
meaning must be shown for a trade dress in a product design to be protectable. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000).

Although Converse noted that it first began using its ‘753 Chuck Taylor midsole trade dress in 1932, the trade dress was not registered until 2013. The Federal Circuit clarified that registered trade dress carries a presumption of secondary meaning prospectively from the date of registration. Prior to the date of registration, the mark owner must show acquired secondary meaning prior to the first infringing use for each accused infringer.

Thus, for infringing uses that began after September 10, 2013, the registration date of the ‘753 mark, Converse is entitled to a presumption of secondary meaning. For uses that began prior to the registration date, Converse must show that it acquired secondary meaning prior to the first infringing use for each alleged infringer, without

the benefit of the presumption. The Federal Circuit proceeded to vacate the ITC’s determination that Converse’s trade dress lacked secondary meaning.

The Federal Circuit further clarified that a six-factor test must be applied to determine if a trade dress has acquired secondary meaning. The test involves weighing the following factors: (1) association of the trade dress with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

In assessing factor (2), the Federal Circuit stated that the most relevant evidence is the trade dress owner’s and third parties’ use in the five-year period before first use or infringement.

The Federal Circuit remanded to the ITC to further analyze secondary meaning.

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Supreme Court Report

Sandip H. Patel

In *Oil States Energy Services, LLC v. Greene’s Energy Group, LLC, et al.*, Justice Thomas, writing for a 7-2 majority of the Supreme Court, explained that inter partes review proceedings do not violate Article III or the Seventh Amendment of the Constitution. 138 S. Ct. 1365 (2018). But his opinion for the majority invited confusion and delay, upon the brink of which the Federal Circuit now stands. This stems from Oil States’ failure to

explicitly challenge, in the broad question its certiorari petition presented, the retroactive application of inter partes review to its patent—a patent that issued before the procedure existed. Oil States did not contest that cancellation of its patent through inter partes review in such circumstances was a putative “taking without just compensation” and denial of due process. The Supreme Court suggested as much, yet refrained from commenting further. *Id.* at 1379.

Supreme Court Decision Invites Confusion and Delay

The Takings Clause of the Fifth Amendment states that private property shall not be taken for public use without just compensation. Contemporary Supreme Court decisions state that patents are property for purposes of the Takings Clause, *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627, 642 (1999), and that patents cannot be appropriated by the government without just compensation. See *Horne v. Dep’t. of Agric.*, 135 S. Ct.

2419, 2427 (2015). Also, a 90-year-old Supreme Court decision posits that laws retroactively eliminating a patent infringement claim would raise concerns under the Takings Clause. *Richmond Screw Anchor Co. v. United States*, 275 U.S. 331, 345 (1928). Unsurprisingly, therefore companies often pursue patents and forego trade secret protections with an expectation the patent laws will not so fundamentally change as to eviscerate the investment in disclosing the invention to the public in exchange for the patent.

The Court's refrain in *Oil States* did not go unnoticed. Patent owners, who, like *Oil States*, similarly lost patents in inter partes review proceedings, have since challenged the constitutionality of those proceedings relative to their lost patents—patents that issued from applications filed before the effective date of the America Invents Act (AIA), which authorized these reviews. One such appeal pending before the Federal Circuit concerns Genentech's patents covering methods of purifying therapeutic antibodies. Other pending appeals concern AbbVie's patents covering therapeutic administrations of its Humira® drug product. In each, the patent owners lost inter partes reviews. And in each, the patent owners have seized on the Court's opinion to raise constitutional challenges.

The Federal Circuit recently issued orders, inviting the government to defend the constitutionality of the proceedings. Specifically, the court stayed both appeals and explained its statutory obligation to certify to the Attorney General that a party is questioning “the constitutionality of an Act of Congress in a proceeding in which the United States ... is not a party.”¹ Having certified that fact, the court directed the Attorney General to advise whether the government would intervene. In *Genentech*, the Attorney General moved² to intervene, and recently

filed a brief³ defending the constitutionality of the proceedings. In *AbbVie*, the Attorney General, in late November, moved⁴ to intervene and is expected to file a brief similar to its *Genentech* brief.

The Attorney General's *Genentech* brief argues that inter partes reviews do not newly expose pre-AIA patents to post-issuance administrative review, but merely alter procedures and the forum for that review—alterations that nevertheless comport with principles of due process. Importantly, according to the brief, the proceedings do not alter any substantive provisions governing patentability determinations but rationally advance a legitimate legislative purpose in “protect[ing] the public's interest in avoiding erroneously granted patents that allow private parties to monopolize ideas that properly belong to the public at large.”⁵ The brief also rejects the Fifth Amendment challenge, stating the Office's cancellation of a patent through inter partes review is merely a determination that the patentee never had a valid property right, and not meaningfully different than a district court judgment that the patent is invalid.⁶ In both cases, according to the brief, “there was nothing for the government to take.”⁷

Congress devised the AIA statute with the Patent Office's input. It is therefore no mystery that the legislative and executive branches of the government considered the proceedings constitutional. Indeed the two branches devised a separate review proceeding available only for patents applied for after the effective date of the AIA, see 35 USC §§ 321–329 (post grant review), underscoring an intention that pre-AIA patents are subject to inter partes reviews. The Department of Justice and the Patent Office reaffirmed these views in the brief they filed in the *Oil States* case.⁸ The Supreme Court's opinion unfortunately has invited delays in the *Genentech* and *AbbVie* appeals (and

in other pending and future appeals) and unnecessarily so if the Court's invitation turns out to have been illusory. More recently, when this due process issue arose in early October, the Court issued an order summarily denying an unopposed certiorari petition. *Advanced Audio Devices, LLC v. HTC Corp.*, 721 F. App'x 989 (Fed. Cir. 2018), *petition for cert. denied*, 586 U.S. ___ (Oct. 9, 2018) (No. 18-183) (denying a petition questioning “[w]hether inter partes review of patents filed before enactment of the Leahy-Smith America Invents Act violates the Takings Clause of the Fifth Amendment to the U.S. Constitution”).

