

# PIPLA NEWS

*The official newsletter of the Pittsburgh Intellectual Property Law Association*

## **UNIVERSITY OF CINCINNATI'S ANNE CHASSER TO SPEAK AT NOVEMBER PIPLA MEETING**

Anne H. Chasser, Associate Vice President for Intellectual Property at the University of Cincinnati and former Commissioner for Trademarks at the United States Patent and Trademark Office, will be the speaker at our November 18<sup>th</sup> luncheon meeting.

Ms. Chasser has broad experience in managing university technology transfer and will discuss current issues facing universities in the commercialization of intellectual property. She will also present a new model for university / industry partnership built around the Open Innovation Model.

Details of the gathering will be circulated shortly in the November meeting notice.

## **DOES A PATENT REFERENCE HAVE A § 102(e) PRIOR ART DATE AS OF THE FILING DATE OF A PROVISIONAL TO WHICH IT CLAIMS PRIORITY??**

*Ying Cao – Jones Day*

Briefs were recently filed for *In re Giacomini* (Fed. Cir. 2009), a case regarding whether a patent reference's priority claim to a provisional application alters its §102(e) prior art date. Under §102(e), an applicant is not entitled to a patent if "the invention was described in ... a patent granted on an application for patent by another filed in the United States before the invention by the applicant ...." §102(e)(2) makes it clear that a patent claiming priority to an international application will be given the international application filing date only if that application "designated the United States and was published ... in the English Language." Divisional and continuation patents are also given the filing dates of their parents as their §102(e) prior art dates if the parents provide sufficient disclosure. *In re Klesper*, 397 F.2d 882 (CCPA 1968). A patent

claiming priority to a foreign filing under §119 cannot have the foreign priority date as its §102(e) date. *In re Hilmer*, 149 USPQ 480 (CCPA 1966); *In re Hilmer*, 165 USPQ 255 (CCPA 1970). However, the Patent Statute and case law are silent on whether a patent claiming priority to a provisional filing can have the filing date of the provisional application as its §102(e) date.

Giacomini's application claimed priority to November 2000. The asserted prior art patent was filed in December 2000 but claimed priority to a provisional application filed in September 2000. The PTO rejected Giacomini's application on the basis that the patent reference was §102(e) prior art having an effective reference date as of the filing date of the provisional application. The BPAI affirmed the PTO's rejection. Giacomini appealed the BPAI's §102(e) rejection, arguing that the patent reference on which the rejection was based cannot have a §102(e) date as of the filing date of the provisional application.

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Giacomini argued that the BPAI erred in holding that §119(e) shifts the effective reference date of the asserted patent to the effective reference date of the provisional application and §102(e) establishes the effective reference date of the provisional application as the filing date of the provisional. Giacomini claimed that §119(e) applies only to the priority date of claims and cannot shift the effective reference date of a patent reference.

Provisional applications are the domestic analog of foreign applications. Since §119(a)-(d) do not shift the effective reference date of a US patent that claims priority to a foreign application, §119(e) should not shift the effective reference date of a US patent that claims priority to a provisional application either. Moreover, Giacomini argued provisional applications are not governed by §102(e). Citing *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), Giacomini stated that a provisional application should not be prior art on its filing date because the inventor has not “done all that he could to make his description public.” Also, as the domestic analog of foreign applications, provisional applications are different from non-provisional applications and are not within the scope of §102(e).

The PTO argued that the plain language of §102(e)(2), §119(e)(1) and §111(b)(8) compels that a patent is prior art as of the filing date of the earliest US application on which the patent can claim priority. Provisional and non-provisional applications should be treated the same in this regard. The PTO has consistently interpreted the statutes as it does today after Congress enacted §111(b) to create the provisional application in 1995. Additionally, the PTO cited *Milburn* and other cases to rebut Giacomini’s analogy of provisional and foreign applications and stated that “domestic and foreign filing dates stand on entirely different footings” in the context of §102(e).

It is now up to the Federal Circuit to decide this novel issue of whether a patent reference claiming priority to a provisional application has a §102(e) reference date as of the filing date of the provisional application.

