

UPDATE

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BEST PRACTICES FOR LEVERAGING BROADEST REASONABLE INTERPRETATION IN PATENT PROSECUTION



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Broadest reasonable interpretation (BRI) can be a challenging, and at times frustrating, issue for patent practitioners. When it comes to interpreting claim terms, examiners usually grasp the concept of “broadest” but at times can struggle with the “reasonable” part. Now that the Supreme Court has confirmed that BRI is here to stay, in *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016), patent practitioners should try to find ways to leverage the doctrine to best serve their clients’ interests.

Several policy reasons have been cited in support of the U.S. Patent and Trademark Office (USPTO) using BRI to interpret claims during examination, in contrast to the sometimes narrower construction used by federal district courts and other tribunals as outlined in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). For example, the practice of BRI functions to ensure that claims are not

given a broader interpretation during enforcement than they were given during procurement. M.P.E.P. § 2111. A broader construction during prosecution also has been justified on the ground that patent applicants have the opportunity to amend claims while an application is pending before the USPTO, whereas patentees are not permitted to amend claims during an enforcement action. *Id.*

Several recent decisions by the U.S. Court of Appeals for the Federal Circuit provide guidance for practitioners, both when drafting a patent application and initial claim set, as well as when arguing that an examiner’s construction of a claim term or application of the prior art is unreasonable.

CLEARLY DEFINE CLAIM TERMS IN THE SPECIFICATION

A patentee may be his or her “own lexicographer and/or may disavow claim scope,” but to do so, the “patentee must *clearly* express that intent in the written description.” M.P.E.P. § 2111.01. Oftentimes patent drafters avoid including explicit definitions in the

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specification due to the risk of unnecessarily limiting claim scope. However, in appropriate situations an applicant may strategically leverage lexicography, for instance to assign a special definition to a term that narrowly avoids known prior art or excludes an inapplicable definition that otherwise may fall under its “plain and ordinary” meaning.

If a claim term is not explicitly defined in the specification, it should be expected that the term may be construed under BRI in a way that is broader than the disclosed embodiments. For example, in *In re Chaganti*, 468 F. App’x 974, 976 (Fed. Cir. 2012), the applicant argued that the Patent Trial and Appeal Board’s (PTAB’s) interpretation of “intangible property” to include “stocks and bonds” was unreasonable in light of the specification. *Id.* However, the Federal Circuit noted that the specification included several references to “intangible property,” and even though the specification listed types of intangible property that did not include stocks and bonds, the list was non-exclusive. *Id.* Some of the phrasing that indicated a non-exclusive list included “related to,” “intangible forms of property such as,” and a statement that “the invented method and system should not be limited by the discussion provided herein.” *Id.* The PTAB’s interpretation was thus held to be reasonable. *Id.*

RELY ON SPECIFICATION TO LIMIT REACH OF BRI

Even when a claim term is not explicitly defined in the specification, the specification often provides the best ammunition against an unreasonable construction of the term. Under BRI, “claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Abbott Diabetes Care, Inc.*, 696 F.3d 1142, 1149 (Fed. Cir. 2012). BRI “does not give the PTO an

unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.” *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). The specification has been identified as “the single best guide to the meaning of a disputed term.” *Abbott*, 696 F.3d at 1149.

In *Abbott*, the Federal Circuit found that the PTAB improperly construed “electrochemical sensor” to include wires and cables despite the specification criticizing prior art that included the same, and further despite “every embodiment showing the electrochemical sensor without wires and cables.” *Id.* at 1149-50. In finding the PTAB’s interpretation unreasonable, the Federal Circuit noted that, “[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.” *Id.*

USE TERMS TO EXPLAIN THE RELATIONSHIP BETWEEN CLAIM ELEMENTS

When drafting claims, an applicant may use language to clarify that different elements in the claims refer to distinct items. Appropriate use of antecedent basis, as well as relative terms, such as “other,” can help to show that a claim interpretation that ignores the antecedent basis or relative term is improper. For example, in *Microsoft Corp. v. Proxycorn, Inc.*, 789 F.3d 1292, 1299 (Fed. Cir. 2015), the Federal Circuit found that the PTAB “erred in concluding that the ‘two *other* computers’ could include the caching computer” where the claim language recited a “system comprising a gateway, a caching computer, and ‘two other computers.’” The Federal

Circuit noted that “[n]ot only are the ‘two other computers’ recited independently from, and in addition to, the gateway and caching computers, the word ‘other’ denotes a further level of distinction between those two computers and the specific gateway and caching computers recited separately in the claim.” *Id.*

CITE OTHER CLAIM LIMITATIONS TO SHOW A PROFFERED CONSTRUCTION IS ILLOGICAL

An applicant sometimes may use other limitations in a claim to show that an overly broad construction of a term is illogical. The Federal Circuit has on multiple occasions found the PTAB’s construction, or the PTAB’s application of the prior art relative to the construction, unreasonable when the construction created an illogical result. Other limitations explicitly recited in a claim are relevant to both how the claim should be interpreted and whether the claim is novel and non-obvious over the prior art. Note that “[c]onstruing a claim term to include features of that term already recited in the claims would make those expressly recited features redundant.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1237 (Fed. Cir. 2016).

For example, in *PPC Broadband, Inc. v. Corning Optical Commc’ns RE, LLC*, 815 F.3d 734, 743 (Fed. Cir. 2016), a claim recited “a continuity member disposed ... so as to maintain electrical continuity between the coupler and the post when the coupler is in the partially tightened position on the interface port, even when the coupler is in the fully tightened position on the interface port, and even when the post moves relative to the coupler.” Yet, the PTAB “explicitly declined to require the continuity member to ‘maintain a continuous electrical connection.’” *Id.* at 744. In finding the PTAB’s interpretation unreasonable, the

Federal Circuit noted that, the “claims expressly require” the continuity member to maintain a continuous electrical connection, “not because they use the term ‘continuity member,’ but because they use the phrase ‘maintain electrical continuity.’” *Id.*

As another example, in *D’Agostino v. MasterCard Int’l Inc.*, 844 F.3d 945, 950 (Fed. Cir. 2016), the PTAB improperly construed “single merchant.” The Federal Circuit noted that this limitation required “that, when the transaction code is requested, the request limits the number of authorized merchants to one but does not then identify the merchant, such identification occurring only later.” *Id.* Yet, the PTAB construed the single merchant reference so that a prior art reference disclosing the scenario “in which the customer seeks a transaction code for an identified chain of stores and, later, picks a specific store within that chain” anticipated or rendered obvious the claim at issue. *Id.* In explaining why the PTAB’s construction was unreasonable, the Federal Circuit noted that “[t]he only way to avoid [the] straightforward logic would be to separate “single merchant” (in the first clause) from “particular merchant” (in the second clause). [However] the claim language of the single-merchant limitation does not allow that separation. Indeed, the second clause speaks expressly of “any particular merchant being identified as said single merchant.” *Id.*

USE DEPENDENT CLAIMS AND CLAIM DIFFERENTIATION TO GIVE FURTHER CONTEXT TO TERMS IN INDEPENDENT CLAIMS

When drafting claims, an applicant may include additional features or defining language in a dependent claim of a target scope to help ensure that a corresponding term in the independent claim is construed at least as broadly as the target scope. If

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a proposed construction of a term in an independent claim “would nullify claims that depend from it, the doctrine of claim differentiation creates a presumption that such a construction is improper.” *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1368 (Fed. Cir. 2012). Dependent claims thus can be used not only to create fallback positions, but also as a tool to guide the construction of terms in independent claims.

