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**IN MEMORIAM  
STEPHEN J. QUIGLEY  
1953 - 2015**

The Publications Committee and the NYIPLA dedicate this issue to Stephen J. Quigley, who suddenly passed away on April 30, 2015. Steve was a longtime member of the Committee, chairperson for several years, and a regular contributor to the Bulletin. He was an NYIPLA Board member for the past two years and the Publications Committee's Board Liaison for the past year. Steve worked for the Bronx District Attorney's Office, the New York State Attorney General's Office, and as an IP lawyer in private practice for the last twenty-five years. In addition to his service to the Board, the Committee, and the NYIPLA, Steve will be remembered for his extensive record of service throughout his life: the Jesuit Volunteer Corps after college (he was being considered for



the Executive Director position of the Corps at the time of his death), the Tuckahoe (NY) School Foundation (which he helped found), the Ignatian Volunteer Corps, as a Boy Scout leader, and as a Tuckahoe Village Trustee for the last five years. Steve touched the lives of many, and he will be sorely missed by all.

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It is difficult to believe that nearly a year has passed since I assumed the presidency of the Association. I turn over the reins to Dorothy Auth at the Annual Meeting on May 19; so this will be my final column as President.

This past year has been marked by several achievements that point the Association in a direction to be increasingly relevant to its members. The Legislative Action Committee, working in close collaboration with our Government relations consultant, American Continental Group, has actively participated in the legislative process involving H.R. 9 (the Innovation Act) in the House, the STRONG (Strengthening The Resilience of Our Nation on the Ground) Act in the Senate, and potential compromise legislation. We have met with a United States senator and congressional staffers, have prepared white papers and bill markups, and are closely following all legislative developments relating to intellectual property. We believe that the Association—as a neutral observer not tied to the interests of any particular industry or client, but having only the quality of the patent system in mind—is one that can have great influence in Congress.

The Association has also sought to have influence in the courts. In addition to regularly monitoring important judicial developments and reporting on most of them in this Bulletin, we have filed amicus briefs before the U.S. Supreme Court and the Court of Appeals for the Federal Circuit on issues as diverse as patentable subject matter (*Alice Corp. v. CLS Bank*), the award of attorney fees (*Highmark v. Allcare Health Management Systems* and *Octane Fitness v. ICON Health & Fitness*), the rebroadcast of television programming (*American Broadcasting Cos. v. Aereo, Inc.*), the effect to be given in litigation to TTAB proceedings (*B&B Hardware v. Hargis Industries*) and seminal issues relating to post-issuance proceedings under the AIA (*In re Cuozzo Speed Technologies*).

We have expanded our influence with the third branch of government as well. The Association regularly comments on proposed USPTO

rules and has established an excellent working relationship with senior USPTO officials, including Director Michelle Lee. We believe that this ongoing relationship will lead to an improved Patent and Trademark Office, which will inure to the benefit of our members and the public at large.

Our members have also been the beneficiaries of numerous programs coordinated by the Programs Committee along with substantive law committees. The Association now sponsors so many programs on so many varied topics that space requirements do not permit me to list them all here. However, I would like to specifically mention the extremely well-received program conducted in Troy, New York, in association with Rensselaer Polytechnic Institute and the IP and Innovation American Inn of Court, spearheaded by my immediate predecessor Charlie Hoffmann. Remembering that this is the New York Intellectual Property Law Association and not the Manhattan Intellectual Property Law Association, I believe that the Association is well on its way to expanding its geographic reach.

Last, but certainly not least, the Association conducted the 93rd Annual Dinner in Honor of the Federal Judiciary on March 27. We had over 2,700 total guests, including 142 honored guests among whom were 96 Article I and Article III judges. The dinner was highlighted by the speeches of our Outstanding Public Service Award recipient, Chief Administrative Patent Judge James Smith, of the Patent Trial and Appeal Board, and our keynote speaker, the Hon. Madeleine K. Albright. Afterwards, I was pleased to hear from many judges how much they enjoyed the dinner and look forward to attending next year's dinner.

As President of the Association this past year, I have often been the recipient of accolades that are truly intended for the Association as a whole. I have been privileged to work with an outstanding Board and collection of Committee Chairs, and can truly say that I thoroughly enjoyed my tenure. I wish my successors all the best.



Anthony Lo Cicero

# GATT Patent Term? A Look Back at the Implementation and Ramifications of GATT

By William A. Di Bianca and Brian R. Tomkins\*

June 8, 2015, will mark 20 years since implementation of the General Agreement on Tariffs and Trade (“GATT”) Uruguay Round legislation in the United States. A significant part of the legislation included provisions relating to patent term and provisional applications. As June 8 of this year approaches, we look back at how this legislation changed the patent landscape, consider whether its intended effects were realized, and discuss its continued impact on patent practice.

Prior to the enactment of GATT, the term of protection afforded to a U.S. utility patent was 17 years measured from the date the patent was granted (provided, of course, that the required fees for maintaining the patent in force were paid). A priority claim from an earlier-filed application or the length of prosecution had no effect on patent term. In fact, it was a well-known strategy in the pre-GATT era for applicants either to stall prosecution or to file continuation application after continuation application (known as “submarine” applications), thereby potentially extending the patent protection for an invention indefinitely.

GATT mandated the term of protection to extend from the date of patent grant until 20 years from the earliest effective U.S. filing date of the application for the patent. 35 U.S.C. § 154(a)(2). Thus, if priority from an earlier U.S. patent application is claimed under Sections 120, 121, or 365(c), the 20-year period is measured from the date of the earliest of such priority applications. *Id.* As a transitional measure, for patents that were already in force on June 8, 1995 or that issued on an application filed before June 8, 1995, the patent term became either 17 years measured from the date of grant or the 20-year term provided above, whichever expires later. 35 U.S.C. § 154(c)(1).

This complete overhaul of patent term calculation significantly changed the effect of “obviousness-type double patenting” (i.e., attempts to extend patent term through multiple applications

directed to similar inventions) and the use of terminal disclaimers to remedy the problem. Under the pre-GATT framework, the ability of the Patent and Trademark Office (“PTO”) to require terminal disclaimers neutralized continuation-after-continuation filing as a strategy used by patent prosecutors for applications with claims that did not recite patently distinct inventions. Terminal disclaimers are still widely used under the post-GATT framework, although, with the exception of cross-family terminal disclaimers, they do little more than limit Patent Term Adjustment determinations (i.e., term extensions due to delays in the PTO), ensure that common ownership within a patent family is maintained, and provide further assurances to the public about the term and expiration of a patent family.

The GATT Uruguay Round legislation also introduced the new patent application format of provisional applications, which provided domestic applicants an opportunity to be placed on an even footing with foreign applicants. Importantly, neither provisional applications nor foreign national applications from which U.S. applications claim priority trigger the start of the 20-year patent term. To this day, the filing of a provisional application continues to provide an inventor with up to one year to further develop the invention, manufacture, determine marketability, acquire funding or capital, sell, explore partnerships, and seek licensing opportunities before the filing of a formal application is required, which initiates the 20-year patent term.

The value of provisional applications has perhaps been no greater than it is now, with the recent implementation of the America Invents Act (“AIA”). The fundamental shift from a “first-to-invent” system to a “first-to-file” system all but necessitated the active filing of provisional applications by inventors to secure the earliest possible priority date.

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While the 20-year anniversary of GATT implementation provides a nice opportunity to reflect on the changes our patent practice has seen, as June 8, 2015, comes and goes, we must remember that patents issued on pre-GATT filings will not magically expire when the clock strikes midnight. There are, of course, those patents that issued less than 17 years ago from applications that were filed prior to June 8, 1995 (and for which maintenance fees were paid). Those patents, while dwindling in number with each passing day, are still alive and well. An even smaller subset includes those applications filed prior to June 8, 1995, which are still pending. The Gilbert Hyatt portfolio is just one example of a patent family with such applications still being prosecuted. *See, e.g.*, U.S. App. Ser. No. 05/302,771. Yes, the vestiges of submarine applications remain, albeit not nearly at the same level as in the pre-GATT period.

As a practical matter, pre-GATT patent references will still be of high importance even after the June 8, 2015 anniversary for practitioners conducting freedom-to-operate studies and due diligence associated with licenses and acquisitions. At the most basic level, one cannot simply pass over any patent with an effective filing date of at least 20 years ago on the assumption that such a patent must have expired. Instead, one must still undertake the same analysis that has been performed for most of the past 20 years in order to determine if a specific patent is pre-GATT and, if so, whether it has expired.

The ramifications of pre-GATT patents do not end there. If an agreement includes a royalty provision and implicates a pre-GATT patent, care

should be taken in drafting or reviewing such a provision, since the implication of the standard phrase “payments shall be made until the last patent expires” could be far-reaching. And naturally, the financial modeling of such a royalty stream must also take into account the existence of any pre-GATT patents that could extend such payments out further than expected.

Therefore, along with the implementation of the AIA into U.S. patent law and practice, patent practitioners must remember that, even after June 8, 2015, we will continue operating within three separate, date-dependent, legal frameworks: pre-GATT; post-GATT but pre-AIA; and post-AIA.



