

Oracle v Rimini

How illuminating were oral arguments?



Editor: Barney Dixon
barneydixon@blackknightmedialtd.com
+44 (0)203 750 6026

Reporter: Ben Wodecki
benwodecki@blackknightmedialtd.com
+44 (0)203 750 6017

Designer: James Hickman
jameshickman@blackknightmedialtd.com
+44 (0)203 750 6021

Contributors: Becky Butcher

Associate Publisher: John Savage
johnsavage@blackknightmedialtd.com
+44 (0)203 750 6021

Publisher: Justin Lawson
justinlawson@blackknightmedialtd.com
+44 (0)203 750 6028

Office Manager: Chelsea Bowles
accounts@blackknightmedialtd.com

Published by Black Knight Media Ltd
Copyright © 2018 All rights reserved



ECTA In Focus

IPPro spoke with several members of ECTA's senior leadership team to discover more about its future



Oracle v Rimini

Oracle v Rimini Street has made it to the US Supreme Court, but how illuminating were oral arguments?

Trade Secrets

US acting attorney general Matthew Whitaker has revealed Huawei has been charged with stealing trade secrets from T-Mobile

p4

Tris v Actavis

The US Court of Appeals for the Federal Circuit has remanded Tris v Actavis back to the US District Court for the District of Delaware for further fact-finding

p5

Eastward Innovations

Innovation is continuing to head eastward, according to the Derwent Top 100 Global Innovators report.

Blockchain patents

Blockchain patent filings more than doubled in 2018, according to research firm Cintelliq

p8

p9

Opposition Standard

The TTAB has relaxed the standard for an interest in a consumer opposition

Latest Events

Pick up your copy of the latest issue of IPPro at these industry events

p20

p23



Subscribe now for free
www.ippromagazine.com

EUIPO Strategic Plan 2025 comment window ends this month

Public commenters only have until the end of this month to comment on proposals for the EU Intellectual Property Office (EUIPO)'s 2025 Strategic Plan.

The comment window, which opened in December last year and closed on 28 February, gives the public the opportunity to share their views on the EUIPO's 2025 Strategic Plan, specifically its three 'strategic drivers' - an interconnected, effective and reliable IP system; customer centric IP Services; and dynamic organisational skill sets and effective support to services.


The aim of the plan, according to the EUIPO, is to "help companies to gain full benefit from their innovation and creativity, whether in Europe or the global marketplace, having regard to technological advances shaping business models".

The EUIPO says it wants to ensure it is an attractive and reliable entry point to IP protection covering a broad range of IP rights.


In relation to the first of its strategic drivers—an interconnected, effective and reliable IP system—the EUIPO says that "EU businesses, citizens and other IP stakeholders need an interconnected, effective and reliable IP system both within the EU's internal market and in the global environment in which they increasingly operate".


It says that its cooperation with other national authorities and supranational organisations such as the European Patent Office and the World Intellectual Property Organization is resulting in the convergence of both tools and practices. However, despite such increases, the EUIPO has asked for suggestions and comments on how the EUIPO can sustain and extend the harmonisation of its tools and practices.


The EUIPO is also seeking comment on how it can encourage small to medium-sized enterprises to enhance their competitiveness through better use of IP rights, strategic actions and how new technology will affect the future of work and how the EUIPO should respond to this.




IPzen
Intellectual Property Made Easy


 +33 (0)1 84 17 45 32

 contact@ipzen.com

 www.ipzen.com

Case Management 


- Manage files online
- Track activities
- Attach documents
- Share Information

Trademark Management 


- Access your portfolios online
- Automatically calculate deadlines
- Integrate trademark data easily

Deadline Tracking 


- View all deadlines in a snap
- Select people and delegate task

Domain Name Management 

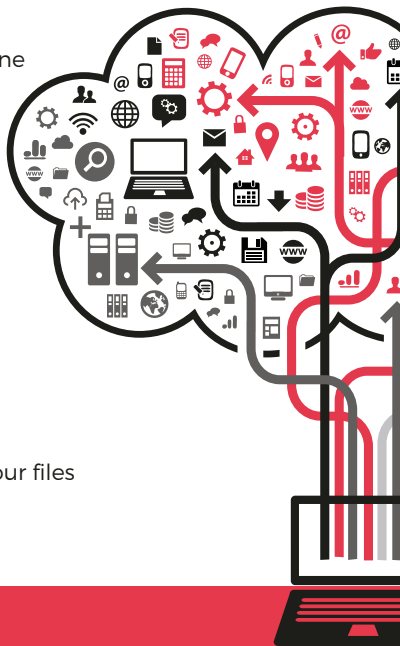
- Manage your domain names online
- Track deadlines
- Sort domain names by category
- Check availability online

Watch Services 

- Trademarks
- Domain names
- Social media

Integrated Invoicing 

- Generate invoices directly from your files
- Consolidate files into a invoice
- Track payments



YOUR IP SOFTWARE SOLUTION IN THE CLOUD

3 IPPro

www.ippromagazine.com



Whitaker charges Huawei with stealing T-Mobile trade secrets

US acting attorney general Matthew Whitaker has revealed Huawei has been charged with stealing trade secrets from T-Mobile.

In a statement from the US Department of Justice, Whitaker explained that Huawei and its US affiliate have been charged with theft of trade secrets conspiracy, attempted theft of trade secrets, seven counts of wire fraud, and one count of obstruction of justice.

The 10-count indictment details Huawei's efforts to steal trade secrets from T-Mobile, as well as its alleged obstruction of justice following the threat of a lawsuit. The alleged conduct is believed to have taken place between 2012 and 2014.

