

# INTELLECTUAL PROPERTY UPDATE AND YEAR IN REVIEW

The Intellectual Property Newsletter of Dykema • January 2021

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**“THE ACT PROVIDES  
ADDITIONAL TOOLS  
TO THE USPTO TO  
RESPOND TO THE  
RISE IN IMPROPER  
BEHAVIOR IN  
TRADEMARK FILINGS  
INCLUDING FILING  
FRAUDULENT  
CLAIMS OF USE.”**

## **CONGRESS PASSES TRADEMARK MODERNIZATION ACT LEGISLATION**

In December 2020, the U.S. Congress took action that will have a significant effect on brand holders. At the end of the year, Congress passed the Trademark Modernization Act (“TMA”) that, inter alia, provides additional tools to the USPTO to respond to the rise in improper behavior in trademark filings including filing fraudulent claims of use. The Act creates two new expedited procedures, expungement and reexamination, to challenge questionable claims of use in U.S. commerce. Expungement will allow for expedited challenge of a registration on the basis the mark “has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.” The petition for expungement must identify the goods/services that were never used in commerce under the mark, along with any supporting evidence and a verified statement setting forth “the elements of the reasonable investigation the petitioner conducted to determine that the mark has never been used in commerce.”

The new law also provides for reexamining a registration based on a claim that the mark “was not in use in commerce on or in connection with some or all of the goods or services recited in the registration on or before the relevant date.” The “relevant date” is the filing date of use-based application or the date an Amendment to Allege Use was filed (or the expiration date of the deadline for filing the Statement of Use). The petition must identify the goods/services that were not in use in commerce as of the relevant date, along with supporting evidence and a verified statement setting forth the elements of the investigation conducted.

The Director of the USPTO is also allowed to initiate either proceeding, presumably if a bogus specimen or claim of use is brought to the USPTO’s attention.

The TMA provides the USPTO has one year to implement regulations to allow for challenges to improper claims of use. It is expected USPTO rulemaking will further clarify the requisite evidence to initiate a claim. The details and deadlines involving such proceedings, and the interplay with other challenges, remain open questions that will be resolved in rulemaking.

The other significant provision in the new Act is to create a rebuttable presumption that irreparable harm exists when trademark infringement is shown. This provision should assist in obtaining injunctions in trademark litigation in the courts.

The TMA also codifies trademark examination procedures that allow third parties to submit evidence in a Letter of Protest, and also give the USPTO the flexibility to set response periods by regulation (and presumably for shorter periods than the current 6 month time frame for all Office Actions to clear “deadwood” sooner).

Dykema’s Trademark Practice Group Chair, Jennifer Fraser, was involved in providing comments and language for the proposed legislation to Congressional Staff.



# NEW COPYRIGHT APPLICATION FOR SHORT ONLINE LITERARY WORKS

The US Copyright Office has issued a final regulation (37 CFR §202.4) permitting a single, “group” registration for “Short Online Literary Works”.

To be eligible, each of the works included in the registration “must be published as part of a website or online platform, including online newspapers, social media websites, and social networking platforms.” Further, each covered work must be comprised mainly of text (this requirement distinguishes the category of covered works from the broader definition of “literary works”, which includes words, numbers, symbols). Thus, the registration will cover only copyright rights in the text of each individual work. No other copyrightable aspect will be protected, including as a compilation or collective work.

In addition:

- each work must contain at least 50, and no more than 17,500 words;
- each work must be authored by an individual or jointly by individuals –no works for hire
- each work must have the identical authors, who also must be the claimant(s) – this does not mean that “owner” of rights has to be the author/claimant, *even at the time of submission* ; current Copyright Office practice allows for author as claimant even if author does not own the rights as of filing date;
- all of the covered works must have been first published within a 3 calendar month period;
- a maximum of 50 works may be included in the registration.

Registration will be made through a new Copyright Office form, GRTX.

Application requirements include providing:

- a title for each covered work and for the group as a whole
- the number of works included
- a sequentially numbered list, similar to a Table of Contents, with title, first publication date, and word count for each covered work
- a deposit copy in the form of a zip file, containing a separate digital file for each included work, named with the title of that work

The filing fee will be \$65.



# PTO INCREASES TRADEMARK OFFICE FEES ON JANUARY 2 2021

After the required rulemaking process allowing for input from stakeholders, the PTO has announced it will be imposing some new fees effective January 2, 2021. Dykema's Trademark Practice Group Leader, Jennifer Fraser, provided testimony on the new fees on behalf of the International Trademark Association. The PTO decided not to impose some initially proposed fees and some of the fees will also affect strategy to avoid fees and extra filings.