CONCLUSION

Although BRI at times may present a source of frustration for patent practitioners, it is possible to strategically navigate the doctrine to procure strong and defensible patents.

Practitioners should keep in mind that the specification always plays a central role in giving meaning to claim terms, whether by an explicit definition or through contextual guidance from which the meaning may be inferred. Structuring claims in a way that clarifies the relationship between claim elements also may help to avoid unreasonable or unintended constructions of terms during prosecution. Dependent claims also should be used to help set inner boundaries on the scope given to terms in independent claims. ■

BANNER & WITCOFF JOINS 2017 LAWYERS HAVE HEART 5K RUN & FUN WALK IN WASHINGTON, D.C.

Banner & Witcoff participated in the Lawyers Have Heart 5K Run & Fun Walk in Washington, D.C. on June 10, 2017. The annual race brings together more than 250 organizations and 6,000 runners and walkers to support the American Heart Association and help advance its nonprofit mission of fighting heart disease and stroke.



Pictured, front row (left to right): Camille Sauer, Elyse Braner, Alisa Abbott, Eleanor Chang and Marcie Burkhart; Back row: Rachel Johns, Zach Stevenson, Rajit Kapur, Steve Chang, Thomas Vaseliou, Brad Edgington, Ben Koopferstock, Jeff Chang, Jason Wagner and Dale Faulls. Participants not pictured: Jennifer Brady, Jay Kim, Donna Koenig, Zach Leciejewski, Deirdre Morris, Teneasha Peirson, Kimberly Turner, Darrell Mottley and Chris McKee.

SUPREME COURT DECIDES CASES INVOLVING PATENT & COPYRIGHT LAW

IMPRESSION PRODUCTS V. LEXMARK INTERNATIONAL

After *Banner & Witcoff* prevailed on behalf of Lexmark International in an *en banc*, 10-2 decision, the Supreme Court on May 30, 2017, changed the law of patent exhaustion and limited the ability of patent owners to control the use of patented products once they are sold.

In its decision, the Supreme Court held that the doctrine of patent exhaustion, a defense to infringement that holds that patent owners lose their rights after an authorized sale, means that post-sale restrictions are not allowed and that U.S. patent rights are exhausted once a patent owner or its distributors sell a patented product anywhere in the world.

The justices said the Federal Circuit was wrong to hold that patent owners can impose restrictions on how patented items can be used or sold in the United States after they are sold and that U.S. patent rights remain in place if a product is first sold in another country.

TC HEARTLAND V. KRAFT FOODS GROUP BRANDS

On May 22, 2017, the Supreme Court held that “a domestic corporation ‘resides’ only in its State of incorporation for purposes of the patent venue statute.” The decision reversed the Federal Circuit and confirmed decades-old Supreme Court precedent that the patent venue statute, § 1400(b), does not incorporate a broader definition of residency found in the general venue statute, § 1391(c).

Writing for a unanimous Court with Justice Gorsuch taking no part in consideration or decision of the case, Justice Thomas explained that “[t]he current version of § 1391 does not contain any indication that Congress intended to alter the meaning of § 1400(b) as interpreted in *Fourco*.”

While the Court’s ruling presumably will result in the case below being transferred out of the U.S. District Court for the District of Delaware, the broader impact of the decision actually could lead to a higher concentration of patent infringement actions in Delaware, where many businesses are incorporated.

STAR ATHLETICA V. VARSITY BRANDS

On March 22, 2017, the Supreme Court affirmed that two-dimensional graphic designs are entitled to copyright protection as “pictorial, graphic, and sculptural works” under the copyright law for useful articles under certain circumstances.

The Supreme Court, in its first decision on copyright protection for apparel, set forth a new two-prong test:

A feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic or sculptural work — either on its own or fixed in some other tangible medium of expression — if it were imagined separately from the useful article into which it is incorporated.

SCA HYGIENE PRODUCTS V. FIRST QUALITY BABY PRODUCTS

On March 21, 2017, the Supreme Court decided that laches cannot be interposed as a defense against damages where the infringement occurred within the six-year period prescribed by Section 286 of the Patent Act.

The decision followed the reasoning from the Supreme Court’s 2014 “Raging Bull” copyright laches case, *Petrella v. Metro-Goldwyn-Mayer Inc.*, where the Court held that since the Copyright Act sets a three-year statute of limitations during which claims must be brought, laches cannot be used to bar claims filed within that period. The 1952 Patent Act includes a six-year statute of limitations provision for past damages.

The case turned on whether the *Petrella* copyright laches holding should likewise apply to patent law, and the Supreme Court held that it did.

LIFE TECHNOLOGIES V. PROMEGA

On Feb. 22, 2017, the Supreme Court decided that the Court of Appeals for the Federal Circuit erred when it decided that shipment outside the United States of one component of a multicomponent invention could violate 35 U.S.C. §271(f)(1).

In its 7-0 decision (with Chief Justice Roberts not participating), the Supreme Court reversed the decision of the Federal Circuit, holding that the supply of a single component of a multi-component invention for manufacture abroad does not give rise to §271(f)(1) liability.

Because only a single component of the patented invention at issue here was supplied from the United States, the case was reversed and remanded to the Federal Circuit.

*The Supreme Court also decided *Matal v. Tam*, which is discussed in more detail in the “Balancing Free Speech and Trademark Rights” article.*

BALANCING FREE SPEECH AND TRADEMARK RIGHTS



BY ROSS A. DANNENBERG AND HEATHER R. SMITH-CARRA

The First Amendment to the United States Constitution secures one of the most well-known rights in the world: freedom of speech. A federal trademark registration, on the other hand, grants its owner the *exclusive* right to use the registered mark in connection with the goods and services that are the subject of the registration, thereby depriving others of the rights granted to the trademark owner. Compounding the issue, many federal trademark registrations include generic words (for unrelated goods and services), descriptive text, or suggestive names or slogans that have applicability in contexts unrelated to the registered goods and services, which an unrelated third party might want to use to identify the trademarked product or service, or to use in a purely descriptive or expressive sense. These third-party uses typically arise in comparative advertising, creative works (e.g., Andy Warhol's famous Campbell's Soup painting), functional use, or detailed depictions involving real-life goods (e.g., movies, television, and software simulations involving real-life scenarios), each of which may or may not be viewed favorably by the mark's owner. Over the last several years, the First Amendment has further clashed with federal trademark law as a result of the U.S. Patent and Trademark Office (USPTO) rigidly enforcing its policy of prohibiting registration of disparaging marks. As a result, it is becoming increasingly difficult to harmonize exclusive trademark

rights under U.S. law with freedom of speech as guaranteed by the First Amendment.

