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## WELCOME

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

Happy holidays! As we close out 2024, we take time to reflect. The IPO team remains in awe of the IPO community and all that our members do to better the profession and IP system.



We are at the end of the first year of our 3-year strategic plan, which includes strategic priorities of advocacy and education on AI and harmonization, promoting the value of IP, and fostering diverse engagement on policy issues. Our goal is to evaluate approaches to consider controversial issues where diverse industry perspectives exist and to take positions based on thoughtful consideration. In addition to accomplishing a great deal towards achieving our strategic objectives, we also kept in mind our North Star of providing a community for friends and colleagues to connect and share knowledge and experiences.

Through the excellent work of committees, IPO accomplished:

- Publishing an AI Patenting Handbook and conducting benchmarking surveys
- Submitting comments to the USPTO on Inventorship for AI-assisted inventions and Guidance on Patent Subject Matter Eligibility including Artificial Intelligence
- Providing feedback, through IP5 Industry, on Global ID and global assignment
- Advocating for expanded options for e-signatures, pre-population of forms, and harmonization of drawings
- Submitting a record 31 comment letters to entities like the USPTO, FTC, NIH, CNIPA, and others
- Providing Comments to USTR regarding the 2024 Notorious Markets List, which identifies marketplaces “that reportedly engage in and facilitate substantial copyright piracy and trademark counterfeiting” and the Special 301 Review concerning acts, policies, or practices by foreign countries that “deny adequate and effective protection of [IP] rights or deny fair and equitable market access to U.S. persons who rely on IP protection.”
- Filing 3 amicus briefs at the U.S. Supreme Court, Federal Circuit, and EPO.

We deeply appreciate the contributions of our committees to help IPO express members’ views.

The IPO Education Foundation began work to launch a public awareness campaign to reach next generation audiences with the message that “IP is everywhere.” Stay tuned for the campaign’s official kickoff at the time of the 2025 Superbowl! The Foundation also created a Next Gen Innovators Toolkit, which has reached approximately 2,200 students to date. And finally, last week marked the annual IPO Education Foundation Awards Celebration. The event honored accomplishments in the fields of IP, innovation, and creativity. Thank you to the over 350 attendees who gathered to celebrate the honorees

and those who generously contributed over \$56,000 during the event. These donations will help IPOEF to reach greater audiences, form new partnerships, and develop innovative learning materials, from virtual tools to tailored content that meets the diverse needs of various audiences.

We thank our members for another successful year. We wish you happy holidays and look forward to 2025!

## Q4 2024 U.S. POLICY DEVELOPMENTS

By **Samantha Aguayo**, *IPO Deputy Executive Director & Chief Policy Counsel* and **Astrid Roe**, *Legal and Policy Associate*

As the U.S. heads into a new year with a new incoming administration, this last quarter saw congressional action on three highly anticipated IP bills, several final rules published by executive agencies, and a continued interest in artificial intelligence. The USPTO, in particular, released rules on new fee schedules for both patent and trademark filings, the process for Director Review and new opportunities to practice before the Patent Trial and Appeal Board, while withdrawing a previously proposed rule regarding terminal disclaimers.



### ARTIFICIAL INTELLIGENCE

On October 16, IPO [submitted comments](#) in response to the USPTO's "[2024 Guidance Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence](#)," published in the *Federal Register* on July 17, 2024. The comments suggest clarifications to the Step 2A, Prong One Analysis including "non-example-based guidance concerning how to distinguish a high-level mental process from a sufficiently detailed eligible concept and a mathematical algorithm from an eligible claim that merely relies on an algorithm" and "additional AI examples that an examiner may, at Step 2A, Prong One, find to be patent-eligible." IPO's comments also encourage the USPTO to ensure the guidance at Step 2A, Prong Two focuses on what a claim is "directed to," highlight possible issues with "the current treatment of 'insignificant extra-solution activity,'" and "urge the USPTO to continue to iteratively refine the patent subject matter eligibility examination guidance through additional requests for comment as the technology and case law evolve."

On November 13, the Senate Judiciary Subcommittee on Intellectual Property held a [hearing on Oversight of the United States Copyright Office](#) (USCO) with USCO Director Shira Perlmutter as the sole witness. Director Perlmutter discussed the Copyright Office's study on the implications of generative AI and its plan to update guidance on registration of works incorporating AI-generated content in 2025. Subcommittee Chair Chris Coons (D-DE), Ranking Member Thom Tillis (R-NC), Senators Mazie Hirono (D-HI), Peter Welch (D-VT), and Marsha Blackburn (R-TN) expressed concerns over whether fair use incorporated the use of copyrighted works to train AI models. Senator Hirono discussed the impact of AI on creative artists, while Senator Welch advocated for legislation protecting artists from the unauthorized use of their works through notification and compensation. Director Perlmutter stated fair use was the most controversial topic in the Office's AI report. Most stakeholders indicated they believed the fair use doctrine was flexible enough to encompass AI training, but the Office had to determine how it should apply. Transparency of AI training materials was a separate issue impeding creators from enforcing their rights. Senator Blackburn noted the [NO FAKES Act](#) would grant additional legal protections for name, image, and likeness not protected by copyright and Senator Coons asked for the Office's input on the bill. Director Perlmutter stated the Office supported the bill and its provisions covering all individuals, restricting free transferability to safeguard licenses, and ensuring removal of replicas from the internet.

## IP LEGISLATION

This quarter, the Senate Judiciary Committee considered three major IP bills: (1) [S. 4713, the IDEA Act](#), introduced by Senator Hirono with Judiciary Committee Chair Dick Durbin (D-IL), Judiciary Committee Ranking Member Chuck Grassley (R-IA), Senators Richard Blumenthal (D-CT), Alex Padilla (D-CA), Amy Klobuchar (D-MN), Coons, and Tillis cosponsoring; (2) [S. 2140, the Patent Eligibility Restoration Act](#) introduced by Tillis with Coons cosponsoring; and (3) [S. 2220, the PREVAIL Act](#) introduced by Coons with cosponsors Durbin and Hirono.

During a [meeting](#) on November 14, the Committee approved the IDEA Act and withdrew the Patent Eligibility Restoration Act from consideration. IPO supports the IDEA Act, which would require the USPTO to collect demographic information from patent applicants on a voluntary basis to help measure progress toward greater inclusion of underrepresented groups in the patent system and complements IPO's and IPO Education Foundation's initiatives towards diversity & inclusion.

On November 21, the Committee approved the PREVAIL Act by a roll call vote of 11-10. The bill proposes numerous changes to the procedures for USPTO inter partes review (IPR) and post grant review (PGR) proceedings such as creating a standing requirement, imposing limits on joinder, and changing the burden of proof of patent invalidity to clear and convincing evidence.

During the meeting, Senator Coons explained he'd amended the bill's standing requirement to explicitly allow patient advocacy groups and generic drug companies to challenge patents at the USPTO's Patent Trial and Appeal Board (PTAB) to address concerns that the bill would negatively affect generic drug development and drug prices. The Committee did not adopt an amendment by Senator Ted Cruz (R-TX) that would have required the consent of small independent inventors before their patents could be reviewed by the PTAB.

