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## NYIPLA PRESIDENT'S CORNER

### COLMAN RAGAN



Well, 2020 has (mercifully) come to an end and given way to 2021, which has its own challenges for all of us personally, and as an Association. If you are like me, you are probably pretty much sick of working from your basement, or kitchen table, or where ever you built your "temporary" home office.

Instead of finishing with a quote from Led Zeppelin, I will start this time – in large part inspired by our fantastic February weather here in New York. "I felt the coldness of my winter, I never thought it would ever go." But it has.

The days are getting longer and warmer, and hopefully the snow will stop coming soon. Perhaps the kids will go back to school soon – we can all dream, right?

I am very excited about 2021 for the NYIPLA. In 2020, we rapidly adapted to providing our content and meetings in a virtual format, and in the first part of 2021, we are showing that we are perfecting it.

That leads me to the big news (which all of you already know). We are having the Judges Dinner in a virtual format on April 22. The event will feature a panel discussion of S. 4711 – The Daniel Anderl Judicial Security and Privacy Act, presentation of the Outstanding Public Service Award, virtual networking, and perhaps even video of yours truly attempting to cook in a tuxedo. That should provide some comic relief. If you have not registered for the Judges Dinner, please do so as soon as you can. If you have, see you there!

In 2021, the NYIPLA will continue to foster diversity in the next generation of inventors, content creators, and innovators as well as the IP legal community. We already held a virtual event with the NYIPLEF discussing fostering diversity in the innovation community and the legal profession and will continue that strong partnership throughout the year. We also signed on to the comments on the USPTO's diversity initiatives submitted by member school, Benjamin N. Cardozo School of Law.

2021 also brings a new President and Congress to Washington. The NYIPLA was contacted by the Biden transition team to give our thoughts on how the new administration can continue to foster innovation in the arts and sciences. We expect Congress, and the individual states, to continue to legislate in the areas of patents, copyrights, trademarks, privacy, and IP-adjacent issues such as antitrust law. As always, the NYIPLA will continue to provide its unbiased insight into the pros and cons of any IP legislation proposed by Congress – and the states.

By the time you read this, we will have held our annual Biosimilars panel, which is always a draw. The Women's Committee, Patent Litigation Committee and Programs Committee once again worked together to put together an amazing panel with great content. The PTAB and Amicus Committees put on an outstanding program giving voice to the various amici that filed briefs in the *Arthrex* case heard by the Supreme Court. The Amicus Committee also recently filed briefs in *Minerva Surgical, Inc. v. Hologic, Inc. et. al.* (on the issue of whether the doctrine of assignor estoppel should be a hard-and-fast rule or a rule to be applied equitably) and *American Axle & Mfg., Inc. v. Neapco Holdings LLC. et. al.* (on the issue of the proper rules for determining patent eligibility). The Young Lawyers Committee also held an "IP Poetry Slam" which provided an innovative way for NYIPLA student members to present essays on intellectual property law. We have so much other great content on the way including the Trademark one-day CLE event this summer.

We continue to develop the new NYIPLA "IP Boot Camp" covering several aspects of IP law for our members, especially our younger lawyers and new associates. We expect that we will start this program by the summer, providing sessions on IP litigation. From there, the "IP Boot Camp" will move to other aspects of IP, including IP transactions and Privacy.

This will be my final President's Corner. I cannot believe how fast the time has gone. We have had a truly busy year in trying circumstances, but the NYIPLA did not back down. We persevered and built a foundation for a more digital future. By necessity, we have found a way to take our bread-and-butter, in person events, and bring that feel to a virtual format. Soon, we will be getting together in person, but the lessons we have learned thus far this year will help us provide our unique perspective and CLE content to a much broader audience going forward.

I want to thank the entire NYIPLA membership, including Board, all the committee chairs and committee members for the hard work and determination to keep the NYIPLA going this year. I also want to thank our administrative support team for keeping us going this year. We could not have done it without you. That is what makes the NYIPLA special – we stick together, especially in the hardest of times.

Best Regards,

Colman

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# CAFC's Opinion in *CardioNet v. InfoBionic* Highlights the Importance of Patent Drafting in Defeating Potential Section 101 Challenges

BY: DR. AMY SONG

Since the Supreme Court's decision in *Alice v. CLS Bank*, the Federal Circuit has issued a number of opinions addressing what is patent-eligible subject matter. In an opinion issued in April 2020, the Federal Circuit relied heavily on the written description of the patent-at-issue, and found the asserted claims to be directed to patent-eligible subject matter in the form of an improved cardiac monitoring device.<sup>[1]</sup> This article addresses the potential importance of intrinsic evidence in defeating potential Section 101 challenges.

## Background

Section 101 provides that “any new and useful process, machine, manufacture, or composition of matter” is patent-eligible.<sup>[2]</sup> The Supreme Court has identified certain subject matter (also known as “judicial exceptions”) that are not patent-eligible, i.e., laws of nature, natural phenomena, and abstract ideas.<sup>[3]</sup> The Supreme Court further articulated a two-step test in *Alice* to examine patent eligibility when a patent claim may involve one of the three judicial exceptions.<sup>[4]</sup> At step one, courts consider the claim in its entirety to determine whether the claim as a whole is directed to a judicial exception. If the claim is not directed to a judicial exception, the claim satisfies Section 101 and courts need not proceed further.<sup>[5]</sup>

The Federal Circuit has found in a number of cases that when the claimed invention improves the functioning of a computer or another technical field, the claim as a whole is not directed to a judicial exception.<sup>[6]</sup> In view of the Federal Circuit's decisions, the United States Patent and Trademark Office (USPTO) amended the Ninth Edition of the Manual of Patent Examination Procedure (MPEP) in June 2020 to provide further guidance to Examiners in evaluating whether a claim that includes a

judicial exception may nonetheless be patent-eligible.<sup>[7]</sup>

## District Court's Decision

In *CardioNet v. InfoBionic*, CardioNet sued InfoBionic for infringement of U.S. Patent No. 7,941,207 (“the '207 patent”), which describes certain cardiac monitoring systems and techniques for detecting and distinguishing atrial fibrillation and atrial flutter from other various forms of cardiac arrhythmia.

The asserted claim 1 of the '207 patent recited:

A device, comprising the:

- a beat detector to identify a beat-to-beat timing of cardiac activity;
- a ventricular beat detector to identify ventricular beats in the cardiac activity;
- variability determination logic to determine a variability in the beat-to-beat timing of a collection of beats; relevance determination logic to identify a relevance of the variability in the beat-to-beat timing to at least one of atrial fibrillation and atrial flutter; and
- an event generator to generate an event when the variability in the beat-to-beat timing is identified as relevant to the at least one of atrial fibrillation and atrial flutter in light of the variability in the beat-to-beat timing caused by ventricular beats identified by the ventricular beat detector.<sup>[8]</sup>

The district court quickly dismissed the case under Fed. R. Civ. Proc. 12(b)(6) on the ground that the asserted claims were directed to patent-ineligible subject matter under § 101.<sup>[9]</sup> While the district court recognized that “idea of using a machine to monitor and analyze heartbeat variability and interfering beats so as to alert the user of potential [atrial fibrillation or



atrial flutter] events may well improve the field of cardiac telemetry,” it nevertheless found that CardioNet “did not identify improvements to any particular computerized technology.”<sup>[10]</sup>

### Federal Circuit’s Opinion

The Federal Circuit reversed and remanded. The Court held that the asserted claims are “directed to an improved cardiac monitoring device and not to an abstract idea.”<sup>[11]</sup> The Court based its holding on the claim language and the written description of the patent. First, the Court found that the language of claim 1 focuses on “a specific means or method that improves cardiac monitoring technology [and is not] directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.”<sup>[12]</sup>

Second, the Court looked to the written description of the patent and found that it confirmed that the claimed invention claimed improvements to cardiac monitoring technology.<sup>[13]</sup> The Summary section of the patent included about 40 lines to describe the purported advantages of the disclosed cardiac monitoring systems and techniques, including improved sensitivity and positive predictivity in detecting atrial fibrillation (“AF”), the ability to identify sustained AF episodes, well-adapted to monitor cardiac signal of ambulatory patients, well-adapted to real-time monitoring of arrhythmia patients, requiring minimal computational resources, and requiring no training before different types of cardiac arrhythmia can be distinguished.<sup>[14]</sup> For example, the ‘207 patent stated that:

*The described systems and techniques are well-adapted to monitoring cardiac signals of ambulatory patients who are away from controlled environments such as hospital beds or treatment facilities. [...] The described systems and techniques are also well-adapted to real-time monitoring of arrhythmia patients, where minimal delays in distinguishing between different types of cardiac arrhythmia can speed the delivery of any urgent medical care. The described systems and techniques also require minimal computational resources.*

*Further, the described systems and techniques do not require training before different types of cardiac arrhythmia can be distinguished.*<sup>[15]</sup>

Even though they may not be improvements to computerized technology per se, the Court “consider[ed] them important in [the Court’s] determination that the claims are drawn to a technological improvement.”<sup>[16]</sup>

Regarding the district court’s decision, the Federal Circuit identified three errors. First, the Court found that “[a]t the heart of the district court’s erroneous step one analysis is the incorrect assumption that the claims are directed to automating known techniques.”<sup>[17]</sup> The Court reasoned that nothing in the record, in particular the writing description, supports the district court’s finding.<sup>[18]</sup> Second, the Court found that “the district court erred by disregarding the written description’s recitation of the advantages of the claimed invention.”<sup>[19]</sup> Finally, the Court found that the district court erred in “oversimplifying the claims by looking at them generally and failing to account for the specific requirements of the claims.”<sup>[20]</sup>

In the last part of the opinion, the Federal Circuit held that remand was unnecessary to assess the state of the art because “Alice step one presents a legal question that can be answered based on the intrinsic evidence.”<sup>[21]</sup> The Court stated that in determining whether a claim is directed to a technological improvement, “a court may well consult the intrinsic evidence, including the plain claim language, written description, and prosecution history” and “need not consult the prior art to see if, in fact, the assertions of improvement in the patent’s written description are true.”<sup>[22]</sup> The Court reasoned that “the § 101 patent-eligibility inquiry is only a threshold test,” and “we reserve for §§ 102 and 103 purposes our comparison of the prior art and the claims to determine if the claims are, in fact, an improvement over the prior art.”<sup>[23]</sup>

Judge Dyk dissented on the last part of the opinion. He opined that the majority erred in “limiting the use of extrinsic evidence to establish that a practice is longstanding.”<sup>[24]</sup> The majority, however, responded that courts are still allowed,

within their discretion, “[to] look outside the intrinsic evidence as part of their Alice step one inquiry.”<sup>[25]</sup> The majority further stated that, however, “there is no basis for requiring, as a matter of law, consideration of the prior art in the step one analysis in every case.”<sup>[26]</sup>

The case is currently on remand pending in the U.S. District Court for the District of Massachusetts.

## Conclusion

The Federal Circuit’s decision in *CardioNet v. InfoBionic* highlights the importance of intrinsic evidence in defeating potential Section 101 challenges. Similarly, in a recent opinion, *Simio, LLC v. FlexSim Software*, the Federal Circuit relied heavily on the specification of the patent-at-issue to reach its decision that the asserted claim was directed to a patent ineligible abstract idea. The Federal Circuit repeatedly quoted the specification and found that the purported advance of the claimed computer-based system “[s]imply appl[ie]d the already widespread practice [] to the environment of object-oriented simulations” and the asserted claim was “directed to the use of conventional or generic technology....”<sup>[27]</sup>

Patent owners should consider drafting claims that focus on a specific technique that improves a technology or technical field, and avoid language that merely invokes generic processes and machinery. Patent owners should also consider including into the specification a description of specific advantages of the claimed invention, for example, a paragraph specifically identifying the “practical applications” achieved by the invention, concrete language of technical improvements that could be amended into the claims if it were ever necessary to overcome a 101 rejection, or data showing specific improvements (e.g., improved sensitivity, accuracy, or efficacy) over the existing technologies.

<sup>[1]</sup>See *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1368 (Fed. Cir. 2020).

<sup>[2]</sup>35 U.S.C. § 101.

<sup>[3]</sup>See *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

<sup>[4]</sup>See *id.* at 217-218.

<sup>[5]</sup>See *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1007 (Fed. Cir. 2018).

<sup>[6]</sup>See *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1338 (Fed. Cir. 2016); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314-1316 (Fed. Cir. 2016); *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259-60 (Fed. Cir. 2017).

<sup>[7]</sup>M.P.E.P. §2106.04(d)(1) (“A claim reciting a judicial exception is not directed to the judicial exception if it also recites additional elements demonstrating that the claim as a whole integrates the exception into a practical application. One way to demonstrate such integration is when the claimed invention improves the functioning of a computer or improves another technology or technical field.”)

<sup>[8]</sup>*CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1365 (Fed. Cir. 2020).

<sup>[9]</sup>See *CardioNet, LLC v. InfoBionic, Inc.*, 348 F. Supp. 3d 87, 93 (D. Mass. 2018), *rev’d and remanded sub nom. CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358 (Fed. Cir. 2020).

<sup>[10]</sup>*Id.* at 93.

<sup>[11]</sup>*CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1368 (Fed. Cir. 2020).

<sup>[12]</sup>*Id.* at 1368-1369.

<sup>[13]</sup>*Id.* at 1368-1370.

<sup>[14]</sup>The ’207 patent col. 3 ll 6-43.

<sup>[15]</sup>*Id.* at col. 3 ll 27-43.

<sup>[16]</sup>*CardioNet*, 955 F.3d at 1370.

<sup>[17]</sup>*Id.*

<sup>[18]</sup>*Id.*

<sup>[19]</sup>*Id.* at 1371.

<sup>[20]</sup>*Id.*

<sup>[21]</sup>*Id.* at 1372.

<sup>[22]</sup>*Id.* at 1372-1373.

<sup>[23]</sup>*Id.* at 1373.

<sup>[24]</sup>*Id.* at 1375.

<sup>[25]</sup>*Id.* at 1373.

<sup>[26]</sup>*Id.*

<sup>[27]</sup>*Simio, LLC v. FlexSim Software Prod., Inc.*, No. 2020-1171, 2020 WL 7703014, at \*4 (Fed. Cir. Dec. 29, 2020).



# Notable Trademark Decisions

MARCH 2021

BY: SCOTT GREENBERG AND ANNA ANTONOVA

## The Fourth Circuit Affirms the Grant of Summary Judgment in Favor of Apple, Upholding a Permanent Injunction Against an Infringer's Use of the Mark "ipad" and Dismissing the Opposition to Apple's Trademark Application

In September 2007, RXD Media LLC ("RXD") launched "ipad.mobi"—an Internet-based notepad for making simple lists online. At the time, Apple, Inc. ("Apple") has had commercial success with other "i-products," including the "iPod," "iTunes," and the "iPhone." However, the "iPad" touchscreen tablet was not released until January 2010. In July 2009 and January 2010, in anticipation of the iPad release, Apple filed intent-to-use applications for trademark protection of the "ipad" mark in connection with electronic goods and services. Additionally, in 2010, Apple acquired from Fujitsu, Inc. (Fujitsu) a registration for "ipad," which had a filing date of March 2003.

