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Everyone's a Celebrity: The Role of the Right of Publicity in a World Increasingly Dominated by Social Media

By Daryl Steiger*

Imagine that you posted a photo of yourself on social media. You decided to hashtag the brand name of your dress and even tag the company in your post. Eventually, you learn that the company reposted your photo to advertise its brand without your permission. You wonder what rights you have and what remedies are available. This is the dilemma that the social media revolution has created for the right of publicity, a cause of action that provides an individual with legal protection to prevent unauthorized commercial uses of his or her identity. Part I of this article provides an overview of the birth of the right of publicity, which has historically been identified as a celebrity's right.¹ Part II analyzes the implications of social media for the right of publicity. This section explores (1) the meaning of "celebrity" and how this concept has been affected by social media, and (2) whether, given the exponential growth and influence of social media, right of publicity claims should continue to focus on celebrities. This article suggests that, although difficult to achieve in practice, the right of publicity should be expanded to include non-celebrities in light of the impact that social media has had on the modern concept of identity. This expansion is in keeping with the historical origins of the right of publicity.

I. The Historical Narrative Behind the Right of Publicity

The right of publicity finds its origins in the right of privacy. In the seminal 1890 article "The Right to Privacy,"² Samuel Warren and Louis Brandeis expressed their growing concern about the publication of private facts or photographs by the media without consent, and argued that there should be a right to be "let alone."³ They further detailed a system that would provide compensation for emotional harm caused by this invasion of an individual's privacy.

One decade later, a case was brought in New York involving the unauthorized use of a non-celebrity's image in an advertisement.⁴ Although the court in that case held that there was no common law right to privacy, in 1903 the New York State Legislature responded to the court's ruling by passing the first statute to recognize a right of privacy and prohibit the unauthorized use of a person's⁵ name or image—whether a portrait or a picture for advertising or trade.⁶ Two years later, a Georgia court wrote in an opinion:

The knowledge that one's features and form are being used for such a

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Recently, I attended the Hands Lecture at the Second Circuit Court of Appeals, given in honor of Judge Learned Hand and his cousin and contemporary, Judge Augustus Hand. The Hands Lecture was the first of a series of events the Second Circuit is presenting over the next year in celebration of its 125th Anniversary. Supreme Court Justice Ruth Bader Ginsberg delivered an introduction in which she praised Judge Learned Hand for his appreciation of the impact of judicial decisions on the lives of ordinary people. Her remarks caused me to wonder whether that attribute of Judge Hand's jurisprudence was evident in his patent decisions.

I took Justice Ginsberg's reference to "ordinary people" to mean the public at large rather than the litigants and those directly or indirectly affected by the decision. Ordinary people benefit from the patent system by having access to innovative products and services embodying inventions incentivized by the availability of a limited legal monopoly. Ordinary people also benefit from the availability of jobs in an economy fueled by invention. The proper judicial administration of the patent system fosters the Constitutional purpose "[t]o promote the progress of science and useful arts" for their benefit, not just for the benefit of direct stakeholders in the system.

Did Judge Hand recognize ordinary people in his patent decisions? Here, I must confess that I lack expansive knowledge of Judge Hand's patent decisions, which number an estimated 240 and span the length of his service as district judge and circuit judge from 1909 to 1961. And, I do not intend to read all of them any time soon (or ever). But those I have read are remarkable for their detailed discussion of the technology at issue and its background, and, of course, for groundbreaking formulations of now-familiar patent law doctrines such as prosecution history estoppel, the doctrine of equivalents, and invalidating public use. There are many memorable quotes, like Judge Hand's description of "the antlike persistency of solicitors" that overcomes "the patience of examiners"—a defender's favorite. *Lyon v. Boh*, 1 F.2d 48, 50 (S.D.N.Y. 1924).

However, if Judge Hand used soaring rhetoric about the public interest in any of his decisions, I have not found it. What I have found is an underlying concern in his application of the law that the scope of the patent monopoly be commensurate with the public benefit conferred by the invention. Here are a few examples:

In deciding the issue of "invention" (the pre-1952 Act formulation of obviousness), Judge Hand emphasized evidence of long-felt need and the failure of other artisans not just because it indicated an inventive leap but also because the benefit conferred on the public was clear. In *Dewey & Almy Chemical Co. v. Mimex Co.*, 124 F.2d 986, 990-91 (2d Cir. 1942), Judge Hand wrote in support of reversal of a judgment invalidating a patent on a composition for sealing tin can lids that failure "to recognize so substantial an achievement as this which has resulted in the improved preservation of foods and other perishable goods, would deny recognition where recognition most is helpful."

On the requirement that a patent disclose an operable invention, Judge Hand dismissed defects in a patent that a skilled mechanic could remedy, stating that "if such a patent would be valid, it can only be because the public gets a good consideration for the monopoly, which means that, despite its defects, it contributes to the art." *Electrical Engineer's Equipment Co. v. Champion Switch Co.*, 23 F.2d 600, 604 (2d Cir. 1928).

In holding that a secret but commercial use of an invention by the inventor within the statutory bar period invalidates the patent, Judge Hand wrote that "it is part of the consideration for a patent that the public shall as soon as possible begin to enjoy the disclosure." *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 515, 519 (2d Cir. 1946).

And on claim indefiniteness arising from the use of functional language, Judge Hand wrote that a claim "must advise the public of its scope, and may not be stated in terms of ends or purposes, for that would extend the monopoly to all contrivances which would accomplish the same results, and these might owe nothing whatever to the patentee." *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 693 (2d Cir. 1948).

Interestingly, although Judge Hand decided more patent cases as a generalist judge than most patent litigators handle in an entire career, he was uncertain why patent law is useful. In 1955, in testimony before the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary, Judge Hand was asked whether he believed patent law has served a useful purpose. He said: "I think it has. A great one. If you cross-question me and ask me why, I don't know." His gut feeling is good enough for me.



Walt Hanley

purpose and displayed in such places as such advertisements are often liable to be found brings not only the person of an extremely sensitive nature, but even the individual of ordinary sensibility, to a realization that his liberty has been taken away from him, and, as long as the advertiser uses him for these purposes, he can not be otherwise than conscious of the fact that he is, for the time being, under the control of another, that he is no longer free, and that he is in reality a slave without hope of freedom, held to service by a merciless master....

So thoroughly satisfied are we that the law recognizes within proper limits, as a legal right, the right of privacy, and that the publication of one's picture without his consent by another as an advertisement, for the mere purpose of increasingly [sic] the profits and gains of the advertiser, is an invasion of this right, that we venture to predict that the day will come when the American bar will marvel that a contrary view was ever entertained by judges of eminence and ability.⁷

Thus, the right of privacy began to establish a foothold in the law, with courts providing a remedy to individuals who preferred to avoid such unwanted attention. Additionally, the right had a publicity-like aspect to it where it encompassed the right against false endorsement.⁸

The current understanding of the right of publicity was formally introduced into the American legal system in the 1950s, as a response to the realization that the right of privacy did not protect economic concerns adequately.⁹ As some scholars note, this right did not always apply to public persons, those with a celebrity status.¹⁰ Rather, those individuals "would be seen as having 'availed' themselves of the public eye, and would be only minimally protected under the existing privacy laws."¹¹ Celebrities would only have a defensive claim, which would allow them to assert the right in cases where their likenesses were used without their authorization and could result in economic loss.¹² In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, the court for the first time acknowledged that an individual has a right to the publicity or commercial value of his image and the right to grant the ability to use that image.¹³ The opinion coined the term "right of publicity" and expressed the importance of this right for "prominent persons."¹⁴ As innovation in technology increases, more forums for publication and use of a person's image emerge; in response to these emerging uses, the right of publicity has expanded to protect more and more aspects of an identity.¹⁵ In a well-

known case involving Bette Midler and the Ford Motor Company, in which Ford used an imitation of her voice for a commercial, the Ninth Circuit held that an identifiable voice constitutes part of a celebrity's commercial identity and may be protected.¹⁶ A few years later, the Ninth Circuit further expanded that right when it held that an advertisement depicting a robot that resembled the identity of a celebrity, Vanna White, violated her right of publicity.¹⁷

Currently, identity has a much larger scope, encompassing almost all attributes associated with an individual.¹⁸ This can include a distinctive voice, catchphrases, famous personas or roles, and even attributes that are evocative of but not unique to a particular person.¹⁹ And while the right is recognized in a majority of states, the legal framework is a "patchwork quilt of statutes and common law" and the individual states differ as to whether the right is transferable or descendible and which remedies apply.²⁰

The right of publicity diverges from its predecessor, the right to privacy, insofar as it specifically protects the commercial use of personal identity.²¹ In fact, where the right to privacy protects an individual person, it does not protect the commercial value of his or her identity.²² The right of publicity, on the other hand, provides individuals with the right to "the exclusive commercial use of his or her name and likeness"²³ and to prevent unauthorized commercial uses.²⁴ The distinction between "commercial" and "non-commercial" uses is complicated, as there is no bright-line rule to differentiate between the two. The most commonly used definition of "commercial speech" is "speech proposing a commercial transaction."²⁵ This vague understanding of commercial use has led to inconsistencies in right of publicity cases, with a number of cases extending protection to non-commercial uses.²⁶ Even with the emphasis on the "commercial use" factor for granting protection, there nonetheless have been a number of cases that have extended protection to non-commercial uses. In *Parks v. LaFace Records*, Rosa Parks brought a claim against the band OutKast for the unauthorized use of her name as the title to a song.²⁷ The court allowed Ms. Parks to pursue this matter as a right of publicity claim despite the fact that the use was not commercial in nature. Similarly, the court in *Doe v. TCI Cablevision* recognized a right of publicity claim by Tony Twist, a former hockey player, to prevent the use of his name as a character in a comic book series.²⁸ In the latter case, the court adopted a test that weighs the expressive quality of a use of an individual's identity against its commercial purpose.²⁹ Additionally, this creates further complications for determining the injury caused to plaintiffs and what damages can or should be awarded.

The right of publicity is further distinguished from the right of privacy through the way in which the rights are viewed and the individuals that the rights are aimed to protect. The right of publicity has two main goals: to protect individuals from any distress resulting from unauthorized and unwelcome use of their identity and to protect the property interest in their identity.³⁰ As Melville Nimmer observed, the main difference between the right of privacy and the right of publicity is that the former is a personal and non-assignable right, whereas the latter can be licensed or assigned.³¹ Some consider this right to have greatly expanded from its “narrow privacy origins” into a “virtually unlimited, descendible, assignable property right.”³² One view of the distinction between the rights is that they are the inverse of each other.³³ As a person’s fame and publicity increases, his or her privacy—and right thereto—is necessarily diminished.³⁴ This view coupled with the emphasis in *Haelan* on “prominent persons” indicates that the rights have been applied differently and disproportionately to celebrities and non-celebrities, with non-celebrities mainly—or even solely—having a right of privacy.

The right of publicity has developed with two distinctive approaches:³⁵ the New York and the California approaches. The major difference between the two approaches derives from New York recognizing the right of publicity within the context of the right of privacy—it is codified in New York’s privacy statute³⁶—rather than as a separate right. This approach provides a broad exception for the First Amendment and interprets the “newsworthy” exception³⁷ more expansively. As the law derives from the right to privacy, it focuses on the intrusion into an individual’s private affairs though it is seen as very friendly and highly protective of the media. Further, New York only recognizes the right via statute,³⁸ whereas California recognizes it under both statute³⁹ and common law.⁴⁰ California and the states that follow its approach view the right as descendible⁴¹ and also provide for a post-mortem right of publicity to those who have died within the last 70 years. Unlike California, New York does not have a post-mortem right of publicity or privacy, but the law does recognize that the right attaches to an individual who resides in another state.

There are many policy justifications provided for the right of publicity, including natural rights and fairness, incentives, economic efficiency, and preventing deception.⁴² The natural rights theory views the identity as an individual’s property to control as he or she sees fit, therefore granting the right to prevent others from unjustly free-riding and benefiting economically from the value the person has built up in

his or her identity.⁴³ The incentive justification asserts that giving individuals the exclusive right to capitalize on the economic value they gain from their identity encourages them to invest in developing their skills and talents.⁴⁴ Since such investment results in socially desirable behavior and leads to a richer society, it deserves protection. The economic efficiency theory acknowledges that making an individual the sole arbiter of how and when to commercially use his or her identity helps maximize its economic value.⁴⁵ Without this protection, anyone who wants to use the identity could do so at will and dilute any cachet associated with the identity, resulting in a loss of economic value. Thus, granting property rights results in efficient allocation of scarce resources and helps ensure that resources go to the highest and best uses.⁴⁶ Finally, the anti-deception justification recognizes that assigning property rights in one’s identity can help prevent deceptive commercial uses.⁴⁷ This argument provides only modest justification, however, because one can infringe the right of publicity without any use of deception. Even with the substantial number of justifications posited for this right, according to some scholars, it still remains unclear why individuals should have this right.⁴⁸

The modern version of the right of publicity has shifted the emphasis away from protecting an individual’s identity to protecting the economic value of celebrity.⁴⁹ The majority of scholars, commentators, and courts maintain that all people have a right of publicity, regardless of celebrity status, and therefore have the right to control marketable personal attributes they possess.⁵⁰ Though a plaintiff’s celebrity status “may be a relevant issue in determining the marketability of his or her personal information,” it generally is not considered to be a prerequisite for a right of publicity claim.⁵¹ In contrast, the minority view reserves the right for celebrities, leaving everyone else with the right of privacy to protect against unauthorized non-commercial uses of a person’s identity that either embarrass or physically harm that individual.⁵² While the right of publicity technically extends to all individuals,⁵³ in practice non-celebrities are not viewed as having sufficient “commercial value in their identity to justify litigation” to defend this right.⁵⁴

Regardless of the majority view, the current trend in case law disproportionately favors celebrities,⁵⁵ and non-celebrities rarely succeed in right of publicity cases. This is largely a result of the burdens placed on the plaintiff to demonstrate that his or her identity has commercial value⁵⁶ and it was exploited for commercial purposes, a difficult task for non-celebrities. Additionally, the main test for infringement over the past decade, the “identifiability” test, has been inconsistently applied

and disfavors cases brought by non-celebrities. The test requires that the identity be “distinctive and recognizable to those receiving the publicity” and assumes that commercial value derives from the widespread identifiability of the identity.⁵⁷ In *Cheatham v. Paisano Publications, Inc.*⁵⁸ and *Pesina v. Midway Manufacturing Co.*,⁵⁹ the non-celebrity plaintiffs attempted to use the Ninth Circuit’s exact reasoning in *Motschenbacher v. R.J. Reynolds Tobacco Co.*⁶⁰ to protect their personas, but were unsuccessful due to the vagueness of what constitutes “identifiable” and the courts’ interpretations.⁶¹ These holdings suggest that a plaintiff’s identifiability will depend on whether he or she is recognizable to a widespread audience, which “seems to necessitate a certain degree of national celebrity as a prerequisite to a successful claim under the right of publicity.”⁶² However, as a result of the advancement in technology and the rise in social media, the term “celebrity” has shifted and private citizens or “non-celebrities” have become more visible and identifiable. Therefore, the right is currently more salient for a broader population of individuals, and courts should respond accordingly.

II. The Social Media Revolution

In addition to the endless technological changes that the law must adapt to, the advent of social media and the way it has invaded and impacted our society has created further implications for the right of publicity. Social media has been described as a “platform harnessing collective intelligence.”⁶³ It allows individuals to share even more information, as well as offering an increasing number of ways to share photographs and display personal preferences. Depending on privacy settings put into place by a user, the user’s profile could be visible to the entire community. Additionally, social media and technological advances have made it easier to “copy and paste,”⁶⁴ and therefore to appropriate images in an increasing number of ways. This has challenged the right of publicity, which struggles “to keep up with the evolving media” through which a person’s name, portrait, picture, likeness, or voice can be exploited.⁶⁵ The public nature of this forum has caught the attention of many companies and brands. For example, in March 2014 Duane Reade tweeted a photograph of Katherine Heigl entering one of its stores with the text “Love a quick #DuaneReade run? Even @KatieHeigl can’t resist shopping #NYC’s favorite drugstore.” Heigl sued Duane Reade for violating her right of publicity, arguing that the chain attempted to exploit her image as an advertisement.⁶⁶ Although the lawsuit was ultimately dropped, this case illustrates the current implications of social media for the right of publicity.

Additionally, as consumers continue to display their personal style on these platforms, brands have found ways to further capitalize on this new medium to promote their designs or products.⁶⁷ There are now an increasing number of ways for companies to find everyday images of or information about customers wearing, buying or engaging with their products. A report by Nielson highlights that:

[s]ocial media enables consumers to generate and tap into the opinions of an exponentially larger universe. While word-of-mouth has always been important, its scope was previously limited to the people you knew and interacted with on a daily basis. Social media has removed that limitation and given new power to consumers.⁶⁸

One method brand owners use to identify their consumer base—or even potential consumer base—is the “hashtag,”⁶⁹ another is allowing consumers to “like” or “follow” the brand on Facebook, Instagram, Twitter, Pinterest, and other platforms. Even further, some platforms allow users to repost images containing styles and looks.⁷⁰ Companies are recognizing that advertisements referencing endorsements made by peers are not only a cheaper alternative but are also viewed by consumers as more credible and become more effective than advertisements crafted by experts.⁷¹ But, while many of these platforms have Terms of Use and privacy policies that grant them a right to display any user content posted on their sites, retailers do not have the same rights or licenses and therefore may not appropriate the content for their own use or purpose.⁷² Sheppard Mullin, Richter & Hampton LLP notes that “retailers may be surprised that consumer submissions are entitled to publicity rights—after all, users are voluntarily posting public photos of themselves on websites knowing that the photos may be used to advertise the brand.”⁷³ Though social media does provide a forum for this “collective intelligence” where consumers can interact with retailers and brands, it does not diminish or forfeit the right to publicity afforded to consumers under the law.⁷⁴

A. The “New” Celebrity and the Shift in Marketable Personalities

As the social media revolution progresses, the concept of what constitutes a valuable personality interest continues to expand, and the term “celebrity” continues to evolve and transform.⁷⁵ With the changes in technology, the meaning of celebrity has shifted from what it once meant, and currently fame can be acquired in an

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increasing number of ways. The current state of social media has created an expanded notion of celebrity, no longer limited to Hollywood stars or television personalities. Now, the arena is flooded with newcomers, such as YouTube sensations and highly followed Instagram or Vine accounts. The Jenna Marbles of the world are becoming less of a phenomenon and more of the norm. Consequently, these “new” celebrities are beginning to gain increasing recognition by the populus and major industries.⁷⁶ However, as these individuals acquire their status through platforms that provide exposure but not necessarily a source of income, the difficulty in proving their personality’s commercial value or worth will likely influence whether or not they can claim a right of publicity.

