

Can Public Officials Block Social Media Critics?

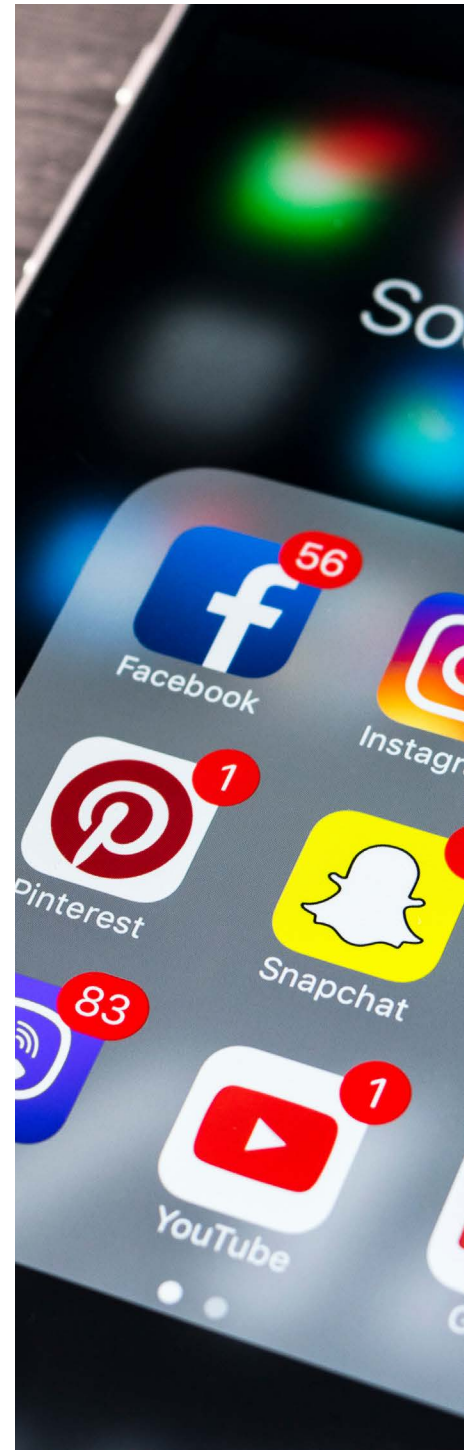


JULIE L. SPIEKER

Intellectual Property Attorney in the MVS Mechanical-Electrical Practice Group and Biotechnology and Chemical Practice Group

In 2014, James Freed was appointed city manager of Port Huron, Michigan and updated his public Facebook page accordingly. He added his title and a link to the city’s website in the “About” section and chose to post a photo of himself wearing a suit and a city lapel pin. Freed posted mostly private but occasionally city-related information. Sometimes, Freed solicited feedback from the public, for instance in the form of a link to a city survey. Freed’s Facebook posts received comments to which Freed often replied. He also deleted comments he found “derogatory” or “stupid.” Kevin Lindke, unhappy with the city’s approach to the COVID-19 pandemic, visited Freed’s Facebook page several times with comments relaying his unhappiness. Freed initially deleted Lindke’s comments (e.g. “the city deserves better”) and eventually Freed blocked him.

Lindke sued Freed alleging that Freed had violated his First Amendment Rights. Lindke contended that Freed’s Facebook page was a public forum and therefore he had the right to comment there and when Freed deleted his comments and blocked him Freed engaged in impermissible viewpoint discrimination. The District Court granted summary judgement to Freed because the “prevailing personal quality” of Freed’s posts and the absence of government involvement in the Facebook account meant that Freed managed his Facebook page in his private capacity and not an official one. Lindke appealed and the Sixth Circuit affirmed. The Sixth Circuit held that an official’s activity is state action if a state law requires the official to maintain the social media account, the official uses state resources or staff to run the social media account, or the account belongs to the Office and not the individual. Any of those situations would make the official’s social media activity “fairly attributable” to the state, and



Freed's activity was not.

Lidke appealed to the Supreme Court and on March 15, the Supreme Court issued an opinion wherein the Court developed a two-prong test to determine whether a public official's social media activity constitutes state action: 1) does the official possess actual authority to speak on the state's behalf, and 2) does the official purport to exercise that authority in the relevant social media posts. Public officials do not relinquish their First Amendment rights when becoming a state agent. Such state actors still have First Amendment protections to speak as a private citizen.

The first prong is related to the requirement that the alleged conduct causing a deprivation of a right be "fairly attributable" to the state. The conduct must be traceable to the state's power or authority. The Court notes that Lindke's focus on the appearance of the Facebook page skips over this crucial step. Lindke argued that Freed's Facebook page looks and functions like an outlet for the city. The Court notes that Freed's conduct is not fairly attributable to the state unless he had state authority to post said city updates. Lindke must show more than just that Freed had some authority; it must be within his jurisdiction or area of operations. The Court gives several potential sources for conferring state power to an individual: statutes, ordinances, regulations, and persistent practices of state offices that are well settled. A city manager like Freed would have the authority to speak for the city if a written law empowered him to make official announcements or if city managers have been recognized to have authority to speak for the city for so long that to become "permanent and well settled." Freed must have actual authority rooted in written law or a longstanding custom.

