New and Useful - Janurary 14, 2013

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- The Supreme Court handed down its decision in **Already, LLC v. Nike, Inc.** The Court held that Nike's covenant not to sue Alreadyfor alleged infringement of Nike's AIR FORCE 1 trademark—entered into after Nike had filed suit and Already had filed a counterclaim challenging the mark's validity—rendered both Nike's claims and Already's counterclaims moot. The Court held that because Already failed to show that it engages in or has sufficiently concrete plans to engage in activities that would arguably infringe Nike's trademark yet not be covered by the covenant not to sue, its claims could not survive Nike's motion to dismiss.

- The USPTO has **issued** a Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents. The notice provides two separate roundtable events with the same agendas, one occurring in Silicon Valley on Tuesday February 12, 2013, beginning at 9 a.m. and the second occurring in New York City on Wednesday, February 27, 2013 beginning at 9 a.m. (both local time). Topics on the agenda include: (1) how to improve clarity of claim boundaries that define the scope of patent protection for claims that use functional language; (2) identification of additional topics for future discussion by the Software Partnership; and (3) opportunity for oral presentations on the Request for Comments on Preparation of Patent Applications. Written comments are requested in response to the first two discussion topics. Written comments on the third discussion topic must be submitted as directed in the forthcoming Request for Comments on Preparation of Patent Applications. Registration for the events is requested by February 4, 2013. For additional information see the **official notice**.
- The USPTO has also **extended a pilot program** allowing an applicant to request a twelve-month time period to pay the search fee, the examination fee, any excess claim fees,

and the surcharge (for the late submission of the search fee and the examination fee) in a nonprovisional application, under specific conditions. The program has been extended until December 31, 2013, with the possibility of further extension. To qualify, the applicant must satisfy the following conditions: (1) Applicant must submit a certification and request to participate in the Extended Missing Parts Pilot Program with the nonprovisional application on filing, (2) the application must be a nonprovisional utility or plant application filed within the duration of the pilot program; (3) the nonprovisional application must directly claim the benefit under 35 U.S.C. 119(e) and 37 CFR 1.78 of a prior provisional application filed within the previous twelve months (the specific reference to the provisional application must be in an application data sheet); and (4) applicant must not have filed a nonpublication request. Additional information is available **here**.

- The Second Circuit Court of Appeals **affirmed in part and remanded in part** a decision by the Southern District of New York finding willful infringement on the part of a retailer for infringing the Fendi trademark by selling allegedly counterfeit Fendi-branded products. The district court awarded $12,324,062.66 in trebled damages, prejudgment interest, costs, and attorneys' fees, including disgorgement of Ashley Reed's based on a finding of willful infringement. The Second Circuit affirmed the district court's finding of infringement and willfulness, but remanded for clarification of the period of disgorgement.

- The Federal Circuit has issued a new opinion on determining obviousness. A more thourough examination of the **dicision** in **The C.W. Zumbiel Company, Inc. v. Kappos** will be available soon here at Filewrapper.