

Amicus Brief Committee

Over the past year, the Association has continued its strong history of representing its diverse intellectual property constituency before the courts through the activity of its Amicus Briefs Committee, which coordinates the activities of the Association in the preparation and filing of briefs *amicus curiae*.

Since the last Annual Meeting on May 14, 2019, committee members participated in the preparation and filing of five briefs in the Supreme Court and one in the Court of Appeals for the Federal Circuit. In the Supreme Court, the committee filed briefs on the merits in *Peter v. Nantkwest, Inc.* (the Supreme Court unanimously agreed with the committee's position that attorneys' fees are not "expenses" payable by appellants in actions brought under Section 145 of the Patent Act), *Thryv, Inc. v. Click-to-Call Technologies, LP* (regarding the ability of the Federal Circuit in an appeal of an IPR final written decision to review the PTAB's 35 U.S.C. § 315(b) time-bar determinations), and *United States Patent and Trademark Office v. Booking.com B.V.* (regarding when it is appropriate to consider survey evidence in evaluating whether a purported trademark is generic). The committee also filed briefs in support of Petitions for Certiorari in *Booking.com B.V. v. United States Patent and Trademark Office* (pending, similar to the issue in *Nantkwest*, regarding whether attorneys' fees are "expenses" payable by appellants in actions brought under Section 1071(b)(3) of the Lanham Act) and *Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC* (denied, regarding patent eligibility in the context of medical diagnostic procedures). In the Federal Circuit, the committee filed a brief in support of the United States' petition for rehearing *en banc* in *Arthrex, Inc. v. Smith & Nephew, Inc.* (denied, regarding the constitutionality of administrative patent judges and the Panel's remedy of making them into "inferior officers").

The Committee has 24 official members, but roughly 45 members of other Committees have also participated in our Committee's monthly meetings over the past year. Twenty-five of these Association members have participated as authors on the amicus briefs discussed above.

During the past year, the Supreme Court ruled on four cases where the committee filed briefs on the merits, namely *Peter v. Nantkwest, Inc.* (see above), *Iancu v. Brunetti* (holding, consistent with the Association's position, that the Lanham Act's prohibition on registration of trademarks that are immoral or scandalous discriminates based on viewpoint is unconstitutional), *Return Mail, Inc. v. United States Postal Service* (holding that a federal agency is not a "person" who may petition for post-issuance review under the AIA and adopting, in part, the position advocated by the Association), and *Mission Product Holdings, Inc. v. Tempnology, LLC* (holding, in line with the Association's reasoning, that under Section 365, a debtor's rejection of an executory contract in bankruptcy, such as a trademark license, has the same effect as a breach outside bankruptcy, and that such an act cannot rescind rights that the contract previously granted). The Supreme Court also denied certiorari in cases that the Association thought should be heard, namely *Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC* (see above) and *RPX Corp. v. ChanBond LLC* (whether the Federal Circuit can refuse to hear an appeal by a petitioner from an adverse final written decision in an IPR proceeding on the basis of a lack of a patent-inflicted injury-in-fact,

Copyright Law & Practice Committee

The 2019-2020 NYIPLA Copyright Law & Practice Committee comprises 17 attorneys and law students sharing the common goals of advancing dialogue on emerging issues in copyright law, supporting the various copyright-related initiatives of the NYIPLA and its other committees, and building a community of copyright attorneys through in-person events and regularly scheduled meetings. In January, the Committee hosted a joint in-person social event with the Trademark Law & Practice Committee. Throughout the year, the Committee convened for monthly teleconferences featuring presentations on notable copyright decisions, including *Georgia, et al. v. Public.Resource.org, Inc.*, *Allen v. Cooper*, and *Google LLC v. Oracle America, Inc.*, in addition to copyright legislation, including the Copyright Alternative in Small-Claims Enforcement (CASE) Act of 2019.

The Committee remains committed to engaging in public discourse concerning important copyright-related issues. In the past year, the Committee drafted comments on behalf of the NYIPLA in response to the USPTO's NOI concerning intellectual property protection for artificial intelligence innovation, as well as the U.S. Copyright Office's NOI concerning publication-related issues that arise in the context of the copyright registration application process. The Committee continued to advise the NYIPLA in connection with its copyright-related discussions within the broader intellectual property community, including making recommendations to the Board concerning proposed copyright legislation. The Committee also has several copyright-focused podcast episodes in the works, which will be featured as part of the NYIPLA's *PodBites* series.

Corporate Committee

The Corporate Committee had a productive year, with regular meetings designed to provide its members with meaningful and relevant content. A highlight of the year was an in-person lunch meeting hosted by Goodwin Procter, following up on last year's roundtable event on gender diversity in innovation. At the lunch, a representative of IPO presented on their gender diversity in innovation toolkit, and committee members continued the conversation on how to improve on this front.

The Committee also heard from Volunteers of Legal Service (VOLS), who shared information on opportunities for IP-related pro bono support through their Microenterprise Project.

Other meetings included outside experts speaking on a variety of topics. Chris Israel of American Continental Group once again joined a meeting to share an update on activity in DC; partners from Quinn Emanuel, Kirkland & Ellis, and Desmarais joined a panel on the topic of "What Outside Counsel Want"; and David Leason and Ed Ellis of Leason Ellis LLP led our committee in a conversation on the topic of design patent strategy for in-house counsel.

