

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

2016-2017

GREEN

BOOKLET

ASSOCIATION ANNUAL REVIEW

NYIPLA Board of Directors	2 - 3
Year In Review by Walter E. Hanley, Jr.	4 - 5
Annual Meeting	6 - 11
Committee Reports	12 - 28
Annual Report of the Treasurer	29 - 30
95 th Annual Dinner in Honor of the Federal Judiciary	31 - 34
Day of the Dinner CLE Luncheon.....	35 - 36
Hot Topics in Intellectual Property Law	37
One-Day Patent CLE Seminar	38 - 39
Events	40 - 43



Walter E. Hanley, Jr.

***NYIPLA President
2016-2017***



Standing: Robert M. Isackson, Mark H. Bloomberg, Charles R. Macedo, Dorothy R. Auth, Colman B. Ragan, Kathleen E. McCarthy, Garrett E. Brown, Jr.
Sitting: Robert J. Rando, Heather M. Schneider, Annemarie Hassett, Walter E. Hanley, Jr., Matthew B. McFarlane, Peter G. Thurlow

2016-2017 BOARD OF DIRECTORS

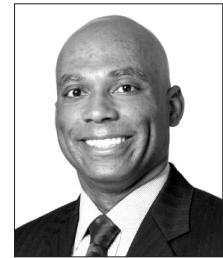
OFFICERS



President
Walter E. Hanley, Jr.



President-Elect
Annemarie Hassett



First Vice President
Matthew B. McFarlane



Second Vice President
Peter G. Thurlow



Treasurer
Robert J. Rando

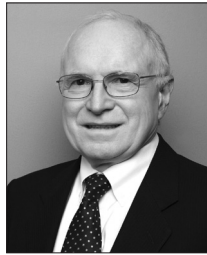


Secretary
Heather M. Schneider

MEMBERS



Immediate Past President
Dorothy R. Auth



Garrett E. Brown, Jr.



Charles R. Macedo



Jeanna M. Wacker



Frank A. DeLucia, Jr.



Kathleen E. McCarthy



Colman B. Ragan



Mark H. Bloomberg



Robert M. Isackson



William J. McCabe

2016-2017 YEAR IN REVIEW

It has been a great honor and pleasure to serve as President of the NYIPLA this past year. It was a busy and exciting year. The year saw the NYIPLA successfully transition its flagship event, the Judges Dinner, to a new venue, increase its outreach to young lawyers and turn its legislative focus to the issue of patent eligible subject matter, while furthering its leading role in continuing legal education and in advocacy as amicus curie. I want to sincerely thank the Board of Directors, the Committee Chairs, and the Executive Office under the direction of Feikje van Rein for their commitment and leadership in making this year so satisfying and rewarding.

Judges Dinner

The year began with the news that the Waldorf Astoria Hotel would be closing in February 2017 for renovations and that the NYIPLA would have to move the Judges Dinner to a different venue for the first time in its history. With the guidance of the Board, the Executive Office made arrangements for the New York Hilton Midtown to host the event and with The Ritz Carlton Hotel to accommodate most of the honored guests. The Dinner was attended by over 2500 guests and, by all accounts, was a great success. The NYIPLA presented its 15th Outstanding Public Service Award to Judge Denny Chin, Circuit Judge of the United States Court of Appeals for the Second Circuit. Judge Chin was recognized for his remarkable career as a United States district court and circuit court judge, including his notable decisions in high profile trademark and copyright cases, his role as teacher at Fordham Law School, and his service to the wider New York community. Judge Chin was characteristically humorous, gracious and inspiring in accepting the OPS Award. The Dinner speaker, famed author and journalist Walter Isaacson, wove together fascinating stories of the collaboration that spawned some of the seminal inventions of the digital age.

Legislative Action

The NYIPLA maintained its momentum on the legislative front in the Legislative Action Committee's third year of existence, working with the NYIPLA's government relations consultant, American Continental Group. The LAC began the year by staging a Q & A session with Rep. Hakeem Jeffries on patent litigation reform and other subjects. However, with patent litigation reform on hold in Congress in an election year, the LAC soon turned its focus to the issue of whether legislative action on patent eligibility is needed in the wake of the Supreme Court's decisions in Mayo and Alice. In December, NYIPLA Officers and LAC leadership participated in USPTO roundtables in Alexandria and Palo Alto on Section 101 and in a seminar on Section 101 reform put on by the Innovation Alliance in Washington, DC. In March, the NYIPLA held a Presidents Forum on the topic "Section 101 Is Broken: Is There a Legislative Fix." The Forum was led by David Kappos, former USPTO Director, and NYIPLA Past President Past Dorothy Auth, and brought together District Judges Katherine Forrest and John C. Lifland (Ret.), Rep. Jeffries, and leaders of IPO, AIPLA, ABA IP Law Section, Boston PLA and BIO for a lively discussion of potential legislation to amend Section 101. A follow up study is underway in the 2017-2018 year toward a recommendation for an NYIPLA position on potential legislation.

Amicus Briefs

The Amicus Briefs Committee continued to exert NYIPLA's influence in cases of broad import, submitting thoughtful and well-crafted amicus briefs in five Supreme Court cases and two cases before the Federal Circuit. The amicus briefs submitted to the Supreme Court argued the merits of a diverse set of issues in patent law (infringement under 35 U.S.C. §271(f), patent

exhaustion), trademark law (denial of registration of disparaging marks) and copyright law (copyrightability standard for designs of useful articles), and urged the Court to grant certiorari to address the issue of the constitutionality of inter partes reviews. Before the Federal Circuit, the NYIPLA's amicus briefs addressed the still-developing issue of the scope of judicial review of IPR institution decisions and the question of what constitutes "transformative" fair use of computer programming code under copyright law.

Young Lawyers

This year saw increased emphasis on young lawyers, pursuant to NYIPLA's strategic plan goal of increasing promoting growth and diversity by appealing to the NYIPLA's smaller constituencies, and corresponding increased activity by the Young Lawyers Committee. The YLC staged multiple roundtable discussions and social networking events, and teamed with the Law Firm Management Committee and Corporate Committee on others. At the end of the year, the NYIPLA launched a Mentoring Program for its young lawyer members, which is being implemented in the 2017-18 year.

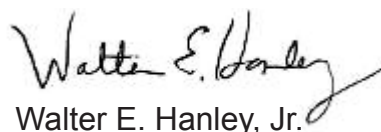
CLE Programs and Events

The NYIPLA's CLE programs are a central element of the Association's service to its members. The core program group—the Half Day Trademark program, the One Day Patent program, the Day of Dinner program and the Annual Meeting program—have been the focal points on the calendar, but the number of smaller programs and round tables presented by the NYIPLA's various Committees has been increasing year by year. This year saw that trend continue. The NYIPLA sponsored fifteen CLE programs this year in addition to the core four, covering a spectrum of IP topics. The many offerings included two programs staged at the U.S. Court of Appeals for the Second Circuit—the 3rd Annual Second Circuit Moot Court Argument CLE Program and the above-mentioned Presidents Forum. Two programs were staged outside New York City—the NYIPLA & NJIPLA Joint Program on Ethics Issues in IP Practice and the Trademark Law & Practice Committee program on Lanham Act damages. The topics of some of the programs reflected the expanding breadth of IP law, such as the inclusion of fashion law in the Half-Day Trademark program and a program on cybersecurity hosted by the Women in IP Law and Trade Secrets Committees. The prevalence of post-grant patent practice was evident in two programs on IPRs staged by the Patent Litigation Committee and in the One Day Patent program. The NYIPLA was fortunate to have many judges as speakers and program participants this year, among them Circuit Judge Denny Chin and District Judges William F. Kuntz (EDNY), Margo K. Brodie (EDNY), Dora L. Irizarry (Chief Judge, EDNY), Katherine Forrest (SDNY), Richard Andrews (D. Del.), Ron Clark (E. D. Tex.) and Dennis Saylor IV (D. Mass.). It was especially gratifying to have their participation.

Conclusion

The NYIPLA is an organization in which we can take tremendous pride. I am sincerely thankful for having had the privilege of serving as President, and I hope to continue to contribute in some way.

Best regards,



Walter E. Hanley, Jr.

2016 Annual Meeting

On May 17, 2016, incoming Association President Walter E. Hanley, Jr. welcomed members and guests at the Princeton Club of New York. Walter expressed his appreciation for outgoing president Dorothy R. Auth.

Keynote Speaker: Honorable Denny Chin,
United States Court of Appeals for the Second Circuit









NYIPLA

The New York Intellectual Property Law Association®

Annual Meeting

May 17, 2016

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

12:00 p.m. – 12:30 p.m.
Registration and Lunch

12:30 p.m. – 1:30 p.m.
CLE Panel

When the Robes Come Off® – Retired Federal Judges Roundtable Discussion: Reflections On The Practice Of Law Based On Perspectives From Both Sides Of The Bench

Honorable Joseph Farnan, Jr. *Former Magistrate Judge, U.S. District Court for the District of Delaware*

Honorable John Hughes *Former Magistrate Judge, U.S. District Court for the District of New Jersey*

Moderator: **Honorable Garrett Brown, Jr.** *Former Chief Judge, U.S. District Court for the District of New Jersey*

~
1:30 p.m. – 1:45 p.m.