Some of the increases are a part of typical periodic increases to adjust fees to improve examination and invest in IT upgrades. Other fees are new and are designed to "adjust applicant behaviors that put an undue burden on the trademark system and that can adversely affect the quality and integrity of the trademark register." For example, after filing a Post-Registration Declaration of Use, if the PTO raises an inquiry questioning use for one or more items in a list of goods/services, a fee will be imposed if use cannot be supported and goods/services are deleted. New fees will also be imposed for Letters of Protest, oral hearings and multiple extension requests for appeal briefs.

	Old Fee	New Fee (effective January 2, 2021)
<b>Application filing fees</b>	TEAS Standard: \$275 per class TEAS Plus: \$225 per class Processing fee for filing to meet TEAS Plus requirements: \$125 per class	TEAS Standard: \$350 per class TEAS Plus: \$250 per class Processing fee for filing to meet TEAS Plus requirements: \$100 per class
<b>Post registration fees</b>	Section 8 or 71 declaration: \$125 per class	Section 8 or 71 declaration: \$225 per class <b>New:</b> for deleting goods, services, and/or classes from a registration after submitting a Section 8 or 71 declaration, but before the declaration is accepted: \$250 per class
<b>Petition fees</b>	Petition to Director: \$100 Petition to revive: \$100	Petition to Director: \$250 Petition to revive: \$150 <b>New:</b> Letter of protest: \$50 per application
<b>TTAB fees</b>	Petition to cancel: \$400 per class Notice of Opposition: \$400 per class Initial 90-day extension request for filing notice of opposition, or second 60-day extension request for filing notice of opposition: \$100 per application Final 60-day extension request for filing a notice of opposition: \$200 per class Ex parte appeal: \$200 per class	Petition to cancel: \$600 per class Notice of Opposition: \$600 per class Initial 90-day extension request for filing notice of opposition, or second 60-day extension request for filing notice of opposition: \$200 per application Final 60-day extension request for filing a notice of opposition: \$400 per class Ex parte appeal: \$225 per class <b>New:</b> Second, and subsequent, requests for an extension of time to file an appeal brief in an ex parte appeal: \$100 per application <b>New:</b> Appeal briefs in ex parte appeal: \$200 per class <b>New:</b> Requests for oral hearings: \$500 per proceeding

# PATENT FEE CHANGES AT THE USPTO

In order to adjust for increasing cost and provide continued operations, effective October 2 2020 most patent fees at the USPTO went up across the board. While most of the fee increases are modest, the USPTO has also added a new fee important to our electronic way of life, discontinued some other fees.

For a full listing of fee changes, see the Table of Patent Fee Adjustments.

## To summarize the USPTO, adjustments include:

1. An approximate 5 percent increase to most fees impacted by the rule, explained as an approximate 2% annual increase to help with inflation in order to achieve strategic goals.
2. Adjustments to certain existing fees to permit cost recovery for certain services.
3. New fees for non-DOCX filings, though the fee will not be effective immediately, and a new fee for pro hac vice admission.
4. Four discontinued fees—three relating to patent service fees and one related to an Office of Enrollment and Discipline USPTO-assisted recovery of ID or password reset fee.

	Current Fees			Final Patent Fee Schedule Fees		
	Large Entity	Small Entity	Micro Entity	Large Entity	Small Entity	Micro Entity
<b>Patent Application Filing Fees</b>						
Basic Filing fee - Utility (paper filing also requires non-electronic filing fee under 1.16(t))	\$300	\$150	\$75	\$320	\$160	\$80
Basic filing fee - Utility (electronic filing for small entities)	n/a	\$75	n/a	n/a	\$80	n/a
Basic Filing Fee - Design	\$200	\$100	\$50	\$220	\$110	\$55
Basic Filing Fee - Design (CPA)	\$200	\$100	\$50	\$220	\$110	\$55
Basic Filing Fee - Plant	\$200	\$100	\$50	\$220	\$110	\$55
Provisional Application Filing Fee	\$280	\$140	\$70	\$300	\$150	\$75
Basic Filing Fee - Reissue	\$300	\$150	\$75	\$320	\$160	\$80
Basic Filing Fee - Reissue (Design CPA)	\$300	\$150	\$75	\$320	\$160	\$80
Each Independent Claim in Excess of Three	\$460	\$230	\$115	\$480	\$240	\$120
Each Reissue Independent Claim in Excess of Three	\$460	\$230	\$115	\$480	\$240	\$120
Multiple Dependent Claim	\$820	\$410	\$205	\$860	\$430	\$215
Utility Application Size Fee - for Each Additional 50 Sheets That Exceeds 100 Sheets	\$400	\$200	\$100	\$420	\$210	\$105
Design Application Size Fee - for Each Additional 50 Sheets That Exceeds 100 Sheets	\$400	\$200	\$100	\$420	\$210	\$105
Plant Application Size Fee - for Each Additional 50 Sheets That Exceeds 100 Sheets	\$400	\$200	\$100	\$420	\$210	\$105
Reissue Application Size Fee - for Each Additional 50 Sheets That Exceeds 100 Sheets	\$400	\$200	\$100	\$420	\$210	\$105
Provisional Application Size Fee - for Each Additional 50 Sheets That Exceeds 100 Sheets	\$400	\$200	\$100	\$420	\$210	\$105
Surcharge - Non-DOCX Filing	n/a	n/a	n/a	\$400	\$200	\$100
Surcharge - Non-DOCX Filing - (electronic filing for small entities)	n/a	n/a	n/a	n/a	\$200	n/a
Submission of sequence listings of 300MB to 800MB	\$1,000	\$500	\$250	\$1,060	\$530	\$265
Submission of sequence listings of more than 800 MB	\$10,000	\$5,000	\$2,500	\$10,500	\$5,250	\$2,625
<b>Patent Search Fees</b>						
Utility Search Fee	\$660	\$330	\$165	\$700	\$350	\$175
Plant Search Fee	\$420	\$210	\$105	\$440	\$220	\$110
Reissue Search Fee	\$660	\$330	\$165	\$700	\$350	\$175
<b>Patent Examination Fees</b>						
Utility Examination Fee	\$760	\$380	\$190	\$800	\$400	\$200
Design Examination Fee	\$600	\$300	\$150	\$640	\$320	\$160