After Apple filed its applications in 2010, RXD filed its own applications to register the mark "ipad" and opposed Apple's applications. *RxD Media, LLC v. IP Application Dev. LLC*, 125 U.S.P.Q.2d 1801 (T.T.A.B. 2018). During the Trademark Trial and Appeal Board ("TTAB") opposition proceedings, which were ongoing for several years, in 2016, RXD launched a "rebranded" website for cloud storage services under the name "ipadtoday.com" using a logo that depicted an image of a cloud with "ipad™" displayed alongside Apple devices with the "ipad™" logo.

In February 2018, the TTAB approved Apple's applications and dismissed RXD's opposition to these applications. *Id.* Further, the Board denied RXD's applications to register the "ipad" mark, at which point RXD turned to the district court for a review of the TTAB decision. In this latest installment of the litigation over the mark "ipad," RXD appealed the district court's grant of summary judgment in favor of Apple, seeking to reverse the finding that RXD infringed Apple's marks and challenge the permanent injunction against RXD prohibiting it from commercial use of the terms "ipad" and "ipod." *RxD Media, LLC v. IP Application Dev.*, 377 F. Supp. 3d 588 (E.D. Va. 2019). The named defendant, IP Application Development LLC, is a company formed and wholly owned by Apple for the purpose of registering the "ipad" mark.

RXD challenged the district court's ruling on three bases:

1. The district court failed to consider that RXD was the senior user of the descriptive mark "ipad" and that Apple had not established secondary meaning before RXD's alleged infringing use;
2. Apple failed to show a likelihood of confusion; and
3. The permanent injunction was too broad in scope.

*RxD Media, LLC v. IP Application Dev.*, 986 F.3d 361, 369 (4th Cir. 2021). Additionally, RXD appealed the dismissal of its opposition to Apple's intent-to-use applications to register the "ipad" mark. *Id.* The TTAB dismissed the opposition, and the district court affirmed. *RxD Media, LLC*, 125 U.S.P.Q.2d 1801; *RxD Media, LLC v. IP Application Dev.*, 377 F. Supp. 3d 588. Seeking to void the applications, RXD argued to the Fourth Circuit that Apple lacked a bona fide intent-to-use the mark for services listed in the applications.

### *RXD's Use of the Mark in 2007 Does Not Grant It Superior Rights as a Matter of Law*

RXD claimed that the district court failed to consider that RXD was the first user of the descriptive mark “ipad” and, therefore, had superior rights to the mark as a matter of law. On appeal, RXD did not argue that its earlier use of “ipad” entitled RXD to trademark protection. It claimed only that RXD did not infringe Apple’s mark because RXD’s use of “ipad.mobi” predated Apple’s acquisition of secondary meaning in the “ipad” descriptive mark.

However, the appellate court found this argument unavailing. Importantly, the court noted that in 2010 Apple acquired a trademark registration for “ipad” from Fujitsu, which had a “first use” date that predated even RXD’s use. As a result of the acquisition, Apple “stepped into the shoes of Fujitsu” and obtained a “first use” date of January 2002 and a “priority use” date of March 2003.

However, even assuming that RXD was a senior user, Apple’s infringement claim did not rest on RXD’s 2007 use of “ipad.mobi.” Instead, Apple claimed infringement by RXD’s October 2016 use in “ipadtoday.com” where RXD mimicked Apple products. By this point, Apple’s iPad had achieved significant commercial success, and the mark “ipad” had acquired secondary meaning. Also, by October 2016, Apple’s registered trademark had become incontestable, earning it the presumption of validity and a secondary meaning. Because Apple was only suing on infringement from October 2016, Apple did not need to establish secondary meaning before RXD’s use of “ipad.mobi” in 2007, as RXD argued. Apple only needed to demonstrate that it established secondary meaning before RXD’s use of the mark in “ipadtoday.com” in October 2016.

Furthermore, the court found that RXD’s use of the mark in 2016 infringed Apple’s rights because Apple qualified as an “intervening junior user” of the mark. Even if RXD was the “first user” of the mark in 2007, its use of the mark on its “ipadtoday.com” website in 2016 was “wholly altered,” and therefore not entitled to protection. Notably, trademark law does not protect a first user’s expansion beyond the original product line into an area occupied by an “intervening junior user” who has established its own rights in the mark. In 2007, when RXD claimed its first use, RXD’s original product line was limited to a mobile Internet notepad used to create simple lists. By January 2010 Apple released a much more sophisticated device with many more capabilities and features. Apple began using the mark thereafter as an intervening user of a product that was much different and much more sophisticated than RXD’s original product. Even if RXD’s use of “ipad” was lawful when used as part of “ipad.mobi” in 2007, Apple became the intervening junior user before RXD rebranded and expanded its services to cloud storage with its “ipadtoday.com” website.

### *Fourth Circuit Affirms that Apple Demonstrated a Likelihood of Confusion*

Although RXD claimed that Apple failed to show a likelihood of consumer confusion, the court was not convinced.

In support of its position, Apple furnished survey evidence to prove actual confusion. The survey showed that 27 percent of consumers mistakenly believed that Apple was the source of, sponsor of, or affiliated with, RXD’s use of “ipad” on the “ipadtoday.com” website. The court noted that this is a higher percentage than the percentage of confusion the court has found persuasive in the past to demonstrate a likelihood of confusion. *See, e.g., Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 159 (4th Cir. 2012) (finding a confusion rate of 17 percent to be clear evidence of actual confusion). Actual confusion is the most important factor in the analysis; however, Apple also offered anecdotal evidence of confusion through comments posted on RXD’s Facebook page.

Another contested factor the court considered was the similarity of goods and services. Both RXD and Apple used the “ipad” mark in connection with computer goods and services. RXD claimed that its use was not infringing because the goods and services were not identical. However, the court stated that the goods and services do not need to be identical or in direct competition with each other in order to



find that the goods or services at issue are similar under a likelihood of confusion analysis. Here, the court found that the goods and services at issue were sufficiently related to cause consumer confusion.

The court also discussed RXD's intent in adopting the "ipad" mark. In particular, the court noted that RXD mimicked aspects of Apple's branding when RXD redesigned its website in 2016. Furthermore, evidence from an Internet forum indicated that RXD was aware that its use of "ipad" could constitute trademark infringement, and nonetheless chose to proceed anyway, which the court found to suggest that this was done in bad faith.

The rest of the factors considered by the court in the likelihood of confusion analysis were found to either be neutral or weighed in favor of Apple. Additionally, the key factor—evidence of actual confusion—weighed strongly in favor of Apple. RXD's argument that summary judgement was inappropriate also failed because most factors clearly weighed heavily in favor of Apple and thus no reasonable jury could have concluded that RXD's use of the "ipad" mark was unlikely to cause consumer confusion.

#### *The District Court Did Not Err in Issuing a Broad Permanent Injunction*

RXD challenged the broad scope of the court's permanent injunction, which prohibited RXD from employing all uses or variations of the "ipad" or "ipod" marks. The court reasoned that RXD was a "proven infringer" and that it was proper for the district court to require that RXD keep a "safe distance" from its previously unlawful conduct. The Fourth Circuit found that the evidence of RXD's infringement was clear in this case, and concluded that the district court did not abuse its discretion.

#### *Dismissal of RXD's Opposition to Apple's Intent-to-Use Applications Was Proper Because Apple Was Not Required to Show a Bona Fide Intent to Use the Mark For Goods and Services Not Listed in the Application*

In its final effort to avoid infringement liability, RXD sought to invalidate Apple's underlying registrations on the ground that the Apple marks were void because Apple lacked a bona fide intent to use the "ipad" mark for "cloud storage services" when it filed its intent-to-use applications. RXD, therefore, called on the Fourth Circuit to reverse the district court's decision affirming the TTAB's dismissal of RXD's opposition to the Apple's applications.

As the challenger, RXD had the burden to show that Apple lacked a bona fide intent to use the "ipad" mark, but RXD failed to meet its burden because there was no absence of Apple's intent. In fact, Apple produced licensing agreements and business plans that supported its bona fide intent to use the mark for the applied-for goods and services. However, Apple never applied for the use of the mark in connection with cloud storage. Thus, the court found that Apple was not required to prove a bona fide intent to use the trademark for services not listed in its application, and its applications are not invalid as a result.

*RXD Media, LLC v. IP Application Dev. LLC*, 986 F.3d 361, 2021 U.S.PQ.2d 81 (4th Cir. Jan. 21, 2021) (precedential). [AA]

#### **CAFC Affirms the TTAB's Ruling of No Likelihood of Confusion Between Word-and-Design Logo Marks For Gas Station Convenience Stores**

Weigel Stores, Inc.'s ("Weigel") applied to register the following mark in connection with food and beverage goods and related services used by Weigel in its operation of combination convenience stores and gas stations:



Registration was opposed by QuikTrip West, Inc. (“QuikTrip”) on the ground of likelihood of confusion with the following mark previously used and registered by QuikTrip in connection with food and beverage products and related services provided by QuikTrip in connection with its combined convenience store and gas stations:



The Trademark Trial and Appeal Board (“TTAB”) dismissed the opposition, concluding that there was no likelihood of confusion, based primarily on the dissimilarity between the two marks. On appeal, the U.S. Court of Appeals for the Federal Circuit (“CAFC”) affirmed the Board’s determination in a precedential decision in January 2021. *QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 U.S.P.Q.2d 35 (Fed. Cir. Jan. 7, 2021).

The Court noted that a likelihood of confusion under Section 2(d) of the Lanham Act (15 U.S.C. § 1052(d)) is determined based on the factors set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (“the *DuPont* factors”). The ultimate question of a likelihood of confusion is a legal determination based on underlying findings of fact relating to the *DuPont* factors. The CAFC reviews the Board’s factual findings on each relevant *DuPont* factor for substantial evidence, but the CAFC reviews the Board’s weighing of the *DuPont* factors de novo. *QuikTrip West*, 984 F.3d at 1034.

The CAFC held that there was substantial evidence in the record, i.e., evidence which a reasonable mind might accept as adequate to support the conclusions, with regard to the Board’s factual findings on whether a likelihood of confusion existed between the marks at issue. In particular, the Board found that the following factors pointed toward a likelihood of confusion: (i) the parties’ identical-in-part goods and related services; (ii) overlapping trade channels; (iii) overlapping classes of customers; and (iv) similar conditions of purchase. Nevertheless, the Board ultimately concluded that the marks were so dissimilar as to avoid a likelihood of confusion. *Id.*

When comparing the marks, the Board accorded less weight to the shared term KITCHEN(S) because “kitchen” is a “highly suggestive, if not descriptive” word. The Board’s holding discussed the evidence of record demonstrating that “kitchen” is a descriptive term, citing dictionary entries defining a kitchen as a room where food is prepared, and numerous articles, third-party uses, and third-party registrations of marks incorporating the word “kitchen” for sale of food and food-related services. Based on this evidence, the Board found that the term KITCHENS was a relatively weak portion of QuikTrip’s mark. The CAFC found no error in this assessment, nor in the Board’s affording of more weight to the dominant, distinct portions of the marks—Weigel’s encircled “W” next to the surname Weigel’s and QuikTrip’s “QT” in a square below a chef’s hat—given their prominent placement, unique design, and color. *Id.* at 1035-36.

The CAFC also held that substantial evidence supported the Board’s finding that Weigel had not adopted the applied-for mark in bad faith. Before both the Board and the CAFC, QuikTrip argued unsuccessfully that Weigel adopted its mark in bad faith, pointing to evidence including Weigel’s alleged surreptitious photographing of QuikTrip’s stores and its examination of QuikTrip’s marketing materials. *Id.* at 1036.

The Board found that Weigel did not adopt the mark in bad faith, noting that Weigel, in response to QuikTrip’s letters objecting to the mark, modified its mark not once, but twice, before arriving at the version of the mark that Weigel applied to register. *Id.*

In particular, Weigel began using the stylized mark “W KITCHENS” in connection with food and beverages sold in its stores. QuikTrip sent Weigel a cease-and-desist letter, requesting that Weigel stop using the W KITCHENS mark on the basis that it was confusingly similar to QuikTrip’s QT KITCHENS mark. In response to QuikTrip’s concerns, Weigel modified its mark by changing the plural “KITCHENS” to the singular “KITCHEN,” altering the font, and adding the words “WEIGEL’S” and “NOW OPEN.” Weigel’s initial and modified marks are pictured below. The final version is the mark that Weigel applied to register, with QuikTrip continuing to object to both its use and registration:

First Iteration	
Second Iteration	
Final Design (Challenged Mark)	

The Board found that Weigel’s willingness to take steps to alter its mark evidenced its lack of bad faith, and the CAFC found no error in this determination. *Id.* The CAFC therefore affirmed the Board’s dismissal of the opposition.

*QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F.3d 1031, 2021 U.S.P.Q.2d 35 (Fed. Cir. Jan. 7, 2021) (precedential). [SG]

### **Express Abandonment “Without Prejudice” Is Improper After TTAB Issues a Final Decision Affirming Registration Refusals**

Information Builders, Inc. (“Information Builders”) sought to register a composite mark consisting of the words “Information Builders” with a specially designed “O” for database software and design services. However, the registration was refused because the Board determined that the mark was confusingly similar to an existing trademark. Although the examining attorney requested a disclaimer, Information Builders failed to provide a compliant disclaimer. In April 2020, the Board issued a final decision affirming the refusals to register the mark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the ground that Information Builders as the applicant failed to provide a proper disclaimer pursuant to Section 6(a) of the Lanham Act, 15 U.S.C. § 1056(a).

Information Builders appealed the Board’s decision to the U.S. Court of Appeals for the Federal Circuit. However, three months later, the applicant moved to voluntarily dismiss the appeal. On the same day, it filed an express abandonment of the application “without prejudice,” citing that it no longer has a bona fide intent to use the mark in commerce. Four days later, the Federal Circuit granted the motion and dismissed the appeal. However, the Board determined that the Information Builders could not file a statement to expressly abandon the application “without prejudice” after the prosecution of that application had already concluded. The express abandonment of an application “without prejudice” is improper and has no effect if filed after the Board has issued a final decision affirming a refusal to register.

Notably, an applicant may file an express abandonment during prosecution of an application or during an ex parte appeal to the Board pursuant to Trademark Rule 2.68, 37 C.F.R. § 2.68. However, once the prosecution process concludes or the Board issues a final decision, the application cannot be reopened, except in limited circumstances permitted by Rule 2.142(g), 37 C.F.R. § 2.142(g). An application that was considered and decided on appeal may be reopened to enter a disclaimer under § 6 of the Lanham Act or by the order of the Director, or if a reviewing court reverses the Board’s decision. Absent these circumstances, an application stands abandoned after a final decision of the Board.

In this case, the Board's April 30, 2020 decision affirming refusals to register Information Builders' mark was final, thereby rendering the application abandoned as of that date. A subsequent filing of an express abandonment "without prejudice" is not permitted past that date, except in the limited circumstances outlined in Rule 2.412(g), which were not present here. Information Builders was not seeking to enter a disclaimer, and there was no order of the Director permitting such an express abandonment "without prejudice." Moreover, there was no court reversal since the appeal to the Federal Circuit had been voluntarily dismissed.

Information Builders' express abandonment "without prejudice" was improper and thus of no effect because it was untimely under Rule 2.68 and contravened the limitations of Rule 2.142(g). The Board noted that a contrary result would allow an applicant to "circumvent an adverse Board decision by filing an express abandonment of the involved application."