## USPTO DIRECTOR RESIGNS

USPTO Director Kathi Vidal resigned her position on December 13. USPTO Deputy Director Derrick Brent will lead the agency as Acting Director until a new Director is nominated by the incoming Trump Administration and confirmed by the U.S. Senate and Chief of Staff SHIRIN Bidel-Niyat will serve as Acting Deputy Director.

## NEW FEE SCHEDULES

On November 18 the USPTO published in the *Federal Register* a [final rule adjusting trademark fees](#) that will take effect on January 18, 2025. The USPTO initiated the fee adjustments in March 2023, proposing a [new fee schedule](#) that was discussed in a June 2023 the Trademark Public Advisory Committee (TPAC) hearing as required under section 10 of the America Invents Act. IPO submitted [comments to TPAC](#) in June 2023. The USPTO then published a [notice of proposed rulemaking](#) in March 2024.

IPO submitted [written comments](#) to the USPTO on that updated proposal in May 2024. An [overview of the fees](#) provided by the USPTO indicates that the final rule introduces seven new fees and discontinues four current fees.

On November 20 the USPTO published in the *Federal Register* a [final rule adjusting patent fees](#) that will take effect on January 19, 2025. The USPTO initiated the fee adjustments in April 2023, proposing a [new fee schedule](#) that was discussed in a May 2023 Patent Public Advisory Committee (PPAC) hearing as required under section 10 of the America Invents Act. IPO submitted [comments to PPAC](#) in May 2023. The USPTO then published a [notice of proposed rulemaking](#) in April 2024. IPO submitted [written comments to the USPTO](#) on that updated proposal in May 2024.

The rule “sets or adjusts 433 patent fees for undiscounted, small, and micro entities, including the introduction of 52 new fees.” The [notice](#) indicated that there would be a 7.5% across-the-board increase to fees not subject to targeted adjustments, higher than the initially proposed 5%, “[t]o keep the USPTO on a stable financial track sufficient to recover the aggregate estimated costs of patent operations and to support the agency’s strategic objectives.” An [overview of the fees](#) provided by the USPTO indicates that the across-the-board adjustment was increased in part to offset revenue from proposed targeted fees that were eliminated or reduced based on public comments, such as After Final Consideration Pilot (AFCP) 2.0 requests, patent term adjustments (PTA), tiered fees for terminal disclaimers, third and subsequent tiered fees for requests for continued examination (RCE), continuing application timing thresholds, and patent term extensions (PTE).

## PPAC AND TPAC

PPAC convened for its final meeting of the year on November 21. Deputy Director Brent opened with remarks on key developments and transitions within the USPTO and provided an update on the USPTO’s progress in reducing patent pendency, noting that by the end of September, the average time to first action had decreased to 19.9 months from 20.5 months earlier in the year. He outlined the office’s commitment to enhancing patent quality and examination efficiency, driven in part by the recent hiring of over 850 new patent examiners—exceeding the initial goal of 800. Other notable developments included the updated guidance on patent subject matter eligibility for critical technologies like AI, revisions to the examiner manual, and enhanced quality assurance measures led by experienced primary examiners. The [2024 PPAC Annual Report](#) served as a central focus of the meeting, addressing key areas such as rulemaking, outreach, finance, patent pendency and quality, the PTAB, and artificial intelligence. Additionally, the PPAC discussed a [recent study](#) on unpatentability findings in IPR final written decisions. Key takeaways indicate that challenged patents with findings of unpatentability have more complex prosecution histories and a higher volume of prior art citations. The overwhelming reliance on prior art introduced in IPR proceedings points to opportunities for improvement in the examination process, including enhanced search tools for examiners and increased focus on expert testimony and analysis.

TPAC held its final [public meeting](#) of the year on November 22. Deputy Director Brent highlighted several ongoing initiatives, such as the appointment of Nancy Kamei as the new Director of Public Engagement, with John Cabeca, former IP attaché for South Asia, as Deputy Director. Other updates included the relaunch of the Council for Inclusive Innovation (CI2) in December, the anticipated opening of a Southeast Regional Office in Atlanta, and the establishment of the 99th Patent and Trademark Resource Center (PTRC) at Mississippi State University. The agenda also included updates on operations, finances, policy, and the Trademark Trial and Appeal Board (TTAB).

## MANUAL UPDATES

On November 8, the USPTO published the ninth edition, Revision 01.2024, of the [Manual of Patent Examining Procedure](#) (MPEP), reflecting USPTO practice and relevant case law as of January 1, 2024. On November 27 the USPTO published the November 2024 version of the [Trademark Manual of Examining Procedure \(TMPEP\)](#), including updates relevant to the TTAB and court decisions reported before August 31, 2024, along with an outline and comprehensive [change summary](#) highlighting some of the changes.

## TERMINAL DISCLAIMER WITHDRAWAL

On December 4, the USPTO [announced](#) withdrawal of a [proposed rule](#), published in May, that would have required “terminal disclaimers filed to obviate nonstatutory double patenting to include an agreement by the disclaimant that the patent in which the terminal disclaimer is filed, or any patent granted on an application in which a terminal disclaimer is filed, will be enforceable only if the patent is not tied and has never been tied directly or indirectly to a patent by one or more terminal disclaimers filed to obviate nonstatutory double patenting in which: any claim has been finally held unpatentable or invalid as anticipated or obvious by a Federal court in a civil action or by the USPTO, and all appeal rights have been exhausted; or a statutory disclaimer of a claim is filed after any challenge based on anticipation or obviousness to that claim has been made.”

IPO [submitted comments](#) on the proposed rule in July, recommending that the USPTO withdraw the rule because, as proposed, it did not “contemplate any claim-by-claim analysis to determine which claims are, in fact, patentably indistinct from the invalidated claim.”

## FINAL RULES AT USPTO

On October 1 the USPTO published the [final rule](#) governing the process for Director Review of proceedings under the Leahy-Smith America Invents Act, which allows parties to request Director Review of any: (1) decision on institution; (2) final written decision in an IPR or PGR or final decision in a derivation proceeding; (3) decision granting rehearing of a decision on institution or a final decision; (4) other decision concluding an AIA proceeding. The final rule also permits the Director to initiate a review *sua sponte*; outlines timing and format of requirements for requests for Director Review; addresses the impact of Director Review on the underlying PTAB proceeding; clarifies the time by which an appeal to the U.S. Court of Appeals for the Federal Circuit must be filed; and provides that the Director may delegate a review. In July IPO [submitted comments](#) to the USPTO concerning the proposed rule, noting that it set reasonable limits and standards. The rule went into effect on October 31, 2024.

On October 10 the USPTO published a [final rule](#) in the *Federal Register* on “Expanding Opportunities to Appear Before the Patent Trial and Appeal Board.” The new regulations “permit parties to proceed without back-up counsel upon a showing of good cause, such as a lack of resources to hire two counsel; establish a streamlined alternative procedure for recognizing counsel pro hac vice that is available when counsel has previously been recognized *pro hac vice* in a different PTAB proceeding; and clarify that

those recognized pro hac vice have a duty to inform the Board of subsequent events that render inaccurate or incomplete representations they made to obtain pro hac vice recognition.” The USPTO decided not to pursue a proposed rule that would have allowed non-registered attorneys to appear as lead counsel.

