

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

# 2017-2018 GREEN BOOKLET

ASSOCIATION ANNUAL REVIEW

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**ANNEMARIE HASSETT**  
**NYIPLA PRESIDENT**  
**2017-2018**



**Standing:** Mark H. Bloomberg, Marian Underweiser, Robert M. Isackson, Douglas R. Nemec, Irena Royzman, Walter E. Hanley Jr., William J. McCabe

**Sitting:** Kathleen E. McCarthy, Robert J. Rando, Annemarie Hassett, Peter G. Thurlow, Heather M. Schneider

# 2017-2018 BOARD OF DIRECTORS

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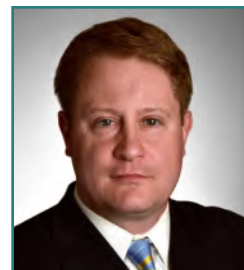
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# 2017-2018 YEAR IN REVIEW

BY: ANNEMARIE HASSETT, NYIPLA PRESIDENT

I am grateful for the honor and pleasure to have served as NYIPLA President from May 2017 to May 2018. During that year, the Association further advanced its stellar reputation as a thoughtful and reasonable national voice on the intellectual property questions of the day. Through its programs, amicus briefs, and articles, NYIPLA helps both its members and the judiciary navigate the rough waters of the contentious questions of law and policy that we face today.

A key factor in the Association's successes of the past year is the commitment of its engaged members, committees, directors, and officers. These volunteers sustain a community of people who think and care deeply about how our intellectual property system can best nurture innovation, creativity, and product identification in the marketplace. Below I review some highlights of the many excellent events that, thanks to our committed membership, NYIPLA hosted during my term as President. The success of each of these events was enhanced by the able skills of the Association's executive administrator, Feikje van Rein and her team at RRR Associations.

In May 2017, NYIPLA bestowed its **2017 Inventor of the Year Award** to **Dr. Adrian Krainer**, a named inventor on numerous patents and patent applications. The Association honored Dr. Krainer for his research that led to discovery of the first FDA-approved drug for treating spinal muscular atrophy (SMA), which is a leading genetic cause of infant mortality. The FDA approved that drug, nusinersen, for use in the United States in December 2016, and not long after it was approved for marketing in Europe. Dr. Krainer conducted the research that led to nusinersen at Cold Spring Harbor Laboratory. Thanks to the Inventor of the Year Committee for its work in soliciting and assessing high-quality applications for the 2017 award.

Following the introduction of NYIPLA's **Mentoring Program** under my predecessor as President, Walter Hanley, the Association hosted a social gathering on July 11, 2017 at Latitude Bar & Lounge to inaugurate this new program. This well-attended and enjoyable event was open to all mentors, mentees, and NYIPLA members. I encourage all NYIPLA members to consider becoming involved in the Mentoring Program.

On July 18, 2017, the Court of Appeals for the Second Circuit once again graciously hosted NYIPLA's **Annual Second Circuit Summer Associate Moot Court Argument CLE Program**. The fourth such program in as many years, this year's hypothetical fact pattern was derived from the Supreme Court's recent opinion in *Star Athletica, LLC v. Varsity Brands, Inc.*, concerning whether a feature incorporated into the design of a useful article is eligible for copyright protection under the Copyright Act. Like its predecessors, this highly successful program featured excellent arguments presented by summer associates and penetrating commentary by the judges' panel that shed light on how lawyers at all career stages can enhance their skills at oral argument.

On September 26th, the NYIPLA **Corporate Committee** held its annual **Fall Mixer** at a bar in midtown Manhattan. This highly anticipated social event provides Corporate Committee members a welcome opportunity to reconnect. As in the recent past, the Committee invited members of NYIPLA's **Young Lawyer's Committee** to join the Fall Mixer, enhancing the opportunity for lawyers new to practice to network with and learn from in-house counsel.

Over this year, the Association continued its **outreach to law students**. On October 4<sup>th</sup>, NYIPLA



and Hofstra Law School jointly hosted a CLE program at the Maurice A. Deane School of Law at Hofstra University. The program consisted of two panels, followed by a networking reception. The first panel, “Diverse Careers in IP Law and Strategies for Achieving Success”, included in-house counsel and attorneys from law firms of various sizes. Panelists explained the types of careers available in the field of IP law and advised on how to pursue these options while in law school and after graduation. The second panel, “IP Considerations for New IP Practitioners and Non-IP Attorneys”, focused on topics such as assignment and transfer of licenses, mergers and acquisitions, bankruptcy matters, and labor and employment issues.

The **Amicus Brief Committee** (ABC) is a vibrant and important component of the NYIPLA, working with the Association’s leadership to add its voice to aid the courts in appeals that relate to intellectual property. On Tuesday, October 17, 2017, the Amicus Brief Committee presented a CLE program on the amicus brief process, graciously hosted by Foley & Lardner . The presentation focused on the amicus brief process as implemented by the NYIPLA and the ABC, including a general background on the process, conflict clearing, pro bono credit, and amicus procedures before the Federal Circuit and the U.S. Supreme Court.

Later in October the NYIPLA **Women in IP Committee** delved into IP in the fashion world with a discussion led by Fordham Law Professor Susan Scafidi and committee member Rachel Dooley on the U.S. Supreme Court's recent decision in *Star Athletica v. Varsity Brands*. Professor Scafidi is the founder and academic director of the Fashion Law Institute, the first center of its kind dedicated to the intersection of law and fashion. Ms. Dooley, an attorney at Willkie Farr & Gallagher LLP, is founder of the fashion brand GEMMA REDUX. Professor Scafidi and Ms. Dooley explained the potential impact of *Star Athletica* on protection for designers, as well as the interplay between this decision and recent efforts to extend copyright protections for certain design infringements. After the discussion, Ms. Dooley led attendees in a workshop where each participant made a one-of-a-kind necklace. Willkie Farr & Gallagher graciously provided the event space.

The **Young Lawyers Committee** explored third-party litigation financing via its January 2018 program entitled “Speaking the Language of Intellectual Property Litigation Finance: What Your Partners Don’t Know.” Hosted at Baker Botts LLP, this program highlighted litigation financing arrangements from the perspectives of key players in the industry. Katharine Polanyi (Buford Capital LLC) discussed how litigants and law firms use litigation finance. Joseph Loy (Kirkland & Ellis LLP) explained the role that litigation counsel play in facilitating third-party financing arrangements and considerations for preserving attorney work-product protecting. Michael Sander (Fastcase Analytics) discussed the use of litigation outcome metrics in pre-litigation diligence decisions. Eric Greenwald (Axinn, Veltrop & Harkrider LLP) moderated the panel.

On February 28, 2018, the **Patent Litigation Committee** kept the Association’s members current on new developments in patent litigation with a presentation entitled “Advanced Topics in PTAB Practice.” Hosted at Troutman Sanders LLP, this event focused on four topics of recent interest. Bruce Koch (AGC and Head of Litigation: Purdue Pharma LP) addressed the 11th Amendment and tribal

sovereign immunity in light of the PTAB's ruling in *Mylan v. St. Regis Mohawk Tribe*. Steve Baughman (Paul Weiss Rifkind Wharton & Garrison LLP) discussed the discretionary denial of institution of IPRs in light of the PTAB's recent ruling in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*. Brian Murphy (Haug Partners LLP) discussed motions to amend claims in IPRs in light of the Federal Circuit's en banc decision in *Aqua Products, Inc. v. Matal*. Joe Robinson (Troutman Sanders LLP) discussed the challenges of presenting to the PTAB evidence of secondary considerations of non-obviousness. Mitchell Epner (Hughes Hubbard & Reed LLP) moderated the panel.

Continuing a growing trend at NYIPLA, in March 2018 the **Patent Litigation Committee** and **Women in IP Law Committee** partnered on an update on legal and policy developments in the biosimilar drug products space, entitled "Hot Topics and Issues in the Biosimilar Space: Part Two." Hosted at Axinn, Veltrop & Harkrider LLP, this program featured Chad Landmon (Axinn, Veltrop & Harkrider LLP) discussing implications of the BPCIA patent dance for biosimilar sponsors; Brian Murphy (Haug Partners LLP) discussing the use of IPRs at the PTAB against patents in parallel BPCIA litigations; and Christine Simmon (The Biosimilars Council, Association for Accessible Medicines) discussing the challenges and opportunities for advocacy in fostering a robust U.S. biosimilar market.. Michael Johnson (Willkie Farr & Gallagher LLP) moderated the discussion.

On March 6, 2018, the **Trademark law & Practice Committee** advised the Association's membership on recent developments in trademark practice. The program, entitled "2018 Trademark Update: A Discussion with a USPTO Policy Maker and a TTAB Decision Maker," was hosted at Pryor Cashman LLP. Committee Co-Chair Dyan Finguerra-DuCharme moderated a discussion with Colleen Kearney (Attorney Advisor, Office of the Deputy Commissioner for Trademark Examination Policy, United States Patent and Trademark Office) and David Mermelstein (Administrative Trademark Judge, Trademark Trial and Appeal Board, United States Patent and Trademark Office). The panel covered a wide variety of topics including letters of protest, doctored specimens and reliance on third party evidence.

The theme of the **2018 Day of Dinner Program**, which was a prelude to the 2018 Judges Dinner on March 23, 2018, focused on "Developments in the Courts and Congress and the Implications for Patent Policy and Innovation." Held at the New York Hilton Midtown, the afternoon presentation reviewed current issues and trends in patent policy and litigation and presented views from the courts, as well as the USPTO, on directions for change. The keynote speaker, Judge Kathleen M. O'Malley of the U.S. Court of Appeals for the Federal Circuit, delivered a historical overview of the U.S. patent system from its inception to the present. Thereafter, Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, highlighted the patent system's historical significance and ways to protect American invention by ensuring a reliable and predictable patent system.

