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WELCOME

By **Jessica Landacre**, *IPO Executive Director*

Each time I write my introduction to the IPOwners Quarterly, I feel a tremendous sense of pride for what the IPO community has accomplished. In addition to active U.S. policy advocacy on behalf of our members, our international involvement has grown year over year. Earlier this year, I was honored to participate in a partnership with WIPO to present an online conference on the Global Innovation Index Future of Innovation featuring IPO Board member companies from diverse industries. In June, IPO participated in IP5 Industry with the IP5 Heads of Office. There was a robust discussion of issues related to procedural harmonization, including on the progress being made on creating a system for a global assignment of patent rights, expanding e-signature options in the Offices, and harmonizing drawing requirements. We have also created a Green IP subcommittee with a focus on a global approach to the topic.



In March, we were fortunate to bring together more than 170 members to Washington, DC, for the IPOwners Spring Summit. Our topics were diverse and forward looking with sessions on data considerations for the future, and effective use of patent agents, taxes and IP, just to name a few. Senator Chris Coons (D-DE), chair of the Senate IP Subcommittee gave an outstanding keynote address forecasting what to expect this year in IP-related legislation. He recalled with pride that he had been the keynote at the IPOwners Spring Summit in March of 2020 just before the world shut-down due to the COVID-19 pandemic. This month we opened [registration for the IPO Annual Meeting](#) in Boston, September 10-12. Like the Summit in March, we have a packed agenda starting with keynote addresses by Shira Perlmutter, Director of the US Copyright Office and Kathi Vidal, Director for the US Patent and Trademark Office. We have concurrent sessions on patents, trade secrets, artificial intelligence, industrial designs, copyrights, trademarks and data licensing. And new this year, we are introducing interactive workshops! Our special event will be a dinner at the Museum of Science. Check out the group discounts and don't miss early bird registration ending on July 31.

For many years, I have wanted to recognize the outstanding collective work of our members and highlight their involvement in activities like those mentioned above. I am pleased to announce that this month we published the association's first [Impact Report](#). This new publication provides an at-a-glance look at IPO's activities from January of 2022 through June of 2023 that have been dedicated to influencing policy in the U.S. and internationally. The report highlights partnerships that have enabled IPO and IPO's Education Foundation to reach broader audiences and celebrates the members who volunteered their time to work on committees, develop new resources, mentor their colleagues, and share best practices. I hope you will review the Impact Report and share it with your colleagues. We welcome feedback. Please enjoy the insights of our thought-leaders in this edition of the IPO Quarterly. I hope to see you all in Boston at [#IPOAM23](#).

2023 ANNUAL MEETING



SEPTEMBER 10-12, 2023

HYNES CONVENTION CENTER | BOSTON, MA

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Q2 2023 U.S. INTELLECTUAL PROPERTY POLICY DEVELOPMENTS

By **Samantha Aguayo**, *IPO Deputy Executive Director & Chief Policy Counsel*

As the summer heats up in the U.S., IP legislation has started heating up in the U.S. Congress. Below I share details about a few of the hottest topics in addition to information about the newest round of proposed USPTO fee adjustments.

IPO appreciates policymakers' continued focus on matters that are important to our members. Although our membership has a diverse range of views on many issues, collectively we endeavor to offer insights on legislation that are inclusive and balance the varying interests of our members, promote innovation, and increase certainty and predictability for IP owners. I invite readers to share their thoughts on these and any other policy issues of interest with me via email at samantha@ipo.org.



PATENT TRIAL AND APPEAL BOARD REFORMS

On June 22, Senator Chris Coons, Chair of the Senate Judiciary Subcommittee on Intellectual Property, introduced the "Promoting and Respecting Economically Vital American Innovation Leadership Act" (PREVAIL Act) with Subcommittee Ranking Member Thom Tillis (R-NC), Judiciary Committee Chair Dick Durbin (D-IL), and Subcommittee member Mazie Hirono (D-HI) as original cosponsors. The bill proposes numerous changes to the procedures for USPTO post grant proceedings, including:

- Requiring the USPTO to establish a code of conduct for Patent Trial and Appeal Board judges, increasing transparency, and preventing interference with PTAB judges' decision making;
- Specifying that judges who decide whether to institute a proceeding may not participate in deciding the outcome;
- Creating a standing requirement similar to seeking declaratory judgment of noninfringement;
- Establishing a rebuttable presumption against joinder for time-barred petitioners and related parties;
- Specifying that petitions raising same or substantially the same prior art or arguments previously presented to the USPTO shall be denied;
- Requiring petitioners and related parties to choose between PTAB or other forums for challenging a patent's validity (and eliminating co-pending litigation as a basis for denying institution as well as civil action estoppel provisions);
- Applying estoppel at the time a petition is filed and limiting petitioners to one petition per patent unless later charged with infringement;
- Prohibiting review where another forum has previously decided a patent's validity;
- Codifying the USPTO's application of the district court claim construction standard;
- Changing the burden of proof to clear and convincing evidence; and
- Codifying current PTAB motion to amend practice.

A [fact sheet](#) and section-by-section summary of the bill are available on Senator Coons' website. A companion was introduced in the House on June 27 by Reps. Ken Buck (R-CO) and Deborah Ross (D-NC).

The PREVAIL Act was introduced days after the comment period closed on a [USPTO Advance Notice of Proposed Rulemaking \(ANPRM\) on "Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board."](#) The USPTO's notice explained that the intent in considering these changes is "to better align the practices with the USPTO's mission to promote and protect innovation and investment in the same, and with the congressional intent behind the American Invents Act (AIA) to provide a less-expensive alternative to district court litigation to resolve certain patentability issues while also protecting against patentee harassment." Specifically, the USPTO is considering revisions to rules used "to exercise the Director's discretion to institute IPRs and PGRs," including "further modifying and clarifying circumstances in which the Board will deny review of serial and parallel petitions," "proposing rules to install *Apple v. Fintiv* and related guidance, with additional proposed reforms," and "rules related to the framework the Board will use to conduct an analysis under 35 U.S.C. 325(d) . . . and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." The notice also indicates that "[t]o curb the potential for abusive filings, the USPTO is considering changes that would limit institution on filings by for-profit, non-competitive entities that in essence seek to shield the actual real parties in interest and privies from statutory estoppel provisions" by discretionarily denying IPR and PGR petitions by for-profit entities that lack declaratory judgment jurisdiction, do not practice in the field of the patent, and lack a substantial relations or service in which the party has invested to bring to market."

When USPTO Director KATHI VIDAL testified in the House Judiciary Subcommittee on Courts, Intellectual Property, and the Internet on Thursday, April 27 on "[Oversight of the U.S. Patent and Trademark Office](#)," many subcommittee members pressed her for information on the ANPRM and expressed concern that the ANPRM exceeds the USPTO's statutory authority. Vidal said Congress had given the USPTO the authority to prescribe regulations governing IPR and PGR proceedings, including setting forth the standards for instituting review, and required the Director to consider the effect of regulations on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability to timely complete proceedings.

IPO submitted [comments on the ANPRM](#), noting that "[c]ertainty and predictability in the law is paramount for IP owners" and that "[s]weeping rules that will undoubtedly be challenged and could be struck down by the courts will undermine that certainty and predictability." IPO urged the USPTO to ensure that each concept under consideration for rulemaking "is within the scope of the agency's statutory authority" and to "cite to the specific source of statutory authority for each new regulation in any future notice of proposed rulemaking." The letter attached comments filed by IPO in December 2020 responsive to a USPTO request concerning the filing of serial petitions for IPR, parallel petitions for IPR, petitions for IPR in view of proceedings in other tribunals, and other considerations, which remain relevant to the issues raised in the April 2023 USPTO request.

I predict a Senate hearing on the PREVAIL Act in the coming weeks or months.

PATENT SUBJECT MATTER ELIGIBILITY

Also on June 22, Senator Tillis introduced the “[Patent Eligibility Restoration Act of 2023](#)” with Senator Coons as cosponsor. The bill maintains the existing categories of eligible subject matter enumerated in 35 U.S.C. § 101—processes, machines, manufactures, and compositions of matter—but adds several categories of ineligible subject matter:

- A mathematical formula that is not part of a useful invention;
- A process that is substantially economic, financial, business, social, cultural, or artistic, unless it cannot be performed without a machine or manufacture;
- A mental process performed solely in the human mind and a process that occurs in nature wholly independent of, and prior to, any human activity;
- An unmodified human gene as it exists in the human body, which does not include genes that are isolated and purified or otherwise employed in a useful invention or discovery; and
- An unmodified natural material as it exists in nature, which does not include materials that are isolated and purified or otherwise employed in a useful invention or discovery.

PERA specifies that eligibility must be determined based on considering the claim as a whole and that considering the way the invention was made, whether a claim element is known, conventional, routine, or naturally occurring, the state of the art as of the date of invention, and any other issues relevant to sections 102, 103, or 112 is not permitted in making an eligibility determination. It also provides that in an infringement action a court may determine eligibility at any time, including on motion for summary judgment, and may permit limited discovery.

In the House, IP Subcommittee Chair Darrell Issa (R-CA) said during the USPTO oversight hearing that the subcommittee will consider legislation on patent subject matter eligibility. Vidal agreed that more clarity was needed in general regarding patent subject matter eligibility and welcomed the opportunity to work with Congress on that issue.

Director Vidal has previously indicated that the USPTO is working on updated subject matter eligibility examination guidance.