In order to resolve this inherent tension between the First Amendment and federal trademark rights, courts adopted the doctrine of nominative fair use, which allows a third party to use or refer to another's mark when necessary and not misleading to consumers. Specifically, nominative fair use is not trademark infringement because there is no likelihood of confusion as to the source of the goods or services. The U.S. Court of Appeals for the Ninth Circuit developed a three-part test to determine whether there is a nominative fair use.¹ First, the good or service must not be readily identified without the mark. Second, the third party must only use so much of the owner's mark as is reasonably necessary to identify the good or service. For example, use of a word mark instead of a distinctive design or logo may weigh in favor of nominative fair use, whereas copying the design or logo in addition to the text may weigh in favor of infringement. Third, the third party must accurately portray the relationship between itself and the owner of the mark, and not mislead consumers as to the source of the third party's goods or services. If these three criteria are met, then a use of the mark is not infringement.

Use of a registered mark is also not infringement if the mark is used in a functional manner and not as a trademark, i.e., not as an indicator of the source of goods or services. If a third party is using another trademark owner's mark in a way that is not a source identifier for the trademark owner's good or service, then the use may be functional and

non-infringing. In *Pagliari v. Wallace China Co.*, Wallace created several china patterns, which it sold both directly and through its authorized dealers.² Pagliero Brothers, one of Wallace's competitors, used several of the same designs on its china. The court found Pagliero Brothers' use of Wallace's designs was not infringement because the features of the china patterns were aesthetically functional. The court stated "where the features are 'functional' there is normally no right to relief. 'Functional' in this sense might be said to connote other than a trade-mark purpose."³

In another well-known example, Christian Louboutin sued Yves Saint Laurent (YSL) when YSL started selling a competing shoe with a red sole. Despite Christian Louboutin shoe's being well known for having red soles, the court held that YSL's use of a red sole was functional because YSL was selling a monochrome red shoe, and preventing YSL from being able to use a red sole on such a shoe would detract from the aesthetic functionality of a completely red shoe. The court held that Louboutin's trademark was limited to a red sole that *contrasts in appearance* to the rest of the shoe, and was not infringed by YSL's monochrome red shoe.⁴

Another issue that arises in the balance of trademarks and free speech concerns product placement in the entertainment industry, such as in movies, television, and video games. However, the Supreme Court stated that entertainment speech should be afforded a high degree of First Amendment protection.⁵ As such, use of an otherwise protectable mark in an expressive context is often protected free speech or otherwise considered fair use.⁶ Many articles and books have addressed product placement and related issues, so we do not address them further here.

Turning to more recent developments regarding allegedly disparaging marks, the Supreme Court ruled in 1976 that commercial speech is protected by the First Amendment. The Supreme Court stated that the First Amendment protects "[e]ntertainment, as well as political and ideological speech, ... [including] motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works."⁷



The Slants logo

More recently, a Portland, Oregon-based rock band named "The Slants" requested federal trademark registration of its name in 2011 for "Entertainment in the nature of live performances by a musical band." Despite the name's reputation as a racial slur, the name was adopted as a nod to the band members' Asian-American heritage. The USPTO refused registration of the mark under Section 2(a) of the Lanham Act, finding that the mark is disparaging.

Section 2(a) of the Lanham Act bars federal trademark registration of a mark that "consists of or comprises immoral, deceptive, or scandalous matter; or *matter which may disparage* or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."⁸

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In its refusal, the USPTO cited to dictionary definitions of “slant” and stated that the term will be viewed as disparaging. The USPTO found that the mark is unregistrable because the likely meaning of the mark is an inherently offensive and derogatory term directed towards the physical features of persons of Asian descent. The USPTO considers the following two factors when determining whether a matter may be disparaging under Trademark Act Section 2(a):

1. What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services; and
2. If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.⁹

The Slants argued, however, that they specifically chose the name to turn the negative connotation of the term into a positive one. The Slants appealed the USPTO’s refusal to register its mark to the U.S. Court of Appeals for the Federal Circuit. In 2015, the Federal Circuit found Section 2(a) to be unconstitutional and thus stated that the mark THE SLANTS should be registrable.¹⁰ The U.S. government petitioned the Supreme Court in 2016 for *writ of certiorari*, which the Court granted.

In another similar case, the USPTO in 2014 canceled several trademark registrations owned by Pro-Football, Inc., the National Football League’s franchise known as the *Washington Redskins*.¹¹ In that case plaintiff Pro-Football, Inc. (PFI) sought reversal of a USPTO Trademark Trial and Appeal Board (TTAB) order cancelling six of its federal trademark registrations for the REDSKINS mark. The court stated “cancelling the registrations of the Redskins Marks under Section 2(a) of the Lanham Act does not implicate the First Amendment as the cancellations do not burden, restrict, or prohibit PFI’s ability to use the marks.”¹² PFI asserts that First Amendment rights are implicated because cancelling its trademark registration will “drive ideas from the marketplace.”¹³ In April 2016, PFI petitioned the Supreme Court for a *writ of certiorari* after the district court upheld the TTAB’s cancellations. The Supreme Court declined to hear PFI’s appeal, however the decision regarding THE SLANTS mark (discussed in more detail below) will impact whether the REDSKINS registrations will continue to be viewed as disparaging and unregistrable by the USPTO.



Redskins logo

Federal registration has its advantages, and The Slants and PFI argue they are being deprived of those federal rights. However, advocates for maintaining the anti-disparagement clause argue that the alleged disparaging marks are still protected by common law rights. While the Redskins may continue using its name without federal protection, The Slants require federal trademark protection to sign a record deal. The Slants argue they are not seeking registration of this name to use it in a disrespectful way. On the contrary, The Slants seek to turn the negative connotation into a positive one for Asian-Americans. As noted above, the USPTO has not been swayed by a trademark applicant's intent or purpose to counter a rejection on the ground of disparagement, whereas the Federal Circuit sided with The Slants in 2015, finding that "[t]he First Amendment allows even hurtful speech."¹⁴ In their respective briefs before the Supreme Court, the government argues that while the First Amendment protects free speech, it is not required to promote hurtful speech such as racial slurs, whereas The Slants argue that the government does not endorse or promote all federal trademark registrations.

