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Honors and Awards**IP LEGAL NEWS AND UPDATES****FTC Settles First "Patent Troll" Consumer Protection Action**

Authors: [Jeffri A. Kaminski](#) and [Carly S. Levin](#)

On November 6, 2014, the Federal Trade Commission (FTC) announced the settlement of its first action against a "patent assertion entity" (PAE), also known as a "patent troll," for allegedly employing deceptive sales claims and fraudulent legal threats in demand letters to thousands of small businesses.

[Click here to learn more about this FTC action.](#)

IPR Spotlight Series: Top 5 IPR Discovery Tips for Patent Owners

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

To help navigate the uncharted waters of *inter partes* review before the Patent Trial and Appeal Board, each edition of *IP Buzz - Post Grant Practice* includes an installment of our IPR Spotlight series, where we feature a specific event on the [IPR timeline](#), from filing the petition for IPR through oral hearing and final written decision. In our [sixth IPR Spotlight installment](#), we focus on IPR discovery tips for patent owners.

Editors' Note: In our last issue, the link was omitted for the fifth installment of the IPR Spotlight Series: [Navigating IPR Discovery](#). We regret the error!

Patent Monetization in the 3-D Printing Era

Author: [Steven J. Schwarz](#)

There has been a lot of talk recently about the proliferation of 3-D printing and the impact it will have on intellectual property rights holders, particularly in the consumer products space. The time has come when consumer products and other goods can easily be reproduced on an inexpensive household 3-D printer.

[Click here to learn about the future of patent monetization with 3-D printing.](#)

The Results Are in on the ITC

Authors: [Andrew F. Pratt](#), [Justin E. Pierce](#), and [Andrew D. Price](#)

The US International Trade Commission investigates imports connected with unfair acts such as IP infringement and directs US Customs and Border Protection to exclude those products from the United States. In 2012, around 75% of all exclusions by the CBP resulted from ITC investigations into brand protection claims sought by Crocs, Inc. (for its foam footwear) and Philip Morris (for counterfeit cigarettes). That figure is remarkable on its own, and even more so given that brand protection claims comprise only a small fraction of ITC investigations. Naturally, this begs the question of why more companies do not use the ITC as a weapon in the brand protection war.

[Click here to learn how brand owners can add the ITC to their arsenal.](#)

Your Terms of Services are Unenforceable

Author: [Joshua J. Kaufman](#)

The vast majority of terms of service (TOS) on websites are unenforceable. Companies spend a great deal of time and money crafting what they believe to be appropriate TOS, which they hope will provide them with the various protections, safe harbors and advantages needed in dealing with the public or in transacting business. Countless hours are spent honing, devising, revising and fine-tuning. Eventually, they are crafted just the way the entity wants them, and then they are posted. From time to time, as circumstances change, they are revised. After countless hours of design, reflection, revisions and thousands of dollars in legal fees, the appropriate well-crafted TOS appear. Unfortunately, in most cases those bits may not have any legal bite.

[Click here to learn how to make your terms of service enforceable.](#)

Gucci America, Inc. et. al. v. Li et. al.: Second Circuit Limits General Personal Jurisdiction

Authors: [Marcella Ballard](#) and Jillian A. Centanni

For years, luxury brand manufacturers like Gucci have been trying to recover profits from online merchants who sell counterfeit goods via offshore websites and ultimately wire the proceeds from these illegal activities to the Bank of China. Plaintiffs in the underlying action brought an action in the Southern District of New York against numerous online merchants who were displaying authentic products on their websites, but were manufacturing and selling counterfeit versions to consumers.

[Click here to learn more about this decision.](#)

PTAB Provides Guidance on Motions to Amend

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

In October, in *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, the Patent Trial and Appeal Board explicitly provided "guidance regarding the requirements of a motion to amend."

[Click here to read a summary of the requirements.](#)

ANNOUNCEMENTS AND REMINDERS

Joshua J. Kaufman Appointed to the Smithsonian Council for American Art

Venable partner [Joshua J. Kaufman](#) has been appointed to the Smithsonian Council for American Art, a group of 100 invited recognized leaders in American Art and history. Established eight years ago as an advisory group to the Smithsonian American Art Museum, the Council's distinguished advisors include Fortune 500 CEOs, university trustees, and non-profit organization directors, as well as artists and scholars from around the country. The American Art Museum relies on the knowledge and experience of Council members for guidance on national programs and initiatives, including the traveling exhibition *1934: A New Deal for Art*, which recently completed its twelve-city tour across America. "It is an honor to be selected and I hope I can contribute to the success and growth of a great institution by sharing my knowledge of art law and the business aspect of the art world," says Kaufman.

Janet Satterthwaite and Toni Herbert ranked in IP Stars – Top 250 Women in IP Law

The prestigious journal *Managing Intellectual Property* has named Trademark partner [Janet Satterthwaite](#)

and Patent partner [Toni-Junell Herbert](#) to its second annual list of top 250 Women in IP.

The selection of only 250 stars from all U.S. outside and in-house counsel as well as judges, government employees, and consultants, is based on thousands of interviews with peers and requires no application or marketing submission from those under consideration. Janet Satterthwaite, named for the second time, is praised as a "leading authority in all aspects of trademark, licensing, portfolio management, and counterfeiting" and is ranked both for contentious and non-contentious trademark work. Toni Herbert, co-chair of Venable's Patent Prosecution practice, is noted for "expertly guid[ing] her clients through all stages of IP development," notably due diligence, litigation, audits, licensing, tech transfer and drug development.

Venable Welcomes Associate to Intellectual Property Litigation Practice

Venable is pleased to announce the addition of [Kristina M. Schrader](#) to our Intellectual Property Litigation Practice. Kristina comes to Venable from the International AntiCounterfeiting Coalition (IACC), where she was Vice President of Legal Affairs and Strategic Planning. She served as second-in-command in executing the overall goals of the IACC, and also managed all legal and legislative activities for the organization. Kristina earned her JD from Vanderbilt University Law School and also holds a Master of Laws in Intellectual Property Law from The George Washington University Law School. She received her B.A. in Political Science from College of Charleston.

IP Strategy - America Invents Act Allows for Virtual Marketing

[Frank M. Gasparo](#) and [Jillian A. Centanni](#) published "IP Strategy - America Invents Act Allows for Virtual Marketing" in the November/December issue of *Middle Market Growth*, the official publication of ACG.

To read the full article, please visit the [Middle Market Growth](#) website.

Venable Brand IP Seminar: Washington, DC

Thursday, December 4, 2014 | 1:00 - 3:30 p.m. ET

[Venable's Washington, DC Office](#)

We are pleased to invite you to attend our fourth Brand IP seminar at Venable's Washington office on Thursday, December 4, 2014. Our panel will include speakers from ABRO Industries and Gemmy Industries Corp., who will discuss the following:

- Working with customs to protect your brand;
- Use of Lanham Act/False Advertising litigation to protect brand/market share; and
- Trademarks and brand protection.

[Click here to register.](#)

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