ARTIFICIAL INTELLIGENCE

With the rapid development of AI technology, policymakers and IP lawyers are scrambling with the rest of the world to understand possible implications and emerging challenges the technology could create that might require the law to develop in new ways. There were several developments over the past few months in this area.

PATENTS

On April 24, the U.S. Supreme Court denied certiorari in *Thaler v. Vidal*, leaving extant the Federal Circuit’s August 2002 opinion affirming the USPTO’s denial of Thaler’s patent applications on two inventions he claimed were generated by an AI system called “Device for the Autonomous Bootstrapping of Unified Science” (DABUS) with no contribution by him. The USPTO determined that his applications were incomplete because “inventors on a patent application must be natural persons.” The Federal Circuit agreed, explaining that “there is no ambiguity: the Patent Act requires that inventors must be natural persons; that is, human beings.” It elaborated that the statute “expressly provides that

inventors are ‘individuals,’” and Supreme Court precedent defines “individual” as “a human being, a person.” The Federal Circuit’s decision did not address “whether inventions made by human beings with the assistance of AI are eligible for patent protection.”

Artificial intelligence was a major theme of the House IP Subcommittee’s April 27 USPTO oversight hearing. Subcommittee members asked numerous questions about how the Office plans to leverage AI to improve patent search and quality and questions about the patent eligibility of AI technologies.

On May 15 IPO submitted comments to the USPTO regarding artificial intelligence and inventorship. The comments stated, among other things, that AI cannot currently be an inventor and that the inventors are the humans who contributed to at least one claim. They also explained that “AI has been used as a tool for many years without affecting the ability of human inventors to seek, receive, and enforce patents. While current AI tools are more sophisticated than ever, this is a difference in degree rather than kind from past AI systems, and AI contributions to inventorship are properly seen as tools used by human inventors to facilitate human conception rather than independent contributions of the AI system.” As part of the request for comments on this topic, the USPTO held an East Coast listening session and a West Coast public listening session.

In June the Senate Judiciary Subcommittee on Intellectual Property held a hearing on “Artificial Intelligence and Intellectual Property – Part I: Patents, Innovation, and Competition.” The hearing highlighted the distinction between generative and non-generative AI, inventorship issues, global competition in AI, the need for guidance from the USPTO, and potential patent law reforms. Subcommittee Chairman Coons said that this would be the first in a series of hearings designed to address the relationship between AI and IP and technology policy. He advocated for the USPTO to participate in shaping these policies and emphasized the need to explore new and unique protections to address the emerging challenges posed by AI. He articulated a desire to strike a delicate balance between ensuring the implementation of critical safeguards and recognizing AI’s role in fostering innovation and the need for reforms to protect AI creations. Ranking Member Tillis also highlighted the positive potential of AI and expressed a strong desire to ensure that the U.S. maintains a leadership position regarding AI and innovation on the global stage.

Witnesses included Corey Salsberg (Novartis) and Laura Sheridan (Google), both of whom are members of the IPO Board of Directors. Mr. Salsberg emphasized the significant impact of AI in the pharmaceutical industry. He said current AI tools enhance human ingenuity rather than invent independently but that it is important to broaden our definition of inventorship. He said this can be achieved by leveraging existing conception standards. Ms. Sheridan said Google prioritizes responsible development while maximizing positive impacts on society. She emphasized Google’s commitment to protecting AI innovations and the company’s belief that AI is a tool to enhance human inventiveness rather than to replace human involvement. She urged the adoption of standardized definitions for AI-related inventions to promote clarity and consistency in discussions. All witnesses’ written statements and a video recording of the hearing are available on the Judiciary Committee website.

COPYRIGHTS

Earlier this year the U.S. Copyright Office announced its initiative concerning the use of artificial intelligence. In May, four members of the House Judiciary Committee’s Subcommittee on Courts, Intellectual Property, and the Internet sent a letter to Register of Copyrights Shira Perlmutter. The letter,

signed by Subcommittee Chair Issa and three other representatives, requests information on “actions that the Copyright Office is taking to ensure intellectual property rights are being protected against potentially unlawful use by artificial intelligence (AI) programs.”

On May 14 the House Judiciary Committee’s Subcommittee on Courts, Intellectual Property, And the Internet held a hearing on “Artificial Intelligence and Intellectual Property: Part I — Interoperability of AI and Copyright Law.” A link to livestream the hearing and witnesses’ written statements are [available on the House Judiciary Committee website](#).

PATENT AND TRADEMARK FEE ADJUSTMENTS

In April the USPTO announced that it would propose [patent fee adjustments](#) and [trademark fee adjustments](#). Under section 10 of the America Invents Act, the USPTO may set or adjust patent fees subject to a public hearing by the Patent Public Advisory Committee and may set or adjust trademark fees subject to a hearing by the Trademark Public Advisory Committee. [Details about the proposed fees](#) are available on the USPTO website.

After reviewing the testimony and written comments, PPAC and TPAC will prepare reports. The USPTO intends to publish notices of proposed rulemaking on patent and trademark fee adjustments in early 2024, with any new fees taking effect in fiscal year 2025.

In a [letter to the Patent Public Advisory Committee \(PPAC\)](#), Director Vidal said the USPTO’s “financial outlook has two dominant themes. First, the Unleashing American Innovators Act (UAIA) of 2022, signed into law December 29, 2022, reduced barriers to entry into the patent system by increasing small and micro entity discounts. As a consequence of new, higher discounts, the USPTO will collect significantly less fee revenue going forward relative to baseline estimates. Second, the broader U.S. economy has experienced higher-than-expected inflation the last two years and, in turn, increased USPTO operating costs relative to baseline estimates. Consequently, aggregate operating costs will exceed aggregate fee revenues for our patent business line beginning in fiscal year 2025.” After completing this comprehensive financial review, the USPTO has concluded it must “adjust fees to increase aggregate revenue and refine certain fees to efficiently finance ongoing operations.”

At the PPAC public hearing on Thursday, May 18, Courtenay Brinkerhoff (Foley & Lardner), co-vice chair of IPO’s U.S. Patent Office Practice Committee, presented preliminary IPO feedback. IPO submitted [written comments](#) the following week.

In a memo to TPAC, Director Vidal explained that the USPTO “recently completed a comprehensive trademark fee review, with the conclusion that we should adjust fees to increase aggregate revenue and refine certain fees to efficiently finance ongoing operations.” She said “forecasts for aggregate revenue using current demand estimates are lower than prior forecasts,” in addition to “changes to trademark filing and renewal patterns, resulting in some imbalances in the overall fee structure.” She also noted that inflation “has increased USPTO operating costs relative to baseline estimates. Consequently, aggregate operating costs will exceed aggregate fee revenue for our trademarks business line beginning this fiscal year. We will finance this operating shortfall using existing operating reserve balances until the implementation of a new fee schedule that increases fee collections.”

At the TPAC public hearing on June 6, Jen Fraser (Dykema), a member of IPO's U.S. Trademark Office Practice Committee, presented preliminary IPO feedback. The following week, IPO submitted written comments.

RECENT IP CASE LAW ROUNDUP

By **Eric Moran**, *McDonnell Boehnen Hulbert & Berghoff LLP* and **IPO Amicus Brief Committee Co-Vice Chair Paul Berghoff**, *McDonnell Boehnen Hulbert & Berghoff LLP*

We are looking forward to seeing everyone in Boston at IPO's Annual Meeting. It should be a great opportunity for education and networking.

There were a number of significant outcomes in the second quarter of 2023, including a quadrifecta of Supreme Court decisions, one each in patents and copyrights, and two in trademarks.



Starting with patents, on May 18, the Supreme Court delivered its highly anticipated decision in *Amgen v. Sanofi*, a case focused on the enablement requirement of Section 112 as applied to a class of antibodies that lower cholesterol. In a unanimous decision authored by Justice Gorsuch, the Supreme Court affirmed the Federal Circuit's (and the district court's) conclusion that Amgen's specification did not adequately enable its claims to antibodies that block the protein PCSK9 by binding to PCSK9's so-called sweet spot. In large part, the functional nature of Amgen's claims was their downfall. "Amgen seeks to monopolize an entire class of things defined by their functions – every antibody that both binds to particular areas of the sweet spot of PCSK9 and blocks PCSK9 from binding to LDL receptors," a class that the Court characterized as "a vast number" and "an entire kingdom of antibodies." As the Court noted in conclusion: "Section 112 of the Patent Act reflects Congress's judgment that if an inventor claims a lot, but enables only a little, the public does not receive its benefit of the bargain."

The Court dismissed Amgen's argument that its patent provided both a roadmap and a large number of conservative substitutions that could be used to find undisclosed antibodies within the scope of its claims, stating that the roadmap and conservative substitutions amounted "to little more than two research assignments," leaving scientists "to engage in painstaking experimentation to see what works." The Supreme Court did note that a patent specification need not describe every single embodiment falling within the claims so long as there is disclosure of "some general quality running through the class that gives it a peculiar fitness for the particular purpose ... that may reliably enable a person skilled in the art to make and use all of what is claimed, not merely a subset." The Court also pointed out that a specification "may call for a reasonable amount of experimentation to make and use a patented invention," which is in line with several of the Supreme Court's earlier precedents. But at the end of the day, the Supreme Court agreed with the lower courts that Amgen's patent "offers persons skilled in the art little more than advice to engage in trial and error."

Two other patent matters of note. First, the Supreme Court denied certiorari on April 24 in *Thaler v. Vidal*, the Federal Circuit decision holding that "inventors on a patent application must be natural persons," as opposed to artificial intelligence. So, for now at least, AI will have to content itself with world domination outside of the USPTO.