Following Director Iancu's remarks, NYIPLA Immediate Past President Walter J. Hanley moderated a panel discussion among Chief Judge Leonard P. Stark (U.S. District Court for the District of Delaware), Chief Judge Jose L. Linares (U.S. District Court for the District of New Jersey), and Joseph Matal (Former Under Secretary of Commerce for Intellectual Property and Former Director of the USPTO). The panel discussed the upswing in patent invalidity cases under Section 101, in particular the recent focus on the factual issue of what constitutes "routine and conventional" in analyzing the second step of the two-part test for determining patent-eligible subject matter. The panel then discussed venue considerations arising after the Supreme Court's *TC Heartland* decision, including the difficulties in assessing venue for Hatch-Waxman cases and cases involving multiple defendants.

That evening, the Association held its **96<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary** at the New York Hilton Midtown Hotel. President Annemarie Hassett welcomed the honored guests, members of the NYIPLA, and their guests. The Association presented its **Sixteenth Annual**



**Outstanding Public Service Award** to the **Honorable Sue L. Robinson**, District Judge for the United States District Court for the District of Delaware. Bob Woodward, award-winning journalist, best-selling author and Associate Editor of the Pulitzer Prize-Winning Washington Post, gave the keynote address.

The Association hosted its third **Annual President's Forum** on April 24, 2018 at the Thurgood Marshall Courthouse of the Southern District of New York. This invitation-only event was moderated by NYIPLA's Immediate Past President Walter E. Hanley and featured three point-counterpoint discussions relating to "Patent Venue After TC Heartland." First, Brian Ledahl (Russ August & Kabat) and Tim Wilson (SAS Institute Inc.) led a discussion on the application of Section 1400(b) to the modern digital business world. Second, Henry Haddad (Bristol-Myers Squibb Co.) and Colman Regan (Teva Pharmaceutical Industries Ltd.) led a discussion on the application of Section 1400(b) in the context of ANDA litigation under the Hatch-Waxman Act. Finally, Charles Macedo (Amster Rothstein & Ebenstein LLP) and Robert Isackson (Leason Ellis LLP) discussed whether the holding in *Brunette Machine Works, Inc. v. Kockum Industries, Inc.*, 406 U.S. 706 (1972), that, as a general rule, foreign defendants do not have venue rights applied in patent litigation, remains (or should remain) good law after *TC Heartland*. Senior Judge Loretta A. Preska (U.S. District Court for the Southern District of New York) guided spirited questioning and conversation.

# 2017 ANNUAL MEETING

On May 16, 2017, incoming Association President Annemarie Hassett welcomed members and guests at the Princeton Club of New York. Annemarie expressed her appreciation for outgoing president Walter E. Hanley Jr.

**KEYNOTE SPEAKER:** Honorable Loretta A. Preska, United States District Court, Southern District of New York









## 2017 Annual Meeting







## ANNUAL MEETING MAY 16, 2017

THE PRINCETON CLUB, 15 WEST 43RD STREET, NEW YORK

1:45 PM - 2:00 PM

### REGISTRATION AND REFRESHMENTS

2:00 PM - 3:15 PM

### CLE PROGRAM I

**MOCK ORAL ARGUMENT: RECONSIDERING DIVIDED  
INFRINGEMENT ISSUES IN VIEW OF FEDERAL CIRCUIT'S  
DECISIONS IN AKAMI V. LIMELIGHT AND CENTILLION  
DATA SYSTEM V. QUEST**

**Ken Adamo**, *Partner*, Kirkland & Ellis LLP

**Michael Kahn**, *Partner*, Akin Gump Strauss  
Hauer & Feld LLP

**David Leichtman**, *Partner*, Leichtman Law  
PLLC

**Charles Macedo**, *Partner*, Amster Rothstein &  
Ebenstien

**Ksenia Takhistova**, *Associate*, Andrews Kurth  
Kenyon LLP



2:00 PM - 3:15 PM

### CLE PROGRAM II

**THE DMCA - HOW RECENT DECISIONS HAVE  
IMPACTED THE SCOPE OF PROTECTION**

**Felicity Kohn**, *Associate*, Pryor Cashman LLP

**Ryan Fox**, *Policy & Advocacy Director*, Authors  
Guild

**Darius Gambino**, *Partner*, DLA Piper

3:30 PM - 4:15 PM

### COMMITTEE MEETINGS

4:30 PM - 5:30 PM

### ANNUAL MEETING OF MEMBERS

5:30 PM - 6:00 PM

### BOARD MEETING

5:30 PM - 8:30 PM

### COCKTAIL RECEPTION

### Awards Dinner Program

### WELCOME NYIPLA INCOMING PRESIDENT

**Annemarie Hassett**

### KEYNOTE SPEAKER

**Honorable Loretta A. Preska**

*United States District Court,  
Southern District of New York*

### 2017 INVENTOR OF THE YEAR AWARD

**Dr. Adrian Krainer**

*Inventor of U.S. Patent No. 8,980,853. Recognized for  
his research that led to the first-ever drug for the  
treatment of Spinal Muscular Atrophy (SMA) in  
children and adults*

### 2017 HON. WILLIAM C. CONNER WRITING COMPETITION AWARDS

**Mary Catherine Amerine**

&

**Hannah Pham**

### HON. GILES S. RICH DIVERSITY SCHOLARSHIP

**St. John's University**



The 2017 Annual Meeting was attended by over 100 NYIPLA Members.





# AWARD RECIPIENTS AT THE 2018 ANNUAL MEETING

## Inventor of the Year Award



### DR. MICHAEL KASS

Recognized for his contributions to the field of computer graphics.

## Hon. William C. Conner Writing Competition



### FIRST PLACE WINNER NICHOLAS MARCELLO

From St. John's University School of Law, for his paper entitled *After TC Heartland Artificial Infringement Could Create Real Problems for Hatch-Waxman Litigants*

### SECOND PLACE WINNER RYAN JIN

From New York University School of Law, for his paper entitled *Indefinitely Interdisciplinary The "Reasonable Clarity" Standard and Challenges in Patenting Interdisciplinary Inventions*



## Hon. Giles S. Rich Diversity Scholarship



### ST. JOHN'S UNIVERSITY

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 2018-2019 Hon. Giles S. Rich Diversity Scholarship to the St. John's School of Law. They will select a scholarship recipient from among their students.

# 2017 - 2018 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:** Aron Fischer and David Goldberg

**BOARD LIAISON:** Irena Royzman

**MEMBERS:** Robert Rando, Charles Macedo, Charles Miller, Richard Koehl, Thomas Bean, Giancarlo Scaccia, Michael Sebba, Andrew Cohen, Michael Kahn, Michael Keenan, John Cleary, Jeffrey Lewis, Robert Isackson, Dave Kaplan, John Stellabotte, A. Antony Pfeffer, Ksenia Takhistova, Howard Shire, and Kathleen Waybourn

The Association has continued its strong history of representing its diverse Intellectual Property constituency before the courts through its Amicus Briefs Committee, which coordinates the activities of the Association in 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 16, 2017, about a quarter of the Committee's members participated in the filing of four amicus briefs, one in the Supreme Court and three in the Court of Appeals for the Federal Circuit. Three of these cases regarded patent issues and one regarded patent and copyright issues.

In particular, in *Regeneron Pharmaceuticals, Inc. v. Merus N.V.*, No. 16-1346, the Association filed a brief amicus curiae with the Federal Circuit in support of Regeneron Pharmaceuticals' Petition for Rehearing en banc, arguing that the court should grant rehearing to clarify when patent litigation misconduct can support an adverse inference of patent prosecution misconduct. Although the Petition was denied, the Supreme Court recently extended time until May 25, 2018 the deadline to file a Petition for Certiorari.

In the patent case *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, No. 15-2082, the Association filed a brief amicus curiae with the Federal Circuit in support of Intercontinental Great Brands' Petition for Rehearing en banc, arguing that the court should grant rehearing to clarify when objective indicia of nonobviousness should be considered in an obviousness analysis. The Association advocated the approach proposed by Judge Reyna, where no determination of obviousness is made until all of the factual evidence is considered. The Petition was denied.

In *WesternGeco LLC v. ION Geophysical Corp.*, No. 16-1011, the Association filed with the Supreme Court a brief amicus curiae in support of neither party arguing that a prevailing patentee should be able to recover foreign damages proximately caused by domestic patent infringement and that the presumption against extraterritoriality should not bar such damages. The Court has not yet issued a decision in the case.

And in *Syngenta Crop Protection, LLC v. Willowood, LLC*, No. 18-1614, the Association filed with the Federal Circuit a brief amicus curiae in support of neither party. With respect to the patent issues raised, the brief argued that the "single entity rule" should not apply to 35 U.S.C. §271(g). With respect to the cases' copyright issues, the NYIPLA argued that the Federal Insecticide, Fungicide and Rodenticide Act should not necessarily preclude copyright protection for the required elements of pesticide labels against so-called "me too" applicants. The Federal Circuit has not yet issued a ruling on the Petition.

