

**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****Trademark Litigators Should Take Care in Alleging "Use of Mark in Commerce" – The Split Between the Second and Sixth Circuits**

Justin E. Pierce and Christopher S. Crook

The Second and Sixth Circuits have different interpretations of what it means to use a mark in commerce for purposes of satisfying the Lanham Act. In a recent decision, a Second Circuit panel acknowledged the split between circuits on the question of whether a plaintiff must allege use of an infringing mark as a trademark in order to pursue a Lanham Act claim. The panel explained that the approach taken by the Sixth Circuit is overly narrow and could exclude cases where consumers are confused through a non-trademark use of a mark.

Patent Troll Did Not Activate Its Gift Card

Melissa Landau Steinman and Christopher S. Crook

Good news for retailers who offer gift cards to their customers for use in stores. For the second time in recent weeks, a jury found that a major retailer has not infringed patents related to prepaid gift cards. In the case of *Alexsam Inc. v. The Gap Inc., et. al.*, Alexsam, a non-practicing entity (sometimes called by the less-complimentary moniker "patent troll"), sued The Gap for violating two patents that cover systems and methods for putting money onto store gift cards and activating the same at the point of sale. After six months of litigation in the Eastern District of Texas' "rocket docket," a popular federal court for patent litigation, Alexsam's infringement claims were rejected by a jury.

Patent Term Adjustment: It's Only A Matter of Time (Until the Federal Circuit Decides *Exelixis*)

Damon W.D. Wright and Matthew R. Farley

Patent term adjustment (PTA) is awarded for essentially two kinds of delay during prosecution, which are based on two sub-sections in the America Invents Act (AIA). One guarantees prompt responses from the U.S. Patent and Trade Office (PTO) called A-delay. The other guarantees no more than three years of patent application pendency, excluding certain delays caused by the applicant which are called B-delays. Recently, a split developed regarding the correct way to calculate and award B-delays.

[Click here](#) to view the full text of this article.

Venable Files *Amicus* Brief at the Federal Circuit on Behalf of BIO

On behalf of The Biotechnology Industry Organization, Venable filed an *amicus* brief at the Federal Circuit in the case of *Fresenius v. Baxter*, a matter involving the interplay between federal court litigation and patent re-examination proceedings. The brief asks the Federal Circuit to rehear a panel decision that adopted a bright-line rule requiring dismissal of cases in which the USPTO invalidates a patent, regardless of whether the court overseeing the case already adjudged the patent as valid. As explained in the brief:

"BIO is concerned that the panel decision could have a number of unintended consequences, such as incentivizing defendants (or declaratory judgment plaintiffs) to employ dilatory tactics in the federal courts while re-arguing already-decided issues under claim construction more favorable to the patent challenger and lower burden-of-proof standards in the PTO. Courts and parties may be forced to expend considerable time and resources litigating matters that may ultimately become moot. Such uncertainty would not be conducive to innovation or investment."

Venable attorneys [Michael A. Gollin](#), [William D. Coston](#), [Martin L. Saad](#), and [Christopher S. Crook](#) are counsel for BIO. Venable filed an *amicus* brief on behalf of BIO in another Federal Circuit case involving re-examination last year.

ANNOUNCEMENTS AND REMINDERS

ABA Antitrust Corporate Counseling Webinar

September 10, 2013
12:00 PM - 1:00 p.m. ET

Please join Venable attorneys for the American Bar Association Corporate Counseling Committee's monthly Antitrust Update for In-House Counsel, a telephonic committee program. This program continues the ABA's popular monthly series of brown bags in which antitrust practitioners report on the most recent developments around the world at antitrust agencies and in the courts. The program will last approximately one hour, including a Q&A at the end. Venable will present this month's update.

[Click here](#) for more details and registration.

"Negotiating and Drafting Global Trademark License Agreements" at the IPO 2013 Annual Meeting

September 17, 2013
10:15 a.m. ET

Venable partner [Marcella Ballard](#) will present on the following global licensing panel: "Negotiating and Drafting Global Trademark License Agreements." This panel will address issues that arise during the negotiation and drafting of a global trademark license agreement, including analysis of standard and essential clauses for licensors and licensees, tips for addressing worldwide licensing, anticipating issues resulting from use of trademarks on the Internet, and implementing an effective brand licensing program.

[Click here](#) for more details and registration.

UCLA Cleantech & Advanced Materials Industry Partnering Conference

September 27, 2013
12:30 p.m. – 6:30 p.m. PT

[Henry Daley](#) will be moderating an investor panel at the UCLA Cleantech & Advanced Materials Industry Partnering Conference. The conference will feature industry panels and showcase recent developments from some of UCLA's leading research labs and initiatives, as well as provide ample time for networking.

[Click here](#) for more details and registration.

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