The indictment includes an excerpt from an internal Huawei announcement from July 2013, which was seized by the FBI which states that employees would receive a bonus if they succeeded in stealing confidential information from other companies.

Whitaker said: "As I told Chinese officials in August, China must hold its citizens and Chinese companies accountable for complying with the law."

"I'd like to thank the many dedicated criminal investigators from several different federal agencies who contributed to this investigation and the Department of Justice attorneys who are moving the prosecution efforts forward. They are helping us uphold the rule of law with integrity."

First assistant US attorney Annette Hayes of the Western District of Washington said the indictment "indictment shines

a bright light on Huawei's flagrant abuse of the law—especially its efforts to steal valuable intellectual property from T-Mobile to gain [an] unfair advantage in the global marketplace".

Hayes added: "Fair competition and respect for the rule of law is essential to the functioning of our international economic system."

Huawei allegedly attempted to steal information on T-Mobile's phone-testing robot, Tappy, in an attempt to build its own version to test its handsets. After its criminal activity was discovered and the threat of a T-Mobile lawsuit loomed, Huawei alleged that it was, in fact, the work of rogue actors within the company.

Whitaker is the second attorney general to take action against a Chinese company in recent months, after Jeff Sessions, who was fired by president Trump in November charged Fujian Jinhua Integrated Circuit Company and United Microelectronics Corporation with stealing trade secrets from a US semiconductor developer.

If convicted, a corporate entity could be punished by a fine of up to \$5 million or three times the value of the stolen trade secret, whichever is greater.

Wire fraud and obstruction of justice are punishable by a fine of up to \$500,000.

US attorney Brian Moran has been recused from this case due to legal representations he undertook before he joined the Department of Justice. In his place, Hayes will act as US attorney.

Tris v Actavis dispute sent back to district court

The US Court of Appeals for the Federal Circuit has remanded Tris v Actavis back to the US District Court for the District of Delaware for further fact-finding.

The dispute centred on the drug, Quillivant XR, which is an extended release methylphenidate for the treatment of Attention Deficit Hyperactive Disorder is held by Tris.

Actavis submitted an Abbreviated New Drug Application to the US Food and Drug Administration to seek approval for a market generic version of Quillivant XR.

Tris then sued Actavis for infringing five of its US patents (8465765, 8563033, 8778390, 8956649, and 9040083), only for the district court to find all asserted claims of Tris' patents to be invalid under section 103 of the US Patent Act.

Tris appealed to the federal circuit, arguing that the formulation of Quillivant XR provides a 45-minute

onset of action and a 12-hour duration of effect with a single mean peak PK profile and (2) a 12-hour duration of effect with an early Tmax of about 4 to 5.25 hours.

The district court had originally found these arguments irrelevant because Tris "had not performed the proper comparison to the closest prior art".

The federal circuit has now sent the case back to the district court, ruling that the lower court's decision was based on "inadequate fact-finding".

Tris founder and CEO, Ketan Mehta, said the firm was "pleased" that the court vacated the ruling.

Mehta said: "We are confident that, based on the reasoning in the court's opinion, Actavis will not be able to meet its burden to invalidate the patents in the upcoming district court proceedings."

Dreyfus
Intellectual Property
in an Innovative World

Trademarks
Domain names
Social Networks

Privacy
Technology Transactions
E-commerce

Patents
Copyrights
Designs

78, avenue Raymond Poincaré
75116 Paris, France
contact@dreyfus.fr
t. +33 (0) 1 44 70 07 04
f. +33 (0) 1 40 06 99 64
Paris · Lyon · Strasbourg

www.dreyfus.fr



PTAB reverses unpatentability ruling over Facebook notification patent

The Patent Trial and Appeal Board (PTAB) has reversed the rejection of a Facebook patent that covered specific notifications for a user.

The patent covers a system that provides relevant notifications to a social media user based on the user’s location and their social information.

A US Patent and Trademark Office examiner found that claims one, two, four through 14, 16 and 17 were unpatentable under section 101 of the US Patent Act.

The examiner said that the collection, storage, and analysis of information “[does] not amount to significantly more than the judicial exception”.

The examiner referred to such functions as “understood routine conventional activities previously known to the industry”.

Facebook appealed the rejection, resulting in the PTAB reversing the examiner’s decision on all disputed claims. The PTAB stated that the examiner lacked evidentiary support to show that such claims were well-understood.

Petošević opens new office in Minsk

Intellectual property law firm Petošević has opened a new office in the Belarusian capital of Minsk.

The new office which brings the firm’s total to 17, will be overseen by the firm’s Russian head of office, Tatyana Kulikova.

The new office’s team will include Daria Dunai, Anastasia Khioni, and Tatiana Konovalova, who will receive support from the firm’s Moscow, Kiev and Tashkent offices.

The firm says the new office’s inception comes about after “an increasing demand for our services, especially patent prosecution, in the region”.

Commenting on the announcement, the firm’s chairperson and CEO, Slobodan Petošević, said: “The focus of Petošević going forward will clearly be split between two large regions—East European EU Region (including the non-EU countries in the Western Balkans) and the ‘Russian speaking region’ (Eurasian Economic Union and surrounding countries).”

“All the countries we cover are very different environments now from what they were 20 years ago.”

Using our ample experience, we decided to continue to improve our position as a highly specialised provider of IP services in the new EU countries, and more than ever—in the Russian speaking region (former USSR).”

He added: “We already cover more than 80 percent of the territory of the Eurasian Economic Union with our own offices, and have a genuine and significant local presence in important countries such as Ukraine and Uzbekistan”.

“With tough quality and working standards, and dedication to our ever-growing team and our clients, we are ready for challenges that 2019 and the following years will undoubtedly present.”



