



Issue Editors:

Martin L. Saad
 mlsaad@Venable.com
 202.344.4345

Meaghan Hemmings Kent
 mhkent@Venable.com
 202.344.4481

Elissa Brockbank Reese
 ebreese@Venable.com
 202.344.4530

Honors and Awards



IP LEGAL NEWS AND UPDATES

Octane and Highmark: Supreme Court Decisions Give District Courts Greater Discretion to Award Fees

Authors: F. Brock Riggs, Jeffri A. Kaminski, and Christopher J. Kim

On April 29, the Supreme Court issued two landmark patent opinions – *Octane Fitness, LLC v. Icon Health & Fitness, Inc.* and *Highmark Inc. v. Allcare Health Management System, Inc.* Both cases dealt with the Federal Circuit's application of 35 U.S.C. § 285, which allows courts to award attorneys' fees for patent litigation to the prevailing party in "exceptional cases." In the past, the Federal Circuit made "exceptional case" determinations under a fairly specific standard, reviewing a lower court's award de novo. However, *Octane* and *Highmark* have fundamentally altered the Section 285 analysis, expanding the discretion of district courts to award attorneys' fees and raising the bar to overturn Section 285 determinations on appeal. As a result, courts have already taken steps to modify their approach when dealing with the exceptional case issue in patent law.

[Click here](#) to learn the details of these opinions.

The USPTO Grants Two Patents Claiming Diagnostic Methods Post the Supreme Court's Mayo v. Prometheus Decision

Authors: Stefan J. Kirchanski and Miguel A. Lopez

On March 20, 2012, the Supreme Court in its decision of *Mayo v. Prometheus* unanimously held that claims directed to a method of administering a drug to a patient, measuring metabolites of that drug, and with a known threshold for efficacy in mind, deciding whether to increase or decrease the dosage of the drug, were not patent eligible subject matter. The Supreme Court's decision was a controversial one that shook up the legal and biotechnology communities. Nevertheless, diagnostic method claims remain important in basic research, particularly with respect to work being done in universities and medical schools. Two patents have been recently issued that have claims strikingly similar to those held unpatentable in *Mayo v. Prometheus*.

[Click here](#) to learn more about these patents.

Supreme Court Gives a Primer on Laches in Intellectual Property Cases

Authors: Meaghan Hemmings Kent and Martin L. Saad

In a recent copyright case revolving around the film *Raging Bull*, the Supreme Court held that the equitable doctrine of laches, which generally prevents claims where there was an unreasonable delay, does not bar a claim brought within the three year statute of limitations articulated in the Copyright Act. *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. ____ (2014). The opinion went on to address the effects of delays in bringing claims in all types of intellectual property cases.

[Click here](#) for a primer on how the doctrines of laches and estoppel play out in delayed intellectual property claims.

Judicial Patent Reform?: The Supreme Court Could Have Major Impact with Five Cases This Term

Authors: Michael A. Sartori and Tamatane J. Aga

Michael Sartori and Tamatane Aga published "Judicial Patent Reform?: The Supreme Court Could Have Major Impact with Five Cases This Term" in *Legal Backgrounders*, a Washington Legal Foundation publication, on April 11, 2014.

This Term, the Supreme Court accepted five cases that affect various areas of patent law. The Court (has already or) will address the standard for infringement when steps of a claimed method are performed by different independent entities. It has also addressed the test for **awarding attorneys' fees in exceptional cases** and the standard of review for such awards. Regarding patent claims, the Court will consider the test for patent eligible subject matter and the test for indefiniteness of a patent claim.

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

Time to Break Some Trademark Rules in 2014

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

Justin Pierce and Andrew Price published "Time to Break Some Trademark Rules in 2014" on cutting-edge trademark issues, in the June/July issue of *World Trademark Review*, published by WTR, the leading source of daily information on global trademark practice. This issue was distributed at the International Trademark Association (INTA) annual meeting, held May 10-14, 2014 in Hong Kong, where over 8,000 trademark attorneys from around the world gathered for the marquee event.

[Click here](#) to learn more about the flexibility of strong brands.

IP Buzz – Post Grant Practice Edition

Earlier this month, Venable issued a special edition of IP Buzz focused on *inter partes* litigation.

[Click here](#) to view the latest issue.