During the past year, the Supreme Court issued opinions in two cases and the Federal Circuit issued a decision in one case where the Association filed briefs on the merits. Specifically, in the patent case *Impression Products, Inc. v. Lexmark Int'l, Inc.*, against the Association's arguments, the Court held that after the sale of a patented item, the patent holder cannot sue for patent infringement relating to further use of that item, even when in violation of a contract with a customer or imported from outside the United States. In the trademark case *Matal v. Tam*, where the Association filed a brief amicus curiae in support of neither party, the Court found the Lanham Act's ban on the registration of marks that may disparage to be unconstitutional. Most recently, the



Federal Circuit in the copyright case *Oracle America, Inc. v. Google Inc.* issued a decision that did not just adopt the NYIPLA's argument, but also cited the Association's brief in the course of overturning a district court decision that Google's unauthorized use of Oracle's Java computer source code in the Android mobile operating system did not constitute copyright infringement because it was constituted fair use. The Federal Circuit endorsed NYIPLA's argument, holding that moving copyrighted material to a new context without altering its expression, meaning, or message, or using it for a different purpose, was not transformative and did not militate in favor of a finding of fair use.

Finally, the Committee in October 2017 presented an in-person CLE geared to understanding the amicus brief process and the ethical issues associated with it. As is our practice, the ABC also published in the Association's publication *The Report* an analysis of important Supreme and Appeals Court IP decisions over the past year. Most importantly, the Amicus Briefs Committee shall continue to represent the Association's interest in all areas of Intellectual Property Law in the courts in the year to come.

## 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:** Tatsuya Adachi and Lauren Emerson

**BOARD LIAISON:** Kathleen McCarthy

**MEMBERS:** Julie Albert, Nicholas Bartelt, Jeremy Boczko, Daniel Brooks, Wayne Cox, Dickerson Downing, Rocio Espada-Brignoni, Timothy Heaton, Laura Irazoque, Peter Menchini, Robert Raskopf, Mariella Reyzis, Joel Schmidt, and Mitchell Stein

The 2017-2018 NYIPLA Copyright Law & Practice Committee comprises 16 attorneys and law students sharing the common goals of advancing dialogue on emerging issues in copyright law, supporting the various initiatives of the NYIPLA and its other committees relating to copyright law, and building a community of copyright attorneys through in-person events and regularly scheduled meetings. The Committee held a kick-off happy hour at the beginning of the year, and has since convened for monthly teleconferences focusing on notable copyright decisions, including *Goldman v. Breitbart News, LLC*, *Fox News Network, LLC v. TVEyes, Inc.*, and *Oracle America, Inc. v. Google, Inc.*, as well as pending copyright legislation, including the CASE Act of 2017 and various music reform bills. In March, the Committee hosted its second in-person meeting featuring guest speaker Nicholas M. O'Donnell, author of *A Tragic Fate: Law and Ethics in the Battle over Nazi-Looted Art*.

Over the past year, the Committee has collaborated with other NYIPLA Committees. In particular, the Copyright Committee worked with the Legislative Action Committee to contribute to discussions on pending music reform legislation. The Copyright Committee authored a working draft of a White Paper in February of this year, providing analysis and proposed recommendations. One of the Committee's members is presently drafting a summary of the current bill for The Report. Recently, the Committee provided feedback on a proposal for an amicus brief in *Syngenta Crop Protection, LLC v. Willowood, LLC*. We will also have a Committee-member speaker at the CLE program at the NYIPLA Annual Meeting on May 15 entitled *Predictability & the Standard of Review in IP Cases*.

# 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 Laura Sheridan

**BOARD LIAISON:** Marian Underweiser

**MEMBERS:** Michele Antis, Jeffrey Butler, Paul Diamond, Kevin Ecker, Joy Goudie, Joshua Harris, David Kaplan, George Macdonald, Brian McCloskey, Gerard McGowan Jr, Steven Purdy, Hannah Samendinger, Louis Sorell, and James Sterner

The Corporate Committee enjoyed a productive year, with monthly meetings designed to provide its members with meaningful and relevant content. For some of its meetings, the Committee had moderated discussions of committee members from diverse industries to share best practices and insights on key issues, such as “what keeps you up at night” as corporate counsel, and how best to engage with international outside counsel. Other meetings included outside experts speaking on a variety of topics. Chris Israel of American Continental Group shared an update on activity in DC, and outside counsel from China gave an update on the Chinese patent landscape tailored to corporate counsel. The Committee also heard from USPTO personnel on examiner and stakeholder training initiatives.

The Committee also held its annual in-person mixer in September, inviting Young Lawyers Committee members to join the event. The mixer gave Committee members a welcome chance to re-connect. For 2018, the Committee will continue to deliver its members content that is useful to their practices, with plans to further engage with the USPTO on topics of interest.

## 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:** Walter Hanley Jr.

**MEMBERS:** Matthew Abbot, Steven Ankrom, David Bomzer, Timothy Caine, Steve Fairchild, Michael Kraich, Sarah Langsted, William Valet, and Vadim Vapnyar

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 November. In December and January, notice was sent to professors at a number of law schools to ask that the writing competition announcement be posted on the NYIPLA website in November. In December and January, 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 34 submissions in 2018. It initially divided the submissions into two groups, which 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:

Nicholas Marcello, [After TC Heartland Artificial Infringement Could Create Real Problems for Hatch-Waxman Litigants.](#)

Hyunjong Ryan Jin, [Indefinitely Interdisciplinary: The “Reasonable Certainty” Standard and Challenges in Patenting Interdisciplinary Inventions.](#)

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



# INVENTOR OF THE YEAR (IOTY) AWARD

**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:** Jonathan Auerbach and Brian Prew

**BOARD LIAISON:** Frank DeLucia Jr.

**MEMBERS:** Catharina Chin Eng, Justine Gozzi, Mitchell Hadley, David Leichtman, Lorraine Morrison, Alessandro Peschechera, Robert Roby, and Eric Yecies

The 2018 Inventor of the Year Award Committee received a number of quality submissions for consideration. It presented its top two (2) choices to the Board for discussion and approval. The Board agreed with the Committee's recommendation. At the NYIPLA Annual Meeting on May 15, 2018, the Association honored the 2018 Inventor of the Year Award Winner Michael Kass, Ph.D.

Dr. Kass was recognized for his work at Pixar, where he developed technology for simulating clothing, posing models, simulating depth of field, creating realistic faces, making painterly animation and building a compelling physical robot for the animated film Wall-E. Dr. Kass has made innovative contributions to image processing, animation, and modeling through physical simulation and optimization. His achievements enabled Pixar to animate stories featuring humans with a degree of realism of motion that would not have been possible with traditional methods.

For example, Dr. Kass's technical breakthroughs made it possible for animations to have clothing that moved dynamically with the character, as opposed to looking painted on or like rubber. Additionally, he and his team introduced technology that allows an increase in the temporal coherence of movement for animated characters, while still allowing human animators to paint specific frames of an animation (see <https://vimeo.com/64407522>). Dr. Kass's work is embodied in a number of U.S. patents, including U.S. Patent Nos. 6,300,960, 7,787,688, 8,244,029, and 8,704,828.

The Committee also published an interview with last year's Award recipient—Dr. Adrian Krainer—in the fall issue of the Report.

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, Frank DeLucia, for his help navigating the process for the 2018 Award.

# 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:** Robert Isackson

**MEMBERS:** Louis Sorell, Catharina Chin Eng, Brian Doyle, Steven Fairchild, Terri Gillis, Anthony Lo Cicero, Charles Macedo, Daniel McGlynn, Jonathan Moskin, Victor Siber, Robert Rando, Irena Royzman, Drew Schulte, and Marian Underweiser

In 2014, the Association launched a new committee, the Legislative Action Committee (LAC). The LAC's mission is to provide the Association with a voice on important issues and challenges facing intellectual property practitioners and stakeholders, by communicating to the Congress and federal agencies the Association's views, by interacting with the Congress and various Executive agencies on IP-related laws, rules and regulations, and by providing analysis and guidance on proposed legislation and regulations of interest to Association members. In order to accomplish this goal, NYIPLA retained American Continental Group (ACG), a public policy advocacy group. The LAC continues to work closely with ACG on numerous projects.

Members of Congress grappling with complex IP concepts need effective, reliable and neutral resources to which they can turn. The LAC proudly serves as such a resource, helping members of Congress and their staffers to understand the IP issues, and put them in appropriate perspective, and better understand 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, so that the Congress can, through appropriate legislation, help the IP system foster innovation as best it can. This need complements the diversity of the Association, whose members serve, among other things, as outside and in-house counsel, representing a broad spectrum of interests, and having nationwide and global practices. The Association's diverse membership gives us a unique opportunity to assess proposed legislation with the advantage of being able to see all sides of an issue and without bias in favor of any particular industry. NYIPLA's expertise and diversity enable it to thoroughly analyze and develop proposed solutions aimed at fairness to stakeholders overall. The LAC was created as a vehicle to accomplish these goals.

Highlights of the LAC's work thus far for the 2017 – 2018 year include the following:

The LAC continues to monitor IP developments and potential IP legislative initiatives of the Congress and of the Trump Administration. While both branches for the most part seem to be focused on issues and matters unrelated to IP, the LAC nonetheless remains engaged in outreach to Congress and especially IP-interested Congressional staffers and others in the District of Columbia (primarily through our relationship with ACG). As a result of recurrent review of IP-related bills, we remain poised to offer guidance to Members of Congress as needed to. To illustrate this aspect of the LAC's mission: In past years, the LAC provided detailed analysis of various patent reform bills (including several that were introduced in the previous Congress, such as the PATENT Act (S. 1137); the Innovation Act (H.R. 9)), as well as potential legislation around venue in patent cases, and litigation reform.

The LAC (in conjunction with the Copyright Committee) has provided input to the Association on proposed copyright office reform, and we currently (early 2018) are working with that other committee to be in a position to propose a White Paper on various pending copyright-related bills. The LAC also continues to monitor developments in trademark law, so as to be in a position to assist the Association if legislative changes are in the offing, or are deemed desirable.