For the second prong of the test, the official must purport to use the state authority. To illustrate, the Court gives the following example:

A school board president announces at a school board meeting that the board has lifted pandemic-era restrictions on public schools. The next evening, at a backyard barbecue with friends whose children attend public schools, he shares that the board has lifted the pandemic-era restrictions. The former is state action taken in his official capacity as school board president; the latter is private action taken in his personal capacity as a friend and neighbor. While the substance of the announcement is the same, the context—an official meeting versus a private event—differs. He invoked his official authority only when he acted as school board president.

The Court acknowledges that the context of Freed's speech is more ambiguous than the above example. The Court reveals that had Freed's account possessed a disclaimer or label that the Facebook page is personal, and the view expressed are strictly his own, that would entitle him to a presumption that all the posts on his page are personal. Such markers give the speech contained therein a clear context. Conversely, speech on a social media account that belongs to a political subdivision, like a City of Port Huron Facebook page, would give a clear context that the speech contained there is state speech.

The Court states that categorizing posts on an ambiguous page such as Freed's is a fact-specific undertaking in which the content and function of each post are important considerations. The Court also articulates the difference between deleting comments and blocking a person entirely. When analyzing comment deletion, only the posts where the comments were deleted are relevant. However, when analyzing blocking a person on a page-wide basis, any post in which Lindke wished to comment is relevant.

Because the Court's two-pronged test differs from the test applied by the Sixth Circuit, the judgment was vacated and remanded for further consideration.

Can a public officials block social media critics? Maybe, if the two prong test is not met: if the official does not possess authority to speak on the state's behalf, or if their social media account or posts are personal and not exercising state authority.

Restrictive Covenants and IP



LUKE T. MOHRHAUSER
Managing Partner and Chair, MVS
Mechanical-Electrical Practice Group



Did you know that the first reported case of a challenge to a non-compete agreement was in England in 1414? Mr. John Dyer had given a promise to not exercise his trade in the same town as the plaintiff for six months but the plaintiff had promised nothing in return. This case is now known as Dyer's case. In Dyer's case, the court decided that it would not enforce such a provision. But wait, let's step back and go over non-compete provisions and other restrictive covenants.

In contract law, a non-compete clause, restrictive covenant, or covenant not to compete, is a clause under which one party (usually an employee) agrees not to enter into or start a similar profession or trade in competition against another party (usually the employer). In the labor market, these agreements prevent workers from freely moving across employers, and weaken the bargaining leverage of workers. Traditionally, non-competes were used to prevent high-skilled workers from transferring trade secrets or a customer list from one firm to a competing firm.

Some examples of restrictive covenants that can be included in agreements include:

- Garden-leave clause: a type of CNC by which an employee is compensated during the period that the employee is restricted.
- Nondisclosure/confidentiality agreement: an agreement by which a party agrees not to use or disclose the other party's confidential information.
- Non-solicitation agreement: an agreement by which an employee agrees not to solicit and/or not to accept business from the employer's customers.
- Antipiracy agreement: an agreement by which an employee agrees not to solicit and/or not to hire the employer's employees.
- Invention assignment agreement: an agreement by which an employee assigns to the employer any potential inventions conceived of during employment.
- Holdover provision: agreement provision that requires employees to assign ownership of their inventions for a period of time after their employment concludes.

There has been much discussion on non-compete clauses in recent times, especially as the Federal Trade Commission (FTC) was tasked with drafting language to create a national ban on such practice. In fact, there was approximately 93 restrictive covenant bills introduced in 37 states in 2023. Of note, Minnesota passed a bill to outright ban all non-compete agreements for Minnesota residents but does allow for some enforcement. California passed the broadest bill, which includes, "any contract that is void under this chapter is unenforceable regardless of where and when the contract was signed ... [and] regardless of whether the contract was signed and the employment was maintained outside of California."¹

¹ In other words, an employee who signs a restrictive covenant agreement in another state, performs services for his/her employer in another state and then takes residence in California will not be subject to the restrictive covenant agreement.

Others, including New York and the FTC, moved toward such bans, but ultimately did not enact or pass any new laws. In addition, Delaware (where many businesses are incorporated) had some judicial opinions that seem to weaken or narrow the use of non-compete clauses.

While it is too much to cover every state in this article, it should be noted that there are generally some common restrictions or exemptions. For example, a few states have taken the position that all non-compete agreements are prohibited, but many others prohibit non-competes only for employees who earn compensation below a certain threshold. The minimums vary by state and are also subject to change as the economy fluctuates. In addition, there are some states that have approaches in barring employers from imposing non-competes on certain employees, which may include:

- Age
- Exempt/Nonexempt Status
- Compensation Levels
- Industry Specific - For example, in a number of states, non-competes cannot be required of physicians, nurses, attorneys, veterinarians, professional service providers, computer professionals, or broadcasters.

It is normal for these agreements to be challenged as well, especially as workers attempt to change employment. In general, courts look to the necessity and reasonableness of the clauses. For example, in a particular case, is it a relevant industry (does the worker do work for a firm in the same industry?), reasonable geographic area, and reasonable time period? Of course, another factor is any intellectual property (IP) that the employee may have accessed while at the previous employment and if this raises the need to delay the worker from starting a new position with a potential competitor.