Second, on April 3, the Federal Circuit in *Ironburg Inventions v. Valve Corp.*, vacated the district court's conclusion that the defendant, Valve, was estopped from litigating an invalidity ground that Valve only discovered *after* filing its unsuccessful IPR petition. In a 2-1 opinion authored by Judge Stark (and joined by Judge Lourie), the majority concluded that the district court had improperly placed the burden of proof on Valve "to show that it could not reasonably have raised" the later discovered invalidity basis during the IPR. Instead, because the burden on this point should have rested with the patentee by a preponderance of the evidence, the majority vacated and remanded the case for further proceedings. The majority, however, went on to address the standards for assessing when grounds "reasonably could have been raised" during an IPR under 35 U.S.C. § 315(e)(2). According to the majority, the focus of the inquiry on remand should be "what a skilled and diligent searcher of ordinary skill would find through reasonable diligence" and not what any real-life researchers may or may not have done. (Judge Clevenger dissented on the issue of definiteness without addressing the scope of IPR estoppel.)

Turning to trademarks, on June 8, the Supreme Court handed down its unanimous decision in *Jack Daniel's Properties, Inc. v. VIP Products LLC*. The case marks the first time the Court has addressed the scope of the *Rogers* test, which was formulated to allow a potentially confusing use of an expressive mark as long as that use is artistically relevant and not explicitly misleading. Here, the question was whether the *Rogers* test must be satisfied when the alleged infringing property implicates the First Amendment via parody but made use of the mark in a way that could create confusion as to the source of the infringing product. In the decision penned by Justice Kagan, the Court found that the Ninth Circuit had improperly required that *Rogers* be satisfied before the "likelihood of confusion" analysis could occur. The Supreme Court confirmed findings in prior cases that applied *Rogers* only to cases in which "a trademark is used not to designate a work's source, but solely to perform some other expressive function." The Court dismissed VIP's argument that the *Rogers* test must be satisfied because VIP "conceded" that it used "its Bad Spaniels trademark and trade dress as source identifiers of its dog toy." While acknowledging the First Amendment interests at play, the Court found such interests were still protected by traditional Lanham Act analysis and suggested that a successful parody is unlikely to cause confusion among consumers. Justice Gorsuch, in concurrence, cautioned that the use of the *Rogers* test in other contexts should be done carefully as the statutory or constitutional origins of the *Rogers* test are unclear, and the Court has necessarily left much unsaid about the test.

The Court also reversed the Ninth Circuit's decision regarding Jack Daniel's trademark dilution claim. The Ninth Circuit held that the use of a mark can be "'noncommercial' even if used to sell a product," and that because the use of the mark by VIP was for parody and "conveys a humorous message," it qualified as a noncommercial use. The Supreme Court held that such an application of the noncommercial use exception to trademark dilution was in conflict with the text of the fair use exception. The Court held that the fair use exception, which explicitly covers parodies, clearly states that it does not apply when the infringing mark is used as a source identifier. The Court went on to say that the Ninth Circuit's application of the noncommercial use doctrine "effectively nullifies Congress's express limits on the fair-use exclusion for parody," by allowing the noncommercial use doctrine to shield parody when the mark is used as a source identifier.

And most recently, on June 29, the Supreme Court issued its opinion in *Abitron v. Hetric* concerning the extraterritorial reach of U.S. trademark law. Because the jury's damages award included foreign sales of products that had never entered the U.S., the Supreme Court vacated and remanded the case back to the Tenth Circuit. In the majority opinion authored by Justice Alito and joined by Justices

Thomas, Gorsuch, Kavanaugh, and Jackson, the Court held: “Applying the presumption against extraterritoriality, we hold that these [Lanham Act] provisions are not extraterritorial and that they extend only to claims where the claimed infringing use in commerce is domestic.”

Abitron generated two concurring opinions that may illustrate how the majority’s holding might play out in the future. Using the example from Justice Jackson’s concurrence of a “Coache” bag made and sold in Germany but brought into the U.S. by an American tourist, the majority would appear ready to absolve the German seller from liability even if the infringing “Coache” bag were later resold in the U.S. by the tourist. According to the majority, the territorial reach of the Lanham Act turns on where the accused conduct takes place. Justice Jackson, however, would hold the German seller liable if the bag were resold in the U.S. by the tourist because then “the German company continues to use the mark in commerce.” For its part, Justice Sotomayor’s concurrence (joined by Chief Justice Roberts and Justices Kagan and Barrett) argues that the Lanham Act should “extend to activities carried out abroad when there is a likelihood of consumer confusion in the United States.”- So, Justice Sotomayor would not necessarily preclude liability for the German “Coache” bag maker based on bags that make their way to the U.S. (whether resold or not) and cause domestic consumer confusion, a result that the majority opinion argued would make “a muzzled Chihuahua” out of the presumption against extraterritoriality. (Really, a muzzled Chihuahua?) All of the justices, however, appear to agree that the Tenth Circuit went too far with respect to the accused products that never entered the United States.

Last but not least is the Supreme Court’s decision handed down on May 18 in *Andy Warhol Foundation v. Goldsmith*. This case dealt with a copyrighted photograph of Prince taken by Lynn Goldsmith that was used by Andy Warhol as the starting point for one of his silkscreen celebrity portraits. Mr. Warhol’s foundation (AWF) had licensed his orange silkscreen of Prince to Condé Nast for it’s a cover following Prince’s death without paying Ms. Goldsmith a license fee.

The majority, in a 7-2 opinion authored by Justice Sotomayor (and joined by Justices Thomas, Alito, Gorsuch, Kavanaugh, Barrett, and Jackson), agreed with the Second Circuit that the first fair use factor, “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,” 17 U.S.C. § 107(1), weighs in favor of Ms. Goldsmith, not Mr. Warhol’s foundation. On this point, the majority opinion and the dissent, authored by Justice Kagan and joined by Chief Justice Roberts, are two ships passing in the night. To the majority, the first fair use factor concerns whether the allegedly infringing use “has a further purpose or different character” than the copyrighted work. Here, because Ms. Goldsmith’s original photograph and Warhol’s silkscreen are both “portraits of Prince used to depict Prince in magazine stories about Prince, the original photograph and AWF’s copying use of it share substantially the same purpose,” and a commercial purpose at that. But to the dissent, relying principally on the Supreme Court’s decisions in *Campbell* and *Google*, the true issue is whether Andy Warhol’s reworking of the original photograph was “transformative,” a question that Justice Kagan would answer in the all-caps affirmative.

We highly recommend reading the majority opinion and the dissent in *AWF v. Goldsmith*. They are both immensely entertaining for their creative snarkiness towards each other, harkening back to the opinions of the late Justice Scalia. (You can skip Justice Gorsuch’s concurrence, joined by Justice Jackson. It’s well written, but rather dry by comparison.) While no substitute for a fulsome reading, we share some of our favorite jabs from the case for your enjoyment.

From Justice Sotomayor’s majority opinion:

1. “[T]he dissent begins with a sleight of hand and continues with a false equivalence between AWF’s commercial licensing and Warhol’s original creation. The result is a series of misstatements and exaggerations, from the dissent’s very first sentence (“Today, the Court declares that Andy Warhol’s eye-popping silkscreen of Prince . . . is (in copyright lingo) not ‘transformative’”), to its very last (“[The majority opinion] will make our world poorer”).
2. “The Court does not have ‘much of a future in magazine publishing,’ the dissent chides. While the dissent is probably correct about the Court’s business prospects, [f]ortunately, the dissent’s ‘magazine editor’ test does not have much of a future in fair use doctrine.”
3. “The dissent makes a similar mistake with *Google*: It fails to read the decision as a whole. So while the dissent claims that the ‘[*Google*] Court would have told this one to go back to school,’ it might be easier just to go back and read *Google*.”
4. “Nor will the Court’s decision, which is consistent with longstanding principles of fair use, snuff out the light of Western civilization, returning us to the Dark Ages of a world without Titian, Shakespeare, or Richard Rodgers. ... In tracing the history of Renaissance painting, the dissent loses sight of the statute and this Court’s cases. *The Lives of the Artists* undoubtedly makes for livelier reading than the U. S. Code or the U. S. Reports, but as a court, we do not have that luxury.”