IPO [submitted comments](#) in May expressing support for the USPTO’s initial proposals to expand opportunities to appear before PTAB and applauding the USPTO’s “careful consideration of the competing goals of ensuring clients competent representation before the PTAB and maximizing client choice while minimizing expense.” The final rule went into effect on November 12.

## DESIGN PATENTS

On November 14 IPO [submitted comments](#) in response to USPTO’s [Supplemental Guidance for Examination of Design Patent Applications Related to Computer-Generated Electronic Images, Including Computer-Generated Icons and Graphical User Interfaces](#). In the submission, IPO proposed “that a practice change be made in the U.S. for user interface designs that would recognize that these designs transcend the traditional display screen” and explained that “computers and user interface designs are rarely designed together and technology has evolved such that computer display screens are not necessary to view a computer-generated user interface design. For this reason, IPO suggests that the USPTO should eliminate the requirement to show the article of manufacture—the computer—in the drawings to satisfy 35 U.S.C. § 171.”

## COPYRIGHT OFFICE

On October 28, the U.S. Copyright Office published a [final rule](#) in the *Federal Register* on “Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies.” Pursuant to Section 1201 of the Digital Millennium Copyright Act (DMCA) and based upon recommendation of the Register of Copyrights, the Librarian of Congress renewed “all but one of the exemptions pursuant to the eighth triennial rulemaking,” adopted a new exemption to vehicle operational data for computer programs, and expanded existing exemptions to text and data mining of audiovisual and literary works and to repair of commercial industrial equipment for computer programs. The final rule went into effect on October 28, 2024.

At the November 13 [hearing on Oversight of the United States Copyright Office](#) before the Senate Judiciary Committee Subcommittee on Intellectual Property, Director Perlmuter also discussed that, in its second year, the Copyright Claims Board (CCB) had proven to be a successful alternative for those who could not afford to litigate copyright claims in federal court. The Office had made significant modernization efforts, including implementing the Enterprise Copyright System (ECS), and had increased its outreach activities. Director Perlmuter encouraged Congress to pass legislation establishing a federal right against digital replicas, while addressing First Amendment concerns. Questions from subcommittee members covered AI under the fair use doctrine, AI-generated digital replicas, ECS processing times, the proliferation of performer rights organizations, the mechanical licensing collective, the amount of CCB determinations, digital piracy legislation, and issues with group registration.



## INTELLECTUAL PROPERTY POLICY LOOKING AHEAD TO 2025

By **Marla Grossman & Luke Lynch**, *ACG Advocacy*

### OVERVIEW

The final quarter of 2024 has brought significant developments in intellectual property (IP) policy, laying the groundwork for major shifts in 2025. With a second Trump administration on the horizon, IP stakeholders are closely watching nominations for key roles in the IP and trade sectors, which will shape U.S. strategy both domestically and globally. Trump's approach to IP has historically emphasized strong enforcement against international IP theft, particularly targeting China, as well as leveraging trade tools like tariffs and agreements to protect American innovation.



Trump's second term is likely to continue these trends, focusing on bolstering patent protections, reducing regulatory burdens, and enhancing enforcement measures. However, Trump's skepticism toward large technology companies and past criticisms of Obama-era AIA laws, which facilitate challenges to patents, may influence policy direction. Much will depend on the individuals appointed to lead agencies like the USPTO and other executive branch positions. Additionally, Trump's alignment with figures like Elon Musk, who have expressed anti-IP sentiments in the past, could introduce complexities for IP advocates. As IP is not a primary focus for Trump personally, the administration's direction will likely be driven by his appointees and their priorities.

### KEY APPOINTMENTS AND LEADERSHIP TRANSITIONS

A lot will depend on who Trump places in positions such as the Secretary of Commerce, the Director of the U.S. Patent and Trademark Office (USPTO), U.S. Trade Representative (USTR), and the Intellectual Property Enforcement Coordinator (IPEC).

#### COMMERCE SECRETARY: HOWARD LUTNICK (AWAITING OFFICIAL NOMINATION)

Lutnick, a Wall Street figure and CEO of Cantor Fitzgerald, is anticipated to play a critical role in selecting the next USPTO Director. His personal experience as a patent owner underscores his familiarity with IP issues, suggesting a strong emphasis on patent policy under his leadership. Lutnick's close ties to the Trump administration and his influence in shaping technology and trade policies make this appointment particularly consequential for innovation-driven sectors.

Trump has indicated a broader intent to reshape traditional trade policymaking, signaling that Lutnick would lead both the Commerce Department and aspects of the tariff and trade agenda traditionally housed within USTR. However, such a consolidation faces significant legal and political hurdles. Notably, trade oversight committees like House Ways and Means and Senate Finance have consistently opposed efforts to diminish USTR's authority. As Everett Eissenstat, Trump's former Deputy Assistant for

International Economic Affairs, observed, consolidating USTR's role under Commerce has been debated for decades but would require statutory changes unlikely to gain congressional approval.

#### UNITED STATES TRADE REPRESENTATIVE (USTR): JAMISON GREER (AWAITING OFFICIAL NOMINATION)

The USTR's mandate to negotiate trade agreements with robust IP protections places this role at the forefront of international IP enforcement. Jamison Greer, advisor to former USTR Robert Lighthizer during Trump's first administration, is poised to continue a legacy of assertive trade policies aimed at combating counterfeiting, piracy, and other IP infringements abroad. Greer's bipartisan respect and expertise in trade law make him a critical figure in safeguarding U.S. IP interests in global markets.

#### INTELLECTUAL PROPERTY ENFORCEMENT COORDINATOR (IPEC): NOT YET ANNOUNCED

The IPEC's role in coordinating IP enforcement strategies remains a pivotal yet uncertain area. While previous administrations have not prioritized this position, the Trump administration's stance on international trade and counterfeiting may prompt an eventual nomination. The IPEC's focus on combating digital piracy and fostering global IP standards will be crucial in addressing modern IP challenges.

#### USPTO DIRECTOR: NOT YET ANNOUNCED

With the recent resignation of Director Kathi Vidal, the USPTO continues under Acting Director Derrick Brent while stakeholders await the anticipated nomination of a permanent Director. The Director's oversight of patent eligibility standards, innovation initiatives, and international collaborations will shape the U.S. innovation ecosystem for years to come. For some historical context about USPTO leadership, the agency has experienced frequent leadership changes, with directors serving for varying durations over the past two decades. ACG's recent memo on USPTO succession planning highlights the importance of continuity during transitional periods. Key historical trends include average wait times for USPTO Director confirmations range from 56 to 200 days. Let us know if you are interested in a copy of this memo.

#### CONGRESSIONAL DYNAMICS AND COMMITTEE LEADERSHIP

The slim majorities in the incoming 119th Congress set the stage for contentious debates over IP legislation. The House GOP majority will be a historic split of 217-215 with the departure of Waltz, Stefanik and Gaetz. This razor thin margin will remain until April when special elections will be held to fill those seats.

Committee leadership will continue to play a pivotal role in shaping the direction of IP policy. In the Senate Judiciary Committee, bipartisan leaders Chuck Grassley (R-IA) and Dick Durbin (D-IL) are expected to guide critical discussions on patent reform. Meanwhile, the House Judiciary Committee will be led by Jim Jordan (R-OH) and Jamie Raskin (D-MD). Raskin, newly endorsed by outgoing top Democrat Jerry Nadler (D-NY), brings a focus on First Amendment and civil rights that could influence oversight in IP-related matters.