The Committee held its annual in-person mixer in September, inviting Young Lawyers Committee members to once again join the event. As a new twist, we included a "fireside chat" with Corporate Committee members, sharing perspectives on career growth.

Fashion Law Committee

The Fashion Law Committee (“Committee”) had 25 active members this year. The Committee corresponded extensively, conducted multiple meetings, contributed to NYIPLA publications and amicus briefs, and organized several CLE events.

In October 2019, the Committee organized and conducted its kick-off program entitled “Drawing the Line Between Trademark Use and Fair Use in the Context of Style and Product Names” held at the offices of Pryor Cashman LLP. CLE was offered and the presentation discussed the impact of *Hard Candy v Anastasia*, an 11th Circuit case that examined whether the use of a cosmetics’ company’s longstanding and famous house mark HARD CANDY by another cosmetics company as the shade name for one its products constitutes trademark infringement or a descriptive fair use. The program was well attended and had 71 registered attendees.

The keynote speaker at was Barbara Kolsun, a leading fashion industry attorney, a Professor of Practice of Fashion Law at Cardozo Law School in New York City where she teaches Fashion Law and related courses, and the co-editor of both *Fashion Law- A Guide for Designers, Fashion Executives and Attorneys*, as well as *Fashion Law* the first casebook covering the emerging issues in fashion law.

In addition to Ms. Kolsun, the program also featured several distinguished speakers: Jessica Heiss, Vice President and Trademark Counsel for The Estee Lauder Companies Inc. and Jessica Elliott Cardon, Deputy General Counsel for Perfumania Holdings, Inc., the perfume retailer, and its related entities, including Parlux Fragrances and Five Star Fragrances.

The Committee is presently planning another program in the Fall of 2020.

Hon. William C. Conner Writing Competition Committee

The Committee solicited and reviewed entries for the William C. Conner Writing Competition. The announcement of the competition was posted on the NYIPLA website in September 2018. In December 2018, notice was sent to professors at a number of law schools to ask that the writing competition announcement be posted to ensure the students were aware of the opportunity.

The Committee received 18 submissions in 2019. This was an increase of 7 from the previous year, and still shy of the number of submissions that has been typically received over the last five years (~25). From those 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. Winner: Rachel Horn, "Not Just Aereo 2.0: Locast, Free TV, and Section 111's Exemption for Nonprofit Retransmission Services"
2. Runner-up: Danielle Marino, "An Illicit Love Affair: How The United States' Legal Landscape Coupled With Social Media Has Created A Fast Fashion Firestorm"

The NYIPLA notified the winners and arranged for the presentations to be made directly to the recipients in an online format, rather than in-person at the Annual Dinner, which was cancelled in 2020.

Inventor of the Year Award Committee

The 2020 Inventor of the Year Award Committee received multiple high-quality submissions for consideration, including a couple repeat submissions. It presented its top two choices to the Board for discussion and approval, and the Board agreed with the Committee's recommendation. At the NYIPLA Virtual Annual Meeting on May 12, 2020, the Association formally announced the 2020 Inventor of the Year Award Winner, **Dr. Rajiv Joshi**.

Dr. Joshi, a key Technical Lead Researcher and Staff Member at the IBM Watson Research Center for over 35 years, was recognized for his pioneering work in advancing the electronic industry and improving artificial intelligence capabilities. His research led to breakthrough discoveries related to the scaling of Moore's law, increasing the computing power of a processor, utilizing machine learning in statistical techniques for big data analysis, and improving memories for data storage capabilities. As the drive for miniaturization and computing power continued, Dr. Joshi's discoveries in material science, including novel compounds and chemical and vapor deposition techniques, helped to achieve miniaturization of electronic circuits. As a result, Dr. Joshi's fundamental inventions are part of almost all computing devices such as servers, mainframes, laptops, smart phones, wearable devices, healthcare electronics, and others—and have made a valuable contribution to society. Dr. Joshi's discoveries also include techniques for predicting failure of electronic circuits utilizing machine learning, which optimize the circuit yield to minimize fabrication losses. Accordingly, his unique computer memory designs have increased data storage capability immensely.

Dr. Joshi is an IEEE Fellow, a member of IBM Academy of Technology, the winner of several coveted national and international awards and an inventor with over 250 US and over 350 international patents. The inventions for which he was recognized as the 2020 Inventor of the Year include: Integrated Circuit Interconnect for Low Power, U.S. Patent No. 6943105; Predictive Failure Analytics and Applications to Machine Learning, U.S. Patent No. 8214190; and Integrated Circuit Memory and Its Usage to Hardware Accelerators for Artificial Intelligence, U.S. Patent No. 8670281.

The Committee Co-chairs would like to recognize and thank the entire Committee for another successful year and their excellent work researching, reviewing, and ranking the submissions. We also want to thank our Board liaison, Patrice Jean, for her help, guidance and support along this process.

IP Transactions Committee

The IP Transactions Committee (“Committee”) has 18 active members. This past year, the Committee conducted multiple conference calls and organized a CLE event.

This event took place on November 13, 2019, and was titled “Patent and Non-Traditional IP Diligence.” The Committee organized this event in collaboration with the Women in IP Law Committee. The program also featured several speakers, including Jeanne C. Curtis, Director at CDF Consulting, Nora E. Garrote, Partner at Venable LLP, Khue Hoang, Partner at Reichman Jorgensen LLP, Chloe Steadman, Vice President and Underwriter at Euclid Transactional, and Dorothy von Hollen, Vice President and Corporate Counsel for Intellectual Property at Prudential Financial, Inc.