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# Supreme Court Trademark Decision Creates More Questions Than Answers

By Dyan Finguerra-DuCharme\*

On March 24, 2015, in a 7-2 decision, the U.S. Supreme Court reversed the Eighth Circuit's decision in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, by holding that a Trademark Trial and Appeal Board ("TTAB") decision on the issue of likelihood of confusion has preclusive effect in a subsequent district court trademark infringement action "[s]o long as the other ordinary elements of issue preclusion are met [and] when the uses adjudicated by the TTAB are materially the same as those before the district court." 135 S. Ct. 1293, 1311 (2015).

The majority opinion, delivered by Justice Alito, came after an 18-year battle between the parties, which began when Hargis applied to register SEALTITE in 1996. B&B opposed Hargis's application, arguing before the TTAB that Hargis's SEALTITE mark was confusingly similar to B&B's SEALTIGHT mark, which was registered in 1993. The TTAB agreed with B&B and denied Hargis's registration. Even though it had the right to appeal, Hargis did not seek judicial review of the TTAB's decision in the Federal Circuit or district court.

In addition to initiating a TTAB opposition proceeding, B&B sued Hargis for trademark infringement in federal court. Before the district court ruled on the main issue of likelihood of confusion, the TTAB issued its decision denying Hargis's registration. B&B then argued to the district court that the TTAB's decision precluded Hargis from relitigating the issue of likelihood of confusion. The district court refused to apply collateral estoppel on the issue of likelihood of confusion and gave no deference to the TTAB decision. In the end, an Arkansas jury determined that there was no likelihood of confusion. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 736 F. Supp. 2d 1212 (E.D. Ark. 2010).

The Eighth Circuit affirmed the district court's decision to not accord collateral estoppel to the TTAB's finding. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 716 F.3d 1020, 1025 (8th Cir. 2013). The court assessed whether the TTAB addressed the same matter as that which was sought to be precluded and concluded that because the TTAB focused mainly on the registration and the application and not on the "marketplace context,"

its analysis was not entitled to either a preclusive effect or deference. B&B petitioned for certiorari, which the Supreme Court granted.

In the Supreme Court, the NYIPLA filed an amicus brief in support of the Respondents, arguing that TTAB decisions should not be given preclusive effect as a matter of course in a subsequent litigation between the parties concerning the same marks at issue before the TTAB. The NYIPLA further argued that on the rare occasion that the TTAB considered marketplace evidence so that the parties have had a full and fair opportunity to be heard, the court should give minimal evidentiary weight to the TTAB decision on the narrow issue of registrability.

While the Supreme Court did not adopt the NYIPLA's suggested approach, the Court's decision acknowledged and addressed the concerns raised in our brief. In particular, the thrust of the NYIPLA's main argument was that because critical information concerning marketplace usage is not assessed by the TTAB, its decision should not be given automatic preclusive effect in a subsequent litigation. Some examples of how the evidence presented in each forum differs are as follows: (1) if the drawing for at least one of the marks is in standard character form, the TTAB will compare the marks visually and phonetically without regard to the intended stylization, whereas a court will compare the marks as they appear in commerce, including the visual similarities, as well as the marks' actual pronunciation, stylization, and appearance; (2) the TTAB compares the goods as they are identified in the application and registration, which are oftentimes very broad and appear to overlap, whereas a court will look to the actual services rendered or goods sold bearing the mark; (3) if the channels of trade and targeted consumers are not limited in either the registration or application, the TTAB will presume that the goods/services travel through normal channels and are targeted to ordinary purchasers of the identified goods/services; in contrast, a court will consider the actual channels of trade and targeted consumers, including retail price points, packaging, advertising, and merchandising markets.

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The Court addressed these concerns by ruling that “if the TTAB does not consider the marketplace usage of the parties’ marks, the TTAB’s decision should ‘have no later preclusive effect in a suit where actual usage in the marketplace is the paramount issue.’” 135 S. Ct. at 1308 (quoting 6 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 32:101, at 32-247 (4th ed. 2014)).

In a concurring opinion, Justice Ginsburg echoed the majority’s observation that “for a great many registration decisions issue preclusion obviously will not apply,” because contested registrations are usually decided based on a “comparison of marks in the abstract and apart from their marketplace usage.” Under those circumstances, “there will be no [preclusion] of the likel[i]hood of confusion issue.” 135 S. Ct. at 1310 (Ginsburg, J., concurring) (quoting 6 McCarthy on Trademarks § 32:101, at 32-247).

It remains to be seen how the *B&B Hardware* decision will affect practice before the TTAB. Often TTAB proceedings are initiated to test the waters and/or to keep the Register “clean.” Before *B&B Hardware*, the issue was solely whether the applicant can register the mark, not whether it can use the mark. Because of that critical difference, parties often choose not to present the same evidence before the TTAB that they would present in federal court because the TTAB has been quite clear that it looks only to the identification of goods in the registration and application and presumes that a standard character mark can appear in any stylization. Now litigants are in a quandary – do they submit marketplace usage to the TTAB or do they stick to arguments related to the identified goods and hope that the decision will not be given preclusive effect? Does the TTAB have to consider marketplace usage even if it broadens or narrows the identified goods? How does the TTAB treat visual and commercial impression similarities if the application and registration are in standard character form yet the stylization of the respective marks in the marketplace are clearly distinctive and different? When is actual usage not the paramount issue in an infringement case?

In response to a TTAB opposition filing, an applicant must now consider whether its resources are better spent in a declaratory judgment action given that there is a significant chance that the TTAB decision will ultimately determine whether it may use the mark at issue. If litigants are going to spend more money on the issue of confusion, they might as well do so in federal court where they can take advantage of live testimony, broader survey designs, and live judicial intervention

throughout the case rather than just at oral argument after trial briefing is complete.

TTAB Chief Administrative Trademark Judge Gerard F. Rogers will be the keynote speaker at the Trademark Law & Practice Committee’s annual Half-Day Program set for July 15, 2015. The NYIPLA is looking forward to hearing from Judge Rogers about the TTAB’s reaction to *B&B Hardware* and gaining insights with respect to proposed changes to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) in light of the decision.



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## Hot Topics in Intellectual Property Law

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**Keynote Speaker Chief Judge Gerard F. Rogers,**  
*Trademark Trial and Appeal Board*

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- **Increased Scrutiny to Trademark Applications Based on Foreign Registrations**  
**Sandra Edelman, Partner, Dorsey & Whitney**
- **Tips on Prosecution from a Former Trademark Examiner**  
**Teresa Lee, Partner, Pryor Cashman**
- **Cyber Intrusions and Theft of IP/Trade Secrets**  
**Seth DuCharme, Deputy Chief, Terrorism and Cybercrimes Unit, United States Attorney's Office for the Eastern District of New York**
- **Attorney Advertising and Social Media and Ethical Implications - **EARN ETHICS!****  
**Michael Graif, Social Media Law Adjunct Professor, Benjamin N. Cardozo School of Law**
- **Recent Developments in Copyright Law**  
**Joe Salvo, former head of Sony Music Legal and current GC for Hit Entertainment**
- **Update on the Hague**  
**David Gerk, United States Patent and Trademark Office**

# Product Configuration Trade Dress: A Case Study

By Michael C. Cannata\*

One of the underlying policy considerations of the Lanham Act is to protect consumers against false or misleading representations concerning affiliation or origin. In that connection, Section 43(a) of the Lanham Act outlines certain protections that facilitate this important policy consideration. One such protection extends to a product's trade dress, which can include, among other things, a product's configuration or packaging. With respect to product configuration trade dress infringement claims involving unregistered trade dress, courts generally require that a plaintiff allege that:

- (1) the claimed trade dress is not functional;
- (2) the claimed trade dress has acquired secondary meaning; and
- (3) there is a likelihood of confusion between the plaintiff's product and the defendant's product.

*Sherwood 48 Assocs. v. Sony Corp. of Am.*, 76 F. App'x 389, 391 (2d Cir. 2003) (citing *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115-16 (2d Cir. 2001)). In addition, courts require that a plaintiff identify the precise character and scope of the trade dress. *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997); *Shevy Custom Wigs, Inc. v. Aggie Wigs*, No. 06-CV-1657, 2006 U.S. Dist. LEXIS 83495, at \*13-14 (E.D.N.Y. Nov. 17, 2006). Given that a broad application of trade dress protection may stifle open competition in the marketplace, courts carefully scrutinize product configuration trade dress claims. The level of scrutiny for such claims was recently underscored by the U.S. District Court for the Eastern District of New York in *Carson Optical, Inc. v. Prym Consumer USA, Inc.*, 11 F. Supp. 3d 317 (E.D.N.Y. 2014) ("*Carson Optical*").

*Carson Optical* involved a dispute between competitors that sold magnification devices to a national retailer. *Id.* at 325. Specifically, Carson Optical, Inc. ("Carson") alleged that Prym Consumer USA, Inc. ("Prym") was able to successfully displace Carson as a supplier to Jo-Ann Stores, Inc. by, among other things, infringing the trade dress affiliated with the SureGrip magnifier product sold by Carson. *Id.* Prym moved to dismiss several of the claims asserted by Carson, including Carson's trade dress infringement claim. After considering the arguments advanced by the parties, the court dismissed, with prejudice, Carson's product configuration trade dress infringement claim. *Id.* at 347. In reaching this holding, the court carefully evaluated each of the above-referenced elements.