Gautam Prakash *Pro Bono Coordinator, United States Patent and Trademark Office*

~
2:00 p.m. – 3:00 p.m.
CLE Workshop 1

Blurred Lines – The State of Play in Design Patent, Copyright, and Trade Dress Law

Andrew Beckerman-Rodau *Professor of Law & Co-Director IP Law Concentration, Suffolk University Law School*

Toby M.J. Butterfield *Partner, Frankfurt Kurnit Klein & Selz*

Darius Gambino *Partner, DLA Piper*

1:50 p.m. – 3:10 p.m.
CLE Workshop 2

Trademark Strategies for the Emerging Marijuana Economy

Kieran Doyle *Partner, Cowan Liebowitz & Latman*

Bill Thomashower *Attorney, Schwartz & Thomashower*

3:15 p.m. – 4:15 p.m.
Committee Meetings

4:30 p.m. – 5:30 p.m.
Annual Meeting of Members

5:30 p.m. – 6:00 p.m.
Board Meeting
(Past Presidents are Welcome)

5:30 p.m. – 6:30 p.m.
Cocktail Reception

6:30 p.m. – 8:30 p.m.
Awards Dinner

~
Welcome

NYIPLA Incoming President
Walter E. Hanley, Jr.

Keynote Speaker
Honorable Denny Chin
United States Court of Appeals for the Second Circuit

2016 Inventor of the Year Award
Dr. Thaddeus Prusik

2016 Hon. William Conner Writing Competition Awards
Christie Laroche and Daryl Steiger

Hon. Giles S. Rich
Diversity Scholarship
St. John's University School of Law



Award Recipients at the 2017 Annual Meeting

Inventor of the Year Award



Dr. Adrian Krainer was recognized for his research that led to the first-ever drug for the treatment of Spinal Muscular Atrophy (SMA) in children and adults.

Hon. William C. Conner Writing Competition Winners



First Place Winner

Mary Catherine Amerine

From William & Mary Law School for her paper entitled *Searching for a Sound: A Proposal for Creating Consistent De Minimis Sampling Standards in the Music Industry*

Second Place Winner

Hannah Pham

From the New York University School of Law for her paper entitled *Standing up for Stand-up Comedy: Joke Theft and the Relevance of Copyright Law and Social Norms in the Social Media Age*



NYIPLA Diversity Scholarship Award



Each year the Association awards at least one scholarship to offset tuition costs of a student from a background traditionally underrepresented in the legal profession, who is interested in Intellectual Property law, and who is currently attending a local law school.

The NYIPLA awarded its 2017-2018 Hon. Giles S. Rich NYIPLA Diversity Scholarship to Kevin Jones of the St. John's University School of Law.

2016 – 2017 Committee Reports

AMICUS BRIEF

Scope of the Committee: To coordinate the activities of the Association relating to preparation and submission of amicus briefs, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: David Goldberg and Irena Royzman

Board Liaison: Robert Isackson

Members: Mark Abate, Bruce Abramson, Julie Albert, Jonathan Auerbach, Nicholas Bartelt, Thomas Bean, Daniel Brooks, Jeff Butler, Pina Campagna, Michael Cannata, Mark Chapman, John Cleary, Marcus Colucci, Lauren Emerson, Joseph Farco, Dyan Finguerra-DuCharme, TaeRa Franklin, Melvin Garner, Walter Hanley, Anne Hassett, Suzanne Hengl, Sandra Hudak, Michael Keenan, Thomas Kowalski, David Leichtman, Ira Levy, Jeffrey Lewis, Stanley Lieberstein, Denise Loring, Charles Macedo, Matthew McFarlane, Yousef Mian, Jonathan Moskin, Lauren Nowierski, Marc Pensabene, Rob Rando, Andrew Riddles, Brian Rothery, Alicia Russo, Brad Scheller, Joel Schmidt, Heather Schneider, Victor Siber, Steve Smirti, Mitchell Stein, John Stellabotte, Ksenia Takhistova, Marian Underweiser, Carl Wischhusen, and Howard Wizenfeld

The Association has continued its strong history of representing its diverse intellectual property constituency before the courts through its Amicus Brief Committee, which coordinates the activities of the Association regarding the preparation and filing of briefs amicus curiae and makes recommendations with respect thereto to the Board of Directors.

Since the last Annual Meeting on May 17, 2016, about a third of the Committee's seventy active members participated in the filing of five briefs amicus curiae in the Supreme Court and two in the Court of Appeals for the Federal Circuit. Four of these briefs regarded the patent matters *MCM Portfolio LLC v. Hewlett-Packard Co.* (constitutionality of inter partes review); *Life Technologies Corp. v. Promega Corp.* (liability for supplying abroad a single component of a patented invention for combination with other components to make an infringing product); *Wi-Fi One, LLC v. Broadcom Corp.* (judicial review of PTO decisions to institute inter partes reviews with respect to statutory time bars); and *Impression Prods., Inc. v. Lexmark Int'l, Inc.* (whether conditional sales of patented goods can avoid patent exhaustion when the conditions are not met). Two regarded the copyright matters *Star Athletica, LLC v. Varsity Brands, Inc.* (on the test to determine whether copyright protection should be afforded to useful objects) and *Oracle America, Inc. v. Google Inc.* (on what may be deemed transformative in fair use analyses). Finally, one regarded the trademark matter *Lee v. Tam* (constitutionality of the prohibition on registering disparaging marks).

Specifically, in the patent case *Kimble v. Marvel Enterprises, Inc.*, the Association submitted a brief to the Supreme Court in support of appellant's argument that *Brulotte v. Thys Co.*, 379 U.S. 29 (1964) (holding that any temporal expansion of the patent monopoly beyond its term is illegal per se), should be overruled since its economic rationale is outdated. Citing the doctrine of stare decisis, the Court declined to overrule *Brulotte*.

During the past year the Supreme Court denied two Petitions for Certiorari that were supported by the Association and issued opinions in two critically important patent cases and one high-profile copyright case where the Association filed amicus briefs on the merits.

Specifically, in the patent case *Cuozzo Speed Technologies v. Lee*, the Association submitted a brief amicus curiae requesting the Supreme Court to reverse the Federal Circuit's holding that, in an appeal from a final decision of a Patent Trial and Appeal Board inter partes review ("IPR"), the court lacks jurisdiction to consider whether the Patent and Trademark Office exceeded its statutory authority by instituting review and invalidating patent claims on grounds not raised in the IPR petition. The Association did not take a position on the second question of which claim standard should apply in IPR proceedings. However, the Association emphasized the importance of this issue, which can impact validity determinations, and submitted that the Court's decision on the issue should be informed by a consideration of the extent to which amendments to patent claims are available in IPRs.

Although the Court found that Cuozzo's petition did not raise appropriate grounds for appeal in that case and affirmed the Federal Circuit's decision, it did set forth guidelines of what would be appropriate grounds for appeal in future cases. The Association is now applying these grounds in *Wi-Fi One, LLC v. Broadcom Corp.*, urging the en banc Federal Circuit to consider appealable PTO decisions to institute IPRs that may violate statutory time bars.

In *Life Technologies Corp. v. Promega Corp.*, the Federal Circuit found that the supply of a single part of a multicomponent invention for manufacture abroad may trigger liability for patent infringement under 35 U.S.C. § 271(f)(1). In the subsequent appeal, the Association filed an amicus brief supporting the Federal Circuit's finding, based on the view that the test for such infringement should be qualitative and not quantitative in nature. However, the Supreme Court disagreed. In its February 22, 2017 opinion, the Court clarified that the test is quantitative and not qualitative. However, the Court did not provide more general guidance on the number or proportion of parts would be required to constitute infringement under the statute. This issue will doubtless be raised in future cases.

The copyright case *Star Athletica, LLC v. Varsity Brands, Inc.*, involved the proper method of determining when a feature of a useful article (such as a cheerleader's uniform) is conceptually separable and therefore protectable under Section 101 of the Copyright Act. The Association's amicus brief in this matter proposed a straightforward inquiry to assess the copyrightability of the pictorial, graphic, and sculptural features of utilitarian works and expressly rejects certain tests that rely on factors extrinsic to the work itself.

On March 22, 2017, the Supreme Court held that an artistic feature incorporated into the design of clothing is eligible for copyright protection if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article; and (2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article. The straightforward inquiry set forth by the Court expressly rejects certain tests that rely on factors extrinsic to the work itself, as was advocated by the Association in its brief.

As is our practice, we plan to provide a roundup of the important Supreme and Appeals Court IP decisions in the September issue of the Association's publication, *The Report*. We are also planning to present a CLE program in the fall specifically geared to understanding the amicus brief process and the ethical issues associated with it. Most importantly, the Amicus Brief Committee shall continue to represent the Association's interests in all areas of Intellectual Property law in the courts in the year to come.

HON. WILLIAM C. CONNER WRITING COMPETITION

Scope of the Committee: To publicize and conduct a law school writing competition on an intellectual property law topic, and to make recommendations to the Board of Directors with respect thereto.