*In re Information Builders Inc.*, 2021 U.S.P.Q.2d 228 (T.T.A.B. Feb. 25, 2021) (precedential). [AA]

**The TTAB Finds That Terms Having a Geographical Association Without Specifically Denoting a Location Can Be Challenged Under The General Deceptiveness Provision of Section 2(a), But Not Under The 'Wine and Spirits' Provision of 2(a) Or The Geographic Misdescriptiveness Provision of 2(e)(3)**

ASW Distillery LLC ("ASW") applied to register the mark "BURNS NIGHT" in connection with "malt whiskey; whiskey" (Application Serial Number 88/427,906). The Scotch Whisky Association Ltd. ("SWAL") opposed ASW's application for registration and ASW moved to dismiss the notice of opposition under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief could be granted. In its first, non-precedential decision on the motion, the Trademark Trial and Appeal Board (TTAB) denied ASW's motion in its entirety, concluding that SWAL alleged facts sufficient to support three claims, namely that the mark is not registrable under (1) the general deceptiveness provision of Section 2(a) of the Lanham Act (15 U.S.C. § 1052(a)); (2) the "wine and spirits provision" of Section 2(a), and (3) the primarily geographically deceptively misdescriptive provision of Section 2(e)(3) (15 U.S.C. § 1052(e)(3)). *See The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, Opposition No. 91252682 (T.T.A.B. July 29, 2020). However, upon ASW's motion for reconsideration, the Board determined, this time in a precedential opinion, that SWAL's factual allegations only supported a claim under Section 2(a)'s general deceptiveness provision, but not under 2(a)'s "wine and spirits provision" or 2(e)(3)'s geographically deceptively misdescriptive provision, because the subject mark was alleged only to have a geographical association but not to specifically denote a geographical location. *The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 U.S.P.Q.2d 179 (TTAB Feb. 16, 2021).

The Board noted that a mark may be refused under the general deceptiveness provision of Section 2(a) if (1) it misdescribes the character, quality, function, composition or use of the goods, (2) prospective purchasers are likely to believe the misdescription, and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase. *The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 U.S.P.Q.2d 179, \*4 (TTAB Feb. 16, 2021) (citing *In re Spirits Int'l, N.V.*, 563 F.3d 1347 (Fed. Cir. 2009)). The Board held that SWAL's allegation that the mark "BURNS NIGHT" is highly evocative of Scotland when used on a whisky product "because the mark refers to celebration of Scottish poet Robert Burns' birthday, was a sufficient factual basis for SWAL's claim of deceptiveness to go forward. *The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 U.S.P.Q.2d 179, \*4 (TTAB Feb. 16, 2021) (citing *Scotch Whiskey Ass'n v. U.S. Distilled Prods. Co.*, 952 F.2d 1317 (Fed. Cir. 1991)). In *Scotch Whiskey*, the Federal Circuit determined that a Section 2(a) deceptiveness claim, based in part on an allegation that the mark "MCADAMS for whisky not produced in Scotland deceptively connotes and signifies that the product sold under said mark has a place of produce and geographic origin in Scotland," was legally sufficient to survive a Rule 12 motion to dismiss, notwithstanding the plaintiff's



failure to allege that the mark is primarily recognized as a geographical term in and of itself. The Board determined that SWAL's allegations in the present case were analogous and sufficient to proceed. *Id.* at \*4.

However, the Board, in its reconsideration opinion, determined that SWAL's allegations were insufficient for its claims to proceed under Section 2(a)'s "wine and spirits provision" or 2(e)(3)'s geographically deceptively misdescriptive provision, because SWAL did not allege that the mark BURNS NIGHT denotes a known geographic location. *Id.* at \*7. Under Section 2(a)'s "wine and spirits provision", a mark may be refused registration if it "[c]onsists of or comprises ... a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after January 1, 1996. *Id.* at \*4-\*5. The Board held that SWAL's allegations did not meet this standard because SWAL "did not allege facts which, if proven, would establish that Applicant's mark identifies a place—that is, a place name, abbreviation, nickname, symbol, or outline or map of a geographic area—other than the origin of the goods at issue". *Id.* at \*7.

In addition, the Board noted that a mark may be refused registration as primarily geographically deceptively misdescriptive under Section 2(e)(3) if (1) the primary significance of the mark is a generally known geographic location, (2) the goods or services do not originate in the place identified in the mark, and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark, and the misrepresentation is a material factor in a significant portion of the relevant consumer's decision to buy the goods or use the services. *Id.* at \*5-6. Accordingly, the Board found that SWAL failed to allege a sufficient claim under Section 2(e)(3) because it did not allege that the primary significance of the mark BURNS NIGHT is "a generally known geographic location." *The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 U.S.P.Q.2d 179, \*6 (TTAB Feb. 16, 2021).

Based on the foregoing findings, the Board dismissed SWAL's claims under the Section 2(a) wine and spirits provision and Section 2(e)(3). However, the Board permitted SWAL's general deceptiveness claim under Section 2(a) to go forward. In doing so, the Board rejected ASW's argument that Section 2(a)'s wine and spirits provision made the general deceptiveness provision inapplicable to wine and spirit products. In making its decision, the Board noted that the wine and spirits provision, which was added to the trademark statute in 1994 as part of the implementation of the Trade-Related Intellectual Property ("TRIPs") portions of the General Agreement on Tariffs and Trade ("GATT") through the Uruguay Round Agreements Act ("URAA"), Pub. L. No. 103-465, 108 Stat. 4809 (1994), had the expressly stated purpose of providing "[a]dditional [p]rotection" (emphasis added) for wines and spirits. URAA, Section 3, Article 23; TRIPs, Article 23. "Congress did not state that the Section 2(a) wines and spirits provision eliminated or rendered inapplicable more general Section 2(a) deceptiveness claims with regard to wines and spirits." *Id.* at \*5-6.

As a result, the Board dismissed SWAL's wine and spirits provision and 2(e)(3) claims, with leave to possibly re-plead those claims within 20 days. However, the TTAB database does not indicate that SWAL amended its pleading within the 20-day period. Therefore it appears that SWAL is proceeding based solely on its general deceptiveness claim under Section 2(a). *The Scotch Whisky Association Ltd. v. ASW Distillery, LLC*, 2021 U.S.P.Q.2d 179, \*7-8 (TTAB 2021) (precedential). [SG]

### **The TTAB Rejected Claim of False Suggestion of a Connection Claim Because the Name of a Historic Person Did Not Identify the Opposer, Nor Did It Uniquely and Unmistakably Point to the Opposer**

Tempting Brands Netherlands B.V. ("Tempting Brands") sought to register the stylized word mark "PIERRE DE COUBERTIN" for a variety of goods and services in multiple International Classes (Application Serial Number 79/185,262). Pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. §

1052(a), the United States Olympic Committee (“Olympic Committee”) opposed the registration based on an alleged false suggestion of a connection with the Olympic Committee and “the Olympic Games as a whole.” See *The United States Olympic Committee v. Tempting Brands Netherlands B.V.*, Opposition No. 91233138 (T.T.A.B. February 23, 2017).

Pierre de Coubertin was a French baron who famously established the modern Olympic Games in the late nineteenth century. *Id.* at \*3. His role in and contributions to the Olympic Games are widely reported.

Tempting Brands is a brand development and licensing company that was attracted to the name “Pierre de Coubertin” because it was looking for a “French-sounding name,” and “Pierre is a quintessential French-sounding name for men,” and the combination of consonants was appealing to the licensing team. The association with the Olympic Games was not discussed or considered in the decision to adopt the name, however the Director of Global Licensing admitted to being aware of Pierre de Coubertin being one of the founders of the Olympic Games. *The United States Olympic Committee v. Tempting Brands Netherlands B.V.*, 2021 U.S.P.Q.2d 164, at \*10-11 (T.T.A.B. Feb. 5, 2021).

Before applying for the mark, Tempting Brands conducted a trademark search, which did not yield any U.S. results. However, the search did reveal three foreign registrations owned by the Fondation de Coubertin, and one E.U. registration owned by the International Olympic Committee. The search also did not yield evidence of use of these marks. *Id.* at \*11.

Notably, neither the Olympic Committee nor Tempting Brands Netherlands B.V. acquired the rights to the name “Pierre de Coubertin” from or through his estate. The rights to the name and likeness of Pierre de Coubertin are owned by his heirs and the Fondation de Coubertin. Tempting Brands entered into a coexistence agreement with the Fondation de Coubertin.

In order to have a statutory right to oppose a registration under 15 U.S.C. § 1063, the Olympic Committee first needed to demonstrate that its opposition is within the zone of interests protected, and that it has a reasonable belief of damage that is proximately caused by the registration of the mark. *Id.* at \*15.

To establish such a right, the Olympic Committee relied on its status as “part of the institution”—the Olympic Movement—to which the use of the PIERRE DE COUBERTIN mark would falsely suggest a connection. *Id.* at \*15-16. To demonstrate its interest in the name, the Olympic Committee offered a T-shirt with Pierre de Coubertin’s name, which is available for sale on its merchandising website. Additionally, the Olympic Movement occasionally awards the Olympic Games sportsmanship medal bearing Pierre de Coubertin’s name. Furthermore, the Olympic Committee furnished as evidence of its interest a trailer for the 1996 Olympic Games that mentioned Pierre de Coubertin, and the monument honoring Pierre de Coubertin in the Centennial Olympic Park in Atlanta, Georgia. *Id.*

The Board determined that this evidence was sufficient to demonstrate that the Olympic Committee’s opposition to registration is within the zone of interests protected, and that it had a reasonable belief of damage that is proximately caused by the registration of the mark. Therefore, the Olympic Committee had a statutory cause of action under 15 U.S.C. § 1063. *The United States Olympic Committee v. Tempting Brands Netherlands B.V.*, 2021 U.S.P.Q.2d 164, at \*16-17 (T.T.A.B. Feb. 5, 2021).

There are four elements of a false suggestion of connection claim under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), are:

- The mark is the *same as, or a close approximation of*, the name or identity previously used by another person or institution;
- The mark would be recognized as such, in that it *points uniquely and unmistakably* to that person or institution;

- The person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and
- The fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

*Id.* at \*17-18 (citing *Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 U.S.P.Q.2d 471774, at \*14 (T.T.A.B. 2019) (emphasis added)).

Upon review of Olympic Committee's claim, the Board ultimately concluded that the Olympic Committee failed to satisfy the first two elements and did not need to review the remaining elements. *Id.* at \*21-23, \*27-29, \*33.

First, the Board noted that Pierre de Coubertin is the name and identity of a historical person, whose publicity rights are preserved and protected by several organizations. Even though Pierre de Coubertin, the individual, was associated with the Olympic Movement, the public would not perceive PIERRE DE COUBERTIN as a name or identity of the Olympic Movement or the U.S. Olympic Committee, or a close approximation thereof. The name "Pierre de Coubertin" is not used interchangeably with "Olympic Games" as a name for the Olympic Games. *Id.*

Further, the Board found that although the Olympic Committee and other entities within the Olympic Movement have used and publicized the name Pierre de Coubertin often, mere use does not establish the term as the identity of the Olympic Committee or that Olympic Movement, or a close approximation thereof. And despite widespread media coverage of Pierre de Coubertin's role in the Olympic Movement, the Board notes that the media coverage does not suggest that consumers would recognize the name PIERRE DE COUBERTIN as synonymous with the Olympics. *Id.*

The Olympic Committee also attempted to argue that the mark does not have to be used to *identify* the senior user, but merely needs to *point* to it. The Board clarified that the "pointing" language ("points uniquely and unmistakably to that person or institution") only applies to the second element of proving false suggestion of connection claim under Section 2(a), and only after it has been established that the mark is the plaintiff's identity. However, the Board had already concluded that the name is not the identity of the Olympic Committee because it points to both the historical person, as well as his role in establishing the Olympic Committee.

Further, the record is clear that other organizations, like the Fondation de Coubertin, have rights in the name. *Id.* at \*23-33. It is well established that after an individual's death, Section 2(a) only applies if the heirs or other successors are entitled to assert the right to use a designation which points uniquely to his or her persona. *Id.* at \*26 (citing *In re MC S.r.l.*, 88 U.S.P.Q.2d 1378, 1380-81 (T.T.A.B. 2008)). In this case, the Olympic Committee is not the successor to the rights in the name of Pierre de Coubertin, and therefore, the name is not the name or identity of the Olympic Committee. *Id.*

The Board acknowledged that sometimes the mark at issue is not the name of the person or institution, but the public knew the person or institution by the nickname or close approximation of the name in the mark. *Id.* (citing *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1639 (T.T.A.B. 2015) (holding that ROYAL KATE was a close approximation of the identity of Kate Middleton because the public has come to recognize her as such from media reports, despite her not using ROYAL KATE as her name or identity)). However, in this case, the record indicates that the media used PIERRE DE COUBERTIN to reference the historical individual, not as the name or identity of the Olympic Committee. *Id.* at \*27.

Although the Olympic Committee implied that PIERRE DE COUBERTIN may point to both the individual and to the Olympic Movement without foreclosing the possibility that the name points uniquely to the Olympic Movement, that argument failed as well. In this case, the Olympic Committee itself acknowledged that more than one entity or group of persons claims to be associated with Pierre de Coubertin. The assertion that the name is uniquely associated with the Olympic Committee is therefore inconsistent with the concession that other entities share the association with the name. *Id.* at \*31.

However, the Board concluded that even if PIERRE DE COUBERTIN were the Olympic Committee's name or identity, or a close approximation thereof, the mark still does not uniquely and unmistakably point to the Olympic Committee. In order to satisfy the second element of proving false suggestion of connection claim under Section 2(a), the association with the person or institution must be unique. Here, the association is not unique to the Olympic Committee or the Olympic Movement. The evidence demonstrates that Pierre de Coubertin is remembered as an individual with his own politics, family background, personal life, interests, and accomplishments other than the revival of the Olympic Games. Because he is not known solely for his role in the Olympic Games, his name is not a mere synonym for the Olympic Games. *Id.* at \*27-29.

Finally, the Olympic Committee challenged the Tempting Brands' intent in adopting the PIERRE DE COUBERTIN mark. Because Tempting Brands was aware of Pierre de Coubertin and his role in the Olympics, the mark is intended to falsely suggest a connection with the Olympic Committee, the opposer contended. The Board found this argument unpersuasive. Instead, the Board was satisfied with the explanation behind the mark's selection provided by the Tempting Brands' Director of Global Licensing—the licensing team liked the “quintessential French-sounding name for men” and the combination of sounds. Moreover, even if Tempting Brands, by its adoption of the mark at issue, did intend to create a false association with the historical individual Pierre de Coubertin, that does not establish intent to create a false association with the Olympic Committee. *Id.* at \*32-33.

*The United States Olympic Committee v. Tempting Brands Netherlands B.V.*, 2021 U.S.P.Q.2d 164 (T.T.A.B. Feb. 5, 2021) (precedential). [AA]

### **The TTAB Holds Showing of Intent To Resume Use of Restaurant Name is Sufficient To Rebut a Presumption of Abandonment**

In September 2017, Jill Peterson petitioned to cancel two registrations owned by Awshucks SC, LLC (“Awshucks SC”) in connection with restaurant and bar services, one for “A.W. SHUCK’S” and one for “A.W. SHUCK’S” plus design, based on abandonment of the registered marks (Registration Numbers 1,510,463 and 4,524,998). *See Peterson v. Awshucks SC*, Cancellation No. 92066957 (T.T.A.B. September 26, 2017). In a precedential decision, the Trademark Trial and Appeal Board (“Board”) granted the petition to cancel the word-plus-design mark based on Awshucks SC's voluntary failure to renew the registration during the pendency of the cancellation proceeding, and denied the petition with respect to the word mark based on Awshucks SC's evidence of intention to resume use of the mark during a three-year-plus period of nonuse. *Peterson v. Awshucks SC, LLC*, 2020 U.S.P.Q.2d 11526 (TTAB Dec. 23, 2020).