When challenged, a court can do one of three things with a defective covenant not to compete:

1. The court can throw out the entire covenant not to compete. This is sometimes called the “red pencil” doctrine.
2. The court can attempt to rescue a portion of the contractual provision by striking out the portion of the clause that renders it unenforceable. This is often called the “divisibility” or “blue pencil” doctrine.
3. Alternatively, the court can attempt to equitably reform the contractual provision, where the court can actually re-write the contract to be consistent with the parties’ original intent as modified by the extent of the law. Also referred to as “reformation.”
 - a. Iowa is a reformation state.



So, how does IP apply and what can be done from an employment perspective? Even as the ability to restrict where workers go grows, there are ways for employers to attempt to protect themselves. Including the following clauses in employment agreements provide some layers of protection for a business' IP:

- Trade Secret Provisions – most states include trade secrets acts and there is a federal law as well. Include reference to these to ensure that employees know they cannot use any trade secrets when changing roles. Work with counsel to identify what trade secrets you may have and to take the necessary steps to keep them secret and valuable.
- Confidentiality Provisions – Make sure you provide notice that employees may be privy to confidential information, even if not a trade secret, and they cannot use such information at any future employment. Working with counsel to identify what may qualify as confidential information is key.
- Know-How/Holdover Provisions/Invention Assignment Provisions – Make sure, in writing, that employees know they have a duty to assign (and make sure assignment language is in present tense, "I hereby assign...") all inventions and other IP created as part of their employment or due to anything learned on the job. These are but a few examples of how employers can protect themselves. As always, if you have specific questions or if you would like tailor-made strategies for your business, please contact the attorneys and patent agents of McKee, Voorhees & Sease. There is no one size fits all strategy, and we are set for any situation, as a boutique IP specialist law firm.

AI Inventions: Are They Patentable?



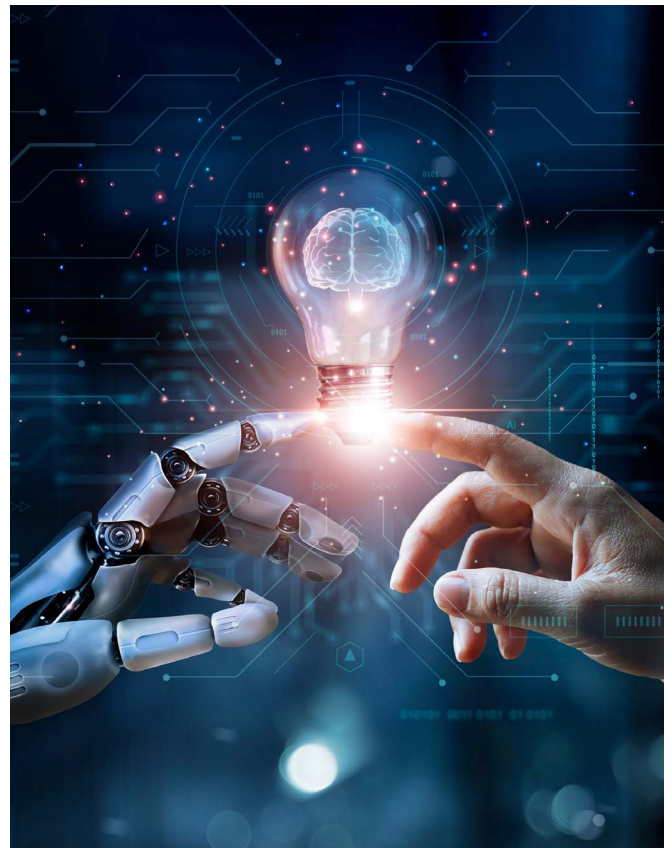
KIRK M. HARTUNG

Partner, Patent Attorney in the MVS
Mechanical-Electrical Practice Group

There are two basic categories of artificial intelligence inventions: those made by a human with assistance from AI and those made solely by AI without human interaction. In the United States, the former may be patentable, but the latter is not, at least under the current patent law. Let's examine both.

AI Assisted Inventions

The U.S. Patent and Trademark Office (USPTO) and the U.S. courts have concluded that to be patentable, an invention must be made by a human. However, this does not preclude patents for inventions created with the assistance of AI. On February 13, 2024, the USPTO published guidelines on AI-assisted inventions, to incentivize, protect and encourage innovations, and investments therein. The USPTO has been working toward these guidelines since at least August 2019, with a series of events and reports to obtain extensive public inputs, comments, and feedback. These guidelines emphasize the requirement for a substantial



human contribution to a joint human-AI collaboration on an invention in order to qualify for patent protection.

These new USPTO guidelines provide examples of inventions that are eligible for patent protection. Even if human and AI joint inventors are eligible to file a patent application, the patent will only be granted if the application meets the other statutory requirements of 35 U.S.C. sections 102, 103 and 112 regarding novelty, obviousness, and sufficient written description.

As one example from the guidelines, if a person merely inputs a problem into a generative AI system which then provides a solution, the human has not contributed significantly to the inventive solution, and therefore the invention is not patent eligible. But if the person inputs more sophisticated details that are directed to a more specific solution to the problem, then he/she may qualify as an inventor, such that the result is patent eligible. Thus, the facts appear to be determinative of whether a patent application can be filed or prosecuted. At a minimum, AI can be used as a tool to assist a human inventor, with any derived inventions being eligible for patent protection.