We have been actively discussing patent eligibility and the oft-heard concerns around Section 101. The LAC



Co-Chairpersons and various LAC members have worked closely with officers and directors of the Association to assist in a Section 101 Roundtable (ongoing, as of this writing) and (especially LAC Co-Chairperson Dorothy Auth) in a 2-part Judicial Workshop: “Applying the *Alice/Mayo* Test to Life Sciences Patents” and “Applying the *Alice/Mayo* Test to Information Technology Patents.” (15 – 16 February 2018, at the Daniel Patrick Moynihan US Courthouse). The LAC was proud to have actively participated in the preparation of last year’s Presidents’ Forum entitled “Section 101 Is Broken. Is There A Legislative Fix?”

This year, we’ve already explored issues as varied and disparate as the “twin-patent” issue (101), issues around sovereign immunity with regard to IPRs, and trade show IP issues, to name a few. We continue to monitor developments on the Hill around antitrust concerns with the Food and Drug Administration processes to approve new drugs (and continue to get periodic updates on the ‘sense of Congress’ in connection with issues such as this).

And in the coming months, we intend to continue to have subject-matter experts report in on legislative developments (or hoped-for legislative change) in connection not only with patent law, but also copyright, trademark law, trade secrets and related laws. Previously, and in conjunction with an ad-hoc Association committee, the LAC has analyzed legislation that created a federal cause of action for trade secret misappropriation (the “Defend Trade Secrets Act”), and continues to monitor that law after its enactment.

The LAC will continue to support the Association by analyzing and providing input to the Board and guidance 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 recommendations to the Board of Directors with respect to the foregoing.

**CO-CHAIRS:** Brian Doyle and Anthony Lo Cicero

**BOARD LIAISON:** Robert Rando

**MEMBERS:** Dan Fischer

Throughout the year, the Media Committee has reviewed and edited the NYIPLA Weekly Report prior to its dissemination to members, and supervised and coordinated the dissemination of alerts regarding significant court rulings. The Committee also liaised with the Inventor of the Year Committee in promoting the IOTY contest among organizations likely to have worthy candidates. The Committee also investigated 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, and suggested additional platforms for increased NYIPLA PR and heightened profile.

# PATENT LAW & PRACTICE

**SCOPE OF THE COMMITTEE:** To consider all aspects of patent laws and practice which affect the right of United States entities in technology, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Jonathan Berschadsky and Carl Wischhusen

**BOARD LIAISON:** Peter Thurlow

**MEMBERS:** John Balaes, James Barabas, Thomas Bean, Andrew Berks, Nicholas Bertram, Dennis Bissonnette, Michael Carmen, Henry Chen, Andrew Chien, Chi Eng, Dan Fischer, Steven Forte, Aswin Garimalla, Joy Goudie, Zach Hong, Michael Kahn, David Kappos, David Kaplan, Kelsie Kelly, Frtiz Klantschi, Richard Koehl, Joel Lutzker, Patrick McClay, Gene Lee, Gerard McGowan, Jason Poulos, Jeffrey Price, Manoranjan Rai, John Resek, Brian Rothery, Ryan Schneer, Laura Sheridan, Tom Tatonetti, 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, 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. We worked with the Programs Committee to conduct a panel on Section 101 at a one-day patent CLE seminar. The panel was moderated by our co-chair, Jonathan Berschadsky, and included in-house counsel from Google, American Express, and Bristol-Myers Squibb. The Committee participated in a roundtable discussion with this organization's Ad hoc Committee on Section 101 and has provided comments on legislative proposals. The Committee participated in a meeting on the USPTO Patent Quality Initiative with the Associate Commissioner of Patent Quality and the Director of Tech Center 3600. We are currently working on responding to a Federal Register notice by the USPTO requesting comments on the elimination of unnecessary regulations.



# 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 Marc Pensabene

**BOARD LIAISON:** Douglas Nemec

**MEMBERS:** Ken Adamo, Mark Baker, James Barabas, J Steven Braughman, Kenneth Canfield, Puja Dave, Leslie Demers, Ralph Dengler, Chi Eng, Eric Faragi, Mitchell Epner, Lauren Fornarotto, Daniel Goldman, Eric Greenwald, Jacqueline Hatherill, Katherine Harihar, Timothy Heaton, Deepti Jain, Michael Kahn, Jeffrey Lewis, Robert Maier, Richard Mandaro, Patricia Martone, Whitney Meier, Jerry Padian, A. Antony Pfeffer, Gerald Porter, Jonathan Roch, Rousseau, Giancarlo Scaccia, Victor Siber, John Stellabotte, Tom Tatonetti, Thomas Vetter, and Ron Vogel

The Patent Litigation Committee enjoyed an active and successful the 2017-18 committee season. Following Douglas Nemec's elevation to the Board, Marc Pensabene became a new co-chair of the Committee. The Committee co-chairs are most appreciative of the contributions of the many proactive committee members. We held monthly in-person lunch meetings, which provided a regular forum for personal interaction among members and insightful discussion. Our Committee took steps to try to increase membership and participation on the part of in-house lawyers and relatively junior lawyers.

Beyond monthly meetings, sub-groups of committee members organized a number of Association-wide events, including (1) a panel discussion on biosimilars on February 1, 2018, co-sponsored with the Women in IP Law Committee, hosted by the Axinn Veltrop firm, and moderated by Michael Johnson of Willkie Farr & Gallagher, and (2) a panel discussion on advanced topics in PTAB practice on February 28, 2018, hosted by Troutman Sanders, and moderated by Mitchell Epner. Both events drew large audiences and were very successful. We plan to discuss with the Programs Committee and the Association the idea of having these two programs occur every year on a recurring basis. For later this year into the next committee season, we are planning a social event and an additional panel presentation with current judges as panelists. After an active and successful year behind us, we look forward to carrying momentum into the 2018-19 committee season.

# 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:** William McCabe

**MEMBERS:** Dan Fischer, Adele Frankel, Ophelie Garnier-Wade, Robert Maier, Kathleen McCarthy, Joshua Sibble, Marsha Sukach, Andrew Riddle, and Joshua Rittenberg

The Privacy, Big Data and Cybersecurity Committee has continued to develop initiatives focusing on issues at the intersection of privacy and intellectual property law and the cutting edge of technology. The committee conducts weekly calls to review the latest developments in these areas and discuss potential publication opportunities and other media initiatives based on these developments. One of the challenges in this area is anticipating how recently enacted and pending legislation will impact privacy and security initiatives and requirements. With the internet making every website and online service accessible from almost everywhere on the globe, the laws of one major jurisdiction can impact the operations of companies in every other territory. Against this landscape, the enactment of the General Data Protection Regulation (GDPR), which comes into effect on May 25th of this year, has created a need for companies around the world to understand and bring themselves into compliance with a privacy regime that applies to the extent those companies collect the personal information of any EU citizen. Accordingly the Committee has been planning to set up a webinar or podcast focused on providing information on the companies impacted by the GDPR, the business services and other activities falling within its scope, a broad overview of the compliance efforts that companies will be required to undertake, and the financial penalties and other potential liabilities that companies could face for noncompliance.

In a similar vein, the committee has monitored U.S. legislation attempting to bring the domestic privacy framework into closer alignment with that of the EU and other territories. This includes New York's own proposed "Right to be Forgotten" legislation, which would in some ways codify an EU court decision affirming the rights of EU citizens to have personal information removed from websites, search engines and other services that make such information available online. The proposed legislation was withdrawn in the Senate in March of this year but remains pending before the Assembly. While the Committee has not taken a position on the merits of such legislation, it has undertaken to monitor the progress of such legislation in preparation for drafting a position paper, article, or other commentary on draft legislation. The committee has also monitored the rollback in April of 2017 of FCC privacy regulations enacted the preceding October by the Obama administration, and the adjacent recent legislative efforts with respect to net neutrality, with the goal of drafting an article or webinar presentation. The committee has been conducting a federal case trend analysis in the privacy space in order to keep track of judicial determinations around Article III standing for an action. Finally, the committee has reviewed how all of these issues impact corporate transactions, in particular M&A transactions. This review includes the impact of security and data breaches on the due diligence process and provisions in agreements to address potential risks and liabilities, with an eye toward presenting a webinar summarizing these developments.



# PROGRAMS

**SCOPE OF THE COMMITTEE:** To formulate and present a series of monthly continuing legal education 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:** Jenny Lee and Michael Johnson

**BOARD LIAISON:** Colman Ragan

**MEMBERS:** Elana Araj, Andrew Berks, David Bomzer, Mark Bloomberg, Ronald Coleman, Patrice Jean, Sarah Prutzman, Robert Rando, John Resek, Diane Santos, Cindy Shu, William Thomashower, Christine Willgoos, Thomas Vetter, and Margaret Welsh

This year the Programs Committee continued its service to NYIPLA Members by providing high quality programs, informative presentations and distinguished keynote speakers. Its slate of programs includes, among others, the Full-Day Patent Program, the Day of Dinner Program, and the annual moot court program before the Second Circuit.

The Programs Committee was honored to present, in conjunction with the Second Circuit Court of Appeals, the Fourth Annual Second Circuit Moot Court Argument CLE Program. The proceedings were held at the Thurgood Marshall Courthouse and presided over by the Honorable Gabriel W. Gorenstein, United States Magistrate Judge for the Southern District of New York sitting by designation, and the Honorable Ramon E. Reyes, Jr. and the Honorable Steve I. Locke, United States Magistrate Judges for the Eastern District of New York sitting by designation. Participants from four different member firms presented oral arguments based on a hypothetical fact pattern regarding separability analysis in the context of copyright protection similar to the Supreme Court's recent *Star Athletic* decision and issues relating to personal jurisdiction. The panel of Judges conducted the proceedings and provided positive feedback the participants.