#### Entitlement to a Statutory Cause of Action

The Board found that Peterson was entitled to bring a statutory cause of action (formerly referred to in Board proceedings as “standing”) based on two different factors: (1) her own application to register AW SHUCKS for restaurant services was refused based on Awshucks SC's registrations, and (2) Peterson and, prior to her, her late husband had been operating a restaurant named AW SHUCKS in Dallas, Texas since 1982. *Id.* at \*5-6.

#### Word-plus-Design Mark: Voluntary Failure to Renew

During the pendency of the cancellation proceeding, Awshucks SC did not renew the registration for the combination word-plus-design mark when renewal was due. Awshucks SC confirmed in its testimony and brief in the cancellation proceeding that the failure to renew was intentional because the design element in question was no longer in use. The Board concluded that this intentional failure to renew during the pendency of the cancellation proceeding was “the equivalent of a cancellation by request of Respondent without the consent of the Petitioner” and therefore granted the petition to cancel and entered judgment against Awshucks SC as to Registration Number 1,510,463 based on abandonment. *Id.* at \*2.



## Word Mark: Presumption of Abandonment Overcome by Evidence of Intention to Resume

With respect to the contested claim of abandonment of the registered word mark, the Board began by noting that, pursuant to Section 45 of the Trademark Act (15 U.S.C. § 1127), a mark is deemed abandoned when two elements are proven: (1) use of the mark "has been discontinued," (2) "with intent not to resume such use." *Id.* at \*9. "If a petitioner shows three consecutive years of nonuse, it has established a prima facie showing of abandonment, creating a rebuttable presumption that the registrant has abandoned the mark." *Id.* (citing *Nobel House Home Furnishings*, 118 USPQ2d 1413, 1417 (TTAB 2016)). In such a case, the burden shifts to the registrant to "produce evidence that he has either used the mark or that he has intended to resume use (e.g., a convincing demonstration of 'excusable non-use' that would negate any intent not to resume use of the mark). The burden of persuasion remains with the plaintiff to prove abandonment by a preponderance of the evidence." *Id.* at \*9.

In her trial brief, Peterson claimed that the presumption of abandonment applied because, between 2016 and 2019, a more-than-three-year period had occurred in which Awshucks SC had not used the A.W. SHUCK'S mark in connection with restaurant services. The Board agreed, noting that Awshucks SC changed the name of its existing A.W. SHUCK'S restaurant on State Street in Charleston, South Carolina to OYSTER HOUSE in January 2016, and didn't resume use of A.W. SHUCK'S until either March 2019, a point in time at which Awshucks SC's principal, John Keener, testified that he began using "A.W. Shuck's on the Porch" at the Oyster House location, or June 2019, when he opened a new Charleston restaurant named A.W. Shuck's Seafood Shack on King Street. *Peterson v. Awshucks SC, LLC*, 2020 U.S.P.Q.2d 11526, \*9-10 (TTAB Dec. 23, 2020). Therefore, the burden shifted to Awshucks SC to present evidence showing that, during the period of nonuse, it had plans to resume commercial use of the mark in the "reasonably foreseeable future." The Board noted that such evidence may include evidence of subsequent commercial use, provided that the evidence of subsequent use is sufficiently linked to the period of nonuse, both temporally and logically, to support an inference of intent to resume use during the nonuse period in question. *Id.* at \*10 (internal citations omitted).

The Board held that Awshucks SC satisfied its burden with evidence, including correspondence with and testimony from third parties such as real estate agents, architects and designers, showing registrant's efforts to find a new location for the A.W. SHUCK'S restaurant (using a different, "fast casual" restaurant concept) between 2016 and 2019 following discontinuation of use at the original location; registrant's plans, designs, and construction at a proposed new location on State Street, adjacent to the original location, between 2017 and 2018; preparation of proposed new logo and menu designs between 2017 and 2018, including designs that were eventually used; and the opening of the King Street location on June 3, 2019. *Id.* at \*6-10, \*16-17.

Moreover, the Board rejected Peterson's arguments against the sufficiency of Awshucks SC's evidence. First, Peterson argued that the lease on the King Street restaurant that opened in 2019 is signed by AWS Shack, LLC, a different entity than the registrant Awshucks SC, and that use of the mark by AWS Shack, LLC does not inure to the benefit of Awshucks SC. However, the Board was persuaded by Mr. Keener's testimony that he is the sole owner of both AWS Shack, LLC and the registrant Awshucks SC; that he controls both companies; and that AWS Shack, LLC uses the mark with his permission under the registrant's control. The Board therefore concluded that AWS Shack was a related company of Awshucks SC, permitting Awshucks SC to rely on use of the mark by AWS Shack under Section 5 of the statute. *Id.* at \*11-12.

Second, Peterson argued that the evidence only showed an intention by Awshucks SC to use "AW SHUCKS", which Peterson asserted is materially different from the registered mark that includes periods and an apostrophe – "A.W. SHUCK'S". Peterson maintained that A.W. SHUCK'S connotes the possessive version of a person's name, while "AW SHUCKS" connotes the expression or exclamation "aw shucks". The Board disagreed, first noting that there was some evidence, from communications during the nonuse period as well as some of the use that was ultimately made at the new restaurant,

that Awshucks SC at least intended to use the apostrophe, if not the periods. Therefore, the Board compared A.W. SHUCK'S and AW SHUCK'S and found that they were not materially different:

Consumers who understand the meaning of the term "aw-shucks," will likely see either manner of use as both an expression of that meaning and as a person's name, fictional or not. Consumers who do not know the meaning of the term, perhaps a younger generation of consumers, will view either term as a person's name. Initials are often displayed without periods. Consequently, we find that Respondent intended to use a mark that is not materially different from the registered mark. *Id.* at \*16.

The Board therefore denied the petition to cancel the word mark registration. *Peterson v. Awshucks SC, LLC*, 2020 U.S.P.Q.2d 11526 (TTAB Dec. 23, 2020) (precedential). [SG]



# VIP PRODUCTS LLC V. JACK DANIEL'S PROPERTIES INC.<sup>[1]</sup>

BY: CARLY A. GARTENBERG

Though perhaps not at the forefront of our minds, the associations we make with commercial branding hugely drives our economic decision-making.<sup>[2]</sup> We are drawn to the sleek and minimalistic design of APPLE® products; we are hesitant to buy off-brand RICE KRISPIES® cereal; and when we need car insurance, we know innately that we could save 15 percent or more by choosing GEICO® insurance.<sup>[3]</sup>

The desire by creatives to incorporate these culturally relevant brands into societal discourse has necessitated a judicial consideration of how to equitably balance free expression with the potential for intellectual exploitation.<sup>[4]</sup> As such, this area of law has become an active and critical sphere of jurisprudence.<sup>[5]</sup> The general rule is as follows: where a genuinely creative work utilizes a registered trademark in its expression, it is offered greater First Amendment<sup>[6]</sup> protection than is a purely commercial work that utilizes a registered mark to further commercialization.<sup>[7]</sup>

In *VIP Products LLC v. Jack Daniel's Properties, Inc.*, VIP Products LLC ("VIP"), a successful pet toy manufacturer, produced a dog toy that virtually replicated a bottle of JACK DANIEL'S® whiskey in a plush, dog-themed form.<sup>[8]</sup> The Ninth Circuit Court of Appeals regarded this dog-themed spin-off of the whiskey bottle design with the JACK DANIEL'S trademark as "humorous," and thus sufficiently expressive to shield VIP from the trademark infringement claims asserted by Jack Daniel's Properties, Inc. ("JDPI").<sup>[9]</sup> In so holding, the VIP court has substantially lowered the bar for what constitutes an expressive work, and by extension, the ease with which one can exploit well-established trademarks for financial gain.<sup>[10]</sup>

This Case Comment contends that the VIP court erred when it designated the Bad Spaniels toy as an "expressive" work immune from trademark infringement claims.<sup>[11]</sup> First, the court improperly extended the *Rogers* test to a work that did not meet the requirements of an expressive work.<sup>[12]</sup> And second, although the toy featured both expressive and commercial elements, the court failed to follow Supreme Court precedent from *Bolger* to determine if the dog toy was expressive or commercial.<sup>[13]</sup>

VIP Products LLC is one of the largest manufacturers of dog toys in the United States.<sup>[14]</sup> It is perhaps most famous for its line of dog toys called SILLY SQUEAKERS®.<sup>[15]</sup> These plush, squeaky toys physically resemble the packaging of commercially well-known beverages but employ puns and creative language to add a dog-themed twist to the design.<sup>[16]</sup> There is a SILLY SQUEAKER toy labeled "Mountain Drool," portraying a dog with its tongue hanging out, superimposed on a plush neon green bottle.<sup>[17]</sup> There is also a whole line of SILLY SQUEAKER toys modeled after well-known alcoholic beverage brands.<sup>[18]</sup> VIP has explained that the purpose of these toys is to "reflect the humanization of dogs in our lives."<sup>[19]</sup>

In 2013, VIP released its newest SILLY SQUEAKER toy: the "Bad Spaniels" dog toy.<sup>[20]</sup> The toy was in the shape of a long rectangular bottle with an oblong neck, and had white text on a black background.<sup>[21]</sup> The bottle design and text on the dog toy strongly resembled the bottle design and text on a bottle of JACK DANIEL'S OLD NO. 7 BLACK LABEL TENNESSEE WHISKEY™.<sup>[22]</sup>

Jack Daniel's Distillery is the oldest registered distillery in the United States.<sup>[23]</sup> Between 1997 and 2015, Jack Daniel's sold upwards of

seventy-five million cases of its whiskey nationwide.<sup>[24]</sup> The signature rectangular bottle, characteristic neck, distinct white typeface and white-on-black label of its Old No. 7 Brand Tennessee Whiskey product is widely recognizable.<sup>[25]</sup> Where Jack Daniel's label reads: "Old No. 7 Brand Tennessee Sour Mash Whiskey," the Bad Spaniels toy reads: "Old No. 2, on your Tennessee Carpet."<sup>[26]</sup> A tag on the toy notes its non-affiliation with Jack Daniel's Distillery.<sup>[27]</sup>

In 2014, JDPI filed suit against VIP, claiming that the Bad Spaniels toy infringed on Jack Daniel's trademark<sup>[28]</sup> and trade dress,<sup>[29]</sup> and tarnished its reputation.<sup>[30]</sup> Accordingly, JDPI demanded that VIP cease the sale of Bad Spaniels dog toys.<sup>[31]</sup> The United States District Court for the District of Arizona held that JDPI had established its trademark and trade dress infringement claims, and that there was tarnishment of Jack Daniel's reputation.<sup>[32]</sup> Further, the district court rejected VIP's proffered First Amendment defense, and granted a permanent injunction<sup>[33]</sup> in favor of JDPI, prohibiting the manufacture, advertisement, and sale of the Bad Spaniels toy.<sup>[34]</sup> On February 20, 2020, VIP appealed to the United States Court of Appeals for the Ninth Circuit.<sup>[35]</sup>

The Federal Lanham Act<sup>[36]</sup> ("Act") sets the framework for enforcement and regulation of proper trademark use.<sup>[37]</sup> The Act's underlying purposes are: (1) to allow trademark owners to benefit from exclusive use of their mark and the reputation it has created; and (2) to make sure that consumers are not buying a product they incorrectly believe is made by the trademark owner.<sup>[38]</sup> In short, trademarks are source identifiers, and the Act helps to ensure that consumers know that all products bearing a given trademark come from the same source."<sup>[39]</sup>

When a registered trademark owner believes his or her mark has been infringed upon, they may bring a claim under the Lanham Act.<sup>[40]</sup> Where the alleged infringement is commercial in nature, courts assess the claim by applying the "likelihood-of-confusion" test.<sup>[41]</sup> Under this test, the plaintiff must prove that: (1) he or she had a protected trademark; and (2) that the defendant's use of that mark was likely to confuse customers as to the origin of the allegedly infringing product.<sup>[42]</sup>

Where the alleged infringement is expressive in nature, courts have generally concluded that the likelihood-of-confusion test does not adequately safeguard individual artistic liberties.<sup>[43]</sup> In the 1989 Second Circuit case, *Rogers v. Grimaldi*, a filmmaker was sued for the unauthorized use of a celebrity's name and persona in his film.<sup>[44]</sup> The court reasoned that although the film was certainly commercial by nature and could lead to associative confusion among consumers, those interests had to yield to the expressive freedom of the filmmaker, who utilized the celebrity as a storytelling aid.<sup>[45]</sup>

The *Rogers* test is now the seminal test for balancing the interests of trademark protection and First Amendment freedoms.<sup>[46]</sup> Under this test, the First Amendment shields an alleged infringer from liability if he or she can prove that the alleged infringement (1) has "artistic relevance" to the underlying work; and (2) does not "explicitly mislead" consumers as to the source of the work.<sup>[47]</sup> Where these criteria are not met, some courts will do a separate likelihood-of-confusion analysis, while others believe the confusion analysis has already been done in the second *Rogers* prong, and will simply deny First Amendment protections.<sup>[48]</sup>

Since the introduction of the *Rogers* test, the circuit courts have consistently limited the application of *Rogers* to "indisputable works of artistic expression:" photographs portraying BARBIE® dolls;<sup>[49]</sup> paintings featuring a university's logo;<sup>[50]</sup> a play that incorporated elements from a DR. SEUSS® book;<sup>[51]</sup> or a video game that used the likeness of a famous NFL player.<sup>[52]</sup>

Determining if a work is commercial as opposed to expressive is not always simple in practice, and companies employ highly imaginative methods to hide commercial products behind expressive facades.<sup>[53]</sup> As such, where both expressive and commercial elements are present, it is critical that courts defer to the test set forth by the Supreme Court case, *Bolger v. Youngs Drug Products, Corporation*,<sup>[54]</sup> which provides a framework to help courts make this distinction.<sup>[55]</sup>

In 1983, in *Bolger*, the Supreme Court found that the following factors, *together*, strongly implicate



the commercial nature of a work: (1) the work is an advertisement; and (2) the speech refers to a specific product; and (3) the speaker has an economic motivation for the work.<sup>[56]</sup> The *Bolger* test has consistently been applied by courts to ensure First Amendment protections are not granted without cause.<sup>[57]</sup>

The United States Court of Appeals for the Ninth Circuit reviewed the *VIP* case de novo.<sup>[58]</sup> The issues on appeal were whether the Bad Spaniels toy infringed or diluted Jack Daniel's trademark, or whether the dog toy was expressive and therefore immune from both infringement and dilution liability under the First Amendment.<sup>[59]</sup>

On the issue of infringement, JDPI argued that because the Bad Spaniels toy failed to introduce new ideas or commentary, it was not sufficiently expressive to warrant First Amendment protection.<sup>[60]</sup> *VIP* argued that the *Rogers* test was warranted because the dog toy proffered a parodic, and therefore expressive message.<sup>[61]</sup>