The USPTO states that these new guidelines provide clarity for stakeholders and examiners as AI continues to play a greater role in innovation, with patents incentivizing and rewarding human ingenuity. As stated in an October 30, 2023 Executive Order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence,

Promoting responsible innovation, competition, and collaboration will allow the United States to lead in AI and unlock the technology's potential to solve some of society's most difficult challenges. This effort requires investments in AI-related education, training, development, research, and capacity, while simultaneously tackling novel intellectual property (IP) questions and other problems to protect inventors and creators. . . .

The Federal Government will promote a fair, open, and competitive ecosystem and marketplace for AI and related technologies so that small developers and entrepreneurs can continue to drive innovation.

Inventions by AI Without Human Contribution

In 2018, Dr. Stephen Thaler filed a series of patent application in the U.S. and internationally which identified the sole inventor as DABUS, an artificial intelligence machine that autonomously generated the invention, admittedly with no help from Dr. Thaler. Today, with the exception of South Africa, every other country has denied patent protection to the DABUS invention, both in their Patent Offices and appeals to their courts. All have concluded that a patent requires a human inventor.

Dr. Thaler, the president and CEO of Imagination Engines, Inc., with the pro bono assistance of Professor Ryan Abbott from University of Surrey School of Law in the United Kingdom, have been part of the Artificial Inventor Project, with their series of test cases seeking intellectual property protection for AI generated inventions with a human inventor. This project is intended to promote dialogue about frontier technologies, and their social, economic and legal impact.

Future Patent Protection for AI Inventions

Some legislative bodies around the world have started discussions and proposed bills to allow AI to be an inventor and have patent protection for AI innovations. The leading example is Brazil, which this month introduced a bill to amend their national patent laws to regulate inventions generated by AI, so as to encourage research and provide a legal system that is effective in protecting IP rights for AI inventions. In the European Patent Office (EPO), the DABUS applications were rejected because the designated inventor has to be a person with legal capacity, and the DABUS machine does not have such legal capacity. However, the EPO Board of Appeals also stated that patent inventions are not limited to human-made inventions, because under the European patent system it does not matter "how the invention was made." Thus, the Board concluded that AI-generated inventions are arguably patentable.

Germany also considered the inventions by DABUS, and concluded that where an invention is conceived by a machine, the persons operating the machines could be considered to be the inventors.

In the United States, as in most other countries, the patent system has existed since long before the recent era of AI generated inventions. The time has come for the U.S. Congress and other lawmakers in other countries to consider how best to incentivize and encourage continued investments of time, money, and other resources in this technology. Global harmonization for revised patent protection would be wise. Such updates to IP laws will inevitably lead to solutions to problems and improvements in virtually all industries and fields of work, all to the benefit of mankind.

The Legal Tightrope of AI Training: Balancing Innovation and Copyright Law



JACOB S. BLACKFORD

Intellectual Property Attorney in the MVS
Biotechnology and Chemical Practice Group

Artificial intelligence (AI) companies that use large language models (LLMs) often employ web scraping techniques to gather vast amounts of data from online sources. These sources can include websites, forums, social media platforms, and other online repositories of information. Once this data is collected, it is processed and used to train LLMs, which are then capable of providing responses to user queries, often in the form of natural language generation.

Web scraping involves automated processes that extract data from websites. While the practice itself is not illegal, the legality of web scraping depends on numerous factors, including the terms of service of the websites being scraped and the specific methods used for scraping. Many websites have terms of service or terms of use that explicitly prohibit or restrict web scraping activities without prior consent. Web scraping must be conducted in a manner that respects intellectual property rights, including avoiding the unauthorized reproduction of copyrighted material.

New technology often pushes the boundaries of existing legal frameworks, and the clash between innovation and copyright law is a familiar narrative. A prime example is the rise of Napster in the late 1990s and early 2000s, which revolutionized digital file sharing but also ignited a legal firestorm over copyright infringement. At its core, Napster challenged traditional notions of copyright by enabling individuals to share copyrighted music without authorization from the rights holders. This sparked a legal battle between Napster and the music industry, leading to lawsuits alleging copyright infringement. The case, ultimately, resulted in Napster being shut down in July 2001 due to its violation of copyright law.

Napster's rise and fall illustrates the tension between technological innovation and copyright protection. It demonstrated how new technologies can disrupt established industries and practices, often outpacing the legal frameworks designed to govern them. The legal ramifications of Napster's operations prompted discussions and legal reforms surrounding digital copyright, shaping subsequent legislation such as the Digital Millennium Copyright Act (DMCA) of 1998. Similarly, today's advancements in artificial intelligence (AI), particularly large language models, are pushing the boundaries of copyright law.

Fair use and copyright infringement represent two sides of a complex legal coin, especially in the context of digital technology and AI. Fair use allows for the limited use of copyrighted material without permission from the copyright holder, under certain conditions such as criticism, commentary, news reporting, teaching,

scholarship, and research. However, determining what constitutes fair use can be subjective and context dependent. Reproducing copyrighted language verbatim presents a significant challenge within this framework. While fair use may permit the use of short excerpts of copyrighted text for purposes such as criticism or commentary, the reproduction of entire passages without authorization raises red flags for potential copyright infringement.