Even individuals who have not realized this new celebrity status face much more exposure now than when the law originated. The technology and social media boom makes complete privacy and anonymity almost impossible, and individuals who engage with any platform have made themselves more searchable and accessible by others. Further, our culture has a powerful fascination with the common person, as evidenced by the spike in the number and popularity of reality television shows.⁷⁷ This raises a number of questions, including: (1) why the right of publicity should apply so disproportionately to individuals that fit into the category of celebrity that the law originally sought to protect, and (2) at what point does a personality hold enough commercial value to deserve protection, especially given the increased exposure individuals have today courtesy of evolving technology.⁷⁸

B. Responding to Social Media: The Need for a Shift in Focus for the Right of Publicity

Historically, the right of publicity has served almost solely to protect celebrities; however, as social media continues to allow non-celebrities to have more public personas, the protection afforded by this right must expand as well. An expanded right of publicity would serve as an important first step in responding to the changes ushered in by social media. Looking back to the language in *Haelan*, the court held that “in addition to and independent of that right of privacy, . . . a man has a right in the publicity value of his photograph, i.e. the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made ‘in gross,’ i.e., without an accompanying transfer of a business or of anything else.”⁷⁹ While the court reasoned that prominent persons should have this right because they would feel deprived if unable to receive money for such advertisements, the same can be said for all

individuals. If a retailer misappropriates a person’s image for use as an advertisement, aside from a claim for invasion of privacy, that individual also has a right to receive consideration for its use.

It currently remains unclear to what extent the law will protect “new” celebrities or other individuals.⁸⁰ Social media is “blurring the line between celebrity and consumer” and courts—especially in California—are beginning to recognize these rights for non-celebrities.⁸¹ However, a minority of courts refuse to recognize right of publicity claims for individuals unless they have “achieved some degree of celebrity.”⁸² Additionally, some scholars do not believe the right of publicity should extend to non-celebrities. Arguments in opposition express that the right often interferes with the First Amendment’s protection of commercial speech, and any justifications that exist for protecting the economic value of a celebrity’s identity do not apply to protecting the “‘presumed’ or nominal value in a noncelebrity’s identity.”⁸³ Further, they assert that since these individuals do not have the requisite amount of commercial value in their identities and the privacy tort provides a category for misappropriation of name or likeness,⁸⁴ non-celebrities should resort to privacy claims instead. This view accurately reflects the context of the time in which the law emerged, when it made more sense for the right to disproportionately apply to celebrities since they, for the most part, had the only identities that held significant commercial value. However, this is currently not always the case, and therefore the argument should not hold as much weight.

Although courts have begun recognizing that the right of publicity claim no longer solely applies to celebrities, other barriers may still serve to deter individuals from seeking relief, and an even-handed system of protection may prove extremely difficult to implement. A major obstacle involves the commercial value factor, as plaintiffs may have issues demonstrating the commercial value in their identities. This is especially salient in California courts and in states that follow the California approach. For those “whose identity is of economic value only to themselves, there is a lack of protection under the right of publicity when that identity is used for the commercial purposes of another without consent.”⁸⁵ Plaintiffs have the burden of proving economic harm to win a claim and must produce evidence demonstrating the harm. For example, California common law requires that an individual prove that his or her identity was used in a commercial context that resulted in economic injury.⁸⁶ If the plaintiff overcomes the burden of proving economic injury, he or she can recover damages measured by the commercial value⁸⁷ of his or her identity or what the person would have had to pay for authorization

to use the identity.⁸⁸ Whereas establishing an economic value is easy with a celebrity plaintiff, largely due to our “cultural fascination with and commodification of famous personas, average private citizens can rarely assert an economic value in their identity to sustain a publicity claim.”⁸⁹ Nevertheless, the definition of “commercial use” leaves ample room for uncertainty and some courts have protected individuals in cases that arguably have no commercial factor. Moreover, this right has been viewed as functioning to protect celebrities by protecting their “brand,”⁹⁰ and this logic could extend to others who create a “brand” for themselves through social media.

The two different approaches to the law may create other barriers for plaintiffs. While the California approach presents its own challenges as mentioned above, the New York law may serve to hinder these actions further. The New York approach often enables defendants to “free-ride off” and take advantage of a celebrity’s identity, as many unauthorized appropriations of identity are deemed lawful under the statute.⁹¹ The statute contains a list of protectable aspects of identity, and, without any common law to supplement the statute, the list is exhaustive and final. Certain conduct that the California law would encompass, such as using phrases associated with a plaintiff or appropriating a “personality or style of performance” are not protected in New York.⁹² This limitation coupled with a broader newsworthiness exception in New York would likely result in non-celebrities having an even more restricted right of publicity or less of an ability to recover from a violation of that right.

More recently, *Fraley v. Facebook, Inc.*⁹³ highlighted the current issues posed by social media and offered an approach that courts could take in non-celebrity right of publicity cases. In 2011, a number of Facebook users filed a class action lawsuit after learning that Facebook had appropriated their identities for use in “Sponsored Stories,” which “appear on a member’s Facebook page, and which typically consist of another member’s name, profile picture, and an assertion that the person ‘likes’ the advertiser, coupled with the advertiser’s logo.”⁹⁴ Facebook relied on a number of defenses, including the argument that these stories were newsworthy and protected by the First Amendment since “(1) Plaintiffs are ‘public figures’ to their friends, and (2) ‘expressions of consumer opinion’ are generally newsworthy.”⁹⁵ Nevertheless, the court deemed the use commercial in nature and allowed the right of publicity claim to survive.⁹⁶

While the case was ultimately settled out of court, the issues it presented have many implications for the right of publicity going forward. By arguing that plaintiffs were public figures to their friends, Facebook tried to persuade the court that appropriation of their identities

would not violate any right of publicity because their interests were “newsworthy” to their friends. As non-celebrity individuals begin to have a larger presence on social media, more information about them will become available and easier for companies like Facebook to access and use. When Melville Nimmer outlined the reasons behind the emergence of the right of publicity, he explained that the right of publicity was inadequate because “well known personalities [...] do not seek the ‘solitude and privacy’” which the right of privacy sought to protect, but rather seek to prevent “[their] name, photograph, and likeness [from being] reproduced and publicized without [their] consent or without remuneration to [them].”⁹⁷ The same argument can be extended to Facebook users: even though they do not wish to seek privacy or hide certain information from their friends, they also do not wish to have their information used to endorse advertisers, products, services, or brands without their consent.

To broaden the reach of the right of publicity and lessen the burden of the economic value factor, courts should weigh an advertiser’s use of an image or other aspect of a person’s identity as demonstrating commercial worth. Everyday consumers and common individuals have become more attractive subjects for companies, retailers and advertisers, and they are recognizing the value of the consumer and consumer opinion in bolstering their brands and attracting other consumers.⁹⁸ Many successful marketing strategies involve incorporating consumer feedback into an advertising campaign or, as seen in the *Fraley* case, appealing to consumers by highlighting their peers’ and friends’ preferences.⁹⁹ Therefore, while a celebrity identity may be more valuable than that of an average person, it does not mean other identities have no commercial value at all.¹⁰⁰ Courts should adopt the view that the use of the identity in an advertisement serves as proof of its value,¹⁰¹ and award damages that seem appropriate in light of the person’s status and worth. A judge could choose to consider a number of factors in addition to the worth of the individual, including the impact and success of the advertisement, what the company would have been willing to pay a model for the advertisement, etc. Therefore, celebrities would still be entitled to a greater amount of relief. Leaving non-celebrities only with a right of privacy claim no longer provides an adequate remedy if the person is not distressed by the use of their identity but instead believes they should have been compensated.¹⁰² Requiring these individuals to rely on privacy claims¹⁰³ creates an unfortunate dichotomy, which perpetuates the outdated belief that celebrities are the only individuals who have commercially valuable identities and non-

celebrities should only seek protection when their privacy is infringed. Where it once might have been the case that the identities of celebrities were more likely to be exploited for advertising purposes and those of non-celebrities were more likely to appear in the news, this no longer is the case and courts should apply the right proportionally.

(Endnotes)

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¹ See Alicia M. Hunt, *Everyone Wants to Be a Star: Extensive Publicity Rights for Noncelebrities Unduly Restrict Commercial Speech*, 95 Nw. U. L. REV. 1605 (2001).

² Mark P. McKenna, *The Right of Publicity and Autonomous Self-Definition*, 67 U. PITT. L. REV. 225, 227 (2005).

³ See *id.* at 227-28.

⁴ See *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538 (1902). In this case, the defendant used a picture of a young woman on a poster advertising a flour brand without consent.

⁵ Note that the statute specified "living" person. See Carrie Rainen, *The Right of Publicity in the United States and the United Kingdom*, 12 NEW ENG. J. INT'L & COMP. L. 197, 200 (2005).

⁶ See *id.* at 200.

⁷ See *id.* at 201 (quoting *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905)).

⁸ See Stacey L. Dogan and Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1167 (2006).

⁹ See Rainen, *supra* note 5, at 202. See also Paul Czarota, *The Right of Publicity in New York and California: A Critical Analysis*, 19 VILL. SPORTS & ENT. L.J. 481, 489 (2012) (discussing Nimmer's differentiation between the right of privacy, which was designed to prohibit "offensive" publicity, and the need to protect when one's identity was appropriated without authorization in a "non-offensive" manner that affected the individual's economic interests).

¹⁰ See Rainen, *supra* note 5, at 201. See also McKenna, *supra* note 2, at 228.

¹¹ See Rainen, *supra* note 5, at 201-02.

¹² See *id.* at 202.

¹³ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953). In this case, two parties published baseball cards. While the plaintiff obtained exclusive contracts from the featured players granting permission to use their images on the cards, the defendant did not.

¹⁴ See *id.* (noting that these persons "would feel sorely deprived

if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways" and that providing this exclusive grant would be the only way to ensure that they would receive money from the use of their images).

¹⁵ See Jennifer L. Carpenter, *Internet Publication: The Case for an Expanded Right of Publicity for Non-Celebrities*, 6 VA. J. L. & TECH. 3, 10 (2001).

¹⁶ *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 503 U.S. 951 (1992). See also *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098-1100 (9th Cir. 1992) (holding that imitating Tom Waits' voice in a commercial violated his right of publicity).

¹⁷ See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397-99 (9th Cir. 1992). See also *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811-12 (9th Cir. 1997) (recognizing the viability of a claim that robots resembling George Wendt and John Ratzenberger violated those actors' rights of publicity). Note that in *White*, the robot in the advertisement was wearing a blonde wig and was depicted spinning a wheel, thus referencing Ms. White's job on the show "Wheel of Fortune."

¹⁸ See McKenna, *supra* note 2, at 232.

¹⁹ See *id.* at 232-33 (citing *Wendt v. Host Int'l, Inc.*, 125 F.3d 806 (9th Cir. 1997)); *McFarland v. Miller*, 14 F.3d 912, 914 (3d Cir. 1994); *White*, 971 F.2d at 1399).

²⁰ See Hunt, *supra* note 1, at 1607-08 (noting that the remedies "may include a preliminary injunction, an injunction, restitution, pecuniary damages, nonpecuniary damages, punitive damages, and attorney's costs and fees").

²¹ See Czarota, *supra* note 9, at 489-90 (citing *Gautier v. Pro-Football Inc.*, 107 N.E.2d 485 (N.Y. 1952)).

²² See Hunt, *supra* note 1, at 1606.

²³ Mark Bartholomew, *A Right Is Born: Celebrity, Property, and Postmodern Lawmaking*, 44 CONN. L. REV. 301, 303 (2011) (citing *Toffoloni v. LFP Publ'g Grp., LLC*, 572 F.3d 1201, 1205 (11th Cir. 2009)).

²⁴ Traci S. Jackson, *How Far Is Too Far? The Extension of the Right of Publicity to a Form of Intellectual Property Comparable to Trademark/Copyright*, 6 TUL. J. TECH. & INTELL. PROP. 181, 182 (2004).

²⁵ Barry M. Benjamin, *Commercial vs. Non-Commercial Speech: A Blurry Distinction*, CONN. L. TRIB. (Apr. 2, 2007) (quoting *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980)).

²⁶ See, e.g., *Kasky v. Nike, Inc.*, 27 Cal. 4th 939 (2002) (holding false statements made by Nike defending its foreign labor practices in press releases, and in letters to newspapers and university presidents, as commercial in nature, and agreeing with plaintiff's argument that this constituted a commercial transaction since Nike sought to promote the purchase of, or at least counteract the refusal to purchase, its goods); *Gorran v. Atkins Nutritionals, Inc.*, 464 F. Supp. 2d 315, 327 (S.D.N.Y. 2006) (finding that the Atkins book and website were "non-commercial" speech since they did more than propose a commercial transaction to promote and sell Atkins books and related products, but rather that they further promoted a type of lifestyle); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185-86 (9th Cir. 2001) (holding the Los Angeles Magazine's publication of a picture of Dustin Hoffman from the movie "Tootsie" in an article about fashion designs as "non-commercial" speech,



and rejecting the argument that the magazine used his image solely to bolster sales and garner attention); *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1001-02 (9th Cir. 2001) (finding “commercial” speech where Abercrombie & Fitch published old photos of former surfing champions in its magazine, relying on the fact that the catalog’s main goal was to sell merchandise even though it also included other content, such as news stories).

²⁷ 329 F.3d 437 (6th Cir. 2001).

²⁸ 110 S.W.3d 363 (Mo. 2003), *cert. denied*, 540 U.S. 1106 (2004).

²⁹ See McKenna, *supra* note 2, at 233 n.32. The test precludes a First Amendment defense where the commercial value outweighs any literary value.

³⁰ See Jackson, *supra* note 24, at 182-3.

³¹ See Czarnota, *supra* note 9, at 489 (citing Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 209 (1954)). Nimmer further noted that without the ability to assign or license a celebrity’s identity, the publicity value would be severely restricted.

³² Dogan, *supra* note 8, at 1166.

³³ See Jackson, *supra* note 24, at 184.

³⁴ See *id.*

³⁵ See Claire E. Gorman, *Publicity and Privacy Rights: Evening Out the Playing Field for Celebrities and Private Citizens in the Modern Game of Mass Media*, 53 DEPAUL L. REV. 1247, 1259-60 (2004) (noting that the twenty-eight states that recognize the right of publicity adhere to one of the two approaches); Czarnota, *supra* note 9, at 481.

³⁶ The law is codified in sections 50 and 51 of New York’s privacy statute. See N.Y. Civ. Rights Law §§ 50, 51. See also Gorman, *supra* note 35, at 1260 & n.97.

³⁷ There is a “newsworthiness” exception to the right of publicity, which was carved out to take into account First Amendment concerns and to ensure that the right of publicity did not create significant obstacles for the media. This exception applies in cases where a reasonable relationship exists between “the use of identity and the subject of the protected story.” See Hunt, *supra* note 1, at 1617. However, if the speech is commercial, the exception does not apply.

³⁸ See N.Y. Civ. Rights Law §§ 50, 51.

³⁹ See Cal. Civ. Code § 3344.

⁴⁰ See Czarnota, *supra* note 9, at 481.

⁴¹ See Gorman, *supra* note 35, at 1261.

⁴² Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125 (1993).

⁴³ *Id.* at 181.

⁴⁴ *Id.* at 206.

⁴⁵ *Id.* at 220-21.

⁴⁶ Note that in *Zacchini v. Scripps-Howard Broadcasting, Co.*, the Supreme Court used a hybrid justification, drawing upon both incentive and economic efficiency theory justifications in its holding. The court determined that an individual has the right “to reap the reward of his endeavors.” 433 U.S. 562, 573 (1977). It also stated that much of the value—in this case, of the plaintiff’s performance from being shot out of a cannon—“lies in the ‘right of exclusive control over the publicity given to his performance’” because “if the public can see the act free on television, it will be less willing to pay to see it at the fair.” *Id.* at 575.

⁴⁷ Madow, *supra* note 42, at 229.

⁴⁸ See Dogan, *supra* note 8, at 1163.

⁴⁹ See *id.* at 1167.

⁵⁰ See *id.* See also Carpenter, *supra* note 15, at 16; Roberta Rosenthal Kwall, *The Right of Publicity v. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L. J. 47, 91-92 (1994).

⁵¹ See Carpenter, *supra* note 15, at 16.

⁵² See Rainen, *supra* note 5, at 205.

⁵³ Lynne M. J. Boisineau, *Intellectual Property Law: The Right of Publicity and the Social Media Revolution*, AmericanBar.org, available at http://www.americanbar.org/publications/gp_solo/2013/may_june/intellectual_property_law_right_publicity_and_social_media_revolution.html. See also Gorman, *supra* note 35, at 1248 (“Although, in theory, noncelebrities have a right to publicity, this right is often neglected in practice.”).

⁵⁴ See Czarnota, *supra* note 9, at 482. See also Rainen, *supra* note 5, at 205 (citing 1 J. Thomas McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 4:1 (2d ed. 2001) (“[t]he fact that most reported right of publicity decisions involve ‘celebrity’ plaintiffs is a product of the economics of litigation, not of inherent legal rights.”)); Carpenter, *supra* note 15, at 5.

⁵⁵ See Carpenter, *supra* note 15, at 20.

⁵⁶ A plaintiff must prove commercial value to receive an award for damages. See Rainen, *supra* note 5, at 205-06. See also Carpenter, *supra* note 15, at 17.