LG loses and Apple wins in Court of Appeal interface patent rulings

The US Court of Appeals for the Federal Circuit has affirmed two Patent Trial and Appeal Board (PTAB) rulings related to interfaces for devices.

Separately, LG Electronics and Apple sought an inter parties review on two patents belonging to Conversant Licensing Wireless that related to interfaces for applications on devices.

Conversant had sued both Apple and LG separately for patent infringement, which led to them both filing for inter parties reviews.

The PTAB conducted the request reviews and issued final written decisions that found Apple's claim against Conversant's US patent was correct but found LG's claim was rejected.

LG appealed the PTAB's decision at the US Court of Appeals for the Federal Circuit. Conversant also appealed the PTAB's decision, but from the Apple dispute. The Court of Appeals affirmed the PTAB's ruling in both instances.

The Court of Appeals for the Federal Circuit agreed with the PTAB's decision to invalidate Conversant's Schnarel and Aberg, and its decision to deny LG's claims based on Blanchard.

Costs were awarded to both Conversant and Apple as successful appellees in respective disputes.

Google, Microsoft, and IBM utilise AST's IP3 programme for patent purchase

Almost 20 companies including Google, Microsoft, and IBM spent a collective \$3 million on 32 patent families in 2018 through Allied Securities Trust (AST)'s IP3 programme.

AST's IP3 program is a fixed price, fixed term, collaborative patent buying scheme.

Patents sold through IP3 in 2018 come from various technology areas, including blockchain, artificial intelligence/machine learning, and wireless.

Overall in 2018, 31 deals were acquired through IP3, which ranged from \$2,500 to \$255,000, with the average price of a patent family sold being \$99,000.

AST's CEO Russell Binns commented: "IP3 2018 was our most successful iteration of our fixed price, fixed term patent purchase program to- date, with more participants, more capital committed from our membership, and more patent families acquired. Our membership, which includes many of the world's leading technology companies, was very impressed with the wealth of this year's submissions from patent owners and the results underscore the desire among our diverse group of members to collaborate on fixed priced, fixed term buying programs that provide a quick and efficient process for purchasing patents."

IBM's patent strategy and defence director, Andy Wojnicki, added: "AST's third fixed price patent purchase program, IP3 2018, built on the experiences of AST's two previous fixed price programs. The result was an even more efficient and cost-effective way to close patent transactions. Transaction ease and cycle time, breadth of patents available to transact, and haggle-free terms and pricing are some of the key advantages of the IP3 approach."

Any assets that weren't acquired through IP3 2018 can still be purchased through AST's standard buying process.



Innovation heading east, says Derwent report

Innovation is continuing to head eastward, according to the Derwent Top 100 Global Innovators report.

The report, published by Clarivate Analytics, shows Asian companies leading Derwent's top 100 innovators list with 48 companies, compared to the 33 based in the US.

This year's report showed an eight percent reduction in the number of US companies making the list, with 36 the previous year.

Japanese companies dominated the list, with 39 percent. The US followed closely behind with 33 percent. Both nations account for 72 percent of the organisations on the list—with mainland China only accounting for three percent. Countries that have remained staples in the list, such as France, Germany and South Korea, are this year joined for the first time by Russia through antivirus and internet security software company Kaspersky.

One of the fastest growing technology sectors that is strongly represented on the list is 5G connectivity. The report says the technology has “the potential to transform digital communications beyond personal entertainment to society-building”.

According to figures seen in the report, the number of patent families related to 5G from the 100 companies on the list has

skyrocketed since 2015, increasing from less than 100 to well over 1000

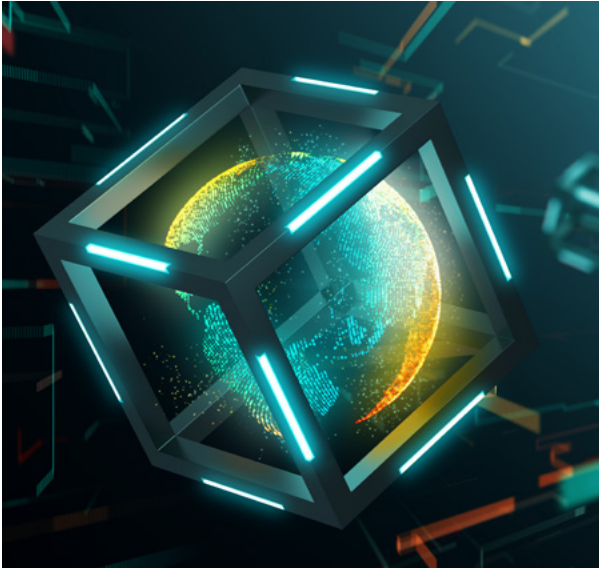
The second fast-growing technology that the report focuses on is artificial intelligence. According to Derwent's findings, 31 of the top 100 companies on the list have “significant numbers” of AI inventions in their total portfolios, with an average of 28 inventions for each of these companies.

Joining Kaspersky in appearing on the list for the first time, is Mitsubishi Chemical Corporation, BYD from China, Cisco.

Along with BYD, the number of Chinese companies on the list has greatly increased this year, with Xiaomi joining the likes of Huawei on the list.

Commenting on the report's findings, report contributor and patent analyst, Bob Stembridge, said: “Tracking patent activity gives a detailed picture of an organisation's commitment to innovation through analysing its inventions with potential for commercialisation.”

“This year's findings show that leading organisations continue to differentiate themselves through a laser-focus on high-value and high-impact innovation and a full embrace of emerging technologies.”



Blockchain patents more than double in a year

Blockchain patent filings more than doubled in 2018, according to research firm Cintelliq.