This issue has come to the forefront in a December 2023 court filing of OpenAI v. New York Times in which The Times contends that millions of articles published by The Times were used to train automated chatbots that now compete with the news outlet as a source of reliable information. In its complaint, The Times said it approached Microsoft and OpenAI in April 2023 to raise concerns about the use of its intellectual property and explore “an amicable resolution,” involving a commercial agreement and “technological guardrails” around generative A.I. products. This is just one of many ongoing lawsuits over the use of copyrighted material, with a sizable portion of the plaintiffs being authors of novels that were “ingested” into text training programs.



These ongoing cases have raised several concerns:

1. **Lack of Compensation:** The uncompensated use of copyrighted material deprives creators of potential revenue and undermines the economic value of their work.
2. **Market Substitution:** If AI models freely reproduce copyrighted language without compensation, it could undercut the market for licensed content, impacting the livelihoods of content creators and publishers.
3. **Attribution Issues:** Verbatim reproduction of copyrighted text without attribution can lead to concerns over plagiarism and intellectual property rights.
4. **Fair Use Analysis:** Determining whether the use of copyrighted language by AI models falls within the bounds of fair use requires careful consideration of factors such as 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 potential market for the copyrighted work.
5. **Legal Liability:** AI companies may face legal repercussions if their use of copyrighted material is deemed to infringe upon the rights of copyright holders.

Moving forward, addressing the issue of compensation for copyrighted material in the context of AI and digital technologies requires a multi-faceted approach that balances the interests of content creators, technology companies, and consumers. One such approach is that of the Associated Press (AP), who in July 2023, made a deal with OpenAI to license part of AP’s text archive back to 1985 to the technology company for language model training purposes.

Potential avenues to explore into the future of avoiding copyright infringement include:

1. **Licensing Deals:** AI companies could negotiate licensing agreements with content creators and rights holders to obtain permission to use copyrighted material in their training datasets and products. These agreements could involve payment of royalties or other forms of compensation based on the usage of the content.

2. **Digital Royalties:** Similar to how musicians receive royalties for the streaming of their songs, content creators could receive digital royalties for the use of their copyrighted material by AI models. Technology platforms could implement systems to track and compensate content creators based on the usage metrics of their content.
3. **Blockchain Technology:** Blockchain technology offers a decentralized and transparent way to track the usage of digital assets, including copyrighted material. Smart contracts could be used to automate royalty payments to content creators based on predefined terms and conditions.
4. **Content Recognition Technologies:** AI-powered content recognition technologies could be integrated into AI models to identify and attribute copyrighted material.

Finding a balance between protecting the rights of copyright holders and fostering the development of AI technology is crucial in maintaining a competitive edge in the global landscape. As with Napster, the challenges posed by AI technologies require a balance between fostering innovation and protecting intellectual property rights. Legal frameworks must adapt to address these technological advancements while safeguarding the interests of content creators and rights holders. Just as Napster prompted reforms in copyright law, the development of AI necessitates ongoing legal and ethical discussions to ensure that innovation can flourish within a framework that respects intellectual property rights.

Navigating these concerns requires a nuanced understanding of copyright law, technological capabilities, and ethical considerations. AI companies must implement measures to ensure compliance with copyright regulations, such as obtaining licenses for copyrighted material or implementing algorithms to filter out copyrighted content. Additionally, collaboration between stakeholders, including content creators, AI developers, and policymakers, is essential to develop guidelines that strike a balance between fostering innovation and protecting intellectual property rights in the digital age.

Overview of the USPTO's Framework to Evaluate Patent Subject Matter Eligibility



JOSEPH H. HALLMAN

Intellectual Property Attorney in the MVS Mechanical-Electrical Practice Group

When applying for a patent several hurdles must be overcome in order to achieve patentability. For example, in order for a patent application to ultimately issue as a patent, the claimed invention must be novel and nonobvious over the existing prior art. Additionally, another hurdle to patentability often overlooked by first-time patent application filers is that the subject matter of the claimed invention must be “patent-eligible” in the eyes of the United States Patent and Trademark Office (USPTO).

The USPTO has put forth a framework known as the *Alice/Mayo* test to determine whether the subject matter of a claimed invention is eligible for patent protection. See [Manual of Patent Examining Procedure \(MPEP\) § 2106](#). The *Alice/Mayo* test was adopted by the USPTO based on two cases decided by the United States Supreme Court: *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 110 USPQ2d 1976 (2014) and *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 101 USPQ2d 1961 (2012).

Step 1 of the *Alice/Mayo* test asks whether the claimed invention is to a process, machine, manufacture, or composition of matter. These categories are the four categories provided in federal statute 35 U.S.C. § 101 for which an inventor can obtain a patent. If the claimed invention is to one of the four statutorily identified categories of invention, thus satisfying step 1, the USPTO can then conduct a streamlined eligibility analysis when the eligibility of the claimed invention



is self-evident. The USPTO states that subject-matter eligibility of a claimed invention is self-evident when the claimed invention, viewed as a whole, “clearly does not seek to tie up any judicial exception such that others cannot practice it.” If the claimed invention is to one of the four statutorily identified categories, but its eligibility is not self-evident, then the USPTO considers the eligibility of the claimed invention under step 2A of the *Alice/Mayo* test. If the claimed invention is not to one of the four statutorily identified categories, the claim must be rewritten, if possible, such that it is to one of the four categories. If the claim cannot be rewritten such that it is to one of the four categories, the claimed invention is not eligible subject matter.