⁵⁷ See Carpenter, *supra* note 15, at 18 (citing Thomas McCarthy: “Identity can be stolen and used to attract attention to an advertisement or product without giving rise to a valid claim of false endorsement. The identity of the famous person is used to cut through the clutter of advertising and to merely draw attention to the advertisement. If an appropriated identity were not identifiable to the publisher’s audience, the publication of that image would not serve the commercially valuable purpose of attracting attention.”).

⁵⁸ 891 F. Supp. 381 (W.D. Ky. 1995).

⁵⁹ 948 F. Supp. 40 (N.D. Ill. 1996).

⁶⁰ 498 F.2d 821 (9th Cir. 1974) (holding that when a famous race car driver’s unique car design was replicated in a television commercial, it was sufficiently recognizable to give that driver a claim under the right of publicity).

⁶¹ See *Cheatham v. Paisano Publ’ns, Inc.*, 891 F. Supp. 381 (W.D. Ky. 1995) (finding that the use of plaintiff’s image as an advertisement did not violate her right of publicity because the court had doubts that the plaintiff could prove sufficiently wide notoriety); *Pesina v. Midway Mfg. Co.*, 948 F. Supp. 40 (N.D. Ill. 1996) (holding that when plaintiff’s martial arts movements were used in video games without his authorization, though individuals who were familiar with plaintiff’s martial arts work would have recognized his movements, they were not sufficiently recognizable to a widespread audience).

⁶² See Carpenter, *supra* note 15, at 20.

⁶³ Efthymios Constantinides, Carlota Lorenzo Romero and Miguel A. Gómez Boria, *Social Media: A New Frontier for Retailers?*, 22 EUR. RETAIL RESEARCH 1, 6 (2008).

⁶⁴ Boisineau, *supra* note 53.

⁶⁵ *Id.*

⁶⁶ See Scott Slavick, *Out of bounds? Playing ball with celebrity right of publicity and fair use*, INSIDE COUNSEL (May 21, 2014), available at <http://www.insidecounsel.com/2014/05/21/out-of-bounds-playing-ball-with-celebrity-right-of?>page=2.

⁶⁷ Sheppard Mullin, *United States: Hashtagging Away Your Rights: Privacy And Publicity Rights In Social Media*, SHEPPARD MULLIN RICHTER & HAMPTON LLP, FASHION & APPAREL LAW BLOG (June 19, 2013), <http://www.mondaq.com/unitedstates/x/247776/Social+Media/Hashtagging+ Away+Your+Rights+Privacy+And+Publicity+Rights+In+Social+Media> (hereinafter “SHEPPARD MULLIN”).

⁶⁸ *State of the Media: The Social Media Report 2012*, THE NIELSEN COMPANY, 2 (Dec. 3, 2012), available at <http://www.nielsen.com/us/en/insights/reports/2012/state-of-the-media-the-social-media-report-2012.html>.

⁶⁹ Hashtags have become a way in which social media platforms filter their content. Consumers have the ability to identify the brand of the clothing they wear in photographs through a hashtag. When a person uses a hashtag, he or she is adding that post or photo to an archive associated with that particular category. See SHEPPARD MULLIN, *supra* note 67.

⁷⁰ For example, users can “repin” a post or image on Pinterest and “regram” a post on Instagram.

⁷¹ See Constantinides, *supra* note 63, at 5.

⁷² See SHEPPARD MULLIN, *supra* note 67.

⁷³ *Id.*

⁷⁴ Another aspect that some scholars consider when discussing the impact of social media on the right of publicity is the increasing number of ways the right can be violated. Lynne Boisineau provides the example of the number of ways a person’s “name” can currently be used, including “as a Twitter handle, as the profile name of a Facebook page, as a YouTube channel, as a character in a video game, or in the title of a smartphone app.” See Boisineau, *supra* note 53.

⁷⁵ See SXSW, http://schedule.sxsw.com/2015/events/event_IAP38967; Boisineau, *supra* note 53.

⁷⁶ For example, this year’s South by Southwest Festival (SXSW) convened a panel entitled, “Changing Face of Fame: Social Media Celebrities.” See *id.*

⁷⁷ Gorman, *supra* note 35, at 1248 (citing Todd Leopold, *How Much Reality TV Can We Survive?*, CNN, <http://www.cnn.com/2001/SHOWBIZ/TV/05/01/reality.tv/index.html> (last visited Jan. 21, 2004) (“discussing the prevalence of reality television programming, examining specific shows, and offering explanations for the unrelenting popularity of this brand of entertainment”).

⁷⁸ According to Gorman, the assertion and success of a claim, either in the publicity or privacy sphere, is often dependent on the status of the plaintiff rather than the interest at issue. See Gorman, *supra* note 35, at 1249.

⁷⁹ *Haelan Labs.*, 202 F.2d at 868.

⁸⁰ Boisineau, *supra* note 53.

⁸¹ See SHEPPARD MULLIN, *supra* note 67 (“California courts in particular have established that non-celebrities can claim economic injury when their likeness is used among people who recognize their image, including friends and family”) (citing *Fraley v. Facebook*, 830 F. Supp. 2d 785 (N.D. Cal. App. 2011)); see also Gorman, *supra* note 35, at 1248.

⁸² See Hunt, *supra* note 1, at 1623 (noting that the supreme courts in Georgia, Utah, Alabama, and Oregon strongly disfavor recovery by private individuals in right of publicity cases).

⁸³ See *id.* at 1611.

⁸⁴ In 1960 William Prosser wrote a law article proposing four

categories of violations under the invasion of privacy tort. These categories were adopted in the Restatement (Second) of Torts and encompass: “(1) unreasonable intrusion upon the seclusion of another, (2) misappropriation of name or likeness, (3) unreasonable publicity given to private life, and (4) publicity that unreasonably places another in false light before the public.” Hunt, *supra* note 1, at 1613. In her article, Alicia Hunt discusses how courts often blur the privacy misappropriation claim and the right of publicity claim. She argues that non-celebrities should not be covered by the right of publicity, but rather should be limited to privacy claims. See *id.* at 1609.

⁸⁵ Gorman, *supra* note 35, at 1248.

⁸⁶ See SHEPPARD MULLIN, *supra* note 67. Note that California statutory law requires proving that the defendant knowingly used the photo, and that a direct connection between the use and the commercial purpose exists. *Id.*

⁸⁷ “[C]ourts have adopted a concept of ‘commercial value’ that is erroneously and unnecessarily dependent upon the widespread identifiability of the plaintiff and the commercial purpose of the publication.” Carpenter, *supra* note 15, at 24.

⁸⁸ Hunt, *supra* note 1, at 1606.

⁸⁹ Gorman, *supra* note 35, at 1249.

⁹⁰ See Boisineau, *supra* note 53.

⁹¹ See Czarnota, *supra* note 9, at 514-15.

⁹² See *id.* at 514.

⁹³ 830 F. Supp. 2d 785 (N.D. Cal. 2011).

⁹⁴ *Id.* at 790.

⁹⁵ *Id.* at 804.

⁹⁶ See *id.* at 805.

⁹⁷ Nimmer, *supra* note 31, at 203-204.

⁹⁸ See Constantinides, *supra* note 63.

⁹⁹ See *Fraley*, 830 F. Supp. 2d at 791; Constantinides, *supra* note 63.

¹⁰⁰ See Gorman, *supra* note 35 at 1248 (citing Roberta Rosenthal Kwall, *Is Independence Day Dawning for the Right of Publicity?*, 17 U.C. DAVIS L. REV. 191, 202 (1983) (“Arguing for a ‘universal right of publicity,’ Professor Kwall explains that noncelebrity endorsement is a reality of modern advertising.”) *Id.* at n.10).

¹⁰¹ Many court holdings have acknowledged that the use of an individual’s identity by a defendant demonstrates its commercial value, irrespective of whether it has been exploited previously. See Carpenter, *supra* note 15, at 17 (citing *Motschenbacher*, 498 F.2d at 824 n.11; *Dora v. Frontline Video*, 15 Cal. App. 4th 536, 536 n.2 (1993); *Cheatham*, 891 F. Supp. at 386). But cf. Carpenter, *supra* note 15, at 25 (“Furthermore, the idea that a defendant’s use of a non-celebrity’s image, alone, shows that the image is commercially valuable which has typically been the most successful argument employed by non-celebrities to prove the commercial value of their personas may not apply in cases involving Internet publication because the costs of publication are negligible.”).

¹⁰² The right of privacy focuses on the “‘indignity and mental trauma incurred when one’s identity was widely disseminated in an unpermitted commercial use.’” See Hunt, *supra* note 1, at 1606 (quoting J. Thomas McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY* 1:7 (2d ed. 2000)).

¹⁰³ Note that “success in asserting a personal or emotional claim brought under the right of privacy is often unattainable absent a showing of an exclusively commercial use of identity.” Gorman, *supra* note 35, at 1249.

Supreme Court 2016-2017 IP Case Preview

By Sandra A. Hudak and Charles R. Macedo*

I. Introduction

The Supreme Court has continued to demonstrate considerable interest in intellectual property issues, as it has over the past several years, by granting writs of certiorari in five intellectual property cases for review this term (as of publication). The Court has invited the views of the Solicitor General in three other cases, and there are several other notable pending petitions awaiting a decision by the Court. The Amicus Brief Committee has already filed a brief in one of these matters and will continue to monitor and propose amicus curiae submissions, where appropriate, to be made to the Court(s).

II. Cases in Which the Petitions Were Granted

***Samsung Electronics Co. v. Apple Inc.*, No. 15-777 (cert. granted March 21, 2016; argued October 11, 2016)**

Issue: Patent Law – Design Patent Damages Calculation

Question Presented:

Where a design patent is applied to only a component of a product, should an award of infringer's profits be limited to those profits attributable to the component?

Under the Patent Act, “[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor. . . .” 35 U.S.C. § 171. And, if a design patent is infringed, by an infringer “(1) appl[ying] the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sell[ing] or expos[ing] for sale any article of manufacture to which such design or colorable imitation has been applied,” the infringer “shall be liable to the owner to the extent of his **total profit**.” 35 U.S.C. § 289 (emphasis added).

Respondent Apple sued Petitioner Samsung in April 2011, alleging infringement of, *inter alia*, three design patents that claim certain design elements embodied in Apple's iPhone. *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 989 (Fed. Cir. 2015). Those patents claim (i) design elements on the front face of an iPhone, including the black rectangular round-cornered front screen face; (ii) another set of features that include the front face as well as the bezel; and (iii) “the ornamental design for a

graphical user interface for a display screen or portion thereof,” which depicts rows of colorful icons with rounded corners. *Id.* at 996-97.

The district court upheld the jury's verdict that Samsung infringed these three design patents, and the Federal Circuit affirmed the district court's denial of Samsung's motion for judgment as a matter of law on design patent infringement and Samsung's alternative motion for a new trial. *Id.* at 989-90. Samsung also appealed the damages award, arguing that the district court legally erred in allowing the jury to award Samsung's **entire** profits on its infringing smartphones. *Id.* at 1001.

The Federal Circuit rejected Samsung's arguments that (i) the damages should have been limited to the profit attributable to the infringing design, as opposed to other attributes of the phones, because of “basic causation principles” or (ii) the profits awarded should have been limited to the infringing “article of manufacture,” not the entire infringing product. *Id.* at 1001-02.

With regard to the first argument, the Federal Circuit held that the “clear statutory language” of Section 289, which states that an infringer “shall be liable to the owner to the extent of [the infringer's] total profit,” prevented the court from applying an “apportionment” requirement to design patent damages. *Id.* The Federal Circuit explained that Congress had expressly rejected such an apportionment requirement in the Act of 1887, which was subsequently codified in Section 289 in the Patent Act of 1952. *Id.* at 1001. The Federal Circuit noted that any policy arguments as to whether a design patent infringer **should** be liable for its entire profits must be directed to Congress. *Id.* at 1003 n.1.

With regard to Samsung's second argument, the Federal Circuit held that the facts of the case did not require the damages for design patent infringement to be limited to “the portion of the product as sold that incorporates or embodies the subject matter of the patent” as Samsung contended. *Id.* at 1002. The Federal Circuit reasoned that the facts of the case were distinguishable from cases in which profits were limited to “articles of manufacture” that were components of the final product as sold (e.g., a piano case sold with a piano), because “[t]he innards of Samsung's smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers.” *Id.* Thus, the Federal Circuit agreed with the district court that there was no legal error in the jury instruction on the design patent damages and affirmed the damages awarded

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for design patent infringements (i.e., Samsung's entire profits from the infringing phones). *Id.* The Federal Circuit denied Samsung's petition for en banc rehearing.

On March 21, 2016, the Supreme Court granted Samsung's petition for certiorari, but limited the Supreme Court's review to the second question presented by Samsung, regarding design patent damages. In its opening brief, Samsung argued that the "Federal Circuit's entire-profits rule conflicts with the text, history, and purpose of Section 289." Brief for Petitioners at 1. It argued that, although Section 289 provides that a design-patent infringer may be liable "to the extent of his total profit," that remedy is limited to the total profit attributable to the "article of manufacture" to which an infringing design is "applied," which can be a part of a product made up of multiple "articles of manufacture." *Id.* at 24-25. It also reiterated its apportionment argument by asserting that Section 289 limits the total profit recoverable to that "made from the infringement," which, pursuant to "background principles of causation and equity," is limited to profit attributable to infringement of the patented design. *Id.* at 25. Samsung also warned that the "Federal Circuit's automatic entire-profits rule" would have detrimental consequences, such as discouraging innovation by making design patents more valuable than utility patents. *Id.* at 26.

Respondent Apple countered Samsung's "apportionment" arguments by pointing to the legislative history of Section 289. Brief for Respondent at 26. It explained that Congress adopted the "total profit" remedy for design patent infringement in response to the *Dobson* decisions, in which the patentees were awarded nominal damages only because they were unable to establish the portion of their lost profits that was attributable to the patented design of a carpet, as opposed to the unpatented aspects of the carpet. *Id.* at 17. Congress reacted with a "new rule of recovery for design patents," and permitted the patentee to recover the infringer's entire profit because, although the design "sells the article," it was difficult for patentees to establish the portion of an infringer's profit that was "directly due to the appearance of those articles as distinguished from their material, their fabric, [and] their utility." *Id.* at 17-18; S. Rep. No. 49-206 (1886); H.R. Rep. No. 49-1966, at 2 (1886).

Apple agreed with Samsung that an "article of manufacture" need not be an entire product as sold, and could instead be a component of a product. Brief for Respondent at 35. However, Apple asserted that determining the relevant "article of manufacture" on which the infringer's "total profit" should be awarded is a factual question for the jury, and that "[t]he defendant

bears the burden of establishing that the infringing 'article of manufacture' is anything less than the product as sold." *Id.* at 26. Apple argued that no remand was necessary because, *inter alia*, Samsung failed to offer evidence that the infringing "articles of manufacture" were anything less than Samsung's entire smartphones. *Id.* Apple argued that Samsung's policy concerns were unpersuasive, especially since the total profit remedy has been in place for over 130 years. *Id.* at 27-28.

The Solicitor General argued on behalf of the United States that Section 289 does not allow for apportionment, but that an article of manufacture can be a component of a multi-component product. Brief for the United States as Amicus Curiae Supporting Neither Party at 11-13, 17-19. The United States advocated for a remand because the jury instructions equated the relevant "article of manufacture" with the accused phones as a whole, rather than permitting the jury to determine whether the phone itself or some portion thereof was the "article of manufacture" to which the patented design had been applied. *Id.* at 31-33. In addition to the Solicitor General's brief, twenty-one amicus briefs were filed.

***Star Athletica, LLC v. Varsity Brands, Inc.*, No. 15-866 (cert. granted May 2, 2016; argued October 31, 2016)**

Issue: Copyright Law – Useful Article Exception

Question Presented:

What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?

The Copyright Act imposes limitations on the copyrightability of "useful articles." A "useful article" is "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. Under the Copyright Act, "the design of a useful article . . . shall be considered a pictorial, graphic, or sculptural work **only if, and only to the extent that**, such design incorporates pictorial, graphic, or sculptural features that **can be identified separately from, and are capable of existing independently of**, the utilitarian aspects of the article." *Id.* (emphasis added). Pursuant to Section 113(a), "the exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work . . . includes the right to reproduce the work in or on any kind of article, whether useful or otherwise."

Respondent Varsity Brands ("Varsity") sued Petitioner Star Athletica for copyright infringement of five registrations for "two-dimensional" artwork for cheerleading uniform designs. *Varsity Brands, Inc. v.*

Star Athletica, LLC, 799 F. 3d 468, 474 (6th Cir. 2015). Varsity had submitted drawings and photographs of cheerleading uniforms as the deposit copies it was required to file when filing for these registrations.

The district court granted *Star Athletica*'s summary judgment motion for non-infringement, finding that Varsity's asserted works were not subject to copyright protection because they were designs of useful articles (i.e., cheerleading uniforms) that lacked any pictorial, graphic, or sculptural ("PGS") features that could be "identified separately from" or were "capable of existing independently of" the utilitarian aspects of the articles. *Varsity Brands, Inc. v. Star Athletica, LLC*, No. 10-2508, 2014 U.S. Dist. LEXIS 26279, at *26 (W.D. Tenn. Mar. 1, 2014). The district court found that "the utilitarian function of a cheerleading uniform is not merely to clothe the body; it is to clothe the body in a way that evokes the concept of cheerleading," and thus the "the colors-and-designs component of a cheerleading uniform cannot be conceptually separated from the utilitarian object itself." *Id.*, at *2-3, *24.

The Court of Appeals for the Sixth Circuit reversed and remanded, using a five-step approach to determine that Varsity's asserted works, if sufficiently original, qualified for copyright protection. The Sixth Circuit explained that courts have struggled with the appropriate test for determining whether PGS features "incorporated into the design of a useful article 'can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article' when those features cannot be removed physically from the useful article" (like they can be for, e.g., artwork printed on a T-shirt). *Varsity Brands*, 799 F. 3d at 484. To illustrate, the Sixth Circuit listed nine different approaches that have been proposed or used by courts and scholars:

(1) **The Copyright Office's Approach:** "A [PGS] feature satisfies [the conceptual-separability] requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article."