On Thursday, November 17, 2016, 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 ethics presentation. The Programs Committee was honored to have participation from the judiciary and United States Patent and Trademark Office (USPTO) at this program. The Keynote Speaker, the Honorable Stanley R. Chesler, Senior District Judge for the United States District Court for the District of New Jersey, gave an engaging speech about the awarding of fees post *Octane Fitness*. Judge Chesler shared some insight from his long career on the bench concerning what makes something an "exceptional case" in his experience. His keynote speech was both entertaining and informative and was very well received by everyone in attendance. In addition, the Programs Committee continued to work with William Covey, Deputy General Counsel of Enrollment and Discipline from the USPTO for a presentation regarding ethical obligations of practitioners before the USPTO, as well as various ethical scenarios and pitfalls to avoid in practicing before the PTO.

This program also allowed the Programs Committee to work with different substantive committees of the NYIPLA and showcase their depth of knowledge and contributions to the association. The first panel of the day, which was organized with input from the Patent Litigation Committee, addressed the impact of the Supreme Court's *TC Heartland* decision and the evolving standards for patent litigation venue. The next panel provided an in-house perspective of the impact of the constantly evolving standards for patent subject matter eligibility under Section 101 across different industries. The panel was organized in collaboration with the Patent Law and Practice Committee and presented an interview-style discussion with in-house counsel panelists across different industries. An interactive ethics presentation with the co-chairs of the Legislative Action Committee gave the program attendees an opportunity to learn more about legislative lobbying and test their knowledge about ethical obligations of being both a lawyer and a lobbyist. In the afternoon, the program included a presentation of two different viewpoints to the then-pending Supreme Court case in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC* and explored debates that developed from the Amicus Brief Committee relating to this case. The last panel of the day addressed licensing consideration in view of recent Supreme Court decisions in *Impression Products, Inc. v. Lexmark International, Inc.*, relating to patent exhaustion, and *Life*

*Technologies Corp. v. Promega Corp.*, relating to extraterritorial induced infringement. The panelists discussed how these decisions have impacted licensing strategies, and provided practical advice on factors to consider when developing licensing strategies in the wake of both cases.

The Programs Committee was also honored to have participation from Circuit and District Court Judges and members of the Executive Branch at the Day of Dinner Luncheon on March 23, 2018. The program kicked off with a keynote speech from the Honorable Kathleen M. O'Malley, Circuit Judge for the United States Court of Appeals for the Federal Circuit regarding "The Search for the Elusive Balance: What Level of Patent Protection Best Fosters Innovation?" The program then proceeded with remarks regarding the patent system and innovation from Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office. The program also featured a lively discussion with a distinguished panel including the Honorable Leonard P. Stark, Chief Judge for United States District Court for the District of Delaware, the Honorable Jose L. Linares, Chief Judge for United States District Court for the District of New Jersey, and Joseph Matal, Formerly Performed the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director, U.S. Patent and Trademark Office. The panelists discussed perspectives from the court and the USPTO regarding the *Mayo/Alice* two-part test for patent eligibility under Section 101 and the "acts of infringement and regular and established place of business" standard for venue under 28 U.S.C. § 1400(b), as well as potential for legislative reform.

The Programs Committee also assisted other NYIPLA committees in hosting, a number of CLE events. 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:** TaeRa Franklin, Elizabeth Murphy, and Jessica Sblendorio

**BOARD LIAISON:** Frank DeLucia Jr.

**MEMBERS:** Dale Carlson, Jayson Cohen, Wayne Cox, William Dippert, Robert Greenfeld, Mitchell Hadley, Keith McWha, Ben Natter, Lauren Nowierski, Margaret Welsh

The Publications Committee publishes *The Report* on a quarterly basis four times a year. *The Report* is a journal of articles of interest to the intellectual property community written by Association members and guests. Beginning in late 2017, *The Report* transitioned from a paper publication to an entirely digital publication. Each issue of *The Report* features both shorter and longer pieces on a number of key developments and issues for intellectual property law. Regular features in *The Report* include reviews of Supreme Court cases decided in last year's term and any notable cases under review or seeking review by the Supreme Court, IP Media Links, and the following features that appear in each edition of *The Report* also include the President's Corner, the Historian's Corner, Notable Trademark Decisions, reports of the Association's events and CLE presentations, and Moving Up & Moving On, which publicizes news of intellectual property practitioners' transitions and accolades.

In 2017 and 2018, *The Report* published five issues featuring a number of articles highlighting key decisions and developments for intellectual property law including the Supreme Court's decision in *TC Heartland* on venue and subsequent interpretations of that decision, the constitutionality of inter partes review in *Oil States*, the constitutionality of the disparagement and scandalous clauses of the Lanham Act, and several articles featuring winners of the William C. Conner Intellectual Property Law Writing Competition.

The Committee greatly appreciates the continuing efforts of its members in helping to publish *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 Boczeko, Pina Campagna, Laura Chubb, David Cole, Ronald Coleman, Ursula Day, Anderson Duff, David Einhorn, David Goldberg, Darienne Grey, Scott Greenberg, Jacqueline Hatherill, Suzanne Hengl, Joni-Kay Johnson, Dwight Kennedy, Michael Kraich, Nehal Madhani, Mark Matuschak, Arielle Matza, Frank Misiti, Dorna Mohaghegh, Ben Natter, Jennifer Okafor, Mariella Reyzis, Jonathan Roch, Joel Schmidt, Mitchell Stein, and William Thomashower

The Trademark Law & Practice Committee (“Committee”) had 28 active members this year. The Committee corresponded extensively, conducted multiple meetings, contributed to NYIPLA publications, and organized several CLE events.

In July 2017, the Committee organized and conducted its annual Half-Day program entitled “Hot Topics in Intellectual Property Law.” The keynote speaker was James Gatta, Chief of the Criminal Division, U.S. Attorney’s Office, Eastern District of New York. In addition to Mr. Gatta, the program also featured several industry leaders who lectured on key topics, including, augmented reality, patent insurance, constructing consumer surveys, and TTAB updates.

The Committee also held an after work networking and social event on October 26, 2017 at Pennsylvania 6.

On November 28, 2017, the Committee held an in-person meeting at the offices of King & Spalding LLP followed by a CLE presentation entitled “Free-Ride or Free Speech?,” presented by Kathleen McCarthy, Brendan O'Rourke, and Marcia Paul.

On March 6, 2018, the Committee held an in-person meeting at the offices of Pryor Cashman LLP followed by a CLE presentation entitled “2018 Trademark Update: A Discussion with a USPTO Policy Maker and a TTAB Decision Maker,” presented by Hon. David Mermelstein, Colleen Kearney, and Dyan Finguerra-DuCharme.

The Committee is presently planning its 2018 Half-Day “Hot Topics in Intellectual Property Law” CLE program, which will be held on July 17, 2018, at The Princeton Club. The Committee has confirmed several dynamic speakers for the program to discuss several topics of interest, including, ADA website compliance, blockchain technology, TTAB updates, litigation finance, copyright, and EU updates.

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*.

# TRADE SECRETS

**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:** John Moehringer and Mark Schildkraut

**BOARD LIAISON:** William McCabe

**MEMBERS:** Laura Chubb, Rachel Blitzer, Ralph Dengler, Kevin Ecker, Dwight Kennedy, Daniel McGlynn, Douglas Nemec, and Jessica Sblendorio

We 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 New Jersey Intellectual Property Law Association, we organized a CLE program entitled: “Trade Secrets/Cybersecurity: Protecting Your Corporate Client’s Information”. The speakers included:

- o David Almeling, O’Melveny & Myers LLP, Leading Counsel on Trade Secret Law
- o Ken Corsello, IBM Corporation, IP Law Counsel for IBM’s Watson Customer Engagement Business Unit
- o Meredith Dearborn, Boies Schiller & Flexner LLP, Represents Clients in High-State Commercial Disputes
- o John Moehrhinger, Cadwalader Wickersham & Taft LLP, Complex Patent Litigation and U.S. International Trade Commission
- o John Gray, Perkins Coie LLP, Focused on Trade Secret, Patent, Copyright, and Trademark Litigation
- o Brian Levine, U.S. Department of Justice, Senior Counsel with the Computer Crime and Intellectual Property Law Section (CCIPS)
- o Daniel Levy, Epstein Becker & Green, P.C., Employment Disputes and Litigation Trade Secret
- o Mark Schildkraut, BD Assistant General Counsel-IP and Worldwide Cybersecurity Counsel
- o Deirdre Wheatley-Liss, Porzio, Bromberg & Newman, PC, Counsels Business Owners on Best Practices and Corporate Governance as Related to Privilege and Cybersecurity

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 Bulletin; 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

On November 9-10, 2017 John Pegram and Ray Farrell traveled to Tokyo on behalf of the NYIPLA as part of the delegation of the US Bar—JPO Liaison Council for meetings with the IP High Court of Tokyo and the Commissioner of the Japan Patent Office. At the November 9, 2017 meeting, the Council delegation met with 18 judges of the IP High Court. The IP High Court presented on IP litigation characteristics in Japan and Japanese case law on patent exhaustion. The Council made presentations on recent case law decisions in the U.S. and the current state of the doctrine of equivalents. Following the meeting with the IP High Court, the Council's delegation hosted a reception for the IP High Court Judges and the JPO. During the reception, Mr. Kunihiro Shimano, the Deputy Commissioner of the JPO gave warm remarks welcoming the Council delegates and thanking them for the longstanding tradition of meetings to have a free exchange of ideas with the JPO. The reception provided a great informal exchange between the Council's delegates and our guests to further deepen the relationship.