Co-Chairs: Richard Brown and Keith McWha

Board Liaison: Frank DeLucia

Members: Stephen Ankrom, David Bomzer, Timothy Caine, Mark Francis, Melanie Raubeson, Allen Rubenstein, Tara Thieme, William Valet, and Vadim Vapnyar

The Committee solicited and reviewed entries for the Hon. William C. Conner Writing Competition. The announcement of the competition was posted on the NYIPLA website in November. In December and January, emails were sent to professors and students at a number of law schools encouraging that the writing competition announcement be posted at the school to ensure that the students were aware of the opportunity.

The Committee received 26 submissions in 2017. The submissions were divided into two groups, and the Committee selected the top three submissions in each group. From those six submissions, the Committee selected the top two submissions and sent them to the NYIPLA Board for its consideration. The Board agreed with the recommendations of the Committee and selected the following as first and second place submissions:

1. Mary Catherine Amerine (William & Mary Law School), *Searching for a Sound: A Proposal for Creating Consistent De Minimis Sampling Standards in the Music Industry.*
2. Hannah Pham (NYU School of Law), *Standing Up for Stand-Up Comedy: Joke Theft and the Relevance of Copyright Law and Social Norms in the Social Media Age.*

The NYIPLA notified the winners and arranged for the presentations to be made at the Annual Dinner.

COPYRIGHT LAW & PRACTICE

Scope of the Committee: To consider all aspects of United States, foreign and multi-national copyright law and practice, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Lauren Emerson and Joseph Farco

Board Liaison: Hon. Garrett Brown

Members: Steve Ankrom, Rachel Dooley, Dickerson Downing, Brooke Ford, Claire Lebe, Patrick Monahan, Joel Schmidt, Francesca Silverman, Maja Szumarska, and Catherine Weiss

This year the New York Intellectual Property Law Association (NYIPLA) Copyright Committee is comprised of 25 members who participate in committee meetings and correspondence. Among the Committee members are attorneys and industry professionals who specialize in copyright. The Committee holds monthly meetings in which we discuss timely topics, including proposed and pending legislation, Copyright Office studies and initiatives, cases of notoriety or significance to the copyright community, and even foreign activities to the extent they may inform future copyright jurisprudence here. For example, the Committee recently discussed a Canadian decision in which a violation of Canada's version of digital copyright protection law resulted in massive fines – something that may lead to similar liability in the U.S. for DMCA violations.

This year was a very busy year for the Committee, whose membership discussed Reply Comments to the Copyright Office Section 1201 Study regarding digital rights management and technology protection protocols. The Committee worked with the Amicus Brief Committee on two cases – *Star Athletica v. Varsity Brands*, which was argued before the United States Supreme Court and *Oracle v. Google*, which is before the Federal Circuit Court of Appeals. Several of ideas expressed in the NYIPLA's *Star Athletica* brief found their way into the majority opinion that came down in March. After months of anticipation, the Committee membership spent several calls discussing a draft response of the NYIPLA to the much-needed Copyright Office Reform letter authored by Chairman Goodlatte. In conjunction with the Legislative Action Committee, the Copyright Committee authored a comprehensive and thoughtful discussion of the various areas in need of reform on behalf of the NYIPLA. After the filing of the amicus brief in *Star Athletica*, the committee met in person to socialize and celebrate. The Copyright Committee also collaborated with the Trademark Committee for a combined membership happy hour, as well as this year's Annual Meeting presentation – *The DMCA – How Recent Decisions Have Impacted the Scope of Protection*.

CORPORATE

Scope of the Committee: To consider intellectual property issues having an impact on in-house intellectual property counsel, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Tulloss Delk and Betty Ryberg

Board Liaison: Colman Ragan

Members: Eric Agovino, Jeffrey Butler, Andrew Chien, Joy Goudie, Courtney Hargrove, Joel Lutzker, Gerard McGowan Jr, Steven Purdy, Laura Sheridan, Louis Sorell, and Marian Underweiser

In October 2016, the Committee held an in-person mixer to re-connect and re-invigorate continuing and prospective members. This has become an annual event for the Committee – one that is always well received by committee members. After 2015's success holding the inaugural event, we again invited the Young Lawyers Committee to join us, which provided an opportunity to re-connect with many of members of that committee in person and to discuss issues important to younger lawyers who may seek an in-house career. We plan to schedule at least one similar event in Fall 2017. This past year we have continued our monthly conference calls to share ideas and discuss relevant topics, including legislative reform (in particular, patent reform and federal trade secret legislation), Supreme Court activity, PTAB post-grant proceedings, and the patent litigation landscape, as we have in years past. This year, we started incorporating guest speakers to speak about issues of particular interest to in-house counsel. Speakers we had speak this past year included Doug Luftman, Chief Innovation Office & General Counsel, Lecorpio, who spoke about innovation and patent strategy, and Eric Stenshoel, Curtis, Mallet-Prevost, Colt & Mosle LLP, who spoke about IP provisions in the TPP.

The Committee has also continued its efforts to work with other committees on issues important to in-house counsel. By way of example, members of the Committee provided comments to (1) the Legislative Action Committee, (2) the Patent Law & Practice Committee, and (3) the Programs Committees. In addition, committee members have been updated on the activities of the Amicus Brief Committee, and members provide comments where appropriate. Our members participated on several NYIPLA panels, and we continue to work with the Programs Committee to plan additional panels in which Corporate Committee members can participate. In sum, the Committee remains focused on finding opportunities to share in-house perspectives with members outside the Corporate Committee. We look forward to continuing our activity in the year ahead.

Finally, we continue to identify and reach out to potential new Corporate Committee members. To that end, we welcomed several new members during the past year.

INVENTOR OF THE YEAR (IOTY) AWARD

Scope of the Committee: To solicit, gather, and review nominations for the Inventor of the Year award, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Jonathan Auerbach and David Leichtman

Board Liaison: Charles Macedo

Members: Justine Gozzi, Allen Rubenstein, Eric Yecies, and Jessica Zafonte

The 2017 Inventor of the Year Award Committee received 12 quality submissions for consideration, composed of 11 new submissions and one resubmission, which represents a nearly 50% increase over last year's submissions. It presented its top two choices to the Board for discussion and approval. The Board agreed with the Committee's recommendation. At the NYIPLA Annual Meeting on May 16, 2017, the Association honored the 2017 Inventor of the Year Award Winner Dr. Adrian Krainer. Dr. Krainer was recognized for his contributions to the development of the first FDA-drug approved to treat Spinal Muscular Atrophy (SMA), which is the leading genetic cause of infant death. SMA is a muscle wasting disease caused by death of motor neurons. Infants suffering from SMA are usually unable to walk, crawl, or even breathe. Babies diagnosed with SMA generally do not live past the age of two, with death occurring as early as within weeks in the most severe cases.

SMA is the result of a splicing defect in the SMN1 gene, which produces a non-functional SMN protein. Since SMN is necessary for survival of motor neurons, its non-functionality caused by errors in SMN1 splicing quickly leads to motor neuron death. There also exists a nearly-identical gene SMN2; however, this naturally generates very low amounts of SMN protein due to an exon skip during splicing. Dr. Krainer hypothesized that improved functionality of SMN protein produced by SMN2 would compensate for SMN1 defects in SMA, restoring motor neuron survival and preventing muscle wasting. Dr. Krainer's research, conducted in collaboration with his post-doctoral researcher and scientists from Ionis Pharmaceuticals, led to the invention of an antisense oligonucleotide (nusinersen) which binds to SMN2 mRNA and allows generation of functional SMN protein. Dr. Krainer's work is embodied in U.S. Patent No. 8,980,853.

We would like to recognize the entire Committee for their excellent work researching, reviewing, and ranking the submissions this year. We also want to thank our Board liaison, Charles Macedo, for his help navigating the process for the 2017 IOTY Award.

LAW FIRM MANAGEMENT

Scope of the Committee: To consider aspects of law firm management, particularly as they pertain to law firms and practice groups practicing intellectual property, and to publish and present as appropriate on such topics with respect thereto to the Board of Directors.

Co-Chairs: Richard Goldstein and Scott Stimpson

Board Liaison: Jeanna Wacker

Members: Mark Baker, Andrew Berks, Gerard Messina, and Rod Turner

In the course of the NYIPLA Law Firm Management Committee's young existence, now in its third year, the Committee has had multiple presentations and meetings directed to law firm management. These include "Nuts and Bolts of running an IP Practice" breakfasts, marketing and management topics, and CLE presentations about alternative fees and best practices for working with small clients. The Committee has also engaged with the Young Lawyer's Committee to host a coordinated business development meeting and networking event. The Committee is currently working on an ethics CLE presentation related to management of an IP Practice. Future topics for presentations and meetings include economics and profitability analyses, fee agreements and associated risks, and firm leadership approaches.

LEGISLATIVE ACTION

Scope of the Committee: To evaluate proposed federal and state legislation and rules, including USPTO and Court rules, that may impact patent and other intellectual property issues; to develop positions and recommendations on the proposed legislation and rules for consideration by the NYIPLA Board of Directors; and to communicate the NYIPLA's positions and recommendations to the legislative and rule-making bodies, as approved by the Board.

