



Shimokaji IP specializes in the litigation and registration of patent, trademark, and copyright matters. We serve start-ups, Fortune 100 companies, government entities, and universities. Our expertise and representation extends across the US and throughout Asia.

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US Supreme Court Now Allows Delay in Bringing Patent Infringement Lawsuit

SCA owned a patent for adult diapers and sent to First Quality a letter alleging infringement. First Quality replied that the SCA patent was invalid and proceeded to market its product.

Next, SCA sought reexamination of its patent, and the patent office confirmed its validity - which was about 3 1/2 years after the infringement letter.

And SCA then filed an infringement suit against First Quality - which was about 7 years after the infringement letter.

First Quality defended the suit by arguing that the suit was barred by the doctrine of laches - unreasonable delay in bringing suit.

The US Supreme Court saw it differently. The patent laws allow the patent owner to collect damages, going back 6 years from the filing of suit. Thus, according to the Court, a suit cannot be barred for delay when the infringement occurred during the 6 year period.

COMMENT:

This decision gives patent owners more "breathing room." Previously, patent owners had to be concerned about knowing of the existence of infringement, but not wanting to take immediate steps in filing a lawsuit. Now, patent owners may not feel compelled to quickly file suit, and may wait for a more "appropriate" time.

Collecting Information, Analyzing It, and Displaying Results Is Not Patentable

Actual and potential patent owners continue to wait for the next Federal Circuit decision on what is abstract and therefore not patentable.

In *Clarilogic v. FormFree*, the Federal Circuit addressed a patent, which in their view, was the "height of abstraction". In this non-precedential opinion, the patent covered a "method for electronically certifying a borrower's financial account data and providing a credit report" in the words of the Federal Circuit.

The Federal Circuit explained that when the "focus" of the patent claim is "on collecting information, analyzing it, and displaying certain results of the collection and analysis", the patent claim is abstract. In fact, it is the "height of abstraction", according to the Court, where the claim is not limited to "how the collected information is analyzed or reformed."

COMMENT:

Though non-precedential, the decision reinforces the need to get beyond mere data collection and analysis in order to be patentable.

Will Your Federal Trademark Registration Be Audited?

To maintain a federal trademark registration, the owner must file a section 8 declaration between the 5th and 6th year after registration. The declaration must state that the registered mark is still being used for each registered class of goods and services. Each class may contain multiple goods and services.

If the owner wants to renew the registration, a declaration of use must be filed between the 9th and 10th year after registration. Again, the owner must confirm use of the mark for each registered class of goods and services.

The declaration of use requires the submission of one specimen for each registered class, even though the class may include multiple goods or services.

Now, for section 8 declarations, where there is more than one good or service per class, the US trademark office will be auditing up to 10% of the declarations.

For audited declarations, the owner will need to provide proof of use for two additional goods/services per class.

If the owner fails to provide the additional proof, the registration will be cancelled.

COMMENT:

Trademark owners have sometimes been lax when submitting a declaration of use that confirms that the registered mark has been used on all the goods and services. The possibility of an audit should make trademark owners more careful when signing a declaration of use.

Star Trek Dispute with Fans Ends in Settlement

The Star Trek TV series and films have been protected by copyright. Star Trek fans wanted to make a fan film about a Star Trek character named Garth of Izar.

As a prelude to their film, defendants produced a short version called "Star Trek: Prelude to Axanar". This was posted on YouTube. The Star Trek makers sued for copyright infringement.

Defendants argued that Garth was not copyrightable. The court saw it otherwise, explaining that Garth had physical and conceptual qualities.

Failing the above, defendants argued that they were exercising their right of fair use. Again, the court saw it otherwise, explaining that defendants' prelude was not transformative of the Star Trek works but instead sought to "stay true" to the original works.

The parties ended up settling.

COMMENT:

Defendants faced a tough road, especially since what they apparently wanted to do was copy the original Star Trek works in order to stay "true to the Star Trek canon down to excruciating details."

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