Plant Examination Fee	\$620	\$310	\$155	\$660	\$330	\$165
Reissue Examination Fee	\$2,200	\$1,100	\$550	\$2,320	\$1,160	\$580
<b>Patent Post-Allowance Fees</b>						
Utility Issue Fee	\$1,000	\$500	\$250	\$1,200	\$600	\$300
Reissue Issue Fee	\$1,000	\$500	\$250	\$1,200	\$600	\$300
Design Issue Fee	\$700	\$350	\$175	\$740	\$370	\$185
Plant Issue Fee	\$800	\$400	\$200	\$840	\$420	\$210
Publication Fee for Republication	\$300			\$320		
<b>Patent Extension of Time Fees</b>						
Extension for Response Within First Month	\$200	\$100	\$50	\$220	\$110	\$55
Extension for Response Within Second Month	\$600	\$300	\$150	\$640	\$320	\$160
Extension for Response Within Third Month	\$1,400	\$700	\$350	\$1,480	\$740	\$370
Extension for Response Within Fourth Month	\$2,200	\$1,100	\$550	\$2,320	\$1,160	\$580
Extension for Response Within Fifth Month	\$3,000	\$1,500	\$750	\$3,160	\$1,580	\$790
<b>Patent Maintenance Fees</b>						
For Maintaining an Original or Any Reissue Patent, Due at 3.5 years	\$1,600	\$800	\$400	\$2,000	\$1,000	\$500
For Maintaining an Original or Any Reissue Patent, Due at 7.5 years	\$3,600	\$1,800	\$900	\$3,760	\$1,880	\$940
For Maintaining an Original or Any Reissue Patent, Due at 11.5 years	\$7,400	\$3,700	\$1,850	\$7,700	\$3,850	\$1,925
Surcharge - 3.5 year - Late Payment Within 6 Months	\$160	\$80	\$40	\$500	\$250	\$125
Surcharge - 7.5 year - Late Payment Within 6 Months	\$160	\$80	\$40	\$500	\$250	\$125
Surcharge - 11.5 year - Late Payment Within 6 Months	\$160	\$80	\$40	\$500	\$250	\$125
Petition for the Delayed Payment of the Fee for Maintaining a Patent in Force	\$2,000	\$1,000	\$500	\$2,100	\$1,050	\$525
<b>Miscellaneous Patent Fees</b>						
Request for Continued Examination (RCE) - 1st Request (see 37 CFR 1.114)	\$1,300	\$650	\$325	\$1,360	\$680	\$340
Request for Continued Examination (RCE) - 2nd and Subsequent Request (see 37 CFR 1.114)	\$1,900	\$950	\$475	\$2,000	\$1,000	\$500
Request for Prioritized Examination	\$4,000	\$2,000	\$1,000	\$4,200	\$2,100	\$1,050
Correction of Inventorship After First Action on Merits	\$600	\$300	\$150	\$640	\$320	\$160
Other Publication Processing Fee	\$130			\$140		
Request for Voluntary Publication or Republication	\$130			\$140		
Request for Expedited Examination of a Design Application	\$900	\$450	\$225	\$1,600	\$800	\$400
Submission of an Information Disclosure Statement	\$240	\$120	\$60	\$260	\$130	\$65
Filing a Submission After Final Rejection (see 37 CFR 1.129(a))	\$840	\$420	\$210	\$880	\$440	\$220
For Each Additional Invention to be Examined (see 37 CFR 1.129(b))	\$840	\$420	\$210	\$880	\$440	\$220
<b>Post Issuance Fees (* Third-Party Filers Are Not Eligible for the Micro Entity Fee.)</b>						
Certificate of Correction	\$150			\$160		
Processing Fee for Correcting Inventorship in a Patent	\$150			\$160		
Ex Parte Reexamination (§ 1.510(a)) Streamlined	\$6,000	\$3,000	\$1,500*	\$6,300	\$3,150	\$1,575*
Ex Parte Reexamination (§ 1.510(a)) Non-Streamlined	\$12,000	\$6,000	\$3,000*	\$12,600	\$6,300	\$3,150*
Refused request for ex parte Reexamination	\$3,600	\$1,800	\$900*	\$3,780	\$1,890	\$945*
Each Reexamination Independent Claim in Excess of Three and Also in Excess of the Number of Such Claims in the Patent Under Reexamination	\$460	\$230	\$115	\$480	\$240	\$120
Statutory Disclaimer, Including Terminal Disclaimer	\$160			\$170		
Request for Supplemental Examination	\$4,400	\$2,200	\$1,100	\$4,620	\$2,310	\$1,155
Reexamination Ordered as a Result of Supplemental Examination	\$12,100	\$6,050	\$3,025	\$12,700	\$6,350	\$3,175
Supplemental Examination Document Size Fee - for Each Additional 50 Sheets or a Fraction Thereof in a Nonpatent Document	\$280	\$140	\$70	\$300	\$150	\$75