From Justice Kagan’s dissent:

1. “As readers are by now aware, the majority opinion is trained on this dissent in a way majority opinions seldom are. ... I’ll just make two suggestions. First, when you see that description of a precedent differs from the majority’s, go take a look at the decision. Second, when you come across an argument that you recall the majority took issue with, go back to its response and ask yourself about the ratio of reasoning to *ipse dixit*. With those two recommendations, I’ll take my chances on readers’ good judgment.”
2. In *Google*, “[w]e reiterated that protecting transformative uses ‘stimulate[s] creativity’ and thus ‘fulfill[s] the objective of copyright law.’ And then we gave an example. Yes, of course, we pointed to Andy Warhol. (The majority claims not to be embarrassed by this embarrassing fact because the specific reference was to his Soup Cans, rather than his celebrity images. But drawing a distinction between a ‘commentary on consumerism’—which is how the majority describes his soup canvases—and a commentary on celebrity culture, i.e., the turning of people into consumption items, is slicing the baloney pretty thin.)”
3. “Consider how the majority’s factor 1 analysis might play out in literature. And why not start with the best? Shakespeare borrowed over and over and over. [L]et’s take *Romeo and Juliet* as an example. Shakespeare’s version copied most directly from Arthur Brooke’s ... Of course Shakespeare also added loads of genius, and so made the borrowed stories “uniquely Shakespearian.” But on the majority’s analysis? The two works—Shakespeare’s and Brooke’s—are just two stories of star-crossed lovers written for commercial gain. Shakespeare would not qualify for fair use; he would not even come out ahead on factor 1.”
4. “Or how about music? Positively rife with copying of all kinds. Suppose some early blues artist (W. C. Handy, perhaps?) had copyrighted the 12-bar, three-chord form—the essential foundation (much as Goldsmith’s photo is to Warhol’s

silkscreen) of many blues songs. Under the majority's view, Handy could then have controlled—meaning, curtailed—the development of the genre. And also of a fair bit of rock and roll. 'Just another rendition of 12-bar blues for sale in record stores,' the majority would say to Chuck Berry (Johnny B. Goode), Bill Haley (Rock Around the Clock), Jimi Hendrix (Red House), or Eric Clapton (Crossroads). Or to switch genres, imagine a pioneering classical composer (Haydn?) had copyrighted the three-section sonata form. 'One more piece built on the same old structure, for use in concert halls,' the majority might say to Mozart and Beethoven and countless others: 'Sure, some new notes, but the backbone of your compositions is identical.'"

OK, OK, that's more than enough judicial sniping for now. The Justices doth protest too much, wethinks. We hope to see everybody in Boston!

IPO SPECIAL 301 COMMENT PROCESS: OPPORTUNITY TO INFLUENCE IPO'S DEVELOPMENT OF GLOBAL IP POLICY

*By International Patent Law and Trade Committee Past Committee Co-Chair **Steve Bauer** (retired), Current Co-Chair **Dean Harts** (3M Innovative Properties Co.), and Vice Chair **Bill Warren** (Eversheds Sutherland (US) LLP)*

For an overview of IP policy issues across different countries and regions, check into either the U.S. Trade Representative's (USTR) annual [Special 301 Report](#), or IPO's annual submission to the USTR providing comments to the [Special 301 Report](#). IPO's Special 301 comment letters, typically submitted to the U.S. Trade Representative in the last week of January, provide a roadmap of a significant part of IPO's international advocacy efforts.

The USTR Special 301 Report is the Congressionally mandated annual review of the global state of intellectual property rights (IPR) protection and enforcement ([website](#)). The Report has been published each year since 1989 and identifies U.S. trading partners that do not "adequately and effectively" protect or enforce IP rights or otherwise deny market access to U.S. innovators and creators. Many countries and regions are featured in the Special 301 Report, in which USTR may place a country on the 'Priority Watch List' or 'Watch List,' indicating that a particular IP-related problem exists. A country may be subject to Section 306 monitoring (19 U.S.C. § 2416).

The USTR may designate a country as a "Priority Foreign Country"—a rarely used designation (last time used in 2014) that identifies those countries that have the most egregious IP policies, and such countries may face trade sanctions. USTR may conduct an Out-of-Cycle Review, which is a tool that encourages progress on IP issues through heightened engagement with the trading partner. Instead of escalating to Priority Watch List in 2014, for example, India was prioritized for an Out-of-Cycle review, favoring "negotiation, not litigation." See [here](#).

The 2023 Priority Watch List countries are Argentina, Chile, China, India, Indonesia, Russia, and Venezuela. The 2023 Watch List countries are Algeria, Barbados, Belarus, Bolivia, Brazil, Bulgaria, Canada, Colombia, Dominican Republic, Ecuador, Egypt, Guatemala, Mexico, Pakistan, Paraguay, Peru, Thailand, Trinidad & Tobago, Turkey, Turkmenistan, Uzbekistan, and Vietnam. This year, the USTR moved Belarus and Bulgaria up to the Watch List. Belarus was added because Belarus legalized unlicensed use of copyrighted works from countries "committing unfriendly actions" such as sanctioning Belarus for its role in Russia's unprovoked invasion of Ukraine. Bulgaria was added because it did not sufficiently address deficiencies in their investigation or prosecution of online piracy. USTR also announced an "Out-of-Cycle" Review of Bulgaria. China continues to be subject to Section 306 monitoring and has the longest country section in the Special 301 report (11 pages, Pages 45-55 of the 2023 Special 301 Report).

The Special 301 Report is used to develop and support U.S. positions in discussions and negotiations with other countries, including the negotiation of trade agreements. The USPTO IP Attachés, for example, refer to the Special 301 Report and IPO's comment letters in their day-to-day interactions with their counterparts, and to carry out their mission to improve IP systems internationally. (See also, <https://www.uspto.gov/ip-policy/ip-attache-program>.)

Each annual review cycle, USTR invites public participation in the review process and solicits comments to help in its assessment of trading partners' IP protection and enforcement. This year 71 non-government stakeholders, including IPO, and 17 foreign governments submitted comments. IPO's International Patent Law and Trade Committee has led IPO's engagement in this process, consolidating input from IPO committees and IPO member companies and firms into a draft comment letter, which is reviewed, revised, and submitted by IPO leadership to USTR. IPO's comment letter, among other things, highlights various issues and concerns raised by international-focused IPO committees throughout the year.

IPO provided detailed comments with respect to Australia, Brazil, Canada, China, India, Mexico, Russia, Argentina, Colombia, Indonesia, and Vietnam. Of these only Australia is on neither the Watch List nor the Priority Watch List. In addition, seven themes were developed in the 2023 IPO Special 301 comment letter, including trade secret protection, counterfeiting, compulsory licenses, weak (or delayed) patent enforcement regimes, genetic resources and traditional knowledge, and data legislation. The first four of these themes were previously discussed in the March 31, 2021, [IP Owners™ Quarterly](#), so for this article the focus will be genetic resources and traditional knowledge (GRTK), and data legislation. Consistent with a May 12, 2022 [IPO Board Resolution](#) on genetic resources and traditional knowledge, IPO commented that “patent disclosure requirements [relating to genetic resources] implemented in various countries (e.g., China, India, Indonesia, Malaysia, Thailand and Columbia) introduce uncertainty for innovators and undermine the sustainable use of technology related to biological resources. . .” These requirements are counterproductive to the stated goal of promoting benefit sharing. IPO is concerned about practical compliance with patent laws requiring information about the source of genetic resources used in the invention and any requirements for obtaining advanced access and benefits sharing agreements, for valid patent disclosures.

In addition to unnecessarily linking patent validity to disclosure of the source of physical genetic resources, further language encompassing information “developed from” genetic resources implicates the use of genetic digital sequence information (DSI) which is currently maintained in publicly accessible databases. Such legislation is very likely to deter investment in research using these available DSI genetic resources because the validity of any patents based thereon could be determined by the accuracy of voluntarily uploaded sequence source information. Moreover, limiting free access to such public genetic sequence databases would impede routinely performed large scale sequence comparisons, and likely result in more privatization of DSI databases. Unrestricted access to public collections of genetic DSI is essential to encourage innovation and promote scientific progress. Accordingly, any legislation that restricts access to public collections of DSI and the imposition of advanced mandatory benefit sharing mechanisms for the use of such DSI is counterproductive as it relates to patent laws. Nations should consider the improvement and use of databases for the defensive protection of genetic resources and traditional knowledge associated with genetic resources.

A range of actions and attention around legal rights in data have implications on IP rights. For example, automated decision-making tools have led to demands on sharing algorithms and data sets used for training. Country attention around information technology systems and network security have led to concerns around sharing trade secret data about system setup and security measures. China's quickly evolving landscape of data security laws, cybersecurity laws, personal information protection laws, cross-border data transfer laws, and privacy more generally, has led to some demands to install “sniffers” in networks of private companies operating in China. Similarly, India's Data Protection Bill purports to regulate data transfer very broadly through central controls with mandates around network/data monitoring equipment installation in private companies operating in India.

The European Union's draft Data Act seeks to regulate part of the data space by mandating that a data holder make content available to users of products or services. The EU General Data Protection Regulations (GDPR), require, *inter alia*, sharing meaningful information about the logic involved in automated decision-making protocols involving personal data, with recent cases involving technology used to match riders to drivers in ride-sharing Apps. The court decisions have gone either way – requiring disclosure of logic or protecting against such disclosure. -Although a few weeks after the 2023 USTR comment submission deadlines, the recent dramatic increase in generative artificial intelligence tool advancement, interest, and usage has prompted much more attention in this space and rapid advances in the EU AI Act first proposed in 2021 ([Website](#)).

We are eager to hear from any IPO member or committee that can provide input for IPO's next Special 301 comment letter. This is our opportunity to influence the U.S. government's international efforts to improve IP systems abroad. You don't need to be a trade specialist, trade expert, economist, lobbyist, or government affairs expert to provide input or participate in this effort. And given how sensitive trade-related IP issues can be, you can stay anonymous: IPO comments are the result of input from members but are not tied back to any specific member. IPO's 2024 Special 301 comment process will kick off later this year and we look forward to hearing from you. Any of the authors or Tom Valente, IPO Senior Director for Global Affairs, would welcome your emails or messages on IPO Connect.

For further information, please [see the Chat Channel](#): Current Global IP Issues Through the Lens of IPO's Special 301 Comments.