According to Cintelliq, 3,426 blockchain patents were published in 2018, more than double the 588 patents published in 2017. Cintelliq's figures show that since 2008, there have been over 5,500 patents filed and granted by over 1,400 assignees.

China holds the most in terms of number of blockchain patents filed, with 41 percent, closely followed by the US with 32 percent.

Cintelliq's report says around 10 percent of these patents are granted, with Korea and the US holding 71 percent of granted patents.

More core technology patents and core/application patents are filed in the US, according to Cintelliq, whereas more application and generic blockchain patents are filed in China.

Various industries have caused the increasing interest in blockchain, with pharmaceutical, silicon vendors, and healthcare some of the notable industries, according to Cintelliq. The number of new inventions in blockchain patents accounts for the bulk of published blockchain patents according to Cintelliq, whose figures show over 2,000 new inventions related to blockchain have been published.

Cintelliq says that the number of blockchain patents will continue to increase over the next few years due to "assignees develop[ing] more inventions and seek[ing] IP protection worldwide".



Arcadia Biosciences patent lawsuit dismissed from District Court

Arcadia Biosciences's patent lawsuit against Arista Cereal Technologies has been dismissed by the US District Court for the Southern District of New York.

Arcadia sued Arista in September last year, alleging that three of Arista's wheat-related patents should have included Arcadia inventors, therefore, breaching certain confidentiality obligations.

Arista argued that Arcadia had omitted various facts in its allegations and sought dismissal of Arcadia's lawsuit. Senior district judge Jed Rakoff ruled in favour of Arista and dismissed Arcadia's lawsuit in its entirety.

This case is the second legal battle between the two firms after the Patent Trial and Appeal Board issued a judgement against Arcadia on the priority of invention in an interference proceeding in relation to wheat-related patents.

Commenting on the latest victory, Pete Levangie, CEO of Bay State Milling, which owns an exclusive licence of the dispute patents, said: "We fully support Arista in their efforts to defend their intellectual property of this innovative ingredient, and we are committed to ensuring our collective success in the North American marketplace."



EURid to cease GB domain registrations in no-deal Brexit

The European Registry for Internet Domains (EURid) will not allow the registration of any new domain names where the registrant country code is either GB/GI in the event of a no-deal Brexit.

The UK's prospective withdrawal agreement was rejected in a vote on the deal on 15 January by a margin of 230 votes, the biggest government defeat in history.

In the event of the UK leaving the EU with no-deal, EURid says it will not allow registration of any new domain name where the registrant country code is either GB/GI from 30 March.

If no-deal occurs, EURid will notify by email both GB/GI registrants and their registrars about the forthcoming

non-compliance of the data associated to their domain name within the .eu regulatory framework. EURid will then notify registrants on 30 March to remind them that their domains will no longer be in compliance with the .eu regulatory frameworks.

Registrants who do not demonstrate their eligibility will be deemed ineligible by EURid and have their domain names withdrawn. One year after a no-deal scenario, all affected domains will be revoked and become available for general registration.

In the event that the UK secures a deal before leaving the EU, the aforementioned occurrences will happen from 1 January 2021.

Energizer successfully opposes ‘confusingly similar’ New Zealand trademark

Battery maker Energizer has successfully opposed the registration of a New Zealand trademark that it claimed infringed its intellectual property. Pakton Developments owns the international registration of IP Energizer and requested an extension of protection in New Zealand.

The Intellectual Property Office of New Zealand (IPONZ) published the designation for opposition purposes. Energizer opposed the registration, claiming that the mark would likely cause confusion amongst consumers.

Pakton Developments operates as an electric fence component manufacturer. The opposed mark is registered in Australia and has had no opposition.

Assistant Commissioner of Trademarks at IPONZ, Natasha Alley found the opposed mark to be conceptually similar to the Energizer name, as well as both similar in appearance and sound.

Alley granted Energizer’s opposition and the mark was not registered.

Pakton Developments was ordered to pay NZD 1650 (\$1114) total costs to Energizer.

Alibaba referred more than 1,500 leads to law enforcement in 2018

Ecommerce giant Alibaba referred more than 1,500 leads to law enforcement authorities in 2018, leading to the arrest of nearly 2,000 suspects, according to Alibaba’s Annual IP Protection Report. The arrests involved a total of RMB 7.9 billion in estimated product values. Alibaba says in 2018, among those listings proactively removed by Alibaba, 96 percent were eliminated before a single sale took place.

Some 96 percent of takedown requests submitted by rights holders were processed within 24 hours, according to the ecommerce company. Alibaba’s efforts to identify and remove potentially problematic listings in 2018 contributed to a 32 percent year-over-year decline in the number of notice and takedown requests submitted by rights holders. On Alibaba’s Taobao website, the total rate of refunds due to suspect intellectual property in products declined by 26 percent.

Former CITMA and EPO presidents to speak at INTA’s Europe Conference

Several key intellectual property leaders including Kate O’Rourke and Benoît Battistelli will be speaking at the International Trademark Association (INTA)’s Europe Conference.

Former Chartered Institute of Trade Mark Attorneys president O’Rourke, and former European Patent Office president Battistelli will speak at the conference, which takes place on the 18 to 19 February in Paris. O’Rourke will be giving a speech on Brexit, while Battistelli, who is currently president of Conseil d’administration du Centre d’études internationales de la propriété intellectuelle (CEIPI), will be interviewed by INTA’s new president David Lossignol on the future of IP.

GroupM and WPP France CEO, Mathieu Morgensztern, and founder and CEO of Pyrates Smart Fabric, Regina Polanco, will be the event’s keynote speakers.