Meanwhile, other marks that would seem disparaging have been granted federal registrations. The USPTO denied registrations for two groups called "Democrats Shouldn't Breed" and "Abort the Republicans." Yet registration of the band name N.W.A., which stands for "Niggaz Wit Attitudes" was allowed, so the USPTO has not been entirely consistent regarding where it draws the line.

However, in a somewhat convoluted decision, the Supreme Court on June 19, 2017, affirmed the Federal Circuit's finding that section 2(a) is unconstitutional, thereby drawing the line for the USPTO and paving the way for The Slants

to get its mark registered. A by-product of the decision is that the Washington Redskins will likely be allowed to keep its federal trademark registrations for various REDSKINS marks.

Will there be a rush to the trademark office to register new disparaging marks? Unlikely, in view of the fact that disparaging marks just don't sell as well as more marketable names. However, The Slants case increases the strength of trademark rights and provides businesses one more option to pursue fringe customers. Coupling trademark rights with nominative fair use and aesthetic functionality, both brand owners and third parties have a number of resources to both defend and attack in brand battles yet to come. ■

1. *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (newspaper's use of *New Kids on the Block* as the subject matter of a reader poll where readers were required to dial a 1-900 number for a fee in order to vote for their favorite *New Kid* was a nominative fair use of the mark). AIA § 3(n)(1) and 6(f)(2)(A). AIA § 3(n)(1)(B), 125 Stat. at 293.
2. *Pagliero v. Wallace China Co.*, 198 F.2d 339, 339 (9th Cir. 1952).
3. *Id.* at 343. See also *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 863 (1982) (Functionality is a complete defense to contributory infringement as it is "an important ingredient in the commercial success of the product.")
4. *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings Inc. et al.*, 2012 WL 3832285 (2nd Cir. 2012).
5. *Schad v. Borough of Mount Ephraim*, 452 U.S. 61, 65 (1981) (stating "[e]ntertainment, as well as political and ideological speech, is protected; motion pictures, programs broadcast by radio and television, and live entertainment, such as musical and dramatic works fall within the First Amendment guarantee.")
6. See, e.g., *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989) (Defendant's title of its movie *Ginger and Fred* not an infringement of plaintiff Ginger Rogers' rights because the title is at least minimally relevant to the movie's content, and because the title does not explicitly denote authorship, sponsorship, or endorsement by Ms. Rogers or explicitly mislead as to content.). See also, *The Sporting Times, LLC v. Orion Pictures Inc. et al.*, No. 1:17-cv-00033 (W.D. Ky., filed February 2017) (in a *Motion to Dismiss* filed May 1, 2017, MGM argues that because there is no confusion as to the source of the film the trademark infringement claims are barred, and that "the Lanham Act does not grant trademark owners [] veto power over the content of expressive works.").
7. *Schad* at 65.
8. 15 U.S.C. § 1052(a).
9. *In re Squaw Valley Dev.*, 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP § 1203.03(c).
10. *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).
11. *Pro-Football, Inc. v. Blackhorse*, 112 F.Supp.3d 439 (E.D. Va. 2015)
12. *Id.* at 455.
13. *Id.* at 456.
14. 808 F.3d 1321, 1328.

AFTER-FINAL PRACTICE: NAVIGATING EXPANDING USPTO OPTIONS FOR COMPACT PATENT PROSECUTION



BY JORDAN N. BODNER AND ERIC J. HAMP

As part of the Enhanced Patent Quality initiative, the United States Patent and Trademark Office (USPTO) has gradually expanded the after-final landscape for patent applicants. Where options at the close of patent prosecution were traditionally limited to full appeals or requests for continued examination (RCE), the USPTO has enacted other options for resolving disputes in potentially quicker and more cost effective manners. These options include the After Final Consideration Pilot Program 2.0 (AFCP 2.0) and the Pre-Appeal Brief Conference (PABC) Pilot. The USPTO recently completed a third pilot program, the Post-Prosecution Pilot (P3) Program, and is analyzing the results prior to any renewal. Based on the renewals/extensions of AFCP 2.0, it is reasonable to assume that P3, or a variation thereof, will be reinstated as well.

Each of these programs has something in common; they afford applicants additional leverage or incentivize the examiner to advance the case. Depending on the situation presented to an applicant, some of these programs may lower prosecution costs and reduce application pendency. In this article, we offer some thoughts and tips on making the best use of these after-final options.

AFTER FINAL CONSIDERATION PROGRAM 2.0

AFCP 2.0, while technically a pilot program, has been continually renewed since its

predecessor was launched in 2013.¹ Unlike the programs discussed below, AFCP 2.0 proceeds before the current examiner.² Participation in the program does not require any additional fees; an applicant merely includes a formal request and one or more non-broadening claim amendments in an after-final response.³ The program authorizes three hours of additional time for examiners to search and consider the response.⁴ If the after-final response does not place the application in condition for allowance, an interview is conducted to discuss the results of the search and consideration with the applicant.⁵

Critically, the additional time provided to examiners rewards them for any use of AFCP 2.0, and therefore provides an incentive for examiners to advance the application. Patent examiners are required to meet production “count” thresholds every two week period (biweek) based on milestones such as issuing office actions, disposal (e.g., allowance, abandonment), and so on.⁶ The 80 hours of a biweek are divided into “examination” time and other time for activities such as training, and the assigned number of counts is assigned based on the number of examination hours, the examiner’s experience level, and the complexity of the art.⁷ For example, an examiner with 72 hours of examination time per biweek, having average experience in an art unit of average complexity, must accrue about seven counts every biweek.⁸ While AFCP 2.0 in itself does not provide any counts, it removes three hours from the total “examination” time and therefore lowers the number of additional counts needed. Using the assumptions provided above, reducing the biweekly

examination time burden by three hours effectively provides about 0.3 counts, which is more than an examiner receives for drafting a final office action.⁹

In short, AFCP 2.0 allows an applicant to present a new amendment that may advance/resolve issues without incurring the expense and delays of an RCE, and gives the examiner more time to carefully consider an after-final response.¹⁰ According to the USPTO, a majority of surveyed applicants felt that that AFCP 2.0 was effective in advancing prosecution and reducing the need for an RCE.¹¹ The survey results are somewhat generalized; in our experience, AFCP 2.0 can indeed be effective, but only under the right circumstances.

Officially, AFCP 2.0 requires that you amend an independent claim in a non-broadening (i.e., narrowing) manner. In practice, however, AFCP 2.0 is typically successful in even more limited scenarios. Our own informal survey of colleagues' experiences revealed that AFCP 2.0 is more effective when the amendments are extremely limited (*e.g.*, merely clarify an already-claimed feature, or rolling in dependent features) and do not present new issues or unexpected claim language. In practice, lengthy amendments, amendments to multiple claim elements, and new claim features not previously considered are often deemed to raise too many issues and result in denial of the AFCP request by requiring efforts that would exceed the time allocated under the program. AFCP 2.0 is also more appropriate where you are early in the shortened statutory period for response, such that no extensions would be needed if the amendment is not entered.