**Patent Trial and Appeal Fees (\* Third-Party Filers Are Not Eligible for the Micro Entity Fee.)**

Petitions to the Chief Administrative Patent Judge Under 37 CFR 41.3	\$400			\$420		
Notice of Appeal	\$800	\$400	\$200*	\$840	\$420	\$210
Filing a Brief in Support of an Appeal in an Inter Partes Reexamination Proceeding	\$2,000	\$1,000	\$500*	\$2,100	\$1,050	\$525
Request for Oral Hearing	\$1,300	\$650	\$325*	\$1,360	\$680	\$340
Forwarding an Appeal in an Application or Ex Parte Reexamination Proceeding to the Board	\$2,240	\$1,120	\$560*	\$2,360	\$1,180	\$590*
IPR Request Fee - Up to 20 Claims	\$15,500			\$19,000		
IPR Post-Institution Fee - Up to 15 Claims	\$15,000			n/a		
IPR Post-Institution Fee - Up to 20 Claims	n/a			\$22,500		
IPR Request of Each Claim in Excess of 20	\$300			\$375		
Inter Partes Post-Institution Request of Each Claim in Excess of 15	\$600			n/a		
Inter Partes Post-Institution Request of Each Claim in Excess of 20	n/a			\$750		
Post-Grant or Covered Business Method Review Request Fee - Up to 20 Claims	\$16,000			\$20,000		
Post-Grant or Covered Business Method Review Post-Institution Fee - Up to 15 Claims	\$22,000			n/a		
Post-Grant or Covered Business Method Review Post-Institution Fee - Up to 20 Claims	n/a			\$27,500		
Post-Grant or Covered Business Method Review Request of Each Claim in Excess of 20	\$375			\$475		
Post-Grant or Covered Business Method Review Post-Institution Request of Each Claim in Excess of 15	\$825			n/a		
Post-Grant or Covered Business Method Review Post-Institution Request of Each Claim in Excess of 20	n/a			\$1,050		
Petition for a Derivation Proceeding	\$400			\$420		
Request to Make a Settlement Agreement Available and Other Requests Filed in a Patent Trial Proceeding	\$400			\$420		
Pro Hac Vice Admission Fee	n/a			\$250		

**Patent Petition Fees (\* Third-Party Filers Are Not Eligible for the Micro Entity Fee.)**

Petitions Requiring the Petition Fee Set Forth in 37 CFR 1.17(f) (Group I)	\$400	\$200	\$100	\$420	\$210	\$105
Petitions Requiring the Petition Fee Set Forth in 37 CFR 1.17(g) (Group II)	\$200	\$100	\$50	\$220	\$110	\$55
Petition for Revival of an Abandoned Application for a Patent, for the Delayed Payment of the Fee for Issuing Each Patent, or for the Delayed Response by the Patent Owner in any Reexamination Proceeding	\$2,000	\$1,000	\$500	\$2,100	\$1,050	\$525
Petition for the Delayed Submission of a Priority or Benefit Claim	\$2,000	\$1,000	\$500	\$2,100	\$1,050	\$525
Petition to Excuse Applicant's Failure to Act Within Prescribed Time Limits in an International Design Application	\$2,000	\$1,000	\$500	\$2,100	\$1,050	\$525
Filing an Application for Patent Term Adjustment	\$200			\$210		
Request for Reinstatement of Term Reduced	\$400			\$420		
Petitions in a Reexamination Proceeding, Except for those Specifically Enumerated in 37 CFR 1.550(i) and 1.937(d)	\$1,940	\$970	\$485*	\$2,040	\$1,020	\$510
Extension of Term of Patent	\$1,120			\$1,180		
Initial Application for Interim Extension (see 37 CFR 1.790)	\$420			\$440		
Subsequent Application for Interim Extension (see 37 CFR 1.790)	\$220			\$230		

