

Emerging Issues in IP

****Abstraction-Filtration-Comparison Test (AFC Test)**:** A test used to determine whether a claimed invention is patentable, particularly in the context of business methods and software. The test involves three steps: (1) Abstraction: identifying the claimed invention's abstract idea; (2) Filtration: evaluating the elements of the claim to determine whether they contain an inventive concept that is sufficient to ensure that the claim amounts to significantly more than the abstract idea; and (3) Comparison: comparing the claimed invention to prior art to assess its novelty and non-obviousness.

****Adverse Possession**:** A legal principle that allows a person to gain ownership of property through long-term, open, notorious, and continuous possession of the property without the owner's permission. While not directly related to intellectual property, the concept is important in the context of trademark law, where a trademark owner may lose their rights in a mark if they fail to police and enforce their rights against infringing uses.

****Copyright Misuse**:** A legal doctrine that prevents a copyright owner from enforcing their copyright rights if they have engaged in anticompetitive behavior or other misuse of their copyright. For example, if a copyright owner licenses their work but includes a provision that prohibits the licensee from creating any competing works, this may be considered copyright misuse.

****Design Patent**:** A type of patent that protects the ornamental design of a product, rather than its functional aspects. Design patents are often used to protect the visual appearance of products such as furniture, jewelry, and consumer electronics.

****Doctrine of Equivalents**:** A legal principle that allows a patent owner to assert infringement against a product or process that does not literally infringe on their claims but is equivalent in its function, way, and result. The doctrine is used to prevent infringers from evading patent infringement by making minor modifications to the claimed invention.

****Fair Use**:** A legal doctrine that permits the use of copyrighted material without obtaining permission from the copyright owner, under certain circumstances. Fair use is determined by evaluating four factors: the purpose and character of the use, the nature of the copyrighted work, the amount and substantiality of the portion used, and the effect of the use on the market for the original work.

****Federal Circuit**:** The United States Court of Appeals for the Federal Circuit (CAFC) is a federal appellate court that has exclusive jurisdiction over appeals from district courts in patent cases, as well as appeals from the United States Patent and Trademark Office (USPTO). The Federal Circuit is known for its specialized expertise in patent law and its role in shaping the development of patent policy in the United States.

****First-Sale Doctrine**:** A legal principle that allows the owner of a lawfully made copy of a copyrighted work to sell or dispose of that copy without the copyright owner's permission. The first-sale doctrine limits

the copyright owner's distribution right and allows for the free transfer of ownership of physical copies of copyrighted works.

****Genericide****: The process by which a trademark becomes so commonly used as a generic term for a product or service that it loses its legal protection as a trademark. For example, the term "aspirin" was once a registered trademark, but it has since become a generic term for a type of pain reliever.

****Grace Period****: A period of time during which an inventor can disclose their invention to the public without losing their right to obtain a patent. In the United States, the grace period is 12 months, during which an inventor can file a patent application after publicly disclosing their invention.

****Infringement****: The unauthorized use of a patented invention, trademark, or copyrighted work that violates the exclusive rights granted to the owner of the intellectual property. Infringement can result in legal action, including injunctions and damages.

****International Trade Commission (ITC)****: An independent federal agency that investigates and adjudicates cases involving imports that allegedly infringe on intellectual property rights. The ITC has the authority to issue exclusion orders that prohibit the importation of infringing products into the United States.

****Laches****: A legal doctrine that prevents a party from asserting their rights if they have delayed unreasonably in doing so, and the delay has caused prejudice to the other party. In the context of intellectual property, laches may be used as a defense to patent infringement, trademark infringement, or copyright infringement.

****License****: A legal agreement between the owner of intellectual property and another party, granting the other party permission to use the intellectual property under certain terms and conditions. Licenses can be exclusive, non-exclusive, or sole, and can cover a wide range of rights, including the right to make, use, sell, or import the intellectual property.

****Markman Hearing****: A pretrial conference in a patent infringement case during which the court determines the meaning and scope of the patent's claims. The Markman hearing is named after the 1996 Supreme Court case *Markman v. Westview Instruments*, which established that claim construction is a question of law for the judge to decide.

****Non-Obviousness****: A legal requirement for patentability that requires an invention to be sufficiently novel and non-obvious to a person having ordinary skill in the relevant art. Non-obviousness is determined by evaluating the differences between the claimed invention and the prior art, and assessing whether a skilled person would have found the invention to be obvious based on the prior art.

****Patent Exhaustion****: A legal principle that limits the rights of a patent owner after they have sold or licensed their patented invention. Once a patented invention has been sold or licensed, the patent owner's rights in that invention are "exhausted," and the purchaser or licensee is free to use the invention as they see fit, without further restrictions or royalties.

****Patent Troll****: A derogatory term used to describe a person or entity that acquires patents for the purpose

of asserting them against others, often through litigation, without intending to practice the patented invention themselves. Patent trolls are also known as non-practicing entities (NPEs) or patent assertion entities (PAEs).

****Prior Art****: Information that is publicly available before a patent application is filed and that can be used to evaluate the novelty and non-obviousness of the claimed invention. Prior art can include published patent applications, scientific articles, and other publicly available documents.

****Shop Right Doctrine****: A legal principle that allows a person who has used another's patented invention without permission to continue using the invention after the patent has expired, under certain circumstances. The shop right doctrine is typically applied in situations where an employee uses an employer's patented invention in the course of their employment.

****Trade Dress****: The visual appearance of a product or its packaging, which can be protected under trademark law if it is non-functional and has acquired secondary meaning. Trade dress can include colors, shapes, and other visual elements that distinguish a product or its packaging from those of competitors.

****Trademark Dilution****: The gradual weakening of a trademark's distinctiveness or reputation through unauthorized uses that are not necessarily infringing but that may diminish the trademark's strength or value. Trademark dilution is prohibited under federal and state law, and can be prevented through legal action.

****Utility Patent****: A type of patent that protects new and useful processes, machines, manufactures, or compositions of matter. Utility patents are the most common type of patent and are often used to protect inventions in fields such as technology, engineering, and chemistry.

****Willful Infringement****: The deliberate and intentional violation of another's intellectual property rights, typically in the context of patent infringement. Willful infringement can result in enhanced damages, including treble damages and attorneys' fees, if the infringer knew or should have known that their actions were infringing.

****Work Made for Hire****: A legal principle that determines who owns the copyright in a work that is created by an employee in the course of their employment. Under the work made for hire doctrine, the employer is considered the author and owner of the copyright, rather than the employee.