Subcommittee leadership is expected to be the main driver of specific IP issues in the 119<sup>th</sup> Congress. In the Senate, Thom Tillis (R-NC) and Chris Coons (D-DE) are expected to maintain their collaborative approach on patent eligibility and technology innovation. In the House, Darrell Issa (R-CA) is expected to continue as Chair, with Hank Johnson (D-GA) serving as Ranking Member. Issa's deep expertise in IP law positions him to spearhead substantive legislative initiatives that will likely shape the nation's innovation landscape.

This evolving congressional landscape underscores the importance of stakeholder engagement and advocacy as the legislative priorities for IP policy come into sharper focus.

#### PATENT LAW UPDATE

On December 6, the House passed a bill, authored by Congressman Darrell Issa (R-CA), to amend Title 35 of the U.S. Code, which governs the USPTO. The legislation allows the USPTO Director to waive penalties for applicants who claim reduced fees under "small" or "micro" entity status, as long as they can prove their claims were made in good faith. The changes to Title 35 are (1) Section 41(j): Adding a provision to excuse penalties if the entity acted in good faith. And (2) Section 123(f): Adding similar language to excuse certification errors made in good faith. At the time of this writing, the bill, which has already passed the Senate, now awaits the President's signature.

#### DRUG PRICING REFORM

Efforts to lower prescription drug costs have garnered mixed results but will continue to be a key focus in the 119th Congress. In September, the Senate HELP Committee planned to review the Medication Affordability and Patent Integrity Act (S. 2780) but canceled the meeting. The bill seeks to enhance transparency by requiring drug and biologics companies to certify consistency in their filings with both the FDA and USPTO. It also introduces a defense to patent infringement if the certification is violated. However, industry groups like IPO oppose the measure, arguing it would force disclosure of confidential regulatory data irrelevant to the patent process, potentially exposing patents to legal vulnerabilities. The IPO Board passed a resolution against the bill, citing concerns about inequitable conduct claims and the risk of patents being invalidated.

#### PATENT ELIGIBILITY AND REFORM EFFORTS

Several bipartisan bills introduced this Congress, aim to strengthen patent rights and eligibility. The RESTORE Patent Rights Act, introduced at the end of July by Senators Chris Coons (D-DE) and Tom Cotton (R-AR) seeks to restore the presumption of injunctions in patent infringement cases, thereby offering enhanced protections for U.S. innovators and startups. A Senate IP subcommittee hearing on patent injunctions is scheduled for December 18.

Additionally, the Patent Eligibility Restoration Act (PERA) was introduced in September, aiming to clarify patent eligibility standards across various industries, with a particular focus on technology-driven

sectors. While this bill was initially slated for markup by the Senate Judiciary Committee, its consideration was delayed along with the PREVAIL Act. However, both remain on the agenda for future discussions. The PREVAIL Act, which was narrowly advanced by the Senate Judiciary Committee prior to the Thanksgiving holiday, addresses concerns regarding patent enforcement and seeks to protect American innovation.

## TRADEMARK AND COUNTERFEIT POLICY

In November, Rep. Darrell Issa (R-CA) introduced the TRIPS Waivers Act, a bill that would require Congressional oversight before international agreements affecting U.S. intellectual property (IP) rights are negotiated. The measure responds to ongoing debates about waivers under the TRIPS Agreement, initially proposed during the COVID-19 pandemic, which many fear could undermine innovation. The bill mandates impact analyses for IP waivers, ensuring transparency and safeguarding U.S. interests in global trade discussions.

## ARTIFICIAL INTELLIGENCE (AI) POLICY

AI regulation remains a dynamic and evolving issue, with differing approaches between the current and incoming administrations. Reports indicate that a second Trump administration would likely adopt a lighter regulatory stance, focusing on limiting China's access to advanced technology while reducing oversight on U.S. AI development. This approach could involve rescinding Biden's 2023 AI Executive Order and scaling back investigations into AI-related issues, such as privacy, antitrust, and fairness. While federal agencies like the National Institute of Standards and Technology (NIST) may continue to issue safety guidelines, state-led regulations could play a larger role in filling the regulatory gaps. Additionally, President-elect Trump has appointed David Sacks, a venture capitalist and member of the "PayPal Mafia," as his AI and cryptocurrency advisor. Sacks is expected to advocate for minimal regulation, with some safeguards, and though his role as a special government employee limits his formal powers, he will still significantly influence the direction of policy on technology and innovation.

Congress will continue to shape AI policy as indicated by bill introductions and reports that have laid the groundwork for action in the 119th Congress. One such bill, introduced by Senator Peter Welch (D-VT) in December, is the TRAIN Act, which aims to enhance transparency in generative AI model training by allowing copyright holders to access information about how their works are used. This proposal seeks to provide legal recourse for those whose content is allegedly misused. The House AI Task Force is expected to release their highly anticipated report soon, which is rumored to recommend a tailored, gradual approach to AI regulation to prevent stifling innovation. The report may emphasize the need for federal preemption to avoid conflicting state laws and propose the establishment of the AI Safety Institute (ASI) to set global standards.

## KEY UPDATES FROM THE USPTO IN 2024

1. **Chief Public Engagement Officer Appointment:**
  - a. Nancy U. Kamei was appointed as the USPTO's first Chief Public Engagement Officer to lead the newly established Office of Public Engagement (OPE). Her focus is on expanding intellectual property (IP) awareness and resources, especially among

students, educators, and small businesses, with an emphasis on underserved communities.

**2. AI and Patent Classification:**

a. The USPTO's SOaR program hosted a virtual session on Cooperative Patent Classification (CPC) for Artificial Intelligence. The session highlighted CPC fundamentals and AI-related classification schemes.

**3. Trademark Audits Policy Change:**

a. The USPTO revised its approach to post-registration trademark audits, moving from random to targeted audits aimed at identifying marks that may not be actively used in commerce. This change enhances the accuracy of the federal trademark register.

**4. Labor Relations:**

a. The USPTO and the National Treasury Employees Union (NTEU) Chapter 245 signed a new collective bargaining agreement (CBA), the first update in over two decades. It aims to improve collaboration between management and employees, covering over 700 attorneys.

**5. PTAB Director Review Process:**

a. A final rule governing Director Review for Patent Trial and Appeal Board (PTAB) proceedings came into effect. This process allows parties to request reviews of decisions in PTAB cases and clarifies procedures for appeals.

**6. Updated MPEP:**

a. A revised version of the Manual of Patent Examining Procedure (MPEP) was released. It includes updates to various chapters, reflecting changes in patent examination policies and procedures.

**7. Pro Hac Vice Admission Rule:**

a. New rules for pro hac vice admission in PTAB proceedings were introduced. These streamline the process for non-registered attorneys, providing more flexibility for legal representation in patent cases.

**8. Leadership Transition:**

a. USPTO Director Kathi Vidal announced her resignation, effective mid-December, with Deputy Director Derrick Brent set to assume her duties. Vidal highlighted achievements during her tenure, including efforts to foster inclusivity and innovation.

**9. Trademark Fee Adjustments:**

a. Starting January 18, 2025, USPTO will implement updated trademark fees to support its strategic initiatives, improve trademark processing, and combat fraud.

