

IP NEWS QUARTERLY

IP Attorneys Group, LLC

Summer 2013

Thinking Outside the Box: Nontraditional Trademarks in the United States.

In the United States, nontraditional marks often identify products or services without the use of words or complex word based designs. Nontraditional marks can help a business leave a unique impression of its products or services on the minds of consumers. A business should determine whether its marks are maximizing the company's impression on the consumers' five senses (i.e. sensory audit). Martin Lindstrom, *BRAND sense: Build Powerful Brands through Touch, Taste, Smell, Sight, and Sound*. 110-122 (Free Press, 2005). The most prominent categories of nontraditional marks include touch (tactile), motion, taste, scent, color, sound, and shape or product configuration. Trade dress is the most commonly registered nontraditional mark. A restaurant's or retail store's interior and exterior designs can be registered as trade dress. Similarly, website design and product packaging are also registrable. Finally, three dimensional marks are considered by some to be a subset of trade dress, and include a product's configuration and overall appearance.

To be registrable with the United States Patent and Trademark Office, a nontraditional mark must be nonfunctional, so that no unfair advantage is gained by the mark owner when registration is granted. This means the mark cannot be registered if its use offers a competitive advantage to its owner in manufacture or use of the product. Additionally, consumers must view the nontraditional mark as indicative of the owner's business or brand, not as an ornamental or decorative aspect of the particular product. The NBC chimes and Owens-Corning's pink insulation are great examples of nontraditional marks that have successfully gained registration. Both businesses devoted significant resources into advertising directed at making the consumer identify their marks with their respective brands.

Please contact this office with any questions regarding nontraditional marks.

In this issue:

Nontraditional trademarks in the U.S. **1**

Association for Molecular Pathology v. Myriad Genetics (AMP v. Myriad) **2**

AMP v. Myriad **3**
continued

Did you know?

- Between 1996 and 2012 only 7 Community Trademark applications for smell marks were filed.

IP Law Update: Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 2107 (U.S. 2013).

On June 13, 2013, in a unanimous decision, the United States Supreme Court invalidated Myriad Genetics' claims to isolated genes, which would have given Myriad an exclusive right to isolate an individual's BRCA1 and BRCA2 genes. The Court held that merely isolating genes that are found in nature does not make them patentable. However, the Court upheld Myriad's patent on synthetically creating BRCA complementary DNA (cDNA), upon finding it was an invention of a molecule that does not occur in nature.

The question presented by the case was whether a naturally occurring segment of deoxyribonucleic acid (DNA) is patent eligible under 35 U.S.C §101 by virtue of its isolation from the rest of the human genome. The Supreme Court of the United States has long held that 35 U.S.C §101 implicitly prohibits patenting products of nature, since those products serve as the tools for

the creation of useful inventions, and allowing them to be patented would hinder further invention contrary to the purpose of patents. The lower court agreed with the plaintiff in holding that Myriad's patents were



invalid under 35 U.S.C. §101 because they covered products of nature. Thus, the precise issue considered by the Supreme Court was whether Myriad's uncovering the exact location and genetic sequence of specific genes within specific chromosomes was an act of invention, or merely an attempt to patent a product of nature.

The Court considered this

case in light of Diamond v. Chakrabarty, 447 U.S. 303, 305 (1980), where the Court held a modified bacterium was patentable, because the patent claim was "to a nonnaturally occurring manufacture or composition of matter—a product of human ingenuity 'having a Distinctive name, character [and] use.'" Diamond, 447 U.S. at 309-310. The Diamond bacterium was new "with markedly different characteristics from any found in nature." Diamond, 447 U.S. at 310.

The Court then contrasted the bacteria in Diamond with the composition patent that claimed a mixture of naturally occurring strains of bacteria in Funk Brothers Seed Co. v. Kalo Inoculant Co., 333 U.S. 127 (1948). In Funk Brothers Seed Co., the Court held the composition patent invalid because there was no actual invention or creation; only an attempt to patent a specific collection of naturally occurring strains of bacteria.

IP Law Update: Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 2107 (U.S. 2013).

The Court found that Myriad, like the patentee in Funk Brothers Seed Co., had not created anything, and that separating a gene from its surrounding genetic material was not an act of invention. Accordingly, the Court held Myriad's patent on isolated DNA segments invalid.

Although the Court found Myriad's patent on isolated DNA segments invalid, the Court held Myriad's patent on creation of a cDNA sequence valid, because the creation of a cDNA sequence from mRNA resulted in an exon-only molecule that is not naturally occurring.

In footnote seven, the Court acknowledged that some viruses

reproduce by using an enzyme called "reverse transcriptase" to copy RNA into cDNA. This seemingly natural process would appear to undercut the Court's rationale for upholding the validity of Myriad's cDNA sequence patent. Nonetheless, the Court stated that such a rare and unusual phenomenon that created a similar molecule did not render the composition of matter nonpatentable.

Additionally, the Petitioners contended that cDNA was not eligible for patenting because nature dictates the nucleotide sequence of cDNA. The Court responded by saying that a new molecule was created when a lab technician makes cDNA. It retains the natu-

rally occurring exons of DNA but is distinct from the DNA from which it was derived, thus making it patent eligible under 35 U.S.C §101, not a product of nature.

Finally, the Court was careful to point out that method claims were not considered in this decision, nor were new applications of knowledge about the BRCA1 and BRCA2 genes. The Court also noted that the patentability of DNA in which the natural order of nucleotides has been altered was not considered in this case, and that scientific alteration of the genetic code presents a different inquiry.

Please contact this office with any questions relating to patentability and patents.



Learn more about us at
www.ipattorneysgroup.com



IP Attorneys Group, LLC

Patents—Trademarks—Copyrights

16 Oxford Road, 2nd Floor

Milford, CT 06460

Tel: 203 298 4830

Fax: 203 298 4832