Co-Chairs: Dorothy Auth and Jeffrey Butler

Board Liaison: Annemarie Hassett

Members: Michael Bullerman, Bindu Donovan, Brian Doyle, Mitchell Epner, Terri Gillis, Michael Johnson, Charles Macedo, Patricia Martone, Daniel McGlynn, Lori Morrison, Steven Purdy, Colman Ragan, Robert Rando, Irena Royzman, Jaime Siegel, and Edward Tulin

The LAC continues to pursue its mission to serve as such a legislative/policy advisory committee for the Association and the bar as a whole, and as an unbiased resource for the US Congress, helping members of Congress and their staffers to understand IP issues and the implications that proposed legislation could have on the IP system and on the enforcement and defense of IP rights in the courts and in the Patent Office. The members of the LAC have discussed various pending and proposed legislation, and have – through White Papers and meetings with Congresspersons – informed members of Congress so that they can, through appropriate legislation, strengthen the IP system to foster innovation.

Among other things, the LAC currently is monitoring the IP initiatives of the new Congress and of the new Administration, is prepared to offer guidance to Members of Congress as needed, and has continued its analysis of various patent reform bills (including several that were introduced in the previous Congress). The LAC (in conjunction with the Copyright Committee) has provided input to the Association on proposed copyright office reform, and the LAC continues to monitor developments in trademark law and trade secret law. Various LAC members have worked closely with officers and directors of the Association to assist in the preparation for, and presentation of, the March 6, 2017, Presidents' Forum entitled "Section 101 Is Broken. Is There A Legislative Fix?" The LAC assisted board member Peter Thurlow and LAC Co-Chair and Immediate Past President Dorothy Auth prepare for the respective USPTO Roundtables they attended (Nov. 14, 2016, and Dec. 5, 2016), at which they represented the Association regarding various Section 101 issues. The LAC Co-Chairs, LAC Board Liaison Annemarie Hassett, and Association President Walter E. Hanley, Jr. attended an Innovation Alliance conference (co-sponsored by Inventing America and IP Watchdog) in Washington, DC, on December 7, 2016, where the focus was the impact on innovation of various Supreme Court decisions concerning patent-eligible subject matter. While in Washington, those representatives of the NYIPLA also met with a senior staffer for Senator Charles Schumer to discuss IP issues, including strategies to address the patent-eligibility problem by suggesting amendments to Section 101. The LAC will continue to analyze and provide input to legislators, their staff, and relevant agencies on these issues and other issues of interest to our members.

MEDIA

Scope of the Committee: To coordinate and oversee the public dissemination of significant news regarding key, IP-related legislative and court developments, as well as NYIPLA programs, events, activities and significant achievements, and to make reports and recommendations to the Board of Directors with respect to the foregoing.

Co-Chairs: Brian Doyle, Michael Kasdan, and Anthony Lo Cicero

Board Liaison: Robert Rando

Members: Samantha Alexander, Ilana Broad, Courtney Hargrove,
Laura Lagone, Patrick Monahan, and Ben Natter

The Committee's mission is to coordinate and oversee the public dissemination of significant news regarding key, IP-related legislative and court developments, as well as NYIPLA programs, events, activities and significant achievements, and to make reports and recommendations to the Board of Directors with respect to the foregoing.

Throughout the year, the Media Committee has reviewed and edited the NYIPLA Weekly Report prior to its dissemination to members. The Committee has also liaised with other committees – including the Amicus Brief Committee and the Legislative Action Committee – to coordinate on the publication of significant news events, including, as one example, the filing of amicus briefs by the NYIPLA. The Committee is also actively investigating additional ways to publicize the work, activities, and achievements of the NYIPLA and its members through media outlets that would complement NYIPLA's current media practices.

PATENT LAW & PRACTICE

Scope of the Committee: To consider all aspects of patent laws and practice which affect the rights of United States entities in technology, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Brian Rothery and Carl Wischhusen

Board Liaison: Peter Thurlow

Members: Ken Adamo, James Barabas, Andrew Chien, Randy Eisensmith, Chi Eng, Steven Forte, Joy Goudie, Althea Harris, Michael Kahn, David Kappos, Fritz Klantschi, Gene Lee, Mord Lewis, Joel Lutzker, Gerard McGowan Jr, Manoranjan Rai, John Resek, Ryan Schneer, Preeti Sharma, Laura Sheridan, Antoaneta Tarpanova, Rod Turner, and Jessica Wu

The mission of the Patent Law & Practice Committee is to monitor, study, and promulgate changes in U.S. patent law and regulations and U.S. Patent & Trademark Office (USPTO) internal practice and to publicly participate in USPTO rule making, practice changes, and policy initiatives on behalf of the NYIPLA. In pursuit of these objectives, the Committee monitors and circulates Federal Register notices relating to USPTO rule making and practice; prepares formal submissions on behalf of the NYIPLA to Federal Register notices where the USPTO is seeking comment(s) from the public and/or practitioners; and holds monthly in-person and/or telephonic meetings to discuss recent Federal Register notices, recent USPTO announcements and practice before the Office generally, recent court decisions of note, and any other developments which affect patent practice and patent practitioners. The Committee also contributes articles to *The Report*, participates in NYIPLA Continuing Legal Education panels and courses, and cooperates with other NYIPLA committees on issues relating to patent law, regulations, and practice.

This year, the Committee continued to monitor and participate in the USPTO's Patent Quality Initiative, which seeks to improve the "quality" of patents through changes to internal USPTO practices. The Committee also continued to monitor issues relating to the USPTO handling of patent eligibility under Section 101.

The NYIPLA was asked to provide comments to the Patent Public Advisory Committee (PPAC) regarding possible changes, areas of improvement, and concerns regarding the operations of the USPTO. A teleconference was conducted to discuss the input that the NYIPLA would provide. This meeting included co-chairs of several committees (including this Committee), NYIPLA President Walter E. Hanley, Jr. and a number of board members of this organization, including Peter Thurlow, who is a member of PPAC. Needless to say, Peter's insights into the politics of PPAC have been invaluable to this Committee. The topic was further discussed at a telephonic meeting of this Committee to develop specific proposals relating to USPTO practice, which were submitted to President Hanley for inclusion in a letter to PPAC.

A co-chair of this Committee, Carl Wischhusen, attended an NYIPLA President's Forum on Section 101, which focused on possible legislative solutions to the confusion and uncertainty following the Supreme Court's decision in *Alice Corp. v. CLS Bank International*. A summary of the forum was presented by Carl during an in-person meeting of the Committee. A lively discussion followed.

PATENT LITIGATION

Scope of the Committee: To consider legislation and rules affecting practice and procedural matters in intellectual property litigation outside the Patent and Trademark Office, and other matters relating to practice in such litigation, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Gene Lee and Douglas Nemec

Board Liaison: William McCabe

Members: Kenneth Adamo, Eric Agovino, Mark Baker, James Barabas, Jeremy Boczeko, Kenneth Canfield, Ralph Dengler, Randy Eisensmith, Chi Eng, Mitchell Epner, Eric Greenwald, Jesse Jenner, Michael Kahn, Dewey Kang, Gene Lee, Mord Lewis, Steven Luksenberg, Patricia Martone, Dennis McMahon, Yousef Mian, Lauren Nowierski, Sapna Palla, Marc Pensabene, Michael Petegorsky, Manoranjan Rai, John Ryan, Anna Schoenfelder, Ioannis Sipsas, John Stellabotte, Stefan Stoyanov, Thomas Vetter, Ron Vogel, and Joshua Whitehill

Thanks to its large and active membership, the Patent Litigation Committee enjoyed a variety of enriching meetings and events in the 2016-2017 committee season. Monthly in-person lunch meetings helped to foster insightful discussion and personal interaction among members – fleeting commodities in the age of webcasts. As in the past, the Committee began the year with a survey to gather input from the committee members on issues of interest and to understand the practice composition of the members. The survey results helped to guide meeting topics and event planning to ensure inclusiveness and relevance for the full range of committee members. In addition to informal discussion and networking, monthly meetings featured organized presentations from members and guest speakers on topics ranging from UK patent litigation to jury consulting to IP challenges facing the new administration. The Committee co-chairs are most appreciative of the contributions of the many proactive committee members.

The Committee's activities were by no means limited to monthly meetings. Sub-groups of committee members organized a number of Association-wide events, including a PTAB panel moderated by committee co-chair Douglas Nemec on June 8, 2016, a former judges panel moderated by Kenneth Adamo on September 21, 2016, and a local counsel panel moderated by committee member (and incoming committee co-chair) Marc Pensabene on January 11, 2017. A number of other programs are currently in the works, including an encore of the PTAB panel and a panel of sitting judges addressed to pressing issues of interest to patent litigators. With these active projects we will enter the 2017-18 committee season with the wind at our back, and look forward to another exciting year.

PRIVACY, BIG DATA & CYBERSECURITY

Scope of the Committee: To consider all aspects of internet and privacy law in the United States, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Karen Bromberg and Kevin Moss

Board Liaison: Kathleen McCarthy

Members: Andrew Allen, James Bikoff, Lindsey Canning, Duane Cranston, David Einhorn, Victoria Ger, Shannon Hedvat, Keith McWha, Jonathan Moskin, Peter Sullivan, William Tabler, and George Wukoson

During the 2016 – 2017 committee year, the rebranded “Privacy, Big Data & Cybersecurity Committee” continued to have monthly telephone meetings to discuss potential panel and webinar topics and impending legislation.