**10. Collective Bargaining Agreement for Patent Examiners:**

a. The USPTO and the Patent Office Professional Association (POPA) finalized a new CBA, the first in nearly 40 years. Covering over 9,600 employees, the

agreement promotes operational efficiency and employee flexibility, aligning with federal labor policy goals.

## USPTO FUNDING AND LEGISLATIVE DEVELOPMENTS

### 1. **FY25 Budget:**

a. The FY25 CJS bill allocates \$4.555 billion to the USPTO, \$359.141 million above FY24 levels, supporting operational needs and global IP protection initiatives.

### 2. **Continuing Resolutions (CR):**

a. The current CR is set to expire on December 20, 2024. The CR limits the USPTO spending to a pro-rated portion of the FY24 appropriated level of \$4.196 billion.<sup>1</sup>

b. If there were an appropriation lapse on December 20, meaning a government shutdown, the USPTO is authorized to spend its operating reserve which will sustain the USPTO for several months.<sup>2</sup>

c. The current expectation is that there will be another CR through March 2025.

d. The budget sequestration issue that was passed in the Fiscal Responsibility Act of 2023 could become an issue for the USPTO in 2025.

i.If regular appropriations are not passed by April 30 of 2025 there will be an across the board cut anywhere from 1-5%. The USPTO's accounts are not exempt because their fees are subject to the reduction.

ii.However, the likelihood of regular appropriations not passing by the deadline are slim.

### 3. **FY26 Budget**

a. Looking ahead, the USPTO submitted the FY26 budget request to OMB in September 2024. The USPTO anticipates a delay in submission of the FY26 President's Budget request to spring 2025 due to the change in administration.<sup>3</sup>

### 4. **Global IP Protection Amendment:**

a. Senators Chris Coons (D-DE) and Bill Hagerty (R-TN) proposed an amendment directing the U.S. Trade Representative to enhance global IP enforcement, reinforcing American innovation and competitiveness.

## CONCLUSION

The fourth quarter of 2024 has set the stage for transformative changes in U.S. IP policy. 2025 will be a busy year with key appointments pending and legislative reforms underway. Moreover, the administration's approach to IP will significantly impact innovation, trade, and enforcement priorities. Stakeholders across industries must closely monitor these developments as the U.S. navigates the complexities of a rapidly evolving global IP landscape as well as the transition of power to the Trump Administration for the second time in 8 years.

IPO will prioritize educating key stakeholders in Congress and the administration about the importance of intellectual property to their industries. This foundational outreach is critical during transitions of power, ensuring that decision-makers understand the unique challenges and opportunities within the IP

landscape. Additionally, we anticipate a strong emphasis on trade-centered IP enforcement, with the USTR likely prioritizing bilateral and multilateral trade agreements as key tools for safeguarding IP rights. Companies should review their interests in major trade markets, such as China, Canada, and Mexico, and prepare for stricter enforcement measures or sanctions targeting nations that violate IP standards. IP-intensive technology firms, in particular, should monitor potential policy shifts emphasizing smaller innovators over larger tech entities, with potential impacts on R&D, licensing, and merger reviews. Finally, IPO will keep an eye on the evolving role of the IPEC in interagency coordination. Previous tensions between the IPEC and USTR may resurface, leading to fragmented enforcement strategies. Staying engaged with the IPEC, if confirmed, and seeking representation in interagency discussions will be vital to ensure their interests are effectively communicated and addressed.

## 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*

The last quarter of 2024 saw no blockbuster rulings in the patent space. Nevertheless, there were a few decisions of note.

On October 8 in *AlexSam v. Aetna*, the Federal Circuit vacated portions of the dismissal of a patent infringement complaint based on the district court's conclusion that the allegations of patent infringement were "merely conclusory" and, therefore, "need not be taken as true." In reaching the opposite



conclusion, in an opinion by Judge Stark and joined by Judges Lourie and Bryson, the panel held:

Whether a particular allegation in a complaint is well-pled and factual, and therefore accorded a presumption of truth, or is instead a legal conclusion or in other respects merely conclusory – and, hence, not credited at the motion to dismiss stage – can be a crucial issue. Yet we have not explicitly set out the standard of review applicable to a trial court's categorization of a complaint's allegations. That is, we have not said whether we accord deferential or non-deferential review to a trial court's decision that an allegation is factual or legal, well-pled or merely conclusory. We hold today that our review of trial court determinations on these matters is *de novo*.

In *UTTO v. Metrotech*, the Federal Circuit answered the question of whether claim construction is appropriate in the context of a Rule 12(b)(6) motion to dismiss. In an October 18 opinion by Judge Taranto (joined by Judges Prost and Hughes), the panel held in the affirmative that construing the asserted claims "is proper and routine in ruling on a motion under Rule 12(b)(6)."

The Federal Circuit's decision in *Cytiva Bioprocess v. JSR* dealt with the interplay of inherency and obviousness. On December 4, the panel (Judge Prost joined by Judges Taranto and Hughes) affirmed six PTAB decisions holding Cytiva's claims to chromatography matrices obvious over the prior art. The claims required Fab binding activity and Cytiva argued that the Board should have considered whether the POSA would have had a reasonable expectation of successful Fab binding. The panel disagreed, noting that Fab binding was an inherent property of the otherwise obvious matrices. "If a property of a composition is in fact inherent, there is no question of a reasonable expectation of success in achieving it."

In *Nexstep v. Comcast Cable*, the majority affirmed a district court's JMOL setting aside the jury's verdict of infringement under the doctrine of equivalents. In an opinion of October 24 authored by Judge Chen and joined by Judge Taranto, the majority agreed that the patentee's expert had provided only



“conclusory and circular ‘because I said so’ testimony [that] is insufficient. Dr. Selker failed to provide what our precedent requires:

‘particularized testimony explaining why the function . . . [was] the same.’” In the same vein, the majority agreed with the district court’s characterization of Dr. Selker’s testimony on the “way” prong of DOE as “a word salad.” Judge Reyna, however, dissented in part, noting that the majority “concocts a rigid new rule that in all cases a patentee must present expert opinion testimony to prove infringement under the doctrine of equivalents. The majority’s new rule ... fails to recognize that each individual patent infringement case presents unique facts and circumstances. There is no cookie-cutter approach to patent infringement.”

In *Osseo Imaging v. Planmeca*, the Federal Circuit affirmed a jury verdict of infringement. The defendant had argued that the patentee’s expert was not a POSA at the time of the invention and should not have been allowed to testify on issues of validity and infringement. The Federal Circuit, however, disagreed. In a September 4 opinion written by Judge Stoll and joined by Judges Dyk and Clevenger, the panel held that “an expert need not have acquired that skill level prior to the time of the invention to be able to testify from the vantage point of a person of ordinary skill in the art. Rather, an expert can acquire the necessary skill level later and develop an understanding of what a person of ordinary skill knew at the time of the invention.”

There were a couple of fun/interesting patent decisions as well.

1. In an October 24<sup>th</sup> Order in *Vascular Solutions v. Medtronic*, District Court Judge Schiltz of the District of Minnesota essentially threw up his hands and surrendered in the face of a Federal Circuit remand. Judge Schiltz had held that all of the asserted claims were invalid because the term “substantially rigid portion” was indefinite. The Federal Circuit disagreed with his analysis and vacated and remanded the case. On remand, Judge Schiltz recused himself and ordered that someone else figure out what the Federal Circuit wanted done.