Members of the Committee participate in monthly phone calls and discuss various IP transactions-related topics. Going forward, the committee plans to continue holding monthly calls, put on another CLE panel or webinar, organize in-person meetings and a social event.

Legislative Action Committee

The Legislative Action Committee continues to support the Association in monitoring proposed and pending legislation of interest to its Members and to the intellectual property committee in general. This past year a principal focus (especially through the Committee's active Pharma Subcommittee) has been on considering issues relating to various life sciences-related legislation, including pay-for-delay settlement bills, various pharma pricing bills, and other bills proscribing so-called 'product hopping' and 'patent thickening,' among others. We also are studying and providing guidance on COVID-19-related IP issues, including the presentation of at least one webinar on that expansive topic.

Members of the Committee participated in various Roundtables (in Washington, DC) related to subject matter eligibility (Section 101). The Committee also coordinated with the Trademark Committee regarding proposed amendments designed to address concerns about fraudulent trademark applications, the "cluttering of the trademark register," and the presumption of irreparable harm in trademark infringement cases. We also have formed an active Subcommittee reviewing and providing guidance on design patent legislation. We are actively observing and advising on the IPR Center (the National Intellectual Property Rights Coordination Center, part of ICE).

Patent Law & Practice Committee

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, 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. Our Committee co-chair, Jonathan Berschadsky, led a panel discussion at the One-day Patent CLE in November 2019 on the topic "Inside View for Working with the USPTO." The panel included, Stefanos Karmis, the Director of the Office of Patent Quality Assurance at the USPTO and patent practitioners, including a former patent examiner. We also hosted a luncheon prior to the CLE at the request of the USPTO with Mr. Karmis and Daniel Ryman, Associate Commissioner for Patent Quality, and a number of our committee members, to discuss the Patent Quality Initiative, give feedback to the USPTO as stakeholders, and learn about future plans for addressing patent quality at the USPTO.

Patent Litigation Committee

The Patent Litigation Committee enjoyed an active and successful 2019-20 committee season. We held monthly teleconference meetings, which provided a regular forum for personal interaction among members and insightful discussion. Our Committee also continues to take steps to expand participation by more junior lawyers, including working with the Young Lawyers Committee.

Beyond monthly meetings, we sponsored or co-sponsored a number of Association-wide events, including:

(1) On September 19, 2019, the Patent Litigation Committee of the NYIPLA sponsored a Judges Panel with distinguished jurists from three of the most important venues for patent litigation in the United States. The District of Delaware's newest member of the bench, Judge Maryellen Noreika, was joined by Chief Administrative Law Judge Charles Bullock, the longest serving ALJ at the International Trade Commission, and retired Judge John Lifland of the District of New Jersey in an engaging discussion moderated by Steven Rizzi of King and Spalding;

(2) On February 11, 2020 we co-sponsored with the Women's Committee, a biosimilars program titled "BPCIA Litigation – A View From The Trenches" with panelists Karen Shen, Senior Corporate Counsel, Pfizer, Heather M. Schneider, Partner, Willkie Farr & Gallagher and Irena Royzman, Ph.D., Partner, Kramer Levin, which was moderated by Katherine Helm, Ph.D., Partner, Dechert; and

(3) On March 24, 2020, we sponsored a webinar titled "An Overview Of District Court Responses To CoronaVirus" with panelists Kenneth Adamo, owner of Law Offices of KRadamo, Irene Hudson, Partner, McGuireWoods, and Zachary Travis, Associate, Willkie Farr & Gallagher.

After an active and successful year behind us, the committee looks forward to carrying the momentum into the 2020-21 season.

Programs Committee

This year the Programs Committee continued its service to NYIPLA Members by providing high quality programs, informative presentations, and distinguished keynote speakers. Committee members have been meeting on a weekly basis to provide to plan and coordinate various programs throughout the year. Its slate of programs includes, among others, the annual Full-Day Patent Program in November, the annual summer moot court program before the Second Circuit, and various webinars in lieu of the Day of Dinner Program.

The Programs Committee was honored to present, in conjunction with the Second Circuit Court of Appeals, the Sixth Annual Second Circuit Moot Court Argument CLE Program on July 9, 2019. The proceedings were held at the Thurgood Marshall Courthouse and presided over by the Honorable P. Kevin Castel, the Honorable Brian M. Cogan and the J. Paul Oetken, United States District Court Judges for the Southern District of New York and the Eastern District of New York sitting by designation. Participants from four different member firms presented oral arguments based on a hypothetical fact pattern for issues that are at the forefront in current patent litigation: (1) proper venue under the *TC Heartland* decision; and, (2) Section 101 patent eligible subject matter under the SCOTUS *Alice/Mayo* framework. We thank Board and Programs Committee Member Rob Rando for his continued efforts in making this program a success year after year.

On Thursday, November 13, 2019, the NYIPLA Programs Committee hosted its annual One Day Patent CLE Seminar at The Princeton Club, which was a success. This year's program included five panels, a luncheon keynote speaker, and an interactive luncheon presentation. The Programs Committee was honored to have Chief Judge Freda Wolfson, District of New Jersey as the Keynote Speaker for this program and participants from the USPTO in two of our panels this year.