Finally, as mentioned above, AFCP 2.0 is only available where an independent claim is amended yet not broadened. One catch is that you must affirmatively

make a statement to that effect. It goes without saying that you do not want to make an inaccurate representation on the record. Furthermore, the non-broadening statement could be used during litigation to interpret the claims. These are additional factors that might make the difference in deciding whether to use AFCP 2.0 at all.

PRE-APPEAL BRIEF CONFERENCE PILOT

Most practitioners consider appeal a procedure of last resort. The full appeal process can take years and incur thousands of dollars in USPTO fees and attorney time. Thus, at any given time, the default best move is to continue negotiating with the examiner, such as via AFCP 2.0. Before the pre-appeal brief route existed, the applicant was sometimes presented with a Hobson's choice — accept claim scope of less than what they were entitled to (in the face of a deficient rejection), or put the case on indefinite hold to await a Patent Trial and Appeal Board (PTAB) decision.

The PABC Pilot, under certain circumstances, offers applicants another genuine option. As in a regular appeal, the application must be eligible for appeal, which requires that the applicant's claims have been twice rejected.¹² This is where the similarity ends.

In the PABC Pilot, the applicant submits, simultaneously with a Notice of Appeal, a Pre-Appeal Brief Request for Review. The brief is reviewed by a panel of three examiners, rather than by the PTAB. Whereas a regular appeal can take years to reach a decision, applicants should expect a decision on pre-appeal within 45 days.¹³ While a regular appeal brief is usually lengthy and covers all arguments, a pre-appeal brief must be concise — it is limited to five pages — and point out a clear error. Moreover, the official fee for filing

MORE ▶

[AFTER-FINAL PRACTICE, FROM PAGE 11]

a pre-appeal brief is simply the fee for filing a notice of appeal, whereas a regular appeal additionally involves an appeal forwarding fee (currently \$2000 for large entities).

There are three possible outcomes from filing a proper pre-appeal brief: the application may be immediately allowed, prosecution on the merits may be re-opened (with a different ground for rejection), or the application may remain under appeal and the applicant is given time to file a full appeal brief under the appeal process.

As mentioned above, the pre-appeal route is appropriate for positions involving straightforward objective errors, such as claim features clearly missing from references or a clear lack of *prima facie* obviousness. Don't expect to win on a nuanced point. Be picky; don't necessarily include all of your arguments as you would in a regular appeal. If the panel feels that the issues are complex, such as requiring substantive interpretation of the prior art, the pre-appeal will almost certainly be bounced to the regular appeal process.

There is one other practical consideration. The panel for the pre-appeal review conference includes the examiner of record and a supervisor.¹⁴ The examiner of record will, per human nature, defend the rejection to the other two panel members (without the applicant being present at the conference to rebut). If the examiner of record is a supervisor (you can tell because the examiner signed the office action), the other two panel members should theoretically have no skin in the game. However, if the examiner is not a supervisor, then most likely the examiner's own supervisor will also be a panel member. Because that supervisor approved (and likely directed) the original rejection, the applicant is going in with two votes against it. This virtually ensures that the pre-appeal will be transferred to the

regular lengthy appeal process. Even if it is a long shot under such circumstances, going through the pre-appeal motions may not be a waste, as there is little downside to trying; there are no additional fees, and the exercise would force the applicant to triage and fine-tune the arguments before a full appeal brief is filed.

POST-PROSECUTION PILOT PROGRAM

Until recently when it ended by design on January 11, 2017, the P3 Program had potential. P3 was promoted as a combination of the PABC Pilot and AFCP 2.0.¹⁵ Similar to the PABC Pilot, the applicant would file up to five pages of arguments, which were reviewed by a panel of three examiners. Similar to AFCP 2.0, the arguments would be considered an after-final response under 37 C.F.R. § 1.116 (thus no notice of appeal or corresponding fee), and the applicant could include a non-broadening amendment to the claims. Thus, if the rejections were upheld, the application would remain in after-final status rather than proceed to the PTAB. Unique to P3, however, the applicant would make an oral presentation to the panel. In contrast to the pre-appeal process described above, this opportunity to interact with the panel theoretically provided a huge advantage.

One peculiar limitation with P3 was that the P3 arguments had to be filed within two months of final rejection. It is unclear why this limitation existed. Hopefully, if the USPTO decides to re-institute a version of P3, the time limitation will be relaxed.

CONCLUSION

There are, of course, many more conventional ways to address an after-final application, such as requesting an examiner interview (always a good idea when budget allows), submitting a traditional after-final amendment, filing a

request for continued examination, or pursuing full appeal. These have their place, but because they constitute the meat-and-potatoes of after-final practice, these procedures have been well-studied and need not be addressed further here. Rather, we have presented some thoughts and tips on the alternatives: AFCP 2.0, PABC Pilot, and P3. With the exception of P3, which for the moment is no longer available and hopefully will return in some form, each can be a valuable (if specialized) tool when used properly. ■

1. After Final Consideration Pilot Program 2.0 Description and Memorandum of Understanding (http://popa.org/static/media/uploads/uploads/After_Final_Pilot_Agreement_09-23-2014.pdf), at 1. AFCP 2.0 is currently extended until September 30, 2017.
2. If the examiner does not have negotiation authority, another examiner will participate in the examiner interview should one occur. *Id.* at 2.
3. 78 Fed. Reg. 29117.
4. <https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>; After Final Consideration Pilot Program 2.0 Description and Memorandum of Understanding at 1-2.
5. <https://www.uspto.gov/patent/initiatives/after-final-consideration-pilot-20>
6. See, e.g., *U.S. Patent & Trademark Office, Examination Time and the Production System* (<https://www.uspto.gov/sites/default/files/Examination%20Time%20and%20the%20Production%20System.pdf>) at 19-20; *U.S. Patent & Trademark Office, FY 2011 Examiner Production Credits and Revisions to Examiner Expectancies* (<http://popa.org/static/media/uploads/Agreements/counts-counts-31aug2010.pdf>) at 2.
7. *Id.* at 14-20 [*Examination Time and the Production System*]
8. See, e.g., 14-20 [*Examination Time and the Production System*]; U.S. Department of Commerce, Office of Inspector General, Report IPE-15722 (available at http://www.americanbar.org/content/dam/aba/migrated/intelprop/109legis/CommerceDept_IGReportonPTO.authcheckdam.pdf).
9. *Examiner Production Credits*, at 2.
10. Applicants should receive a response within a month of filing the AFCP request. See, e.g., <https://www.uspto.gov/sites/default/files/afcp%202-0%20faq.pdf>.
11. <https://www.uspto.gov/sites/default/files/afcp%202-0%20faq.pdf>.
12. Practitioners sometimes misunderstand what “twice rejected” refers to. This requirement refers to twice rejecting the applicant’s request for a patent, rather than requiring that a particular individual claim must have itself been rejected twice. *Ex parte Lemoine*, 46 USPQ2d 1420 (BPAI 1994).
13. For additional details, see: <https://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm>.
14. MPEP § 1204.02.
15. <https://www.uspto.gov/patent/initiatives/post-prosecution-pilot>.