## 1. Non-Functionality

The "test of non-functionality in trade dress claims that are based on product design is even more critical than in trade dress claims based on packaging, because a monopoly right in the design of the product itself is more likely to preclude competition..." *Id.* at 341 (citing *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 116 (2d Cir. 2001)). Accordingly, trade dress will be deemed "functional, and thus not protectable, when it is essential to the use or purpose of the article." *Id.* at 340 (citing *Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 F. App'x 615, 620 (2d Cir. 2008)).

In *Carson Optical*, Carson alleged that the following elements of the SureGrip magnifier were non-functional: (1) the size, placement, and oval shape of the label on the magnifier's handle; (2) the color scheme of the magnifier; (3) the positioning of the smaller magnifying lens; and (4) the ledge on the rim of the larger magnifying lens. *Id.* at 341. With respect to this element, the court concluded that the allegations supported a reasonable inference of non-functionality as effective competition in the magnifier marketplace would not require use of these particular features of the SureGrip magnifier. Stated differently, a competitor would be capable of designing a competing magnifier that did not contain these discrete design features. *Id.* at 341-42.

## 2. Secondary Meaning

The purpose of this element is to make certain that the trade dress identifies the source of the product. In assessing whether a product design has acquired secondary meaning, the following factors are considered: (1) advertising expenditures; (2) consumer studies; (3) unsolicited media coverage; (4) sales success; (5) attempts to plagiarize the design; and (6) the length and exclusivity of the design's use. *Id.* at 343 (citing *Cartier, Inc.*, 294 F. App'x at 618).

Carson attempted to demonstrate secondary meaning by alleging that Carson had continuously and exclusively marketed and sold the design, and engaged in a substantial advertising campaign involving the design, that the design was a sales and marketing success, and that it was featured in numerous periodicals, and received excellent reviews. *Id.* at 343. The court rejected these allegations as conclusory and held:

In sum, absent from the pleadings are facts concerning actual consumer surveys, unsolicited

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media coverage or specific attempts to plagiarize the trade dress at issue which would support an inference that the trade dress of the SureGrip acquired secondary meaning. In addition, plaintiffs' general and cursory allegations that Carson has sold, marketed and promoted the SureGrip trade dress design since 1998, has spent substantial sums of money advertising the product design and that these designs have been a sales and marketing success, with no factual enhancement linking the claimed trade dress to Carson, fail to support an inference that SureGrip has acquired secondary meaning.

*Id.* at 344-45.

Accordingly, the court concluded that Carson did not allege sufficient facts to support the contention that the alleged trade dress associated with the SureGrip magnifier identified the source of the SureGrip magnifier.

### 3. Likelihood of Confusion

The likelihood of confusion component of a product configuration trade dress claim, similar to a traditional trademark infringement claim, requires the application of a multi-factored test. The purpose of that test is to determine whether prudent purchasers are likely to be confused as to the source of the product in question because of the defendant's trade dress. *Id.* at 345 (citing *Playtex Prods., Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 161 (2d Cir. 2004)); *Conte v. Newsday, Inc.*, No. 06-CV-4859, 2013 U.S. Dist. LEXIS 35676, at \*68 (E.D.N.Y. Mar. 13, 2013). In assessing likelihood of confusion, courts evaluate the following factors:

- strength of the plaintiff's mark or dress;
- similarity between the two marks or dresses;
- proximity of the products in the marketplace;
- likelihood that the prior owner will bridge the gap between the products;
- evidence of actual confusion;
- defendant's bad faith;
- quality of defendant's product; and
- sophistication of the relevant consumer group.

*Id.* (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)); *Blumenthal Distrib., Inc. v. Executive Chair, Inc.*, No. 10-CV-1280, 2010 U.S. Dist. LEXIS 142193, at \*27 (E.D.N.Y. Nov. 9, 2010).

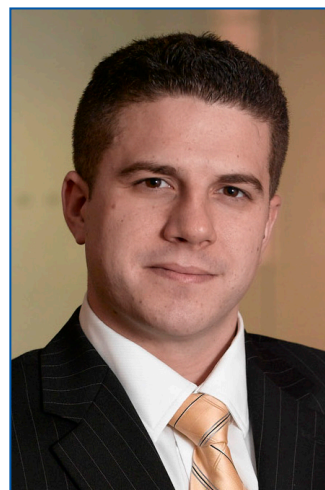
In *Carson Optical*, the court concluded that Carson did not satisfactorily allege the likelihood of confusion element of Carson's trade dress claim and that the allegations which sought to establish this particular element were "essentially a formulaic recitation of the *Polaroid* factors." *Id.* at 346. For example, with respect to the strength of its trade dress, Carson alleged that "the

distinctive and non-functional aspects of the SureGrip enumerated above are strongly associated with Carson by the relevant market." *Id.* Likewise, with respect to the similarity between the designs at issue, Carson alleged that the Prym product "incorporates all of the above enumerated distinctive and non-functional aspects to the SureGrip identically or nearly identically." *Id.* The court concluded that such "naked assertions" did not allow the court "to draw the reasonable inference that there is a likelihood of confusion." *Id.*

### 4. Character and Scope

The final requirement is that a plaintiff not only identify those components of its design that are claimed to be distinctive, but also explain how such components are distinctive. Laudatory descriptions of the designs which are claimed to be distinctive without specificity are not acceptable. *Id.* at 346 (citing *Landscape Forms, Inc.*, 113 F.3d at 381-82). With respect to this element, the court in *Carson Optical* concluded that Carson properly articulated the elements that constitute the trade dress, and that such elements had been determined by the court to be non-functional. *Id.* at 347. However, the court went on to conclude that the complaint was devoid of any allegations explaining "how the asserted trade dress elements for the SureGrip magnifier are distinctive." *Id.* Accordingly, for this reason, and those outlined above, the court dismissed Carson's trade dress infringement claim.

The takeaway for both plaintiffs and defendants from *Carson Optical* is clear. Plaintiffs must make absolutely certain that they are equipped with sufficient facts to adequately allege all of the elements of a product configuration trade dress claim. Likewise, defendants tasked with defending against such a claim must carefully scrutinize the allegations of the complaint, identify those allegations that are nothing more than a formulaic recitation of the legal elements of a cause of action, and assess the viability of an early dispositive motion.



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# Summary of Pending Legislation Affecting Trademarks

By James Bikoff\*

Several bills that affect trademark owners and their counsel, monitored by the NYIPLA Trademark Practice & Law Committee, were recently reintroduced. Brief summaries of these bills are as follows:

## **H.R. 236: Foreign Counterfeit Merchandise Prevention Act**

Ted Poe (R-TX 2nd District) reintroduced H.R. 236, the Foreign Counterfeit Merchandise Prevention Act (formerly H.R. 22), on January 9, 2015. H.R. 236 would amend the Trade Secrets Act to expand the ability of U.S. Customs and Border Protection (“Customs”) to share information about potentially infringing items following their detention or seizure, without having to first consult the owner of the detained product. It also would amend the Lanham Act to expand information-sharing capability between Customs and trademark owners in those instances in which detained items suspected of bearing a counterfeit mark constitute critical merchandise—posing, for example, a danger to the health, safety or welfare of consumers, or to the national security of the United States.

## **H.R. 635: Promoting American Agricultural and Medical Exports to Cuba Act of 2015**

H.R. 635, Promoting American Agricultural and Medical Exports to Cuba Act of 2015, introduced by Rep. Charles Rangel (D-NY 13th District) on February 2, 2015, and S. 757, No Stolen Trademarks Honored in America, successor to H.R. 778, introduced by Senator Bill Nelson (D-FL) on March 17, 2015, would modify the prohibition on recognition by U.S. courts of rights in trademarks. H.R. 635, as well as H.R. 403, Free Trade With Cuba Act, introduced by Rep. Rangel on January 16, 2015, H.R. 274, United States-Cuba Normalization Act of 2015, introduced by Rep. Bobby Rush (D-IL 1st District) on January 12, 2015, and H.R. 735, Cuba Reconciliation Act, introduced by Rep. Jose Serrano (D-NY 15th District) on February 4, 2015, all would lift the trade embargo on Cuba.

## **H.R. 9: Innovation Act**

A successor to the Innovation Act, H.R. 3309, 113th Cong. (2013), this bill is intended primarily to address allegedly abusive patent litigation practices by “patent

assertion entities,” referred to pejoratively as “patent trolls.” Nevertheless, the bill also contains provisions pertaining to certain types of bankruptcy proceedings that would, if enacted, affect the treatment of trademark licenses under the Bankruptcy Code.