The Committee is currently working on a webinar that will be co-sponsored with Bloomberg BNA entitled, “Privacy Issues in M&A Transactions: A Primer for Intellectual Property Attorneys.”

The Committee is also working on developing a webinar concerning New York legislation related to the so-called “right to be forgotten”, as well as a webinar on the EU – US “privacy shield.”

PROGRAMS

Scope of the Committee: To formulate and present a series of monthly continuing legal educational programs of interest to the broad spectrum of the Association’s membership, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Michael Johnson, Jamie Lucia, and Ksenia Takhistova

Board Liaison: Mark Bloomberg

Members: Ken Adamo, Alexandra Awai, Andrew Berks, Jason Grauch, Patrice Jean, John Resek, Cindy Shu, William Thomashower, Thomas Vetter, Huiya Wu, and Eric Yecies

This year the Programs Committee continued to provide, and expand upon, its slate of programs, including, among others, the Full-Day Patent Program, the Day of Dinner Program, the annual moot court program before the Second Circuit, and a number of programs presented jointly with other committees. The Committee continued its service to NYIPLA Members by providing high quality programs, informative presentations, and distinguished keynote speakers.

The Programs Committee was honored to have participation from judges from various Circuit and District Courts and members of the Executive Branch at its programs. In July 2016, the Committee organized the 3rd Annual Second Circuit Moot Court Argument CLE Program, presided over by the Honorable Denny Chin of the U.S. Court of Appeals for the Second Circuit, and the Honorable William F. Kuntz and the Honorable Margo K. Brodie, United States District Judges for the Eastern District of New York sitting by designation.

At the One-Day Patent CLE Seminar in November 2016, the Honorable Dora L. Irizarry, Chief Judge, United States District Court for the Eastern District of New York was the keynote speaker. Panelists throughout the day included William Covey, Anthony Knight, and Robert

Oberleitner, from the U.S. Patent & Trademark Office; the Honorable Arthur J. Gajarsa, Former Circuit Judge, United States Court of Appeals for the Federal Circuit; and the Honorable Scott E. Kamholz, Former Administrative Patent Judge, United States Patent Trial and Appeal Board. Participation from the judiciary continued at the Day of the Dinner Luncheon in March 2017 on *Intent in Patent Cases: How Courts Sort Out Whether Infringement Is Knowing, Egregious or Exceptional*. That program featured a distinguished panel including the Honorable Ron Clark, Chief Judge, U. S. District Court, Eastern District of Texas, the Honorable Richard G. Andrews, Judge, U. S. District Court, District of Delaware, and the Honorable F. Dennis Saylor IV, Judge, U. S. District Court, District of Massachusetts.

The Programs Committee also hosted, and assisted other NYIPLA committees in hosting, a number of CLE events. As the above report indicates, the Committee has been working closely with the Patent Office to participate in, and to facilitate, programs sponsored by them with the goal of reaching patent practitioners. The success of the Committee's programs could not have been achieved without the hard work and dedication of all of the members of the Committee and the NYIPLA administrative office to whom we are grateful.

PUBLICATIONS

Scope of the Committee: To prepare, edit, publish and disseminate such publications as may be requested by the Board of Directors, and to make recommendations to the Board of Directors.

Co-Chairs: Dale Carlson, William Dippert and Mary Richardson

Board Liaison: Frank DeLucia, Jr.

Members: Jayson Cohen, TaeRa Franklin, Robert Greenfeld, Annie Huang, Michael Keenan, Keith McWha, Vadim Vapnyar, and Joshua Whitehill

The Publications Committee publishes *The Report* on a bi-monthly basis, five times a year. The Green Booklet, published in the summer, is the annual record of the NYIPLA.

The Report is a journal of articles of interest to the intellectual property community written by Association members and guests. For the fourth year in a row, a themed issue was published as the February/March issue—its focus was on post-grant proceedings. Articles of note included a discussion of post-grant decisions recently made precedential, recent developments in biopharma PTAB practice, a discussion of changes to inter partes review and post-grant review procedures, and a discussion of timing considerations when settling post-grant proceedings.

Articles in other issues of *The Report* this year covered a wide range of topics. In the beginning of the year, *The Report* continued its practice of publishing the first and second place Hon. William C. Conner Writing Competition winners' articles. These articles discussed allowing judicial review of inter partes review institution decisions and the role of the right of publicity in a world increasingly dominated by social media, respectively. There were articles on a variety of intellectual property law topics, including whether functional claiming has functionally changed since *Williamson v. Citrix*, PTAB developments involving CRISPR-Cas9 gene editing technology, strategic and practical tips for successful ex parte seizure under the DTSA, and whether it is time for another look at secret prior art.

Many of the articles published in *The Report* come from members of other NYIPLA Committees, such as the Copyright Law & Practice Committee, Patent Law & Practice Committee, the Patent Litigation Committee, and the Trademark Law & Practice Committee.

Regular features in *The Report* include reviews of Supreme Court cases decided in last year's Term (August/September issue), interviews with new members of the NYIPLA Board of Directors (August/September issue), IP Media Links, U.S. Bar-JPO Liaison Council and U.S. Bar/EPO Council Liaison Meeting Reports (August/September and October/November issues, respectively), and the following features that appear in each edition of *The Report*: the President's Corner, the Historian's Corner, Notable Trademark Trial and Appeal Board Decisions, reports of the Association's CLE presentations, minutes of the Board of Directors' meetings, calendar of the Association's upcoming events, New Members list, and Moving Up & Moving On—for publicizing news of intellectual property attorneys' transitions and accolades. Copies of *The Report* were mailed to all Association members and posted on the nyipla.org website in color.

This year marked the passing in April of one of our Committee's co-chairs, Mary W. Richardson. Mary served our Committee tirelessly from 2010, and she co-chaired the Committee for five years from 2012-2017. During her tenure, the scope and depth of the Association's publications became enhanced, thanks in no small part to Mary's efforts in organizing and cultivating a team spirit among Committee members. Needless to say, Mary will be sorely missed by her "family" at the NYIPLA.

The Committee greatly appreciates Robert Greenfeld's efforts in co-chairing the April/May issue of *The Report*.

TRADEMARK LAW & PRACTICE

Scope of the Committee: To consider all aspects of trademark law and practice, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Michael Cannata and Dyan Finguerra-DuCharme

Board Liaison: Kathleen McCarthy

Members: Jeremy Boczko, Pina Campagna, Laura Chubb, David Cole, Dickerson Downing, David Einhorn, David Goldberg, Scott Greenberg, Suzanne Hengl, Christina Kim, Lindsay Korotkin, Michael Kraich, Claire Lebe, Steve Luksenberg, Arielle Matza, Dorna Mohaghegh, Chase Morgan, Gabrielle Nagler, Ben Natter, Kelly O'Connell, Loren Pani, Joshua Reisberg, Joel Schmidt, Preeti Sharma, Francesca Silverman, Ioannis Sipsas, Stefan Stoyanov, Marsha Sukach, Maja Szumarska, and William Thomashower

The Committee corresponded extensively, held monthly conference calls, and conducted several in-person meetings, as well as fall and winter CLE events. In addition, Committee members Scott Greenberg, Michael Kraich, and Pina Campagna provided regular summaries of relevant TTAB and Federal Circuit decisions for inclusion in *The Report*.

On August 12, 2016, the Committee prepared public comments for the NYIPLA to submit to the USPTO in connection with certain changes in the requirements for Affidavits or Declarations of Use, Continued Use or Excusable Nonuse.

On November 10, 2016, the Committee had an in-person meeting at the offices of Rivkin Radler LLP followed by a CLE presentation entitled "Show Me The Money! A Primer on Lanham Act Damages," presented by Frank Misiti, John Plumpe, and Dana Smith and moderated by Committee Co-Chair Michael C. Cannata.

Members of the Committee also participated in the preparation of a SCOTUS amicus brief in the case of *Lee v. Tam* that was filed on November 21, 2016.

On January 12, 2017, the Committee had an in-person meeting at the offices of Pryor Cashman LLP followed by a CLE presentation entitled “Understanding the Upcoming Changes to the Trademark Rules of Practice,” presented by Hon. David Mermelstein and Colleen Kearney and moderated by Committee Co-Chair Dyan Finguerra-DuCharme.

The Committee, together with the Copyright Law & Practice Committee, held an after-work networking event on February 9, 2017 in NYC at the Knickerbocker Hotel.

The Copyright Committee and the Trademark Law & Practice Committee are presenting a joint panel at the NYIPLA Annual Meeting entitled *The DMCA – How Recent Decisions Have Impacted the Scope of Protection*. The panel will focus on recent case law interpreting Section 512 of the DMCA as well as policy issues related to the efficacy of the current notice-and-takedown regime, which is a timely topic given the number of recent cases interpreting the statute and the Copyright Office’s Notices of Inquiry focusing on Section 512. The panel includes Ryan Fox, Policy & Advocacy Director of the Authors Guild Ed Klaris, former in-house counsel at Condé Nast and Managing Partner of Klaris Law PLLC and will be moderated by Felicity Kohn of Pryor Cashman LLP.