Step 2A of the *Alice/Mayo* test is divided into a two-pronged analysis to determine whether the claimed invention is directed to an abstract idea, law of nature, or natural phenomenon. Prong 1 of step 2A asks whether the claimed invention recites an abstract idea, law of nature, or natural phenomenon. Courts have categorized abstract ideas, laws of nature, and natural phenomena as judicial exceptions that, when the claimed invention is directed to such a judicial exception, render the claimed invention to be ineligible for patent protection. Examples of abstract ideas include mathematical concepts, particular methods of organizing human activity, and mental processes. The USPTO notes that courts view judicial exceptions as “‘the basic tools of scientific and technological work’, and are thus excluded from patentability because ‘monopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it.’” If the USPTO determines that the claimed invention does not recite a judicial exception under prong 1 of step 2A, the claimed invention is not directed to a judicial exception and, therefore, qualifies as eligible subject matter. If the USPTO determines that the claimed invention recites a judicial exception, the USPTO then proceeds to further evaluate the eligibility of the claimed invention under prong 2 of step 2A.

Prong 2 of step 2A asks whether the claimed invention recites additional elements that integrate the judicial exception into a practical application. Under prong 2 of step 2A, the USPTO evaluates “whether the claim as a whole integrates the exception into a practical application of that exception”. The USPTO further states that “[a] claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” Examples of additional elements that the USPTO notes can integrate a recited judicial exception into a practical application include “[a]n improvement in the functioning of a computer, or an improvement to other technology or technical field”, “[i]mplementing a judicial exception with, or using a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim”, “[e]ffecting a transformation or reduction of a particular article to a different state or thing”, and “[a]pplying or using the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception”. On the other hand, the USPTO notes that “[g]enerally linking the use of a judicial exception to a particular technological environment or field of use” has been identified as a feature that does not integrate a judicial exception into a practical application. If the claimed invention includes additional elements that

integrate the judicial exception into a practical application, then the claimed invention qualifies as eligible subject matter. If the claimed invention does not include additional elements that integrate the recited judicial exception into a practical application, then the USPTO proceeds to further evaluate the eligibility of the claimed invention under step 2B of the *Alice/Mayo* test.

Step 2B of the *Alice/Mayo* test asks whether the claimed invention recites additional elements that amount to significantly more than the judicial exception. The USPTO notes that this step is often referred to as “a search for an inventive concept.” The USPTO provides that “an ‘inventive concept’ is furnished by an element or combination of elements that is recited in the claim in addition to (beyond) the judicial exception, and is sufficient to ensure that the claim as a whole amounts to significantly more than the judicial exception itself.” When evaluating whether the claimed invention amounts to significantly more than the judicial exception, the USPTO considers any additional elements individually and in combination. The evaluation under step 2B of the *Alice/Mayo* test is similar to the evaluation under prong 2 of step 2A, however, one difference is that step 2B considers whether additional elements are well-understood, routine, or conventional in the field. If such additional elements are not well-understood, routine, or conventional, this can help form an argument that the subject matter of the claimed invention is patent eligible. If the claimed invention includes additional elements that are found to amount to significantly more than the judicial exception, then the claimed invention qualifies as eligible subject matter. If the claimed invention does not include additional elements found to amount to significantly more than the claimed invention, then the claimed invention is not eligible subject matter.

The foregoing is meant to be a brief overview of the framework the USPTO uses to evaluate subject matter eligibility that is hopefully helpful for first-time patent application filers. If any questions arise regarding the subject matter eligibility of a specific invention for which an inventor wishes to seek patent protection, it is generally a good idea to consult a patent practitioner. Additionally, rejections of patent applications based on lack of eligible subject matter is more common among software inventions than other fields. Thus, for such software-type inventions it is likely wise for an inventor to consult an experienced and knowledgeable patent practitioner rather than attempt to file a patent application independently.

Trademark Scams



MIKE C. GILCHRIST

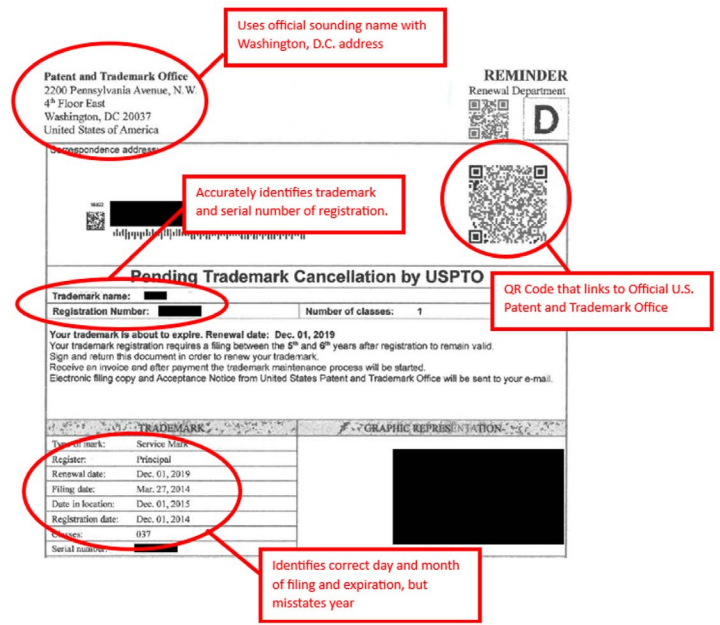
Intellectual Property Attorney in the MVS Mechanical-Electrical Practice Group

Trademark scams aimed at trademark registrants and applicants are common. The perpetrators are seeking to illegitimately acquire money or confidential information. As with most scams, some are ham-fisted and easy to spot, but many are subtle and require diligence to avoid. Below is some information that can help spot these scams and recommendations on how to avoid them.