(2) **The Primary-Subsidiary Approach:** A [PGS] feature is conceptually separable if the artistic features of the design are "primary" to the "subsidiary utilitarian function."

(3) **The Objectively Necessary Approach:** A [PGS] feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article.

(4) **The Ordinary-Observer Approach:** A [PGS] feature is conceptually separable if "the design creates in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously."

(5) **The Design-Process Approach:** A [PGS] feature is conceptually separable if the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences."

(6) **The Stand-Alone Approach:** A [PGS] feature is conceptually separable if "the useful article's functionality remain[s] intact once the copyrightable material is separated."

(7) **The Likelihood-of-Marketability Approach:** A [PGS] feature is conceptually separable if "there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities."

(8) **Patry's Approach:** There no need to engage in a separability analysis if (A) the work is the design of a three-dimensional article, and (B) the design is not of a "useful article." When determining whether [PGS] features are protectable under the Copyright Act, the focus should be on whether those [PGS] aspects are separable from the "utilitarian *aspects*" of the article, not the "article" because "the protected features need not be capable of existing apart from the article, only from its functional aspects." This task requires two additional steps. First, the court "must be able to discern [PGS] features." Second, the [PGS] features "must be capable of existing as *intangible* features independent of the utilitarian *aspects* of the useful article, not independent of the whole article. . . ." This necessitates asking "whether the [PGS] features are dictated by the form or function of the utilitarian aspects of the useful article." If form or function—rather than aesthetics—dictates the way that the [PGS] features appear, then those [PGS] features are not capable of existing independently of the utilitarian aspects of the useful article.

(9) **The Subjective-Objective Approach:** Conceptual separability is determined by balancing (A) "the degree to which the designer's subjective process is motivated by aesthetic concerns"; and (B) "the degree to which the design of a useful article is objectively dictated

by its utilitarian function.” “The first factor requires courts to consider the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer.” The second factor considers whether “the design is mostly dictated by function” or “hardly dictated by function at all.” If the design of the useful article “is mostly dictated by function,” then that fact “weigh[s] against conceptual separability, and therefore, against copyright protection.” If the design “is hardly dictated by function at all” then that fact “weigh[s] in favor of a finding of conceptual separability.”

Id. at 484-85 (internal citations and footnotes omitted). After discussing these approaches, the Sixth Circuit decided on its own five-step approach:

- (1) “Is the design a [PGS] work?”
- (2) “If the design is a PGS work, then is it a design of a useful article—‘an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information’?”
- (3) “What are the utilitarian aspects of the useful article?”
- (4) “Can the viewer of the design identify ‘[PGS]’ features ‘separately from ... the utilitarian aspects of the [useful] article[?]’?”
- (5) “Can the ‘[PGS]’ features of the design of the useful article ‘exist[] independently of[] the utilitarian aspects of the [useful] article’?”

Id. at 487-88. Using this approach, the Sixth Circuit found that (i) Varsity’s asserted works were two-dimensional works of graphic art and thus PGS works; (ii) the asserted works were designs of useful articles (i.e., cheerleading uniforms); (iii) the utilitarian aspects of cheerleading uniforms are to “cover the body, wick away moisture, and withstand the rigors of athletic movements,” and not to “identify the wearer as a cheerleader and a member of a cheerleading team” nor to serve a “decorative function”; (iv) the “graphic features of Varsity’s designs—the arrangement of stripes, chevrons, zigzags, and color-blocking” are separate from the utilitarian aspects because they “do not enhance the cheerleading uniform’s functionality *qua* clothing” since “[a] plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip”; and (v) the arrangement of stripes, chevrons, color blocks, and zigzags exist independently of the utilitarian aspects of a cheerleading uniform. *Id.* at 489–92. Judge McKeague dissented, explaining that the utilitarian function of a cheerleading uniform includes “serv[ing] to identify the wearer as a cheerleader” and agreed with the district court that the reasonable observer would not

associate a blank white pleated skirt and crop top with cheerleading. *Id.* at 495 (McKeague, J., dissenting).

Petitioner Star Athletica argued that “Congress did not intend to grant a century of monopoly protection” to garment designs under copyright law, which is demonstrated by its deliberate exclusion of industrial-design protection from the Copyright Act and its history of repeatedly refusing to extend copyright protection to garment design. Brief for the Petitioner at 22. Star Athletica proposed a test in which the court determines (i) whether the work is a design of a useful article; (ii) all of the article’s inherent, essential, or natural functions; (iii) whether a feature of a useful article can be recognized as a unit by itself, apart from the utilitarian aspects; and (iv) whether the artistic feature and the useful article could both exist side by side as fully separate works (i.e., an artistic work and a useful article). *Id.* at 38-39. It also argued that a close case should be decided against copyrightability. *Id.* at 39.

Respondent Varsity argued that separability exists when the artistic feature is *either* physically or conceptually separable from the useful article. Brief for the Respondents at 23. It also argued that two-dimensional artwork on useful articles is inherently separable, and that the same rule governs two-dimensional artwork on clothing as on any other useful article. *Id.* at 24-28. In response to Star Athletica’s arguments that cheerleading uniforms serve the utilitarian functions of identifying the wearer as a cheerleader and that certain designs are used to make the wearer appear more attractive, Varsity argued that conveying information and enhancing appearance are not utilitarian functions. *Id.* at 42-43. It also argued that its works “are not designs *of* useful articles” but instead “are designs that appear *on* useful articles,” and that their designs have not only been used on cheerleading uniforms but on warm-ups and jackets as well. *Id.* at 18 (emphasis in original).

The Solicitor General submitted a brief on behalf of the United States, arguing that Varsity’s works, if sufficiently original, are copyrightable. Brief for the United States as Amicus Curiae Supporting Respondents at 13. The United States argued that the Copyright Act, embodying principles recognized by the Supreme Court in *Mazer v. Stein*, 347 U.S. 201 (1954), and Copyright Office practice, treats a garment with two-dimensional surface decoration as having two distinct components, i.e., the surface decoration and the garment itself, which is used as the medium for the decoration. *Id.* at 13-14. Because it was not disputed that the deposit drawings were copyrightable, the United States argued that respondents have the exclusive right under Section 113(a) to reproduce the decorations depicted in the drawings on any medium of display, including any type of garment. *Id.* at 14.

On July 22, 2016, the NYIPLA filed an amicus curiae brief in support of neither party, in which it took no position with regard to the dispute between the parties, but disagreed with the Sixth Circuit’s analytical framework. In its brief, the Association proposed an alternate framework, arguing that a proper analysis of copyrightability must begin with consideration of the claimed design at issue, rather than with an analysis of the utilitarian features of the article embodying that design. Brief of *Amicus Curiae* New York Intellectual Property Law Association in Support of Neither Party at 6. Further, while the Association recognized that there is not necessarily only one correct test for conceptual separability, certain tests are particularly inefficient, inconsistent, and likely to yield unpredictable results. *Id.* at 5. Specifically, the Association eschewed tests with overly subjective elements. Instead, the Association recommended adoption of a test in which the inquiry is limited to analysis of the design and article at issue. *Id.* at 6-7. The NYIPLA brief was a collaboration of the Copyright Law & Practice Committee and the Amicus Brief Committee. Lauren B. Emerson (Co-Chair of the Committee on Copyright Law & Practice, Baker Botts LLP) was counsel of record, and Julie B. Albert (Baker Botts LLP), NYIPLA President Walter E. Hanley, Jr. (Andrews Kurth Kenyon LLP), Charles R. Macedo (Amster, Rothstein & Ebenstein LLP), David P. Goldberg (Co-Chair of the Amicus Brief Committee, Amster, Rothstein & Ebenstein LLP), Joseph Farco (Co-Chair of the Committee on Copyright Law & Practice, Locke Lord LLP), Mitchell C. Stein (Sullivan & Worcester LLP), and Nick Bartelt, Emily C. and John E. Hansen (Intellectual Property Law Institute Inc.) also participated on the brief.

In addition to the Solicitor General’s and the Association’s brief, eleven other amicus briefs were filed.

***SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC*, No. 15-927 (cert. granted May 2, 2016; argued November 1, 2016)**

Issue: Patent Law – Laches Defense

Question Presented:

Whether and to what extent the defense of laches may bar a claim for patent infringement brought within the Patent Act’s six-year statutory limitations period, 35 U.S.C. § 286.

Disclosure: Amster Rothstein & Ebenstein LLP is counsel to the Respondents in this case.

For over 120 years, laches has been a recognized defense in patent law. The Supreme Court used the doctrine of laches to bar a patent infringement suit in

Lane & Bodley Co. v. Locke, 150 U.S. 193 (1893), and laches has been consistently available as a defense to patent infringement ever since. In 1992, the full bench of the Federal Circuit expressly considered the issue of whether laches is an available defense, and confirmed that laches is an available defense under 35 U.S.C. § 282 of the 1952 Patent Act, which provides for an “unenforceability” defense. *A. C. Aukerman Co. v. R. L. Chaides Constr. Co.*, 960 F.2d 1020, 1028 (Fed. Cir. 1992)(en banc). The *Aukerman* court also confirmed that a court may bar pre-filing damages if the two elements of laches are met: (a) the patentee’s delay in bringing suit was unreasonable and inexcusable and (b) the alleged infringer suffered material prejudice attributable to the delay. *Id.*

SCA and First Quality are competitors in the market for adult incontinence products. On October 31, 2003, SCA sent a letter accusing First Quality of making and selling protective underwear products that infringed SCA’s U.S. Patent No. 6,375,646 (“the ‘646 patent”). *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 807 F.3d 1311, 1315 (Fed. Cir. 2015). Three weeks later, First Quality responded to SCA with a letter explaining that First Quality’s products did not and could not infringe the ‘646 patent because that patent is invalid in light of a prior art patent (“Watanabe”). *Id.* First Quality heard nothing further from SCA regarding this patent until SCA sued First Quality nearly seven years later on August 2, 2010. *Id.* at 1316. On August 16, 2013, the Western District of Kentucky granted First Quality’s motion for summary judgment of laches and estoppel. *Id.*

SCA appealed this decision and, before the Federal Circuit panel issued its decision, the Supreme Court issued its decision in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1662 (2014), regarding the laches defense in copyright law. The majority opinion in *Petrella* held that, “in face of a statute of limitations enacted by Congress,” such as Section 507(b) of the Copyright Act, “laches cannot be invoked to bar legal relief.” 134 S. Ct. at 1674. *Petrella* so held because “courts are not at liberty to jettison Congress’ judgment on the timeliness of suit.” *Id.* at 1667. *Petrella* confirmed that laches is typically understood to play a “gap-filling” role, where no statute of limitations has been enacted. *Id.* at 1674. It also confirmed, however, that a plaintiff’s delay may always be considered in determining the award of equitable remedies, such as injunctive relief and the infringer’s profits. *Id.* at 1667. Three Justices dissented from the majority opinion in *Petrella*, criticizing the majority holding for disabling courts from addressing the inequity that results from a plaintiff’s laches and arguing, *inter alia*, that “permitting laches to apply to

copyright claims seeking equitable relief but not to those seeking legal relief . . . places insufficient weight upon the rules and practice of modern litigation.” *Id.* at 1985 (Breyer, J., dissenting).

SCA argued to the Federal Circuit panel that the logic of *Petrella* compelled a finding that the en banc *Aukerman* decision was no longer good law, and that laches was no longer available as a defense in patent law. *SCA Hygiene Prods.*, 807 F.3d at 1317. SCA argued that 35 U.S.C. § 286 was analogous to Section 507(b) of the Copyright Act. Section 286, entitled “Time Limitation on Damages,” provides in relevant part: “Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”

The Federal Circuit panel rejected SCA’s argument and held that “*Petrella* [notably] left *Aukerman* intact,” citing a footnote in *Petrella* explaining that the Supreme Court had “not had occasion to review the Federal Circuit’s position” that “laches can bar damages incurred prior to the commencement of suit, but not injunctive relief” in patent law, “[b]ased in part on § 282 and commentary thereon, legislative history, and historical practice.” *See id.* at 1321 (citing *Petrella*, 134 S. Ct. at 1974 n.15). SCA petitioned for en banc rehearing, which the Federal Circuit granted, requesting briefing on two issues: (i) whether *Aukerman* should be overruled and (ii) whether laches should be available under some circumstances to bar an entire infringement suit for either damages or injunctive relief, rather than just pre-filing damages. *Id.* at 1317.

In a 6-5 opinion, the en banc SCA court agreed with First Quality that Congress codified a laches defense in Section 282 and that the laches defense applied to legal, as well as equitable, remedies. *Id.* at 1315. Thus, it held that the separation-of-powers issue governing the outcome of *Petrella* is inapplicable in patent law, just as it is inapplicable to the Lanham Act, which statutorily provides for a laches defense. *Id.* at 1329. In addition to confirming that laches remains a defense to legal relief in patent law after *Petrella*, the court reexamined its earlier precedent as to the effect of a laches defense in patent law. The court held that laches (i) bars legal relief; (ii) must be weighed under the *eBay* framework with respect to an injunction; and (iii) in some cases (e.g., where there are “extraordinary circumstances”) precludes an ongoing royalty. *Id.* at 1331-32. The dissent “agree[d] with the majority that laches is available to bar equitable relief” and that laches may be applied, in some cases, to bar prospective relief. *Id.* at 1333 n.1 (Hughes, J., dissenting in part). However, the dissent criticized the majority for “adopt[ing] a patent-specific approach to the equitable doctrine of

laches,” i.e., that “Congress adopted the view of some lower courts that laches could bar legal relief in *patent cases*” and “ignored the Supreme Court,” which had already recognized in 1952 “the common-law principle that laches cannot bar a claim for legal damages.” *Id.* at 1333 (emphasis added). The Supreme Court granted certiorari on May 2, 2016.

Petitioner SCA argued that Section 286 is controlling and that, in light of *Petrella*, the equitable doctrine of laches may not constrict a statutory limitations period applicable to legal claims. Brief for Petitioners at 17-18. SCA argued that Section 282, which provides for, *inter alia*, an “unenforceability” defense, does not authorize courts to shorten Section 286’s six-year time period because Section 282 speaks in general terms and never mentions laches. *Id.* at 19. It asserted that the unenforceability defense that was codified by the 1952 Patent Act in Section 282 should not be interpreted to include the defense of laches, because there was no settled practice of using laches to bar damages claims in patent law before 1952. *Id.* SCA argued that, instead, the controlling precedents are the Supreme Court’s pre-1952 cases that stated that laches cannot be used to shorten statutory limitations periods for actions at law. *Id.* It also argued that a laches defense would upset the purpose of Section 286, which is to create a clear, predictable, and uniform timeliness rule for patent law. *Id.* at 19-20.

Respondent First Quality argued that Congress codified the laches defense as a defense to damages claims in Section 282 of the 1952 Patent Act. Brief for Respondents at 13. First Quality explained that every circuit that had considered the issue had recognized laches as an available defense prior to 1952, and that laches was used to bar not just equitable remedies, but also legal damages both before and after the merger of law and equity in 1938. *Id.* at 13-14. It further explained that Section 282 was intended to codify the existing unenforceability defenses. *Id.* at 14. First Quality pointed out that Congress has altered the Patent Act repeatedly since 1952, but has never disturbed the laches defense, and that any changes should be left to Congress. *Id.* First Quality also explained that the statutory and practical differences between copyright and patent law illustrate why Congress chose to retain laches as a defense in patent law. *Id.* at 15. For example, First Quality clarified that Section 286 is not a statute of limitations and thus does not account for a plaintiff’s delay, leaving a gap to be filled by laches. *Id.* It pointed out several other critical differences, including that Congress chose to impose liability for “innocent” infringement under the Patent Act but not the Copyright Act, and the life of a patent (20 years) is significantly shorter than the copyright term. *Id.* at 45.

Eleven amicus briefs were filed on the merits in support of upholding the laches defense in patent law, and six were filed in support of eliminating the defense.

There are pending petitions for certiorari in *Medinol Ltd. v. Cordis Corp.*, No. 15-998, and *Romag Fasteners, Inc. v. Fossil, Inc.*, No. 16-202, regarding the same issue as is raised in this case.

***Life Technologies Corp. v. Promega Corp.*, No. 14-1538 (cert. granted June 27, 2016; briefing ongoing)**

Issue: Patent Law – Induced Infringement

Question Presented:

Whether the Federal Circuit erred in holding that supplying a single, commodity component of a multi-component invention from the United States is an infringing act under 35 U.S.C. § 271(f)(1), exposing the manufacturer to liability for all worldwide sales.

Under 35 U.S.C. § 271(f), a party may infringe a patent based on its participation in activity that occurs both inside and outside the United States. Specifically:

(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a ***substantial portion of the components*** of a patented invention, where such components are uncombined in whole or in part, in such manner as to ***actively induce the combination of such components*** outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

35 U.S.C. § 271(f) (emphasis added).

LifeTech manufactures genetic testing kits, which include multiple components. In 2010, Promega sued LifeTech for patent infringement. LifeTech’s accused genetic testing kits include a (1) primer mix, (2) a

polymerase chain reaction (PCR) mix, (3) a buffer solution, (4) control DNA, and (5) a polymerase (*Taq*), which is necessary for the PCR amplification. *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1344 (Fed. Cir. 2014). LifeTech manufactures the *Taq* polymerase component in the United States. *Id.* LifeTech then ships this component to its facility in the United Kingdom for incorporation into its accused genetic testing kits, which are sold worldwide, including in the United States. *Id.* At the district court, the jury awarded damages for infringement under Section 271(f), but the district court judge granted LifeTech’s motion for JMOL and reversed. *Id.* at 1345. The district court judge found that Promega failed to prove infringement under Section 271(f)(1) because (i) Section 271(f)(1) requires the involvement of another, unrelated party to “actively induce the combination of components” and that no other party was involved in LifeTech’s assembly of the accused kits, and (ii) a “substantial portion of the components” requires at least two components to be supplied from the United States and that LifeTech supplied only a single component—the *Taq* polymerase—from the United States.” *Id.* at 1351.