The *VIP* court stated that a work need not be a "Mona Lisa" to qualify as expressive,<sup>[62]</sup> citing the holding from *Gordon v. Drape Creative, Inc.*<sup>[63]</sup> as support for this assertion.<sup>[64]</sup> In *Gordon*, greeting cards that used "humorous" wordplay were sufficiently expressive to warrant an application of the *Rogers* test.<sup>[65]</sup> On that basis, the *VIP* court concluded that because the Bad Spaniels toy also conveyed a "humorous" message, it necessitated the *Rogers* test.<sup>[66]</sup>

On the trademark dilution issue, JDPI argued that the Bad Spaniel toy, which said, "Old Number 2 on your Tennessee carpet" diluted Jack Daniel's trademark by associating its whiskey with dog feces, and thus harming Jack Daniel's reputation.<sup>[67]</sup> *VIP* argued that trademark owners do not have the liberty to dictate public discourse by claiming an otherwise creative work is negative or offensive.<sup>[68]</sup>

Further, the *VIP* court reasoned that where a product exists for any reason other than to be bought and sold, it can conclusively be classified as "expressive."<sup>[69]</sup> To justify this limited analysis, the court applied *Nissan Motor Company v. Nissan Computer Corporation*.<sup>[70]</sup> In *Nissan*, a website featured both original commentary about Nissan cars as well as links to purchase

Nissan cars.<sup>[71]</sup> Because the website included commentary, it exceeded a mere proposal for a commercial transaction, and no dilution analysis was undertaken by the court.<sup>[72]</sup>

Relying on *Nissan's* reasoning and holding, the "*VIP*" court held that because the dog toy was "humorous," it too exceeded mere commerciality and fell within the realm of expressivity.<sup>[73]</sup> Noting that the First Amendment immunizes all expressive works from dilution liability, the *VIP* court circumvented a dilution analysis, concluding as a matter of law that *VIP* did not dilute Jack Daniel's trademark.<sup>[74]</sup> Said differently, despite the presence of both commercial and expressive features in the dog toy, *VIP* employed the singular standard utilized by *Nissan* in order to classify the dog toy as expressive and immune from dilution liability.<sup>[75]</sup>

The *VIP* court erred by improperly extending the *Rogers* test to a commercial good, when *Rogers* applies only to expressive works.<sup>[76]</sup> The *Rogers* test is strictly reserved for works that utilize a registered trademark to set forth novel ideas, commentary or points of view.<sup>[77]</sup> Works that do not must be analyzed under the likelihood-of-confusion test.<sup>[78]</sup>

In *Mattel Incorporated v. MCA Records*, Mattel, the creator of the BARBIE doll and well-known "Barbie Girl" song, sued a band for trademark infringement after the band produced its own version of the "Barbie Girl" song.<sup>[79]</sup> Mattel's Barbie Girl song introduces a blonde girl named Barbie who is "living in a Barbie world," where "life in plastic," "is fantastic."<sup>[80]</sup> She has a boyfriend Ken, and in the song, Barbie tells Ken, "you can brush my hair, undress me anywhere."<sup>[81]</sup> The band's Barbie Girl song introduces a "blonde bimbo girl, in a fantasy world."<sup>[82]</sup> The band's song continues, "kiss me here, touch me there. . ." "I can beg, on my knees. . ." "you can do whatever you please," and ends with "hit the town, fool around, let's go party."<sup>[83]</sup> The *Mattel* court applied the *Rogers* test and found that the band's song was expressive speech entitled to First Amendment Protection based on its proffered commentary on the underlying work.<sup>[84]</sup>

In contrast, Dr. Seuss Enters., L.P. ("Seuss") is a California limited partnership that owns most of

the copyright and trademark rights to works by children's book author, Dr. Seuss.<sup>[85]</sup> Seuss sued publisher Penguin Books in the 1997 case, *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, after Penguin produced the book, "The Cat NOT in the Hat!," by "Dr. Juice."<sup>[86]</sup> This book attempted a satiric telling of the O.J. Simpson case "One Knife? / Two Knife? / Red Knife? / Dead Wife."<sup>[87]</sup>

The court noted that although the book mimicked Dr. Seuss's distinctive style, and riffed off his famous title and name, there was no effort to transform the work's meaning or message.<sup>[88]</sup> Additionally, the court noted that "The Cat NOT in the Hat," used Dr. Seuss's style as a way to get attention and to avoid having to come up with its own ideas.<sup>[89]</sup> This further evidenced Penguin's use of the Dr. Seuss brand not for its content, but for its name, and on these bases, the court found there was no expressive interest implicated.<sup>[90]</sup> Thus, the court applied the likelihood of confusion test to make a determination regarding trademark infringement.<sup>[91]</sup>

There is no doubt that VIP, like the band in *Mattel*, and the publisher in *Seuss*, used a well-recognized brand to draw consumers.<sup>[92]</sup> However, unlike the band's Barbie Girl song in *Mattel*, the Bad Spaniels toy did not have any "artistic relevance" to the underlying work, nor did it explicitly mislead consumers as to the source of the work.<sup>[93]</sup> The band's replacement of a "Barbie girl living in her own world," with, a "bimbo girl living in a fantasy world," was a deliberate critique of Mattel's portrayal of women as sexually subservient and intellectually vacuous.<sup>[94]</sup> The same cannot reasonably be said about VIP's replacement of "40% Alcohol by Volume" with "43% POO BY VOL."<sup>[95]</sup> It can hardly be argued that the Bad Spaniels toy would lead consumers to believe that Jack Daniel's whiskey is made with feces.<sup>[96]</sup> Thus, where the *Rogers* test was clearly warranted in *Mattel*, it was not warranted in *VIP*.<sup>[97]</sup>

In contrast, like the book in *Seuss*, the "Bad Spaniels" toy had no artistic relevance to the underlying Jack Daniel's product, but utilized Jack Daniel's as a vehicle to call attention to itself for commercial gain.<sup>[98]</sup> Just as the "Bad Spaniel's" toy nearly replicated the Jack Daniel's

bottle, save for the addition of the dog related text and imagery needed to make it a dog toy,<sup>[99]</sup> "The Cat NOT in the Hat" retained all the hallmark imagery of Dr. Seuss, changing only what was necessary to tell the O.J. story.<sup>[100]</sup> Neither creator had the intention to comment on the underlying products.<sup>[101]</sup> It follows that as in *Seuss*, only the likelihood-of-confusion test is warranted.<sup>[102]</sup>

The *VIP* court's decision to apply the *Rogers* test to the "Bad Spaniels" toy lacks sufficient legal justification.<sup>[103]</sup> Because the "Bad Spaniels" toy was not expressive in nature, the court should have applied the likelihood-of-confusion test.<sup>[104]</sup> Had it done so, the court may or may not have found that the Bad Spaniel's toy had the potential to cause source confusion among consumers.<sup>[105]</sup>

Also, the *VIP* court erred when it failed to consider the *Bolger* test, which is applied where both expressive and commercial elements may be present.<sup>[106]</sup> The legal implications of characterizing a work as expressive versus commercial loom large.<sup>[107]</sup> As such, the *Bolger* tests inquiries about the nature of a work by asking if the work is an advertisement, refers to a specific product, and is economically motivated.<sup>[108]</sup>

In the Ninth Circuit Court of Appeals case, *Dex Media West, Inc. v. City of Seattle*, a Seattle ordinance banned phonebook distribution where publishers failed to satisfy certain criteria.<sup>[109]</sup> Dex Media, a phonebook publisher, challenged the constitutionality of the ordinance, claiming that because the books were noncommercial, conditional restrictions on their distribution was in violation of the First Amendment.<sup>[110]</sup> The phonebooks featured commercial elements, such as paid advertisements, as well as non-commercial elements, such as community information and phone listings.<sup>[111]</sup> In its analysis, the court noted that the presence of both noncommercial and commercial elements merited a *Bolger* analysis.<sup>[112]</sup>

The *Dex* court found that only one of three *Bolger* factors was satisfied.<sup>[113]</sup> The phonebooks made no reference to a specific product and could not be classified as an advertisement.<sup>[114]</sup> The only *Bolger* factor satisfied was the economic motivation behind the phonebook distribution.<sup>[115]</sup> Nevertheless, this factor alone

cannot conclusively establish a work as commercial.<sup>[116]</sup> The *Dex* court held that the phonebooks were noncommercial and thus entitled to full First Amendment protection.<sup>[117]</sup>

Courts have extended the *Bolger* test to intellectual property cases as well.<sup>[118]</sup> In the Seventh Circuit Court of Appeals case, *Jordan v. Jewel Food Stores, Inc.*, former NBA star, and Chicago native, Michael Jordan brought an action against Chicago grocer, Jewel-Osco, alleging violations of state and federal trademark laws.<sup>[119]</sup> To celebrate Jordan's induction into the Hall of Fame, Jewel printed an advertisement featuring the following text: ". . . Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was 'just around the corner'. . . ."<sup>[120]</sup>

Jordan claimed that the grocer used his persona for commercial purposes without consent, and the grocer claimed that the First Amendment protected the expressive advertisement.<sup>[121]</sup> By touting its business, the advertisement was certainly commercial in nature, but the advertisement also featured noncommercial elements, such as original writing, graphics and mixed-media composition.<sup>[122]</sup> Accordingly, the court was tasked with determining if the advertisement constituted commercial or expressive speech, ultimately deferring to the Supreme Court's *Bolger* test to instruct in that designation.<sup>[123]</sup>

The *Jordan* court found that all three *Bolger* factors were satisfied.<sup>[124]</sup> Although the advertisement did not promote a specific product, it generally promoted Jewel and functioned as an advertisement.<sup>[125]</sup> The primary motivation for this advertisement was economic, since it sought to increase brand visibility by positively associating itself with a cultural icon.<sup>[126]</sup> As a result, *Jordan* held that the Jewel's advertisement was commercial speech not entitled to First Amendment protection.<sup>[127]</sup>

The Bad Spaniels toy was an unequivocal reference to a specific product, Jack Daniel's Old No. 7 Brand Tennessee Whiskey.<sup>[128]</sup> This is unlike the phonebooks in *Dex*, which featured a broad array of advertisements.<sup>[129]</sup> Further, while the phonebooks are a business endeavor, they were mainly intended to serve as an informational

community resource.<sup>[130]</sup> This is qualitatively different from the dog toy, which was solely intended to be bought and sold.<sup>[131]</sup> The *Bolger* factors were not sufficiently satisfied in *Dex*, but if the *Bolger* test been applied in *VIP*, it would have found that the Bad Spaniels met more of the *Bolger* factors for commerciality than the phone books.<sup>[132]</sup>

The Jewel advertisement referenced specific commercial products in the grocery store by implication, whereas *VIP* referenced the Jack Daniel's product directly.<sup>[133]</sup> Further, Michael Jordan is a household name, whose image and brand is recognized globally, and whose achievements make him highly desirable as a brand endorser.<sup>[134]</sup> An advertisement lauding Jordan's accomplishments beside Jewel's logo was a promotional tactic.<sup>[135]</sup> Similarly, *VIP*'s near replication of the Jack Daniel's whiskey bottle sought to exploit public affection for a globally recognized brand.<sup>[136]</sup> As such, if the *VIP* court had properly applied the *Bolger* test, it would have found that the Bad Spaniels toy possessed similar and perhaps more commercial elements than the Jordan advertisement and was therefore not entitled to First Amendment protection.<sup>[137]</sup>

The *VIP* court failed to apply Supreme Court precedent from *Bolger* despite finding that the dog toy possessed both commercial and noncommercial elements.<sup>[138]</sup> Instead, it declared as a matter of law that a "humorous" dog toy was expressive.<sup>[139]</sup> As such, the court erred by presumptively deciding on an issue where other courts have routinely sought additional guidance.<sup>[140]</sup>

The court in *VIP Products LLC v. Jack Daniel's* erred in its designation of the Bad Spaniels dog toy as expressive.<sup>[141]</sup> First, the *VIP* court mandated the *Rogers* test where the toy failed to proffer a novel message.<sup>[142]</sup> This was in error as the *Rogers* test has consistently been applied ONLY to expressive works and the dog toy is a commercial product.<sup>[143]</sup> And second, after the court recognized the presence of both commercial and expressive features in the dog toy, the court failed to consider Supreme Court precedent from *Bolger*.<sup>[144]</sup> This was in error as the *Bolger* test has historically been applied to help properly classify works that employ some modicum of originality in an attempt to stimulate



commercial transactions.<sup>[145]</sup>

Courts have deliberately sought to strike an equitable balance between the protection of expressive and commercial works.<sup>[146]</sup> By expanding the definition of “expressive” to include cheap humor, the *VIP* court has dangerously upset this balance.<sup>[147]</sup> *VIP*’s definition is substantially in conflict with the well-established precedent from which it claims to derive its rule, and was issued without a sufficient utilization of the legal tests available.<sup>[148]</sup> *VIP* has offered no legally cognizable justification for these diversions.<sup>[149]</sup>

Concerns surrounding the First Amendment typically relate to the abridgment of individual expressive freedoms, and there is no doubt that the protection of these freedoms is at the core of the American ideal.<sup>[150]</sup> That said, this case serves as a reminder that a deeply ingrained fear of stifling free expression does not warrant affording protections beyond the scope of what the Constitution permits.<sup>[151]</sup> The holding in *VIP Products LLC v. Jack Daniel’s* calls for an honest examination of when too much freedom can be harmful.<sup>[152]</sup> *VIP Products LLC v. Jack Daniel’s* has concerning, far-reaching implications.<sup>[153]</sup> It has, in essence, created a backdoor for sellers to legally profit from the intellectual labor of others with minimal intellectual labor of their own.<sup>[154]</sup> The result is that trademarks are no longer truly safe from the very exploitation that trademark law was designed to shield.<sup>[155]</sup> The *VIP* decision has undermined the protections afforded to intellectual property, and will without a doubt stunt and deter the innovations to society on which we so depend<sup>[156]</sup>.

<sup>[1]</sup>953 F.3d 1170 (9th Cir. 2020).

<sup>[2]</sup>See generally Alexander J. Kasparie, Comment, *Freedom of Trademark: Trademark Fair Use and the First Amendment*, 18 U. Pa. J. Const. L. 1547 (2016) (discussing in part, the big-picture impacts of trademarks on decision-making).

<sup>[3]</sup>See *id.*

<sup>[4]</sup>See *id.*

<sup>[5]</sup>David M. Kelly, Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 Trademark Rep. 1360 (2009) (discussing the careful balance

between the protection of expressive freedoms and trademark infringement).

<sup>[6]</sup>U.S. CONST. amend. I. Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

<sup>[7]</sup>4c M.J. Constitutional law § 78. Freedom of speech and Press (2020).

<sup>[8]</sup>*VIP Prods. LLC*, 953 F.3d at 1172.

<sup>[9]</sup>*Id.* at 1175; *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 271 (9th Cir. 2018).

<sup>[10]</sup>See *VIP Prods. LLC*, 953 F.3d at 1175 (holding that dog-themed puns were expressive enough to warrant First Amendment protection).

<sup>[11]</sup>*Id.*

<sup>[12]</sup>*Id.* at 1174.

<sup>[13]</sup>See *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 517 (7th Cir. 2014) (utilizing the *Bolger* test where marks feature both commercial and expressive elements).

<sup>[14]</sup>Appellee’s Answering Brief at 1, *VIP Prods. LLC v. Jack Daniel’s Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), 2019 WL 571425.