BANNER & WITCOFF CONGRATULATES INNOVATIVE CLIENTS FOR APPEARANCES ON ABC’S “SHARK TANK”

Banner & Witcoff congratulates clients ReThink LLC and Guard Llama Inc. for their recent appearances on ABC’s “Shark Tank.”

Trisha Prabhu, a 16-year-old innovator, social entrepreneur and advocate from Naperville, Ill., appeared on “Shark Tank” on Sept. 23. She invented ReThink as a way to stop cyberbullying. When a teenager posts a message on social media, ReThink uses its context sensitive filtering technology to determine whether or not it is offensive and gives the teenager a chance to reconsider his or her decision.

Joe Parisi, the CEO of Chicago company, Guard Llama, appeared on “Shark Tank” on April 14. He founded his company to help people who are in danger but can’t call for help on their cell phone. By pressing a button on the Guard Llama, the device sends a signal to their phone via Bluetooth, and the phone then automatically sends the police their location.

Watch their episodes at abc.go.com/shows/shark-tank.

USING *EX PARTE* APPEALS TO ADVANCE KEY PATENTS TO FURTHER CORPORATE GOALS



BY BRADLEY J.
VAN PELT AND
CAMILLE SAUER

Although much of the discussion lately has been focused on Patent Trial and Appeal Board (PTAB) trials, the U.S. Patent and Trademark Office (USPTO) has also taken an initiative to reduce the backlog of *ex parte* appeals and to reduce the average pendency of appeals of examiner rejections. In past years, to applicants, the PTAB guised itself as a black hole for appealing examiner decisions in slowly processing examiner rejections. In many instances, this led to applicants being forced to accept narrower claim language from examiners or applicants abandoning applications altogether due to prospective patent rights losing value in light of long wait times for the PTAB's decision on the appeal. In the past, the PTAB took an average of 2 ½ to 3 years to review an examiner's rejections. The latest statistics show that the PTAB now reviews decisions on average in 1 ½ years, and the USPTO's goal is to further reduce overall pendency to a year. This makes the appeal process much more attractive to applicants.

In many cases, dealing directly with the examiner will still lead to obtaining rights quicker than pursuing an appeal. However, special circumstances exist where it makes sense to appeal. For example, applicants can be faced with a difficult examiner, an incorrect application of art, or the invention may be highly important to the business. There are certainly no one-size-fits-all approaches in deciding whether to file an appeal, but in addition to the potential delay in obtaining rights, certain factors may include the likelihood of success, the overall importance of the case to applicants, costs associated with filing an appeal, and examiner statistics. Below we address some of the factors involved with the decision-making process in determining whether to appeal an examiner's rejection.

CURRENT PENDENCY OF APPEALS AT THE PTAB

Applicants typically consider filing an appeal in instances where applicants regard the rejections to be improper and, as such, are not interested in amending the claims to advance prosecution. However, one main factor when deciding whether to appeal is the delay it will introduce. This factor appears

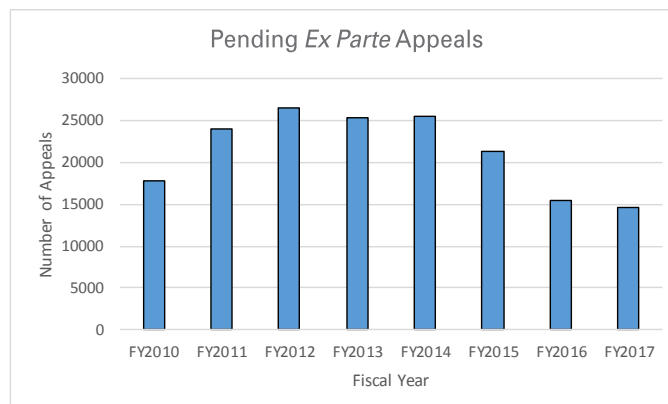


Illustration No. 1 – Number of pending *ex parte* appeals from Fiscal Years 2010 to 2017 (Source: “USPTO Appeal and Interference Statistics,” March 31, 2017)

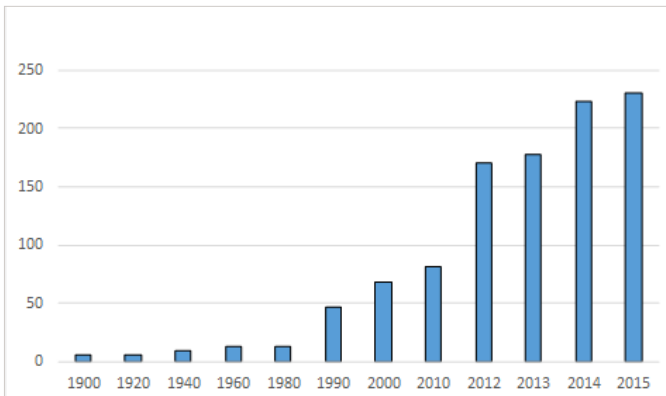


Illustration No. 2 – Number of judges on the PTAB as of April 20, 2015 (Source: “Patent Trial and Appeal Board Update,” May 14, 2015)¹

to be changing. One indication that *ex parte* appeals are proceeding through the PTAB at a faster pace is the trend in the overall reduction in pending *ex parte* appeals. Illustration No. 1 shows the number of pending appeals from Fiscal Year 2010 to Fiscal Year 2017. There has been a 43 percent reduction in pending *ex parte* appeals from Fiscal Year 2012 (the highest recorded year, and also when the America Invents Act (AIA) was enacted), in which 26,484 appeals were pending, to March 2017, in which only 14,611 appeals were pending.

This can be attributed to the increase in the headcount of PTAB judges brought by the AIA. As shown in Illustration No. 2, the most recent data shows that the PTAB (or the Board of Patent Appeals and Interferences prior to the formation of the PTAB in 2012) has been continuously increasing the number of its judge count at the PTAB, including a number

of judges who only handle *ex parte* appeals.