The Federal Circuit reversed. *Id.* at 1358. With regard to the first point, the Federal Circuit found that the requirement that the Section 271(f)(1) infringer “actively induce the combination” only requires specific intent to cause the combination of the components of a patented invention outside the United States and does not require a third party. *Id.* at 1351. One of the panel judges disagreed with this conclusion and filed a dissenting opinion. *Id.* at 1358-60 (Prost, J., dissenting in part).

With regard to the second point—whether Section 271(f)(1) requires at least two components to be supplied from the United States—the Federal Circuit held that there are circumstances in which a party may be liable under Section 271(f)(1) for supplying or causing to be supplied a ***single*** component for combination outside the United States if that component is, for example, important or essential to the invention. *Id.* at 1356. The Federal Circuit held that there was substantial evidence to support the jury’s verdict that the *Taq* polymerase is a “substantial portion” of the components of LifeTech’s accused genetic testing kits because the kits would be inoperable without that component and LifeTech’s own witness admitted that the component was one of the “main” and “major” components. *Id.*

After the parties filed their briefing on the certiorari petition, the Supreme Court invited the views of the Solicitor General, who argued that certiorari should be granted on the second question (the “substantial component” requirement) but not on the first question (whether the “actively induced” requirement required a

third party or whether LifeTech could “induce” itself). Brief for the United States as Amicus Curiae at 15. The Supreme Court heeded this advice and granted certiorari as to the second issue only.

In its merits brief, the Solicitor General argued that the statutory text of Section 271(f)(1) requires at least two components to be supplied from the United States. *Id.* at 8-9. The brief contrasts the two paragraphs of Section 271(f) to support that conclusion, as well as the statutory purpose, practical considerations, and presumption against extraterritoriality. *Id.* at 17-30. Petitioner LifeTech made similar arguments.

Six other amici submitted briefs, representing views from both sides of the debate.

***Lee v. Tam*, No. 15-1293 (cert. granted September 29, 2016; briefing ongoing)**

Issue: Trademark Law – Disparaging Trademarks

Question Presented:

Whether the disparagement provision in 15 U.S.C. 1052(a) is facially invalid under the Free Speech Clause of the First Amendment.

Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), provides that no trademark “shall be refused registration . . . on account of its nature unless it,” *inter alia*, “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

Respondent Mr. Simon Shiao Tam is the “front man” for the Asian-American dance-rock band “The Slants,” which Mr. Tam so named to “reclaim” and “take ownership” of Asian stereotypes. *In re Tam*, 808 F.3d 1321, 1331 (Fed. Cir. 2015). On November 14, 2011, Mr. Tam filed an application to register the mark THE SLANTS, but the examiner refused to register the mark, finding it likely disparaging to “persons of Asian descent” under Section 2(a). *Id.* The Trademark Trial and Appeal Board affirmed the examiner’s rejection. *Id.* at 1332. A panel of the Federal Circuit then affirmed the Board’s determination that the mark is disparaging and its affirmance of the rejection. The Federal Circuit held that Mr. Tam’s arguments that Section 2(a) violates the First Amendment were foreclosed by the binding precedent of *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), which held that Section 2(a) does not implicate the First Amendment because a refusal to register a mark does not bar the applicant from using the mark. *Id.* at 1333. The Federal Circuit sua sponte ordered rehearing en banc because, *inter alia*, First Amendment jurisprudence had evolved significantly since *McGinley*

was decided over 30 years ago, and the *McGinley* opinion had been “widely criticized.” *Id.* at 1333-34.

At the en banc level, a majority of the Federal Circuit held Section 2(a)’s prohibition against the registration of “disparaging” trademarks to be a violation of the First Amendment. *Id.* at 1328. First, it found Section 2(a) to be subject to “strict scrutiny” because it concerns private expressive speech, not commercial speech. *Id.* at 1339-40. The majority then held that, even though Section 2(a) does not prohibit use of the mark altogether, Section 2(a) does not survive strict scrutiny because the federal registration of trademarks offers valuable substantive and procedural rights to trademark owners, and Section 2(a) denies those important legal rights based on disapproval of the message conveyed by the mark: a “viewpoint-discriminatory regulation.” *Id.* at 1345-52. The majority also rejected the PTO’s arguments that trademark registration is government speech or a form of government subsidy that the government may refuse where it disapproves of the message a mark conveys. *Id.* at 1345-55. Finally, the majority held that, even if Section 2(a) regulated “commercial speech” rather than expressive speech and was thus subject to intermediate scrutiny, it would still fail to survive. *Id.* at 1355-57. The majority found that the entire interest of the government in Section 2(a) depends on disapproval of the message, which was insufficient to satisfy the substantial government interest requirement for intermediate scrutiny. *Id.* at 1357.

There were four additional opinions. One concurred, asserting that Section 2(a) is also unconstitutional under the Fifth Amendment for being too vague. *Id.* at 1358. Another opinion concurred in part with the result, asserting that Section 2(a) regulates both commercial and expressive speech depending on the mark and, while the statute is constitutional as applied to “purely commercial trademarks,” it is not constitutional as applied to marks that concern “core political speech” like Mr. Tam’s. *Id.* at 1363-64. However, it dissented from the majority, agreeing with the PTO’s position that trademark registration amounts to a subsidy, which “may be content based” (although Section 2(a) is “viewpoint neutral”). *Id.* at 1368. It argued that the government’s interest in protecting disparaged groups was sufficient for this regulation. *Id.* at 1372. The additional dissenting opinions agreed with this discussion of commercial speech, and further argued, *inter alia*, that *stare decisis* favors upholding the statute; the government has a substantial interest in the orderly flow of commerce; and federal registration may be restricted as government speech because registration imparts the “imprimatur” of the federal government on a mark. *Id.* at 1375.

Amicus Pro-Football, Inc. submitted a brief in support of the PTO’s certiorari petition, arguing that the Federal Circuit majority decision that Section 2(a) is unconstitutional was correct. Pro-Football has a strong interest in the case due to its own litigation over this issue, in which the Eastern District of Virginia found six of its trademarks including the term REDSKINS used by the Washington Redskins professional football team were properly canceled by the TTAB under Section 2(a), and that Section 2(a) is constitutional under the First and Fifth Amendments. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015). Amicus Pro-Football urged the court to grant Pro-Football’s certiorari petition rather than the PTO’s; however, Pro-Football’s certiorari petition was denied a few days after the Supreme Court granted certiorari in *Lee v. Tam*.

III. Pending Petitions with Calls for the Views of the Solicitor General

***SmithKline Beecham Corp., D/B/A GlaxoSmithKline v. King Drug Co. of Florence, Inc.*, No. 15-1055 (petition filed February 19, 2016; SG brief filed October 3, 2016)**

Issue: Antitrust – Reverse Payments

Question Presented:

In *FTC v. Actavis*, 133 S. Ct. 2223 (2013), the Supreme Court held that a patentee who settles a patent challenge by making a “large” and “unexplained” reverse payment to the patent challenger is not protected by the antitrust immunity generally afforded to patentees.

The question presented is:

Whether the Third Circuit’s sweeping holding that a patentee’s grant of an exclusive license must undergo antitrust scrutiny by courts and juries—even though such a license is specifically permitted under the patent laws—is inconsistent with this Court’s decision in *Actavis* and decades of this Court’s earlier precedents.

Petition for a Writ of Certiorari at i.

***Sandoz Inc. v. Amgen Inc.*, No. 15-1039 (petition filed February 16, 2016; SG brief invited June 20, 2016)**

Issue: Patent Law – BPCIA: Notice of Commercial Marking

Questions Presented:

In the Biologics Price Competition and Innovation Act of 2009 (“BPCIA”), Congress created an abbreviated regulatory pathway for the Food and Drug Administration (“FDA”) to license “biosimilar” products—i.e., products

that are “highly similar” to approved biological products. 42 U.S.C. § 262(i)(2). The BPCIA’s “Notice of commercial marketing” provision states that a biosimilar applicant shall provide notice to the incumbent seller of the biological product “not later than 180 days *before the date of the first commercial marketing* of the biological product licensed under” this abbreviated pathway. *Id.* § 262(l)(8)(A) (emphasis added).

The Federal Circuit concluded that a biosimilar applicant “may only give effective notice of commercial marketing *after* the FDA has licensed its product.” App., *infra*, 20a (emphasis added). As the dissenting judge recognized, the Federal Circuit turned this mere notice provision into a grant of 180 days of additional exclusivity for all biological products beyond the exclusivity period Congress expressly provided—delaying the launch of all future biosimilars by six months. The Federal Circuit transformed the notice provision into a stand-alone requirement unconnected to the patent resolution provisions of the BPCIA. It also disregarded the only remedy provided by Congress—the right to initiate patent litigation—and instead created its own extrastatutory injunctive remedy to bar the launch of FDA-approved biosimilars.

The questions presented are:

Whether notice of commercial marketing given before FDA approval can be effective and whether, in any event, treating Section 262(l)(8)(A) as a standalone requirement and creating an injunctive remedy that delays all biosimilars by 180 days after approval is improper.

Petition for a Writ of Certiorari at i-ii.

***Impression Products, Inc. v. Lexmark International, Inc.*, No. 15-1189 (petition filed March 21, 2016; SG brief invited June 20, 2016)**

Issue: Patent Law – Exhaustion

Questions Presented:

The “patent exhaustion doctrine”—also known as the “first sale doctrine”—holds that “the initial authorized sale of a patented item terminates all patent rights to that item.” *Quanta Computer, Inc. v. LG Electronics, Inc.*, 553 U.S. 617, 625 (2008). This case presents two questions of great practical significance regarding the scope of this doctrine on which the *en banc* Federal Circuit divided below:

1. Whether a “conditional sale” that transfers title to the patented item while specifying post-sale restrictions on the article’s use or resale avoids application of the patent exhaustion doctrine and therefore permits the enforcement of such post-sale restrictions through the patent law’s infringement remedy.

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2. Whether, in light of this Court’s holding in *Kirtsaeng v. John Wiley & Sons, Inc.*, 133 S. Ct. 1351, 1363 (2013), that the common law doctrine barring restraints on alienation that is the basis of exhaustion doctrine “makes no geographical distinctions,” a sale of a patented article—authorized by the U.S. patentee—that takes place outside of the United States exhausts the U.S. patent rights in that article.

Petition for a Writ of Certiorari at i.

The NYIPLA previously filed an amicus curiae brief in support of neither party with the en banc Federal Circuit. The Association argued that *Quanta* did not directly address *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700 (Fed. Cir. 1992), or the situation in which a patentee properly conditions or restricts its sale or license. It argued that, to the extent that *Mallinckrodt* allows patentees to impose restrictions that are not otherwise anticompetitive or unlawful, such that subsequent sales would be unauthorized and therefore not immunized by exhaustion, *Mallinckrodt* has a firm foundation in both statutory law and case law and over twenty years of settled expectations, is not in conflict with *Quanta*, and provides useful guidance to the district courts. Brief of Amicus Curiae The New York Intellectual Property Law Association in Support of Neither Party at 6.

The Association’s amicus brief further argued that although *Kirtsaeng* does not compel overruling *Jazz Photo Corp. v. Int’l Trade Comm’n*, 264 F.3d 1094 (Fed. Cir. 2001), it illustrates that *Jazz Photo*’s categorical rule does not universally comport with the principles underlying exhaustion. *Id.* at 7. The Association argued that “the proper focus should be on whether subsequent sales have been ‘authorized,’ regardless of where the initial sale takes place.” *Id.* It explained that, in certain circumstances, it will be apparent that an extraterritorial sale does not authorize subsequent sales under the United States patent and it would therefore be incongruous to apply exhaustion. *Id.* “In other circumstances, however, subsequent sales of a patented article under the United States patent may clearly be intended and ‘authorized’ even though the initial sale took place outside the United States.” The Association argued that, “[t]o the extent *Jazz Photo*’s categorical rule would hold that even these sales *never* give rise to exhaustion, it stretches too far.” *Id.*

Noah M. Leibowitz (Simpson Thacher & Bartlett LLP) was counsel of record, and Walter Hanley Jr. (NYIPLA President, Andrews Kurth Kenyon LLP) and the late David F. Ryan (former Co-Chair of NYIPLA Amicus Brief Committee) also participated on the brief.

The majority en banc opinion maintained its prior jurisprudence on the two important issues raised, as

the NYIPLA amicus brief had advocated. Consistent with the amicus brief submitted by the Association, Judge Taranto explained “[w]e find *Mallickrodt*’s principle to remain sound after the Supreme Court’s decision in [*Quanta*], in which the Court did not have before it or address a patentee sale at all, let alone one made subject to a restriction, but a sale made by a separate manufacturer under a patentee-granted license conferring unrestricted authority to sell.” *Lexmark Int’l, Inc. v. Impression Prods.*, 816 F.3d 721, 726 (Fed. Cir. 2016). The en banc Federal Circuit also adhered to its prior ruling in *Jazz Photo*. It distinguished *Kirtsaeng* on the basis that the Patent Act has a different statutory structure from the Copyright Act, a point made by the Association’s amicus brief. *Id.* at 727.

IV. Additional Notable Pending Petitions

***TC Heartland LLC v. Kraft Food Group Brands LLC*, No. 16-341 (petition filed September 12, 2016; response due November 16, 2016)**

Issue: Patent Law – Venue

Question Presented:

The patent venue statute, 28 U.S.C. § 1400(b), provides that patent infringement actions “may be brought in the judicial district where the defendant resides . . .” The statute governing “[v]enue generally,” 28 U.S.C. § 1391, has long contained a subsection (c) that, where applicable, deems a corporate entity to reside in multiple judicial districts.

In *Fourco Glass Co. v. Transmirra Products Corp.*, 353 U.S. 222 (1957), this Court held that § 1400(b) is not to be supplemented by § 1391(c), and that as applied to corporate entities, the phrase “where the defendant resides” in § 1400(b) “mean[s] the state of incorporation only.” *Id.* at 226. The Court’s opinion concluded: “We hold that 28 U.S.C. § 1400(b) is the sole and exclusive provision controlling venue in patent infringement actions, and that it is not to be supplemented by the provisions of 28 U.S.C. § 1391 (c).” *Id.* at 229.

Federal Circuit precedent holds to the contrary. Although Congress has not amended § 1400(b) since *Fourco*, the Federal Circuit has justified its departure from *Fourco*’s interpretation of § 1400(b) based on amendments to § 1391(c). As stated in the decision below, Federal Circuit precedent holds that “the definition of corporate residence in the general venue statute, § 1391(c), applie[s] to the patent venue statute, 28 U.S.C. § 1400” (App. 4a) and that “*Fourco* was not and is not the prevailing law” (App. 8a) on where venue is proper in patent infringement actions under § 1400(b).

The question in this case is thus precisely the same as the issue decided in *Fourco*:

Whether 28 U.S.C. § 1400(b) is the sole and exclusive provision governing venue in patent infringement actions and is not to be supplemented by 28 U.S.C. § 1391(c).

Petition for a Writ of Certiorari at i.

***DBN Holdings, Inc. v. International Trade Commission*, No. 16-63 (petition filed July 13, 2016; response filed October 12, 2016)**

Issue: Patent Law – ITC Jurisdiction

Questions Presented:

19 U.S.C. § 1337(a)(1)(B)(i) gives the International Trade Commission jurisdiction to investigate and to deal with the importation of “articles that . . . infringe a valid and enforceable” patent. Yet in a series of recent cases that have repeatedly and deeply divided the Federal Circuit, the Commission has been permitted to expand its jurisdiction to regulate the importation of articles that do *not* infringe any patent but are merely associated with the alleged infringing conduct of U.S. companies on U.S. soil. And in the decision below, the Commission exercised its expanded jurisdiction to enforce a patent that has been finally adjudicated to be invalid by the federal courts. The questions presented are:

1. Whether the International Trade Commission’s jurisdiction over the importation of “articles that . . . infringe a valid and enforceable” patent extends to articles that do not infringe any patent.

2. Whether the Federal Circuit erred in affirming the Commission’s assessment of civil penalties for the domestic infringement of a patent that has been finally adjudicated to be invalid.

Petition for a Writ of Certiorari at (i).

***Lenz v. Universal Music Corp.*, No. 16-217 (petition filed August 12, 2016; response filed September 26, 2016)**

Issue: Copyright Law – DMCA: Good Faith Takedown Notice

Question Presented:

Whether the Ninth Circuit erred in concluding that the affirmation of good faith belief that a given use of material use is not authorized “by the copyright owner, its agent, or the law,” required under Section 512(c) of the Digital Millennium Copyright Act (“DMCA”), may be purely subjective and, therefore, that an unreasonable belief—such as a belief formed without consideration of the statutory fair use factors—will not subject the sender of a takedown notice to liability under Section 512(f) of the DMCA?

Petition for a Writ of Certiorari at i.

(Endnote)



* Sandra A. Hudak is a member of the NYIPLA’s Amicus Brief Committee and an Associate at Amster, Rothstein & Ebenstein LLP. Charles R. Macedo is a Member of the Board of Directors of the NYIPLA and a Partner at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues, including litigating patent, trademark and other intellectual property disputes. If you would like to join the Amicus Brief Committee, please contact Co-Chairs, David P. Goldberg (dgoldberg@arelaw.com) and Irena Royzman (iroyzman@pbwt.com).



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As Time Goes By—FTC on the “Deplorable” Patentee

Echoing hard times of bygone eras, our nation’s IP policies are in deplorable condition. The creation of our Association in 1922 was in direct response to the state of affairs in the Patent Office at a time when the Commissioner of Patents declared it to be in “deplorable” condition. By 1949, when “flash of genius” was still the test for patentability of an invention, patent policy itself had sunk to a new low, as summed up by Supreme Court Justice Jackson: “[T]he only patent that is valid is one which this Court has not been able to get its hands on.”¹



Flashing forward to the present, a September 2016 Harvard Business School Report² on American competitiveness in the global economy paints a bleak picture for the future. In the report, innovation was alluded to as one of our nation’s few bright spots. However, the Harvard Business School Report failed to consider recent adverse judicial and legislative developments that have undermined U.S. IP policy, thereby stifling innovation in America.