On the following day, Friday, November 10, 2017, the Council went to the JPO for a full day of meetings. The meeting opened with an exchange of opening addresses by JPO Deputy Commissioner Shimano and Council Chair Raymond Farrell. The balance of the morning session was filled with presentations by the Council. The JPO delegation, in addition to the Deputy Director was comprised of members from the International Policy Division, the Examination Policy Planning Office, the Examination Standards Office, the Administrative Affairs Division, the General Coordination Division, the Legislative Affairs Office and the Trial and Appeal Policy Planning Office. The Council's next meeting with the Commissioner of the JPO will take place on Monday, October 22, 2018 in Washington, D.C.

# US BAR - EUROPEAN PATENT OFFICE LIAISON COUNCIL

**DELEGATES:** Raymond Farrell and John Pegram

The 33rd Annual Meeting of the US Bar/EPO Liaison Council was held at the European Patent Office in Munich, Germany on November 15, 2017 and was attended by representatives of thirteen US IP organizations and a former Council chair who remains professionally active. As in past years, EPO President Battistelli attended and reported along with five other top level EPO officials who also made presentations during the course of the day. (An index and copies of the presentations provided by the EPO are available at the Association website.) Tom Spath attended on behalf of the NYIPLA.

A number of new initiatives and continuing programs of interest to US applicants and practitioners were discussed. These included improvements in timeliness and quality, concerns with filing costs and increased international influence.

## EPO Operations

President Battistelli reported that EPO filings continued to rise with an annual rate of about 4%, with an increase of 9.2% in filings from the US in the first 6 months of 2017. The US continues to be the largest EPO filer at about 24%.

Extension states now include Morocco and Moldavia and discussions are being held with Tunisia. The number of countries participating in PPH programs with the EPO has been expanded to twelve.

President Battistelli pointed out that there has been no increase in fees in ten years and that even while maintaining a steady workforce of about 7000 for nine years, the EPO has increased productivity. Since 2010, 1000 examiners have been recruited with 500 new positions added by reducing support staff positions, bringing the total to 4400 examiners. Improvements in quality have been maintained by having each application examined by three people to avoid bias.



There was an increase of about 40% in the number of patents granted from the prior period.

The EPO maintains one billion search documents and has increased the Asian patent documentation available for searching to 50 million. Currently 27% of the patents cited in EPO search reports had an Asian priority, versus only 2% in 2010.

Under the Global Dossier (GD) program, data from the file histories from all IP-5 patent offices are available and is being used extensively by the EPO examiners who pulled information documents that are translated on the fly from other IP-5 offices 2.5 million times in 2016. The EPO delivered data to the other IP-5 offices 2.7 million times in 2016.

The previously established goal of issuing search reports within 6 months of the EPO filing date regardless of the route, i.e., direct or via PCT with EPO as ISR, has been exceeded and now stands at 4.9 months. The current goal is to reduce the average examination time of 22.4 months to 12 months by 2020, and to reduce the current 23.4 month opposition time to 15 months for so-called "standard" oppositions.

Under a new rule that took effect on January 1, 2016, the PACE request can be filed online. All PACE requests are recorded in the "non-public" portion of the EPO file.

A presentation on the topic of claim amendments focused on the requirements of Rule 137(4) EPC and identified the best practice for applicants to indicate the basis in the original application when the requested amendment is submitted during examination. It was stressed that this is an opportunity for the applicant to provide convincing arguments as to how the proposed amendment(s) is/are "directly and unambiguously derivable from the specification as filed".

President Battistelli also described a number of changes in the internal organization and management of the examining, opposition and administrative directorates that have made it possible to improve the timeliness, quality and efficiency in the search and examination of applications that is described above.

### **User Driven Early Certainty (UDEEC)**

Apparently some applicants find the progress made by the EPO in reducing the time for search and examination to be commercially disadvantageous. The EPO is currently considering a program that will offer applicants the no-fee option of postponing examination by up to three (3) years; under the proposed program examination could be initiated by a third-party request supported by substantiated reasons.

### **Harmonization Among the IP-5 Countries**

The EPO has taken a leadership role over the past ten years in harmonization efforts among the Trilateral countries (US, Japan and EPO) and among the IP5 group (the Trilaterals plus China and Korea) by urging that other the members prioritize this effort. This appears to be made possible by the fact that the EPO can establish its agenda and initiate its programs quickly using its own user-generated funds without the necessity of close oversight and budgetary restraints by legislative bodies to which other national offices are subject. (In a meeting several years ago, the Council was candidly advised by President Battistelli that the USPTO had been slow in completing its conversion and full participation in the Common Citation Document (CCD) program with the EPO and JPO.) Achievements have been made in harmonizing procedural requirements, but not without difficulty; substantive harmonization, admittedly more difficult, is initiated among the Trilateral Agreement members and then brought to the IP-5 group. Trilateral and IP-5 Industry Groups were reported to be especially effective in applying pressure to advance substantive harmonization among the respective IP-5 national overseers.

### **Workshops**

A portion of the morning and afternoon sessions was allocated to a total of seven (7) separate concurrent workshops described below, each in excess of an hour.

1. *Search (Chemistry/Bio)*: After reviewing current EPO searching practices and considering how the need for timely searching can be balanced against the desires of users for comprehensive searches, an opportunity was provided for an open discussion of topics including: (1) searches being limited due to lack of unity; (2) procedures for extending searches if such a lack of unity objection is overcome during examination; (3) hints and tips on claim drafting to improve search outcomes at the EPO; and (4) user suggestions for improving the search procedure.

2. *Workability/Sufficiency*: The issue of sufficiency of disclosure was discussed in the context of model cases and scenarios, and how to meet such objections should they arise during prosecution or opposition proceedings.

3. *Patenting Computer-Implemented Inventions (CII)*: The discussion focused on how to differentiate between technical and non-technical features of CII to determine which features should be considered, or not, under inventive step. Practical guidance for applicants was offered through interactive discussion of examples of CII claims.

4. *Opposition*: The procedural aspects of opposition proceedings including the filing of new evidence and new requests in the run-up to oral proceedings, the conduct of oral proceedings, and how the interests of the parties are balanced was discussed, as well as the impact of the streamlined procedure under the "Early Certainty from Opposition", effective 1 July 2016, under which "straightforward" cases are to be decided within 15 months.

5. *Article 123 Undisclosed Disclaimers*: Addressed the legal controversy surrounding current referral question G1/16, i.e., fundamental questions concerning the allowability or disclaimers/amendments arising from previous decisions G1/03 and G2/10. The workshop sought to develop specific practical guidance for dealing with uncertainty arising from, and possible outcomes of the pending referral.

6. *Article 123 (Chemistry/Bio)*: Common pitfalls to avoid during drafting and prosecution of EP patent applications in the Chemistry/Biotech sectors with regard to Article 123 EPC, including concrete examples and a checklist of "Do's & Don't's" were discussed.

7. *Clarity*: The requirement for clarity of claims (Art. 84 EPC), including differences in US and EPC standards, modifying US-origin applications for the EPO while maintaining priority claims, responding to clarity rejections, relationships with the inventive step (Art. 56 EPC) and sufficiency of disclosure (Art. 83 EPC) requirements, and the role of clarity in oppositions was discussed.

### **Practice Before the EPO Board of Appeals**

The Council was advised that there is a substantial backlog of both *ex parte* appeals by applicants and also third party oppositions. Since 2011, there has been an average excess of 700 new appeals filed over final decisions issued by the Boards. (A more detailed discussion is provided below in the context of the Council's discussion with the President of the EPO Boards of Appeal.) As of November of 2015, about 3400 appeals had been pending for more than two years. Although the average time from filing to decision is about 34 months, the actual time is only about one year and the remainder of the delay is attributable to the backlog,

In 2014, about 1100 decisions were issued by the Board in *ex parte* appeals. About 20% of rejections by examiners are appealed. About 1200 decisions were issued by the Board in opposition proceedings, which about 55% of the decisions are appealed.

As in the case of the PACE program for requesting expedited examination of applications, it is also possible to request that the review of the Appeal by the Board be expedited, and apparently such requests are usually granted. However, as in the case of the PACE program, not many such requests are filed with the Boards of Appeal.

### **Developments in the Unitary Patent System and Unified Patent Court**

Various aspects and expectations were presented by EPO representatives and discussed by the Council regarding the outcome of the then-ongoing negotiations over the Unitary Patent System (UPS) and the Unified Patent Court (UPC). In view of the subsequent successful conclusions of those negotiations in 2018 (as was predicted last year by President Battistelli), the details of the EPO's presentations are not included in this report.

### **Visit to the EPO Boards of Appeal on November 16, 2017**

In a new initiative, the U.S. delegates were also afforded the opportunity of visiting the offices of the Boards of Appeal located a short train ride from Munich in the suburban community of Haar on the day following the general meeting. Presentations by the President of the Board, Carl Josefsson (SW), and senior Board members were followed by a question and answer session which included comments by US delegates concerning difficulties experienced by U.S. applicants and practitioners involved in appeals.

A principal concern commonly expressed by applicants was the delay in the issuance of a decision on appeal, which President Josefsson confirmed at the time of our meeting was 49 months, with a backlog of 8900 cases.

After the appeal is filed, EPO time lines are suspended for applicants. In the event of an interlocutory revision in *ex parte* examination that results in allowance (e.g., an applicant proposes a further claim amendment to avoid delay), the appeal may be withdrawn or dismissed, but there is no refund of the fees.

In general, the Board renders an oral decision at the close of the oral proceedings, which may be continued and expanded upon in the written decision which follows in about three months.

