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For more information on the U.S. Trademark Industry please visit www.rmclegal.com

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If you are interested in discussing how trademark and/or copyright protection might help your business profitability, please contact us.

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NEW FEDERAL “DEFEND TRADE SECRETS ACT OF 2016” SIGNED INTO LAW; REQUIRES COMPANY ACTION

On May 11, 2016, President Obama signed the Defend Trade Secrets Act of 2016 (“DTSA” or “Act”) into law. The Act requires companies to give contractual notice regarding certain whistleblower protections for its contractual workers and subcontractors or risk being barred from recovering attorneys’ fees or exemplary damages in any subsequent lawsuit with the employee. This requirement also applies to amendments to any employee or subcontractor agreement that has been amended since the effective date of the Act (May 12, 2016).

Other highlights of the Act include:

- Choice of Federal or State Remedies
- New Federal Remedies
- New Recovery Tool
- Litigation Safeguards for Trade Secrets
- Specific Discussion about Digital Issues/Remedies
- Whistleblower Protections
- Employer Notification Requirement

The whistleblower provision provides immunity to a person revealing a trade secret “in confidence” to local, state, or federal governments, or an attorney, solely for the purpose of reporting or investigating a suspected violation of law. As stated previously, employers have an affirmative duty to inform their employees and independent contractors about the immunity.

The passage of the DTSA warrants many suggestions for best practices including modifications of employment and contractor agreements as well

as verifying current and continuing reasonable measures designed to protect trade secrets. RMC has a detailed whitepaper that we can share upon request entitled [Congress Strengthens Trade Secret Protections; Employers Required to Notify Employees and Independent Contractors.](#)

Additionally, contact Attorney J.J. Burchman at Burchman@RMCLegal.com or 517.999.5414 if you have any questions regarding changes to employment and contractor agreements.

TTAB REVERSES REFUSAL BASED ON GEOGRAPHICAL DESCRIPTIVENESS

The Trademark Trial and Appeal Board (“TTAB”) recently reversed an examiner’s refusal to register a mark based upon Section 2(e)(2)’s prohibition against marks that are geographically descriptive.

This decision potentially opens up possibilities for registration of trademarks with *geographic elements*.

The test established under Section 2(e)(2) involves a three-prong analysis, namely whether: (1) the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public, (2) the public would make an association between the goods or services and the place named in the mark, that is, believe that the goods or services for which the mark is sought to be registered originate in that

place, and (3) the source of the goods or services is the geographic region named in the mark. *In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445, 1448-9 (Fed. Cir. 2015).

In the case of the application for a registration of the trademark Cass Park Village, the examiner refused registration, arguing that “Cass Park” identifies a specific area in Detroit of historical significance and designated as a federal historic district. The applicant intended to build a development within the Cass Park district. In support of his refusal, the examiner attached a Wikipedia entry as well as a printout from a Curbed Detroit blog regarding the applicant’s plans.

In its ruling, the TTAB found the evidence insufficient to support a refusal. The opinion acknowledged that while both the Wikipedia entry and the blog post constituted some evidence, there was no evidence cited that customers have been exposed to the term “Cass Park” and are aware of the historical significance. “[T]he mere entry in a gazetteer or the fact that a location is described on the internet does not necessarily evidence that a place is known generally to the relevant public.” [In re Olympia Development of Michigan, LLC](#), Serial No. 86333108 (June 10, 2016), at *4. Please contact us to discuss the impact of registration of



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trademarks with geographic elements.

UNITED STATES PATENT AND TRADEMARK OFFICE ANNOUNCES PROPOSED FEE INCREASES

On May 27, 2016, the United States Patent and Trademark Office (“USPTO”) issued a notice of proposed rulemaking in which it proposes to raise rates for certain trademark filing fees. The larger increases in fees involve filing paper applications and paper responses, but the costs for certain electronic applications are also proposed to increase. The increases proposed are intended to incentivize electronic filings whenever possible as paper filings involve additional costs for the USPTO. Comments on the proposed changes were received on or before July 11, 2016. For more information, please contact us.

UNITED STATES PATENT AND TRADEMARK OFFICE PUBLISHES PROPOSED RULEMAKING

On Wednesday, June 22, 2016, the United States Patent and Trademark Office (“USPTO”) published a *Notice of Proposed Rulemaking* entitled “Changes in Requirements for Affidavits or Declarations of Use, Continued Use, or Excusable Nonuse in Trademark Cases.” According to the USPTO, the proposal to amend its rules concerning the examination of affidavits or

declarations of continued use or excusable nonuse is intended to assess and promote the accuracy and integrity of the trademark register by potentially requiring more information to be submitted with renewal affidavits of trademarks.

“Specifically, the USPTO proposes to require the submission of information, exhibits, affidavits or declarations, and such additional specimens of use as may be reasonably necessary for the USPTO to ensure that the register accurately reflects marks that are in use in the United States for all the goods/services identified in the registrations, unless excusable nonuse is claimed in whole or in part.”

Comments must be received by the USPTO by August 22, 2016. Please contact us if you are interested in either formulating a comment or monitoring submitted comments.



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