The program began with an insightful discussion relating to reasonable royalties when assessing patent damages and addressed questions of calculating damages in patent litigation from the point of view of in-house counsel, outside counsel, and economic experts. The second panel of the day tackled the important issue of diversity and inclusion within our profession. Panelists from the USPTO, in-house and a law firm discussed issues concerning diversity, and tools and strategies for implementing diversity within organizations. The Legislative Action Committee presented a panel providing a timely update of pending and proposed legislation that could have significant impact on areas of intellectual property. Our lunchtime interactive CLE program addressed social medial use for lawyers and New York State Bar Association's guidelines concerning social medical use.

The Programs Committee also collaborated with the Patent Law Committee for a moderated panel about interactions with the USPTO and included a discussion about the inner workings of the USPTO. The panel included Stefanos Karmis, Senior Advisor for the Office of the Deputy Commissioner for Patent Quality from the USPTO. He discussed patent quality, how examiners are trained, and the resources/opportunities available to practitioners and their applicants. The panel additionally included a former patent examiner, who provided insight from the point of view of an examiner. The Women in IP and the IP Transactions Committees presented the last panel of the day discussing IP diligence in technology transactions.

The Programs Committee was also honored to have slated participation from District Court Judges and the Executive Branch at the Day of Dinner Luncheon originally scheduled for March 20, 2020. That program was unfortunately postponed in view of the current COVID-19 emergency. However, the committee has worked to organize a series of webinars for NYIPLA Members providing timely updates regarding the state of litigation and patent practice in view of the current state of emergency. We thank the Patent Litigation and Patent Law Committees for providing rapid and timely updates regarding district courts' responses to and practical guidance in managing patent portfolios in view of the current state of emergency in webinars on March 24 and 26, 2020, respectively. Additional webinars include information for law firms about the recently passed CARES Act (April 17, 2020), discussions regarding current state of the courts with Judge P. Kevin Castel of the Southern District of New York (April 23, 2020) and Chief Judge Leonard P. Stark of the District of Delaware (May 5, 2020) and a discussion with Director Andrei Iancu of the USPTO (to be scheduled for May). We also thank the Legislative Action Committee for working with us to provide a webinar regarding current and potential legislation affecting patent rights in the face of the COVID-19 epidemic (April 28, 2020).

The Programs Committee has also been coordinating with other committees of the NYIPLA to help facilitate scheduling and planning of various events for the Association so that the in-person events are well-attended while we continue to deliver valuable content to our membership. The Committee solicited programming ideas and proposed dates from various committees of the Association throughout the year and facilitated collaboration and coordination between committees to provide a slate of robust programming that is logistically feasible for the Association calendar. The Programs Committee also provided additional support in the planning of various events throughout the year. 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, the Committee's Board liaison, Heather Schneider, and the NYIPLA administrative office to whom we are grateful.

PTAB Committee

In 2018, the Association established the Patent Trial and Appeals Board (“PTAB”) Committee to provide thought leadership regarding legislation, rules and litigation practice with respect to post-issuance proceedings heard by the PTAB, and to make recommendations to the Board in connection therewith. Since then, the Committee has attracted nearly 40 members (including counsel working in-house and attorneys in private practice) and has been active both in developing a forum where practitioners can discuss legal developments affecting post-issuance proceedings, and in providing practical recommendations to improve PTAB practice by submitting comments on US Patent & Trademark Office (“USPTO”) proposed revisions to PTAB rules.

Over the past year, in addition to monthly calls where the Committee discusses the latest cases and trends involving PTAB practice, it hosted two live meetings. On December 11, 2019, the Committee sponsored a panel presentation on the PTAB’s use of discretion to deny institution of a PTAB proceeding and featured Hon. William M. Fink, Vice Chief Administrative Patent Judge at the USPTO. On February 4, 2020, the Committee hosted another live lecture entitled “PTAB Precedential Opinion Panel’s (POP) Decision in *Hulu, LLC v. Sound View Innova.*” that featured former PTAB Administrative Patent Judge and PTAB Committee member Brian Murphy. The Committee had another live panel planned for April 7, 2020 featuring Lead Administrative Patent Judge Michelle Akenbrand to discuss the PTAB’s motion to amend practice in PTAB proceedings along with the Precedential Opinion Panel’s (POP) decision in *Hunting Titan Inc. v. DynaEnergetics GmbH & Co. KG*. However, due to the pandemic, the Committee has postponed this panel until national and local health conditions permit.

Additionally, several PTAB Committee members have participated in the NYIPLA’s new Pod Bites Series, which discusses current issues and developments in intellectual property law. The PTAB Committee, in conjunction with the Amicus Brief Committee, also prepared and submitted an amicus brief in *Arthrex v. Smith & Nephew, Inc.* on December 30, 2019 on behalf of the Association. The amicus brief encouraged the full Court to accept rehearing *en banc* of the October 31, 2019 Panel Decision, which declared PTAB APJs principal officers that were appointed in violation of the Appointment’s Clause of the U.S. Constitution, and implemented a “fix” going forward by removing Title 5 protections to PTAB APJs. In a split decision, the Federal Circuit denied rehearing *en banc*.

The PTAB Committee’s activities continue to ensure that the intellectual property community actively debates important issues affecting PTAB practice, and that the intellectual property community’s voice is heard by the USPTO in their deliberations on PTAB-related issues. The PTAB Committee will continue its commitment to represent the Association’s interests at the PTAB in the year to come.

