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Honors and Awards**IP LEGAL NEWS AND UPDATES****Patent Trial and Appeal Board Statistics (September 2014)**

Authors: [Fabian M. Koenigbauer](#), [Meaghan Hemmings Kent](#), [Steven J. Schwarz](#), and [Carly Levin](#)

On September 16, 2012, *Inter partes* review, Post-Grant review, and covered business method review became available for challenging the validity of issued patents in front of the USPTO's Patent Trial and Appeals Board. The popularity of these proceedings is increasing. The following roundup of statistics follows up on our [earlier statistical analyses](#).

[Click here for a PTAB statistical year-in-review.](#)

PTAB Designates First Precedential AIA Trial Decision

Authors: [Fabian M. Koenigbauer](#), [Meaghan Hemmings Kent](#), [Steven J. Schwarz](#), and [Carly Levin](#)

On July 31, 2014, the Patent Trial and Appeal Board (PTAB) designated as "precedential" under Standard Operating Procedure 2 a decision in a Covered Business Method (CBM) Review, *SecureBuy LLC v. CardinalCommerce Corporation*. This marks the first time that the PTAB has designated a decision in an AIA trial to be binding precedent.

[Click here to read about the opinion and the PTAB's mechanism for designating an opinion as "precedential."](#)

Case Study: Venable Provides IP Counsel for Private Equity Firms

Author: [Frank M. Gasparo](#)

Private equity firms often struggle with how to value, protect and enforce the IP of a portfolio company in which they are investing; how to ensure the return on that investment; and how to manage its IP assets. Often, the management of the portfolio company's IP assets is spread across multiple U.S. and foreign law firms, and there is no one go-to resource for all IP-related issues. Thus, a private equity shop's posture when handling the IP assets of the companies they acquire can be reactionary and often lacks consistency.

[Click here to read about Venable's solutions for private equity firms.](#)

New Process for Suspension of Infringing Domain Names

Authors: [Marcella Ballard](#) and [Kristen S. Ruisi](#)

The Internet Corporation for Assigned Names and Numbers (ICANN) has the responsibility for administration of domain names. ICANN developed a program for the expansion of new generic top level domain names (gTLDs) beyond the standard .com, .org, .net, .edu and .biz. Within hours of the first new gTLDs being launched, cyber squatters proceeded to register domains consisting of brand owners trademarks with the new gTLDs, such as "Tommyhilfiger.clothing" and "Carters.clothing." This has become a growing problem for brand owners, and enforcement of their trademark rights can be very expensive.

[Click here to learn about protecting your trademarks from cyber squatters.](#)

Venable's Inaugural IP Symposium

Authors: [Trent B. Ostler](#), [Michael A. Sartori, Ph.D.](#), and [Laura G. Remus](#)

On September 10, 2014, Venable hosted its inaugural Intellectual Property Symposium in its Washington,

D.C. office to highlight the important role of intellectual property in business and society. The Symposium brought together intellectual property practitioners and businesses, and included a keynote address by Senator Mike Lee (R-Utah), various panel discussions and a rooftop reception. The event covered aspects of patent reform, looked at trends in patent, copyright, and trademark law, and explored issues related to settlement of patent litigation.

[Click here to learn more about the event.](#)

The Invention that Resulted in the Rights of Privacy and Publicity

Author: [Joshua J. Kaufman](#)

The Right of Privacy has become deeply embedded in our culture and is part of our everyday conversations as a result of the NSA's reported eavesdropping, drones flying overhead taking pictures, and the data mining of everything we do on the Internet. Let us not forget the surreptitious pens filming us in public, and Google glasses capturing our every move. It is no surprise that in this environment we more regularly see celebrities claiming violation of their Right of Publicity (an offshoot of the Right of Privacy). Today, the Right of Privacy and Right of Publicity are governed by statutes in most jurisdictions and those that do not have specific statutes use the common law.

[Click here to learn about the origins of these Rights.](#)

ANNOUNCEMENTS AND REMINDERS

Marty Saad Quoted in *Law360* on Laches Defense in Patent Cases

Venable counsel [Marty Saad](#) was quoted in a September 24, 2014 *Law360* article on the use of laches, the equitable doctrine which bars lawsuits after an unreasonable delay, as a defense in patent cases. Last week a Federal Circuit panel declined to address whether a Supreme Court decision limiting laches as a defense in copyright matters applied equally to patent matters. In its ruling, the panel cited a 1992 decision as controlling precedent which it said could only be overruled by the Supreme Court or an *en banc* panel.

"The way the panel addressed it really does tee it up for en banc review," said Saad. "It gives the Federal Circuit a chance to address this issue before there is a cert petition to the Supreme Court."

[Click here to read this article.](#)

The Legal Year in Review

[Jeff Knowles](#) and [Greg Sater](#) were published in an *Electronic Retailer* article discussing the legal and regulatory events of the past year, and considering what may be coming next. In this article, they provide an overview of the events and decisions that shaped direct response marketing law over the past 12 months and share some thoughts on what may be just over the horizon.

[Click here to read the article.](#)

Venable's Annette Kwok Honored by Asian Pacific American Bar Association-DC, DC Bar Foundation Board of Directors

[Annette Kwok](#), an associate in Venable's Washington, DC office and a member of the Patent Prosecution and Counseling Group, was honored with the Asian Pacific American Bar Association of the Greater Washington, DC Area's (APABA-DC) 2014 President's Award at APABA-DC's Award and Installation Gala on September 12, 2014. The award honors the tremendous service and commitment invested by the outgoing President of APABA-DC. Annette will continue her service as the Immediate Past-President for APABA-DC.

Ms. Kwok was also appointed by the DC Bar Foundation Board of Directors to the Young Lawyers Network Leadership Council for a two-year term that began July 1, 2014 and will end June 30, 2016.

"Intellectual Property Strategies for the 3D Printing Era"

at the Inside 3D Printing Conference and Expo

Thursday, October 22, 2014 | 11:00 - 11:45 a.m. PT

Santa Clara Convention Center

5001 Great America Pkwy

Santa Clara, CA 95054

Justin Pierce will host a discussion of the application of IP in developing strategies to protect or leverage products, services and business models that use 3D printing technology. The Inside 3D Printing Conference and Expo is the leading B2B trade show for the 3D printing industry.

Venable attorneys **Heili Kim** and **Claudia Lewis** will speak at 9:45 that morning in a session titled "Digitally Manufacturing Food to Your Dietary Needs – Are Innovations Advancing Faster than FDA Regulations are Evolving?"

Click here for more information and to register for the Inside 3D Printing Conference and Expo.

Use discount code **SPK50** to save 50% when registering.

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