Specifically, Paragraph (2) of the bill: (a) adds trademarks, service marks, and trade names to the definition of intellectual property in the Bankruptcy Code, so that trademark licensing agreements will be treated the same as other intellectual property licenses under 11 U.S.C. § 365(n); (b) provides that a licensee who elects to retain its rights must continue to make “royalty or other payments” due under the licensing agreement, and not merely “royalty payments,” as § 365(n) currently provides; and (c) provides that debtor-licensees will not be relieved of contractual obligations to monitor and control the quality of licensed products or services. In sum, the bill attempts to provide “for trademark licenses to be retained instead of voided in bankruptcy.”

However, under *Sunbeam Products, Inc. v. Chicago American Manufacturing, LLC*, 686 F.3d 372 (7th Cir. 2012), *cert. denied*, 133 S. Ct. 790 (2012), trademark licensees do not lose their rights under licensing agreements when debtors reject them. It is the view of some practitioners that this bill does not properly account for the *Sunbeam* decision and will place trademark licensees at a greater disadvantage to the debtor-licensee than without this legislation.

## **S. 328: “A bill to amend the Trademark Act of 1946 to provide for the registration of marks consisting of a flag, coat of arms, or other insignia of the United States, or any State or local government, and for other purposes” (formerly S. 1816)**

Under current law, 15 U.S.C. § 1052(b), an applicant’s trademark registration is subject to refusal if the mark consists of or comprises the flag or coat of arms or other insignia of the United States, or of any state or municipality, or of any foreign nation, without providing an exception for the registration of such marks by government entities. This bill, reintroduced by Senator Amy Klobuchar (D-MN), would amend the Lanham Act to allow the U.S. government, or any state or local government, to register its flag, coat of arms, or other official seals as trademarks.

*cont. on page 10*

cont. from page 9

## H.R. 684: Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act of 2015

Formerly H.R. 1278, this bill, introduced by Rep. Michael M. Honda (D-CA17th District), aims to amend the Lanham Act to provide for a conclusive presumption that a “mark that uses the term ‘redskin’ or any derivation of that term consists of matter which may disparage persons if: (1) it has been, is, or is intended to be used in commerce in connection with references to or images of Native Americans; or (2) the U.S. Patent and Trademark Office (USPTO) determines that the term as included in the mark is commonly understood to refer to Native Americans.” As Section 2(a) of the Lanham Act bars registration of marks that consist of or comprise disparaging matter, the USPTO would be required to cancel any such marks already on the Register. It has 32 Democratic co-sponsors.

The bill is timely, as there is ongoing litigation between Pro-Football, Inc. (i.e., the Washington, D.C. football team) and several Native Americans regarding the cancellation of Pro-Football’s federal registrations for the REDSKINS mark.



\* James Bikoff is a partner in the Intellectual Property Practice of Smith, Gambrell & Russell, LLP. His practice focuses on formulating and implementing worldwide trademark and copyright protection and enforcement programs for clients in the consumer and industrial product sectors, as well as non-profits, and service providers such as banks and insurance companies. He also engages in Internet and domain name counseling and enforcement actions. For any questions or comments on any of these bills, please contact Jim Bikoff at [jbikoff@sgrlaw.com](mailto:jbikoff@sgrlaw.com).

## Moving UP ▲ & Moving ON ►►►

- ▶ Craig Whitney, formerly of Morrison & Foerster LLP, has joined Frankfurt Kurnit Klein + Selz as a partner in the Litigation and Intellectual Property Group.
- ▶ Foley Hoag LLP has opened an office in New York City led by Peter Sullivan and Walter Egbert III, formerly of Hughes Hubbard & Reed LLP, who join as partners in the intellectual property practice.
- ▶ Lisa A. Chiarini, formerly of Hughes Hubbard & Reed LLP, has joined Fish & Richardson PC as a principal its Intellectual Property Litigation Group.
- ▶ James Dabney, formerly of Fried, Frank, Harris, Shriver & Jacobson LLP, has joined Hughes Hubbard & Reed LLP as a partner in and co-head of the Firm’s Intellectual Property and Technology Practice group.
- ▶ Jeffrey I.D. Lewis, formerly of Patterson Belknap Webb & Tyler LLP, has joined Fried, Frank, Harris, Shriver & Jacobson LLP as a partner in the Intellectual Property Litigation Practice.
- ▶ Brian Slater and Gregory Sephton, formerly of Fitzpatrick, Cella, Harper & Scinto, have joined Kramer Levin Naftalis & Frankel LLP as partners in the intellectual property department. Mr. Slater also joins as Chair of the Life Sciences Practice.
- ▶ William R. Hansen and Bridget A. Short have joined Fox Rothschild LLP as partners, and Suzanna M. M. Morales has joined as counsel, in its Intellectual Property Department. All three join from Lathrop & Gage LLP.
- ▶ Michael Eisenberg, formerly of Latham & Watkins LLP, has joined Holland & Knight LLP as a partner in its intellectual property practice.

The Bulletin’s Moving Up and Moving On feature is for the Association’s members. If you have changed your firm or company, made partner, received professional recognition, or have some other significant event to share with the Association, please send it to the Bulletin editors: Mary Richardson ([mary.e.w.richardson@gmail.com](mailto:mary.e.w.richardson@gmail.com)) or Robert Greenfeld ([rgreenfeld@stepsto.com](mailto:rgreenfeld@stepsto.com)).

# 93<sup>rd</sup> Annual Dinner in Honor of the Federal Judiciary

The New York Intellectual Property Law Association held its 93<sup>rd</sup> Annual Dinner in Honor of the Federal Judiciary on March 27, 2015 at the Waldorf Astoria New York Hotel. President Anthony F. Lo Cicero welcomed the honored guests, members of the NYIPLA, and their guests. Joseph Bartning, Amy Buckley and Malena Dayen opened the evening's events with a magnificent rendition of the National Anthem.

The Association's Thirteenth Annual Outstanding Public Service Award was presented to the Honorable James D. Smith, Chief Administrative Patent Judge of the United States Patent and Trademark Office. The Keynote Address was given by Dr. Madeleine K. Albright, former United States Secretary of State (1997-2001).



*Standing:* Kevin Ecker, Hon. Janet Hall, Hon. Leonard Davis, Denise Loring, Hon. William Skretny, Annemarie Hassett, Hon. Richard Roberts, Hon. Joy Flowers Conti, Hon. Leonard Stark  
*Sitting:* Hon. Carol Bagley Amon, Walter Hanley, Hon. Sharon Prost, Anthony Lo Cicero, Dr. Madeleine Albright, Hon. James Smith, Dorothy Auth, Hon. Ruben Castillo, Hon. Loretta Preska

## Chief Administrative Patent Judge James D. Smith's Remarks Upon Receiving the NYIPLA's Outstanding Public Service Award at the 93<sup>rd</sup> Annual Dinner in Honor of the Federal Judiciary



**M**adame Secretary Albright, distinguished platform guests, your Honors from all the Honorable Courts represented, Mr. President Lo Cicero, other officers and members of the New York Intellectual Property Law Association, and other guests, including my mother:

What a rare opportunity to stand before such a distinguished group and accept this honor on behalf of the Patent Trial and Appeal Board [and address a whole group of judges that are not permitted to stop me and ask any questions! We'll have to hope this doesn't cause any anxiety attacks for them.]

Thank you, New York Intellectual Property Law Association. Thank you so much – and, of course, that is the one thing I really wish to say; thank you.

A very special classmate of mine from law school who – quite marvelously – persuaded Circuit Judge Paul R. Michel to take me on as a clerk 25 years ago wrote me this week – with this evening in mind – to admonish me along these lines: “James, many people go a whole lifetime without the thrill of the type of recognition these New Yorkers so generously have decided to bestow on you and the Patent Trial and Appeal Board. Treasure each moment of the evening with an awareness of how inexplicably blessed you are that they have done this.” Those are certainly words to take to heart, and I have.

In the seemingly countless hours working to help the Patent Trial and Appeal Board succeed at the nearly overwhelming challenge of deciding a preexisting mountain of appeals, and a new, similarly prodigious mountain of trial matters, there certainly has been the possibility of our thinking that no one was watching or cared about the amount and difficulty of our work; and consequently much possibility for us to have become discouraged. Thank you so much, NYIPLA, for having

watched and cared. It is transformative and uplifting to the human spirit to arrive at a new sense that our efforts are observed and appreciated.

It would appear that the Outstanding Service Award does bear my name. Certainly the designation of the recipient is by your knowing design merely the designation of a representative, and the inscription intentionally rendered in abbreviated fashion. We know “Chief Judge James Smith” on the plaque to be code for: “James Smith, merely as representative of all of his fabulously intelligent and hardworking colleagues at the Patent Trial and Appeal Board.” May I only lay eyes upon or contemplate this award with an undiminished appreciation for the privilege that it has been to work, as part of a team, with my Board colleagues, and to try to lead that team honorably.

At various times in the past four years the following individuals have served in leadership roles at the Board. Everything within me would revolt against not having mentioned their names to ensure the special recognition they so deserve. Judges Jay Moore, Scott Boalick, Michael Tierney, Linda Horner, Allen MacDonald, Barbara Benoit, Miriam Quinn and Ken Barrett. And let me mention also Ms. Krista Flanagan, a very special Board Patent Attorney, who has done as much as anyone in our endeavor for achievement. And I also must mention Ms. Janet Gongola, who served as the Agency Coordinator for Implementation of the provisions of the Smith-Leahy America Invents Act, and now is serving as Senior Advisor to the Under Secretary of Commerce for Intellectual Property; in both roles, she has been magnificently supportive of the Patent Trial and Appeal Board.

