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Shimokaji IP specializes in the strategic development of patent and trademark portfolios. We serve start-ups, Fortune 100 companies, government entities, and universities. Our expertise and representation extends across the US and throughout Asia.

IS AUTOMATED FINANCIAL PLANNING PATENTABLE?

No, because the Federal Circuit found that it is "directed to patent-ineligible subject matter."

In re Greenstein involved a patent of "receiving investment data, adjusting an individual's savings, and investing the adjusted savings to achieve a projected retirement income."

That, according to the Federal Circuit, "describes no more than the automation of the longstanding fundamental economic concept of personal financial planning."

Further, the claims "fail to recite an inventive concept" and instead "merely recite an abstract idea with instructions to implement it 'using one or more [general purpose] computers associated with software.'"

The Court rejected the patent owner's argument that the inventive concept resided in "utiliz[ing] a projected amount of income at a future date for at least one person."

COMMENT: Though not articulated by the Court, even a layperson would likely find it difficult to see patentability in simply automating what was previously done by pencil and paper.

USPTO EXPANDS PRIORITIZED PATENT EXAMINATION

Want to get your patent issued in twelve months after filing your application, rather than waiting a few years?

The USPTO track one prioritized examination program promises to do so. And it does NOT require a pre-examination search.

The program has been expanded to accept an additional 20% more applications per year.

Eligible applications include original nonprovisional utility applications and national stage applications. This includes continuation, continuation-in-part, and divisional applications. The application cannot have more than four independent claims nor more than thirty total claims. The request for prioritized examination must be filed before the first office action.

The filing fee is \$2K to \$4K.

Prioritized examination will cease if: 1) you file an extension of time to reply, 2) you amend the application to include more than four independent claims or more than thirty total claims.

COMMENT: For the additional fee, prioritized examination can make sense for many patent applicants.

YOUR WEB ADVERTISEMENT MAY NOT BE TRADEMARK USE TO SUPPORT REGISTRATION

Federal law provides for trademark registration when the mark is used in commerce.

This can be met if the mark "is placed in any manner on the goods or their containers or the displays therewith or on the tags or labels affixed thereto." Mere advertising is not enough.

The issue in *In re Siny* was whether a webpage qualified as a "display."

The trademark Board found an absence of information to make a purchasing decision, such as price, minimum purchase quantity, method of payment, and shipment method. There was a phone number "for sales information." Notably, goods could not be purchased through the webpage.

The Board concluded that "if virtually all important aspects of the transaction must be determined from information extraneous to the web page, then the web page is not a point of sale."

The Federal Circuit agreed with the Board that the webpage did not constitute trademark use in commerce and, thus, the mark could not be registered.

COMMENT: In brick and mortar stores, a point of display typically omits much, if not all, of the information considered necessary by the Board. The required information may arguably be too restrictive. But that is the law.

YOUR LINKEDIN PROFILE DATA CAN BE USED BY OTHERS

hiQ used automated bots to scrape information from users' public LinkedIn profiles. LinkedIn sent a cease-and-desist letter. hiQ sought a preliminary injunction to prevent LinkedIn from denying the former access.

The Ninth Circuit explained that the primary issue was whether hiQ's computer access was "without authorization." In other words, was hiQ's access analogous to "breaking and entering."

The court concluded that accessing public information was not "breaking and entering" a computer. A preliminary injunction against LinkedIn was upheld.

COMMENT: LinkedIn argued there was no authorization to access its computers when it sent a cease and desist letter. That may not have been its best argument against the fact that the information was public.