From a judicial standpoint, the Supreme Court negatively impacted IP policy by adding uncertainty and unpredictability to the validity and enforceability of countless patents in its decisions in *eBay*³ (2006), *KSR*⁴ (2007) and *Alice*⁵ (2014).

From a legislative standpoint, the inaptly titled, ineptly drafted, ill-fated America Invents Act of 2011 added further confusion to patent policy. The Defend Trade Secrets Act of 2016 shifts the patent/trade secrecy dichotomy in favor of trade secrets. Both Acts stifle innovation by encouraging corporate “siloeing” of information that is potentially valuable to competitors.

Against this backdrop of judicial and legislative undermining of IP policies, along comes the FTC, adding injury to insult for smaller patentees, such as undercapitalized universities and “mom and pop” shops.



Dale Carlson, a retired partner at Wiggin and Dana, LLP is “distinguished practitioner-in-residence” at Quinnipiac University School of Law, NYIPLA historian, and a Past President. His email is dlcarlson007@gmail.com. The views expressed herein are those of the author and do not reflect the views of Quinnipiac University School of Law or the NYIPLA.

A new FTC Report⁶ demonizes undercapitalized entities as “patent trolls,” without focusing on that term. Instead, the FTC uses politically correct jargon in dividing the kingdom of troll-dom into two kinds of so-called “patent assertion entities or PAEs.” One kind, namely, well-capitalized entities (for example, Intel) are referred to as “Portfolio PAEs” (think “good guys”). Another kind, namely, less well-capitalized entities (for example, Intellectual Ventures) are referred to as “Litigation PAEs” (think “bad guys”).

If demonizing one class of patentees vis-à-vis another sounds strangely familiar, it should. Back in 1999, Intel’s GC Peter Detkin branded a less well-funded rival as a “patent extortionist,” and was promptly threatened with a suit for libel. The term “patent troll” was then chosen as a non-libelous way for Intel to cast aspersions upon its foe.

Mr. Detkin went on to become a founder of Intellectual Ventures, which some, perhaps even Intel, might characterize as a “patent troll,” or as in FTC parlance, a “Litigation PAE.”

A recent *Fortune Magazine* article observed that the FTC Report is “[w]hat the Tech Industry has been saying for years.”⁷ To the extent that the Tech Industry is exemplified by Intel, indeed it has.

The key IP issue that our nation faces now goes beyond petty vilifying of one class of patentees. After all, the only right any patentee has, at least up until the *eBay* decision, is the right to exclude others.

That right should be sacred, no matter what garb the patentee is wearing. The key issue is whether petty vilifying will serve as cover for the failed IP policies of the last decade. Who will stand up to say, “The Emperor has no clothes”?

With kind regards,
Dale Carlson

(Endnotes)

¹ *Jungersen v. Ostby & Barton Co.*, 335 U.S. 560, 572 (1949) (Jackson, J., dissenting opinion).

² Michael E. Porter et al., *Problems Unsolved and a Nation Divided: The State of U.S. Competitiveness 2016*, HARVARD BUSINESS SCHOOL SURVEY ON U.S. COMPETITIVENESS (Sept. 2016), available at <http://www.hbs.edu/competitiveness/Documents/problems-unsolved-and-a-nation-divided.pdf>.

³ *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

⁴ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

⁵ *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014).

⁶ Patent Assertion Entity Activity: An FTC Study, FED. TRADE COMM’N (Oct. 2016), available at https://www.ftc.gov/system/files/documents/reports/patent-assertion-entity-activity-ftc-study/p131203_patent_assertion_entity_activity_an_ftc_study.pdf.

⁷ Jeff John Roberts, *The FTC Has Some Harsh Words for Patent Trolls*, FORTUNE MAGAZINE (Oct. 6, 2016), available at <http://fortune.com/2016/10/06/ftc-patent-report>.

October/November 2016 IP Media Links

By Jayson L. Cohen*

Brand Protection

With the new *Star Wars* movie, *Rogue One*, due to premiere in December, Erin McCann reported in *The New York Times* on October 20, 2016, that Disney-owned Lucasfilm took legal action against companies offering “lightsaber combat and Jedi training classes for adults and children.” The lawsuit accuses the Lightsaber Academy and New York Jedi of trademark infringement and false designation of origin under the Lanham Act, among other causes of action, for allegedly improper uses of the terms “Jedi” and “lightsaber” and the Jedi Order logo. Ms. McCann contrasts Lucasfilm’s protection of its intellectual property in this case with its past support for fan-based projects that do not seek to earn a profit or are specifically targeted at charitable causes. (<http://www.nytimes.com/2016/10/20/business/media/lucasfilm-sues-jedi-classes.html>; <https://www.documentcloud.org/documents/3143771-Lightsaber.html>.)

On September 11, 2016, Sam Fortier published a piece in *The New York Times* about Boise State University’s active defense of its blue football field trademark. The university has leveraged the blue field to attract recruits and improve its football program over the last 30 years, and the city of Boise touts the blue field as a landmark. Attorney Rachel Bickerton runs the university’s trademark licensing and enforcement program for the blue field. According to the article, she maintains Boise State’s exclusive right to the blue field in Division I college football but otherwise allows others to use the blue field under a license. The article also reports that Boise State interprets its trademark protection to include non-green fields under the doctrine of initial interest confusion. (<http://www.nytimes.com/2016/09/11/sports/ncaaf-football/boise-state-mounts-a-paper-defense-of-its-home-turf.html>.)

The big news in Texas on October 14, 2016, was a preliminary injunction against the South Texas College of Law’s attempt to change its name to the Houston College of Law. Articles by Zach

Despart of the *Houston Press* and Gabrielle Banks of the *Houston Chronicle* reported the University of Houston Law Center’s victory in a dispute centered on branding, marketplace perception, and consumer confusion. (<http://www.houstonpress.com/news/judge-orders-houston-college-of-law-to-revert-back-to-its-old-name-updated-8861035>; <http://www.houstonchronicle.com/news/houston-texas/houston/article/UH-comes-out-on-top-in-judge-s-ruling-on-law-9972730.php>.)

According to Janelle Nanos’ article in *The Boston Globe* on August 8, 2016, Boston-based Tasty Burger announced that it would defend its intellectual property rights against Chipotle, which expects to launch a burger restaurant chain named Tasty Made this fall. The article reports a statement by Tasty Burger chief executive, David Dubois: “Despite the obvious David and Goliath scenario, we cannot simply stand by and watch an enormously powerful company like Chipotle move forward with opening a burger restaurant with a similar name, mark, and logo design.” With Chipotle apparently moving forward with Tasty Made, this burger battle may end up in court. (<https://www.bostonglobe.com/business/2016/08/08/burger-battle-tasty-burger-squares-off-against-chipotle/4HqwSA7wkhoph1Q0H6VqI/story.html>.)

(Endnote)



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

Notable Trademark Decisions

By Michael Kraich, Pina M. Campagna, and Scott Greenberg*

Application for MT. RAINIER THE MOUNTAIN OF SEATTLE EXPRESSO & MILK Refused Registration

Morinaga Nyugyo Kabushiki Kaisha (“Applicant”) was refused registration on the Principal Register for the mark “MT. RAINIER THE MOUNTAIN OF SEATTLE EXPRESSO & MILK” (“the mark”) along with an accompanying design mark. The Examining Attorney denied registration under Section 2(d) of the Trademark Act for being likely to cause confusion, as well as under Section 2(e)(3) as being primarily geographically deceptively misdescriptive. The Board affirmed the refusal under Section 2(d), but reversed the refusal under Section 2(e)(3). *In re Morinaga Nyugyo Kabushiki Kaisha*, Serial No. 86338392, at 25 (TTAB Sept. 8, 2016).

The Examining Attorney denied registration for the mark based on the registered standard character mark for “MOUNT RAINIER COFFEE COMPANY” and a corresponding design mark. The Board noted that, in lieu of a response addressing the *DuPont* factors for determining likelihood of confusion, the record “ma[de] abundantly clear that Applicant’s goods are identical or very closely related to those in the cited registration.” *Id.* at 3.

The Applicant argued that the registered mark was on the Supplemental Register and should not be cited as a basis to refuse registration of the Applicant’s mark. The Applicant further pointed to six additional registrations containing the term “RAINIER,” all owned by different entities and registered in connection with bakery products. *Id.* at 7. Based on these additional registrations, Applicant argued that the marks were “relatively weak and entitled to only a narrow scope of protection,” and the registrations “demonstrate that RAINIER is suggestive or descriptive of the identified goods.” *Id.* at 7-8.

The Board stated that “although [the marks in question] differ in some respects, Applicant’s mark and the Registrant’s standard-character mark are significantly similar.” *Id.* at 8. Given that the first part of the mark is often the most likely to be impressed upon a consumer, denial was affirmed. *Id.* at 8-11. The Board further rejected the Applicant’s reliance on McCarthy on Trademarks and Unfair Competition as a basis for contending that the USPTO should be barred from citing marks on the Supplemental Register; according to the Board, Federal Circuit precedent dismissed that approach and expressly permitted citation to registrations on the Supplemental Register. *Id.* at 11-12.

Turning to the use of “SEATTLE” in the Applicant’s mark, the Board held that the term played a relatively minor role visually, and that the mark as a whole would not be found to indicate the origin of the goods to the relevant public. *Id.* at 19-24. Ultimately, the refusal to register the Applicant’s mark was upheld under Section 2(d), but reversed under Section 2(e)(3). *Id.*

In re Morinaga Nyugyo Kabushiki Kaisha, Serial No. 86338392 (TTAB Sept. 8, 2016) [precedential].

Board Affirms Rejection of Repeating Mark as Merely Decorative

The Applicant (“Fantasia Distribution”) applied for registration of a mark described as “consist[ing] of the design of repeated rows of diamonds applied to the goods which appear on the lower third of the cylinder of the hookah device.” *In re Fantasia Distribution, Inc.*, Serial No. 86185623, at 2 (TTAB Sept. 21, 2016). That application was refused registration, and the Applicant appealed. On appeal, the Board affirmed the refusal to register the mark, concluding that the claimed mark was merely ornamental. *Id.* at 25.

Fantasia Distribution’s claimed mark consisted of a repeating symmetrical diamond pattern associated with electric hookahs, encompassing the base of a handheld electronic hookah. The Examining Attorney’s rejection stated that, based on available evidence, placement of ornamental designs “toward the bottom of electronic hookah devices is a common practice in the industry.” *Id.* at 13. The Examining Attorney further stated that consumers would view the design as “a decorative feature of the goods rather than as a trademark.” *Id.* The Board pointed to other e-hookah devices with ornamental designs affixed to the base of the hookahs to support this finding. *Id.* at 10-13.

Fantasia Distribution maintained, nonetheless, that the proposed mark was inherently distinctive or, alternatively, the proposed mark had acquired distinctiveness under Section 2(f) of the Trademark Act. *Id.* at 13-15. The Board noted that repeating patterns are frequently used for ornamental purposes, and affirmed the Examining Attorney’s inherent distinctiveness analysis. *Id.* at 3, 14-17. In reaching that conclusion, the Board also rejected the Applicant’s “contention that the evidence must specifically show other diamond patterns placed on electronic hookahs,” stating that “such a showing is unnecessary if, for other reasons, the public

would not perceive the mark as an indicator of source.” *Id.* at 14. The Board found that the Applicant’s claim of inherent distinctiveness was unpersuasive. *Id.* at 17.

The Board affirmed the Examining Attorney’s findings in regard to the acquired distinctiveness claim finding the Applicant’s evidence unpersuasive given the lack of commercial context and in light of the Examining Attorney’s submitted evidence. *Id.* at 21-25. Notably, the Board stated that “when Applicant’s e-hookahs are sold in boxes, the transparent window in the box does not even reveal the applied-for diamond pattern.” *Id.* at 23. Based on the evidence available, the Board stated that “Applicant’s repeating diamond pattern does not create a distinct commercial impression apart from the other wording and designs appearing on the electronic hookahs.” *Id.*

In re Fantasia Distribution, Inc., Serial No. 86185623 (TTAB Sept. 21, 2016).

Board Denies Respondent’s Motion for Summary Judgment on Res Judicata

In an order dated August 30, 2016, the Board denied Great Concepts, LLC’s (“Respondent”) motion for summary judgment. Specifically, in response to Chutter, Inc.’s (“Petitioner”) petition to cancel the Respondent’s registration, the Respondent filed a motion under Fed. R. Civ. P. 56 to bar the Petitioner’s claim under the doctrine of res judicata (a.k.a., claim preclusion). The Respondent argued that the claims asserted in an earlier proceeding involving the Petitioner’s predecessor-in-interest were being reasserted in the instant proceeding. The Respondent further contended that the claim of fraud could have been asserted in the earlier proceeding, and, as a result, should be barred.

The Board first clarified that the Petitioner had standing to file the petition and then proceeded to analyze the res judicata claim. Although Respondent satisfied the first two factors—namely, (1) that privity between the parties exists, and (2) there was an earlier final judgment on the merits—the Board found that the Respondent had failed to show that the second claim was based on the same set of transactional facts as the first. The Board noted that “a subsequent assertion of the same transactional facts in the form of a different cause of action or theory of relief” was barred, but found that the transactional facts at issue were not sufficiently connected. *Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1866-69 (TTAB Aug. 30, 2016).

With respect to the fraud allegation, the Board noted that, “[c]onsidering the factual allegations in each petition for cancellation, it is clear that Petitioner’s

claim of fraud in the current proceeding is based on Respondent’s execution of a Section 15 declaration, whereas the claim of fraud in the Prior Proceeding was based on Respondent’s failure to reveal during ex parte examination of the underlying application that the mark identified a living individual.” *Id.* at 1870. Based on the distinction that the prior claim was directed at alleged fraud during prosecution and the current claim was directed at alleged fraud arising out of maintenance of the mark, the Board denied the Respondent’s motion for summary judgment and *sua sponte* entered summary judgment in favor of Petitioner on the issue of res judicata. *Id.*

Chutter, Inc. v. Great Concepts, LLC, 119 USPQ2d 1865 (TTAB 2016) [precedential].

Federal Circuit Affirms Dismissal of Opposition to MAYARI

On June 24, 2016, the United States Court of Appeals for the Federal Circuit affirmed the Trademark Trial and Appeal Board’s dismissal of an opposition to an application for the mark “MAYARI” for “wine.” Oakville Hills Cellar, Inc. (“Opposer”) brought the opposition under Section 2(d) of the Trademark Act based on the registered mark “MAYA,” also for “wine.”

The Federal Circuit noted that, in general: (a) likelihood of confusion under Section 2(d) is a question of law that is based on underlying questions of fact, the latter relating to the individual likelihood-of-confusion factors set out in *re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“the *DuPont* factors”); (b) the Board’s legal conclusion of likelihood or non-likelihood of confusion is reviewed without deference, and the Board’s underlying factual findings are reviewed for the presence of substantial evidence supporting the determination that was reached; and (c) a single *DuPont* factor may be dispositive in a given case, especially when that single factor is the dissimilarity of the marks. *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 1379 (Fed. Cir. 2016).

In this case, the Federal Circuit decided that (1) the Board did not err in concluding that confusion was not likely, based primarily on the dissimilarities between the marks, and (2) substantial evidence supported the Board’s findings that the parties’ marks were sufficiently different in their entirety as to appearance, sound, meaning, and commercial impression. *Id.* at 1380-81. In so concluding, the Federal Circuit found no reason to disturb the Board’s finding that several of the Opposer’s contentions were unsupported by substantial evidence. *Id.* at 1381.

cont. on page 26

As to meaning and overall impression, the Federal Circuit ruled that substantial evidence supports the Board's finding that the "unfamiliar" term "MAYARI" is sufficiently distinguishable from the "familiar word" MAYA. *Id.* at 1381-82. The evidence on which the Board relied showed that "Maya" is a recognized female name and the name of the pre-Columbian civilization, while there was no persuasive proof that "Mayari" would be perceived by most U.S. consumers as anything but a coined term without meaning. *Id.* In making this finding, the Board noted that the Opposer presented some evidence from the Internet that "Mayari" is itself a female given name and is also the name of a Filipino goddess. However, the Board had found, and the Federal Circuit agreed, that the Opposer did not present any evidence that these "more esoteric meanings" of "Mayari" would be generally known to U.S. consumers. *Id.*

Regarding the sound and pronunciation of the marks, the Federal Circuit concluded that the Board did not err in finding that (a) there was no evidence to support the Opposer's argument that the marks would be pronounced similarly, and (b) they may well be pronounced quite differently. *Id.* at 1381. In particular, there was no evidence to support the Opposer's argument that consumers are likely to perceive and therefore pronounce the applicant's mark as "MAYARI" instead of "MAY-ARI" or "MA-YARI." *Id.*

On the issue of appearance of the marks, the Federal Circuit also noted the Board's rejection of the Opposer's argument that the bottle label bearing the applicant's mark "MAYARI" will appear to read as "MAYA" at certain orientations relative to the observer. *Id.* at 1378. The Federal Circuit found no reversible error in the Board's finding that the likelihood of such a misreading of the applicant's bottle label remains speculative, given the absence of any evidence regarding the regularity of such mistakes. *Id.* at 1378, 1382.

Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC, 826 F.3d 1376 (Fed. Cir. 2016) [precedential].

Board Upholds Refusal of HEMP HOME HEALTH Application Due to Applicant's Failure to Address Actual Grounds for Refusal

In a precedential decision dated August 24, 2016, the Board affirmed the refusal of an intent-to-use based application for the mark HEMP HOME HEALTH ("HOME HEALTH" disclaimed) for "home health care services" in Class 44. The Examining Attorney's grounds for final refusal were: (1) mere descriptiveness

of the mark under Section 2(e)(1) of the Trademark Act; (2) in the alternative to ground (1), deceptive misdescriptiveness of the mark under Section 2(e)(1); and (3) failure to respond to the Examining Attorney's request for information under 37 C.F.R. § 2.61(b). *In re Harley*, 119 USPQ2d 1755, 1757 (TTAB 2016).