“In almost 20 years on the bench, the undersigned has never once recused after being reversed by an appellate court. But in this case, the Court literally does not know how it would proceed to construe ‘substantially rigid portion’ in a manner consistent with the Federal Circuit’s opinion and does not believe that it can set aside its previous conclusions to make an impartial determination. It is best that this case be handled by a different judge who can write on a clean slate.”

2. The en banc appeal in *EcoFactor v. Google* addresses a specific damages issue, namely, the allowability of expert testimony assigning a per-unit royalty rate to lump-sum licenses. On December 4, the Federal Circuit sua sponte issued an Order identifying 18 pages of Google’s opening brief as exceeding “the scope of the court’s en banc rehearing .... EcoFactor should not address this argument in its response brief.” The errant argument by Google related to apportionment of the lump-sum licenses to patents beyond those asserted in the litigation. Interestingly, someone at the Federal Circuit must have started reading Google’s opening brief before all of the briefs had been filed. Impressive proactivity!

The trademark space was relatively quiet as well. The Supreme Court held oral argument on December 11 in *Dewberry Group v. Dewberry Engineers*, a case concerning disgorgement of profits under the Lanham Act. The infringer (“Group”) used the Dewberry mark in violation of the Lanham Act but had no profits to disgorge. Instead, its commonly-owned corporate affiliates were the ones that booked

profits. The district court treated Group and its affiliates as a single corporate entity and awarded the plaintiff (“Engineers”) those profits. The Fourth Circuit, in a split decision, affirmed.

The questioning by the Supreme Court justices focused on whether general principles of equity could justify the district court’s award. The attorney for Group argued that general equitable principles could not pierce the corporate veil without meeting the separate standards for such piercing. Some of the justices also explored whether the “just sums” language in the Lanham Act could form the basis for the decisions by the lower courts, the Lanham Act stating that “if the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case.” Group’s counsel argued that language does not justify disgorgement of profits from any corporation other than the named defendant, Group. While it is always risky to try and predict the outcome of any case based on oral argument, it does seem that the Supreme Court is leaning towards remand at least, if not an outright reversal. We’ll see what happens next year.

In *Crocs v Effervescent*, the Federal Circuit reversed and remanded a summary judgment for failure to state a cause of action under Section 43(a)(1)(B) of the Lanham Act. The plaintiff had argued that Crocs’ use of “patented,” “exclusive,” and “proprietary” in its advertisements for shoes, which were not patented, constituted actionable misrepresentations under the Lanham Act. In an October 3 opinion authored by Judge Reyna and joined by Judges Cunningham and District Judge Albright sitting by designation from W.D. Texas, the panel held liability can be found if a party “falsely claims that it possesses a patent on a product feature and advertises that product feature in a manner that causes consumers to be misled about the nature, characteristics, or qualities of its product.”

In *DowntownDC Business Improvement District v. Clarke*, the TTAB sustained an opposition to the mark DISTRICT OF FASHION for likelihood of confusion with the mark DOWNTOWNDC DISTRICT OF FASHION. Notably, the Applicant for the DISTRICT OF FASHION mark was a former employee of the opposing party, DowntownDC. The Applicant claimed priority of the applied-for DISTRICT OF FASHION mark by arguing that she had previously used the DOWNTOWNDC DISTRICT OF FASHION mark outside the scope of her employment with DowntownDC. In rejecting this argument, the Board concluded that her use of the prior mark fell within the scope of her employment and found no evidence that either party’s conduct suggested that the Applicant had rights in the prior use of the mark or that DowntownDC had been granted an implied license to it.

Finally, in *1661, Inc. v. TF Intellectual Property Pty Ltd*, the TTAB denied a motion to compel discovery where a party timely served an objection of excessiveness to a second set of production requests and interrogatories by the opposing party. Opposer, 1661, argued that TFIP waived its right to object to the second set of RFPs and interrogatories on the grounds of excessiveness because it did not raise this objection to the first set of RFPs and interrogatories. The Board disagreed, holding that because TFIP did not determine the first set as exceeding the limit of 75 total RFPs or interrogatories, it had no duty to disclose to 1661 its method of counting. Furthermore, since TFIP did not owe this duty, it did not waive its right to the objection of excessiveness to the second set when it determined discovery exceeded the 75-count limit.

We wish everyone a great holiday season and we will see you next year!

## PROCEDURAL HARMONIZATION UPDATE: A YEAR OF PROGRESS AND HOPE FOR THE FUTURE

By **Thomas Valente**, *IPO Senior Director of Global Affairs*

When the IPO Board met in Boston last fall for strategic planning, it declared procedural harmonization as one of its top priorities. IPO provides input on harmonization of patent office procedures through, for example, participation in the IP5 Industry Group and the Industry Trilateral and through its involvement in various WIPO activities. This year has proved to be a banner year for procedural harmonization, with progress being made in numerous areas and potential being shown for further advancements in the future.



Expanding options for e-signatures in IP offices has long been a priority for IPO. Over the last few years, IPO has advocated for IP offices to allow IP owners the option to use advanced or qualified e-signatures to help alleviate burdens associated with in-person authentication. As reported in the July issue of the Quarterly, this past spring both the U.S. Patent and Trademark Office<sup>1</sup> and the European Patent Office<sup>2</sup> amended their rules to provide broader options for use of e-signatures. In fact, in making the rule change, the USPTO cited stakeholder input received in harmonization forums, and noted that the new rule “is directed towards increasing harmonization of practices and procedures amongst intellectual property offices globally.” These were steps forward for the IP system that were welcomed by IPO.

Now, WIPO is evaluating the potential implementation of a Global ID, a single ID for a natural person or a legal entity in the form of an alphanumeric token or digital ID.<sup>3</sup> WIPO is entering Phase 2 of its Global ID project, and IPO is participating in that phase through the IP5 Industry E-Signature Task Force. This project, if successful, could help address several issues related to applicant name standardization and, in so doing, make the IP system more accessible, harmonized, transparent, and cost-effective.

A Global ID might also be able to be used to help facilitate a top international priority of IPO: a global assignment of patent rights, allowing one to file an assignment of rights in one place with effect in multiple jurisdictions. Global Assignment is an IP5 Project, and the IP5 Offices are currently developing proposed business requirements for it. Should WIPO be successful in its institution of a Global ID, that might make the initiation of a Global Assignment system all the easier through the use of a single ID for each IP asset holder that would be accepted by all participating IP offices.

There have also been advancements in other harmonization areas. For example, with respect to the harmonization of drawing requirements, the China National Intellectual Property Administration has already revised its examination guidelines to accept color drawings. IP5 Industry hopes that all the IP5 Offices will move forward to accept color and grayscale drawings and adopt a common image format; this is definitely a long-term goal, but progress is being made step by step.

Another area where the potential of harmonization can be seen is with respect to the pre-population of forms. [Global Dossier](#) has long provided “a single, secure point of access to publicly available, published dossier and examination information, enabling and encouraging the streamlining of office procedures among different IP Offices.” Now there is an eIDS *beta* release available on Global Dossier which allows one to pre-populate data on the eIDS form. Also, in a different use of Global Dossier, the European

Patent Office has proposed a technical system that could potentially work with Global Dossier to facilitate Global Assignment, and the question has been raised whether it might have other applications. These ideas show the potential of Global Dossier to move from a “passive” to an “active” system.