I also do want to thank my parents, family and friends for their guidance and support. My mother and sister are present. I apologize to my mother and my late father – both educators – for any moments along the journey of life in which I did not honor them by working as hard as they did. They are the finest models of commitment, diligence and hard work that could be found anywhere. Maybe the last four years have been part of my attempt to try to make amends for any dereliction tending toward laziness in times hopefully long past.

Finally, if the joy of the moments tonight has within it as much satisfaction as can arise from the fullness of all the Board's combined efforts, some great joy is indeed possible.

I thank all my colleagues at the Patent Trial and Appeal Board, and, again, I thank you, New York Intellectual Property Law Association. ■



# April/May 2015 IP Media Links

By Jayson L. Cohen\*

## Kodak's Present and Possible Future – Technology and IP

Quentin Hardy wrote a piece for The New York Times, dated March 20, 2015, entitled “At Kodak, Clinging to a Future Beyond Film.” The article describes a Kodak that emerged from bankruptcy in 2013 smaller and less self-sufficient than in its heyday. According to current Kodak CEO, Jeff Clarke, the key to Kodak’s future is leveraging previously developed commercially viable technologies (including the related intellectual property) that the old Kodak never commercialized, as well as developing new technologies and IP through Kodak’s ongoing and active R&D function. These technologies include digital printing technologies, nanoparticle inks, sensors, and touch screens. In its current form and financial position, Hardy reports that Kodak cannot bring these new products to market on its own; rather, it expects to partner with companies that can make the products that Kodak would like to sell (and perhaps without using the once iconic Kodak brand and its corresponding trademarks). But, as the article stresses, profitability for Kodak is an open question given market competition, even in cases where Kodak’s technology is allegedly better. Right now, Kodak is losing money, and restructurings and layoffs continue to be part of the Kodak story. Hardy’s article closes, tongue in check, by straddling the positive and negative: “There is, indeed, no sign that the changes will stop coming.” (<http://www.nytimes.com/2015/03/22/business/at-kodak-clinging-to-a-future-beyond-film.html>.)

## A Twain Blast from the Past! New Copyrights for the Future?

On May 4, 2015, for the Associated Press, and on May 5, 2015, in the Los Angeles Times, Janie Har and Carolyn Kellogg, respectively, published articles about scholars at the University of California, Berkeley, who found 110 previously lost letters in the form of newspaper columns written by Mark Twain in 1865 and 1866 for his then-employer, the San Francisco Dramatic Chronicle. While these articles as originally published have been lost to San Francisco fires, the Twain scholars at Berkeley, led by Bob Hirst, apparently found and collected Twain’s letters by mining the now digitized archives of western newspapers outside San Francisco. There is a plan to publish these Twain letters as a compilation book. While any copyright that may have existed for these letters has almost certainly expired, one would expect the book compilers and their publisher to claim a copyright on what will be a fas-

cinating compilation. (<http://bigstory.ap.org/article/9649e9bd569f4f24acce7b08ee8a45a6/uc-berkeleys-mark-twain-project-finds-cache-new-writing>; <http://www.latimes.com/books/jacketcopy/la-et-jc-lost-mark-twain-stories-recovered-by-berkeley-scholars-20150505-story.html>; *see also* <http://www.theguardian.com/books/2015/may/04/mark-twain-cache-uncovered-berkeley>.)

## Whole Foods' Trademarks Hint at Future Chain

In a May 7, 2015 piece, entitled “Clever Egg? Filings may hint at the name for new Whole Foods chain,” Leslie Patton wrote for Bloomberg News about Whole Foods’ plans, announced on May 6, to open a lower-priced chain of grocery markets. The move is seen as a reaction to increased competition in the organic and locally grown produce food markets, as such foods become more available through large retailers like Kroger and WalMart. Speculating about the name of the new chain, Ms. Patton reported on Whole Foods’ trademark-application activity in the week leading up to the announcement. Whole Foods applied for the following marks: 365, DAILYSHOP, CLEVER EGG, SMALL BATCH, SWIFTGOODS, and GREENLIFE. Look out for a Dailyshop, Clever Egg, Swiftgoods, or Greenlife store near you in the coming months. (<http://www.bostonglobe.com/business/2015/05/07/whole-foods-trademark-filings-may-hint-new-chain-name/CnLUglBQIVW1CgYwBbCLL/story.html>.)

## Flying into the Future

The title of Daisy Carrington’s May 5, 2015 article for CNN is compelling — “Airbus and Boeing have some amazing plane ideas to shape the future of flying.” Here are the six inventions that Ms. Carrington discusses (with the names that she gave each invention in quotes) (<http://www.cnn.com/2015/05/04/travel/gallery/future-of-flight-through-patents/index.html>):

1. “Windowless cockpits” by Airbus: pilots are located away from the nose of the plane (allowing it to become more aerodynamic) and view the outside world using a digital display. (U.S. Patent Application Serial No. 14/138,574.)
2. “Smart windows” by Airbus: passenger windows in the plane cabin are “interactive touchscreen[s].” (U.S. Patent Application Serial No. 14/489,712.)

3. "Flying donut" by Airbus: a torus-shaped cabin allows for more passenger space and a more even distribution of cabin pressure. (U.S. Patent Application Serial No. 14/263,376.)
4. "Virtual reality IFE" by Airbus: virtual reality helmets for in-flight entertainment provide "sensorial isolation." (U.S. Patent No. 8,814,266.)
5. "Terrorist trap door" by Airbus: while not exactly new for 2015, a trapdoor outside the cockpit, which leads to a secured cell, allows the pilot and crew to protect against threats to the cockpit. (U.S. Patent No. 6,844,817.)
6. "Force field" by Boeing: a shockwave attenuation system detects a nearby explosion and generates a plasma to dissipate the oncoming

shock wave before impact. (U.S. Patent No. 8,981,261.) There was also a CNN article by Euan McKirdy on this invention specifically, entitled "May the force-field be with you: Boeing granted patent for 'shock wave attenuation.'" (<http://edition.cnn.com/2015/03/23/tech/boeing-shock-wave-attenuation-patent/index.html>.)



\* Jayson L. Cohen is an associate at Morrison & Foerster LLP, where his practice focuses on patent litigation and counseling. He is a member of the Publications Committee of the NYIPLA.

## NYIPLA Calendar

[www.nyipla.org](http://www.nyipla.org)

### Hot Topics in Intellectual Property Law

Keynote Speaker **Chief Judge Gerard F. Rogers**, *Trademark Trial and Appeal Board*

➤ WEDNESDAY, JULY 15, 2015 ◀

The Union League Club, 38 East 37th Street, New York, NY 10016

### 2nd Annual Second Circuit Moot Court Argument

➤ THURSDAY, JULY 16, 2015 ◀

Thurgood Marshall US Courthouse, 40 Centre Street on Foley Square, New York, NY 10007

### Global Intellectual Property Protection Strategy

Joint Program with World Intellectual Property Organization (WIPO)

➤ THURSDAY, SEPTEMBER 17, 2015 ◀

### One-Day Patent CLE Seminar

➤ FRIDAY, NOVEMBER 6, 2015 ◀

The Princeton Club, 15 West 43rd Street, New York, NY 10036

### 94th Annual Dinner in Honor of the Federal Judiciary

➤ FRIDAY, APRIL 1, 2016 ◀

The Waldorf Astoria New York Hotel, 301 Park Avenue, New York, NY 10022

# Notable Trademark Trial and Appeal Board Decisions

By Stephen J. Quigley\*

(Unless noted, all decisions are precedential.)

## TTAB Rulings Can Be Preclusive on Likelihood of Confusion

The U.S. Supreme Court, in a 7-2 ruling issued on March 24, 2015, held that an adjudication of likelihood of confusion by the Trademark Trial and Appeal Board can constitute issue preclusion in a federal district court case involving the same trademarks.



Although district courts and the Board often consider different factors, the likelihood of confusion standards they use are “not fundamentally different, and, more important, the operative

language of each statute is essentially the same.” The Court’s ruling, however, is limited to those situations “when the usages adjudicated by the TTAB are materially the same as those before the district court.” For example, where marketplace usage is a factor, the Board’s determination of likelihood of confusion will not have preclusive effect.

*B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293 (2015).

## Disparagement

PORNO JESUS as a mark for adult DVDs and videos would likely be perceived as associating Jesus Christ with pornography, which could be disparaging to a substantial composite of Christians in the United States.

A two-part test determines if a trademark is disparaging: 1) what is the likely meaning of the term, and 2) if the meaning refers to identifiable persons, institutions, beliefs or national symbols, is the term disparaging to a substantial composite of such group?