CANADA PROPOSES NEW LAW TO INTRODUCE PATENT TERM ADJUSTMENT

By Kristin Wall, Paul Jorgensen, Anna Wilkinson, (Norton Rose Fulbright Canada LLP)

BACKGROUND

On April 20, 2023, the Canadian government tabled proposed legislation (Bill C-47) that would amend the *Patent Act* to introduce, for the first time, a system of general patent term adjustment (PTA). Canada is required under the Canada-United States-Mexico Agreement (CUSMA) to adopt a PTA system by 2025. The PTA system is intended to compensate patentees for “unreasonable delays” by the Canadian patent office in issuing a patent. Unlike Certificates of Supplementary Protection (CSP), which were implemented by Canada in 2017, PTA is not limited to pharmaceutical patents and would apply to all eligible patents.



Kristin Wall, Paul Jorgensen, Anna Wilkinson (L-R)

Bill C-47 (the *Budget Implementation Act, 2023 No. 1*) amends the *Patent Act* to meet Canada’s obligation to implement a PTA regime under CUSMA. The amendments are expected to come into force on or before January 1, 2025. Bill C-47 completed its third reading in the Canadian House of Commons and is now being reviewed by the Senate.

Before introducing the PTA system in Bill C-47, changes were made to the *Patent Rules* in 2022 in an attempt to speed up patent prosecution, including by introducing excess claim fees and limiting the number of examination reports that may be issued before a Request for Continued Examination must be made.

THE PROPOSED SYSTEM OF PATENT TERM ADJUSTMENT

The PTA system proposed in Bill C-47 would provide, if the conditions are met, “an additional term for a patent.” Bill C-47 leaves many of the details to be addressed by subsequent regulation. However, certain key aspects of the PTA system are outlined in the proposed amendments to the *Patent Act*, which are provided in new sections 46.1 to 46.4.

- **Eligible patents:** Patents with a filing date on or after December 1, 2020, would be eligible for PTA. The patent must issue the later of:
 - (i) the fifth anniversary of the “applicable day”. The “applicable day” is yet to be prescribed for patents that issue based on a divisional application or a PCT national phase application. In any other case, the “applicable day” is the filing date of the patent application [DATE A]; and
 - (ii) the third anniversary of the first day on which a request for examination has been made and the prescribed fees have been paid [DATE B].
- **Time to apply and fees:** The patentee would have three months to apply for PTA after the patent issues. A fee, in an amount to be prescribed, will also be due as part of the application. The proposed amendments also suggest that additional maintenance fees will be charged during the PTA term.

- **Start of additional term:** Any additional PTA term will commence upon expiry of the regular patent term (*i.e.*, 20 years). The patent must be valid until the expiry of its regular patent term.
- **Impact on CSP term:** Notably, for pharmaceutical patentees, any PTA term would run concurrently with any CSP term. Running the terms concurrently is inconsistent with the different objectives of these regimes. While CSP term is intended to restore patent term lost over time spent in research and development and regulatory approval, PTA term is intended to compensate for delays before the patent office. If passed, Canada will be offside with its US trading partner, which runs its equivalent additional patent terms consecutively.
- **Duration of additional term:** The PTA term will be determined by the Commissioner of Patents (Commissioner) as the number of days between the patent issue date and the later of: DATE A and DATE B. However, days can then be subtracted from this period according to “the number of the days that is determined under the regulations.” The regulations will presumably provide days that can be subtracted owing to delays attributed to the patent applicant.
 - If the above equation produces a result of zero or a negative value, no PTA term will be awarded.
- **PTA certificate:** Upon granting PTA, the Commissioner shall issue “a certificate of additional term” that identifies the patent number and the duration of the additional term.
- **Disputing duration of PTA term:** The Commissioner may reconsider the duration of PTA term on the Commissioner’s own initiative. Any person would also be able to apply to the Commissioner and/or bring an action in Federal Court to shorten the duration of the PTA term. The Commissioner may stay any reconsideration that is pending before the Court. Notice of any reconsideration will be provided to the patentee in accordance with the regulations.

The full scope of the Canadian PTA system will not be known until this legislation is passed and the regulations are published. The progress of [Bill C-47](#) can be tracked on the [webpage](#) of the Parliament of Canada.

A GREEN IP SUBCOMMITTEE AT IPO – HOW CAN IP PLAY A ROLE IN SUSTAINABILITY?

By Laurence Loumes, European and US patent attorney at Plasseraud IP, Lead of the Green IP subcommittee at IPO

While we heard for many years that the climate is changing, one could argue that society only recently grasped this reality. There is a common necessity to reduce our gas emissions and to live in a more sustainable world. In this new paradigm, innovation will play a central role in reinventing our ways of life.



Nations came together first through the Kyoto Protocol and later under the Paris Agreement, by pledging to limit global warming to well below 2, preferably to 1.5 degrees Celsius. The Paris Agreement has various action lines, including a technology one. The aim of the technology action line is to accelerate green innovations, such as low-carbon solutions, and tech transfer. By 2030, zero-carbon solutions could be competitive in sectors representing over 70% of global emissions.

The actions are not only international. Domestically, President Biden signed executive actions on tackling climate change under the banner of economic necessity. President Biden pledged to cut emissions by 50% by 2030 and achieve net-zero by 2050. In Europe, the Green Deal Industrial Plan supports the transition to climate neutrality by enhancing the competitiveness of Europe's net-zero industry.

Climate considerations are global and intrinsically linked to the economy, resulting in a push to eco conceived inventions. In this actively changing world, companies need to rethink how they do business. There is an increased emphasis on taking into consideration each product's environmental impact. Manufacturers will need to explore new lines of businesses, new products to develop, pivot completely their line of work, and change the way they do things. Even when a product isn't modified, the way it is manufactured, packaged, and delivered may have to be completely rethought.

In the incoming years, IP owners will be faced with different types of challenges. Governments are imposing new regulations and taxations. For example, one will not be allowed to produce items which may be non-recyclable or do not conform to specific norms or regulations. Engineers will have to come up with creative ideas to, such as for example reduce packaging weight without comprising resistance or creating new easily recyclable materials.

Simultaneously, pressure may come from the public, enticing companies to innovate in the green space even when no external obligation is imposed on them. The public may retaliate against companies that are not seen as green enough, for example those which do not manufacture eco-friendly products, which are not ecolabeled, or those seen as greenwashing because they do not bring an actual eco innovation.

There have also been calls for compulsory licenses of green technologies. These calls, however, do not take into consideration the role that IP plays in incentivizing innovation and in allowing for the sharing of IP through voluntary partnerships.

As a result of all of these possibilities, companies must be able to grasp the breadth of what's coming. The implications are transverse to many technical fields and within a company structure.

What role can play IP in the above defined context? How can IP be used to accelerate the rate of innovation for the good of all, while preserving the incentives and resources needed for future innovation?

The intersection of green and IP has started with different unrelated initiatives from the public and the private sectors.

The patent offices have individually come up with schemes related to green innovation. Better known are acceleration programs. The USPTO has, for example, reinstated accelerated prosecution for green patents. The EPO has no acceleration program, but has a class dedicated to green inventions. The EPO believes that identifying eco inventions better would help the public access and build upon them. In addition, a class dedicated to eco inventions can be leverage for companies, as investors may be more inclined to fund companies whose innovations are identified by the patent office as green.

On the international stage, WIPO has a green program, WIPO Green, created with a goal of sharing information by facilitating contact between potential licensors and licensees.

IP owners have already been sharing their knowledge for the greater good. For example, they are partnering with other companies to produce new products, innovating based on sharing their IP and know-how . When appropriate, they also share technologies with the public through various patent pooling and patent pledging models.

Although patents are what come to mind first when discussing innovation, it is wrong to think that climate change will only affect that aspect of IP. Can IP owners obtain a green trademark? How would that be characterized? What will happen to geographical indications in a world that warms up and shifts the areas were the produces are grown?

What can IPO do?

The first thing is exchange and brainstorm around the new constraints and difficulties our member companies are facing, such as how to turn into IP investments we are making to comply with new eco regulations.

As IP owners, we can monitor public sector initiatives, whether coming from the patent offices or other government bodies. IPO is often asked its opinion on these topics. By being involved in the discussions, IPO can provide a strong voice if there are threats or opportunities related to IP rights (think for example of calls for compulsory licensing).

With this background, it became clear that a subcommittee on Green IP and Sustainability would be helpful. This year we kicked off a Green IP Subcommittee of the AI & Emerging Technologies Committee; the subcommittee is currently working on a white paper mapping the current intersection of climate

issues and IP. The subject is broad and impacts a variety of IP practitioners (not just patents), and in a whole array of technical domains.

If you are interested in exploring this subject with us, please [join our Green IP subcommittee!](#)

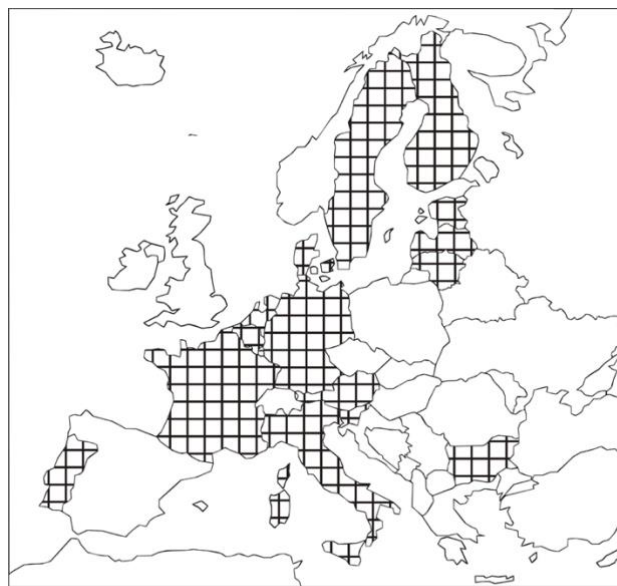
A NEW ERA IN INTELLECTUAL PROPERTY – THE UNITARY PATENT SYSTEM IS FINALLY THERE

By **Prof. Dr. Aloys Hüttermann**, (*Michalski • Hüttermann & Partner, Düsseldorf*)

As discussed in the first *Quarterly* of this year,¹ there is a new era dawning for the intellectual property, and in particular patent, system in Europe that will surely have worldwide implications: The Unitary Patent System has finally started in June 2023.

