

## PATENT & TRADEMARK POLICY REPORT JANUARY 8, 2021



### I. Congressional Developments:

- On December 27, 2020, President Trump signed [H.R. 113](#), the Consolidated Appropriations Act, 2021, into law. The massive end-of-the-year spending package funds the federal government through the remainder of Fiscal Year (FY) 2021 and included a \$900 billion stimulus. The package included several provisions related to copyrights and trademarks in Division Q, Title II ([PDF page 2,539](#)). For instance, the *Trademark Modernization (TM) Act of 2020* ([H.R. 6196/S. 3449](#)) made it into the final package. The bill seeks to restore balance in the trademark system by creating new processes to allow even small businesses to challenge improper registrations through ex parte cancellation proceedings. It was [introduced](#) on March 11, 2020 by Reps. Jerrold Nadler (D-NY), Chairman of the House Judiciary Committee; Doug Collins, then-Ranking Member of the House Judiciary Committee; Hank Johnson (D-GA), Chairman of the Subcommittee on Courts, Intellectual Property, and the Internet; and Martha Roby (R-AL), Ranking Member of the Subcommittee on Courts, Intellectual Property, and the Internet. Senate Judiciary IP Subcommittee Chairman Thom Tillis (R-NC) and Ranking Member Chris Coons (D-DE) introduced companion legislation in the upper chamber. The bill creates a mechanism for individuals to file petitions to expunge or reexamine trademarks based on an argument that the mark has never been used in commerce in connection with the goods and services listed in the registrations. It also allows third parties to submit evidence during the trademark examination on why the application should be refused. Finally, the bill includes a provision designed to shield the Trademark Trial and Appeal Board (TTAB) from a constitutional challenge, by giving the USPTO Director the authority to reconsider, and modify or set aside a decision

### Headlines and Highlights:

- *TM Act of 2020* signed into law as part of the end-of-the-year government funding and stimulus package.
- President-elect Joe Biden taps Rhode Island Governor Gina Raimondo to serve as Commerce Secretary.
- ITC opens investigation into whether Volkswagen AG infringed on patents held by Jaguar Land Rover.
- Judge sets tentative start date for Google antitrust trial in lawsuit brought by DOJ for September 2023.
- CBP officers in Louisville intercept shipment containing 1,216 pieces of counterfeit designer jewelry.
- Health Canada issues advisory warning Canadians about the potential risks associated with counterfeit vaccines.

from the Board. The House Judiciary Committee had reported the bill favorably out of the House Judiciary Committee on September 9, 2020.

## **II. Administration Updates:**

- News surfaced on Thursday that President-elect Joe Biden intends to nominate Rhode Island Governor Gina Raimondo as Commerce Secretary. Before running for office, Raimondo was a founding employee at the investment firm Village Ventures and co-founded her own venture capital firm, Point Judith Capital. Read more [here](#).
- On Tuesday, the U.S. Customs and Border Protection (CBP) officers in Louisville intercepted a shipment, arriving from Hong Kong, containing 1,216 pieces of counterfeit designer jewelry with an estimated retail value of \$707,160. The parcel was bound for Hollywood, Florida. More info. [here](#).

## **III. USPTO Updates:**

- On Wednesday, USPTO issued a guidance memorandum to the Patent Trial and Appeal Board (PTAB) regarding the approach to indefiniteness under 35 U.S.C. § 112 in America Invents Act (AIA) post-grant proceedings. The memorandum ensures that the agency's approach to analyzing indefiniteness in AIA post-grant proceedings will adhere to the approach used in district courts, as set forth in the Supreme Court's *Nautilus* decision. Under that decision, a claim of a patent challenged for indefiniteness is unpatentable for indefiniteness if the claim, read in light of the patent specification and the prosecution history, fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention. Read the full memorandum [here](#).
- USPTO is reopening the public comment period for the application of the traditional doctrines of trademark infringement to the e-commerce setting for 14 days. More info. [here](#).

## **IV. Judicial Updates:**

- At a status hearing last month, Judge Amit Mehta set September 12, 2023, as a tentative start date for the trial of the antitrust lawsuit brought by the U.S. Department of Justice (DOJ) against Google. The trial date suggests that the search giant, who currently faces three lawsuits from different groups of states and the DOJ, will stay in the public spotlight in the coming years as policymakers examine its practices. Read more [here](#).

## **V. International Updates:**

- Last month, the U.S. International Trade Commission (ITC) opened an investigation into whether Volkswagen AG infringed on patents held by Jaguar Land Rover for a system used for off-road driving. Jaguar Land Rover filed a complaint with the ITC in November seeking to prevent the import of some VW Porsche, Lamborghini and Audi models with "certain vehicle control systems," claiming that the vehicles in question infringe its patents. VW said that it was examining the action and determining next steps. Read more [here](#).
- Health Canada has issued a pre-emptive advisory to Canadians warning them not to buy COVID-19 vaccines online or from unauthorized sources, due to the potential health risks of

potentially counterfeit vaccines. Health Canada has authorized the use of two vaccines so far – one from Pfizer-BioNTech and another from Moderna. More info. [here](#).

## **VI. Industry Updates:**

- In an editorial published in *The Washington Post* on Tuesday, Doni Bloomfield and Aaron S. Kesselheim with the Therapeutics, Law, and Regulation (PORTAL) research group at Brigham and Women’s Hospital/Harvard Medical School, urged USPTO to work to curb rising prescription drug prices through action that does not require Congress to act. Specifically, Bloomfield and Kesselheim urge USPTO to give examiners more leeway to reject ineligible applications and more time to do their jobs, as well as reduce the Office’s dependence on revenue from granting patents. The authors claim that so-called follow-on patents, which are secondary patents on successful drugs that cover things other than the active ingredient, are invalidated in court at a much higher rate than drugmakers’ original patents. Bloomfield and Kesselheim claim that the government issues what they see as weak patents because the USPTO “treats patent applicants, rather than the public, as its customers.” Read more [here](#).