Most of the thousands of patents subjected thus far to inter partes review petitions issued from applications filed before the effective date of the AIA. Over time, that will change. But for now nobody should be surprised if patent owners appealing Patent Office decisions that canceled their pre-AIA patents question the constitutionality of the proceedings. The Attorney General's brief in *Genentech* identifies nearly two dozen other pending appeals posing the same question.⁹ No matter what, the Federal Circuit decides in *Genentech*, *AbbVie*, or some other appeal, the Supreme Court is going to have to address this issue. It's a pity, perhaps, that it did not do it in *Oil States*.

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1. *Genentech, Inc. v. Hospira, Inc.*, No. 20181933, at 2 (Fed. Cir. Aug. 24, 2018) (order) (citing and quoting 28 U.S.C. § 2403(a)); *AbbVie Biotech., Ltd. v. Coherus BioSciences Inc.*, Nos. 20172304, 2305, 2306, at 2 (Fed. Cir. Oct. 31, 2018) (order) (same); *AbbVie Biotech., Ltd. v. Boehringer Ingelheim Int'l GmbH*, Nos. 20172362, 2463, at 2 (Fed. Cir. Oct. 31, 2018) (order) (same).
2. Unopposed Motion of the United States to Intervene, *Genentech, Inc. v. Hospira, Inc.*, No. 20181933 (Fed. Cir. Sept. 24, 2018).

3. Brief for the United States, *Genentech, Inc. v. Hospira, Inc.*, No. 20181933 (Fed. Cir. Nov. 19, 2018).
4. Unopposed Motion of the United States to Intervene, *AbbVie Biotech., Ltd. v. Coherus BioSciences Inc.*, Nos. 20172304, 2305, 2306 (Fed. Cir. Nov. 30, 2018); Unopposed Motion of the United States to Intervene, *AbbVie Biotech., Ltd. v. Boehringer Ingelheim Int'l GmbH*, Nos. 20172362, 2463 (Fed. Cir. Nov. 30, 2018).

5. Brief for the United States, *supra* note 3, at 11.
6. *Id.* at 12–13.
7. *Id.* at 33.
8. See generally, Brief for the Federal Respondent, *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC, et al.*, 138 S. Ct. 1365 (2018) (No. 16712).
9. Brief for the United States, *supra* note 3, at 15 n.1.



PTO Practice

Christina Sperry and Elissa Kingsland

Understanding Priority Claims for U.S. Patent Applications

In general, for examination purposes at the U.S. Patent and Trademark Office (USPTO), a priority claim determines the priority date of a patent application. But why is that important? Because the priority date effectively determines what references can and cannot be asserted as prior art against a patent application during its examination. That is, the priority date draws a line in the sand for prior art, and this line cannot be crossed.

This column outlines post-America Invents Act (AIA) procedures applicable to applications and issued patents filed on or after March 16, 2013.

A priority claim is made to an earlier-filed patent application. For example, an Applicant can claim priority in a later-filed patent application to earlier-filed U.S. provisional applications, U.S. nonprovisional applications, PCT applications, and/or foreign (*i.e.*,

non-U.S. Paris Convention signatory) applications. In order for a priority claim to be effective, certain conditions must be met. These specific conditions are set forth in 35 U.S.C. §119(e) and 37 C.F.R. § 1.78(a) for a priority claim to earlier-filed provisional applications, 35 U.S.C. § 120 and 37 C.F.R. § 1.78(d) for a priority claim to earlier-filed nonprovisional applications or PCT applications, and 35 U.S.C. §119(a)–(d) and 37 C.F.R. § 1.55 for a priority claim to earlier-filed foreign applications.

Generally, a priority claim is properly made when:

1. the later- and earlier-filed patent applications include a *common inventor or joint inventor*;
2. the later-filed patent application makes a *specific reference* to the earlier-filed patent application(s);
3. the claim is made within *16 months* from the filing date of the earliest-filed application *or 4 months* from the filing of the later-filed patent application; and
4. the later-filed patent application is filed *before or on the same day* as the grant or

abandonment of the earlier-filed patent application.

Additional Comments on Specific Reference to an Earlier-Filed Patent Application(s)

Per 37 C.F.R. § 1.78(d)(2), the later-filed patent application must specifically reference (1) the serial number of the earlier-filed patent application(s) and (2) the relationship between the later- and earlier-filed patent applications (*e.g.*, a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application). Furthermore, if the later-filed patent application is a U.S. nonprovisional, the specific reference must be made in an Application Data Sheet (ADS) for the later-filed patent application.

While not required, it is good U.S. patent practice for an applicant to include a “Cross-Reference To Related Application(s)” section within a patent application that includes a specific reference to the earlier-filed patent application(s). Examples of “Cross-Reference To Related Application(s)” sections are listed below. Further, while not required, it may be beneficial for the applicant to include an incorporation by reference statement as shown in the below examples.