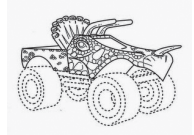
The applicant cited trademark registrations for HOOKERS FOR JESUS (charitable services), REDNECK JESUS (entertainment), JESUS FREAK (apparel), THE DAY JESUS SPOKE HIP HOP (entertainment), and WHO WOULD JESUS SUE? (publications for faith-based advocacy). The Board held that PORNO JESUS is a different type of use as it is likely to mean “Jesus of Nazareth partaking of acts related to pornographic or sexually explicit materials.”

*In re Matthew Beck*, 114 U.S.P.Q.2d 1048 (T.T.A.B. 2015).

## Functions As a Trademark

A truck cab body designed as a fanciful, prehistoric animal for monster truck exhibitions constitutes a valid trademark. The Board reversed the refusal to register on the ground that the design failed to function as a trademark.

While product designs are not inherently distinctive, product packaging for goods and services can be. In this instance, the applicant’s unique design was “akin to the packaging of what is being sold.” The design was not a commonly adopted or well-known form, nor was it a mere refinement of other monster truck designs.



*In re Frankish Enterprises Ltd.*, 113 U.S.P.Q.2d 1964 (T.T.A.B. 2015).

## “SMART” Marks Are Not Confusingly Similar

SMART ONES and SMART BALANCE, both for food products, including some that are identical, are not confusingly similar trademarks. The weakness of SMART as a trademark component was a major factor in the Board’s ruling. Other factors were 17 years of co-existence and Applicant’s survey finding that only 2% of relevant purchasers were likely to be confused.

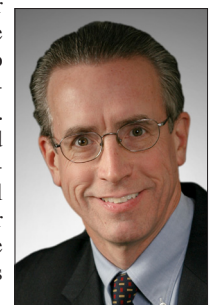
The Board also rejected Opposers’ claim that SMART ONES is a famous mark. Although sales were substantial, the mark always appeared in conjunction with the WEIGHT WATCHERS trademark, which



made it impossible to attribute the sales to the SMART ONES mark by itself.

*ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 2015 TTAB Lexis 67 (T.T.A.B. 2015).

\* Stephen J. Quigley passed away shortly after submitting this article for the April/May issue of the Bulletin. Stephen was Of Counsel to Ostrolenk Faber LLP, where his practice focused on trademark and copyright matters. He was also a member of the NYIPLA Board of Directors and the Publications Committee’s liaison to the Board of Directors, as well as a prior Publications Committee member and Chair. His insightful analysis of notable Trademark Trial and Appeal Board decisions will be greatly missed.





## As Time Goes By: Reel or Real?

Three years ago, Harvard and M.I.T. announced that they were teaming up to offer “free” online courses through a partnership known as edX, making no-credit online classes available to many thousands of students from around the globe who might not otherwise have access to this educational opportunity.<sup>1</sup> This was big news at the time and, indeed, is news that continues to play in educational circles today.

Virtually buried in history’s dustbin were earlier versions of multi-university broadband educational efforts that failed prior to the Great Recession resulting from the global banking crisis. One, called Fathom, involving Columbia University, the University of Chicago and others, began in 2001 but failed by 2003. Another, called AllLearn, involving Yale, Princeton and Stanford, failed by 2006.<sup>2</sup>

Elite universities that are considering trying to become a latter-day University of Phoenix face the risk of diluting their prestige brands. That dilemma is succinctly summarized in a 2009 article in *The Chronicle of Higher Education* entitled, “Open Courses: Free, but Oh So Costly — Online Students Want Credit; Colleges Want a Working Business Model.”<sup>3</sup> Students certainly do want credit, but most of all they seek the credentials necessary to gain entry to their first jobs out of school. So far, the free, online open-course concept appears to fall short in terms of providing desired credentials.

You may wonder how these developments in higher education might affect the business model of the NYIPLA, if at all. Obviously, an important mission of our Association is to provide for continuing legal education in the IP arena for all of our members, including the law students and newer practitioners among us.



To accomplish this goal, the Association has a well-honed

*Dale Carlson, a retired partner at Wiggin and Dana, is “distinguished practitioner-in-residence” at Quinnipiac University School of Law, NYIPLA historian, and a Past President. His email is dlcarslon007@gmail.com.*

outreach program whereby the NYIPLA’s committees engage with law schools to put on programs of interest to the students.

The most recent of these programs involved an IP careers panel discussion at Quinnipiac University School of Law on April 13th. Foremost in the students’ minds was how to connect with potential employers in the current challenging job market. Foremost in the panelists’ minds was the desire to explain to the students that they need to personally connect with potential employers in real time, rather than merely by means of an online application. Each panelist painted a unique picture about landing their first job and developing mentorships and business relationships within the IP profession. Each panelist paid tribute to the NYIPLA as a springboard for their professional growth.

Our Association’s leadership is to be commended for its current outreach efforts, not only in Connecticut and New Jersey, but also in upstate New York, in places like Buffalo and Troy. Perhaps Vermont, also within the NYIPLA’s geographic jurisdiction, will be the site of a future program, ideally during ski season. Rest assured, students and practitioners in those localities appreciate the personal attention and the effort it takes to put on a program on their home turf.

In sum, although there is doubtlessly a place for the NYIPLA within the social media, the medium in which our Association really shines is in its live programs. Foremost among those live programs is the Annual Meeting of our Association on May 19th at the Princeton Club. I hope to see you then!

With kind regards,  
 Dale Carlson

### (Endnotes)

<sup>1</sup> Tamar Lewin, *Harvard and M.I.T. Team Up to Offer Free Online Courses*, *The New York Times*, May 2, 2012, available at <http://www.nytimes.com/2012/05/03/education/harvard-and-mit-team-up-to-offer-free-online-courses.html>.

<sup>2</sup> *Id.*

<sup>3</sup> Marc Parry, *Open Courses: Free, but Oh, So Costly*, *The Chronicle of Higher Education*, Oct. 11, 2009, available at <http://chronicle.com/article/Free-Online-Courses-at-a-Very/48777>.

## Day of the Dinner CLE Luncheon Program

By Mark Bloomberg, Colman Ragan, and Robert Rando

# CLE PROGRAMS

Once again, the NYIPLA's annual "Day of the Dinner" CLE Luncheon Program was an outstanding success. Over 130 judges and attorneys attended the 2015 program entitled, "The Changing Patent Landscape: Issues Affecting Practice in the District Courts and the Patent Office." We have received overwhelmingly positive and enthusiastic feedback from the attendees about the program.

The distinguished panel included the Honorable Leonard P. Stark, Chief Judge of the United States District Court for the District of Delaware, the Honorable Barbara M.G. Lynn, District Court Judge of the United States District Court for the Northern District of Texas, and the Honorable James D. Smith, Chief Administrative Patent Judge of the PTO Patent Trial and Appeal Board. In addition, Director Michelle Lee, who was recently confirmed as Under Secretary of Commerce for Intellectual Property and Director of the Patent and Trademark Office, delivered opening remarks describing PTO initiatives that are in progress and are planned.

The panel, which was moderated by NYIPLA immediate Past President, Charles R. Hoffmann, provided the audience with valuable insights into recent decisions of the United States Supreme Court and legislative actions and how those decisions and actions are affecting the practice of law in the district courts and in the Patent and Trademark Office.

The discussion began with an overview of the various changes in how patent disputes are decided in light of recent Supreme Court decisions and IPR proceedings. The District Court judges provided valuable insight on their respective views concerning issues raised by these decisions, including claim construction and indefiniteness (*Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, and *Nautilus, Inc. v. Biosig Instruments, Inc.*), attorney fees (*Highmark, Inc. v. Allcare Health Management Systems, Inc.* and *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*), and patentability (*Alice Corp. v. CLS Bank Int'l*, and *Association for Molecular Pathology v. Myriad Genetics, Inc.*). Chief Judge Smith also provided his valuable

insights on PTAB practice. The entire panel addressed additional issues of the interplay between the two fora and the potential impact of proposed legislation on abusive patent litigation practices. The panel provided a particularly interesting discussion from their different perspectives of the potential for different claim constructions to be provided by the PTAB and the district courts. The panelists explained why it makes sense for the district courts and the PTO to have different tests for determining claim construction because, unlike a case in the district courts, the patent owner has the opportunity to amend the claims of a patent before the PTO to avoid prior art. Although this sets up the possibility that different claim constructions may result, the panelists noted that, in their experience, claim constructions have not generally been different in a meaningful way.

The panel also discussed the ongoing debate about the circumstances under which an action for infringement pending in a district court should be stayed while a post-grant proceeding is simultaneously going forward before the PTO. This scenario is occurring with increasing frequency following the enactment of the AIA. Chief Judge Smith informed the audience that, notwithstanding the increasing demand on PTO resources to handle those matters, the PTO has a perfect record in resolving such disputes within the time period it has set. Accordingly, if a district court decides that staying an action is appropriate, it can do so with confidence that the action will not be delayed by any failure by the PTO to resolve the dispute within the expected time.

In addition, the panel discussed some of the practical concerns that judges have with resolving fee-shifting issues, which are expected to be brought with increased frequency. The judges explained that their dockets are enormous, and noted that diverting their time to resolving such disputes after an action is finally over, as a matter of routine, may not be the best use of increasingly scarce judicial resources.