### **PENNSYLVANIA SUPREME COURT STRIKES DOWN TRADEMARK LAW AS OVERBROAD**

*Kathryn M. Cooper – BECK & THOMAS, P.C.*

On October 5, 2009, in a 4-3 decision, the Pennsylvania Supreme Court held that because the Trademark Counterfeiting Statute, 18 Pa.C.S. § 4119, criminalizes speech protected by the First Amendment, it is therefore unconstitutionally overbroad. *Commonwealth of Pennsylvania v. Omar*, No. J-162A-B-2008 (Pa. Oct. 5, 2009).

The Trademark Counterfeiting Statute provides:

(a) Offense defined. – Any person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.

\* \* \* \* \*

(i) Definitions.– As used in this section, the following words and phrases shall have the meanings given to them in this subsection:

“Counterfeit mark.” Any of the following:

(1) Any unauthorized reproduction or copy of intellectual property.

(2) Intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed or identifying services offered or rendered, without the authority of the owner of the intellectual property.

“Intellectual property.” Any trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person’s goods or services.

18 Pa.C.S. § 4119.

The Commonwealth noted that “a statute is unconstitutionally overbroad only if the statute criminalizes a substantial amount of constitutionally protected speech.” *Commonwealth of Pennsylvania v. Omar*, No. J-162A-B-2008 at 5 (citing *DePaul v. Commonwealth*, 969 A.2d 536, 553 (Pa. 2009)).

The Commonwealth argued that the Trademark Counterfeiting Statute is not unconstitutionally overbroad because “it is limited to persons with the intent to sell or distribute items with counterfeit trademarks, and thus that the statute does not reach a substantial amount of constitutionally protected speech.” *Id.* at 6.

The Commonwealth also relied on a proposed amendment to the statute, statutes from sister states, and additional provisions in the Crimes Code. The proposed amendment substitutes a definition for “counterfeit mark” which eliminates the need for the definition of “intellectual property” that is in the current statute. *Id.* at 7 n.6. “The proposed amendment overtly incorporates the concept of intent to deceive into the definition of a counterfeit mark.” *Id.* at 6-7. Footnote 6 explains that the proposed amendment was referred to the Judiciary Committee on June 6, 2007 but as of July 31, 2009, the website of the General Assembly did not indicate any further action on the amendment. *Id.* at 7 n.6.

Appellees cited examples of word usage that would violate the Trademark Counterfeiting Statute including their own use of the brief they submitted in the case because “they distributed (to the Court and the parties) an item containing an unauthorized reproduction of words, such as Nike and Penn State, that are used by other entities to identify goods or services.” *Id.* at 8. The Court also stated, “Taken to the extreme, even our use of the words ‘Nike’ and ‘Penn State’ in this opinion without the permission of the company or the university would fall under the current definition of a counterfeit mark.” *Id.* at 12.

The Court noted that the plain language of the Trademark Counterfeiting Statute “as written prohibits a broad range of uses of trademarks, many of which involve constitutionally protected speech.” *Id.* at 11. The statute “unconstitutionally prohibits protected speech, including the use of words on a sign praising or protesting any entity with a trademarked name.” *Id.* at 12.

The Court held that under the definition of “intellectual property,” any use of a “term” or “word” that is “engaged by another person to identify that person’s goods or services is a ‘counterfeit mark’ ... accordingly, the definition of intellectual property criminalizes not only the use of the trademark, which would include the stylized logo or name but also the mere word, without regard to font or color.” *Id.*

The Court affirmed the decision of the Centre County Court of Common Pleas striking 18 Pa. C.S. § 4119 as unconstitutionally overbroad.

## THE CUTTING EDGE

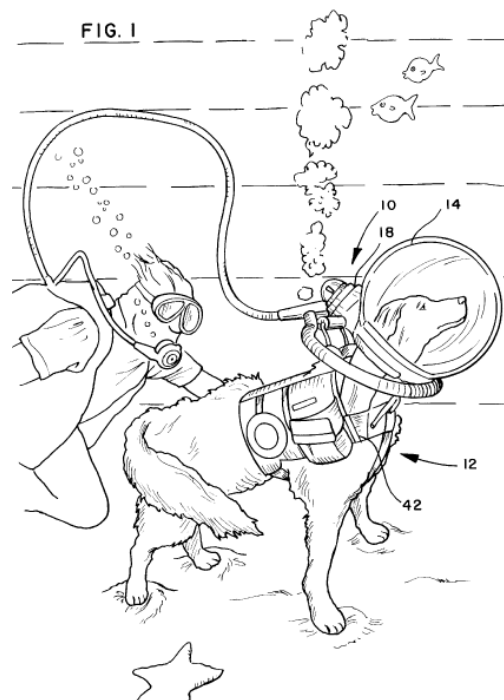
*In The Cutting Edge, we break down the best of the best pending patent applications and recent patent grants to give you a preview of the next great invention that is coming soon to your neighborhood. For example...*