**PCT Fees - National Stage**

Basic National Stage Fee	\$300	\$150	\$75	\$320	\$160	\$80
National Stage Search Fee - Search Report Prepared and Provided to USPTO	\$520	\$260	\$130	\$540	\$270	\$135
National Stage Search Fee - All Other Situations	\$660	\$330	\$165	\$700	\$350	\$175
National Stage Examination Fee - All Other Situations	\$760	\$380	\$190	\$800	\$400	\$200
Each Independent Claim in Excess of Three	\$460	\$230	\$115	\$480	\$240	\$120
Multiple Dependent Claim	\$820	\$410	\$205	\$860	\$430	\$215



Search Fee, Examination Fee or Oath or Declaration After the Date of Commencement of the National Stage	\$140	\$70	\$35	\$160	\$80	\$40
National Stage Application Size Fee - for Each Additional 50 Sheets That Exceeds 100 Sheets	\$400	\$200	\$100	\$420	\$210	\$105
<b>PCT Fees - International Stage</b>						
Transmittal Fee	\$240	\$120	\$60	\$260	\$130	\$65
Search Fee - Regardless of Whether There is a Corresponding Application (see 35 U.S.C. 361(d) and PCT Rule 16)	\$2,080	\$1,040	\$520	\$2,180	\$1,090	\$545
Supplemental Search Fee When Required, per Additional Invention	\$2,080	\$1,040	\$520	\$2,180	\$1,090	\$545
Transmitting Application to Intl. Bureau to Act as Receiving Office	\$240	\$120	\$60	\$260	\$130	\$65
Preliminary Examination Fee - U.S. Was the ISA	\$600	\$300	\$150	\$640	\$320	\$160
Preliminary Examination Fee - U.S. Was Not the ISA	\$760	\$380	\$190	\$800	\$400	\$200
Supplemental Examination Fee per Additional Invention	\$600	\$300	\$150	\$640	\$320	\$160
Late Furnishing Fee for Providing a Sequence Listing in Response to an Invitation Under PCT Rule 13ter	\$300	\$150	\$75	\$320	\$160	\$80
Petition for the extension of the twelve-month (six-month for designs) period for filing a subsequent application	\$2,000	\$1,000	\$500	\$2,100	\$1,050	\$525
<b>Hague International Design Application Fees</b>						
International Design Application First Part U.S. Designation Fee	\$960	\$480	\$240	\$1,020	\$510	\$255
(Part II Designation Fee) Issue Fee Paid Through the International Bureau in an International Design Application	\$700	\$350	\$175	\$740	\$370	\$185
<b>Patent Service Fees</b>						
Copy Patent File Wrapper, Paper Medium, Any Number of Sheets	\$280			\$290		
Copy Patent File Wrapper, Electronic Medium, Any Size or Provided Electronically	\$55			\$60		
Handling Fee for Incomplete or Improper Application	\$130			\$140		
Additional Fee for Expedited Service	\$160			\$170		
Copy of Patent Technology Monitoring Team (PTMT) patent bibliographic extract and other DVD (optical disc)	\$50			discontinue		
Copy of U.S. patent custom data extracts	\$100			discontinue		
Copy of selected technology reports, miscellaneous technology areas	\$30			discontinue		
<b>Patent Enrollment Fees</b>						
Application Fee (Non-Refundable)	\$100			\$110		
On Registration to Practice Under §11.6	\$200			\$210		
On Grant of Limited Recognition Under §11.9(b)	\$200			\$210		
For Test Administration by Commercial Entity	\$200			\$210		
For Test Administration by the USPTO	\$450			\$470		
Review of Decision by the Director of Enrollment and Discipline Under §11.2(c)	\$400			\$420		
Review of Decision of the Director of Enrollment and Discipline Under §11.2(d)	\$400			\$420		
On Petition for Reinstatement by a Person Excluded or Suspended on Ethical Grounds, or Excluded on Consent from Practice before the Office	\$1,600			\$1,680		
Administrative Reinstatement Fee	\$200			\$210		
On Change of Registration From Agent to Attorney	\$100			\$110		
For USPTO-Assisted Recovery of ID or Reset of Password for the Office of Enrollment and Discipline Information System	\$70			discontinue		
For USPTO-Administered Review of Registration Examination	\$450			\$470		



# SUPREME COURT AFFIRMS ADDITION OF .COM TO GENERIC TERM RENDERS BOOKING.COM REGISTRABLE

In June of 2020, in a decision contrary to then-current Patent and Trademark Office (“PTO”) rules, the United States Supreme Court found the mark BOOKING.COM as a whole is not generic and that combining a generic term with “.com” does not necessarily result in a composite term that also is generic. “Consumers do not in fact perceive the term ‘Booking.com’ that way,” the court wrote. “That should resolve this case: Because ‘Booking.com’ is not a generic name to consumers, it is not generic.”