The program was organized by the Association's Programs Committee chaired by Mark Bloomberg, Robert Rando, and Colman Ragan.



## Diverse Careers in IP Law and Strategies for Achieving Success

*By Dale Carlson*

On April 13, 2015, the Programs Committee sponsored an event hosted at Quinnipiac University School of Law as part of a series of educational programs and networking events planned by the Committee for the benefit of students and newer practitioners. The panel was composed of T. David Bomzer of Pratt & Whitney, Bryan D. Zerhusen of Locke Lord LLP, and Alexandra B. Frisbie of UTC Building & Industrial Systems. I had the pleasure of moderating the panel. Jonathan Auerbach of Goodwin Procter LLP provided excellent program materials that were useful as a handout for the attendees.

The attendees included about forty students and recent graduates having an interest in IP, as well as several Quinnipiac University School of Law faculty members. An interactive dialogue between the panelists and the other attendees began as soon as the program started, and was spurred by personal stories of career progression that each of the panelists told. Each panelist talked about landing their first job, and the highlight of their career to date.

Alexandra Frisbie explained how she began her career in private practice and relied upon mentors to direct her to her next job with a firm in Manhattan prior to obtaining her current position in-house with UTC. Bryan Zerhusen described his work with a biotech start-up prior to his entering private practice with Locke Lord. David Bomzer discussed his career path from private practice to his current job in the corporate sector with Pratt & Whitney, and described how he expected

his career to evolve going forward. Mentoring seemed to play a key role in all of the panelists' career paths, and organizations that promote such mentoring, such as the NYIPLA and the various IP Inns of Court, were mentioned time and again.

If there was a prominent take-away, it was that each step in a career path builds upon the prior step, be it from in-house positions to private practice to academia, as with my career, or some other mix of the various forms of employment open to IP attorneys. All of the panelists emphasized the importance of establishing personal contact between potential employers and job candidates. Put differently, online applications by themselves are insufficient to get a meaningful first, or subsequent, job.

A question posed from the audience concerning how a student with an undergraduate degree in the liberal arts might become registered as a patent attorney elicited a response, not from a panelist, but rather from a member of the audience, namely, NYIPLA member and Quinnipiac University School of Law graduate Brian McGuire, who provided the answer based upon his own personal experience.

The IP careers program was a great success. There are many to thank for this fine result, including the panelists themselves, the Programs Committee members, event planner Lisa Lu, and Quinnipiac University School of Law's IP Society President, Melissa Tharp. Quinnipiac University School of Law is hopeful that the NYIPLA will choose to sponsor a program at the law school again in the near future. ■



# The Rapidly Changing Patent Law Landscape: What Entrepreneurs, Investors, Inventors, Lawyers and Judges Need to Know

By Mark Bloomberg, Colman Ragan and Robert Rando

On Wednesday, April 15, 2015, the NYIPLA Programs Committee, in conjunction with Rensselaer Polytechnic Institute (RPI) and the IP and Innovation American Inn of Court, hosted a full-day program in Troy, New York on “The Rapidly Changing Patent Law Landscape: What Entrepreneurs, Investors, Inventors, Lawyers and Judges Need to Know.” The program included four panels, a presentation on claim construction, and a keynote speech by The Honorable Arthur Gajarsa, Former Circuit Judge of the United States Court of Appeals for the Federal Circuit. Panel I was directed to basic patent issues and primarily intended for non-attorneys. Panel I was followed by a presentation on mastering claim construction from the perspective of a patent special master. Panel II was directed to issues of entrepreneurship and technology transfer from a business perspective. Panel III provided an update on current issues in patent law from recent Supreme Court and Federal Circuit decisions. Panel IV covered local patent rules, AIA litigation issues and the interplay of different fora in which to litigate patent disputes. This was the first program that the NYIPLA has sponsored in New York’s Capital District. Nearly 100 people attended the program, which received positive and enthusiastic feedback.

## ***Panel I – Basic Patent Issues***

The members of Panel I included Programs Committee Co-Chair and Moderator, Colman Ragan from Actavis, Inc., and Speakers Programs Committee Co-Chair Mark Bloomberg from Zuber Lawler & Del Duca LLP, Michael Johnson from Willkie Farr & Gallagher LLP, Peter Thurlow from Jones Day, and Matt Kinnier from Hoffman Warnick LLC. The panel’s basic “Patent 101” discussion was intended to help the attendees navigate through common patent issues at a high level so that inventors and business people could get some understanding of patent issues they are likely to confront as they attempt to develop their inventions into commercial products and grow companies based on the commercialization of those products.

This panel was presented in two sections. The first section explained to inventors and entrepreneurs what intellectual property is, what types of intellectual property exist, what types of protections intellectual property provides, and how to obtain protection for intellectual property. The second section explained what one can do with intellectual property once it is obtained, and the options inventors, small businesses and entrepreneurs have for defending themselves should another party assert intellectual property rights against them. The audience had many excellent questions that stirred healthy debate between the panelists and the audience.

## ***Presentation on Claim Construction***

Programs Committee Co-Chair Robert Rando from The Rando Law Firm P.C. gave a presentation on “Mastering Patent Claim Construction from the Perspective of a Patent Special Master.” The presentation covered the fundamental nuts-and-bolts aspects of the district court claim construction process. It provided an arbiter’s view on tips and strategies for presenting claim construction arguments in briefs and at *Markman* hearings. It also included a list and discussion of the twelve most common canons of patent claim construction, or presumptions, that courts rely upon in construing disputed patent terms.

## ***Panel II – Entrepreneurship and Technology Transfer***

The members of Panel II included Moderators Neil Zipkin and Benjamin Charkow from Amster, Rothstein & Ebenstein LLP, and Speakers Michael Hickey, Executive in Residence and Executive Director of the Center for Innovation and Entrepreneurship at Siena College, James Spencer, Jr., Executive Director of the Rensselaer Technology Park and Acting Director of the Office of Intellectual Property, Technology Transfer and New Ventures, Esther Vargas, Director of RPI’s Emerging Ventures Ecosystem (“EVE”), Martin Ricciardi from Whiteman Osterman & Hanna LLP, outside IP counsel to RPI, and Dr. Daniele Gallardo, co-founder and Vice President, Business Development of Actasys, Inc.

The panel discussion was directed to faculty, students and budding entrepreneurs in the Capitol District. After a brief discussion by the moderators about some of the legal issues facing a new venture, Mike Hickey gave a general overview identifying the numerous programs available to startups, including mentorship programs, industry networks, business plan assistance and programs focusing on attracting more startup capital to the region. Next, James Spencer discussed various services available through the Technology Transfer Office of RPI, focusing on the licensing of RPI technology. Esther Vargas spoke about RPI’s EVE incubator and the services offered by it to students and faculty. Marty Ricciardi went through the nuts and bolts of licensing RPI technology and, finally, Dr. Daniele Gallardo discussed his experiences as an entrepreneur and the various RIP programs from which he was able to benefit in the early-stage development of his company, which was based on technology developed during his graduate research and licensed through the RPI Technology Transfer Office.

### *Keynote Speech*

The Keynote Speaker, The Honorable Arthur Gajarsa, Former Circuit Judge of the United States Court of Appeals for the Federal Circuit, provided an outstanding presentation about his perspective on the historical role of the Federal Circuit in following its mandate to harmonize patent law, and the conflict that the Federal Circuit has increasingly been facing between following that mandate and complying with the generalist view of the Supreme Court. Judge Gajarsa discussed the importance of patent law in maintaining the technological advantage and continued growth of the United States economy, and how recent decisions of the Supreme Court and initiatives under consideration in Congress may not be helpful in achieving that goal. His discussion was vibrant, engaging and informative.

### *Panel III – Update on Key Supreme Court and Federal Circuit Decisions*

The members of Panel III included NYIPLA Immediate Past President and Moderator, Charles Hoffmann and Speakers NYIPLA President Anthony Lo Cicero from Amster, Rothstein & Ebenstein LLP, Annemarie Hassett from the Engelberg Center for Innovation Law and Policy, NYU School of Law, and Nicholas Mesiti from Heslin Rothenberg Farley & Mesiti P.C.

The presentation covered the several recent Supreme Court decisions affecting patentability, claim construction appellate review, fee shifting and patent validity. The panel provided an in-depth and robust review of the cases and insightful guidance on the practical aspects of litigating cases at the trial level in light of these changes.

### *Panel IV – Discussion on Local Patent Rules, Discrete AIA Litigation Issues, Interplay of Different Fora in Which to Litigate Patent Disputes*

The members of Panel IV included Programs Committee Co-Chair and Moderator, Robert Rando from The Rando Law Firm P.C., and Speakers Robert Maier from Baker Botts LLP, Alan Sack from SACK IP Law p.c., and Heather Schneider from Willkie Farr & Gallagher LLP.

The panel focused on pre-suit filing considerations, fora selection, and the pitfalls, advantages and disadvantages presented in each one. The panel discussed the impact of several AIA provisions and local patent rules on litigation strategies and tactical decisions. The panel also discussed issues and suggested practice tips for dealing with the changing patent law in terms of IPRs and motion practice in the district courts.