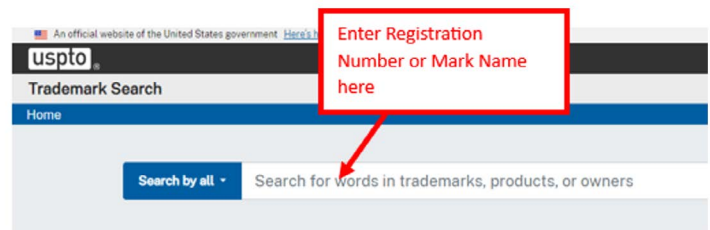
Post-registration Scams

This is the scam we see most often. The scammer sends a notice (either by email or regular mail) indicating that the trademark registration will be cancelled if not renewed. That much may be true, registered trademark are periodically subject to renewal and proof use. Specifically, a trademark registrant is required to file an affidavit attesting that it is using the mark in commerce (or has a valid excuse for not using the mark) during the fifth year after registration. Additionally, trademarks must be renewed every ten years. For trademarks filed by our firm where we are still attorney of record, we will send clients reminders in advance of these dates.

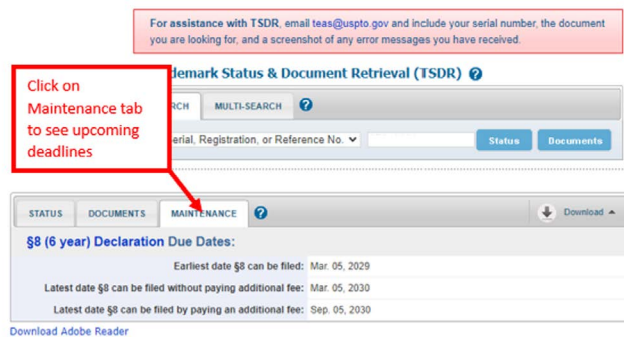
However, the scammers have no intention of helping to prepare and file the necessary paperwork to keep the registration in force. They want the registrant to pay them money, which the scammers simply pocket. Very often the notice will include a mixture of actual information from the registration along with incorrect information. In the example below, received by one of our clients, the notice included accurate information about the trademark name and registration number, but listed a registration date one-year before the actual registration date—thereby making it appear that that the affidavit of use was due one year before its actual due date. In this way, the scammers avoid the registrant having received a real notice of the actual due date from the registrant’s attorney.



There are a few things registrants should keep in mind. If your trademark registration lists your attorney as the correspondence address, as is most common, the USPTO will address all correspondence to the attorney, and you select your registration from the search results and then click on the Maintenance tab of the TSDR record to see relevant upcoming deadlines: should never receive correspondence directly from the USPTO. You can always check the status of your registration by contacting your attorney, or, if you prefer to do things yourself by checking the USPTO website <https://tmsearch.uspto.gov/search/search-information>.



Select your registration from the search results and then click on the Maintenance tab of the TSDR record to see relevant upcoming deadlines:



Solicitation related to Fake Conflicting Marks

Another scam is to try to get companies to pay money to prevent nonexistent third parties from registering trademarks related to the companies' names or trademarks. A few of our clients recently received a version of the following email (with identifying information omitted):

There is much about the email that is simply wrong: there is no deadline for registering a mark with the USPTO and there is no way to "hold a request" made by a third party. A review of Trademark Office records shows no pending trademark applications or registrations of concern. In short, the email is a scam.

It is possible to challenge third-party applications and registrations through opposition or cancellation proceedings at the USPTO. However, if you receive an unsolicited email regarding a third-party trademark application it should be viewed with suspicion. At the very least it should identify the pending application or registered mark so that its existence can be verified. If in doubt, contact your attorney who should be able to quickly determine whether there is a legitimate reason for concern.

Caller ID Spoofing Scams

The USPTO reports that callers are spoofing numbers with Washington, D.C. or Alexandria, Virginia area codes claiming to be calling from the USPTO. Again, if your attorney is listed as the Correspondence Address on your registration or application, the USPTO will never contact you by telephone. You should also be aware that the USPTO will never ask for payment over the phone (or via text or email).

One way to make these calls less likely is to omit your phone number (and email address) from the trademark application if you use an attorney to file the application. While the trademark application includes a blank for the phone number of the person signing, it is not mandatory, and we strongly recommend not including the phone number. Furthermore, it is permissible to use an email controlled by your attorney as the email address of the applicant, which also helps avoid dealing with scam emails related to the application.

Conclusion

Owners of trademark registrations or pending trademark applications should be on guard for scam communications. The United States Patent and Trademark Office (USPTO) has a webpage devoted to identifying the most common scams: <https://www.uspto.gov/trademarks/protect/caution-misleading-notices>. Best practices include using your attorney as the correspondence address and omitting your phone number and email address from the trademark application. When in doubt it always best to contact your attorney for confirmation.