<sup>[15]</sup>*Id.*

<sup>[16]</sup>*VIP Prods. LLC*, 953 F.3d at 1172.

<sup>[17]</sup>*Id.* This is a play on the widely known beverage, Mountain Dew. *Id.* at 1172.

<sup>[18]</sup>*Id.* These toys come in many varieties: Heiniesniff’n (Heineken), Pissness (Guinness), Smella-R-Crotch (Stella Artois) and more. Appellee’s Answering Brief at 1, *VIP Prods. LLC*, 953 F.3d at 1170 (No. 18-16012).

<sup>[19]</sup>*VIP Prods. LLC*, 953 F.3d at 1172.

<sup>[20]</sup>*Id.*

<sup>[21]</sup>*Id.*

<sup>[22]</sup>*Id.*

<sup>[23]</sup>Appellee’s Answering Brief at 1, *VIP Prods. LLC*, 953 F.3d at 1172 (No. 18-16012).

<sup>[24]</sup>*Id.*

<sup>[25]</sup>*Id.*

<sup>[26]</sup>*VIP Prods. LLC*, 953 F.3d at 1172.

<sup>[27]</sup>*Id.*

<sup>[28]</sup>A trademark is a word, phrase, logo, or other sensory symbol used by a manufacturer or seller to distinguish its products or services from those of others. *Trademark*, Black’s Law Dictionary (11th ed. 2019). The main purpose of a trademark is to designate the source of goods or services. *Id.* In effect, the trademark is the commercial substitute for one’s signature. *Id.*



[29]Trade dress is the overall appearance and image in the marketplace of a product or a commercial enterprise. *Trade dress*, Black's Law Dictionary (11th ed. 2019). *Id.* For a product, trade dress typically comprises packaging and labeling. *Id.* If a trade dress is distinctive and nonfunctional, it may be protected under trademark law. — Also termed *get-up*; *look and feel*. *Id.*

[30]*VIP Prods. LLC*, 953 F.3d at 1172; *Deere & Company v. MTD Products, Inc.*, 41 F.3d 39, 43 (2d Cir. 1994). 'Tarnishment' generally arises when the plaintiff's trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering thoughts about the owner's product. *Id.* In such situations, the trademark's reputation and commercial value might be diminished. . ." *Id.*

[31]*VIP Prods. LLC*, 953 F.3d at 1171-72.

[32]*Id.* at 1173.

[33]A permanent injunction is a court order commanding or preventing an action after a final hearing on the merits. *Permanent Injunction*, Black's Law Dictionary (11th ed. 2019). Despite its name, a permanent injunction does not necessarily last forever. *Id.*

[34]*VIP Prods. LLC*, 953 F.3d at 1172.

[35]*Id.* at 1170.

[36]15 U.S.C. § 1051 *et seq.* (2002).

[37]*E.g.*, *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1030 (9th Cir. 2010).

[38]McCarthy on Trademarks and Unfair Competition, Fifth Edition § 2:2 (J. Thomas McCarthy 2020).

[39]*Id.*

[40]*Id.*

[41]112 AM. Jur. Proof of Facts 3d 1: Likelihood of Confusion Pursuant to the Federal Lanham Act, 15 U.S.C.A. §§ 1051 *et seq.* (Pollack 2010). Most civil suits pursuant to the Federal Lanham Act, 15 U.S.C.A. §§ 1051 *et seq.*, are premised on the defendant's use of some indicium of origin tied to the plaintiff in a situation where the use of that indicium of origin is likely to cause confusion, or likely to cause mistake, or likely to deceive the public. *Id.*

[42]*E.g.*, *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018).

[43]*See generally* David M. Kelly, Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 Trademark Rep. 1360 (2009) (discussing various circuit courts' rejection of the likelihood-of-confusion test where expressive interests are implicated).

[44]*Rogers v. Grimaldi*, 875 F.2d 994, 996-97 (2d Cir. 1989).

[45]*Id.* at 1000-02.

[46]The First Amendment and the Lanham Act: The Rogers Test, § 69:47 (Stalhkopf 2020).

[47]*Id.*

[48]*See generally* David M. Kelly, Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 Trademark Rep. 1360 (2009) (discussing differing methods employed by various circuits in balancing First Amendment rights with intellectual property rights).

[49]*Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003).

[50]*Univ. of Alabama Bd. of Trustees v. New Life Art, Inc.* 683 F.3d 1266, 1278-79 (11th Cir. 2012).

[51]*Accord Lombardo v. Dr. Seuss Enters., L.P.*, 729 Fed. Appx. 131, 133 (2d Cir. 2018).

[52]*Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1248 (9th Cir. 2014); Amicus Brief for Petitioners, 5, *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), 2019 WL 571425.

[53]*See Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 540 (1981).

[54]*Bolger v. Youngs Drug Corp.*, 463 U.S. 60 (1983).

[55]*E.g.*, *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 517 (7th Cir. 2014).

[56]*Bolger*, 463 U.S. at 67.

[57]*E.g.*, *Jordan*, 743 F.3d at 517.

[58]*VIP Prods. LLC*, 953 F.3d at 1170. Appeal *de novo* is an appeal in which the appellate court uses the trial court's record but reviews the evidence and law without deference to the trial court's rulings. *Appeal de novo*, Black's Law Dictionary (11th ed. 2019).

[59]*Id.* at 1173.

[60]Appellee's Answering Brief at 44, *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), 2019 WL 571425.

[61]Appellee's Brief at 16, *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), 2019 WL 571425

[62]*VIP Prods. LLC*, 953 F.3d at 1175.

[63]*Gordon*, 909 F.3d at 264.

[64]*VIP Prods. LLC*, 953 F.3d at 1173 (citing *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 268-69 (9th Cir. 2018)).

[65]*Gordon*, 909 F.3d at 271.

[66]*VIP Prods. LLC*, 953 F.3d at 1175.

[67]Appellee's Answering Brief at 30, *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), 2019 WL 571425.

[68]Appellant's Brief at 32-33, *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (No. 18-16012), 2019 WL 2029761.

[69]*VIP Prods. LLC*, 953 F.3d at 1176.

[70]*VIP Prods. LLC*, 953 F.3d at 1173 (citing *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004)).

[71]*Nissan Motor Co.*, 378 F.3d at 1007.

[72]*Id.* at 1017.

[73]*VIP Prods. LLC*, 953 F.3d at 1176.

[74]*Id.*

[75]*Id.*

[76]*VIP Prods. LLC* at 1174; *Accord* *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 907-08 (9th Cir. 2000); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997).

[77]*VIP Prods. LLC*, 953 F.3d at 1174.

[78]*Id.*

[79]*Mattel*, 296 F.3d at 899.

[80]*Id.* at 901.

[81]*Id.*

[82]*Id.* at 909.

[83]*Id.*

[84]*Id.* at 907-08.

[85]*Dr. Seuss Enters.*, 109 F.3d at 1396.

[86]*Id.* at 1397.

[87]*Id.* at 1401.

[88]*Id.*

[89]*Id.*

[90]*Id.*

[91]*Id.*

[92]*VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170, 1172 (9th Cir. 2020).

[93]*Id.*

[94]*See* *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 901 (9th Cir. 2000) (finding that the Band's lyrical choices rendered its song an expressive work).

[95]*VIP Prods. LLC*, 953 F.3d at 1172.

[96]*Id.*

[97]*Mattel*, 296 F.3d at 907-08; *VIP Prods. LLC*, 953 F.3d at 1176.

[98]*Id.*; *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997).

[99]*VIP Prods. LLC*, 953 F.3d at 1172.

[100]*Seuss*, 109 F.3d at 1401.

[101]*Id.*

[102]*Id.*

[103]*See generally* *VIP Prods. LLC*, 953 F.3d at 1170 (holding that a "humorous" comment on a registered trademark warrants First Amendment protection).

[104]*Id.*

[105]*Id.*

[106]*Accord* *Dex MediaWest, Inc. v. City of Seattle*, 696 F.3d 952, 957-58 (9th Cir. 2012); *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 517 (7th Cir. 2014).

[107]*See generally* David M. Kelly, Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 Trademark Rep. 1360 (2009) (discussing the careful balance between the protection of expressive freedoms and intellectual property rights).

[108]*Dex*, 696 F.3d at 957-58; *Jordan*, 743 F.3d at 517.

[109]*See* *Dex*, 696 F.3d at 954. The Ordinance mandated that phonebook publishers obtain proper licensure, pay a nominal fee for each phonebook delivered, and prominently display, on the front page of the book, instructions for how to opt-out of receiving phonebooks. *Id.* at 955.

[110]*Id.* at 953.

[111]*Id.* at 954.

[112]*Id.* at 957-58.

[113]*Id.* at 959.

[114]*Id.*

[115]*Id.* at 960.

[116]*Id.*

[117]*Id.* at 965.

[118]*See generally* *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983) (holding that courts must sufficiently assess the commercial components of work before declaring it commercial); *E.g.*, *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 513 (7th Cir. 2014).

[119]*Jordan*, 743 F.3d at 513.

[120]*Id.* at 512.

[121]*Id.* at 511.

[122]*See id.* at 518 (noting the presence of typical commercial elements as well as potential expressive elements in the advertisement).

[123]*Id.* at 517.

[124]*Id.* at 519-520.

[125]*Id.* at 518.

[126]*Id.* at 520.

[127]*Id.*

[128]*VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170, 1172 (9th Cir. 2020).

[129]*Dex MediaWest, Inc. v. City of Seattle*, 696 F.3d 952, 954 (9th Cir. 2012).

[130]*Id.*

[131]*Id.* at 959; *VIP Prods. LLC*, 953 F.3d at 1172.

[132]See generally *VIP Prods. LLC*, 953 F.3d at 1170 (holding that a “humorous” comment on a registered trademark warrants First Amendment protection).

[133]*Id.*; *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 519 (7th Cir. 2014).

[134]*Id.* at 513.

[135]*Id.* 519.

[136]*VIP Prods. LLC*, 953 F.3d at 1172.

[137]*Jordan*, 743 F.3d at 512; See also *VIP Prods. LLC*, 953 F.3d at 1172.

[138]See *VIP Prods. LLC*, 953 F.3d at 1177 (holding that a dog toy nearly replicating a registered trademark did not necessitate an inquiry into the toy’s commerciality).

[139]*Id.*

[140]Accord *Jordan*, 743 F.3d at 511, 517 (7th Cir. 2014); *Dex MediaWest, Inc. v. City of Seattle*, 696 F.3d 952, 957-58 (9th Cir. 2012).

[141]See generally *VIP Prods. LLC*, 953 F.3d at 1170 (holding that a “humorous” comment on a registered trademark warrants First Amendment protection).

[142]*Id.* at 1175-76.

[143]The First Amendment and the Lanham Act: The Rogers Test, § 69:47 (Stalhkopf 2020).

[144]*E.g.*, *Jordan*, 743 F.3d at 517.

[145]Accord *id.* at 511; *Dex*, 696 F.3d at 954.

[146]David M. Kelly, Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 Trademark Rep. 1360 (2009) (discussing the careful balance between the protection of expressive freedoms and trademark infringement).

[147]*Id.*

[148]See generally *VIP Prods. LLC v. Jack Daniel's Props.*, 953 F.3d 1170 (9th Cir. 2020) (holding that a “humorous” comment on a registered trademark warrants First Amendment protection).

[149]*Id.*

[150]See generally U.S. CONST. amend. I. Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances. *Id.*

[151]See generally 4C M.J. Constitutional Law § 78. Freedom of Speech and Press (2020) (discussing the need to carefully balance expressive freedoms with intellectual property protection).

[152]See generally *VIP Prods. LLC*, 953 F.3d at 1170 (holding that a “humorous” comment on a registered trademark warrants First Amendment protection).

[153]*Id.*

[154]David M. Kelly, Lynn M. Jordan, *Twenty Years of Rogers v. Grimaldi: Balancing the Lanham Act with the First Amendment Rights of Creators of Artistic Works*, 99 Trademark Rep. 1360, 1369 (2009) (discussing the careful balance between the protection of expressive freedoms and trademark infringement).

[155]*Id.*



# Spring 2021 IP Media Links

BY: JAYSON L. COHEN

## The Innovation Garden

Not all innovators protect their commercially valuable IP. Some are content to innovate out of love for what they do. On March 17, 2021, Margaret Roach published a piece in the New York Times entitled, “Why Shop at a Specialty Nursery?” Ms. Roach’s one-line teaser to horticulturists appears below this title: “If you buy all your plants at a big-box store, you’re missing out on a wealth of botanical treasures you’ll never find anywhere else.” The piece then focuses on her interview with garden-plant innovators Taylor Johnston and Ed Bowen of Issima Nursery in Little Compton, R.I., whose energy and love for what they do are palpable in Ms. Roach’s article. Through their eyes, Ms. Roach unveils a small web of nurseries in the United States that painstakingly develop distinctive new garden plants through cross-breeding and seedling selection. Johnston and Bowen work *without* patent protection. “Sometimes a larger nursery might pick up on Mr. Bowen’s successful but unpatented crosses and selections, ramp up production and capitalize. But that’s all right, he said. He is content to be part of the legacy of each plant. ‘Posterity is often easier to realize in horticulture,’ he said, ‘than prosperity.’”

<https://www.nytimes.com/2021/03/17/realestate/why-shop-at-a-specialty-nursery-issima.html>

## Can you patent panela?

Jennie Erin Smith took a deep dive into the world of *panela*, a sweetener made from sugar cane juice, in her January 26, 2021 article entitled, “Colombians Ask: Who Would Dare Patent Panela?” The piece starts by reporting that a U.S. patent for “a method for making an unrefined sugar” was issued last year to “a shareholder at one of Columbia’s largest sugar companies” but that “to Columbians, the process . . . rings suspiciously familiar. It is indistinguishable from that for panela, a sweetener made here since the arrival of the Conquistadors.” What follows is Ms. Smith’s wide-ranging look — brought to life by striking photos — into panela’s history, nutritional value, production (both industrial and small scale), markets, and status as a food staple. She reports that Columbians consume a “pound per person per week” of panela, according to Fedepanela, Columbia’s national federation of panela producers, and “‘agua panela’ — panela dissolved in hot water — is an essential source of calories for working people. Her piece reflects criticism of the USPTO: “To patent a humble staple like panela struck Columbians as absurd, like patenting café con leche. . . . Fedepanela lawyers would like to know how an ancestral process so richly documented in Columbia could have escaped the attention of the [USPTO]. Not only do colonial-era records describe it in minute detail but technical universities all over [Columbia] also produce literature on panela.”

<https://www.nytimes.com/2021/01/26/science/colombia-panela-patent-gonzalez.html>



### **Are PTAB Judges “Principal Officers”?**

The question of whether the 250+ PTAB Judges were properly appointed, the key issue in the *Arthrex v. Smith & Nephew* case before the Supreme Court, has spilled over to the mainstream media. This case is likely a familiar topic of water-cooler (now, Zoom) conversation for NYIPLA’s audience. If the Court finds that the PTAB Judges are “Principal Officers” under the Constitution, it has to figure out if it can fix the appointment regime to its satisfaction or otherwise punt the appointment process back to Congress to reform. Recognizing that the PTAB’s power to invalidate a patent can be worth millions or billions of dollars, numerous news outlets reported on the oral argument that took place before the Court on March 2, 2021. Bloomberg even invoked former Federal Circuit Chief Judge Rader’s old characterization of the PTAB as a “death squad” for patents. While the Biden administration has taken the position that the PTAB Judges are properly appointed inferior officers, these news stories stress the Justices’ skepticism with that position, questioning the power exercised by PTAB Judges who were not appointed by the President and confirmed by the Senate. These articles also discuss that the Justices are contemplating whether they have the power to vest the PTO Director with review authority over PTAB decisions to cure the constitutional issue.