The Examining Attorney's request for information required the two co-applicants to advise regarding (a) the significance of "HEMP" as applied to the services, (b) whether the services will comply with the Controlled Substances Act ("CSA"), 21 U.S.C. §§ 801-971, and (c) whether applicants will be using hemp-based products, extracts, oils or derivatives in connection with their services. In the course of prosecution, the Examining Attorney advised applicants that the information to be provided in response to the Examining Attorney's requests may possibly support a refusal under Sections 1 and 45 on the ground that the identified services would not be lawfully used, if the information indicated that the mark would be used in violation of the CSA. *Id.* at 1756-57.

The Board noted that the applicants' brief on appeal did not address the merits of any of the issues that formed the basis of the Examining Attorney's final refusals of registration. *Id.* at 1757. Instead, applicants stated that they were appealing the refusal to register on the ground that use of the mark would not be lawful due to the possibility that hemp may be used in the provision of applicants' services. *Id.* In particular, applicants argued that (a) the USPTO is not authorized to ban the registration of all terms associated with hemp inasmuch as using the term "HEMP" in a service mark does not mean that applicants are violating the CSA or Sections 1 and 45 of the Trademark Act, (b) there is nothing illegal under the CSA about the provision of home health care services, and (c) there was no evidence that applicants' services were related to hemp. *Id.*

The Board noted that Section 20 of the Trademark Act restricts the Board's jurisdiction in ex parte proceedings to final refusals of the Examining Attorney. *Id.* In this case, however, there was only an advisory notification of a potential refusal on grounds of unlawful use of the mark. *Id.* This advisory statement was not even an actual refusal, let alone a final refusal. *Id.* According to the Board, "the lack of finality, inherent in the word 'advisory' dooms review." *Id.*

Moreover, the Board held that an applicant's failure to address, on appeal, any ground of refusal that was subject to appeal, is a basis for affirming refusal on such grounds. *Id.* at 1757-58. Therefore, the Board affirmed the final refusals under Section 2(e)(1) and 37 C.F.R. § 2.61(b). *Id.* at 1758.

In re Harley, 119 USPQ2d 1755 (TTAB 2016) [precedential].

Board Dismisses Cancellation Proceeding on Collateral Estoppel Grounds with Regard to Petitioner's Lack of Standing

The Board granted summary judgment dismissing a cancellation proceeding that was brought against the mark BEACH PIZZA for “pizza” based on claims of genericness, descriptiveness, geographic descriptiveness, fraud, and abandonment. The Petitioner alleged standing based on damage should the petitioner be prevented from using the allegedly generic term “beach pizza,” as well as the receipt of assertions from the registrant regarding consumer confusion. *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1862 (TTAB 2016).

Fatal to the Petitioner's claim, however, was that the same Petitioner had previously brought a prior cancellation proceeding against the same registration, alleging the same grounds and the same basis for standing. In that prior proceeding, the Board dismissed the petition after trial for lack of standing, because the Petitioner had failed to present any evidence concerning its commercial activities and its interest in the Respondent's registered BEACH PIZZA mark. *Id.*

In the new proceeding, the Respondent moved for summary judgment on the ground of issue preclusion (a.k.a., “collateral estoppel”) with regard to the issue of standing. The Board agreed with the Respondent and granted summary judgment dismissing the new proceeding. *Id.* at 1862-63.

The Board held that the doctrine of issue preclusion can apply to, and bar the relitigation of, the question of the plaintiff's standing to bring a given claim. *Id.* at 1863. The Board distinguished the Federal Circuit decisions relied on by the Petitioner, including *University of Pittsburgh v. Varian Medical Systems, Inc.*, 569 F.3d 1328 (Fed. Cir. 2009). *Id.* at 1864. The Board noted that, in these cases, either the wrong party filed the first action or a potentially necessary party was not joined as a plaintiff, so that dismissal of the first action “with prejudice” would have deprived the proper plaintiff of an opportunity to pursue relief. *Id.* The Board held that, by contrast in the present case, in both the first and second cancellation proceedings “the same, sole, correct party” pleaded a sufficient basis for standing, but simply failed to carry its burden of proving standing in the first action. *Id.*

The Board also concluded that the four required elements for issue preclusion were met in the present case. In particular: (1) the issue in both proceedings was identical—the Petitioner pleaded the same basis for standing in both cases and did not allege any change in circumstances; (2) the issue of standing was “actually litigated” in the prior proceeding—an issue

is actually litigated for purposes of collateral estoppel even though the determination is based on a failure of proof; (3) the issue of standing was necessary to the Board's determination in the prior proceeding; and (4) the Petitioner had a full and fair opportunity to litigate the issue of standing in the first proceeding; it simply failed to do so. *Id.* at 1864-65.

The Board further noted that the cancellation petitioner could have sought to rectify its failure to prove standing in the first proceeding by bringing an appeal by way of civil action under Section 21(b) of the Trademark Act, in which the Petitioner could have submitted new evidence regarding its standing. However, the Petitioner took no such action. *Id.*

Because the Petitioner was precluded from relitigating the threshold requirement of standing, the Board granted summary judgment to the Respondent, dismissing the new cancellation proceeding with prejudice. *Id.* at 1865.

NH Beach Pizza LLC v. Cristy's Pizza Inc., 119 USPQ2d 1861 (TTAB 2016) [precedential].

(Endnote)

*Michael Kraich, a recent graduate of the University of Pittsburgh Law School, is a technical advisor for Carter, DeLuca, Farrell, & Schmidt, LLP, and focuses on patent and trademark preparation and prosecution. Pina M. Campagna is a partner at Carter, DeLuca, Farrell & Schmidt, LLP. Ms. Campagna's practice includes representing regional, national and international businesses, with a particular concentration in trademark and design patent matters. Scott Greenberg is senior counsel in the New York office of Locke Lord LLP. His practice focuses on trademark, copyright and unfair competition matters, and includes litigation before the courts and the U.S. Patent and Trademark Office, in those fields as well as in domain name disputes. Prior to entering private practice, Mr. Greenberg was a Trademark Examining Attorney at the U.S. Patent and Trademark Office.



➤ JANUARY 12, 2017 ◀

Understanding the Upcoming Changes to the Trademark Rules and Practice

Pryor Cashman LLP, 7 Times Square, New York, NY 10036

➤ MARCH 31, 2017 ◀

95TH ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY

New York Hilton Midtown, 1335 Avenue of the Americas, New York, NY 10019

➤ APRIL 27, 2017 ◀

33RD JPPCLE SEMINAR

Crown Plaza Hotel, Times Square, 1605 Broadway, New York, NY 10019

➤ MAY 16, 2017 ◀

NYIPLA 2017 ANNUAL MEETING

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

The Report to Publish Post-Grant Proceedings Updated Issue

The February/March 2015 issue of the Bulletin was devoted to Post-Grant Proceedings (see <http://www.nyipla.org/images/nyipla/Documents/Bulletin/2015/Bulletin%20Feb-Mar%202015.pdf>). Because practice in this area has evolved rapidly since then, the February/March 2017 issue of *The Report* will again be devoted to post-grant proceedings. Articles can encompass any of the intellectual property aspects of post-grant proceedings.

Articles can be any length, but a length of 1700 to 2500 words is expected to be about average. Please submit the articles in MICROSOFT WORD®, 1997-2003 format (i.e., “.doc”, not “.docx”) and with endnotes rather than footnotes. Also, please submit electronic versions of all sources cited in either the text of the article or the endnotes.

- Abstracts (1-2 paragraphs) due by **January 6, 2017** (for planning purposes)
- Final articles due by **February 3, 2017**

For more information, contact *The Report* editors

Mary Richardson (mary.e.w.richardson@gmail.com),
William Dippert (wdippert@patentusa.com) or
Dale Carlson (dlcarlson007@gmail.com).

U.S. Bar/EPO Liaison Council 2016 Meeting Report

*By Samson Helfgott and Thomas E. Spath**

The 32nd meeting of the U.S. Bar/EPO Liaison Council took place on Thursday, September 15, 2016 in New York City in conjunction with the annual meeting of the IPO. The Council meets annually, alternating between the United States and Europe, and comprises the President and other Officials of the EPO. The Council meets with patent attorneys representing national and regional patent bar associations in the United States.

EPO President Benoît Battistelli made an initial presentation summarizing the current state of the EPO. He pointed out that at present the EPO provides patent protection in up to 42 countries in Europe. The EPO currently has 7,000 employees, about 4,300 of whom are qualified Examiners.

In 2015 over 160,000 European patent applications were filed, representing an almost 5% increase over the previous year. Of those patent applications filed in 2015, 27% originated from the United States, which is the largest filer in the EPO. There was an increase of over 16% in the filings from the United States during 2015. Although patent applications filed from China are still only about 4% of the total patent applications filed, this number has grown over 22% compared to 2014.

The top three technical areas are medical technology, digital communications, and computer technology. A large increase in the number of patents granted is expected in 2016, with that number approaching 90,000. Most of this increase is the result of increased capacity; however, a third of the increase represents an increase in efficiency.

As a result of Brexit, the future of the Unitary Patent system is uncertain. In order for the Unitary Patent system to go into effect, it is required that the UK be one of the approving governments. There is a possibility that the UK may ratify the Unitary Patent system while it is still a member of the EU, in which case the system will go into effect, and that when the UK leaves the EU, it will have to make accommodations to maintain its membership in the Unitary Patent system. At present, it does not appear that the UK is moving in this direction. There is also an option for replacing the UK with another country for approval, but the situation is currently unsettled.

Although all of the programs for operating this system are in effect, and while it is anticipated that ultimately it will go into effect, currently the state of play is unknown.

One of the major programs undertaken by the EPO over the last few years is Early Certainty from Search. This program has a goal of issuing all searches within about six months after receiving the file. It expedites examination following a positive search opinion, and also fast tracks examination once it has begun. This program also provides fast processing of cases where a substantial third-party observation has been filed, and gives priority to opposition first actions. As a result, the backlog of searches has been gradually reduced.

The Early Certainty from Search program is currently being expanded to examination and opposition proceedings. In connection with examination proceedings, the EPO is streamlining the patent practice, workloads, and procedures supported by extended refund fees following withdrawal. The EPO is also streamlining the opposition procedure to issue decisions faster, while giving parties more time to react to a summons and to be adequately prepared for oral proceedings.

The EPO's goal is that by 2020, searches will be completed within six months, examinations will be completed within an average of 12 months, and standard oppositions will be completed within 15 months.

The EPO reiterated the availability of the PACE program, which is a fast-track procedure that can be requested by applicants, without charge. In the past year, about 7% of the applications have been fast tracked under this program.

Another procedure for expediting patent grants is to agree to various waivers available in the grant procedure. These waivers eliminate the necessity for additional communications following the intention to grant notice and can save quite a number of months in the process of issuing the patent certificate.

In connection with its PCT work, the EPO is first in the world as an International Searching Authority (ISA) and an International Preliminary Examination Authority (IPEA). The EPO serves as the ISA for

cont. on page 30

37% of United States filings. The EPO is providing improved services to users in connection with a PCT Direct program. This program is especially relevant for applicants filing a PCT application based on a priority application which has already been searched by the EPO. With such applications, a letter is filed with the PCT application containing informal comments on the objections made in the earlier search and on the opinion provided by the EPO. Examiners then provide an international search report and written opinion taking into account these informal comments. It is expected that this program will increase the likelihood of receiving a positive written opinion in the international phase.

The EPO is also participating in the collaborative search and examination program whereby one PCT search is performed by a main ISA in collaboration with other ISAs which provide their contribution and feedback. The aim of this program is to provide a high quality search with increased legal certainty early on in the procedure. Another EPO pilot program provides an information sheet on search strategy which will be attached to all search reports provided by the EPO for both PCT and EPO searches. This information sheet will contain relevant data on classification, databases, and key words used by EPO examiners when performing the search. It will be available through file inspection in PATENTSCOPE for PCT applications and within the European Patent Register for EPO applications.

The EPO is arranging for a reorganization of the Boards of Appeal to make them a separate unit. They will have their own President, who will be responsible directly to the Administrative Council. There will also be a Chairman of the Enlarged Board of Appeal. This reorganization will make the Boards of Appeal an independent body. It is hoped that this will focus more attention on efficiency and independence of the Boards. Ultimately, the Boards of Appeal will be relocating to new premises in Munich.

The EPO has been very active in working with other patent offices to establish a new Cooperative Patent Classification System (CPC), which is now being utilized by 24 patent offices. The EPO is also working actively to include Asian documents in its system; currently 27% of EPO citations are from Asia. The EPO is also including industry standards documentation in its system for use by the examiners.

To provide more interactive communication with United States users, the EPO has appointed an EPO attaché who will reside in the United States and be available to United States applicants. Currently, Mr. Albert Keyack is the attaché.

The NYIPLA is represented on the U.S. Bar/EPO Liaison Council by Thomas Spath and Samson Helfgott.

(Endnote)



* Samson Helfgott is Of Counsel at Katten Muchin Rosenman LLP. His practice focuses on domestic and international patent, trademark, and copyright matters, international patent strategy and patent and trademark administration, before United States and foreign patent tribunals. Thomas E. Spath is Of Counsel at Abelman, Frayne & Schwab, and his practice focuses on United States and international patent, trademark, and licensing law, with a concentration in the chemical engineering patent arts.

Business Development for Young Lawyers: Building and Maintaining Professional Relationships in the IP World

By Gary Yen

On September 13, 2016, the Young Lawyers Committee hosted a workshop on “Business Development for Young Lawyers: Building and Maintaining Professional Relationships in the IP World.” The workshop was led by Rich Goldstein, Co-Chair of the Law Firm Management Committee and an experienced practitioner with many years of business development experience.

Over a dozen young lawyers gathered to attend this interactive workshop. The evening began with

informal networking. Mr. Goldstein then led a discussion on the importance of starting to network early in a young lawyer’s career, and various approaches a young lawyer can take to growing a professional network. Finally, Mr. Goldstein led the participants in an exercise to develop the participants’ elevator pitches. The Young Lawyers Committee thanks Mr. Goldstein and those who attended the event. ■

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

By Doug Nemec

On September 21, 2016, four distinguished veterans of the bench regaled an audience of Association members with stories and a debate concerning patent litigation at the interface of PTAB and district court proceedings. The panel presentation, held at the Cornell Club, was organized and moderated by Kenneth Adamo of Kirkland & Ellis LLP and was sponsored by the Patent Litigation Committee. The panelists included retired U.S. District Judge Faith Hochberg of the District of New Jersey, retired U.S. Magistrate Judge Jeff Kaplan of the Northern District of Texas, and retired Administrative Patent Judges Scott Kamholz and Neil Smith of the Patent Trial and Appeal Board.

For an action-packed ninety-plus minutes, Mr. Adamo led the panelists in a spirited debate on a range of topics, revealing insightful perspectives on the issues. For example, early in the session the

panelists addressed the question of the real party in interest—a topic that was expected to be fairly cut and dry, but that drew diverging views from Judge Kamholz on the one hand, who views the issue as mostly settled, and Judge Hochberg on the other hand, who continues to see real party in interest issues as a potential source of abuse and gamesmanship. It was just this sort of debate that the panel was intended to evoke, and each panelist delivered. Other hot topics of discussion included litigation stays, estoppel in the PTAB and district courts, discovery, and *in limine* treatment of PTAB rulings. The panelists also delved into practical, “nuts and bolts” issues, such as how case decisions are assigned and the impact of a judge’s technology background on case decisions. All told, it was an evening full of valuable takeaways and candid revelations from a highly engaging panel. ■

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

By Lindsay Korotkin

On September 26, 2016, the Young Lawyers Committee, in conjunction with Arent Fox LLP, hosted a roundtable event entitled, “Speaking the Language of Your Clients: Music Industry.” The panel included a cross-section of music industry representatives: Andrew Sparkler, Vice President, Business Affairs and Operations for Downtown Music Publishing; Keenan Popwell, Director of Partnerships for Rhapsody; and Jeff Curtin, the drummer with the

Small Black band, and a sound mixer/engineer and producer. The panelists engaged in a vibrant discussion of the key stakeholders in the music industry and the ways in which new media and new means of distribution have shaken up the industry. The attendees and panelists then discussed the future of the music industry.

The Young Lawyers Committee thanks all participants and looks forward to seeing more lively discussions at its next industry roundtable. ■

In-House Counsel Happy Hour

By Tulloss Delk

On October 13, the Corporate Committee held its annual in-person mixer at Public House in midtown Manhattan. This event has become a tradition for the Committee, as it provides a great opportunity for members to reconnect in a casual setting. For the second consecutive year, we invited the NYIPLA Young Lawyers Committee to join us. Both Committees turned

out in good numbers, and everyone had a good time. Most importantly, people appreciated the face-to-face interaction with familiar voices from Committee telephone calls, as well as the chance to meet members of another Committee. We look forward to scheduling more mixers like this in the year ahead.

