

ATRIP CONGRESS 2002
NEW DELHI, INDIA

REVOLUTION IN U. S. PATENT, TRADEMARK
COPYRIGHT AND INDUSTRIAL DESIGNS

PROFESSOR WILLIAM T. FRYER, III
UNIVERSITY OF BALTIMORE SCHOOL OF LAW

OUTLINE (Including resources)

Overview – Strategic Events and Players – Predictions

| Expected Primary Influences

- A. U. S. Economy Status — Slow down in some areas.
- B. U. S. Congressional political Situation – U. S. Patent and Trademark Office (PTO) fee diversion remains a significant issue.
- C. U. S. International Trade Needs – Major now and expanding.

Review of Selected, Recent U. S. Supreme Court (USSC) – Impact

- A. *Festo* case [122 S. Ct. 1831, 62 U.S.P. Q. 2d 1705 (2002)] – Patent law doctrine of equivalents clarified -- Utility patent application preparation, prosecution and patent interpretation are more complex now and U. S. patents may be more narrowly construed as a result of this decision.
- B. *Pioneer* case [534 U.S. 124, 60 U.S.P.Q. 2d 1865 (2001)] – Improved opportunities for biological plant protection (affirmed current PTO practice).
- C. *Zurko* case [527 U.S. 150, 50 U.S.P.Q. 2d 1930 (1999)] – Federal Circuit, Court of Court of Appeals, review of PTO decisions – Procedure – More deference to PTO factual determinations – Strengthens PTO role.

- D. *TrafFix* case [532 U.S. 23, 58 U.S.P.Q. 2d 1001 (2001)] – Clarified trade dress law – Some view this decision as narrowing the scope of protection for trade dress.
- E. *Wal-Mart* case [529 U. S. 205, 54 U.S.P.Q. 2d 1065 (2000)] – Limited trade dress protection – some interpret the case as requiring secondary meaning for all product configurations.
- F. *College Savings Bank* case [527 U.S. 666, 51 U.S.P.Q. 2d 1065 (1999)] – States cannot be sued for IP infringement (11th Amendment of the U. S. Constitution) in most situations – Continuing issue on which legislation is being prepared.

III. Patent and Trademarks – PTO Strategic Plan – Newest PTO Actions (copy of report on PTO web site - <http://www.uspto.gov>)

A. Proposed fee increases

- 1. Opposition on most points by professional legal organizations (See House Judiciary PTO Oversight Hearing on July 18, 2002 at <http://www.house.gov/judiciary>).

B. All electronic PTO - No paper

C. Proposed amendment of patent laws

- (1) Post Grant Opposition
- (2) Deferred Examination
- (3) PCT Enhancements

D. Work on further harmonization with other governments through the WIPO Standing Committee on Law of Trademarks, Geographically Indications and Industrial Designs (SCT), and the Standing Committee on Law of Patents (SCP)

IV. Trademarks - U. S. ratification of the Madrid Protocol (See WIPO web site under Activities ----> International Trademarks)

- 1. This treaty has been pending for 4 years in the U. S. Senate, because of political differences. Its ratification must wait for the next election, probably, and even then the differences, not related to the treaty, may not be resolved. There is strong support from U. S. attorneys and companies for ratification.

V. Copyrights – Internet Impact

- A. Federal cases on copyright and the Internet – *A & M Records, Inc. v. Napster, Inc.*, [284 F.3d 1091, 62 U.S.P.Q. 2d 1221 (2002)] - upheld copyright protection.
- B. WIPO Role – Policy development and dispute resolution (WIPO activities and reports found on its web site – <http://www.wipo.int>, under the Activities → Domain Name listing).

VI. Industrial Designs

- A. The Geneva Act of the Hague Agreement for the International Registration of Industrial Designs - Ready for submission to the U. S. Senate for ratification – Provides a system similar to PCT for international registration (See WIPO web site under Activities → International Designs
 - 1. This treaty will be a major improvement for industrial design protection.
 - 2. After commencement of operation, probably in 1995, this treaty will provide the incentive for harmonization of industrial design protection law.

VII. International Players

- A. WIPO - Process reorganized in 1998 for governments to develop recommendations on treaties and treaty revisions, as well as recommendations for national law changes to promote harmonization - Major national impact (WIPO Standing Committees' work with can be reviewed on the WIPO web site, accessed on the WIPO home page under the Intellectual Property heading ----> IP category).
 - 1. SCP [see item III(D)] – Achievements include completion of the Patent Law Treaty and initiating discussions on further patent law harmonization.
 - 2. SCT [see item III(D)] – Achievements include completion of the Trademark Law Treaty and a major discussion of Geographical Indications.
 - 3. Electronic Network between IP Offices – Under construction -- Connects with WIPO databases for registration systems and it has other uses.

VIII. World Trade Organization (WTO) (web site – <http://www.wto.org> – under the heading Trade Topics).

- A. Third world countries increasing impact on this organization

1. Medical drug cost issue is an example - Doha Declaration – Where WTO Revisited the interpretation of the TRIPS and Paris Convention provisions on patents (see heading Doha on WTO web site under Intellectual Property Topic).

IX: Conclusions

- A. Major changes are underway in the PTO organization and operation. It is looking for new ways to meet its Constitutional mandate.
- B. There is now and will be in the future a direct influence in the U. S. from links to the UN-WIPO SCP and SCT activities.
- C. WIPO's major commitment to all electronic processing related to the IP treaties and its provision of electronic networks for IP offices will make the goal of an all electronic PTO a reality relatively soon.
- D. WTO is having an overriding influence on the interpretation and development of national IP treaties and national IP laws, as evidenced by the Doha experience.

End of Document (October 3, 2002).