The Rapporteur is a technical member of the panel of 3 or 5 members that includes two technical and one legal member, or three technical and two legal members, respectively.

The so-called Enlarged Board can be presented with the determination of issues to assure a uniform application of the law, as where prior decisions of the Board appear to be inconsistent, and to clarify a point of law of "fundamental importance". The President of the EPO may refer such issues to the Enlarged Board, which questions may be declined with a reasoned explanation.

A Petition for a decision by an Enlarged Board can allege (1) that a fundamental procedural defect occurred or (2) that a "criminal act" had an impact on the merits of the decision.

It is to be noted that there is no administrative appeal beyond the Boards of Appeal, but a challenge can be made in national courts.

Several specific issues relating to patentable subject matter and evidentiary issues and the presentation of evidence during oral argument in an *inter partes* proceeding without notice to the other party/parties were discussed.

The Board looks to the credibility of the asserted technical effect as derivable from the specification and also to the ability of the reasonably skilled technical person in the field. The Board needs to be convinced that the technical effect can be causally linked to the disclosure in the specification, and that it makes sense. The quality of the evidence of the technical effect is key. The technical effect should be part of the claim whenever possible. For example, a new GUI must be clearly defined in the claim and from the description in the specification what is derivable as the effect.

### **Next Council Meeting**

Plans were underway for this year's Council meeting in Washington, D.C. However, the Council was recently advised that the schedule of the new EPO President, Antonio Campina, Executive Director of the European Union Intellectual Property Office (EUIPO) who takes office July 1, 2018, cannot accommodate the proposed dates, and the Council has been invited to return to Munich in October or November.

In any event, NYIPLA members wishing to propose questions or present issues for discussion relating to EPO practice should forward them to both Sam Helfgott (samson.helfgott@kattenlaw.com) and Tom Spath (tspath@lawabel.com) for inclusion on the agenda for this year's meeting.



# WOMEN IN IP LAW

**SCOPE OF THE COMMITTEE:** To facilitate and empower women in their practice of intellectual property law, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Jessica Copeland and Abigail Langsam

**BOARD LIAISON:** Faith Hochberg

**MEMBERS:** Katherine Adams, Nitya Anand, Alexandra Awai, Naomi Birbach, Stephanie Chichetti, Puja Dave, Ursula Dave, Stephanie DelPonte, Lauren Fornarotto, Katherine Harihar, Jacqueline Hatherill, Khue Hoang, Kelsie Kelly, Whitney Meier, Nancy Mertz, Lorraine Morrison, Jennifer Okafor, Hannah Samendinger, Diana Santos, and Merav Shor

The Women in IP Law Committee had a successful year in 2017-2018, hosting CLE and networking events, in addition to committee meetings. On October 24, 2017, the Committee hosted its Fall event – a discussion on IP in the fashion industry in the wake of *Star Athletica v. Varsity Brands* – at Willkie Farr & Gallagher LLP. The discussion was led by Fordham Law Professor Susan Scafidi and Committee member Rachel Dooley. After the discussion, Ms. Dooley led well over 50 attendees in a workshop where each participant made a one of a kind necklace. On February 1, 2018, the Women in IP Law and Patent Litigation Committees co-hosted a panel discussion entitled, “Hot Topics and Issues in the Biosimilars Space: Part Two,” at Axinn, Veltrop & Harkrider LLP. This program provided an update on legal and policy developments in the biosimilar drug products space. Chad Landmon (Axinn, Veltrop & Harkrider LLP) addressed the current legal landscape surrounding the BPCIA “patent dance” and considerations for biosimilar sponsors going forward. Brian Murphy (Haug Partners LLP) discussed the use of *inter partes* review challenges before the PTAB against patents involved in parallel BPCIA litigations. Christine Simmon (The Biosimilars Council, Association for Accessible Medicines) discussed the challenges and opportunities for advocacy in fostering a robust U.S. biosimilar market, including regulatory and antitrust issues. Michael Johnson (Willkie Farr & Gallagher LLP) moderated the panel. On March 1, 2018, the Committee, in collaboration with the Young Lawyers Committee, hosted a networking happy hour at which members and guests of the respective committees engaged in informal discussion on professional development and career paths. 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

**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, Scott Forman, Lindsay Korotkin

**BOARD LIAISON:** Heather Schneider

**MEMBERS:** Nitya Anand, Naomi Birbach, Dennis Bissonnette, David Cole, Eric Greenwald, Darienne Grey, Zach Hong, Gina Kim, Yan-Xin Li, Matthew Miller, Margaret Mortimer, Dorna Mohaghegh, Gerald Porter, Jeffrey Price, Michael Sebba, Tom Tatonetti, Christina Wilson, Jessica Wu

The Young Lawyers Committee started off the year with an event at Hofstra Law School that included two panels and a networking reception. The subjects of the panels were “Diverse Careers in IP Law and Strategies for Achieving Success,” and “IP Considerations for New IP Practitioners and Non-IP Attorneys.” The Committee then hosted a panel on litigation finance, entitled “Speaking the Language of Litigation Finance: What Your Partners Don’t Know.” Panelists discussed how litigants and law firms use litigation finance, the role of litigation counsel in facilitating financing arrangements, and the use of litigation outcome metrics in pre-litigation diligence.

The Young Lawyers Committee continued its tradition of joining other committees for networking over happy hours. Members attended mixers with the Corporate Committee and Women in IP Committee.

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

**STATEMENT OF ACTIVITIES**

**YEARS ENDED APRIL 30, 2018 AND 2017**

	<u>2018</u>	<u>2017</u>
Revenues		
Judges Dinner - event fees	\$ 1,104,570	\$ 1,238,020
Continued legal education (CLE) revenue	56,715	82,430
Membership dues	250,053	250,495
Other programs and events	19,658	26,815
Interest income	3,140	<u>2,148</u>
Total revenues	1,434,136	<u>1,599,908</u>
Expenses		
Judges Dinner	763,658	867,284
Continued Legal Education (CLE)	33,515	42,157
Other programs and events	54,693	87,953
Scholarships, awards and donations	17,500	19,096
Professional fees	588,627	539,970
Postage and mailing	393	1,089
Printing and publications	49,472	53,869
Office expense	13,143	14,534
Telephone	780	780
Insurance	12,178	11,051
Miscellaneous	234	<u>1,139</u>
Total expenses (Note 3)	1,534,193	<u>1,638,922</u>
Change in unrestricted net assets (Exhibit C)	(100,057)	(39,014)
Net assets - unrestricted - beginning of year	2,003,984	<u>2,042,998</u>
Net assets - unrestricted - end of year (Exhibit A)	\$ 1,903,927	<u>\$ 2,003,984</u>



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

**STATEMENT OF CASH FLOWS**

**YEARS ENDED APRIL 30, 2018 AND 2017**

	<u>2018</u>	<u>2017</u>
Cash flows from operating activities		
Change in net assets (Exhibit B)	\$ (100,057)	\$ (39,014)
Adjustments to reconcile change in net assets to net cash provided (used) by operating activities		
Decrease (increase) in assets		
Accounts receivable		3,150
Prepaid expenses	(66,133)	24
Increase (decrease) in liabilities		
Accounts payable and accrued expenses	(3,756)	4,387
Deferred revenue	27,925	55,685
	<u>(142,021)</u>	<u>24,232</u>
Net cash provided (used) by operating activities	<u>(142,021)</u>	<u>24,232</u>
Net change in cash and cash equivalents	(142,021)	24,232
Cash and cash equivalents - beginning of year	2,088,281	2,064,049
Cash and cash equivalents - end of year	\$ <u>1,946,260</u>	\$ <u>2,088,281</u>



## 96<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary

The New York Intellectual Property Law Association held its 96<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary on March 23, 2018 at the New York Hilton Midtown Hotel. President Annemarie Hassett 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 Sixteenth Annual Outstanding Public Service Award was presented to the Honorable Sue L. Robinson, District Judge for the United States District Court for the District of Delaware. The Keynote address was given by Bob Woodward, award-winning journalist, best-selling author and Associate Editor of the Pulitzer Prize-Winning *Washington Post*.



**Standing:** Heather Schneider, Hon. Leonard Stark, Peter Thurlow, Hon. Dora Irizarry, Hon. Jose Linares, Kathleen McCarthy, Hon. Barbara Lynn, Robert Rando

**Sitting:** Hon. Janet Hall, Matthew McFarlane, Hon. Sharon Prost, Hon. Sue Robinson, Annemarie Hassett, Bob Woodward, Hon. Joy Flowers Conti, Hon. Ruben Castillo





This black-tie gathering had over 2,400 guests including federal judges, government officials, corporate counsel, legal professionals, and representatives from other intellectual property associations.