The Committee is presently planning the Half-Day “Hot Topics in Intellectual Property Law” CLE program, which will be held on July 19, 2016, at The Princeton Club. The Committee has developed a list of current topics of interest and confirmed several dynamic speakers for the program. The keynote address will be provided by Jim Gatta from the U.S. Attorney’s Office who will speak on criminal issues related to IP enforcement. The program will also include presentations from experts in the fields of insurance coverage for intellectual property claims and marketplace surveys.

TRADE SECRETS

Scope of the Committee: To consider all aspects of trade secret law in the United States and other jurisdictions having an impact in the United States, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: John Moehringer and Mark Schildkraut

Board Liaison: William McCabe

Members: Rachel Blitzler, Laura Chubb, Daniel McGlynn, and Jessica Sblendorio

The Committee held monthly meetings and a committee member (Jessica Sblendorio of Haug Partners) provides the committee with an update on the latest developments regarding the Defend Trade Secrets Act and trade secrets law generally.

In combination with the Women in IP Committee, the Committee organized a CLE program entitled: “Protecting Valuable and Sensitive Information in the Corporate Setting.” The speakers included:

- Una Dean, Assistant United States Attorney in the Eastern District of New York, National Security and Cybercrime Section
- Joanna Levin, Pfizer Corporate Counsel, Global Privacy
- Erez Liebermann, Prudential Chief Counsel-Cybersecurity and Privacy
- Mark Schildkraut, BD Assistant General Counsel-IP and Worldwide Cybersecurity Counsel
- Andrew Tannenbaum, IBM Cybersecurity Counsel

Before the end of the year, the Committee will be hosting a telephone conference with Professor Mark Schultz, who is a Senior Scholar and Director of Academic Programs at the George Mason Center for the Protection of Intellectual Property and is an Associate Professor of Law and Director of Faculty Development at Southern Illinois University School of Law. He will give a talk on: A Comparative Legal and Economic View of Global Trade Secret Regimes. Any interested NYIPLA committee members are invited to join the call.

Looking forward to next year, the Committee is planning to (i) prepare a paper of Trade Secret considerations for the in-house IP professional for possible publication in the NYIPLA *The Report*; and (ii) prepare interviews (for audio or written publication) with leading professionals (e.g., in-house lawyer, outside counsel, law enforcement) on different trade secret matters.

US BAR – JAPAN PATENT OFFICE COUNCIL

Delegates: Raymond Farrell and John Pegram

The U.S. Bar – JPO Liaison Council and the JPO are at the beginning stages of planning for their next meeting, scheduled to take place on November 9, 2017 at the JPO in Tokyo. The Japanese government has yet to appoint a successor to the current commissioner, Yoshinori Komiya. An announcement is expected by June as to whether a new commissioner will be named, or if Commissioner Komiya will be asked to stay on for another year. Additionally, the Council hopes to meet with the IP High Court during the visit to Japan.

In January 2017, Commissioner Komiya and key members of the JPO International Policy Division, namely, Matsuo Nonaka, Director of International Policy Affairs, Yuki Takeuchi, Assistant Director of International Policy Affairs, and Wataru Imamura, JPO Representative, Sr. Director, IP Division, JETRO met with Ray Farrell, the current Council Chair, at the offices of Carter, DeLuca, Farrell & Schmidt to discuss matters of current interest to the JPO and the Commissioner in particular. These topics included how to respond to emerging technologies in what is referred to in Japan as the 4th Industrial Revolution (or Industry 4.0), which encompasses the Internet of Things, Artificial Intelligence, proprietary considerations of big data. The Japanese government has directed the JPO to come up with initiatives to address these issues and so it is high on their priority list. We expect that these issues will still be keenly of interest to the JPO at our meeting in November.

US BAR – EUROPEAN PATENT OFFICE LIAISON COUNCIL

Delegates: Samson Helfgott and Thomas Spath

The 32nd meeting of the U.S. Bar/EPO Liaison Council was held in New York City on September 15, 2016 in conjunction with the annual meeting of the IPO. These annual Council meetings alternate between the European Patent Office in Munich and a venue in the U.S., which has often been Washington D.C. and coordinated with the AIPLA meeting. In keeping with custom, the EPO president Benoit Battistelli opened the meeting with a presentation of significant operational details and statistics, including that about 27% of the 160,000 European applications filed in 2015 originated in the United States, making it the largest EPO filer. The EPO serves as ISA for 37% of United States PCT filings. He also provided a then-current update on the prospects for the Unitary Patent and Unified Patent Court system that requires approval by the British government, which he predicted was likely even in the face of Brexit.

Presentations were also made on behalf of a number of the principal EPO directorates by their heads who advised of several major programs affecting U.S. applicants including the prompt issuance of searches, the goal being within about six months of receiving the file, expedited examination following a positive search opinion, and a fast tracking of examination once it has begun. The established goal for 2020 is the issuance of searches within 6 months, the completion of examinations in an average of 12 months, and the issuance of decisions in non-complex oppositions within 15 months. A program has also been initiated that permits applicants to provide informal comments on the EPO search as ISA that will be taken into account when the examiner prepares the International Search Report and Written Opinion, thus giving the applicant an additional opportunity to advance prosecution. A number of other programs were described and discussed, as well as revisions to administrative procedures relating to EPO Boards of Appeal. The results of these new programs and others will certainly be discussed at this year's Council meeting which will be held in Munich on November 15, 2017.

WOMEN IN IP LAW

Scope of the Committee: To facilitate and empower women in their practice of intellectual property law, and make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Wan Chieh (Jenny) Lee and Jessica Copeland

Board Liaison: Heather Schneider

Members: Katherine Adams, Leora Ben-Ami, Jennifer BianRosa, Pina Campagna, Ursula Day, Stephanie DelPonte, Jennifer Dereka, Brooke Ford, Nidhi Garg, Terri Gillis, Justine Gozzi, Darianne Grey, Alyssa Harvey Dawson, Patrice Jean, Chloe Jiang, Miriam Kavalerschik, Delphine Knight Brown, Abigail Langsam, Jessica Lin, Jennifer Moore, Lynda Nguyen, Diana Santos, Karen Sebaski, Julie Vo, Julia Weis, and Huiya Wu

The NYIPLA Women in IP Law Committee successfully planned and conducted Committee meetings, CLE events and networking events. The Committee held its fall networking and wine tasting event on October 19, 2016 at Haug Partners LLP with about fifty attendees. The keynote speaker, Sarah Feingold, currently General Counsel at Vroom, provided an inspirational talk about "Following the Law, Break the Mold." Sarah was the first attorney to join the staff at Etsy and played an essential role in Etsy's exponential growth from a small start-up to a public company valued at \$2 billion. Her speech was lighthearted, but empowered the attendees with practical tips for charting one's own career and supporting advancement of women in the legal field. Following Sarah's delightful presentation, the attendees enjoyed an evening of wine tasting and conversation lead by the first female wine director of a well-known 3-star restaurant.

On February 28, 2017, the Committee collaborated with the Trade Secret committee for a CLE and networking event at Skadden Arps relating to "Protecting Valuable and Sensitive Information in the Corporate Setting" with thought leaders from the financial, medical device, pharmaceutical, and computer industries, as well as law enforcement. The event kicked off with a networking session followed by a lively CLE presentation. The panelists provided an engaging and interactive discussion exploring a variety of data privacy concerns, while providing legal strategies for getting in front of, or remediating security breaches. The panel was moderated by Una Dean, Assistant U.S. Attorney for the Eastern District of New York, National Security and Cybercrime Section and included panelists: Joanna Levin, Corporate Counsel, Global Privacy for Pfizer; Erez Liebermann, Chief Counsel-Cybersecurity and

Privacy for Prudential; Mark Schildkraut, Assistant General Counsel- IP and Worldwide Cybersecurity Counsel for BD, and Andrew Tannenbaum, Cybersecurity Counsel for IBM.

The Committee, along with the Young Lawyers Committee, held a joint happy hour networking event on February 7, 2017 with more than thirty attendees mingling over food and drinks. Throughout the year, the Committee also held various telephonic and in-person committee meetings where constructive ideas were shared relating to various potential events. Overall, the Women in IP Law Committee had a productive year with many active members contributing their tireless efforts and great ideas to developing our Committee and events.

YOUNG LAWYERS

Scope of the Committee: To address the concerns and needs of minorities, women and newly-admitted lawyers, and to report with respect thereto to the Board of Directors.

Co-Chairs: Steven Bernstein and Lindsay Korotkin

Board Liaison: Heather Schneider

Members: Stephen Ankrom, Elana Araj, Timothy Buckley, Alexandra Caleca, Preetha Chakrabarti, Isaac Chao, Srikant Cheruvu, Frank DeLucia, Vicki Franks, John Geager, David Hubbard, Gina Kim, Eric Lin, Steven Luksenberg, Jacqueline Niedbala, Khalil Nobles, Loren Pani, Brian Reddy, Jeremy Saks, Diana Santos, Michael Sebba, Kyung Shin, Cindy Shu, Emily Stein, Edward Tulin, Julie Vo, George Wukoson, Gary Yen, and George Zalepa

The Young Lawyers Committee wrapped up another eventful year in 2016-2017. This year the Committee continued its educational series of Young Lawyers Roundtables, expanded collaboration with other NYIPLA committees, and created more networking opportunities for young lawyers in the NYIPLA.

