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## PATENT & TRADEMARK POLICY REPORT JUNE 7, 2024



### I. Congressional Update:

- On Friday, June 7, Sen. Elizabeth Warren (D-MA) and Rep. Pramila Jayapal (D-WA) wrote a letter to eight pharmaceutical company CEOs, urging them to remove 130 patents from a government registry. This action targets patents deemed by the Federal Trade Commission as “junk patent listings” that block low-cost, generic competitors. The targeted companies include Novo Nordisk and GlaxoSmithKline, with patents related to expensive drugs such as Ozempic. The effort aligns with the Biden administration's broader strategy to lower drug costs by challenging pharmaceutical companies' patent practices. Read more [here](#).
- On Wednesday, June 12, the House Judiciary Subcommittee on Courts, Intellectual Property, and the Internet is holding a hearing titled, “The U.S. Intellectual Property System and the Impact of Litigation Financed by Third-Party Investors and Foreign Entities.” The hearing will examine recent developments with respect to intellectual property (IP) litigation financed by third party investors and foreign entities, including the impact of those developments on the U.S. IP system and our national security. As of now, the witnesses are Hon. Bob Goodlatte (former U.S. Representative (VA-6); former Chairman, House Judiciary Committee), Paul Taylor (Visiting Fellow, National Security Institute, George Mason University), and Donald Kochan (Professor of Law and Executive Director of the Law and Economics Center, Antonin Scalia Law School, George Mason University). You can view the hearing [here](#).

### II. USPTO Updates:

#### Headlines and Highlights:

- Sen. Warren and Rep. Jayapal Urge Removal of 130 Pharmaceutical Patents
- House IP Subcommittee to Hold Hearing on IP Litigation
- USPTO Extends Comment Period for AI-Assisted Inventions Guidance to June 20, 2024
- USPTO and UKIPO Sign Agreement on SEPs
- Derris Banks Appointed USPTO Midwest Regional Director
- WHO Releases Report on Health, Innovation, and IP
- Federal Circuit Denies Google’s Motion for New Trial
- USPTO Upholds Masimo Corp. Patents Against Apple
- NAI Announces 2023 Top 100 U.S. Universities for Utility Patents

- On Monday, June 3, the US Patent and Trademark Office (USPTO) and the UK Intellectual Property Office (UKIPO) signed a memorandum of understanding (MOU) to collaborate on policies related to standard essential patents (SEPs). The agreement, signed by USPTO Director Kathi Vidal and UKIPO CEO Adam Williams, aims to enhance transparency in the fair, reasonable, and non-discriminatory (FRAND) licensing of technical interoperability standards. It includes cooperation on SEP policy matters, education for small and medium-sized enterprises, outreach to stakeholders, and discussions on incorporating additional jurisdictions. The MOU will remain in effect for five years from the date of signing. Read more [here](#).
- On Tuesday, June 4, the USPTO announced the appointment of Derris Banks as Regional Director of the USPTO's Elijah J. McCoy Midwest Regional Office in Detroit, Michigan. Banks will oversee outreach in the Midwest region, including Illinois, Indiana, Iowa, Kentucky, Michigan, Minnesota, Ohio, and Wisconsin. He will implement the strategic direction of the Under Secretary of Commerce for Intellectual Property and ensure USPTO initiatives are tailored to the region's unique industries and stakeholders. Banks, who joined the USPTO in 1994 and has held various leadership roles, will focus on expanding the innovation ecosystem and supporting nearly 246,000 patented inventors and over 314,000 trademark registrants in the Midwest. He aims to enhance engagement with innovators, entrepreneurs, and creators, fostering a culture of innovation essential for economic growth. Banks assumed his new role on June 2, succeeding James O. Wilson, who will resume his responsibilities as Assistant Regional Director.
- On Wednesday, June 5, the USPTO announced an extension for the comment period on their "Inventorship Guidance for AI-Assisted Inventions." Initially published in the Federal Register on February 13, 2024, the guidance had a comment deadline of May 13, 2024. Due to continued stakeholder interest, the USPTO has extended this deadline to June 20, 2024. Comments submitted between the original deadline and the extension announcement date, June 6, 2024, will still be considered timely.

### **III. Administration Updates:**

- On Monday, June 3, the World Health Organization (WHO) published a report detailing a global survey and action plan on health, innovation, and intellectual property. The report discusses the contentious TRIPS Agreement, revealing that 40% of surveyed countries felt their national laws did not take advantage of TRIPS' flexibility. Article 27 of TRIPS, which deals with patentable subject matter, was the most frequently utilized by these countries. The complete report can be accessed [here](#).

### **IV. Judicial Updates:**

- On Monday, June 3, in an opinion by Judge Reyna, the Federal Circuit affirmed the denial of Google's motion for a new damages trial, rejecting Google's claim that EcoFactor's expert testimony was inadmissible due to an unsubstantiated hypothetical royalty rate and flawed comparability analysis. The court found the royalty rate valid, based on three lump-sum license agreements, corresponding testimony, and an email, noting the licenses were comparable as they involved patents related to the same smart thermostat technology. Judge

Prost dissented, citing issues with the calculation and scope of the lump-sum payments and the comparability analysis.

- On Wednesday, June 5, Bloomberg reported that the USPTO again rejected Apple Inc.'s efforts to cancel two Masimo Corp. patents involved in the International Trade Commission's import ban on certain Apple Watch models. Apple failed to raise new questions about the patentability of US Patent Nos. 10,945,648 and 10,912,502, according to two decisions issued May 30 by a panel of three examiners. These patents cover devices using noninvasive systems to measure blood constituents such as glucose. The USPTO's Patent Trial and Appeal Board and the ITC had previously upheld the validity of these patents and found Apple had infringed them. Apple is appealing the decision at the US Court of Appeals for the Federal Circuit and has moved to tweak its software to work around the ban. Knobbe Martens represented Masimo, while Fish & Richardson PC represented Apple. Read more [here](#).
- On Wednesday, June 5, the European Court of Justice (ECJ) ruled in favor of the Irish fast food chain Supermac's, revoking McDonald's Big Mac trademark in the European Union for poultry products. Previously, the European Union Intellectual Property Office (EUIPO) had partially supported McDonald's trademark, but the ECJ overturned and modified this decision. The ECJ stated that McDonald's failed to provide sufficient evidence of the trademark's use in connection with chicken sandwiches.

## **V. Industry Updates:**

- On Monday, June 4, the National Academy of Inventors (NAI) announced its annual list of the Top 100 U.S. Universities Granted U.S. Utility Patents for 2023, recognizing institutions for their contributions to innovation and intellectual property protection. Paul R. Sanberg, President of the NAI, highlighted the importance of safeguarding intellectual property to maintain U.S. competitiveness in the global innovation landscape. Since 2013, NAI has published rankings starting with the Top 100 Worldwide Universities list, introducing the Top 100 U.S. Universities ranking last year to focus on national innovation. This year, NAI also launched the Top 60 Worldwide Non-profit Research Institutes and Government Agencies ranking. The Top 100 U.S. Universities list is based on data from the United States Patent and Trademark Office, considering all named assignees on patents. The full list can be viewed [here](#).