NEW YORK  
MIDTOWN HILTON

MARCH 23, 2018

THE  
NEW YORK INTELLECTUAL PROPERTY  
LAW ASSOCIATION

*in conjunction with*  
THE NYIPLA 96TH ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY  
*present*  
DAY OF THE DINNER CLE LUNCHEON

*Developments in the Courts and  
Congress and the Implications for  
Patent Policy and Innovation*

« KEYNOTE SPEAKER »

**HONORABLE KATHLEEN M. O'MALLEY**

CIRCUIT JUDGE OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

« REMARKS »

**ANDREI IANCU**

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

« PANEL »

**HONORABLE LEONARD P. STARK**

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

**HONORABLE JOSE L. LINARES**

CHIEF JUDGE OF THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY

**JOSEPH MATAL**

FORMERLY PERFORMED THE FUNCTIONS AND DUTIES OF THE  
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

« MODERATOR »

**WALTER E. HANLEY JR.**

NYIPLA IMMEDIATE PAST PRESIDENT

*Hosted by the NYIPLA Programs Committee*

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

Nineteen Hundred and Twenty-two  
**NYIPLA®**







2018 DOD CLE Luncheon



# Hot Topics in Intellectual Property Law

Wednesday, July 19, 2017

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



2:00PM – 12:45PM	Registration and Lunch
12:45PM – 1:00PM	Welcoming Remarks
1:00PM – 1:30PM	<b>Keynote Address – Taking Criminals Out of Cyberspace and Into the Courtroom: An Evolving Battlefield for Lawyers</b> <b>James Gatta</b> , Chief of the Criminal Division, U.S. Attorney's Office, Eastern District of New York
1:30PM – 2:00PM	<b>The Impact of Varsity Brands for Design Protection in the Fashion Industry</b> <b>Olivera Medenica</b> , Partner, Medenica Law PLLC <b>Viviana Mura</b> , Intellectual Property Law Counsel, Luxottica Group <b>Lisa W. Rosaya</b> , Partner, Baker & McKenzie LLP
2:00PM – 2:30PM	<b>Augmented and Virtual Reality: Issues for IP Practitioners</b> <b>Robert deBrauwere</b> , Partner, Pryor Cashman LLP
2:30PM – 2:45PM	Refreshment Break
2:45PM – 3:15PM	<b>Don't Go At It Alone: Insurance for Intellectual Property Claims</b> <b>Michael C. Cannata</b> , Parter, Rivkin Radler LLP <b>Robert W. Fletcher</b> , President, IPISC Patent Insurance <b>Frank Misiti</b> , Partner, Rivkin Radler LLP
3:15PM – 3:45PM	<b>Trademark/Trade Dress/Copyright Infringement: A View From the Branding and Survey Design Perspective</b> <b>Matt Ezell</b> , Partner, Ford Bubala & Associates <b>Rob Wallace</b> , Managing Partner, Best of Breed Branding Consortium
3:45PM – 4:15PM	<b>Fireside Chat with Gerard F. Rogers</b> , Chief Administrative Trademark Judge, Trademark Trial and Appeal Board <b>Dyan Finguerra-DuCharme</b> , Partner, Pryor Cashman LLP
4:15PM – 4:45PM	<b>Trademark Ethics 101: Investigations, Advance Consents and Terminating Client Relationships</b> <b>Brent E. Routman</b> , Partner and General Counsel, Merchant & Gould LLP
4:45PM – 4:50PM	Closing Remarks



# One-Day Patent CLE Seminar

Thursday, November 16, 2017  
The Princeton Club, 15 West 43rd Street, New York, NY

## AGENDA

- 8:15AM – 9:00AM      *Registration and Continental Breakfast will be served*
- 9:00AM – 9:05AM      Welcome Remarks by **Annemarie Hassett**, NYIPLA President, Engelberg Center on Innovation & Policy, NYU School of Law
- 9:05AM – 10:25AM      Panel 1: **TC Heartland: Returning to Life Under Section 1400(b) Venue**  
*Moderator: **Thomas Vetter**, Of Counsel, Lucas & Mercanti LLP  
**Kenneth Adamo**, Partner, Kirkland & Ellis LLP  
**Jeffrey Lewis**, Partner, Norton Rose Fulbright LLP  
**Joshua Raskin**, Shareholder, Greenberg Traurig LLP*
- 10:25AM – 10:40AM      *Refreshment Break*
- 10:40AM – 12:00PM      Panel 2: **Section 101 – Three Years of Uncertainty**  
*Moderator: **Jonathan Berschadsky**, Partner, Merchant & Gould PC  
**Serena Farquharson-Torres**, Senior Patent Counsel, Bristol-Myers Squibb  
**Cindy Huang**, Counsel – IP Law & Strategy, American Express  
**Laura Sheridan**, Patent Counsel, Google Inc.*
- 12:00PM – 12:45PM      *Lunch*
- 12:45PM – 1:15PM      *Keynote Speaker Honorable Stanley R. Chesler, Senior District Judge, United States District Court for District of New Jersey*
- 1:15PM – 2:05PM      Interactive Ethics CLE: **Shifting Between IP Lawyer and Lobbyist**  
*Moderator: **Colman Ragan**, Associate General Counsel – U.S. IP Litigation, Teva Pharmaceutical Industries LTD  
**Dorothy Auth**, Partner, Cadwalader, Wickersham & Taft LLP  
**Jeffrey Butler**, Senior Counsel, Global IP/Lonza, Inc.*
- 2:05PM – 3:00PM      Panel 3: **Recent Updates to Ethical Duties of a Practitioner Before the USPTO**  
*Moderator: **Mark Bloomberg**, Partner, Zuber Lawler & Del Duca LLP  
**William R. Covey**, Deputy General Counsel and Director of the Office of Enrollment and Discipline, USPTO*
- 3:00PM – 3:15PM      *Refreshment Break*
- 3:15PM – 4:05PM      Panel 4: **Patent Rights: Public or Private; Whose Thoughts and Ideas Are They Anyway?**  
*Moderator: **Anthony Lo Cicero**, Partner, Amster Rothstein & Ebenstein LLP  
**Robert Rando**, Founder, The Rando Law Firm PC  
**Melvin Garner**, Partner, Leason Ellis LLP*
- 4:05PM – 5:00PM      Panel 5: **Licensing Strategies in View of Lexmark and Promega**  
*Moderator: **Diana Santos**, Associate, Willkie Farr & Gallagher LLP  
**Eugene Chang**, Partner, Willkie Farr & Gallagher LLP  
**Robert Isackson**, Partner, Venable LLP*
- 5:00PM – 5:05PM      *Closing Remarks*

## 2017 One-Day Patent Program





# EVENTS



## **Social Gathering for Members**

July 11, 2017



## **4<sup>th</sup> Annual Second Circuit Moot Court Argument**

July 18, 2017

**Judges' Panel:**  
Hon. Gabriel Gorenstein,  
Hon. Ramon Reyes Jr., and  
Hon. Steven Locke

**Participating Firms:**  
Haug Partners,  
Hodgson Russ LLP,  
Pryor Cashman LLP, and  
Willkie Farr & Gallagher LLP

**Speakers:**  
Benjamin Dahl, Devon  
Edwards, Kristen Flick,  
Esther Kim, Luke Rushing,  
Jessica Sblendorio, Aislinn  
Toohey, and David Yovanoff

Hosted by the  
Programs Committee



## **IP Considerations for New IP Practitioners and Non-IP Attorneys**

October 4, 2017

**Speakers:**  
Melissa Schoffer Farber,  
Brian Bloom,  
Stephen Breidenbach,  
Robert Rando, and  
Evgeny Krasnov

Hosted by the  
Young Lawyers Committee



## **In-House Counsel and Young Lawyers Happy Hour**

September 26, 2017

Hosted by the  
Corporate Committee



## **Preparing an Amicus Brief on Behalf of the NYIPLA**

October 17, 2017

**Speakers:** David Goldberg,  
Robert Isackson,  
Jeffrey Lewis,  
Charles Macedo,  
Charles Miller,  
Jonathan Moskin, and  
Robert Rando

Hosted by the  
Amicus Brief Committee



## **Understanding the Protectable IP of Jewelry and Fashion**

October 24, 2017

**Speakers:**  
Rachel Dooley and Susan  
Scafidi

Hosted by the  
Women in IP Law Committee



# EVENTS



## **Trademark Law & Practice Committee Happy Hour**

October 26, 2017

Hosted by the  
Trademark Law & Practice  
Committee



## **Parody: A Viable Defense to Dilution Claims?**

November 28, 2017

Speakers:  
Kathleen McCarthy,  
Brendan O'Rourke, and  
Marcia Paul

Hosted by the  
Trademark Law & Practice  
Committee



## **Young Lawyers Committee Happy Hour**

December 13, 2017



## **Speaking the Language of IP Litigation Finance: What Your Partners Don't Know**

January 10, 2018

Speakers:  
Eric Greenwald, Joseph Loy,  
Michael Sander, and Katharine  
Wolanyk

Hosted by the Young Lawyers  
Committee

Sponsored by: Baker Botts LLP



## **Hot Topics and Issues in the Biosimilars Space: Part Two**

February 1, 2018

Speakers:  
Michael Johnson,  
Chad Landmon,  
Brian Murphy, and  
Christine Simmon

Hosted by the  
Patent Litigation Committee

Sponsored by: Axinn, Veltrop  
& Harkrider LLP

# EVENTS



## **Advanced Topics in PTAB Practice**

February 28, 2018

### **Speakers:**

J. Steven Baughman,  
Bruce Koch,  
Brian Murphy, and  
Joseph Robinson

Sponsored by: Troutman  
Sanders LLP



## **Happy Hour Hosted by the NYIPLA Women in IP Law & Young Lawyers committees**

March 1, 2018



## **2018 Trademark Update: A Discussion with a USPTO Policy Maker and a TTAB Decision Maker**

March 6, 2018

### **Speakers:**

Dyan Finguerra-DuCharme,  
Colleen Kearney, and  
Hon. David Mermelstein

Hosted by the  
Trademark Law & Practice  
Committee



## **NJIPLA & NYIPLA Joint Program - Trade Secret/ Cybersecurity: Protecting our Corporate Client's Information**

April 18, 2018

### **Speakers:**

Brian Levine,  
Daniel Levy,  
David Almeling,  
Deirdre Wheatley-Liss,  
John Gray,  
John Moehringer,  
Ken Corsello,  
Lisa Wang,  
Mark Schildkraut, and  
Meredith Dearborn