Women in IP Law Fall Networking Event: Following the Law, Break the Mold

By Jessica Zafonte

The Women in IP Law Committee held its fall networking event at the offices of Frommer Lawrence & Haug LLP on Wednesday October 19th. It was an evening of wine, the opportunity to connect with other women in the field, the inspirational success story of one such particular individual, our keynote speaker, and more wine. The evening's speaker was Sarah Feingold, a lifelong artist who pursued a career in law, believing it to be the best way to protect other artists. Ms. Feingold was the first attorney to join the staff at Etsy and played an essential role in its exponential growth from a small start-up to a public company, now valued at \$2 billion. Ms. Feingold is now General Counsel at Vroom (although she still sells her handmade jewelry on Etsy). She had many tips on how to succeed as an attorney, including not being scared of rejection, whether it is when applying for employment positions, pitching new business, trying to get published, seeking speaking engagements, etc. In fact, Ms. Feingold's advice was to actually welcome rejection, because it is an indication that you are challenging yourself

professionally. After hearing many "nos," inevitably you will eventually hear a "yes." She also stressed the importance of supporting other women, not only because kindness is a more effective tool than callousness, but also because of the sexism that still exists in the legal field. Ms. Feingold showed the audience examples from her collection of professional letters that she has received over the years addressed "Dear Sir." Ms. Feingold's talk was lighthearted but also fiercely motivational. After she spoke, another leader in a male-dominated field, Heidi Turzyn, led the group in a wine tasting. Ms. Turzyn gave us insight into both the wines that we were tasting and the wine industry generally—and it seems that the legal field and wine business are similar in that both are competitive, ego-driven, and have quite a bit of

pretentiousness among their members! But, as the first female wine director at Gotham Bar & Grill, Ms. Turzyn echoed Ms. Feingold's sentiment that women need to work hard and support one another to reach their professional goals, whatever they may be.



Trademark Law & Practice Committee Hosts Spirited Panel Discussion on Lanham Act Damages

By Dyan Finguerra-DuCharme, Michael C. Cannata, and Frank M. Misiti

On November 10, 2016, the Trademark Law & Practice Committee hosted a panel discussion at Rivkin Radler LLP's Long Island office entitled, "Show Me The Money! A Primer on Lanham Act Damages."

The panel members included Dana Trexler Smith, a partner in the Forensic, Litigation and Valuation Services Group at EisnerAmper LLP, and John G. Plumpe, a principal at Charles River Associates, both accountants with decades of experience in providing expert witness services in connection with intellectual property matters. Frank M. Misiti, an attorney at Rivkin Radler LLP, was also a panelist and brought his expertise in intellectual property and insurance coverage litigation to the discussion. The panel was moderated by Michael C. Cannata, a partner in the Intellectual Property Practice Group at Rivkin Radler LLP and a Co-Chair of the Trademark Law & Practice Committee.

The discussion was attended by approximately thirty individuals, including in-house counsel, outside counsel, accountants, and law students. The panel addressed several different topics concerning the identification of damages under the Lanham Act, the computation of such damages, and the availability of insurance coverage for those damages.

Ms. Smith and Mr. Plumpe, accountants with experience in conducting damages analyses in intellectual property litigations, addressed the different methods for calculating both a disgorgement of an infringer's profits and, separately, a plaintiff's lost sales under 15 U.S.C. § 1117. They also addressed issues connected to the calculation of reasonable royalties and the availability of corrective advertising.

Mr. Misiti concluded the panel discussion by outlining the availability of insurance coverage for the defense of lawsuits seeking damages under the Lanham Act, as well as coverage for the payment of any judgments or settlements arising out of such lawsuits. He also addressed the typical defense costs associated with lawsuits for damages under the Lanham Act and the process by which a defendant seeks insurance coverage for those lawsuits.

The presentation resulted in numerous questions from those in attendance which, in turn, sparked a spirited exchange between the panel and the audience. The event was well received by those in attendance. The Trademark Law & Practice Committee looks forward to hosting another event on a different topic in late winter/early spring.

Extra . . . Extra – Call for Submissions!

The Publications Committee seeks original articles for possible publication in upcoming issues of *The Report*. Articles on all intellectual property-related topics will be considered.

An article can be any length, but a length of 1700 to 2500 words is about average. Articles should be submitted in MICROSOFT WORD®, 1997-2003 format (i.e., ".doc," not ".docx") and with endnotes rather than footnotes. Authors should also provide us with electronic copies of any sources cited in either the text of the article or in the endnotes to assist us with the editing process.

Please send your submission via e-mail to Publications Committee Co-Chairs Mary W. Richardson at mary.e.w.richardson@gmail.com, William Dippert at wdippert@patentusa.com, and Dale Carlson at dcarlson007@gmail.com. Please check with the Co-Chairs regarding the deadline for submission of your article.



THE NEW YORK
INTELLECTUAL PROPERTY
LAW ASSOCIATION

The
95th
Annual Dinner
IN HONOR OF THE
*Federal
Judiciary*

MARCH 31, 2017
NEW YORK HILTON MIDTOWN

NYIPLA is pleased to announce that the 95th Annual Dinner in Honor of the Federal Judiciary will be held at the **New York Hilton Midtown** on **Friday, March 31, 2017**. The Waldorf Astoria New York Hotel will be temporarily closing for renovations next year.

New York Hilton Midtown provides the opportunity to consolidate most of the dinner tables into one **Grand Ballroom** on the 3rd floor to provide Honored Guests, NYIPLA members and their guests with a view of the dais and a more collegial atmosphere. The NYIPLA also reserved the **Trianon Ballroom** on the 3rd floor for members and their guests who prefer a satellite room.

Dinner Online Reservation

As the firm's designated Judges Dinner Liaison, you have a username to access the Judges Dinner Online Reservation page: www.nyipla.org/judgesdinner. This will allow you to verify NYIPLA membership, enter the type and number of tables, add and edit names, and view your invoice.

Hospitality Suite Reservation

To reserve a hospitality suite for the day of the Judges Dinner, a firm must have attorneys who are NYIPLA members and meet the minimum number of dinner tables requirement. Please contact Ashley Nelson (Ashley.Nelson@hilton.com) and Trevor Witcher (Trevor.Witcher@hilton.com) for details.

Congratulatory Notice Reservation

The NYIPLA is pleased to announce that its 15th Annual Outstanding Public Service Award will be presented to the **Honorable Denny Chin**, *United States Court of Appeals for the Second Circuit*. If you would like to reserve space for a Congratulatory Notice in the Judges Dinner program, please contact dinner@nyipla.org for details.

NYIPLA 95TH ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY

“DAY OF THE DINNER” LUNCHEON CLE

Registration

11:00 AM – 11:30 AM

Rotunda, 3rd floor

Luncheon followed by a Discussion from a distinguished panel of Federal Judges

11:30 AM – 2:15 PM

Mercury Ballroom, 3rd floor

DINNER IN HONOR OF THE FEDERAL JUDICIARY

(BLACK TIE PREFERRED)

Registration

Firm Hosts and Honored Guests

5:00 PM – 8:00 PM

Rotunda, 3rd floor

Reception

NYIPLA Members and Honored Guests

6:30 PM – 7:30 PM

Mercury Ballroom, 3rd floor

Dinner

8:00 PM – 10:00 PM

Grand Ballroom & Trianon Ballroom, 3rd floor

15th Annual Outstanding Public Service Award

Honorable Denny Chin

Circuit Judge of the United States Court of Appeals for the Second Circuit

Dinner Speaker

Walter Isaacson

President and CEO of the Aspen Institute

Author of The Innovators; Steve Jobs; Einstein; Benjamin Franklin

The After-Dinner Party with DJ

10:00 PM

Mercury Ballroom, 3rd floor

MINUTES OF JULY 13, 2016

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

The Board meeting was held at Kenyon and Kenyon, LLP, One Broadway, New York, NY. President Walter Hanley called the meeting to order at approximately 12:15 p.m.. In attendance were:

Dorothy Auth (by phone)	Matthew McFarlane
Mark Bloomberg	Charles Macedo
Garrett Brown	Colman Ragan
Frank DeLucia (by phone)	Robert Rando
Walter Hanley	Heather Schneider
Robert Isackson	Peter Thurlow
William McCabe	Jeanna Wacker
Kathleen McCarthy	

Annemarie Hassett was absent and excused from the meeting. Lisa Lu was in attendance from the Association's executive office.

The meeting was called to order, and President Hanley introduced the auditors from Loeb & Troper LLP, Alan Blum and Anna Shaverofa. The auditors reported that the audit they performed was clean, with no material weaknesses and one minor recommendation regarding conflicts. The auditors explained the Board of Directors Presentation, financial statements and auditor's report, management letter, and Form 990, which were accepted by the Board. The auditors then left the meeting.

The Board approved the Minutes of the June 22, 2016 Board meeting. Mr. Rando briefly addressed the financial report.

The Board approved twelve new members and then discussed membership more generally, including reviewing a report on membership by year. The Board discussed possible financial incentives to encourage membership in the Association (e.g., bulk discounts, free CLEs, etc.), which the Strategic Planning Committee will consider in more detail. Mr. McFarlane and Mr. Ragan will schedule a meeting.

Mr. Isackson provided a report from the Amicus Brief Committee on upcoming proposals that will be circulated to the Board, including the amicus brief in *Star Athletica, LLC v. Varsity Brands, Inc.*, which is due July 22, 2016.

The Board then discussed the Judges Dinner 2017, including a report from President Hanley and others who visited the Hilton, Sheraton, and Marriott Marquis. The Association will require additional suites for the judges, which could perhaps be booked at the Ritz-Carlton. The Board authorized Ms. van Rein to negotiate with the Hilton and the Ritz-Carlton.

Ms. Auth provided a report on the Legislative Action Committee, which has been considering whether to step down the services of ACG from the current level of \$10,000 to \$7,500/month. Given the items that may be considered by Congress this year,

the Association will continue to retain ACG at the level of \$10,000. Board members proposed additional topics for the meeting with Representative Jeffries that was arranged by the LAC for July 21.

Ms. Schneider reported on work with the Young Lawyers Committee, whose co-chairs met with President Hanley, Ms. Hassett, Ms. Schneider, and Ms. van Rein in June. The YLC is interested in (1) a mentoring program; (2) classes at local law schools for an NYIPLA IP certificate; (3) expanding the YLC social get-togethers to non-committee members; (4) the budget for future events; and (5) a series of talks from business leaders. Ms. Schneider will prepare a survey on the possible mentoring program.

The Board discussed other upcoming programs, including the Moot Court, trademark program, RPI program, and joint NYIPLA/NJIPLA program. There was some interest in exploring the possible creation of an ad hoc Hatch-Waxman/Biologics Committee, which Mr. McCabe will discuss with the Litigation Committee co-chairs. There was also some discussion of a possible PTAB committee.

The Meeting was adjourned at approximately 2:30 p.m.

The next Board meeting will take place on September 20, 2016 and will include a dinner with committee chairs.

Committee Liaisons:

Amicus Brief – Rob Isackson
 Corporate – Colman Ragan
 Copyright Law & Practice – Garrett Brown
 Hon. William C. Conner Writing Competition – Frank DeLucia
 Privacy, Big Data and Cybersecurity – Katie McCarthy
 IOTY – Charles Macedo
 Law Firm Management – Jeanna Wacker
 LAC – Anne Hassett
 Media – Robert Rando
 Patent Law & Practice – Peter Thurlow
 Patent Litigation – Bill McCabe
 Presidents' Forum – Walt Hanley
 Programs – Mark Bloomberg
 Publications – Frank DeLucia
 Strategic Planning – Walt Hanley
 Trademark Law & Practice – Katie McCarthy
 Trade Secrets – Colman Ragan
 Women in IP Law – Heather Schneider
 Young Lawyers – Heather Schneider

Mark your Calendars for the 2016-2017 NYIPLA Board Meetings – all meetings will be at Kenyon & Kenyon LLP's office unless otherwise noted.

September 20, 2016 (dinner including committee chairs), October 20, 2016, November 09, 2016, December 14, 2016, January 11, 2017, February 15, 2017 (dinner including committee chairs), March 8, 2017, April 20, 2017 and May 16, 2017 (Annual Meeting).

MINUTES OF SEPTEMBER 20, 2016

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

The Board meeting was held at the Union League Club, 38 East 37th Street, New York, NY. President Walter Hanley called the meeting to order at approximately 5:00 p.m. In attendance were:

Dorothy Auth	Kathleen McCarthy
Mark Bloomberg	Matthew McFarlane
Garrett Brown	Charles Macedo
Frank DeLucia	Colman Ragan
Walter Hanley	Robert Rando (by phone)
Annemarie Hassett	Heather Schneider
Robert Isackson	Peter Thurlow
William McCabe	Jeanna Wacker

Feikje van Rein and Lisa Lu were in attendance from the Association's executive office.

The meeting was called to order by President Hanley and the Board approved the Minutes of the July 13, 2016 Board meeting.

Mr. Rando addressed the financial report, indicating that the Association is in sound financial condition. The Board approved new members and then discussed the approximately 10% decline in membership, including the student and 3+ year active segments. The Board decided to send a membership survey. The Board also discussed the pros and cons of having a no-solicitation policy to attract corporate members. Mr. Ragan will discuss that topic with the Corporate Committee, Ms. Schneider will draft the survey, and Ms. Hassett will talk to heads of other organizations (such as IPO, AIPLA, LAIPLA) regarding their membership efforts.

The Amicus Brief and Legislative Action Committees gave reports on their activities, including the *Life Technologies Corp. v. Promega Corp.* amicus brief, and the idea of preparing a White Paper on Section 101 to discuss with members of Congress.

The Board reviewed the arrangements at the Hilton for the Judges Dinner and the Ritz-Carlton for the judges' suites, with a shuttle in-between and a breakfast at the Ritz-Carlton on Sunday morning. President Hanley discussed a possible keynote speaker, Walter Isaacson, who wrote a biography of Steve Jobs, was CEO of CNN, and does policy work on innovation. The Board discussed and approved giving the annual public service award to Judge Denny Chin.

The Board considered whether to allow translation services, ESI vendors, or other entities to sponsor events (such as Young Lawyers Committee cocktail parties), and decided not to do so at this time.

The Programs Committee reported on upcoming programs including the Patent Litigation Committee event that night, the new Hatch-Waxman/BPCIA subcommittee call, the One-Day Patent CLE, and the NJIPLA event. In terms of new business, the Board discussed the extensive number of events being planned and reiterated that events should go through the Programs Committee, and there could be more joint committee sponsorship of events. The Media Committee has also asked for a liaison from each committee to keep them apprised of events.

The Meeting was adjourned at 6:30 p.m. to allow for the reception with the Committee Co-Chairs.

The next Board meeting will take place on October 20, 2016.

Committee Liaisons:

Amicus Brief – Rob Isackson
Corporate – Colman Ragan
Copyright Law & Practice – Garrett Brown
Hon. William C. Conner Writing Competition –
Frank DeLucia
Privacy, Big Data and Cybersecurity –
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Moving UP ▲ & Moving ON ➤➤➤

- John Squires, formerly of Perkins Coie LLP, has joined Gibson Dunn & Crutcher LLP as a partner in its Intellectual Property, Financial Institutions, and Technology Transactions Practice Groups.
- Robert Isackson, formerly of Orrick Herrington & Sutcliffe LLP, has joined Venable LLP as a partner in its Intellectual Property Litigation practice. He is also a Member of the Board of Directors of the NYIPLA.
- Irene Hudson, formerly of Fish & Richardson, has joined BakerHostetler as a partner in its Intellectual Property Group and on its Biotechnology, Chemical and Pharmaceutical team.
- David Manspeizer, formerly of WilmerHale, and Greg Chopskie, formerly of Gilead Sciences, Inc., have joined Morrison & Foerster LLP as partners in its Intellectual Property Litigation Practice.
- Craig Tractenberg, formerly of Nixon Peabody LLP, joins Fox Rothschild LLP as a partner in its Litigation Department in the Philadelphia and New York offices.
- Daniel Margolis has been promoted to partner in Goodwin Procter LLP's Litigation Department and is a member of its Intellectual Property Litigation Practice.
- Giuseppe Molaro, formerly of Leviton Manufacturing Co., joined Kacvinsky Daisak Bluni PLLC as a principal in its Princeton office.
- Kevin Culligan and John Hanish, formerly of Goodwin Procter LLP, and John Hintz, formerly of Rimon PC, have joined Maynard, Cooper & Gale P.C. as partners in its Intellectual Property practice and have opened up the firm's New York office.

*The Report's **Moving Up and Moving On** feature is for publicizing news of intellectual property attorneys' transitions and accolades. If you have changed your firm or company, made partner, received professional recognition, or have some other significant event to share with the Association, please send it to *The Report* editors: Mary Richardson (mary.e.w.richardson@gmail.com), William Dippert (wdippert@patentusa.com) or Dale Carlson (dlcarlson007@gmail.com).*



NYIPLA Job Board

A perfect chance to submit job openings,
refer members to postings,
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CALL FOR NOMINATIONS!

2017 NYIPLA INVENTOR OF THE YEAR AWARD

Deadline: Friday, December 30, 2016

The 2017 Inventor of the Year
will be honored at the
Association's Annual Meeting
and Awards Dinner
to be held at
The Princeton Club of New York
on Tuesday, May 16, 2017

**This year's winner will be
awarded \$5,000.00**

We invite you to nominate an
individual or group of individuals
who, through their inventive talents,
have made a worthy contribution to
society by promoting the progress of
Science and useful Arts.

See [http://www.nyipla.org/nyipla/
InventorOfTheYear.asp](http://www.nyipla.org/nyipla/InventorOfTheYear.asp)

for more information, including submission rules,
instructions, and answers to
frequently asked questions.

Should you have any questions,
feel free to contact:

David Leichtman at
dleichtman@robinskaplan.com or
Jonathan Auerbach at
jonathan@radip.com

2017 NYIPLA HONORABLE WILLIAM C. CONNER INTELLECTUAL PROPERTY LAW WRITING COMPETITION

Submission Deadline:

March 3, 2017



- ✓ The Winner will receive a cash award of \$1,500.00
- ✓ The Runner-up will receive a cash award of \$1,000.00

-
- The competition is open to students
enrolled in a J.D. or LL.M.
 - The subject matter must be directed
to one of the traditional subject areas
of intellectual property, i.e., patents,
trademarks, copyrights, trade secrets,
unfair trade practices and antitrust.
 - Entries must be submitted electronically by
March 3, 2017 to the address provided
below:
Richard H. Brown
Day Pitney LLP, 7 Times Square,
New York, NY 10036-7311
Tel: 1.212.297.5854 **Fax:** 1.212.916.2940
E-mail: rbrown@daypitney.com
 - See [rules](#) for details on submission requirements at
www.nyipla.org

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The Report is published bi-monthly for the members of The New York Intellectual Property Law Association.

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