The first of this year's Roundtables took place on October 7, and was entitled, "All the Licenses You Will Encounter as an IP Attorney." Led by Christopher Chase (Frankfurt Kurnit Klein & Selz) and Kristin Garriss (Kilpatrick Townsend & Stockton) and moderated by Committee member Gary Yen, Roundtable attendees participated in a lively discussion about all aspects of licensing law and practice. The Committee's spring Roundtable took place on February 23, and was entitled "The ABCs of ADR." Led by Daniel Ebenstein (Amster, Rothstein & Ebenstein) and Theodore Cheng (Fox Horan & Camerini) and moderated by Committee member Michael Sebba, participants learned about the practices of arbitration and mediation from two experienced practitioners.

This year the Committee also increased collaboration on events with other NYIPLA committees. The Committee joined several other committees for happy hours throughout the year to create networking opportunities for young lawyers, and also co-hosted a webinar entitled, "A Day in the Life of a Privacy Practitioner," with the Privacy, Big Data & Cybersecurity Committee. The Committee also strengthened relationships with several groups at New York law schools, and expects to build upon those relationships to host exciting events in the upcoming year.

The Committee looks forward to a year of growth as it plans additional networking, outreach, and educational activities in the upcoming year. The Committee thanks all NYIPLA members who participated in its events this past year, and invites all young lawyers to attend an upcoming Young Lawyers Committee happy hour.

Annual Report of the Treasurer 2016-2017
The New York Intellectual Property Law Association, Inc.
Statements of Financial Position – Cash Basis
For the years ended April 30th

	<u>2017</u>	<u>2016</u>
Revenues		
Judges Dinner - event fees	\$ 1,238,020	\$ 1,236,890
Continued legal education (CLE) revenue	82,430	87,385
Membership dues	250,495	277,403
Other programs and events	26,815	13,956
Interest income	<u>2,148</u>	<u>2,473</u>
Total revenues	<u>1,599,908</u>	<u>1,618,107</u>
Expenses		
Judges Dinner	867,284	878,811
Continued Legal Education (CLE)	42,157	47,959
Other programs and events	87,953	65,227
Scholarships, awards and donations	19,096	63,500
Professional fees	539,970	473,658
Postage and mailing	1,089	1,311
Printing and publications	53,869	72,784
Office expense	14,534	13,510
Telephone	780	1,538
Insurance	11,051	12,007
Miscellaneous	<u>1,139</u>	<u>753</u>
Total expenses (Note 3)	<u>1,638,922</u>	<u>1,631,058</u>
Change in unrestricted net assets (Exhibit C)	(39,014)	(12,951)
Net assets - unrestricted - beginning of year	<u>2,042,998</u>	<u>2,055,949</u>
Net assets - unrestricted - end of year (Exhibit A)	<u>\$ 2,003,984</u>	<u>\$ 2,042,998</u>

See independent auditor's report.

The accompanying notes are an integral part of these statements.

Annual Report of the Treasurer 2016-2017
The New York Intellectual Property Law Association, Inc.
Statements of Activities & Changes in Net Assets – Cash Basis
For the years ended April 30th

	<u>2017</u>	<u>2016</u>
Cash flows from operating activities		
Change in net assets (Exhibit B)	\$ (39,014)	\$ (12,951)
Adjustments to reconcile change in net assets to net cash provided (used) by operating activities		
Decrease (increase) in assets		
Accounts receivable	3,150	(3,150)
Prepaid expenses	24	
Increase (decrease) in liabilities		
Accounts payable and accrued expenses	4,387	(45,047)
Deferred revenue	<u>55,685</u>	<u>(8,750)</u>
Net cash provided (used) by operating activities	<u>24,232</u>	<u>(69,898)</u>
Net change in cash and cash equivalents	24,232	(69,898)
Cash and cash equivalents - beginning of year	<u>2,064,049</u>	<u>2,133,947</u>
Cash and cash equivalents - end of year	<u><u>\$ 2,088,281</u></u>	<u><u>\$ 2,064,049</u></u>

See independent auditor's report.

The accompanying notes are an integral part of these statements.

95th Annual Dinner in Honor of the Federal Judiciary

The New York Intellectual Property Law Association held its 95th Annual Dinner in Honor of the Federal Judiciary on March 31, 2017 at the New York Hilton Midtown Hotel. President Walter E. Hanley, Jr. welcomed the honored guests, members of the NYIPLA, and their guests. Joseph Bartning, Malena Dayen, and Emily Eagen opened the evening with a magnificent rendition of the National Anthem. The Association's Fifteenth Annual Outstanding Public Service Award was presented to the Honorable Denny Chin, Circuit Judge for the United States Court of Appeals for the Second Circuit. The Keynote address was given by Walter Isaacson, President and CEO of the Aspen Institute and author of *The Innovators: How a Group of Hackers, Geniuses, and Geeks Created the Digital Revolution*; *Steve Jobs*; *Einstein: His Life and Universe*; and *Benjamin Franklin: An American Life*.



Standing: (Left to Right) Hon. Christopher Conner, Heather Schneider, Hon. Leonard Stark, Hon. Barbara Lynn, Hon. Robert Katzmman, Peter Thurlow, Robert Rando
Seated: (Left to Right) Hon. Janet Hall, Matthew McFarlane, Hon. Sharon Prost, Hon. Denny Chin, Walter Hanley, Jr., Walter Isaacson, Annemarie Hassett







NEW YORK
MIDTOWN HILTON

MARCH 31, 2017

THE
NEW YORK INTELLECTUAL PROPERTY
LAW ASSOCIATION

95th Annual Dinner in Honor of the Federal Judiciary

presents

DAY OF THE DINNER CLE



Intent in Patent Cases

*How Courts Sort Out
Whether Infringement Is Knowing,
Egregious or Exceptional*



PANELISTS

HONORABLE RON CLARK

CHIEF JUDGE OF THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS

HONORABLE RICHARD G. ANDREWS

JUDGE OF THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

HONORABLE F. DENNIS SAYLOR IV

JUDGE OF THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

MODERATOR

DOROTHY R. AUTH

NYIPLA IMMEDIATE PAST PRESIDENT
PARTNER, CADWALADER, WICKERSHAM & TAFT LLP

REGISTRATION
11:00 A.M. – 11:30 A.M.

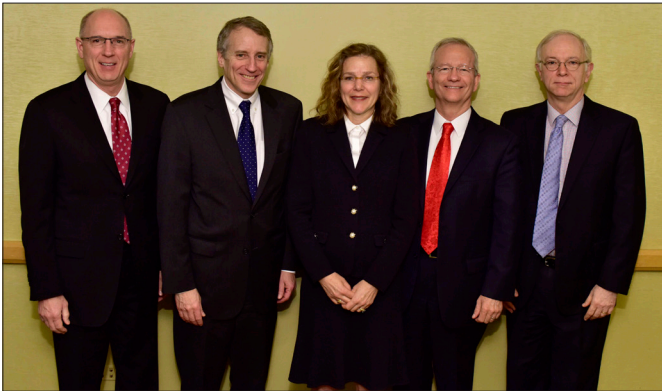
LUNCH
11:30 A.M. – 12:20 P.M.

PRESENTATION
12:20 P.M. – 2:15 P.M.

2.0 NY/NJ CLE
PROFESSIONAL
CREDITS FOR BOTH
NEWLY ADMITTED
AND EXPERIENCED
ATTORNEYS



*Hosted by the
NYIPLA Programs Committee*





Hot Topics in Intellectual Property Law

Wednesday, July 20, 2016 • Princeton Club, 15 West 43rd Street, New York 10036

EARN 3.5 NY/NJ CLE CREDITS INCL. **0.5 ETHICS** • FOR BOTH NEWLY ADMITTED & EXPERIENCED ATTORNEYS



- | | |
|---------------|---|
| 12:00 - 12:45 | Registration and Lunch |
| 12:45 - 1:00 | Welcome Remarks |
| 1:00 - 1:30 | <p>Keynote Address State of the Union in Fashion Law
 Professor Barbara Kolsun, Adjunct Professor of Fashion Law at Cardozo and Co-Director of Cardozo's FAME program (Fashion, Art, Media and Entertainment)</p> |
| 1:30 - 2:00 | <p>Evidentiary Considerations for Evaluating "Disparaging Marks" Under Section 2(a)
 Dyan Finguerra-DuCharme, Partner, Pryor Cashman LLP
 Scott Greenberg, Senior Counsel, Locke Lord LLP
 Robert L. Raskopf, Partner, Quinn Emmanuel LLP</p> |
| 2:00 - 2:30 | <p>Shammas & Nantkwest: A Critical Look at Expense-Shifting Provisions and the De Novo Review of Agency Rulings
 Charles E. Miller, Member, Eaton & Van Winkle LLP</p> |
| 2:30 - 2:45 | Refreshment Break |
| 2:45 - 3:15 | <p>Criminal Prosecution In Counterfeit Trademark and Trade Secret Cases
 William P. Campos, Assistant U.S. Attorney, Intellectual Property Crimes Coordinator, Business and Securities Fraud Unit, U.S. Attorneys' Office of the Eastern District of New York</p> |
| 3:15 - 3:45 | <p>New Rules and New Fees... What Changes Are Afoot at the TTAB?
 Honorable Gerard F. Rogers, Chief Administrative Trademark Judge, Trademark Trial and Appeal Board</p> |
| 3:45 - 4:15 | <p>Exploring a Trademark Safe Harbor
 Patricia Chang, Legal Specialist, Etsy</p> |
| 4:15 - 4:45 | <p>Ethical Considerations in Trademark Practice – EARN ETHICS!
 Kathleen E. McCarthy, Partner, King & Spalding LLP</p> |
| 4:45 - 4:50 | Closing Remarks |

