



Question Q233

National Group: AIPPI-US Division of AIPLA

Title: **Grace period for patents**

Summary:

In the United States, different grace periods apply to pre-AIA patents (i.e., patents granted on applications filed before March 16, 2013, generally speaking) and post-AIA patents. For pre-AIA patents, the grace period is one year from the earliest effective U.S. filing date, while for post-AIA patents, the grace period is one year from the earliest effective filing date, taking into account foreign priority and international claims. The scope of the pre-AIA grace period includes printed publications, patents, and public uses or sales/offers for sale of the invention by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor. In addition, for pre-AIA patents, a disclosure by a third party prior to the applicant's filing date but during the grace period is generally prior art unless the applicant is able to "swear behind" it by establishing an earlier date of invention. While the scope of the post-AIA grace period has many similarities with respect to the pre-AIA grace period, the new grace period has different implications for disclosures by third parties. Third party disclosures prior to the inventor's earliest effective filing date generally count as prior art unless derived from the inventor. However, the AIA grace period provides that if the inventor disclosed the invention and then subsequently filed within the grace period, the inventor's prior disclosure of the same subject matter as the intervening disclosure by a third party will cause the intervening disclosure to be deemed not to prejudice the inventor's entitlement to a patent with respect to that subject matter.



Question Q234

National Group: United States of America

Title: **Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation**

Summary:

In the United States, the relevant public for "famous marks" is defined by statute for trademark dilution purposes: "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." The term "well-known marks" is used in several treaties and international agreements to which the U.S. is a party, and in the WIPO recommendations which the U.S. supports, but there is limited case law using that term. Where the term is used, the relevant public is a limited set of the general public, typically, those who purchase the goods or services in question. The term "marks with a reputation" is not normally used, and does not have a generally accepted definition in the United States. However, a mark's reputation – in the sense of how widely it is recognized, or whether a descriptive term has acquired trademark distinctiveness through use and promotion – would be measured by considering a limited set of the general public, such as, those who purchase the goods or services in question.



Question Q235

National Group: United States of America

Title: Term of Copyright Protection

Summary:

The much-politicized discussion of term for copyright protection is the subject of Q235. Copyright term is governed by international treaties, which set minimum standards of protection. These treaties include the Berne Convention amended in 1979, the Trade-Related Aspects of Intellectual Property Rights (TRIPS) of 1994, and the WIPO Copyright Treaty, which have all been ratified and implemented in the United States through various statutes. The term of copyright protection in the United States has moved upward 11 times in the last forty years, and the current term of copyright for works by natural persons is life of the author plus 70 years. The determination of adequate copyright protection in the United States involves a difficult balance between the interests of authors in the control and exploitation of their works and society's competing interest in the free flow of ideas, information, and commerce. The AIPPI-US Division does not take a position at this time on what an optimum term might be. The term of life of the author plus 70 years has been adopted by 80 other states, but we are unaware of any significant movement within the United States or elsewhere to extend term past the current standard. Accordingly, the AIPPI-US Division does not see a need to set an upper limit of term in an international treaty.



Question Q236

National Group: United States of America

Title: Relief in IP proceedings other than injunctions or damages

Summary:

This report identifies numerous types of relief available in the United States in intellectual property proceedings, other than injunctive relief or damages. The report steps through each type of available relief, describes what factors must be established before such relief is awarded, and explains the level of judicial discretion available for each type of relief as well as whether United States' courts consider interests of third-parties when awarding relief. The report concludes by proposing ways that relief available in intellectual property proceedings in the United States can be harmonized with that of other jurisdictions.

The report discusses the relief available for holders of (or accused infringers of) utility and design patents, trademarks, copyrights, and trade secrets in the United States. In all cases, declaratory judgment, publication of judgment, an order for inspection, and/or an order to provide information are available remedies. Then, depending on the intellectual property at issue, additional remedies such as, for example, an accounting of profits (patent holder's lost profits or accused infringer's profits), delivery up and/or destruction, royalties, enhanced damages and injunctions may also be available.

The report then discusses proposals for harmonization. For instance, the report proposes that the following types of additional relief should be available for all types of intellectual property rights in the United States: declaratory relief, publication of judgment, corrective advertising, orders to preserve documents, orders for inspection, protection of privileged information, and reparation for unjust enrichment.