The keynote speakers, who will talk on topics that reflect the conference’s central theme of embracing change are just some of the 40 speakers who come from various industries.

Morgensztern will be joined by Red Fuse’s Europe, the Middle East and Africa managing director, Jason Oke, to talk about how brands are adapting to change across the world. Polanco, who will speak on the second day, will discuss how companies are embracing change.

INTA CEO Etienne Sanz de Acedo said: “The world is changing fast for brand owners and trademark professionals.”

“The Europe conference will be providing attendees with new perspectives that can alter the narrative of their brands and their trademark teams given the current and future environment.”

Sessions at the conference will include the changing role of trademark teams, monetising IP assets, the impact of European copyright reform on creative works, and solutions to fight counterfeiting.

Uncovering actionable intelligence to drive informed decisions.



Core Intellectual Property Investigation services including:

- Anonymous Domain/Trademark Acquisitions
- Distributor/MLM Compliance Investigations
- U.S. Importer/Import Records Analysis
- Unauthorized Supplier Identification/Stock Lot Locate (globally)
- Third-Party Infringement Litigation Support
- Trademark Use Investigations
- Unauthorized Seller Identification
- Counterfeit Product Investigations

For more details on these or our other service offerings, please visit our website or contact us at info@vaudra.com.

+1 704-895-3939 ▪ www.vaudra.com



ECTA: a modern association for Europe

ECTA

The European Communities Trade Mark Association (ECTA) is at the forefront of intellectual property rights within the EU. The association is extremely proactive when it comes to the ever-changing IP world. With Brexit, new technologies, and legal reforms threatening to alter the way in which rights holders enforce, ECTA is more than prepared to face the world's new challenges.

Between June of 2017 and December of 2018, ECTA produced various position papers on draft guideline changes, the digital single market, free trade zones and copious amounts of content. The speed and efficiency of its committees and staff are excellent.

ECTA is a very active association that carries out extensive work on various topics including the protection and use of trademarks, designs, and domain names in and throughout the EU.

According to Mladen Vukmir, ECTA's second vice president ECTA will "maintain and increase its preeminent role in the IP world as a nimble, agile and international relevant IP organisation" over the next five years.

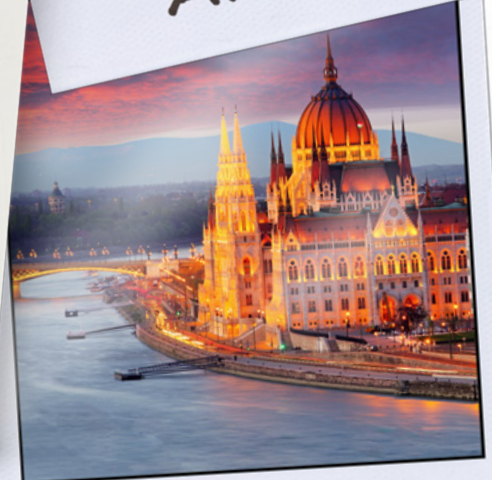
As Europe is reshaped and ECTA along with it, IPPro spoke with several members of the association's senior leadership team to discover more about the future of the preeminent European trademark association.



Edinburgh



Athens



Budapest

Sozos-Christos Theodoulou | President

What are the key tenets of ECTA? How does it operate and what are the organisation's goals?

ECTA is a professional organisation, which stands for good legislation and practice in the wider field of IP. Founded in 1980 to cover trademarks, ECTA, now approaching its 40th anniversary, has substantially developed into a forum of discussion for trademarks, industrial designs, copyright, geographical indications, anti-counterfeiting and internet-related issues. ECTA maintains an open dialogue with the EU Commission, the EU IP Office, the World IP Organization and various national IP offices, with regard to the monitoring and progress of IP legislation and practice. It regularly submits position papers to these authorities and participates in many surveys and questionnaires, in order to state its opinion and assist in the better functioning of the IP legal systems in Europe.

Internally, the council is ECTA's primary decision organ, while the management committee, based in ECTA's headquarters in Brussels, runs ECTA's everyday business. Management meets every two to three months and holds regular conference calls, on top of the plethora of emails exchanged daily. ECTA's numerous committees, run by skilled leaders and top professionals in IP, deal with specialised matters and their activity is the backbone of the association.

What is the future for ECTA? Where are you taking the organisation in 2019?

At this point, ECTA needs stability. While the association changes its registered office and attempts to better organise itself internally, it would not be wise to take unnecessary risks. That being said, ECTA is planned to participate in more than 50 different events around the globe in 2019 (bilateral and multilateral meetings, conferences, seminars, workshops, webinars, and more), where it will be represented by many of its members and at which it is expected to actively deliver its expertise. The ECTA Annual Conference will take place in Edinburgh, Scotland, between 26 and 29 June 2019, and in October I will have the honour to welcome the Autumn Council Meeting in my hometown, Larnaca, Cyprus for the first time ever!

The association will be holding bilateral meetings with the EU Commission, the EUIPO and the WIPO. It will also organise a roundtable in Alicante in February and a workshop in Munich in March, as well as a couple of more workshops in September and in December.

Specific information will be provided in due course on our website, so stay tuned!

ECTA is planned to participate in more than 50 different events around the globe in 2019, where it will be represented by many of its members to actively deliver its expertise



Anette Rasmussen | First vice-president

How has ECTA's expansion gone in the past 5 years?

There is an increased interest in the membership in our association from all around the world, we now have regular members from over 85 countries and counting.

We offer more membership benefits than before and have diversified our publications, type events we organise, our internet presence and web content.