Co-Chairs. Charles R. Macedo and Kenneth R. Adamo
PTAB Committee

Trade Secrets Committee

A. 2019-2020 Updates

- i. **Monthly Meetings.** We conduct monthly meetings. Committee member Jessica Sblendorio of Haug Partners continues to provide the Committee with an update on the latest developments regarding the Defend Trade Secrets Act and trade secrets law generally.

ii. Guest Speakers on Trade Secrets

a. Steve Kayman, partner at Proskauer Rose LLP and is a professor at Brooklyn Law School, spoke for approximately 45 minutes on the topic of: **Available Resources for Recovering Your Client's Misappropriated Trade Secrets**. He discussed the various options available to corporate clients to effectuate such recovery – law enforcement, courts (civil action, criminal action), etc. He also touched on the roles of outside and inside counsel in this regard.

b. Yunchuan (“Y.C.”) Zhou, a partner at the Saelink law firm in Beijing, China, will be speaking at the May 2020 Committee Meeting for about 30 minutes on: **the implications of the terms of the recent U.S./China trade deal as those terms relate to IP issues and specifically trade secrets**. Y.C. was an IP judge in China for 14 years and has been in private practice since then. <https://www.saelinklaw.com/en/saelink-team-en.php?id=yczhou>

iii. Trade Secret Podcast.

The Trade Secrets Committee submitted five podcast segments on the topics of trade secrets, in which an in-house lawyer, former prosecutor and outside counsel weighed on practical topics.

Episodes (30-40 minutes each):

Podcast Topic	Interviewee
Best practices for identifying and protecting a global company's trade secrets	Mark Schildkraut, BD, Associate General Counsel-IP Worldwide Cybersecurity Counsel Law Group
Suspicious that your trade secret may have been stolen? How to Conduct an Internal Investigation	David Almelling, O'Melveny & Myers, Partner

How to recover exfiltrated information	Brian Levine, Ernest & Young, Managing Director, Transactions Cyber Group
U.S. District Court trends after 4 Years of the Defend Trade Secrets Act (DTSA)	David Almelling, O'Melveny & Myers, Partner
Trial Strategies – What plaintiffs and defendants need to think about before, during and after trial	Tony Sammi, Skadden, Partner

- iv. Cross-Committee Support.** The Trade Secrets Committee has invited the Cybersecurity Committee members to attend the meetings in which we have guest speakers.

Trademark Law & Practice Committee

The Trademark Law & Practice Committee (“Committee”) had 24 active members this year. The Committee corresponded extensively, conducted multiple meetings, contributed to NYIPLA publications, amicus briefs and legislative activities, and organized several CLE events.

In July 2019, the Committee organized and conducted its annual Half-Day program entitled “Hot Topics in Trademark Law.” The keynote speaker was Lesley Fair, Senior Attorney with the Federal Trade Commission’s Bureau of Consumer Protection, who addressed critical legal and practical issues concerning advertising claims. The program also featured Honorable Mark A. Thurmon, the Deputy Chief Administrative Trademark Judge for the Trademark Trial and Appeal Board, who provided a comprehensive overview and update concerning the Trademark Trial and Appeal Board, as well as several expert panels and lecturers on topics including trademarks in bankruptcy proceedings, the new Canadian trademark statute, and ethics issues pertaining to intellectual property practice.

From October 2019 through March 2020, members of the Committee, on the NYIPLA’s behalf, actively participated in U.S. Congressional activities relating to potential new trademark legislation intended to deal with false claims of use within trademark applications and registrations, as well as related aspects of trademark enforcement. The Committee’s participation included attending two discussion roundtables held at the House of Representatives in Washington, related reporting to the NYIPLA Board, and the preparation of written comments which the NYIPLA submitted to Congress in connection with this proposed legislation. These activities have led to the introduction of a bill, entitled the *Trademark Modernization Act of 2020*, which has now been introduced on a bicameral and bipartisan basis.

The Committee, together with the Copyright Law & Practice Committee, held an after-work networking and social event on January 29, 2020 at Pennsylvania 6.

Members of the Committee participated in the preparation of an amicus brief submitted by NYIPLA in February 2020 in the SCOTUS case of *Iancu v. Booking.com B.V.*, which deals with issues of genericness of claimed trademarks and the use of consumer survey evidence in such cases.

On March 2, 2020, at the offices of Pryor Cashman LLP, the Committee conducted its annual CLE presentation entitled “Trademark Update: A Discussion with a USPTO Policy Maker and a TTAB Decision Maker,” presented by Kathleen Cooney-Porter, Mary Beth Myles and Dyan Finguerra-DuCharme.

The Committee is presently planning its 2020 Half-Day “Hot Topics in Intellectual Property Law” CLE program. Due to the COVID-19 pandemic, the NYIPLA has decided not to conduct this program as a single live program in July, as in other years. Instead, this program will be conducted as a series of individual webinars. The lead-off, “keynote” webinar of this series will be John Welch and Ted Davis presenting a summary of their popular annual survey of noteworthy trademark decisions on July 23, 2020. The additional presenters and topics for the subsequent webinar presentations are in the planning stages.

Finally, throughout the year, members of the Committee prepared summaries of interesting and noteworthy decisions from the TTAB for inclusion in each edition of *The Report*.

US BAR-EPO Council

The 35th Annual Meeting of the US Bar-EPO Liaison Council was held in Washington, DC on September 24, 2019 and was attended by representatives of US bar associations and IP organizations, and a former Council chair who remains professionally active. Laura Brutman and Tom Spath participated on behalf of the NYIPLA.