### CANINE SCUBA DIVING APPARATUS

(U.S. Patent No. 6,206,000)

The present invention relates to a diving apparatus for a user that cannot operate a conventional diving apparatus, including animals. The invention has been employed with an animal, the well known diving dog, Shadow. Shadow, being a canine, cannot communicate with her owner and handler, Dwane Folsom, and is unable to operate a scuba apparatus herself.

Accordingly, the present invention provides a means for Shadow to dive both in swimming pools and the open ocean. Shadow has accomplished numerous dives in pools and in the Caribbean Sea around Grand Cayman, British West Indies. She has appeared on approximately thirty television programs or news reports, many of them broadcast nation-wide, such as CBS's morning news and ABC's "Good Morning America," and is a highly experienced diver.



A scuba apparatus 10 is shown being worn by Shadow 12 in FIG. 1. Referring to FIG. 1, the apparatus 10 includes a helmet 14 worn by Shadow. Helmet 14 is spherical and made of any suitable plastic material. Helmet 14 is preferably large enough to hold a reasonable volume of air and avoid contact with the user's head and nose, but not any larger since increased helmet volume adds to the user's buoyancy. Also, helmet 14 tends to create a significant moment because the buoyancy of helmet 14 is at one end of Shadow's body, and well away from its center of buoyancy. Helmet 14 is preferably UV-stabilized so that it will not lose its transparency. In Shadow's case, helmet 14 is approximately 10 ½ inches in diameter.

Helmet 14 includes an opening 16 the interior of which is lined with a skirt 15 of any non-abrasive, water-resistant material. In Shadow's case, Naugahyde® material has proved suitable. The skirt 15 seals the helmet 14 to a harness 42, described below, and therefore assists in creating a slight back pressure in helmet 14. Skirt 15 also cushions the helmet and prevents abrasion to Shadow's neck. Helmet 14 also includes a regulator 18, a compensating weight 20, and an intercom system 22.

Compensating weight 20 must be adjusted for the particular user, and for changes from salt to fresh water. In Shadow's case, weight 20 is approximately four to six pounds. Less weight is required in fresh water than in salt water. More weight can be used to insure that all four of Shadow's feet contact the bottom, or to enable her to lie on the bottom or enable her to perform certain movements or positions she has been trained to use upon signals from her handler, Dwane Folsom.

The bottom surface of weight 20 is hemispherical to fit the bottom of helmet 20. Weight 20 is anchored to helmet 14 by some means 20a that allows the weight to be removed if necessary, for example, when Shadow dives in a fresh water pool instead of the ocean. In the present embodiment, Velcro® 20a material has proven useful and convenient.

Breathable gas can be supplied to Shadow in two ways. One is by means of an air tank, not shown, attached to connector 50, with the first-stage regulator and an air gauge nearer Shadow's tail, to keep them away from Shadow's other equipment. A

conventional first-stage regulator, not shown here, is used to connect the high-pressure air in the bottle to the inlet of regulator 18. Shadow has used an aluminum tank having a capacity of ten or fifteen cubic feet; a tank will typically last for ten to twelve minutes in either a pool or the open ocean. Alternatively, air can be supplied from an air tank and first-stage regulator worn by a human diver, such as Dwane Folsom, Shadow's owner and trainer.

A microphone lead for Shadow's handler, Dwane Folsom, is not shown here, but can be connected at the quick-disconnect fitting and terminates in a microphone mounted inside the regulator used by Dwane. He can use the microphone to give oral commands to Shadow at any time through speaker 57.

#### **FROM THE NEWSLETTER COMMITTEE**

We hope you've enjoyed this issue of the 2009/2010 PIPLA News, an informative and hopefully entertaining look at the goings on in IP law. We invite our entire readership to contribute to this endeavor with articles, announcements, and job postings of your own. If you have something you would like included in PIPLA News or have questions about how you can contribute, please contact Matt Johnson at 412-394-9524 or at [mwjohanson@jonesday.com](mailto:mwjohanson@jonesday.com).

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