Subject: The Trademark Has Been Filed by Another Applicant

Dear _____:

I hope this message finds you in good health. I am reaching out to formally notify you of the approaching deadline for registering the trademark " _____ " with the United States Patent and Trademark Office (USPTO).

Despite our repeated attempts to establish contact, we regret to inform you that we have not received any response from you thus far. It is crucial to bring to your attention that once the necessary classes are paid for the applicant, our ability to assist you will be limited to filing any opposition on your behalf.

The other applicant has initiated their application process with another firm. Our efforts thus far have been aimed at holding their request, allowing you the opportunity to register the trademark under your ownership, considering you have been using this business name for a significant period. Should you still wish to proceed with trademarking it under your ownership, we stand ready to file opposition on your behalf.

If the other applicant successfully registers " _____ " several potential consequences may arise, including loss of rights, rebranding costs, confusion among customers, legal action, limited expansion, and difficulty in enforcing your rights.

Your immediate attention to this matter is crucial. We still have the opportunity to initiate opposition proceedings, and given your long-term use of this business name, we believe we have a strong case.

Thanks & regards,



MVS: SUPPORTING INNOVATION EVENTS

[Michigan State University Innovation Celebration](#)

April 2, 2024 - Lansing, Michigan

Heidi Sease Nebel, Patent Attorney and Chair, [MVS Biotechnology and Chemical Practice Group](#)

MVS is a sponsor of the event

[State Science & Technology Fair](#)

April 4-5, 2024 - Ames, Iowa

MVS is a sponsor of the event

[Technology Association of Iowa \(TAI\) Technology Summit](#)

April 8-9, 2024 - Des Moines, Iowa

Gregory Lars Gunnerson, Patent Attorney and Chair, [MVS Design Patent Group](#)

[CSU Strata Demo Day](#)

April 17, 2024 - Fort Collins, Colorado

Glenn Johnson, Attorney Practicing in Commercial, Employment, Intellectual Property Law and Litigation

MVS is a sponsor of the event

[Managing Partner Forum](#)

May 1-2, 2024 - Atlanta, Georgia

Luke T. Mohrhauser, Managing Partner and Chair, [MVS Mechanical-Electrical Practice Group](#)

[Minnesota IP Law Association Annual Meeting and Stampede Event](#)

May 1-2, 2024 - Edina, MN

Shireen Bhatia, Patent Attorney in the [Biotechnology and Chemical Practice Group](#)

[Get to Know Ira Flatow from Science Friday](#)

May 2, 2024 - Des Moines, Iowa
May 4, 2024 - Ames, Iowa

MVS is the presenting sponsor for the event

[PPAC Executive Session and the 25th Anniversary Celebration of the Patent Public Advisory Committee](#)

May 6, 2024 - Washington, D.C.

Heidi Sease Nebel, Patent Attorney and Chair, [MVS Biotechnology and Chemical Practice Group](#)

[2024 INTA Annual Meeting](#)

May 18-22, 2024 - Atlanta, Georgia

Christine Lebrón-Dykeman, Trademark Attorney and Chair, [MVS Trademark Practice Group](#)

[Iowa Engineering Conference](#)

May 21-23, 2024 - Des Moines, Iowa

Gregory Lars Gunnerson, Patent Attorney and Chair, [MVS Design Patent Group](#)

[ABI Taking Care of Business Conference](#)

June 4-6, 2024 - Davenport, Iowa

Luke T. Mohrhauser, Managing Partner and Chair, [MVS Mechanical-Electrical Practice Group](#)

Sarah M.D. Luth, Patent Attorney in the [MVS Biotechnology and Chemical Practice Group](#) and Co-Chair, [MVS Data Privacy and Cybersecurity Practice Group](#)

Joseph M. Hallman, Patent Attorney in the [MVS Mechanical-Electrical Practice Group](#)

Julie S. Spieker, Patent Attorney in the [MVS Mechanical-Electrical Practice Group](#) and [Biotechnology and Chemical Practice Group](#)

MVS is a sponsor of the event

[LEGUS Annual Meeting](#)

June 13-15, 2024 - Aachen, Germany

Jill Link, Patent Attorney and Chair, [MVS Licensing Practice Group](#)

[Iowa Arts Summit](#)

June 18, 2024 - Ankeny, Iowa

Gregory Lars Gunnerson, Patent Attorney and Chair, [MVS Design Patent Group](#)

[The Society for In Vitro Biology Conference](#)

June 8-11, 2024 - St. Louis, Missouri

Cassie J. Edgar, Patent Attorney and Chair, [MVS Regulatory Law Practice Group](#) and Co-Chair, [Data Privacy and Cybersecurity Practice Group](#)

Kevin M. Kercher, Patent and Trademark Attorney in the [MVS Mechanical-Electrical Practice Group](#)

Charles P. Romano, Ph.D., Senior Patent Agent in the [MVS Biotechnology and Chemical Practice Group](#)

MVS is a sponsor of the event

BRIEFS is published periodically and is intended as an information source for the clients of McKee, Voorhees & Sease, PLC. Its contents should not be considered legal advice and no reader should act upon any of the information contained in the publication without professional counsel.

Let's Create Connections!

☎ 515-288-3667

✉ www.ipmvs.com/subscribe

📍 801 Grand Avenue
Suite 3200
Des Moines, IA 50309