ECTA is organising more events throughout the year, in addition to the annual conference and autumn council meeting we hold regular roundtables, workshops and retreats several times a year. These events are dedicated to very interesting and current topics, recent legislative developments and they are free of charge for members and non-members alike. However, only the members are able to access the recordings of these events, if they weren't able to attend in person.

Where is the organisation heading in 2019?

In terms of projects, participation in meetings with authorities etc, ECTA will continue to be very active and participate strongly in the IP community.

ECTA moves in pace with time and modernises whenever it is necessary. For 2019 ECTA will be implementing a new IT-system for the functions of the secretariat, which will allow for better service of the membership and all the activities of ECTA. Also, the new IT will lead to a new and more interactive ECTA website. The process is now very forward and we expect to launch this well before our Edinburgh conference.

With this new website and administration system, we have tried to take on board as many wishes and needs, which we have received from our membership. ECTA is revising its internal processes and workflow to continue its dynamic presence and be on top of the pace of the changes surrounding us.

How are brands tackling the many issues in Europe right now?

Brands are realising that in the current environment it is no longer possible to tackle the many issues and the multiplicity of factors arising in IP in Europe on their own. They are becoming more involved with the user associations like ECTA and others, so that they could have their voices heard and could have a true impact on the future of IP in Europe and around the world.



ECTA Statistics

800 attendees at the 2018 Annual Conference - a record number of registrants.

33 percent of the delegates attended from non-European countries.

Edinburgh - the city where 2019's ECTA conference will take place.

Carolin Kind | Secretary general

As secretary general of ECTA, what are the toughest challenges facing your office right now?

We have a lot of important projects running as far as our administration is concerned.

One project that keeps me particularly busy as secretary general is our legal restructuring. ECTA is currently incorporated as a limited liability company in the UK with a branch office in Brussels. We are about to establish a new association under Belgian law that will take over the assets and activities of ECTA. This is mainly due to the fact that our office has been located in Brussels for many years.

It, therefore, makes sense that the association also moves to Belgium. Brexit plays a role in our considerations as well.

The new legal structure of ECTA also requires new articles of association. We are currently reviewing and modernising the existing articles of association, including membership categories and many other aspects. Our aim is to achieve simplification and transparency for our members.

How is ECTA positioning itself for 2019? What are some of your key initiatives on the administrative side?

This year will be a particularly important year for ECTA as we will finalise two major projects, namely our new administrative tool and our new website.

Our new administrative tool will revolutionise the way we work in the secretariat. It will also provide a common working platform for our committees. Furthermore, it will enable an online membership application process. The new system will, therefore, be a milestone for our staff, but also for all members as well as committee members. The internal and external communication be much easier and quicker.

The ECTA website has been completely reviewed and modernised. It has a fresh look, is much easier to navigate and will meet the demands of our fast moving times. We have put a lot of effort and resources into this project and are pleased that it will go live very soon.

Our next annual conference in Edinburgh this June will be one of the highlights we publish on the brand new site. We encourage all our members to use it and to see for themselves as soon as it is ready!

How is using ECTA utilising IT tools in 2019?

The new working tool and the new website are without any doubt the main achievements for 2019 in this respect. But we are already investigating further possibilities in order to get ECTA ready for the near future and the years to come.

For example, we are currently working on our new conference app which will be more advanced than in the past. It will feature many additional options and allow more interaction.

We are even planning to establish a permanent ECTA app. This app would not only enable members to get all the information they need before and during the Annual Conference, but also to stay informed on our association as well as our further events and activities. The potential of such an app will have an effect on our entire communication strategy and would also enable our members to communicate amongst themselves throughout the year. The new website and the app would then be the two main sources of information for our members.

Also, podcasts are under discussion, and we are currently investigating how we could implement this. Our members already have a lot of work-related texts to read, and sometimes it is nice to just sit back and listen to interesting news and interviews.

You see, a lot is changing and we always welcome new ideas in order to make ECTA more modern and attractive for our members!



Jonathan Agmon | Secretary of the internet committee

Tell me about some of the work ECTA's internet committee does, what are some of the biggest issues right now?

The ECTA internet committee works to identify those Internet related issues that affect intellectual property rights of the ECTA members. The committee assesses legal, technological, structural and other changes to the internet, proposes studies and prepares comments, which the ECTA leadership approves and the ECTA membership can benefit from. During the committee's work various internet experts are asked to make presentations on various issues so committee members will be able to assess how changes to the internet affect ECTA members.

Committee members are asked to study various issues and raise suggestions for studies and reports that may benefit the membership. Since the committee is made of experts on the field, many of the issues we deal with are those that we encounter in our practice. Discussions lead to the generation of new projects, which when approved are undertaken by the committee members and later provided to the association and its members.

The committee's current subjects reflect primarily the ongoing changes to privacy issues in Europe with the advent of the General Data Protection Regulation (GDPR). The members are working on assessing the impact of the GDPR on the WHOIS system and on the European ccTLDs. In this regard committee members follow developments in a number of ICANN groups in view of the ongoing discussions relating to URS/UDRP reform. As ECTA works closely with WIPO, the committee is working on preparing submissions for WIPO's latest effort to study the interaction between geographical indications and domain name.

The committee is also working on providing more information to ECTA members on various online national ADR proceedings relating to ccTLDs. This project is quite unique since there are multiple ccTLDs ADR rules, many of them with unique variations compared with the UDRP. ECTA members will benefit from this study because they can review the unique features of the rule set for each ccTLD they wish file an ADR in and get a better understanding how to file a complaint or manage an ongoing case.

A recent study that the committee was working on related to the admissibility of snapshots from various internet website archives, a project which I found to be very useful in my practice, since it included the study of the position of courts in 21 countries with respect to internet archives.