The average pendency of appeals varies depending on the particular technology at issue. Illustration No. 3 is a chart released by the USPTO showing a breakdown of the pendency of appeals based on the technology center. Technology Center 3600 “Construction, Electronic Commerce, Agriculture, National Security and License & Review Management Roster” and Technology Center 3700 “Mechanical Engineering, Manufacturing and Medical Devices/Processes Management Roster” have the highest pendency of appeals of around two years. These particular technology centers both include mechanical arts. Although, Technology Center 3600 includes some mechanical areas, it also includes electronic commerce, which is highly susceptible to ineligibility rejections under the Supreme Court’s decision in *Alice Corp. v. CLS*

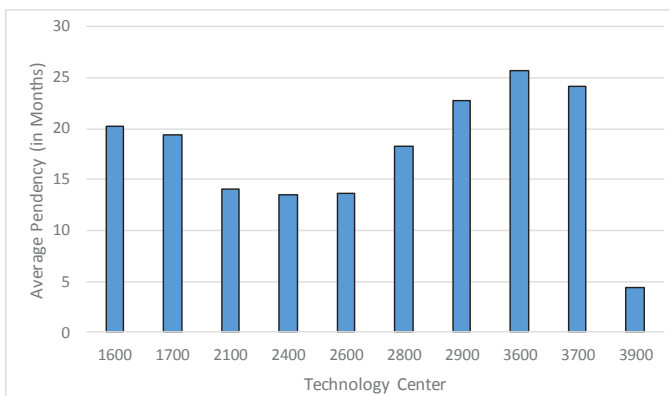


Illustration No. 3 – Pendency of appeals by technology center Fiscal Year 2017 (Source: “USPTO Appeal and Interference Statistics,” March 31, 2017)

MORE ▶

[EX PARTE APPEALS, FROM PAGE 15]

Bank Int'l, 573 U.S. ___, 134 S. Ct. 2347 (2014), so this may be why Technology Center 3600 receives many appeals of examiner rejections. Certain estimates indicate that recent *ex parte* appeals regarding ineligibility rejections have an even lower rate of successfully reversing the examiner's rejections.²

The lowest appeal pendency is Technology Center 3900 "Central Reexamination Unit" followed by Technology Center 2400 "Computer Networks, Multiplex Communication, Video Distribution, and Security," Technology Center 2600 "Communications," and Technology Center 2800 "Semiconductors, Electrical and Optical Systems and Components." The low pendency in Technology Center 3900 is likely due to the special nature of this technology center, which only handles requests for reexamination. Also the pendency of appeals of design cases from Technology Center 2900 is relatively higher, which may be somewhat of a surprise given that design cases are less complicated than utility applications.

CHANCES OF SUCCESS IN WINNING AN APPEAL

In addition to the likely delay that would be caused by an appeal, an applicant must also contemplate the overall chance of success in winning an appeal. Unfortunately for

applicants, examiners have a slight advantage in winning at the PTAB, and Illustration No. 4 reflects this data. Applicants have a less than 50 percent chance at prevailing at the PTAB. Examiners are affirmed 55 percent of the time. Examiners are reversed completely 29.9 percent of the time and are reversed in part 13 percent of the time. However, this data should be reconciled with the fact that after filing the appeal brief, certain cases can be allowed after the appeal conference, meaning that at the appeal conference, the examiners decided that the case was allowable based on the arguments set forth in the appeal brief. For example, some estimates indicate 19 percent of appeal briefs filed lead to an allowance before reaching the PTAB and another 21 percent were pulled from the appeal cycle by the examiner via an office action.³

The fact that many cases are pulled from the appeal cycle may indicate that examiners will only send stronger rejections to the PTAB. During the appeal conference three examiners, typically the examiner, the examiner's supervisor, and a more senior examiner, meet and discuss the merits of the case. The examiners must agree on whether to continue to argue the rejection and to send the case to the PTAB for review. In certain instances, the examiners do not all agree, at which point the application may be allowed

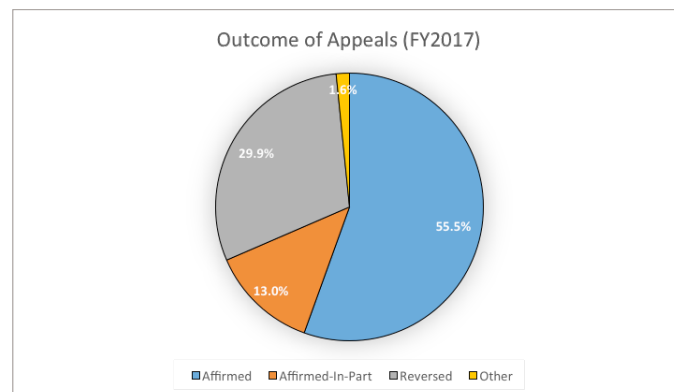


Illustration No. 4 – Appeal outcomes Fiscal Year 2017 (Source: "USPTO Appeal and Interference Statistics," March 31, 2017)

or prosecution may be reopened. Thus, when dealing with a more difficult examiner and a weaker rejection, submitting an appeal may be more attractive to applicants.

COSTS ASSOCIATED WITH FILING EX PARTE APPEALS

Cost is also an important factor in deciding whether to appeal. Filing an appeal adds to the cost of any application. The rules provide that applicants are permitted to file an appeal, once the claims have been twice rejected. Filing an appeal involves filing a notice of appeal for a fee of \$800 for regular/large entities. After two months the applicant must submit an appeal brief. This contains all of the applicant’s arguments and is likely the most expensive aspect of an appeal. The USPTO then conducts an appeal conference with the examiner handling the application and two other examiners from the art unit, one of which is the examiner’s supervisory patent examiner or SPE. During the conference, the examiners must decide whether to maintain the rejection and send the case to the PTAB for review. In some instances, during the appeal conference, the examiners may decide to allow the application. However, if the examiners decide that the case should go to the PTAB, the examiner handling the application will draft an examiner’s answer defending the grounds

of the rejection. Once the examiner’s answer is mailed, the applicant may file an optional reply brief and optionally request an oral hearing. In order to send the case to the PTAB at this stage, the applicant must submit a fee of \$2,000. The applicant can also request an oral hearing by paying the required fee of \$1,300. Once the briefs and any oral argument have been considered, the PTAB issues its decision, which may reverse the examiner in whole or in part, affirm the examiner, or even set forth new grounds of rejection. Although the USPTO fees are reflected above, this does not include the attorney fees associated with the appeal. The average attorney fees are reflected below in Illustration No. 5, which shows the average costs associated with appealing an examiner’s decision both with and without oral argument.