Hosted by the

NYIPLA Trademark Law & Practice Committee in conjunction with the NYIPLA Programs Committee

One-Day Patent CLE Seminar

November 17, 2016

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

EARN 7.0 PROFESSIONAL CLE CREDITS INCL. 2.0 ETHICS CREDITS

AGENDA

- 8:15 AM - 9:00 AM** *Registration and Continental Breakfast will be served*
- 9:00 AM - 9:05 AM** *Welcome Remarks* **Walter E. Hanley**, NYIPLA President, Andrews Kurth Kenyon
- 9:05 AM - 10:25 AM** **Panel 1: Litigation Discovery Considerations from an In-house Counsel Perspective: Litigation Hold Memos, Spoliation and ESI**
Moderator: Michael W. Johnson Willkie Farr & Gallagher LLP
- **Philip L. Blum** *Vice President and Senior Counsel*, CA Technologies
 - **Serena Farquharson-Torres** *Senior Patent Counsel*, Bristol-Meyers Squibb Company
 - **Kevin B. Jordan** *Partner, Vice President and Assistant General Counsel*, J.P. Morgan Chase & Co.
- 10:25 AM - 10:40 AM** *Refreshment Break*
- 10:40 AM - 12:00 PM** **Panel 2: The State of Available Remedies for Patent Infringement: Injunctive Relief, Willfulness and Enhanced Damages, and Attorneys' Fees**
Moderator: Jamie L. Lucia Saul Ewing LLP
- **Jessica L. Copeland** *Partner*, Hodgson Russ LLP
 - **Heidi J. Martinez** *Associate General IP Counsel*, Xerox
 - **William J. McCabe** *Partner*, Perkins Coie LLP
 - **Steven Purdy** *Corporate Litigation Counsel*, IBM
- 12:00 PM - 12:45 PM** *Lunch*
- 12:45 PM - 1:15 PM** **Keynote Speaker Honorable Dora L. Irizzary** *Chief Judge*, United States District Court for the Eastern District of New York
- 1:15 PM - 2:10 PM** **Interactive Post-Lunch Presentation on the Changing Landscape of Technology: Ethics and Professional Responsibility**
- **Andrew H. Berks** *Partner*, Cittone & Chinta LLP
 - **John F. Resek** *Resek Liang & Frank LLP*
- 2:10 PM - 3:30 PM** **Panel 3: Recent Developments in Practice Before the USPTO: Ethics in Practicing in New Program and Procedures**
Moderator: Mark Bloomberg, Zuber Lawler & Del Duca LLP
- **William R. Covey** *Deputy General Counsel of the Office of Enrollment and Discipline and Director of OED*, USPTO
 - **Robert Oberleitner** *Assistant Deputy Commissioner of Patent Operations*, USPTO
 - **Anthony Knight** *Administrator of the Office of Stakeholder Outreach and Patents Ombudsman*, USPTO
- 3:30 PM - 3:45 PM** *Refreshment Break*
- 3:45 PM - 5:05 PM** **Panel 4: Recent PTAB, Federal Circuit and Supreme Court Developments Across a Range of Issues**
Moderator: Robert J. Rando The Rando Law Firm
- **Honorable Arthur J. Gajarsa** *Former Circuit Judge*, United States Court of Appeals for the Federal Circuit
 - **Honorable Scott E. Kamholz** *Partner*, Foley Hoag LLP and *Former Administrative Patent Judge*, United States Patent Trial and Appeal Board
 - **Charles R. Macedo** *Partner*, Amster Rothstein & Eberstein LLP
- 5:05 PM - 5:10 PM** *Closing Remarks*

Hosted by the NYIPLA Programs Committee



Events

PTAB Trials: Tips and Strategies

June 8, 2016

Hosted by the Patent Litigation Committee

Co-chairs: Douglass Nemec and Leslie Spencer

Panelists: Honorable Kimberly McGraw,
Honorable Bryan Moore, J. Steven Baughman,
and Sang Young Brodie

Moderator: Douglas Nemec

Sponsored by: Skadden, Arps, Slate, Meagher & Flom

3rd Annual Second Circuit Moot Court Argument CLE Program

July 11, 2016

Hosted by the Programs Committee

Co-chairs: Michael Johnson,
Jamie Lucia, and Ksenia Takhistova

Judges' Panel: Honorable Margo K. Brodie,
Honorable Denny Chin, and Honorable William F. Kuntz

Participating Firms: Hodgson Russ,
Pryor Cashman, Ropes & Gray and WilmerHale

USPTO Quality Check – One Year Later

June 14, 2016

Hosted by the Programs Committee

Co-chairs: Michael Johnson, Jamie Lucia,
and Ksenia Takhistova

Panelists: Mark Bloomberg, Wendy Garber, Jack Harvey,
Robert Rando, Valencia Martin Wallace,
and *Moderator:* Mindy Bickel



Happy Hour Hosted by the Young Lawyers Committees

August 9, 2016

Hosted by the Young Lawyers Committee

Co-chairs: Lindsay Korotkin and Gary Yen

Events

Business Development for Young Lawyers

September 13, 2016

Hosted by the Young Lawyers Committee

Co-chairs: Lindsay Korotkin and Gary Yen



Young Lawyers Roundtable – Speaking the Language of Your Clients: Music Industry

September 26, 2016

Hosted by the Young Lawyers Committee

Co-chairs: Lindsay Korotkin and Gary Yen

Panelists: Andrew Sparkler,
Keenan Popwell, and Jeff Curtin

Sponsored by: Arent Fox

In-House Counsel Happy Hour

October 13, 2016

Hosted by the Corporate Committee

Co-chairs: Tulloss Delk and Betty Ryberg

Managing / Trying Cases in a Post Issuance Review World: Life at the PTAB / District Court Interface

September 21, 2016

Hosted by the Patent Litigation Committee

Co-chair Douglass Nemec and
Committee Member Ken Adamo

Panelists: Honorable Faith Hochberg,
Honorable Scott Kamholz, Honorable Jeff Kaplan,
and Honorable Neil Smith

Sponsored by: Kirkland & Ellis



Women in IP Wine Tasting

October 19, 2016

Hosted by the Women in IP Law Committee

Co-chairs: Jessica Copeland and Jenny Lee

Speaker: Sarah Feingold

Sponsored by: Frommer Lawrence & Haug



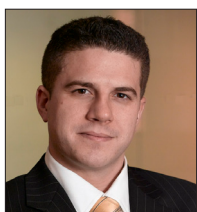
Events

Show Me the Money! A Primer on Lanham Act Damages

November 10, 2016

Speakers: Frank Misiti, John Plumpe, and Dana Smith

Moderator: Michael Cannata



NJIPLA & NYIPLA Joint Program: Ethics Issues in IP Practice

December 8, 2016

Speakers: William Covey, Anthony Davis
Professor David Hricik, and David Rabinowitz



Happy Hour Hosted by the Young Lawyers Committee

November 15, 2016

Co-chairs: Lindsay Korotkin and Gary Yen

When in Rome: Insights From Practitioners in the Nation's Busiest Patent Courts

January 11, 2017

Panelists: Jack Blumenfeld, Arnold Calmann, Jennifer Doan
and Clyde Siebman

Moderator: Marc Pensabene

Sponsored by: O'Melveny



Events

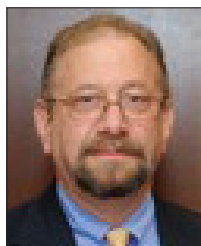
Understanding the Upcoming Changes to the Trademark Rules and Practice

January 12, 2017

Panelists: Collen Kearney and Honorable David Mermelstein

Moderator: Dyan Finguerra-DuCharme

Sponsored by: Pryor Cashman



Happy Hour! With the Women in IP Law and Young Lawyers Committees

February 7, 2017

Hosted by: Young Lawyers Committee

Copyright Law & Practice and Trademark Law & Practice Happy Hour

February 16, 2017

Hosted by: Trademark Law & Practice
and Copyright Law & Practice Committee

Protecting Valuable and Sensitive Information in the Corporate Setting

February 28, 2017

Speakers: Una Dean and Joanna Levin

Sponsored by: Skadden, Arps, Slate, Meagher & Flom



Young Lawyers Roundtable – Speaking the Language of Your Clients: The Advertising Industry

March 23, 2017

Hosted by: Young Lawyers Committee

Panelists: Julia Clark, Patrick O'Donoghue,
and Scott Schreiber

Sponsored by: Frank Kurnit Klein & Selz

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®
2125 Center Avenue, Suite 406, Fort Lee, NJ 07024-5874
Tel 1.201.461.6603 • Fax 1.201.461.6635
E-mail admin@nyipla.org • Web www.nyipla.org