How has GDPR affected internet activity, specifically in relation to IP, over the past year?

I can clearly say that the GDPR has had a big effect on the working of the committee over the past two years. It has certainly taken a centre stage with many issues, especially those related to domain names, the WHOIS and privacy concerns. These issues were discussed in general by the committee previously but the GDPR shifted the level of discussion and forced these issues to take centre stage. The committee's concerns were the rapid changes that the GDPR would bring.

Trademark owners faced challenges in identifying cybersquatters as ICANN's response to the GDPR included a significant changes to the WHOIS system. The committee took time and effort in studying and responding to these challenges.

I believe that we will continue to be busy with GDPR related issues for the foreseeable future as implementation of these provisions is still ongoing.





Oracle v Rimini: The shifting sands of copyright

Oracle v Rimini Street has made it to the US Supreme Court, but how illuminating were oral arguments?

Ben Wodecki reports

The focus of the high profile Oracle v Rimini Street has shifted more than quicksand. What started out as allegations of infringement has now become an argument over what the term ‘full costs’ means. The high profile and high stakes case has been rumbling since 2010, and may now be coming to an end at the US Supreme Court.

Rimini was found guilty of infringing Oracle’s copyright when it installed PeopleSoft, a human resources management system owned by Oracle, and ordered to pay \$73.9 million to Oracle.

Following a stint at the US Court of Appeals for the Federal Circuit, the US Supreme Court agreed to hear the case in September of 2018. At the Supreme Court, Rimini Street questioned whether the US Copyright Act’s allowance of ‘full

costs' to a prevailing party is limited to taxable costs as the US Court of Appeals for the Eighth and Eleventh Circuit have held, or whether the act also authorises non-taxable costs. Oracle argued that full costs meant paying the full costs and no less.

During oral arguments in mid-January, the justices of the Supreme Court focused on working out the statutory interpretation of the term 'full', with the previously recused Samuel Alito arguing that the term meant nothing.

Brinks Gilson & Lione shareholder Brad Lane called justice Alito's comments "interesting" and added that he could be arguing that 'full' means nothing to increase the universe of potential expense categories that could be compensated under the Copyright Act.

"In other words, he was tracking what the solicitor general and Rimini Street were saying, that 'full' is directed to the amount of each of the enumerated costs in §1920."

Fowler White Burnett shareholder, Joe Englander, notes Alito's use of surplusage in relation to Rimini Street's arguments.

The idea of costs has turned a simple infringement case on its head, meaning what could happen in the future following a particular ruling in this case? Phillips Nizer partner Alan Behr remarked that the overall awarding of costs is "one of a very long list of problems that the current statute provides to practitioners and litigants".

He continued: "Problems like this one will continue to arise until we have a Copyright Act fit for the 21st century."

His concerns were echoed by Lane, who suggests that there should be a mechanism to resolve copyright disputes in a more efficient way, rather than full-blown litigation. He suggests something like a small claims court of copyright disputes or "a different legislative fix" could address recovery of some of the expense items that are the subject of Oracle v Rimini Street.

The outcome of this case could have several impacts on the future of copyright litigation. If the Supreme Court opts to rule in favour of Rimini, then the consensus would likely remain. However, if Oracle descends the Supreme Court's steps victorious, then an increase in copyright litigation could occur.

Lane warns that litigators would be able to seek the expenses of electronic discovery, consultants, contract attorneys who are not members of the firm, and more, in the bill of costs, after the merits have been determined.

"If there is an agreement with Oracle's position, there could be a significant incentive for litigating copyright disputes going forward."

The problem with such litigation, according to Behr, is the lack of "laudable clarity" in amendments to the Copyright Act, which is "in need of comprehensive revision or complete replacement".

Rimini questioned the effectiveness of §505 of the Copyright Act, saying that it is a statute that "does not refer explicitly to witness fees and, under a plain application of Murphy, cannot authorise witness fees".

Rimini's counsel Mark Perry said he believed that the 'full costs' concept of the Copyright Act came from the English copyright statute, which he called "a historic artefact".

But Englander contends that Perry "depended upon the fact that the fact that the text of the statute says 'full costs' and does not specifically say that those full costs include fees or expenses".

In Lane's opinion, the court was "looking favourably upon the argument that §505 of the copyright statute should not be utilised to almost turn a costs petition into a second litigation over what expenses are reasonable and what are recoverable under a broad interpretation of 'full costs'".

So, what is the likely outcome of the case? Englander states that many SCOTUS IP cases are either unanimous or decided by overwhelming majorities, but after reviewing the transcript of the oral hearing, he believes that "this decision will be decided much more closely".

Chief justice John Roberts difficulty following Oracle's arguments and questioning of its interpretation of the term full could indicate his voting intention, but Rimini had its own failings in court.

Rimini alleged that "no single case has ever read the statute the way the Ninth Circuit read it in the Twentieth Century Fox case" but failed to provide evidence of such. Justice Sonia Sotomayor's questioning of this led to laughter in the court.

The ninth circuit's split ruling opened up the type of reimbursed categories of expenses that can be granted as costs, as opposed to the eighth and eleventh circuit rulings that strictly adhere to particular categories enumerated in §1920 of the US Code on judicial procedure.

Predicting an outcome, Lane says the Supreme Court may have taken this case to "reign in the ninth circuit". [IPPro](#)



Lowering the bar: TTAB loosens standing requirements

Katherine Dennis Nye discusses a recent decision by the TTAB that relaxes the standard for what constitutes a real interest in a consumer trademark opposition

In denying a doll maker's motion to dismiss a mother's opposition to the registration of the trademark 'Rapunzel', the US Trademark Trial and Appeal Board (TTAB) has further relaxed the already liberal standard for what constitutes a "real interest" and "reasonable belief of damage" required for standing, allowing a consumer to bring a TTAB opposition proceeding.