The meeting opened with a presentation by EPO President, Antonio Campinos, who was in his second year in office, and gave a second presentation later in the day to outline the EPO's strategic plan through 2023; he also attended a private luncheon at the Washington Marriott hosted by the U.S. Bar delegation. The EPO was represented by four other top-level officials who provided the customary overview and made presentations in nine selected aspects of Office operations during the course of the day. (An index and copies of the presentations provided by the EPO are available at the Association website.)

During his opening remarks, President Campinos noted that he had completed personal meetings with over 1,000 EPO staff members since taking office and that the results of a staff satisfaction survey were "not thrilling", but did provide "good engagement" by the staff.

Item of Interest to US Practitioners

President Campinos reported on a meeting with a group of German patent attorneys from several prominent local patent firms that had written an open letter critical of the EPO's "speedy" examination goal as adversely affecting the quality of searches and examination, and limiting the number of office actions before a Summons to Oral Proceedings is issued.

He pointed out that 60% of applicants avoid Oral Proceedings and secure claims. Examiners are apparently being encouraged to consider amended claims and contact applicants' representatives promptly following submission of the Main and any Auxiliary claims in order to reach agreement and have the Summons withdrawn.

As to similar complaints from the examiners, President Campinos stated: "Examiners will learn to run faster". These responses imply that President Campinos is determined to meet the goals of the EPO for a reduction in the time from filing to issue of the Initial Search Report, and in reducing the overall pendency time to grant, or other final disposition.

Examination: Staffing, Goals and Achievements

It was reported that the EPO presently includes a staff of 4,500 scientists and engineers, and maintains the largest patent and prior art library in the world. An incoming application file is reviewed for referral to the right examination "team" and examiner. Artificial intelligence (AI) technology is being used to identify the most appropriate division and examiner. Patentability decisions are made by at least two and sometimes three examiners in a division.

The EPO's current goals are as follows:

1. ISR and WO in 6 months: actual 4.5 months;
2. Final decision in 15 months: actual 22.4 months; and
3. Opposition decision in 15 months: actual 19.6 months for non-complex oppositions involving only one opposer.

Quality review of prosecution histories for procedure and formalities and the quality of the search will be increased from about 750 to 1,500 annually.

Developments

The EPO has continued its efforts to improve productivity, even in the face of an almost 4% increase in filings over the prior year. There was an increase of more than 10% in granted patents, with a total of over 120,000 projected for 2019.

Extension states were increased by 2 with the addition of Bosnia-Hertzogovina and Montenegro; Cambodia, Moldova, Morocco and Tunisia have entered as validation states and discussions with OAPI regarding validation are on-going.

The translation activity continues to increase with 28,000 requests per day having been reported.

PCT Practice Via the EPO

It had been announced in a previous year's meeting that there would be no inflation-based annual fee adjustment for the years 2018-2020, and there was no mention at this year's Council meeting of a fee increase in the future. (In the meantime, a modest fee increase of about 4% effective 1 APR 2020 has taken effect.

The EPO produces more International Search Reports (ISR) than any other PCT ISA, and 96% of the ISRs were issued in time to be included in the A1 publication. The EPO commenced the program for the early start of Chapter II examination on July 1, 2019.

A pilot has been initiated for IP5 offices with a combined examination report to be produced for up to 100 applications from each of the IPS offices. The recent IP5 Collaborative search and examination pilot program was only briefly discussed since the initial application quota had been met prior to the closing date in September 2018; participation will reopen in July 2019 for English-language applications. As indicated by the title of the pilot program, the draft ISR and WO for each application will be shared at an early stage among examiners in the IP5 offices. A favorable combined report will be a significant benefit to the applicant and could lead to much earlier issuance of the national/regional patents that could otherwise be expected.

PCT Direct

PCT Direct has been fully operational since last year and is available for use at all Receiving Offices; credit card payments can be made via the On-line Payment Portal. The EPO recommends that Applicants wishing to participate in PCT Direct should do so via a PCT or EPO first filing. Applicants submit the PCT Direct Letter with a track-changes copy of the application as amended based on the ISR issued by the FFO. One financial issue is that the local national office must subsidize the EPO's processing.

Computer Implemented Inventions

The EPO's activities in the field of software patenting, or computer implemented inventions (CII) have been reaffirmed with annual updates and improvements to the CII content in the official Guidelines of Examination. After the claims of a new application have been preliminarily identified as being directed to CII, the application is assigned to an intradisciplinary technical

division and three examiners are designated to review the case both initially and during prosecution. Additional CII training has been put in place throughout the entire EPO operational realm, and continuing enhancement of the CII internal practice and the Guidelines is being implemented.

Artificial Intelligence (AI) and Inventorship

The EPO accepts in principle that inventions in the field of AI are patentable and subject to the same standards for determining novelty and inventive step as other established technical fields. Of particular importance is that AI inventions be disclosed in a manner that is sufficiently clear and complete in order to be carried out by a person skilled in the art, and the customary definitions and standards will be applied to these statutory terms. In answer to the question of "whether AI can be recognized as an inventor", the EPO has determined that the "inventor" must be a person and the one who makes a contribution to the invention's conception. A programmer or the person who trains AI will be considered as an inventor and should be identified in the Request as such.

It was also noted that based on information exchanged at a conference attended by representatives of other patent offices, it appeared that a generally consistent and uniform approach to the examination and patenting of AI has been developed.