<https://www.nytimes.com/2021/03/01/us/politics/supreme-court-patent-judges.html>;

<https://www.bloomberg.com/news/articles/2021-03-01/supreme-court-justices-question-powers-of-patent-death-squad>;

<https://apnews.com/article/us-supreme-court-coronavirus-pandemic-patents-courts-b7f527bf4c6520ea0deb3d59d47bbbbc>



## 'As Time Goes By - Centennial Sentinel'

BY: DALE CARLSON\*

It goes without saying that our Association wasn't born until four years after the Spanish flu epidemic was in full force in 1918. That flu didn't originate in Spain, but rather in Kansas, of all places.

The Spanish flu was named such because press about the virus emanated from there. As a neutral country during World War I, Spain's news media was able to cover topics beyond the war effort dominated by countries engaged in the war, including the United States.

After that pandemic ended, there seems to have been little appetite for survivors to broach the topic with their successors. Perhaps the reason is that there were so many other potentially-fatal diseases circulating at the time, including polio, black diphtheria, and tuberculosis, that the Spanish flu was just another addition to the list. Through scientific advances, cures or preventive measures were eventually discovered for those diseases.

By the time of our first Judges Dinner in December 1922, masking and social distancing seem to have become a faded memory. By then, the Spanish flu had become endemic, circulating around the globe, together with variants, for the next century as the so-called seasonal flu.

The mood at our first Judges Dinner was festive, light-hearted and celebratory, seemingly a fitting reflection of the era known as the Roaring Twenties. It stands as a testament to humanity's ability to continue to survive and thrive.

What can we learn from the time-line of the prior pandemic? Presumably by 2024 COVID-19 will too have become endemic, and its threat to survival a distant memory. By then, our Judges Dinners should be back in full force.

Already, we can pretty much chalk up 2021 for the books as a virtual year, thankfully with technology enabling us to function effectively at any distance. 2022 and 2023 pose real question-marks as to how they will unfold. We will find out soon enough.

In the meantime, one thing is certain. Our Association has endured tough times before, including the Great Depression, World War II, the dot com bust, and the Great Recession, to name a few. Each time, our Association has come back stronger than before. With the past as prologue, we can count on the adaptability, flexibility and sheer grit of our members to enable the NYIPLA to flourish in its second century.

\* Mr. Carlson is an NYIPLA past president and current historian. His email is [dale.carlson@quinnipiac.edu](mailto:dale.carlson@quinnipiac.edu).

# 2020-2021 WEBINAR RECAPS

## Discussion with Chief Judge Leonard P. Stark

May 5, 2020

The Programs Committee organized a webinar on May 5, 2020 with the Honorable Leonard P. Stark, Chief Judge of the United States District Court, District of Delaware to discuss the impact of the COVID-19 pandemic on practice before the District Court for the District of Delaware. Judge Stark discussed developing rules and procedures for handling the court's busy docket and ways the court conducted hearings during these unprecedented times. The webinar was moderated by Heather Schneider, Partner at Willkie Farr & Gallagher LLP.

## Discussion with Director Andrei Iancu, USPTO

June 4, 2020

The Programs Committee organized on webinar on June 4, 2020 with Mr. Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. The webinar was moderated by NYIPLA President, Colman B. Ragan. Director Iancu discussed the impact of the COVID-19 pandemic on the USPTO and its impact on deadlines before the USPTO. Director Iancu explained that the USPTO has been able to continue its full workload and had existing infrastructure to transition to full remote working during this time.

## The July 2020 Amendments to the Federal Circuit Rules of Practice

July 8, 2020

On July 8, 2020, the Patent Litigation Committee presented a panel discussion entitled, "July 2020 Amendments to the Federal Circuit Rules of Practice." This panel provided an overview of the Federal Circuit's numerous rule changes and updates to various forms, and perspectives on their impact on Federal Circuit appeals and practitioners. The panel included Mark C. Fleming of WilmerHale LLP, Richard M. Koehl of Hughes Hubbard & Reed LLP and Jennifer Rea Deneault of Paul, Weiss, Rifkind, Wharton & Garrison LLP. The panel was well-received and provided a concise summary for appellate practitioners.

## Discussion with Judge Lucy H. Koh

July 14, 2020

On July 14, Committee Co-Chair Jon Auerbach moderated a discussion with Hon. Lucy H. Koh, District Judge for the Northern District of California about the Court's response to COVID-19 and its current practices.

## Alternative Dispute Resolution in the COVID-19 World: A Panel Discussion

July 29, 2020

On July 29, Committee Co-Chair Lynn Russo moderated a panel discussion on alternative dispute resolution in the COVID-19 world. The panelists included Judge Garrett Brown, Judge Elizabeth Laporte, James Amend, and P.J. Murphy.

## Pandemic Impacts on Trademark Enforcement, Licensing Breaches/Force Majeure, and Brands in Bankruptcies

August 5, 2020

On August 5, 2020, the NYIPLA Trademark and Programs Committees presented a CLE Webinar on “Pandemic Impacts on Trademark Enforcement, Licensing Breaches/Force Majeure, and Brands in Bankruptcies.” The program was to address the issue that the pandemic had reduced access to the courts, thereby affecting trademark policing and enforcement. In addition, some trademark licensees in hard hit industries such as restaurants, hotels, manufacturing and other service business would be impacted by licensees’ difficulties in meeting minimum royalties or sales requirements unless the licensee could avail themselves of force majeure clauses or the impossibility/frustration defense. Finally, the wave of bankruptcies from the pandemic was affecting brand owner-licensors and resellers, sometimes leaving the disposition of branded inventories to be resolved in the bankrupt’s estate. Richard Levy, Jr., a partner in Prior Cashman LLP’s Bankruptcy and Creditors’ Rights Group, discussed the impact of the Supreme Court’s 2019 decision in *Mission Products Holdings, Inc. v. Tempnology, LLC*, 587 U.S. \_\_\_, 139 S. Ct. 1652 (2019). This pre-pandemic case declared that a bankrupt licensor’s “rejection” of an unexpired trademark license under federal bankruptcy law operates only as a breach of the license, not as termination, and that the licensee may continue to use the mark in accordance with the contractual terms. In the pandemic context, the bankruptcy of the licensee or reseller could lead to increased rejections of trademark licenses which would also be treated as breaches but not as terminations, but because the license terms and restrictions would remain enforceable just as they existed outside bankruptcy, the bankrupt-licensee could face difficulties in disposing of branded merchandise through regular sell-offs or bulk sales without the licensor’s further consent. Cameron S. Reuber, a partner at Leason Ellis LLP, presented on enforcement of trademark rights and other IP in the midst of the pandemic, which limited the functioning of the courts. As he noted, IP Owners can still file lawsuits, but every other aspect of the process has been upended, making preliminary relief unlikely and progress on the merits much less predictable and slower to achieve. As one federal court in Chicago explained after summarizing the shutdowns and grave limitations cause by the pandemic, a TRO against sales of counterfeit unicorn drawings would be denied without prejudice pending an opportunity for a hearing with a greater showing of harm. In contrast, a motion for preliminary injunction of sales of a product directly tied to the pandemic, N95 masks, at an exorbitant price by a defendant likely to be confused with authorized resellers, was granted in less than 30 days. William Thomashower, a Counsel in Pryor Cashman’s IP Group, discussed force majeure and related contract defenses in trademark licensee breaches caused by the pandemic. The word “pandemic” was not routinely included in the list of events in force majeure clauses, which under New York law, ordinarily provide a defense only for specifically stated events that prevent the party’s performance. At the same time, such clauses often refer to “governmental laws and regulations” which would be applicable when state governments issued pandemic shut down orders or other restrictions affecting contract performance. “Acts of God” was another commonly listed event with potential applicability. In contrast, under New York law, performance rendered unprofitable or even likely to result in bankruptcy is not cognizable as an impossibility defense. He noted that future contract drafting would likely now make use of the word “pandemic” as a specified event in force majeure clauses.



## The Growing Scourge of Counterfeiting and Strategies to Tackle It

August 11, 2020

On Tuesday August 11, 2020, James Bikoff of Smith, Gambrell & Russell LLP and Peter Sloane of Leason Ellis LLP participated in a lively panel Q&A entitled "The Growing Scourge of Counterfeiting and Strategies to Tackle It". James and Peter discussed new trends in counterfeiting-scope, harm and remedies. Specific topics included how the nature of counterfeiting has changed in recent years, the ins-and-outs of working with customs, when to consider cooperating with competitors as well as potentially promising legislation on the horizon.

## Looking at Booking

August 13, 2020

On August 13, 2020, the Trademark Law and Practice Committee, as part of its virtual half-day program, presented a panel discussion on the Supreme Court's June 2020 decision in *Booking.com* which addressed the registrability and protectability of "generic.com" marks. Notably, the Trademark Law and Practice Committee filed an amicus brief in support of the respondent, *Booking.com*, which ultimately prevailed. The panelists included Frank Misiti of Rivkin Radler LLP and Bruce Baber of King & Spalding LLP and was moderated by Michael Cannata of Rivkin Radler LLP. The panelists addressed many aspects of the decision, including, the importance of consumer perception in evaluating "generic.com" marks, the probative value of consumer survey evidence, and how the decision will affect the examination of .com marks going forward. The panel discussion was well-received and was followed by several thought-provoking questions from the audience.

## In-house Counsel Happy Hour

September 9, 2020

On September 9, 2020, the Corporate Committee held its annual in-house counsel happy hour, and invited the Young Lawyers Committee to join. The virtual event featured a conversation with Corporate Counsel members to learn about working in-house and their career paths to get there. Corporate Committee Co-Chairs Laura Sheridan (Google) and Steven Purdy (IBM) moderated the discussion, and members Michele Antis (PwC) and Joshua Harris (Burford Capital), along with other in-house members, shared their insights with the group. The Corporate Committee appreciated the opportunity to engage with the Young Lawyers Committee.

## Developing Habits to Improve Your Practice & Take Better Care of Your Clients

September 30, 2020

The Law Firm Management Committee in September 2020 hosted a CLE presentation titled "Developing Habits to Improve Your Practice and Take Better Care of your Clients." NYIPLA participants learned from the presenter, Ms. Denise Gamez of Atticus Advantage Inc., about key strategies for client time management, and how client selection can affect your bottom line. Ms. Gamez over the past ten years has advised law firms and attorneys on how to grow their practices in a sustainable way. She has presented at numerous legal conferences, published several articles on law firm practice growth and assisted many law firms with their practices. Participants at the CLE

presentation learned simple, but powerful tools to take control of the clock. Ms. Gamez discussed some key strategies to avoid time-robbing interruptions. Also discussed was how an attorney's mindset can impact overall firm operation. Four cornerstones or key principles for law firm practice growth was explored, namely, time management, client development/marketing, building a great team, and cash flow/profitability. Strategies for each of these key principles were further discussed.

## **Report on Facebook v. Windy City and its Impact on PTAB Practice**

October 6, 2020

On October 6, 2020, the PTAB Committee sponsored an interactive Zoom Video Conference Meeting to discuss the Federal Circuit's opinion in Facebook v. Windy City Innovations, LLC, which issued on September 4, 2020. Specifically, the Federal Circuit held, inter alia, that there is no such thing as same party joinder in inter partes reviews and Section 315(c) is about joinder of parties to a proceeding and not joinder of issues. The decision also discusses a host of related decisions on institution, consolidation, appealability and non-appealability of PTAB decisions, POP panel decisions, the Administrative Procedures Act, Chevron deference, Skidmore deference and obviousness. The PTAB Committee was honored to feature Hon. William M. Fink, Vice Chief Administrative Patent Judge at the USPTO. The meeting also featured speakers Charles R. Macedo, PTAB Committee Co-Chair and Partner at Amster, Rothstein & Ebenstein LLP, Kenneth R. Adamo, PTAB Committee Co-Chair and Principal Attorney at Law Offices of Kenneth R. Adamo, Brian Murphy, PTAB Committee Member and Partner at Haug Partners, Christopher Lisiewski, PTAB Committee Member and Associate at Amster, Rothstein & Ebenstein LLP, and Robert J. Rando, Board Liaison and Partner at Taylor English Duma LLP. The speakers discussed the various holdings in the Windy City decision and several related and follow-on decisions before concluding the meeting with a lively conversation open to all attendees.

## **Diverse Careers in Intellectual Property Law**

October 13, 2020

On October 13, 2020, NYIPLA and Hofstra Law School hosted "Diverse Careers in IP Law." Attorneys practicing in a broad range of intellectual property fields discussed the opportunities available in today's intellectual property marketplace and how law students can navigate their career paths. The program featured Melissa Schoffer Farber, General Counsel at BroadwayHD, Michael Sparling, Vice President & Assistant General Counsel at 1-800-Flowers.com, Robert Rando, Partner at Taylor English & Duma, and Scott Forman, Senior Associate at WilmerHale.

## **NYIPLA Presidents' Forum**

October 21, 2020

In the first of two President's Forums, NYIPLA President Colman Ragan showcased his Led Zeppelin fandom and joined NYIPLA Immediate Past President Katie McCarthy in moderating a panel of experts addressing music copyright law, with the focus on the 2020 Ninth Circuit en banc decision involving "the greatest rock song of all time," STAIRWAY TO HEAVEN. Skidmore v. Zeppelin, 952 F. 3d 1051, 1055 (9th Cir. 2020). For 90 minutes, the invited audience of NYIPLA members and New York City area law students were privileged to hear a diverse array of panelists discuss and debate the challenges presented in music cases and how music infringement assessments may differ from other copyright infringement assessments such as those involving software, written works, photographs, and works of

visual art. We heard a judicial perspective from the Hon. Denny Chin, Circuit Judge, United States Court of Appeals for the Second Circuit, as well as the perspective presented in an amicus brief by the U.S. Copyright Office from Nicholas Bartelt, Attorney Advisor at the Copyright Office. We also heard from Prof. Christopher Buccafusco, Professor of Law, Benjamin N. Cardozo School of Law, who along with other professors of law, also submitted an amicus brief. Brian Caplan, Member & Partner, Reitler Kailas & Rosenblatt LLC, presented the music litigator's point of view, while Alisa Coleman, COO, ABKCO, and Chair, Mechanical Licensing Collective, gave the point of view of a music licensing collective. Dr. E. Michael Harrington, Professor in Music Copyright and Intellectual Property, Berklee College of Music, and a frequent expert witness in copyright cases, was able to further explain and put into historical and musical context the chromatic scale at issue in the STAIRWAY TO HEAVEN case from the point of view of a musicologist. Last, but certainly not least, we also listened to segments of the songs at issue. Copyright committee members Jeremy King and Joshua Weigensberg were instrumental in helping assemble our esteemed panel.