The Unitary Patent System consists of two parts: the Unitary Patent and the Unified Patent Court.

Both presently cover 17 countries, i.e. *Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia, and Sweden.*



 Participating countries of the UPC

It is expected that more countries may join in the future; Ireland has announced that it intends to do so 2024 or 2025. Already, the covered territory accounts for approx. 75% of the EU's GNP.

The Unitary Patent (UP) can be requested for all future granted European patent applications and will cover all member states of the UPC system² at the time of registration of the Unitary Patent.

¹ <https://ipo.org/index.php/ipowners-quarterly-03-31-2022/>

² Remark: In many articles and presentations, this also called the "Unitary Patent Package" (UPP). However, personally I much prefer calling it the "Unitary Patent System" or UPC system, following a suggestion by *Haedicke* (*Haedicke, Rechtsfindung, Rechtsfortbildung und Rechtskontrolle im Einheitlichen Patentsystem, GRUR Int 2013, 609*)

Within a deadline of one month after grant of a European Patent Application, the Unitary Patent can be requested with the EPO. The request is cost-free, but a translation of the specification must be filed, either in English, if the application was in German or French, or a language of the EU, if the application was in English. This requirement can (and is expected to) be lifted in six years.

Although this additional translation is for information only, it is advisable that it have some degree of quality lest it be considered no translation at all, which may cause your unitary patent to be void. One practical tip: Portuguese and Spanish are languages of the EU, so you can adapt translations filed in Latin America, should you seek protection there.

Important note: When future countries join the UPC system, only Unitary Patents registered after accession will increase in scope; there will be no change in scope for then existing patents.

The Unified Patent Court (UPC) opened its doors on June 1, 2023. At the time of writing (June 12, 2023) there have been some cases filed, but any analysis would be only anecdotal given the minimal data available. Therefore, I will focus on the basics and some recent developments.

The UPC is competent for infringement and nullity of all pending and future European patents (and SPCs thereof, should they exist), unless these patents have been “opted-out,” meaning there is no court action that has been filed, possible until May 1, 2030.

The UPC is also competent for infringement and nullity of all future Unitary patents – for these patents an “opt-out” is not possible.

To avoid a “race to the courthouse,” it was possible to “opt-out” patents preemptively during the so-called “sunrise period” that took place from March 1 to May 31, 2023. During that time, if a (valid) request for an “opt-out” was filed, it was deemed to be effective on June 1, and a nullity action of a competitor could not block an “opt-out”.

According to sources,³ approximately 500,000 “opt-outs” were filed during the “sunrise period” and shortly after, which would be a third of all “opt-outable” patents, estimated to be 1.5 million.⁴ Important note: From now on, “opt-outs” will be effective at the time of registration (only) and not at the time of filing, as it was with the “sunshine-opt-outs.”

It is noteworthy, though, that until June 1, 2030, national nullity and infringement may still be filed, regardless of whether an “opt-out” has been registered or not.

Even when an “opt-out” has been filed for a patent, this does not mean that the UPC cannot be addressed – the “opt-out” can be withdrawn once, which is called an “opt-in”. However, patents that were “opted in” cannot be “opted out” again.

The proceedings before the Unified Patent Court are tightly managed, front loaded, and have a clear course. Both suitably qualified attorneys-at-law and patent attorneys can act as representatives, which is a novelty as previously you would need an attorney-at-law in any event.

³ Cf here: <https://patentblog.kluweriplaw.com/2023/06/07/unified-patent-court-465-247-opt-outs-in-the-sunrise-period/> (note that probably not all “opt-outs” that were filed before 1 June were registered already by the court, so the number of 500,000 seems more realistic)

⁴ Source: Klaus *Grabinski*, lecture at the VPP Frühjahrstagung in Dresden, 4 May 2023. Please note that other sources (e.g. the Kluwer Patent Blog) come to different numbers.

Nullity actions must be filed in the language in which the patent was filed. For infringement actions special rules apply, but they can be filed in English.⁵

As a parallel to the German procedure, there is the right to reimbursement of costs in the event of victory, although the court has greater leeway here. The UPC must respect the ECJ's jurisdiction, though, and the ECJ provides (e.g. in the "Novatext"-decision C 531/20) that only reasonable costs may be reimbursed.

A ruling of the UPC is valid for all UPC member states in which the patent-in-suit is alive.⁶ However, if whilst a case is ongoing a further country accedes the UPC system then – if the requests are drafted *lege artis*⁷ – the verdict of the UPC affects this new country as well, provided that the patent-in-suit is still alive there as well.

A significant difference to the otherwise very similar German practice is that a counterclaim for invalidity is possible in the suit procedure, so that the local or regional chamber can then deal with validity and infringement at the same time. As a consequence, the German bifurcation (or rather: separation) principle⁸ is essentially given up.

A further noteworthy issue is the "appeal-on-the-go." Any procedural order or decision (with any meaning any) can be subject to review, first by the panel (if the initial order came from the judge-rapporteur) and if the panel does not alter the decision, by the appeal court, even if the panel has not given leave to appeal. These review instruments are expected to be widely used in the early years of the UPC, once a solid jurisdiction has been established.

In October 2022, the court published⁹ the names of the judges who initially will handle cases and – much to the relief of the IP community – the selection was widely considered to be excellent, including household names such as Edger *Brinkman*, Klaus *Grabinski*, Rian *Kalden*, Holger *Kircher*, Sabine *Klepsch*, Bérénice *Thom*, Ulrike *Voss*, and Matthias *Zigann*. Especially highlighted was that Klaus *Grabinski* will become the 1st president of the appeal court – which due to the possibility to appeal whilst cases are ongoing will be important from the very beginning. The decision to make Rian *Kalden* the presiding judge of the second chamber of the appeal court was considered favorable, as well.

⁵ cf. here: <https://www.unified-patent-court.org/en/court/language-proceedings> (For definitions of local and regional divisions cf. my previous article)

⁶ It should be noted that according to the so-called "Brussels-I- Regulation" under certain conditions the UPC may also rule on non-UPC-countries, cf. *Véron*, EIPR 2015,588 and my book, *Hüttermann*, Unitary Patent and Unified Patent Court, Wolters Kluwer, para 494 et seqq. This "long arm jurisdiction" is somewhat controversial, though.

⁷ For suggestions cf. *Kircher*, in *Bopp/Kircher*, Handbuch Europäischer Patentprozess, Beck, Note 50 to Section 13 or my book, *Hüttermann*, Unitary Patent and Unified Patent Court, Wolters Kluwer, para 1129 et seqq.

⁸ Although widely used, the term "bifurcation" used in the context of the present German system is actually wrong, Germany has a separation regime. The UPC, however, actually is bifurcated – cf. *Meier-Beck*, Bifurkation und Trennung, GRUR 2015, 929

⁹ For the full list cf. here: <https://www.unified-patent-court.org/en/news/unified-patent-court-judicial-appointments-and-presidium-elections>, cf. also <https://www.unified-patent-court.org/en/news/communication-administrative-committee-meeting-2-june-2023>

The importance of the UPC cannot be overstated and it is accurate to say that 50 years after the European Patent Convention was passed, another era in European intellectual property has begun that will have implications far beyond our continent.

WOMEN IN IP COMMITTEE CORNER: BALANCING MOTHERHOOD WITH LAWYERING – SUCH A LONG WAY TO GO

By **Camilla Balleny** (*Carpmaels & Ransford LLP*), **Carlyn Burton** (*Osha Bergman Watanabe & Burton LLP*), and **Christina Lee** (*Perry + Currier Inc*)

A few months ago, you may have seen a viral LinkedIn post quoting a text message sent to a female associate that characterized her parental leave as “collecting salary from the firm while sitting on you’re a**” and also called the associate a “soul-less and morally bankrupt person.”¹⁰ While the text was sent because the associate had given notice that she was leaving for a new job, apparently causing the texter to spew vitriol, the viral post also noted that the associate had in fact been asked to do work during her maternity leave. Whether the woman sought another job because she was asked to work during her maternity leave (perhaps signaling that work life balance would be difficult to attain) or because she experienced one too many microaggressions or just blatant toxicity in the workplace (which would not be a surprise given the text that she received), this viral post demonstrates that still too many have the impression that maternity leave is a “vacation” or at the very least, a time when a new parent is just “sitting on [their] a**.”

A significant number of women leave the legal profession immediately after or in the years following childbirth, some due to lack of work/life balance, the “motherhood penalty”, a toxic culture, or a combination of these factors.¹¹ The greater attrition of women leaving the profession than their male counterparts is particularly harmful to the IP profession because fewer women enter the IP profession in the first place, as compared to the legal profession as a whole. Sadly, the fact that too many attorneys still have a misguided belief that parental leave is a vacation does not bode well for our hopes of reaching gender parity in the profession.