Cooperation with Standards Development Organizations (SDOs)

In the past, the EPO's reliance on industry standards development documentation has apparently been challenged on the basis that it was not publicly available, i.e., that it was secret or confidential information among the members of the standards setting organization. The status has now been clarified by way of agreements with the SDOs. At the end of 2017, over 3 million documents from these sources were in the database and available to EPO examiners and in that year there were nearly 22,000 citations of standards documents, representing an increase of more than 12% over 2016. In one earlier analysis (2015), it was estimated that up to 12% fewer patents were issued as a result of standards documentation citations.

User-Driven Early Certainty (UDES)

The EPO's so-called "Early Certainty" Initiative is based upon the premise that expediting the examination of applications and issuing decisions in oppositions is better for both applicants by enabling timely and well-reasoned decisions and help secure investment, especially for small entities. The asserted benefits to the public are (1) providing a better overview of the state of the art to innovating competitors and (2) avoiding "blind spots" in long-pending European patent applications. (In this context, see the discussion under the EPO's consideration of the option to defer examination.)

The three principal goals which the EPO has set for itself are reporting the search within six months, completing examination (on average) within 12 months and in concluding oppositions in non-complex cases within 15 months.

The backlog of examination requests for 2018 was estimated at approximately 160,000, with a projected issuance of 210,000 examination reports, achieving a net decrease in the backlog of 50,000 applications. Productivity increases are apparently being achieved by providing incentives to examiners to move new cases along, in some instances by issuing a summons to oral

proceeding at a relatively early stage. As mentioned at the beginning of this report, a group of European patent attorneys from several well-known German law firms signed an "open letter" expressing concern that the examiner incentive program had a potentially deleterious effect on the quality of both the search and the examination, and could result in a less than thorough assessment of cases by the Office.

In any event, the applicant who wishes to advance the processing of the case to the maximum extent will be able to complete its own analysis and respond promptly rather than taking advantage of the 4 to 6 months term allotted, or the even further delay accorded by the relatively inexpensive "further processing" procedure.

The Possibility of Deferred Examination

As reported in prior years, the EPO has been considering a program to offer applicants a "no-fee option" of postponing examination for up to three years, but with the proviso that examination would be initiated upon the request of a third-party when supported by substantiated reasons. We were advised that discussions with stake holders have continued, but that the proposal is seen as controversial. One significant issue is safeguarding the principle of "legal certainty" as discussed above which is premised on the right of competitors and other interested members of the public to know the outcome of the EPO's examination in order to dispel any implication that putative rights in a long-pending application might come into existence in order to inhibit advances by others in the marketplace. Apparently, deliberations will continue.

Cooperation Among the IP-5 Countries

Representatives from the patent offices of the IP-5 countries (US, EPO, Japan, China, and Korea) continue to meet regularly. Topics under discussion include further patent harmonization including artificial intelligence, defining subject matter eligibility and inventorship issues.

A major achievement of the IP5 is the Global Dossier that provides a user friendly interface for ease of use by examiners, and by other interested parties. The Patent Prosecution Highway (PPH) has been expanded by the EPO to countries in addition to those of the IP5.

Procedural Patent Harmonization efforts have been concluded on the topics of unity of invention, citation of prior art, the written description requirements, and sufficiency of the disclosure. Users have requested that the EPO explore electronic implementation so that citation in one office will suffice for all offices. This will require a focus on IT requirements for implementation.

Further efforts are being undertaken in the area of unity of invention which will apparently be limited to PCT practice, rather than in all national offices. Presentations and discussions proceeded on the harmonization topics of unity of invention and grace periods, which are the subject of future IP5 meetings.

Plant Patents in the EPO

Plant inventions are limited to "technical breeding processes/methods, and their products, and to genetic modification (GM) processes and their products". Plant varieties cannot be patented. There has been cooperation with the Community Plant Variety Office ("CPVO"), to include developing a more extensive data base in order to improve the quality of search, with one goal to be avoiding the grant of patents on plant varieties. The filings in the plant category are about 200 a year, and only about 50 transgenic applications survive the eligibility test. It was estimated that less than 100 patents have been granted since 1995. As a result of apparently inconsistent prior decisions by the Boards of Appeal, clarification by the Boards of Appeal has been solicited by the EPO, and about 250 applications and 6 oppositions have been stayed.

Next Council Meeting

Plans are underway for the 36th Annual Meeting of the Council in National Harbor, MD, across the Potomac River from Washington, DC. and will likely be held on October 21st or 22nd. The Council meeting will be coordinated with the 2020 annual meeting of the AIPLA at that venue . It is anticipated that President Campinos and a cadre of high level administrators will again attend and participate on behalf of the EPO.

Members of the NYIPLA wishing to propose questions or present issues for discussion relating to EPO practice should forward them by e-mail to both Laura Brutman (lbrutman@schiffhardin.com) and Tom Spath (tespath@lawabel.com) to be considered for inclusion on the agenda for this year's Council meeting.