IPO thanks all of those on its team who work on procedural harmonization efforts and looks forward to continuing to try to find ways to move procedural harmonization forward. Doing so will not only make the IP system more cost-effective and efficient, but also more transparent and accessible. With technology advancing rapidly, the sky is the limit for procedural harmonization.

## INTRODUCING THE WIPO GUIDE TO TRADE SECRETS AND INNOVATION

**by James Pooley, IP Litigator and Trade Secret Expert**

It may not surprise the reader to learn that the World Intellectual Property Organization (WIPO) offers a major resource about trade secret law and management. But this new online “[WIPO Guide to Trade Secrets and Innovation](#)”—introduced this past summer—was a long time coming. In part this lag was due to the agency’s primary mission, which is to implement and manage international treaties affecting *registered* IP rights: patents, copyrights, trademarks and designs. In many corners of the IP community, trade secrets don’t even qualify as “intellectual property,” in spite of the TRIPS Agreement, which declares otherwise and requires all member states (through Article 39) to provide enforcement of rights in “undisclosed information.”



When I arrived at WIPO in late 2009, I learned more about why trade secrets had received so little attention relative to the rest of the IP landscape. Why didn’t we have robust programs dealing with this obviously important asset? In the first place, I was told, the diplomats in Geneva didn’t really understand what trade secrets were, but they presumed that secrecy must conflict with the notion of transparency in government, a principle which they all valued, at least in the abstract. Second, to the extent that anyone knew what trade secrets were, they thought immediately of Article 39(3) of TRIPS, which was designed to protect clinical data owned by drug companies, an industry that unfortunately many loved to hate.

I learned that this negative view was reinforced by another misunderstanding, that trade secrets encouraged and enabled hoarding of knowledge. That the opposite was true seemed confounding to many, until of course one considered how tech transfer works, and how sharing in an information-based economy is made safe only by the existence of legal frameworks to enforce expectations of confidentiality. In spite of the confusion and wrong assumptions, it seemed clear to anyone engaged in business that secrets were important. After all, the promised “knowledge transfer” to the developing world that had been promoted as the payoff for agreeing to TRIPS hadn’t materialized. Even though everyone could read published patents, without the relevant know-how it was often impossible to build the infrastructure to practice the patented inventions. So this was the conundrum: trade secrets seemed to be both essential and mysterious at the same time.

It wasn’t that the subject was entirely ignored. We had a division focused on helping small and medium enterprises (SMEs), universities and research institutions with practical application of IP, and trade secret education was a part of that effort. But it wasn’t in the spotlight. That started to change in 2016, following a wave of attention from the business community reflected in the near-simultaneous passage in the U.S. of the [Defend Trade Secrets Act](#) and the EU’s issuance of its [Trade Secrets Directive](#). In 2019 WIPO sponsored a [Symposium](#) on Trade Secrets and Innovation, an event that was [repeated](#) in 2022. Along the way, it published articles promoting secrecy as an [intellectual property right](#) and explaining why trade secrets are the most popular form of [IP protection for SMEs](#).

The symposia were designed and carried out under the leadership of Tomoko Miyamoto, Head of the Patent Law Section at WIPO, whose keen interest in trade secrets was the primary force behind those

events. When the idea for publishing a comprehensive treatise emerged in 2022, she also led that project. It bears emphasis, however, that the finished work, like many WIPO publications, was authored by many individuals from all around the globe. This approach has the advantage of bringing multiple points of view and experience to a multinational resource; but it also creates a serious editorial burden, finding ways to harmonize forms of expression while retaining helpful comparisons among jurisdictional frameworks of individual countries. I had the privilege of working with Tomoko to bring the final version to print, and it was released in June 2024.

As the title suggests, this 145-page (plus appendices) volume is intended to “guide” the reader. A great deal of effort went in to making it accessible as well as comprehensive, to meet the needs of two major constituencies: (1) businesses, particularly SMEs, and (2) policymakers in a position to influence the development of legal frameworks, particularly in developing countries. Of course, WIPO also intends the Guide to be educational, providing the public with easy-to-understand explanations and examples. It is practical, not academic, designed to meet the varied needs of the small shop owner, the fast-growing online business, as well as the established company seeking cross-border collaborations. Therefore, it can be a valuable resource for any organization anywhere in the world, providing insights and tips, presented in a global context not present in most other reference works.

The Guide is organized logically, beginning (after the introduction) with the strategic role of trade secrets in an information-based economy. Recognizing that the idea may seem counterintuitive, the Guide emphasizes that secrecy enables the sharing and dissemination of information, by providing enforceable guarantees of confidentiality and trust. And because certain types of innovations are not suitable for patent protection (for example, process technology deployed in private where infringement cannot be detected), the public interest in trade secret enforcement aligns with the patent system, as each encourages innovation in different ways. We can only hope that this sort of clarification will help to overcome the widespread suspicion of trade secret laws and lead to meaningful efforts to harmonize global frameworks.

The next section (Part III) provides a primer on trade secrets, including a basic definition “in 150 words,” a description of the kinds of information that can qualify for protection, and the common elements of most countries’ laws and procedures for enforcement. Similar to WIPO’s treatment of other forms of IP, the Guide includes a section on “exceptions and limitations” to the right (for example, whistleblowers). It also includes a discussion contrasting patents and secrets, while emphasizing that commercialization of innovation usually relies on both forms of protection pursued through a complementary strategy.

One of the most practical and useful sections (Part IV) addresses management of trade secret assets, directed at the twin goals of preventing loss and proving that the owner took “reasonable steps” (an element of the TRIPS formulation) to protect the integrity of its secrets. The Guide includes instructions on how to identify and assess secrets and related risks, as well as how to design and implement a trade secret protection program. It focuses not only on preservation of assets but also on how to deploy them in the business to increase enterprise value. Defensive strategies are also included, directed at avoiding contamination, for example in hiring high-level talent from competitors, or controlling exposure in the course of third-party relationships.

Part V deals with litigation, including investigations, offensive and defensive strategies, and finding ways to resolve disputes that are often driven by emotions. The Guide surveys various remedies (including extraterritorial reach), and deals with ways in which judges can maintain the secrecy of information that has to be submitted as part of court proceedings. Although not all jurisdictions allow criminal

prosecution for trade secret theft, given the risks involved in cross-border transactions, the discussion of criminal exposure is clearly helpful.

As if to drive home the point that trade secret laws encourage knowledge-sharing in the pursuit of innovation, the Guide includes an extensive discussion of collaborations. The commercial aspects are described through the timeline of most relationships, beginning with establishing contracts and trust, through management of the development process, and eventually sorting out the resulting rights. A similar but distinctive treatment is given to academic collaborations.

Finally, the Guide takes a look at special issues involving the increasingly critical asset class represented by “digital data” in its various forms, including raw data, analytics and code. For many companies whose business model has been transformed by the value of data they collect in the ordinary course, this section (VII) will be illuminating and helpful.

It hasn’t been that long since trade secrets were barely whispered about at WIPO. With the *WIPO Guide to Trade Secrets and Innovation*, the organization has made a major contribution to completing the “IP stack” of modern business.