Leaves of absence are often unfairly compared to vacation leave or paid time off, simply due to the nature of an extended non-working period. Each type of leave has a specific purpose – in the case of parental leave, it allows parents to take time off from work to (a) give birth and recover from childbirth, for a child-bearing parent; and (b) care for a new child.

In focusing on the joy of a new child and the fragility of a newborn, the recovery and health of mothers who have just given birth is often overlooked.¹² Childbirth is an intense physical experience, and the stress of childbirth on the body can cause complications and a host of postpartum medical issues. In addition to recovery from the act of childbirth itself, the body continues to adapt to prepare to provide for an infant during the postpartum period. On top of the physical aftereffects of childbirth, new mothers may experience mental and emotional fluctuations, including postpartum depression, experienced by one in nine new mothers,¹³ and other challenges.

In addition to physical and mental recovery for a woman who has given birth, new parents are all spending time to care for their new child. This can range from tending to a needy infant, fostering a safe

¹⁰ <https://www.cleveland.com/metro/2023/01/cleveland-law-firm-attorney-criticized-after-social-media-post-shows-insulting-text-sent-to-attorney-who-left-firm-after-maternity-leave.html>

¹¹ <https://www.abajournal.com/news/article/why-do-female-lawyers-leave-law-firms-blatantly-unfair-compensation-often-cited-aba-report-says>

¹² <https://www.pbs.org/newshour/health/broken-tired-and-ashamed-how-health-care-fails-new-moms>

¹³ <https://www.womenshealth.gov/mental-health/mental-health-conditions/postpartum-depression>

and welcoming environment for a newly adopted child, developing, and strengthening familial bonds amidst changing family dynamics, and many situations in between, roles that can take months to adjust to¹⁴.

There are many benefits of adequate parental leave, and in particular, adequate *paid* parental leave. Focusing on maternity leave in particular, studies have shown that maternity leave contributes to better overall physical health of both mother and child, decreased depressive symptoms and less stress for postpartum mothers, as well as better bonding experiences between mother and child.¹⁵ Paternity leave has similarly been demonstrated to strengthen relationships with both partner and child, as well as promoting greater economic equality between the partners and equality in family dynamics, not only in the short term, but as a foundation for the future distribution of familial responsibilities.¹⁶ The benefits experienced by parents have a lasting impact on their children, including lower infant mortality rates, improved physical health in early life, and bonding experiences which affect basic cognitive, behavioral, and socioemotional skills of children.¹⁷

In the same way that recovering from general surgery or another medical procedure or grieving the passing of a loved one is not a “vacation,” neither is parental leave. Parental leave exists to allow time for physical and mental recovery and to allow new parents to dedicate time to their new family. Nurturing a child takes dedication and effort, and employers should be mindful of ensuring that parents have the space and time they need during their leave to be free of work.

Employers and clients should not want or expect their patent agent drafting an application or their trademark litigator presenting arguments during those critical recovery and development periods. Parental leave policies should therefore be crafted with careful consideration and thought to provide sufficient support to parents and their families, our current and future workforce.

However, given that the impact of a leave on an organization can vary significantly when the firm, department, or group is a size of two as compared to a size of 50 (or more), not all parental leaves look the same. Leaves should be designed to provide the new parent the necessary time to care for a new child, rest, and heal (both mentally and physically). A longer leave may allow for more healing as well as greater bonding between parent and child, but the length of leave offered by an employer generally is considered relative to the financial sustainability of the organization, whether there is government subsidization of the salary, and how the employer can continue operations with the absence of the employee.

Generally, the larger the organization, the more likely it is that the organization can accommodate the workload of the new parent by delegating to others in their absence. Even still, however, those people who handle their colleagues’ work during the period of the leave were likely not sitting idly before they are asked to be assigned new work and are therefore generally handling a substantial volume of work, and likely the work of two. However, the work of the new parent should not just be held for them to handle upon their return, nor should they be expected to work an unreasonable number of hours in the weeks leading up to leave. When this occurs, the new parent returns from leave to find themselves with

¹⁴ <https://www.sciencedirect.com/science/article/pii/S1877575617302835>

¹⁵ <https://www.forbes.com/health/family/how-maternity-leave-affects-health/>

¹⁶ <https://www.mckinsey.com/capabilities/people-and-organizational-performance/our-insights/a-fresh-look-at-paternity-leave-why-the-benefits-extend-beyond-the-personal#/>

¹⁷ <https://www.apa.org/monitor/2022/04/feature-parental-leave>

an unreasonable amount of work to complete, at a time when there are significant changes in their home life.

Taking parental leave requires both ramping down to transition to the start of leave and then ramping back up upon returning. This transition phase can be difficult for many in the intellectual property field, particularly considering unique stressors such as billable hours, office action quotas, court and patent office deadlines, client deadlines, and the like. Offloading an entire docket and then reloading that docket often requires a period of flexibility to accommodate and adjust during these transition phases. Additionally, hiccups are almost certain to happen along the way: issues in childcare arise, sicknesses will be aplenty, and daycare and school closures occur. A grace period both immediately prior to and immediately after leave may be beneficial to allow the new parent/returning employee to adjust. This may include providing some flexibility or grace in billable hours or other requirements during this time. A buddy system with coworkers may also be helpful to assist the returning employee in resuming work at a preferred pace and ensuring a smooth transition both for the returning employee and for workflow.

In navigating this transition period, employees should be open to a new normal after returning. For example, the return to work might entail a change in normal work hours (e.g., many working parents end the “office day” earlier but log in from home after the children have gone to bed). When preparing to return, employees should consider reaching out to their boss, mentor, lead partner, etc. to discuss their return and to set goals or expectations for the return. In a similar vein, returning employees may benefit from efforts to build relationships with colleagues (especially other working parents) wherever possible, especially if the new return-to-work life is limited from attending happy hours or other after-hours work social events. Such relationships can offer various forms of mentorship, ally-ship, and/or sponsorship to the returning employee readjusting back to work.

In addition to having a parental leave plan or policy in place, employers should also allow for some flexibility where possible, as well as fostering an empathic environment that supports employees in transitioning to and from a parental leave. Additional efforts by employers to make the workplace conducive to working parents – such as providing lactation rooms, having an employee assistant program that provides emergency childcare, and providing onsite childcare facilities – may further foster and support a welcoming environment for working parents. While these efforts are not without cost, they are largely needed to gain and retain the best talent, particularly for younger workers who have indicated an interest in parental leave policies.¹⁸ Research shows that companies that invested more in working parents saw higher rates of reported retention, advocacy, and effort.¹⁹ Parental leave policies that are embraced by the whole company and provide the support and flexibility needed for employees benefit everyone.

¹⁸ <https://www.benefitspro.com/2022/05/04/paid-parental-leave-employers-cant-win-talent-without-it/?slreturn=20230511133214>

¹⁹ <https://www.businessinsider.com/data-great-place-to-work-maven-paid-parental-leave-benefits-2020-12>;
<https://www.forbes.com/sites/forbestechcouncil/2022/05/12/why-paid-leave-is-crucial-for-your-business/?sh=6e82f8a7cb5c>

MENTOR WOMEN ENTREPRENEURS IN NEW IPO/USPTO PILOT PROGRAM



IPO and USPTO have launched a new pilot program to support women entrepreneurs. [Sign up](#) to mentor a woman entrepreneur as part of the [WE \(Women’s Entrepreneurship\) Initiative](#), which strives to “increase equity, job creation, and economic prosperity through their ideas, insights and innovations.”

Women are one of the underrepresented sectors when it comes to equity in innovation. “Gender parity is a priority at IPO,” said IPO Executive Director Jessica Landacre. “Making sure our association does what it can to aid in diversifying the innovation ecosphere in race and gender is key to the future of innovation and economic prosperity. Collaborating with the USPTO gives us greater reach to accomplish this mission and the WE Mentorship Program is the perfect opportunity for IPO members to contribute in a tangible way.” Join IPO’s ongoing commitment to diversity by [signing up](#) to mentor and being a resource to future women innovators and entrepreneurs!

DIVERSITY AND INCLUSION COMMITTEE CORNER

MONTHLY WEBINARS

The D&I committee holds monthly virtual meetings featuring speakers on important, interesting topics pertaining to diversity and inclusion. At the June meeting, Shelly Skeen from Lambda Legal provided insight on worrisome legislative trends affecting trans and LGBTQ+ rights. In May, Tara M. Raghavan, current President of the South Asian Bar Association of North America, discussed her work advancing Asian American and Pacific Islander (AAPI) concerns and initiatives. The April meeting featured a roundtable discussion on diversity initiatives by different firms and lessons to draw. Those who aren't members of the committee are welcome to join the monthly calls.



HISPANIC RESOURCE GROUP CHAIRS

The Hispanic Resource Group is adding two co-chairs, who will lead the group: Natalie Guio from Leydig, Voit & Mayer and Derek Abeyta from Harrity & Harrity.

HIRING & RETENTION GUIDE WEBINAR

On May 16, 2023, Shruti Costales (Dell Technologies), Dr. Keisha Hylton-Rodic (Hylton-Rodic Law Intellectual Property), Rachael Rodman (Ulmer & Berne, LLP), and Elaine Spector (Harrity & Harrity, LLP) spoke on an IPO Chat Channel webinar on the topic of "[IPO's D&I Committee's Hiring & Retention Guide – An Introduction and Overview.](#)"

As hiring and retention of underrepresented groups in the legal profession continue to confound law firms and legal departments, IPO's Diversity & Inclusion Committee aims to demystify best practices by sharing the newly created Hiring & Retention Guide. This Guide is the newest section of the Practical Guide to Diversity & Inclusion in the Legal Profession and focuses on solving problems associated with the hiring and retention of underrepresented groups in the legal profession – especially in law firms and corporate legal departments.