US Bar-JPO Committee

The following is the report to the Board of the NYIPLA US Bar—JPO Liaison Council delegates, John Pegram and Raymond Farrell:

The biennial delegation trip of the US Bar—Japan Patent Office Liaison Council to Tokyo for meetings with the Japan Patent Office and the Intellectual Property High Court was held on October 17-18, 2019. At the Japan Patent Office (JPO), the US Bar delegates were updated with presentations by the JPO on recent JPO statistics and initiatives; the Hantei (advisory opinion) system for Standards Essential Patents (SEPs); the newly refreshed J-PlatPat patent database; Recent Revision of the IP Act in Japan; and JPO Examination Case Examples of AI-related Inventions. US Bar delegates presented on recent developments of the USPTO and US Congress; PTAB Updates; and Patent Eligibility in the US. The meeting with the JPO concluded with a free discussion of US Bar experiences practicing before the JPO and JPO tips and observations for US applicants. The US Bar/JPO Liaison Council hosted a reception for JPO meeting participants and Judges of the IPHC at the Tokai University Club.

As with prior delegation trips, the US Bar Liaison Council also conducted a second day of meetings at the Intellectual Property High Court (IPHC) with IPHC judges. Following opening remarks by the Chair of the Council and Judge Yoshiyuki Mori of the IPHC, the IPHC gave presentations on a Recent Grand Panel Judgment on Damages Calculation, Case No. 2018 (Ne) 10063, decided June 7, 2019; and Establishment of the Inspection System and IP Mediation in Japan. The US Bar delegates presented on Patent Infringement Damages Calculations in the US.; and an Update on Patent Eligibility in the US.

The next meeting with the JPO in the US has not been scheduled yet due to the COVID-19 circumstances. If there are any patent prosecution or enforcement issues that NYIPLA members would like to raise to the JPO, please contact either John Pegram or Ray Farrell for consideration and conveyance to the JPO during our next meeting with them.

John Pegram and Ray Farrell, NYIPLA Delegates to the Council.



Women in IP Law Committee

The Women in IP Law Committee had a successful year in 2019-2020, hosting CLE and networking events, in addition to committee meetings.

On November 13, 2019, during the One-Day Patent CLE Seminar, the Committee coordinated a panel on “IP Transaction Panel: Patent and Non-Traditional IP Diligence in Technology Transaction.” The program was moderated by Jeanne Curtis, Director of CDF Consulting and the panel included Nora Garrote, Partner at Venable, Khue Hoang, Partner at Reichmann Jorgensen, Chloe Steadman, VP and Underwriter at Euclid Transactional and Dorothy von Hollen, VP and Corporate Counsel at Prudential Financial.

On December 3, 2019, the Committee co-hosted a “Negotiation Skills” panel with the Young Lawyers Committee at Willkie Farr & Gallagher’s New York office. This program focused on overcoming stereotypes and implicit bias during negotiations, and the panelists actively engaged with the attendees, including many women and diverse attorneys. These panelists included Kathy Holub, a lawyer and consultant who teaches negotiation at Columbia and Harvard, Christina Licursi from Wolf Greenfield, Rebecca Waldman from Dechert, and Eugene Chang from Willkie. The panel was moderated by Maegan Fuller from Cadwalader.

On February 11, 2020, the Women in IP Law and Patent Litigation Committees co-hosted a panel discussion entitled, “BPCIA Litigation-Lessons from the Trenches,” at Dechert’s New York office. This program included a lively panel discussion about recent experience with biosimilar litigation, from the perspective of in-house and outside counsel involved. Panelists included Karen Shen from Pfizer, Heather Schneider from Willkie Farr, Irena Royzman from Kramer Levin. Katherine Helm from Dechert moderated the discussion.

Throughout the year, the Committee also held telephonic and in-person committee meetings at which members actively and generously contributed to planning and executing this year’s events. The Committee thanks all NYIPLA members who contributed to and participated in this successful year.

Young Lawyers Committee

Despite the shortened year, the Young Lawyers Committee hosted multiple innovative programs and welcomed new members. YLC kicked off the 2019-2020 year with a festive mid-summer happy hour that had over 40 attendees. In October, YLC partnered with St. John's University School of Law to sponsor a career-focused panel at the law school, entitled "Diverse Careers In Intellectual Property Law & Strategies For Achieving Success." Then, in a first-of-its-kind program, YLC joined forces with the Women in IP Committee to host an interactive negotiation skills panel that attracted in excess of 30 attendees. The panel featured a Columbia University professor and partners from Dechert, Wolf Greenfield and Willkie Farr, for whom this program was their first with NYIPLA. And in February, the Committee added another skills-based program to the calendar—"Deposition Skills: Video Stop." This program featured a panel of experienced practitioners playing, pausing and analyzing video clips from famous depositions to discuss emulable styles and techniques of taking and defending attorneys.

The YLC continued its tradition of networking over happy hours with a mixer with the Corporate Committee in September.

The Committee brought in close to a dozen new members in the 2019-2020 year, including first-year associates and students from New York City law schools.

when Congress has statutorily created the right for dissatisfied parties to appeal to the Federal Circuit).

The Federal Circuit ruled on and adopted, in part, the position advocated by the Association in *Syngenta Crop Protection, LLC v. Willowood, LLC* (regarding whether the Copyright Act conflicts with the Federal Insecticide, Fungicide, and Rodenticide Act, and how to interpret Section 271(g) governing imported products). Finally, the Court of Appeals for the Fourth Circuit adopted, in part, the position advocated by the Association in and *Brammer v. Violent Hues Productions, LLC* (regarding copyright fair use determination).

The Association's participation in these cases ensured that the intellectual property community's voice was heard by the courts in their deliberations on these important issues. The Amicus Brief Committee will continue its commitment to represent the Association's interests in all areas of intellectual property law in the courts in the year to come.