### *Summary*

The program was well received and a huge success, adhering to the high quality and standards of NYIPLA Programs Committee programs and exceeding expectations both in style and substance. The presenters provided clear guidance on a variety of topical issues, and the feedback from attendees was very positive. The members of the Subcommittee who prepared this program invested substantial time and energy to secure local interest and attendance and to provide informative and engaging presentation of the issues at the forefront of the rapidly evolving patent law landscape that was tailored to a diverse audience that included entrepreneurs, investors, inventors, academics and attorneys.

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## Should the EU's Right to Be Forgotten Ruling Be Extended to the US?

*By Karen Bromberg and Kevin Moss*

On April 23, 2015, the Internet and Privacy Committee co-hosted a Twitter Panel with Bloomberg BNA – the NYIPLA's first event of this kind – to address the topic of whether the EU's Right to Be Forgotten Ruling should be extended to the United States. EU privacy regulators want the right to be forgotten—the delisting of information on the Internet—to go global. The Twitter Panel discussion focused on the issues stemming from the EU's Right to Be Forgotten Ruling and whether this ruling could extend to U.S. search engines. The panel included Don Aplin, Bloomberg Senior Legal

Editor, data privacy specialist Jef Ausloos, Doctoral Researcher at the University of Leuven, Faculty of Law, and Committee Co-Chairs Kevin Moss and Karen Bromberg. The panel was moderated by noted Internet privacy expert Omer Tene. The combined Twitter following of the panelists and moderator amounted to just under 3,000 people, and the hashtags used to drive the conversations, #R2BF and #NYIPLA, averaged 1.6 million impressions. Additionally, the success of the panel resulted in a request from Bloomberg BNA for Kevin and Karen to lead a webinar/CLE on the topic.

## Minutes of February 11, 2015

### MEETING OF THE BOARD OF DIRECTORS OF THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The Board meeting was held at The Union League Club. President Anthony Lo Cicero called the meeting to order at 7:50 p.m. In attendance were:

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|-------------------|----------------------------|
| Dorothy Auth      | Charles Hoffmann           |
| Garrett Brown     | Denise Loring              |
| Kevin Ecker       | Richard Parke (left early) |
| Raymond Farrell   | Stephen Quigley            |
| Walter Hanley     | Peter Thurlow              |
| Annemarie Hassett |                            |

Matthew McFarlane, Jessica Copeland, Jeanna Wacker, and Wanli Wu were absent and excused from the meeting. Lisa Lu and Patrick Boland were in attendance from the Association’s executive office. David Leichtman was present for a portion of the meeting.

David Leichtman and Raymond Farrell reported on candidates for the Inventor of the Year award. The Board voted to accept the Inventor of the Year Award Committee’s recommendation for the award recipient. The Board discussed ways to identify candidates for the award in the future.

The Board approved the Minutes of the January 14, 2015 Board meeting.

Treasurer Kevin Ecker reported that the Association’s financial condition continues to be healthy. There was an increase in revenue over the past month in connection with the upcoming Judges Dinner.

Kevin Ecker reported that total Association membership is up over the same period last year. The Board approved admission of new members to the Association.

President Lo Cicero reported, on behalf of Matthew McFarlane, on the activities of the Amicus Brief Committee. The Board discussed a proposal from the Amicus Brief Committee for filing a brief in support of neither party in the *Maling v. Finnegan, Henderson, Farabow, Garrett, Dunner, LLP* case, relating to the obligations of a law firm when prosecuting

“similar” inventions for competitor clients. The Board had several comments to the proposal, which will be passed on to the Committee. The Committee is monitoring a number of other cases and will consider whether to recommend filing briefs, as appropriate.

Annemarie Hassett and Denise Loring reported on the February 10 and 11, 2015 meetings in Washington, D.C., with Capitol Hill staffers and PTO representatives in connection with proposed patent reform legislation. Officers Anthony Lo Cicero, Dorothy Auth, Walt Hanley, Annemarie Hassett, and Denise Loring attended the meetings, accompanied by representatives of ACG, the Association’s public policy advisors. The Association’s issue paper on the proposed legislation, prepared by the Legislative Action Committee, was distributed at the meetings. The Board discussed follow-up to the meetings.

Stephen Quigley presented the proposal of the working group (Annemarie Hassett, Stephen Quigley, and Denise Loring) for the composition and responsibilities of a new Media Committee. Board members will provide any comments to the proposal at the next Board meeting.

The Board approved a proposal for the Association to provide comments to the PTO in connection with its Enhanced Patent Quality Initiative as submitted by Peter Thurlow.

Dorothy Auth reported on the Association’s upcoming China program.

Annemarie Hassett reported on plans for the lunch presentation at the Annual Meeting in May 2015.

The meeting adjourned at 9:13 p.m.

The next Board meeting will take place at noon on March 11, 2015. ■

## Minutes of March 12, 2015

### MEETING OF THE BOARD OF DIRECTORS OF THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The Board meeting was held at the offices of Amster, Rothstein & Ebenstein LLP. President Anthony Lo Cicero called the meeting to order at 12:30 p.m. In attendance were:

Dorothy Auth	Denise Loring
Garrett Brown	Peter Thurlow
Walter Hanley	Stephen Quigley
Annemarie Hassett	Richard Parke
Charles Hoffmann	

Jessica Copeland, Kevin Ecker, Raymond Farrell, and Wanli Wu participated by telephone. Matthew McFarlane and Jeanna Wacker were absent and excused from the meeting. Feikje van Rein was in attendance from the Association's executive office.

The Board approved the Minutes of the February 11, 2015 Board meeting.

Treasurer Kevin Ecker reported that the Association's financial condition continues to be healthy. Revenue remained the same as last month, but income was down as a result of additional administrative and other expenses.

Kevin Ecker reported that total Association membership is again up over the same period last year. There was a discussion of the Association's residency requirements for active members. The Board approved admission of new members to the Association.

President Lo Cicero reported, on behalf of Matthew McFarlane, on the activities of the Amicus Brief Committee. The Committee filed a brief in the *Kimble v. Marvel Enterprises* case. The Board discussed the status of a proposed brief in support of neither party in the *Maling v. Finnegan, Henderson, Farabow, Garrett, Dunner, LLP* case, relating to the obligations of a law firm when prosecuting "similar" inventions for competitor clients. The Committee is monitoring a number of other cases and will consider whether to recommend filing briefs, as appropriate.

President Lo Cicero reported that preparations for the Judges Dinner and Day of the Dinner luncheon continue on track. Former Secretary of State Madeleine Albright, the guest speaker, has been very involved in the activities to date.

Annemarie Hassett and Denise Loring reported on the activities of the Legislative Action Committee. ACG, the Association's public policy advisors, circulated a redline of the Goodlatte Bill, H.R. 9, to Congressional staffers with whom Association officers had met in February. The Committee also prepared for distribution to staffers a white paper on the impact of the proposed abrogation of Form 18 of Fed. R. Civ. P. 84, the patent complaint form. Mses. Hassett and Loring noted with appreciation the work of Brian Doyle, Charles Macedo, and Robert Rando in preparing the white paper.

Charles Hoffmann reported on the search by the Nominating Committee for candidates for Association Board and Officer positions.

Stephen Quigley presented the proposal of the working group (Annemarie Hassett, Stephen Quigley, and Denise Loring) for the composition and responsibilities of a new Media Committee. Board members had no additional comments to the proposal. A search will begin for co-chairs of the committee.

President Lo Cicero noted the need to amend the Association Bylaws to account for the merger last year of the Meetings & Forums and Continuing Legal Education Committees into the Programs Committee.

Stephen Quigley reported on the proposed name change for the Association bulletin. The Board approved "The NYIPLA Report" as the new name for the Bulletin.

Annemarie Hassett reported on plans for the lunch presentation at the Annual Meeting in May 2015. Board members reported on past and upcoming Association-sponsored programs. Dorothy Auth reported that the China program, co-sponsored with the NJIPLA, was a success. She recommended that the Association continue to work with the NJIPLA in future programs.

The meeting adjourned at 2:15 p.m.

The next Board meeting will take place on April 22, 2015.

## General Call for Committee Volunteers May 2015 - April 2016

Apply by Thursday, June 18, 2015



**H**ave you thought about further developing your career, and at the same time, sharing your expertise and interest with other professionals? You can, by volunteering for one of the NYIPLA's committees – it is easy and very rewarding. You can meet new people, contribute to your profession, help advise the NYIPLA's Board of Directors, and expand your leadership skills. More importantly, your experience, combined with that of many other NYIPLA volunteers, plays a critical role in moving the NYIPLA forward.

Committees are open to members only. Membership dues must be current for May 2015 to April 2016 to be considered for a committee.

Login with your username and password at [www.nyipla.org/volunteerforcommittee](http://www.nyipla.org/volunteerforcommittee) to indicate up to 3 committees in order of your preference. *If you were involved in a committee last year*, and would like to continue to stay on the committee, please submit your committee preferences again for this year.

More information about each Committee can be found at [www.nyipla.org](http://www.nyipla.org) under the "About Us" menu.

### THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.

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