During this webinar, the speakers highlighted that despite years of various efforts to improve hiring and retention of qualified candidates from underrepresented groups, law firms and corporate legal departments continue to struggle in making meaningful advances.

The Core problems with HIRING underrepresented or diverse lawyers/legal professionals are captured on slide 4 of the Guide. Key problems with RETAINING underrepresented or diverse lawyers / legal professionals are captured on slide 5 of the Guide. Solutions both categories of problems are summarized in slide 6, with detail in the Background section. The DOs and DONTs of Hiring & Retention are found on slide 7.

Although the Guide serves to help with improving hiring and retention of underrepresented groups in the legal profession, it can be used to improve hiring of retention of any qualified candidate by facilitating equitable hiring and retention of all qualified candidates.

PATENT AGENTS: NON-ATTORNEYS PRACTICING LAW?

By **Dahlia A. George** (USPTO)

Ms. George is a Staff Attorney at the Office of Enrollment and Discipline at the United States Patent and Trademark Office. The views and comments expressed herein are solely the opinion of the author, do not reflect the performance of duties in the author's official capacity, and are not endorsed by, nor should be construed as, any viewpoint official or unofficial of the United States Patent and Trademark Office. The author confirms to the best of his or her knowledge that no information contained herein is privileged, confidential or classified.



The preparation and prosecution of patent applications for others constitute the practice of law. However, when it comes to patent prosecution before the USPTO, you do not have to be an attorney to engage in this specific field of practice of law. For many lawyers who may not be familiar with patent practice before the USPTO, the term “patent agent” may sound foreign and may be mistaken for a paralegal who specializes in patent matters. That is an inaccurate assumption and therefore a definition is a beneficial place to start.

Pursuant to 35 U.S.C. § 2(b)(2)(D), Congress granted express authority to the USPTO to establish regulations that

may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render ...valuable service, advice, and assistance in the presentation or prosecution of their applications.

(emphasis italicized)

A patent agent is a non-attorney practitioner, who fulfills the USPTO requirements, who may be registered to practice before the Office in the preparation and prosecution of patent applications pursuant to 37 C.F.R. §§ 11.5(a) and 11.6(b).²⁰ To do so requires detailed knowledge and expertise in specialized technical and scientific fields, among them taking and passing the patent bar examination and demonstrating good moral character and reputation to be registered as patent agents.²¹ Accordingly, registered patent agents are authorized to engage in the patent-related activities outline in 37 C.F.R. § 11.5(b)(1), which includes preparing and prosecuting patent applications, consulting with and giving advice to a client in contemplation of filing a patent application, and responding to Office communications regarding such application which includes reexamination proceeding and appeals

²⁰ Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters pursuant to 37 C.F.R. Part 11 prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters. See 37 C.F.R. 11.14(b); Trademark Manual of Examining Procedure (hereinafter referred to as “TMEP”) 602.

²¹ See 37 C.F.R. 11.6(b) and 11.7(a)(2).

before the Patent Trial and Appeal Board. Registration to practice before the Office in patent cases sanctions the performance of those services which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application including consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office.

The Congressional authority granted to patent agents to practice before the USPTO did not receive significant attention or demand analysis until the landmark decision in *Sperry v. Florida ex rel. Florida Bar*²² which addressed state regulatory powers that contravene Federal authority.²³ There the Florida Bar brought an unauthorized practice of law action against a non-attorney patent practitioner who was registered to practice before the USPTO but had not been admitted to practice law in the state of Florida. The Bar requested and received an injunction from the Florida Supreme Court to enjoin Sperry from, among other things sanctioned by the USPTO, advising clients as to patentability, drafting patent applications, and responding to USPTO communication regarding the viability of a claimed patent. After reviewing the legislative chronology of the Office, the Court found that Congress had granted authority to the Commissioner of Patents to refuse recognition of “any person as a patent agent, either generally or in any particular case ...” for gross misconduct.²⁴ In 1869, the Commissioner promulgated several regulations, among them that “[a]ny person of intelligence and good moral character may appear as the attorney in fact or agent of an applicant ...”²⁵ And in 1899, the Commissioner required registration of those who practiced before the Patent Office, *i.e.*, attorneys and *agents*.²⁶ In 1922, the patent statute expressly authorized the Commissioner to establish regulations for the recognition of agents and attorneys; to create a patent bar and to require, among other things, technical or scientific skills and qualifications.²⁷ This Congressional history led the Court to consider and analyze whether the preparation and prosecution of patent applications by patent agents constitutes the practice of law and, if so, whether a state may regulate such activities. The Court found that, indeed, “the preparation and prosecution of patent applications for others constitute the practice of law.”²⁸ Despite the fact that the state of Florida has an interest in prohibiting the unauthorized practice of law, nonetheless the Court recognized that “the act of Congress, ... , is supreme; and the law of the State, though enacted in the exercise of powers not controverted, must yield to it.”²⁹ The Court noted that states may exercise their powers except where doing so is incompatible with federal legislation.³⁰ The *Sperry* decision is seminal

²² 373 U.S. 379 (1963).

²³ Due to the scope of this article, a brief overview of the *Sperry* decision is provided herein. The author encourages a full reading of the *Sperry* text for further edification.

²⁴ *Id.* at 388 (citing Act of March 2, 1861, ch. 88, § 8, 12 Stat. 247; *see also* Act of July 8, 1870, c. 230, § 19, 16 Stat. 200, as amended, 66 Stat. 793, 35 U.S.C. § 6. Notably, several individuals appearing on behalf of patent applicants were engineers or chemists who specialized and were well-versed in the particular art that was the subject-matter of the patent. *Id.* at 389 (quoting Letter from Edward Rogers, Hearings before House Committee on Patents on H.R. 5527, 70th Cong., 1st Sess. 84 (1928)); S. Rep. No. 1209, 70th Cong., 1st Sess. 1.

²⁵ *Id.* at 388-89 (citing Rules and Directions for Proceedings in the Patent Office, § 127 (Aug. 1, 1869)).

²⁶ *See* Rules of Practice in the United States Patent Office, § 17 (July 18, 1899) (emphasis italicized).

²⁷ *See* Act of February 18, 1922, c.58, § 3, 42 Stat. 390.

²⁸ 373 U.S. at 383; *Greenough v. Tax Assessors*, 331 U.S. 486 (1947); *Murdock v. City of Memphis*, 87 U.S. 590 (1874).

²⁹ *Gibbons v. Ogden*, 22 U.S. 1, 211 (1824); *See State Ex Rel. State Bar v. Keller*, 16 Wis.2d 377 (Wis. 1962).

³⁰ *Id.* at 403.

because it recognized that patent law, unlike other areas of practice, is unique because it is strictly within the domain of federal practice.³¹

However, the *Sperry* Court left unanswered the extent to which communications between a patent agent and a client would be privileged, if at all, as they are between an attorney and client. This question has been the subject of disagreement and various interpretations among various courts thereby yielding inconsistent rulings as of date.

In the next installment, a detailed discussion regarding the question of whether, and to what extent (if any) communications between a patent agent and a client are privileged.

³¹ Article 1, Section 8 of the U.S. Constitution grants Congress the authority to establish a system for awarding patents in the United States.

IPO EDUCATION FOUNDATION LAUNCHES NEW INVENTION COMPETITION FOR STUDENTS



IPO Education Foundation is seeking sponsors to support the mission of promoting an understanding and respect for intellectual property rights and their value to society through programs like “Why Didn’t I Think of That?”. “Why Didn’t I Think of That?” is a new virtual invention competition for students. Students will have the opportunity to attend educational sessions to learn about IP strategies. Additionally, patented inventors will compete for a trip to Washington, DC, to attend the Foundation Awards Celebration and the opportunity to work with an industry professional to further their inventions. IPO members and the public will vote for their favorite invention to determine the winners. Inventors will be highlighted on social media, through press releases, and more to demonstrate the value of intellectual property protection. Contact Foundation Deputy Executive Director Kristen Lurye, klurye@ipo.org, to learn more about how to support this program and IPO Education Foundation.

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- European Commission [Publishes Proposed Changes To EU Pharmaceutical Legislation](#)
- **IPO Submits [Comments to EPO](#) on Updated Guidelines for Examination**
- **USTR Releases [2023 Special 301 Report](#)**
- **Biden Nominates Deborah Robinson to Be Next Intellectual Property Enforcement Coordinator**
- **IPO Submits [Comments to FTC](#) on Proposed Ban on Non-Compete Clauses**
- IPO and USPTO launch [pilot program](#) to support mentor entrepreneurs as part of the [WE \(Women's Entrepreneurship\) Initiative](#) to "increase equity, job creation, and economic prosperity through their ideas, insights and innovations."
- **USPTO [Delays Requirement](#) That Registered Patent Practitioners File Biennial Registration Statements**
- **USPTO [Announces](#) Transition To E-Office Patent Center [e-Office Action program](#)**
- **USPTO [Expands Admissions Criteria](#) For Patent Bar**
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- **IPO Law Journal Posts [White Paper on Patent Searching](#)**
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- IPO Black IP Professionals Resource Group presented "Journey to Juneteenth" virtual event in commemoration of the Juneteenth holiday, available on [D&I Advocacy page](#) at IPO.org