As many brand owners are aware, after a trademark application is approved by US Patent and Trademark Office (USPTO) examiners, it is published. During the publication period, third parties that object to the trademark's registration have an opportunity to oppose. Then, even if the trademark registers, third parties may petition to cancel the registration at any time.

A majority of these oppositions and petitions to cancel are based on the opposer's allegations that they own rights in a trademark or trademarks that are confusingly similar to the applied-for trademark. However, a smaller but still significant number of trademark oppositions and cancellations allege that the applied-for trademark is merely descriptive or generic, or in other words, the opposer alleges that the trademark does not serve to identify the source of the applicant's goods or services.

Of course, standing is a threshold issue that must be proven in an opposition or cancellation proceeding—15 US Code § 1064; *Lipton Indus v Ralston Purina*.

The US Court of Appeals for the Federal Circuit, which hears the majority of appeals of TTAB decisions, has set out a liberal threshold for trademark oppositions. Specifically, an opposer has standing if it can show that it has "a real interest in the proceeding" and "a reasonable basis for its belief of damage"—*Ritchie v Simpson* in 1999.

The Federal Circuit has held that a "real interest" is a direct and personal stake in the outcome of the proceeding, or a legitimate personal interest. To satisfy the "reasonable belief of damage" requirement, an opposer's belief of damage is not merely subjective, but rather its belief of damage must have a reasonable basis in fact.

With respect to descriptiveness or genericness claims, the TTAB has interpreted the two-pronged real interest and reasonable belief of damage standard to require that the opposer must be a competitor in the applicant's industry. This is reflected in *Sheetz of Delaware v Doctors Associates*, *Duramax Marine v R.W. Fernstrum & Co*, *Plyboo Am v Smith & Fong*. In those cases, the competitors successfully alleged

standing because they had a direct interest in using the applicant's mark to describe their own goods or services.

In other cases, like *Nobelle.com v Qwest Communications International*, the TTAB held that a petitioner lacked standing to petition to cancel because they were not in a position to use the mark themselves.

On 28 December 2018, however, the TTAB denied a motion to dismiss in *Curtin v United Trademark Holdings*, holding that an opposer need not be a competitor. In that case, United Trademark Holdings had applied to register the trademark 'Rapunzel' for dolls. Rebecca Curtin, an associate professor of IP law at Suffolk University, started an online petition using the hashtag #FreeRapunzel. She opposed the 'Rapunzel' application, alleging that the 'Rapunzel' trademark is merely descriptive or generic for dolls. Critically, however, Curtin is a mother to a young daughter, and is a regular consumer of dolls and other fairy tale toys. Her opposition argues that allowing United Trademark Holdings to register the mark would deny her access to other Rapunzel dolls, and increase her costs for other Rapunzel merchandise.

In denying United Trademark's motion to dismiss, which alleged that Curtin lacked standing to oppose, the TTAB agreed with Curtin that she had sufficiently alleged a real interest in the proceeding and reasonable belief of damage.

The TTAB held that "[c]onsumers, like competitors, may have a real interest in keeping merely descriptive or generic words in the public domain (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved,

thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products."

They further held that her allegations regarding decreased access to Rapunzel merchandise, and the increased costs thereof, were a reasonable factual basis for her belief of damage. At this time, the case remains pending.

This represents a significant step toward allowing nearly anyone to plead the "real interest" and "reasonable belief of damage" necessary for standing to oppose or petition to cancel a trademark registration. While prior decisions had hinted that the opposer's interest need not be beyond the interest of the general public, this represents the first time that a member of the general public has been held to have appropriately alleged standing. Accordingly, trademark applicants seeking to register terms that might be considered arguably descriptive or generic should be aware that the potential field of opposers has now multiplied exponentially.

It remains to be seen whether a significant number of consumers (beyond those consumers who also happen to be trademark law professors) will actually oppose trademarks, given the somewhat technical nature of the proceedings and the costs involved, particularly if retaining counsel. However, it may present another avenue for consumers with grievances to create headaches for businesses. This is especially true given that the TTAB does not require opposers be represented by counsel, and because a petition to cancel a trademark registration alleging genericness can be filed at any time, even decades after registration. [IPPro](#)



In denying United Trademark's motion to dismiss, which alleged that Curtin lacked standing to oppose, the TTAB agreed with Curtin that she had sufficiently alleged a real interest in the proceeding and reasonable belief of damage

*Katherine Dennis Nye
Partner
Neal Gerber Eisenberg*

IPPro



Daily news updates
Fortnightly newsletter
Industry analysis
Conference reports
Interviews with experts

FREE to read

www.ippromagazine.com



46th Global Legal & IP ConfEx

Singapore

events4sure.com/singapore2019

21 February 2019



Oil & Gas IP Summit

London

oilandgasip.iqpc.co.uk

26-27 February 2019



47th Global IP ConfEx & Global GDPR ConfEx

San Francisco

events4sure.com/sfo-feb2019/overview.php

28 February 2019



IP Law Summit

Los Angeles

events.marcusevans-events.com/iplawsummit-2019

10-12 March 2019



Register to attend exclusive Legal\IP & GDPR Conference

*T&C APPLY



SINGAPORE

21 FEBRUARY 2019

GLOBAL LEGAL / IP & GDPR CONFEX



DELHI, INDIA

25 APRIL 2019

GLOBAL LEGAL / IP & GDPR CONFEX

Connecting 300+ In House
Counsels & Law Firms across
the globe

FREE REGISTRATION

www.events4sure.com