## IPO DEI COMMITTEE MEMBER SPOTLIGHT:

Elaine Spector  
Partner  
*Harrity & Harrity, LLP*



Throughout the year, the IPO DEI Committee will spotlight members to acknowledge their contributions to DEI by having them answer specific questions.

### Experience

[Harrity & Harrity, LLP:](#)  
Partner

[Johns Hopkins  
Technology Ventures:](#)  
Senior IP Manager

[Drinker Biddle &  
Reath LLP:](#)  
Senior Attorney

[Burns, Doane Swecker  
& Mathis LLP:](#)  
Associate IP Attorney  
[Meyers, Liniak &  
Berenato:](#)  
Associate IP Attorney

### **Question: Please explain why you are passionate about DEI within the IP legal community?**

When I entered the classroom during my freshman year in college, I was one of only three women pursuing a degree in mechanical engineering. Even then, I knew I wanted to go to law school after finishing my degree, having learned about a career in patent law back in high school. It was shocking to see so few women in mechanical engineering, and this trend continued into the patent profession. When I started my career in 1996, women with mechanical engineering degrees were a rarity, leaving few female mentors and role models in the field. Early in my career, there were very few women partners where I worked, and as I began to have children, I faced a lack of flexibility in the requirements for advancement. My desire to work reduced hours (i.e., a 40-hour week) led to being placed on the “mommy track,” as I was deemed not committed enough.

Diversity, Equity, and Inclusion (DEI) within the IP legal community is crucial to me because I don’t want other women to experience what I did. I aim to challenge the existing structure within law firms so that women don’t have to choose between caring for their families and having fulfilling careers. Allowing advancement for women, even when they work part-time, gives them more control over their lives and a greater sense of satisfaction—something I have found in my current practice at Harrity & Harrity.



## Education

[University of  
Baltimore:](#)  
J.D. IP Law

[University of  
Maryland:](#)  
B.S. Mechanical  
Engineering

**Question: Based on the events (social and/or legal) in the last few years, please describe how you see the IPO DEI Committee promote DEI efforts in the IP profession in response to these events.**

In the past couple of years, DEI has faced numerous challenges, especially following the Supreme Court decision on affirmative action. We've witnessed the repercussions, with law firms being sued over their diversity initiatives. As a board member of the nonprofit Patent Pathways, which aims to increase diversity in the patent field, we've had to restructure our program to mitigate any legal action against our organization.

Additionally, there has been a surge of biases against diverse individuals, who are often unfairly labeled as “diversity hires” when they make a mistake. This characterization is completely inappropriate and is a concern that many of my diverse colleagues have voiced. They face disproportionate consequences for errors, which is unacceptable. I am committed to helping change this perspective and foster a more inclusive and equitable environment.

## IPO EDUCATION FOUNDATION'S ANNUAL AWARDS CELEBRATION



IPO Education Foundation held its 2024 [Awards Celebration](https://ipoef.org/awards-celebration) [ipoef.org/awards-celebration] on December 12 at the Mayflower Hotel in Washington, DC. The annual event honors accomplishments in the fields of IP, innovation, and creativity. Over 350 attendees from all over the world gathered to celebrate the honorees and promote the value of the IP system. This year, the Foundation honored Dr. Martine Rothblatt (United Therapeutics Corp.) as the Executive of the Year and the inventors of Mounjaro (Eli Lilly and Co.) and Ozempic (Novo Nordisk) as the Inventors of the Year. Learn more about this year's honorees below:

## INVENTORS OF THE YEAR:



IPO Education Foundation's Inventor of the Year award recognizes the world's most outstanding recent inventors and how their inventions benefit the nation's economy and quality of life. The Foundation honored the inventors of Mounjaro (Lilly) and Ozempic (Novo Nordisk) for identifying novel compounds targeting incretin hormones to treat diabetes. The honorees from Lilly include Krister Bokvist, Tamer Coskun, Robert Chad Cummins, and Jorge Alsina-Fernandez. The honorees from Novo Nordisk include Jesper Lau, Paw Bloch, and Thomas Hansen. Mounjaro and Ozempic have made significant positive impacts on the lives of those affected by diabetes by lowering A1C and the risk of major cardiovascular events such as stroke, heart attack, or death in adults also with known heart disease.

Click [here](#) to learn more about the 2024 Inventors of the Year.



## EXECUTIVE OF THE YEAR:



The Foundation awarded Dr. Martine Rothblatt (United Therapeutics Corp.) as the Executive of the Year for her commitment to the creation, promotion, and protection of intellectual property. Dr. Rothblatt, an inventor and entrepreneur, has made transformative contributions across various fields, including telecommunications with the creation of SiriusXM, biotechnology, and aviation. Dr. Rothblatt founded United Therapeutics in 1996 after her daughter was diagnosed with life threatening pulmonary hypertension. Under her leadership as Chairperson and CEO, the company developed a successful treatment for this condition, impacting and improving the lives of many patients. Beyond her work with United Therapeutics, Dr. Rothblatt has been a driving force in the biotech industry, advancing treatments and research that address significant medical challenges.

Her colleagues celebrated her accomplishments in this awards ceremony [video](#).

The Awards Celebration also featured IPOEF's first ever fundraising campaign. Donations received during the event will help IPOEF to reach greater audiences, form new partnerships, and develop innovative learning materials, from virtual tools to tailored content that meet the diverse needs of our audiences. **We are amazed by the generosity of our attendees who contributed over \$56,000!** We look forward to sharing about the Foundation's progress in the coming months towards educating the next generation about the value of IP. IPOEF President, Henry Hadad, shared during the Awards Celebration that the Foundation will be launching a public awareness campaign on social media around the Super Bowl in

February 2025. Aspiring journalist and social media influencer, Jeremiah Fennel, will be interviewing players and brands to raise awareness of the importance of intellectual property.

Jeremiah, and IPO Education Foundation, will be tying innovation and intellectual property to major cultural events in 2025. Make sure you're following [Jeremiah](#) and IPO Education Foundation to see his interviews from the Awards Celebration and stay up to date - you're not going to want to miss out!

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## IN CASE YOU MISSED IT!

10/3 [IPO Submits Comments on the 2024 Notorious Markets List](#)

10/7 [IPO Law Journal Publishes “Brazilian Courts and Preliminary Injunctions in SEP Infringement Lawsuits”](#)

10/9 [IPO Submits Comments to CNIPA on the Model Text of Patent Agency Contract \(Draft for Comments\) and Other Regulations](#)

11/10 [IPO Submits Comments to TIPO on Announcement of Draft Amendments to Some Provisions of the Patent Law](#)

11/15 [IPO Submits Amicus Brief to EPO Enlarged Board of Appeal in \*Philip Morris Prods. S.A. v. Yunnan Tobacco Int’l Co., Ltd.\*](#)

11/22 [IPO Submits Amicus Brief to Federal Circuit in \*EcoFactor v. Google\*](#)

12/5 [IPO Law Journal Publishes “Intellectual Property, Sustainability and Climate Change”](#)

12/11 [IPO Sends Letter to President-Elect Donald Trump Regarding Recommended Qualifications for USPTO Director](#)

12/12 [IPO Board Adopts Resolution Opposing “Bill to Address Patent Thickets”](#)