



Fall 2011

Welcome to the Fall Edition of Own the Market®. We hope you'll have a great Thanksgiving! In this issue, we discuss one of the biggest changes to affect the U.S. Patent system for over 50 years with Congress passing the Leahy-Smith America Invents Act. Then there's the new generic Top-Level Domain (gTLD) opportunities afforded by a revamped naming system at ICANN - are domain names involving your trademarks safe? Finally, some office news at Hamilton IP Law.

IP Update

Important News and Information about Intellectual Property



Significant Change to U.S. Patent System

On September 16, 2011, President Obama signed the Leahy-Smith America Invents Act (AIA) into law. Many commentators have billed the AIA as the most significant change to the U.S. patent system since 1952. Here, we provide a brief summary of the features of the AIA that are most likely to impact inventors and/or companies that file for patent protection.

1. First-(inventor) To-File System and Grace Period

Many individuals have cast the AIA as transforming the U.S. patent system from a first-to-invent system to a first-to-file system. Those individuals are half right-the AIA implements a first-inventor-to-file system. That means that even if a non-inventor (who may have stolen the invention from the inventor) files for patent protection, the true inventor would have superior rights.

In a related change, the AIA has removed a large portion of the 12-month grace period that U.S. inventors previously enjoyed as related to public disclosures, public use, offers for sale, or sales. The grace period remains only for public disclosure by the inventor. Accordingly, an offer for sale prior to filing for patent protection destroys patent rights. Coupled with the first-inventor-to-file provisions, the new grace period may create a race to the Patent Office between inventors, but shouldn't create a race between inventors and non-inventors or licensees.

2. New Fees

As of September 26, 2011, the USPTO implemented a fee increase of 15% that applies to nearly all fees at the PTO. On the other hand, the AIA has

created a new micro-entity status that provides a 75% discount on filing, issuance, appeal, and maintenance fees. A "micro entity" is defined as an applicant that qualifies as a small entity, has not been named on more than four previously filed patent applications, does not have a gross income exceeding three times the median household income, and has not transferred any right to an entity that would not meet any of the above conditions.

3. False Marking

The AIA made at least one important change to false marking complaints-the person or business filing suit must be able to show a competitive injury. This is a significant change from the previous regime in which any entity could file suit against a false marker no matter what relation, if any, the entity had to the false marker. Hopefully this change will eliminate many of the false marking trolls who ensnared unsuspecting businesses with no intent to deceive. If you would like to discuss the AIA and how it is likely to affect you and your business, please contact Hamilton IP Law to schedule a meeting. Additionally, the attorneys at Hamilton IP Law are planning a brief seminar highlighting some of the most significant portions of the AIA and how those portions are likely to affect the patent landscape.

Industry News



New Top-Level Domain Names: Is Your .Trademark Safe?

What is a .TLD?

Top-level domains are the letters to the right of the dot in a domain name. Since the 1980's only a handful of common TLDs (.com, .edu, .gov, .int, .mil, .net, .org, .biz, .info, .name) have been in use. That will all change on January 12, 2012 since ICANN's new gTLDs can be used to identify (1) a geographical location: .nyc, .chicago; (2) a brand: .apple, .google; or (3) an industry: .bank, .law.

Why is this valuable?

The flexibility of this new Program will allow businesses to segregate themselves for easier customer recognition (www.lawyer.davenport or www.davenport.lawyer) and actually own and control the use of an industry or geographical location on the internet. An owner of a gTLD will have the ability to name their own price for domains with their given gTLD or, if they so desire, may maintain a monopoly on their new gTLD.

The ICANN filing fee for each new gTLD application is \$185,000. The annual fees to maintain a new gTLD are estimated to start at \$25,000 and increase for each domain name created within the registry. While this number seems high, many Fortune 500 companies have already begun looking into the pros and cons of their own gTLD. ICANN predicts as many as 1,000 applicants from January 12, 2012 through April 12, 2012 when the first round of registration ends.

Why is this important?

While it is nearly impossible to predict how many gTLD's will appear it is not hard to imagine the new ways that infringers will attempt to capitalize on your trademark by using gTLD's. For example, Hamilton IP Law's trademark - "Own

the Market®" - could be infringed using new gTLD's in two ways: *www.ownthemarket.(whatever)* or *www.(whatever).ownthemarket*. Since the purchaser of a gTLD is also the gatekeeper, there are more opportunities than ever before for willful and accidental infringement to take place. Acknowledging this problem, ICANN is in the process of developing avenues of recourse for trademark owners. Among these options will be a method of objecting to or challenging proposed gTLD's, and a method of registering your trademark with ICANN.

