “judicial exceptions,” which have existed in our case law since the early 19th century. In deciding *Amgen*, the Supreme Court did not consider previous Federal Circuit decisions but looked to history of the enablement provision which involved Court decisions from the 19th and early 20th century. While *Amgen* was the Court’s first antibody case, it found analogous cases which provided guidance as to how the enablement requirement had been interpreted. Since U.S. patent law is based on common law, this is the appropriate approach to provide the needed predictability. Without understanding the policy behind the exceptions, one will continue to wander aimlessly from one case to the next like the Federal Circuit has been with “abstract ideas.” The Federal Circuit’s cries for help are caused by its failure to consider the history of the concept. More [here](#).

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