Underlying the Court’s decision is the fact that Booking.com also established it had acquired distinctiveness in the BOOKING.COM mark, including through the use of survey evidence. While the scope of protection against competitors is likely narrow, the Court’s decision opened the door to registering marks consisting of generic marks with TLDs. However, registration of such marks still will not be easy. The full discussion on the Dykema website is available here.

In an Examination Guide issued in October, the USPTO said such names will continue to face an uphill climb to prove that they are worthy of protection, requiring plenty of evidence that consumers view them as trademarks before they are approved. The Guide explains that because there is no per se rule a generic.com trademark is generic, examining attorneys are to view the evidence on a case-by-case basis. Examiners must show “the relevant consumers would understand the primary significance of the term, as a whole, to be the name of the class or category of the goods and/or services identified in the application.” Such a refusal could also be appropriate if the evidence establishes that the combination of the generic elements of the mark “yields no additional meaning to consumers capable of distinguishing the goods or services.”

Consistent with current procedures, the examiner should not initially refuse registration of such a mark as generic, but should instead refuse registration of the mark as merely descriptive and should not suggest amendment to the Supplemental Register or a claim of acquired distinctiveness. The Examination Guide also discusses likelihood of confusion refusals for such marks indicating additional terms play a significant role and, as with many examination issues, the evidence will be critical.

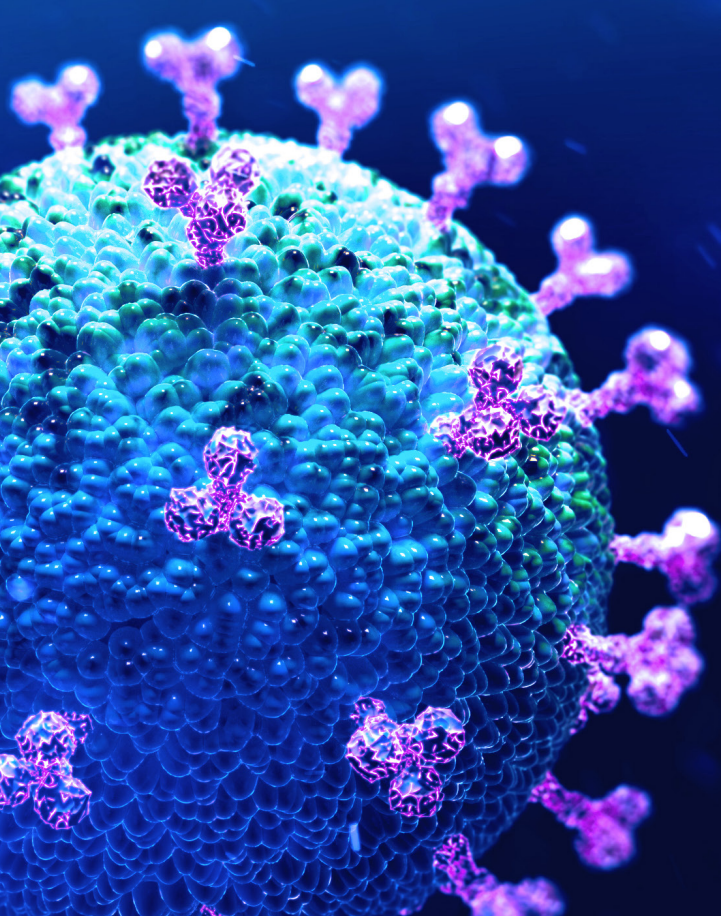
## USPTO ACTIVE DURING COVID-19

The USPTO was quick to action moving all interviews, oral hearings and other in-person meetings to telephone and video conferences, and closing its offices to the public. Relief from a few minor requirements was quickly implemented (e.g., waiving petition fees and signature requirements). The most substantive relief came with the CARES Act which allowed the USPTO to grant extensions of time to file certain documents and pay required fees.

The USPTO implemented initiatives related to technologies and products for helping the country handle the pandemic. One is a web-based marketplace for pandemic-related patents and patent applications available for license. There are now almost 900 assets listed in the marketplace covering various technologies, including disposable wipes and RNA extraction methods.

Other initiatives focused on COVID-19 inventions and products. These included a pilot program for priority patent examination on COVID-19 related inventions and priority examination for trademark and service mark applications for COVID-19 medical products and services. Additionally, the USPTO waived the fee for such petitions.