In Conclusion

ICANN is still in the process of finalizing the Guidebook and developing remedies to prevent potential infringement. Trademark owners will have many options for protecting their rights, but ultimately, monitoring the new gTLD's as well as other instances of use will become vitally important to the longevity of your mark. To protect your marks in the future, ICANN recommends registering with the Trademark Clearinghouse- a program created in an attempt to protect trademark holders after the gTLD registration period.

Hamilton IP Law is actively watching this developing Program and is prepared to answer any questions you may have regarding the safety of your trademarks in the coming months. Hamilton IP Law is also in the process of developing a Trademark Monitoring Program to help better serve our clients' needs. For current information, timelines and activities related to the new gTLD Program, go to <http://www.icann.org/en/topics/new-gtld-program.htm>.

Feel free to contact us for more information on Hamilton IP Law's Trademark Monitoring Program or to discuss the impact of ICANN's new gTLD program and the impact it may have on you. Additionally, Hamilton IP Law will offer a free seminar at the NewVentures Center in Davenport on December 14, 2011 from 12:00pm until 1:30pm.

[1] See gTLD Applicant Guidebook (September 19, 2011), available at <http://www.icann.org/en/topics/new-gtlds/rfp-clean-19sep11-en.pdf> (the "Guidebook").

Office News



Charlie Damschen, who has been with Hamilton IP Law since 2006, has recently joined the University of Iowa College of Law as a part-time adjunct lecturer. Adjunct faculty members typically teach part-time, outside of their normal practice, to provide students with additional exposure to the realities of legal practice. Mr. Damschen will continue his full-time duties at Hamilton IP Law providing IP advice and counsel. As an adjunct, Mr. Damschen is assisting with the Iowa Medical Innovation Group (IMIG). IMIG is a joint venture with students from the colleges of law, medicine, engineering, and business.

With assistance from faculty, students enrolled in IMIG originate an idea for a medical device and pursue the idea to commercialization (potentially). Along the way, students may make detailed drawings or a prototype of the device, perform a patent search, file a patent application, develop a business plan, and form a business entity. As the only patent attorney involved with IMIG, Mr. Damschen will help primarily with any issues related to patentability, inventorship, assignment/licensing, and patent application drafting. IMIG enrollment is limited to 4-6 law students per year, and requires a one-year commitment from students.



Cody Kiroff has recently joined the team of attorneys at Hamilton IP Law full-time. Cody was born and raised in Charles City, Iowa. He earned a B.S.E. in Biomedical Engineering and an entrepreneurial certificate from the University of Iowa in 2008, and earned his J.D. at the University of Iowa College of Law in the spring of 2011. He is a member of the Iowa Bar. Cody has strong medical and electrical backgrounds and gained invaluable experience working in the engineering departments for major corporations such as Pfizer, Inc. - formerly Cambrex Chemical, and Oral B Laboratories - a Proctor and Gamble Inc. subsidiary. Cody will sit for the Patent Bar on December 20, 2011, and the Illinois Bar on February 28, 2012.

DISCLAIMER

The determination of the need for legal services and the choice of a lawyer are extremely important decisions and should not be based solely upon advertisements or self-proclaimed expertise. This disclosure is required by rule of the Supreme Court of Iowa. The materials in this newsletter are intended to provide general information, and individuals should not rely upon the materials herein for specific legal advice. Hamilton IP Law, PC recommends that individuals seek legal counsel regarding questions and issues of protection or infringement of rights, so as to avoid possible loss of rights or infringement of the rights of others. This newsletter alone or the receipt thereof in no way creates an attorney-client relationship.

©2009-2010 Hamilton IP Law, PC. All rights reserved.

[Forward email](#)



Try it FREE today.

This email was sent to brandonl@sparqonline.com by jay@hamiltoniplaw.com | [Update Profile/Email Address](#) | Instant removal with [SafeUnsubscribe™](#) | [Privacy Policy](#).
Hamilton IP Law, PC | 331 W. Third Street, Suite 120 | Davenport | IA | 52801