ANNOUNCEMENTS AND REMINDERS

Venable Is Pleased to Announce that Ralph A. Dengler has Joined the Firm

Ralph is a partner in the IP Litigation group in New York. Prior to Venable, Ralph was a Director in the Intellectual Property Department of another law firm. With Ralph's practice, he brings extensive experience in litigating patent, trademark, copyright, trade secret, and unfair competition matters in a variety of industries. He has litigated across diverse technologies and arts involving business methods, chemical compounds, computers, electronics, food containers and packaging, magazines, marine dredging, pharmaceuticals, and telecommunications. His other legal experience includes eleven years at an IP boutique firm and several years as a Bronx County District Attorney. Ralph is also a retired Colonel in the United States Marine Corps. As a Marine, he had an impressive 22-year career where he commanded Platoon to Battalion-sized units during peacetime and combat operations including Operations Desert Shield / Desert Storm in 1991, Operation Enduring Freedom in 2002, and the Global War on Terrorism in 2003 and 2007-2008. Ralph is a 1996 graduate of Fordham University School of Law. He also holds a Master of Education degree from the University of Virginia and a Bachelor of Science degree in Engineering from the United States Naval Academy.

Venable Grants Avon the "Team of the Year" Award at WTR Industry Awards Night

[Justin E. Pierce](#) and [Andrew D. Price](#), on behalf of Venable, awarded Avon the "Team of the Year" award in the category of Fashion, Cosmetics & Luxury Goods at the World Trademark Review Industry Awards at the INTA Annual Meeting in Hong Kong on May 13, 2014.

Each year, WTR honors leading in-house departments or groups through the WTR Industry Awards. The awards are designed to recognize the vitally important work carried out by in-house trademark counsel and to identify the teams and individuals that are performing their functions to the highest possible standards. The awards are divided into geographical, industry and individual categories, and the winners are selected from nominations received from the global trademark community.

Venable has been a proud sponsor of the awards for several years.

Venable Ranked #10 in Trademarks by *Intellectual Property Today*

Intellectual Property Today ranked Venable #10 in Trademarks out of 202 law firms/individuals. Firms are ranked according to the number of U.S. trademark registrations issued in 2013 where the firm or individual is listed as the legal representative on the registration.

[Click here](#) for more information on the rankings.

Venable Attorneys to Present at 2014 BIO International Convention: "Navigating Patent Challenges Under the America Invents Act"

Wednesday, June 25, 2014 | 10:15 - 11:30 a.m. PT
San Diego Convention Center, Room 23ABC

Venable attorneys will present the panel "Navigating Patent Challenges Under the America Invents Act" at the 2014 BIO International Convention. The panel will discuss the potential impact of these changes from various perspectives – the bench, the administration, and the patent owner – and will investigate the mechanisms available for challenging patents; analyze strategies and issues to consider when challenging or defending patent validity; and assess the risks and benefits associated with the various types of actions that can be used to challenge patent validity.

[Click here](#) for more information and to register for the 2014 BIO International Convention.

Join us at Happy Hour during BIO at Fox Sports Grill (within walking distance from the San Diego

Convention Center) on Tuesday, June 24, 2014 from 6:30-8:30 p.m. PT. [Click here to RSVP](#).

Save-The-Date: Lunch Panel on "Successfully Navigating AIA Trials"

Monday, July 14, 2014 | 12:00 - 2:00 p.m. ET
Venable LLP's Washington Office, Multipurpose Room

Venable, in partnership with the Bar Association of the District of Columbia, will present a lunch panel on practice tips for successfully using AIA trials. Panelists will include Administrative Patent Judge at the Patent Trial and Appeal Board Brian Murphy, Proctor & Gamble Senior Counsel of Intellectual Property Mark Charles, PTAB expert and consultant Oliver Ashe, and Venable partner Adam Hess. Stay tuned for more information in the coming weeks.

Save-The-Date: Venable IP Symposium

Wednesday, September 10, 2014 | 12:30 - 6:00 p.m. ET
Venable LLP's Washington Office, Multipurpose Room

On Wednesday, September 10, 2014, Venable LLP's Intellectual Property Division will hold its inaugural IP Symposium. Venable IP attorneys will be joined by distinguished guest speakers for a half-day event in our Washington, DC offices. We'll kick off with a keynote luncheon, followed by panel discussions on current trends in IP law and strategies for settling a case favorably, and we'll end the day with drinks on the rooftop. The IP Symposium is complimentary and CLE credit will be available. We hope you will join us!

[Click here](#) for early registration.

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