EXAMINER STATISTICS

Whether to file an appeal may depend in large part on the particular examiner that is handling the case. Reviewing examiner data can be especially important when deciding whether to file an appeal with the USPTO. Many examiner statistics are tracked by legal research services. Generally, examiners that have higher allowance rates are likely to be more favorable to applicants and an appeal may not be necessary. When handling a case in front of an examiner with a higher

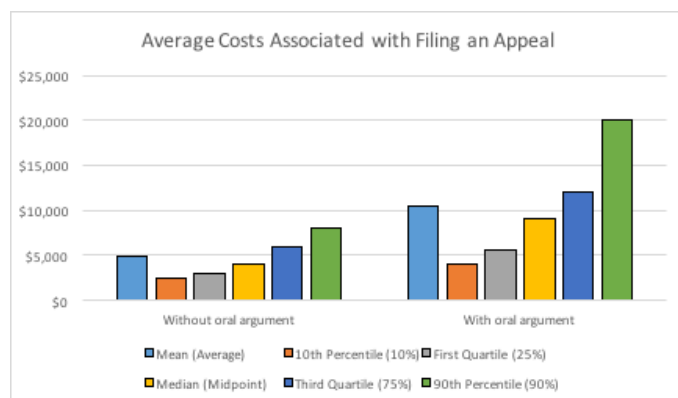


Illustration No. 5 – Average costs associated with filing an appeal (Source: AIPLA 2015 Report of the Economic Survey)

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[EX PARTE APPEALS, FROM PAGE 17]

allowance rate and faced with a rejection, you may be able to discuss the case with the examiner and come to an agreement on allowable subject matter. On the contrary, if the examiner's allowance rate is low, an appeal may be a more strategic option.

Legal research providers also track various appeal statistics of examiners. Illustration

Nos. 6-8 illustrate some of the examiner data that is tracked by legal research services. For instance, applicants can also review appeal exit breakdowns, total applicant wins and losses, and whether a particular examiner has a low or high reversal rate at the PTAB. This data can be very useful in helping applicants decide whether to file an appeal.

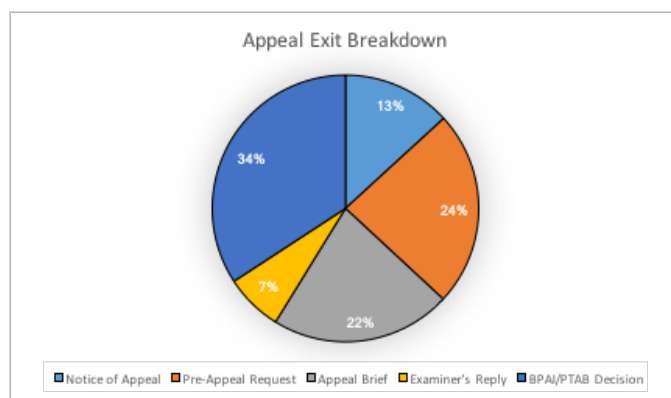


Illustration No. 6 –
Example examiner appeal record analysis (Source: LexisNexis PatentAdvisor)

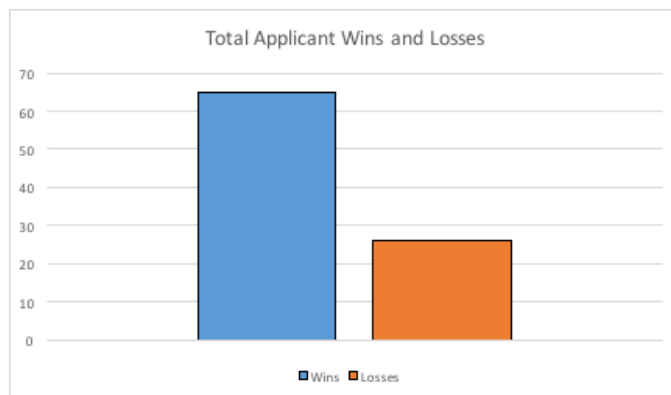


Illustration No. 7 –
Example examiner appeal record analysis (Source: LexisNexis PatentAdvisor)

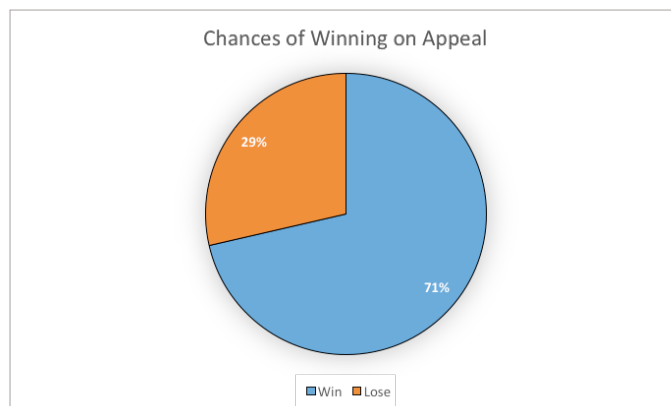


Illustration No. 8 –
Example examiner appeal record analysis (Source: LexisNexis PatentAdvisor)

CONCLUSION

Applicants have a number of factors to ponder when deciding whether to file an appeal – including timing, cost, the examiner whose rejections are potentially being appealed, and the chances of winning an appeal. In most instances, on balance, it is more practical to deal with the examiner to accomplish the applicant's goals, and, ultimately, filing an appeal will most likely remain a last resort for applicants despite the improved pendency statistics. Filing an appeal may also add significant costs to the

application. However, now that the USPTO has reduced pendency, appeals have become a better tool to applicants, for example, where the invention is important and the applicant is faced with a difficult examiner. ■

1. "Patent Trial and Appeal Board Update," May 14, 2015; https://www.uspto.gov/sites/default/files/documents/20150514_PPAC_PTAB_Update.pdf
2. "Alice on Dulany Street: How the PTAB handles 101 in ex parte appeals," January 31, 2017; <http://www.ipwatchdog.com/2017/01/31/alice-dulany-street-ptab-handles-101-ex-parte-appeals/id=77800/>
3. "Ex Parte Appeal as a Potential Means to Quick Allowances," March 21, 2016; <http://www.ipwatchdog.com/2016/03/21/ex-parte-appeals-quick-allowances/id=67297/>

BANNER & WITCOFF ATTORNEY SERVES AS VOLUNTEER JUDGE AT D.C.-AREA HIGH SCHOOL

One-hundred percent of graduates of Benjamin Banneker Academic High School, a magnet school located in Washington, D.C., are accepted into college. During a visit to Banneker High School in 2016, then President Barack Obama praised these achievements: "We have made a lot of progress in terms of making sure that young people across the country get the kind of great education that you're getting here at Banneker. And I am really proud of what we've accomplished. I'm proud of what the District of Columbia has accomplished."

Banner & Witcoff attorney Jeffrey H. Chang served, alongside scientists, teachers, and speechwriters, as a volunteer judge at the 2017 Banneker High School Science Fair on Feb. 24. In a turn of events, the organizers tasked Jeff with judging the chemistry projects, despite his background in electrical engineering. In addition to judging the numerous science fair projects and interacting with students, Jeff learned much from the projects, including the quality of local bodies of water in the D.C. area and which sports drinks truly contain the most electrolytes.

Banner & Witcoff's Pro Bono Committee, chaired by Darrell G. Mottley, supports local and national Science, Technology, Engineering and Math (STEM) programs that train the next generation of innovators and entrepreneurs.

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