The USPTO created a webpage to help practitioners and the public keep track of the changes and initiatives. Between March 15 and the end of September, there were more than 20 notices related to COVID-19. Practitioners had to keep up with all of these changes and assess whether their clients could benefit.



Judges and IP lawyers became adept at conducting virtual hearings. Given the success of virtual hearings, it is likely courts will continue to utilize them in many instances, but resume traditional in-person hearings when it is safe to do so for important matters such as summary judgment and jury trials.

## IP LITIGATION DURING COVID-19

With many courts shutting down to stem the rising tide of cases, almost all IP case deadlines were continued pursuant to Court order. Because IP clients were often dealing with health and business issues, pending and prospective IP litigation matters were often placed on hold so that clients could focus on matters of more immediate importance. With courts closed, parties seeking to resolve IP litigation matters found themselves taking things into their own hands by initiating settlement discussions and ADR.

Additionally, judges and IP lawyers became adept at conducting virtual hearings. Given the success of virtual hearings, it is likely courts will continue to utilize them in many instances, but resume traditional in-person hearings when it is safe to do so for important matters such as summary judgment and jury trials.

In anticipation, several courts recently began to defrost their dockets. However, scheduling trials continues to be difficult. Chief Judge Rodney Gilstrap recently announced he was postponing all jury trials in the IP-heavy Eastern District of Texas until March 2021 citing, inter alia, the rising rate of increase of COVID-19 cases and travel restrictions and quarantines. Other courts throughout the country have issued similar orders. When trials resume in earnest, priority is given to criminal cases over civil cases, meaning IP trials in many busy courts may not take place until well into 2021. But this will be assessed on a case-by-case basis by the judge.

In terms of patent litigation, 2020 has seen a decrease in most cases. However, Hatch-Waxman litigation continues unabated due to immovable deadlines, and NPE litigation appears to be picking up. Looking to 2021, we expect patent litigation to look much like it did pre-pandemic, with the possible exception of additional NPE cases under patents recently owned by companies that had to sell their IP as a result of financial hardships.

Dykema attorneys have prepared a resource of all COVID-related court closures and rule changes throughout the U.S. The website is updated regularly and also includes individual state reopening plans and other resources.

# USPTO YEAR IN REVIEW BY THE NUMBERS

**251** patent requests for the COVID-19 Prioritized Patent Examination Pilot Program have been granted, and 33 patents are being allowed or granted. *(More than half of the patent applications granted prioritized examination are directed to medical treatments, vaccines, and diagnostic technology. The balance of the applications are directed to ventilators, personal protective equipment (PPE), and other technology related to COVID-19.)*

**129** trademark petitions have been granted for the COVID-19 Prioritized Trademark Examination Program. *(Almost half of the trademark petitions granted are for items designed to detect and treat COVID-19. The other half are for PPE and medical goods, as well as medical services related to COVID-19.)*

**400,000** trademark registrations were issued by the USPTO in 2020.

Trademark application filings increased by **9.6%** in FY 2020, which was much higher than Trademark Operations' original projection.

Trademark Operations initially estimated it would receive **692,000** classes for registration in FY 2020. However, the actual number of classes filed in FY 2020 was 738,112, due to a surge in both domestic and foreign applications during the second half of the fiscal year.

Trademark Operations continued to receive notable increases in filings originating from mainland China. **14%** of total classes filed came from China, the largest share of filings from any foreign country. This represents an increase of almost **1,521%** from seven years ago, far outpacing growth from any other country. Despite a slow start for the year, Chinese filings increased by **34.2%** from FY 2019 to FY 2020.

All-electronic processing of trademark applications rose to **88.7%** leading to more efficient processing, fewer errors, and more cost-effective transactions.

**23.3** months - the USPTO reduced average patent examination time. Faster than last year's 23.8 months average and significantly faster than in recent years.

The Patents End-to-End (PE2E)-Search Tool, a new patent search system, provides examiners with increased access to prior art. This tool currently provides examiners access to **39 million** more foreign documents and full English translation documents than the current search tool (EAST/WEST); by April 2021, that number will increase to over **70 million**. The search system can also integrate with an artificial intelligence-based tool to help examiners find more relevant prior art.



# ARTIFICIAL INTELLIGENCE AND THE INTERSECTION WITH IP

In early October the United States Patent and Trademark Office (USPTO) released a report titled “Public Views on Artificial Intelligence and Intellectual Property Policy.” It took a comprehensive look at a wide variety of stakeholder views on the impact of artificial intelligence (AI) across the intellectual property (IP) landscape, including patent, trademark, copyright, and trade secret policy, as well as developing issues about database protection. As stated by Director Iancu, “One of the agency’s top priorities is to ensure that the United States maintains its leadership in innovation, especially in emerging technologies such as artificial intelligence (AI). To that end, the USPTO has been actively engaging with the innovation community and experts in AI to determine whether further guidance is needed to promote the predictability and reliability of intellectual property rights relating to AI technology and to encourage further innovation in and around this critical area.”

According to the WIPO Technology Trends 2019-Artificial Intelligence Publication, we know that machine learning is the dominant AI field “and is included in more than one-third of all identified inventions.” AI published applications grew by 400% in the past decade. At the USPTO, AI technologies are part of about 26% of annual patent filings, which is a 34% increase in the share of AI patent filings since 2005.

An interesting topic that arises in the report is on the issue of whether AI can be patentable. A common theme was that AI is not sufficiently advanced—and will not be for some time—to warrant the exclusion of a human inventor, therefore eliminating the need for novel legislation. However, the growing ubiquity of AI would affect how the USPTO and courts would assess the legal hypothetical standard of a “person having ordinary skill in the art,” which is critical to determining the issuance of a patent right.

Specifically on trademarks, most commenters agreed that AI would improve efficiency of examination of trademark applications. Although this sentiment was also generally shared in regard to patent examination.

“One of the agency’s top priorities is to ensure that the United States maintains its leadership in innovation, especially in emerging technologies such as artificial intelligence (AI). To that end, the USPTO has been actively engaging with the innovation community and experts in AI to determine whether further guidance is needed to promote the predictability and reliability of intellectual property rights relating to AI technology and to encourage further innovation in and around this critical area.”

— Andrei Iancu, Director of the U.S. Patent and Trademark Office



## WEST TEXAS BECOMES PATENT HOTBED

Numbers don't lie. By any account, Judge Alan Albright's Western District of Texas courtroom in Waco, Texas is the preferred venue for patent cases and the new patent rocket docket. Prior to Judge Albright taking the bench, patent cases filed in Waco were scarce. In 2016 and 2017, the two years prior to Judge Albright's appointment, there were only five patent cases filed in Waco. Indeed, since the division's creation in 1984, fewer than 10 patent cases had been filed in Waco. But since taking the bench, patent cases have exploded. In 2018, the WDTX had 90 patent cases. Last year, in 2019, the WDTX saw a three-fold increase, with 278 patent cases in the district. In 2020, the pace has continued. Through November 23, 2020, 3,863 patent cases have been filed nationwide. Of that number, nearly 791 have been filed in Judge Albright's court, meaning 1/5th (20%) of all new patent cases are filed in his court. If this pace continues for the year, the WDTX will see a tripling of the number of patent case from 2019 and a more than 700% increase in patent cases over the last four years.

While not all patent cases can be filed in Waco due to post-Heartland venue restrictions, the WDTX is home to many companies with regular and established place of business and Judge Albright has solidified his place at the nation's go to judge for patent cases. If patent filing trends continue through the rest of this year, we should exceed the 3,600 patent cases filed in 2019. And while no one can predict the number of cases that might be filed in 2021, we can rest assured that Judge Albright and Waco, Texas will get the lion's share.



## DYKEMA CONGRATULATES ITS NEWLY ELECTED MEMBERS IN THE IP DEPARTMENT



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Tania Shapiro-Barr, M.D. focuses on the preparation and prosecution of patent applications in technology fields including medical devices, biotechnology, and pharmaceuticals. Ms. Shapiro-Barr has experience prosecuting both foreign and domestic patent applications, as well as counseling clients and drafting opinions regarding patentability, freedom-to-operate, infringement, and validity. Her experience further includes patent litigation and trademark prosecution.



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James Pechacek has a decade of experience in the patent field, including work in patent preparation, prosecution, litigation, and licensing. His experience includes preparing and prosecuting patent applications with the USPTO while also conducting complex patent litigation in a number of venues across the country. Mr. Pechacek's technical experience includes significant work in electromagnetic and solid state data storage systems and sub-systems, electro-mechanical systems, and manufacturing automation. His experience also includes work in biomedical, automotive and green technologies. As an engineer, he worked as a lead product design engineer in the photo-electric sensor industry.

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Denise Mayfield Denise brings sophisticated scientific, commercial and legal experience combining patent, health care, pharma, biotech and software/AI advances to protect client assets. Her strong science background (with an advanced degree in genetics and physiology, and years of experience as a medical researcher) together with her legal training, brings strategic and technically focused legal services to her clients. A skilled and experienced patent attorney, she assists domestic and international clients in identifying, protecting, licensing and litigating bet-the-company technologies.



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Michael Gzybowski enjoys working with inventors and company R&D personnel to fully evaluate and protect their inventions. As an engineer and experienced patent examiner in the USPTO, he concentrates his practice in preparing and prosecuting U.S. patent applications and obtaining foreign patents in many countries around the world in various technical fields. In addition, Mike provides support for patent litigation, counsels clients on patentability, infringement, right to use, and validity issues, and prepares and evaluates licensing agreements, joint development agreements and other intellectual property-related agreements.



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