## Arthrex at the Supreme Court

November 3, 2020

On November 3, 2020, the PTAB Committee hosted a Zoom Video Conference Meeting to discuss the Supreme Court's decision to grant certiorari in a trio of related petitions involving the Federal Circuit's October 31, 2019 decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2020). With a discussion led by Charles R. Macedo, PTAB Committee Co-Chair and Partner at Amster, Rothstein & Ebenstein LLP, and Chandler Sturm, PTAB Committee Member and Associate at Amster, Rothstein & Ebenstein LLP, the session began with a refresher of the Federal Circuit's decision, how that decision is being criticized and challenged, and the questions the Supreme Court took for review—whether PTAB APJs were principal or inferior officers for purposes of the Appointment Clause of the U.S. Constitution, and if so, if the “fix” worked. The PTAB Committee ended its meeting with a discussion on the USPTO's request for comments on new proposed rulemaking with respect to PTAB Practice regarding serial petitions, parallel petitions, and proceedings in other tribunals.

## Fall Patent CLE Series

November 10, 2020

On November 10, 2020, the PTAB Committee hosted an interactive panel at the NYIPLA's Fall Patent CLE Series: Mock PTAB Hearing: How to Handle Difficult Issues that Come Up During a PTAB Trial. PTAB trials are similar to but unlike other types of hearings that patent lawyers often participate in at trial court, the Federal Circuit or even PTAB appeals. They have unique guidelines based on the authority granted and not granted to PTAB APJs under the Patent Act, USPTO Regulations and Guidance, PTAB practice, and Federal Circuit and Supreme Court cases. The panel walked through portions of a mock PTAB Trial including, the Pre-Hearing Conference, Petitioner's Argument, Patent Owner's Argument, and Rebuttal. The panel members raised some difficult examples of issues that may come up during a PTAB Trial including, handling of confidential information, objections to newly presented evidence, and waiver, with suggestions and commentary on how to address the issues at hand. The panelists leading the discussion included Brian Murphy, PTAB Committee Member and Partner at Haug Partners in the role of PTAB APJ, Charles R. Macedo, PTAB Committee Co-Chair and Partner at Amster, Rothstein & Ebenstein LLP in the role of Petitioner's Counsel, Kenneth R. Adamo, PTAB Committee Co-Chair and Principal Attorney at Law Offices of Kenneth R. Adamo in the role of Patent Owner's Counsel, and Christopher Lisiewski, PTAB Committee Member and Associate at Amster, Rothstein & Ebenstein LLP in the role of PTAB Clerk.

## **Social Mixer - This Is Your Chance to Really Understand the PTAB**

November 12, 2020

On November 12, 2020, the Young Lawyers Committee hosted a discussion with former Patent Trial and Appeal Board (“PTAB”) judge and current Wilson Sonsini partner Lora M. Green. She provided a historical perspective on the PTAB as well as practice tips. She also provided her personal perspective on becoming an administrative patent judge. Jennifer Rea Deneault of Paul, Weiss, Rifkind, Wharton & Garrison LLP facilitated the discussion. This social mixer had strong audience engagement. The questions were practical and lead the program in interesting directions that covered a wide range of topics. The event was part of the Fall Patent CLE Series.

## **PTAB Committee Tackles Discretionary Denials**

December 1, 2020

On December 1, 2020, the PTAB Committee hosted a Zoom Video Conference Meeting to discuss the PTAB’s discretion to institute trials before the PTAB and the USPTO’s request for comments on the new proposed rules with respect to discretionary denials. The session began with a presentation discussing the current state of the law related to the PTAB’s discretionary denial power and then delved into whether the proposed rules make sense. The discussion was then opened to committee members to share their thoughts and opinions. Charles R. Macedo, PTAB Committee Co-Chair and Partner at Amster, Rothstein & Ebenstein LLP, and Devin Garrity, PTAB Committee Member and Associate at Amster, Rothstein & Ebenstein LLP led the discussion.

## **Women in IP Law Trivia Night**

December 16, 2020

On December 16, 2020, the Women in IP Committee held an IP Trivia Night. The event was held virtually, and was hosted and moderated by attorneys from Goodwin. Teams of competitors gathered in break out rooms to brainstorm tough categories of questions, including US legal history, notable women jurists, and classic holiday movies. Those in attendance laughed, learned, and reconnected with other NYIPLA members.

## **Update on Latest PTAB Rules and Precedential Decisions**

January 5, 2021

On January 5, 2021, the PTAB Committee hosted a Zoom Video Conference Meeting to discuss the new rules issued by the Patent and Trademarks Office as well as the newly-designated precedential PTAB decisions involving real party-in-interest, copycat petition, and institution issues. The PTAB’s decisions in *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (Oct. 2, 2020) (precedential) and *SharkNinja Operating LLC, v. iRobot Corp.*, IPR2020-00734, Paper 11 (Oct. 6, 2020) (precedential) are helpful clarifications of PTAB practice now that the Federal Circuit has confirmed that decisions regarding time bars of petition and real party in interest are no longer considered appealable to the Federal Circuit. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential) is another helpful clarification on the limited scope of joinder motions. In addition, *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential) and *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 (Oct. 21, 2020) (precedential) provided insight on the



PTAB's institution analysis under the Fintiv factors. The PTAB Committee also discussed the USPTO's final rules issued in December 2020 codifying PTAB's existing practices for burdens of persuasion in motions to amend (85 Fed. Reg. 82923 (Dec. 21, 2020)), as well as rules of practice for instituting an IPR or PGR on all challenged claims and grounds, patent owner responses and sur-replies, and presumptions on institution (85 Fed. Reg. 79120 (Dec. 9, 2020)). Charles R. Macedo, Partner at Amster, Rothstein & Ebenstein LLP and PTAB Committee Co-Chair, and Chandler Sturm and Devin Garrity, Associates at Amster, Rothstein & Ebenstein LLP and PTAB Committee Members, led the discussion before opening conversation regarding the practical application of these decisions and rules to all attendees.

## **Paths to Equity & Inclusion in Intellectual Property Law**

January 28, 2021

On January 28, 2021, the New York Intellectual Property Law Education (NYIPLEF) in collaboration with the NYIPLA co-hosted a panel discussion on efforts to create more inclusivity in the field of IP law. The panel was moderated by Jasmine Whyte, a student at Columbia Law School and winner of the 2020 NYIPLEF Diversity Scholarship. The NYIPLEF Diversity Scholarship was established to provide funds to talented and diverse law students pursuing a career in the IP profession. The panel also included Serena Farquharson-Torres, Senior Corporate Counsel, Innovation Law at Bristol Myers Squibb; Melvin Garner, a Partner at Leason Ellis; Sharonmoyee Goswami, a Partner at Cravath Swaine & Moore; and Bismarck Myrick, Director of the Office of Equal Employment Opportunity and Diversity at the USPTO. The panel of experienced professionals discussed their career journeys and the hurdles and challenges that they have experienced as diverse members of the IP community. The panel also discussed current efforts and advice on creating more inclusivity in the field of Intellectual Property law at law firms, the courts, and at the USPTO. The program offered one CLE credit that qualified for the diversity, inclusion and elimination of bias in the legal profession New York CLE requirement. The New York Intellectual Property Law Education Foundation NYIPLEF is a charitable organization 501(c)(3) whose mission is to promote intellectual property law education to diverse, outstanding law students in the New York area. The Foundation was established in 2015 but functioned prior as a direct scholarship from the New York Intellectual Property Law Association.

## **PTAB Committee Tackles PTAB'S Fast-Track Appeals Pilot Program**

February 2, 2021

On February 2, 2021, the PTAB Committee sponsored an interactive Zoom Video Conference Meeting and was thrilled to have Lead-APJ Dave McKone and Vice Chief Judge for Engagement Janet Gongola join the PTAB Committee to discuss the PTAB's Fast-Track Appeals Pilot Program that was started in July 2020 for ex parte appeals. Under the Fast-Track Appeals Pilot Program, appellants can have their ex parte appeals advanced out of turn. Appellants simply file a petition to request fast-track review of their ex parte appeal and pay an additional petition fee. The PTAB has set a target of issuing a decision within six months from the date the petition is granted, and the ex parte appeal is entered into the pilot program. Lead APJ Dave McKone and Vice Chief Judge for Engagement Janet Gongola led the discussion providing information how the program functions and statistics about appeals that have applied to take part in the program. They also sought feedback about the program since the 1-year Pilot Program had reached the six-month point before discussion was opened to all attendees to share their thoughts and opinions on important issues related to the program.

**MINUTES OF DECEMBER 8, 2020**  
**MEETING OF THE BOARD OF DIRECTORS OF THE**  
**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**

The Board meeting was held via videoconference. President Colman Ragan called the meeting to order at approximately 4:00 p.m. In attendance were:

Colman Ragan, President, presiding  
Gene Lee  
Marc Pensabene  
Jonathan Berschadsky (joined by 4:15 pm)  
Kathleen McCarthy (joined by 4:15 pm)  
Diana Santos (joined by 4:15 pm)  
Paul Bondor  
Rob Isackson  
Rob Rando  
John Moehringer  
Patrice Jean  
Heather Schneider  
Alicia Russo  
Cheryl Wang

Feikje van Rein attended from the Association's executive office. Abigail Struthers was unable to attend. John Mancini left at 5:48 p.m.

The meeting was called to order by President Colman Ragan. Minutes from prior meeting were approved.

**Financial Report:** Feikje reported that the organization is on a slower trajectory down than the auditor predicted. This has been the result of pivoting to virtual paid programming, which involve less overhead.

**New Members:** There were 4 new members approved for membership. We are down about 400 members, a majority of which are mid-level associates.

**Other Programming:** The Board discussed the various factors impacting the drop in membership, partly the result of canceling the Judge's Dinner. The discussion also focused on the need for engaging content and speakers. Another discussion point was the potential value of expanding the organization's more patent-driven focus to engage a variety of other intellectual property practices.

**NYIPLA Bootcamp:** Heather Schneider reported that the organizational kick-off call went well with enthusiastic discussion. The proposal is for the first bootcamp to be about patent litigation, as the expertise and prepared materials are readily available. Instead of 2 full days, it will be broken out over sessions, e.g., 5 sessions for about 1.5 hours each. There will be opportunities for mid-levels to teach which provides additional membership incentive. The Board agreed that the following bootcamp should be outside of patents.

**Amicus Brief Committee:** Rob Isackson noted that everything is currently on hiatus and that is expected to be the case until after inauguration. Due to differences of opinion among the board members, the committee ultimately did not file in Arthrex. He also pointed out that with respect to marketing for membership, the ABC committee is very active on policy and has filed briefs covering a variety of subject areas.

Legislative Action Committee: Colman Ragan reported on S.4711, a bill providing for judicial security and privacy, which is still pending and also likely to be on hold until next Congress. The plan is to review existing whitepapers and publish updates. Senator Cornyn put certain pharmaceutical pricing bills on the floor. Although nothing is happening until January, the committee is working with Chris Israel on negotiations. Katie McCarthy reported that DMCA reform will likely be taken up by next Congress given the bipartisan support. Despite bipartisan support, there are differing motivations, including a strong politically motivated influence.

Judge's Dinner 2021: Colman shared the NJ judges' feedback and the majority sentiment was that if the event will essentially require sitting through another Zoom call, then it would be best to wait for a time it can be held in-person. Currently, the Supreme Court justices that were contacted have declined except for Justice Thomas. Katie reported that we are still waiting to hear back from his chambers.

The Board was largely in agreement that it would still be worthwhile to secure a Supreme Court justice but the remainder of the discussion focused on alternative event ideas and ways to raise money and/or membership. The Board agreed on a date in April and everyone tentatively agreed that April 8th would be a good date.

Centennial Project: Rob Rando reported that he is working with Feikje to schedule a January 11th meeting. In the meantime, Dale is gathering historical information and artifacts.

Previous and Upcoming Programs:

11/10 - 11/19 Fall Patent CLE Series: Heather Schneider reported the series generated \$11,332 at a price point of \$150 which included diversity and ethics CLE credits.

11/12 Young Lawyers Social Mixer: Marc Pensabene was ultimately unable to attend but Rob Isackson attended and noted that there was good engagement among the 6-7 people who attended. Rob suggested holding an interview tips workshop for the next OCI cycle.

12/3 6 pm Diversity Fundraiser: Patrice Jean reported that the NYIPLF fundraiser went well and the money raised was enough to cover both prize awards this year. A motion to accept NYIPLF's offer to cover the amount for both prize awards this year was passed.

The meeting was adjourned at approximately 6:15 pm.

**MINUTES OF JANUARY 12, 2021**  
**MEETING OF THE BOARD OF DIRECTORS OF THE**  
**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**

The Board meeting was held via videoconference. President Colman Ragan called the meeting to order at approximately 4:00 p.m. In attendance were:

Colman Ragan, President, presiding  
Gene Lee (late)  
Marc Pensabene  
Jonathan Berschadsky  
Kathleen McCarthy  
Diana Santos  
Paul Bondor  
Rob Isackson  
Rob Rando  
John Moehringer  
Patrice Jean  
Heather Schneider  
Alicia Russo  
Cheryl Wang (joined at 4:39 pm)

Rob Rando and John Mancini were excused from the meeting.

Feikje van Rein attended from the Association's executive office.

The meeting was called to order by President Colman Ragan. Minutes from prior meeting were approved.

Various ideas for the Judges' Dinner were discussed including a famous chef doing a cooking session with a judge or Colman & Katie, other types of entertainment, etc.

Board members discussed the Remo.co platform for the Judges' Dinner. The platform was well-received. A motion for approving the Remo platform in order to move forward with soliciting sponsorships was approved. The Board discussed the sponsorship levels suitable for vendors. Individual pricing has been set at \$195 for members and \$395 for non-members.

Board members noted that because the event is virtual and given the prices set, it will be important to have good gift bags. Ideas for gift bags discussed included useful household items that would have the NYIPLA logo or label on it.

Other Programming: The Board discussed the benefit of having events lined up so that they can be announced at the Judges' Dinner. The board members agreed that it would be beneficial to consider scheduling consistent programming throughout the summer, which has traditionally been quiet. The board agreed it was worthwhile to consider putting on unique programming that offers different perspectives while leveraging the convenience of a virtual environment. An example of that programming: panel of counsel that has argued in front of the Supreme Court.

NYIPLA Bootcamp: Heather Schneider reported that the first bootcamp will start in June, with patent litigation. The timing was selected so as not to interfere with the Judge's Dinner. Additional boot camps will potentially be added over the summer, perhaps even working in parallel.

Amicus Brief Committee: Rob Isackson reported that we reached a small quorum for Valeant v. Mylan so he proposed moving forward based on the majority of those who are not conflicted out. The motion was passed. Rob noted that the ABC is following the cases: GS Cleantek case is pending court granting



cert; Hazaki case about protectability of Pocky confectionary designs; Aeirioso v. Alumina case about separating DNA fragments where, if cert is granted, the committee will probably weigh in. VIP Products v. Jack Daniels was denied so there will not be an amicus.

Legislative Action Committee: Another group on Section 101 – draft answers will be circulated to the board which are due on the 20th. Colman will attend on the 22nd. S4711 – Judicial Conference will likely push to have it reintroduced in the next Congress. The committee is working on comments for patent CLEs and patent design & liability. With a democratic majority, there will probably be more pharma cases that the LAC will need to monitor.

Inventor of the Year: Request to the board to extend the deadline from February 4th to March 15th. The board members discussed the timeline, where the individual is named at the Judges' Dinner and honored a month later. The board approved the request.

The meeting was adjourned at approximately 6:00 pm.

**MINUTES OF FEBRUARY 9, 2021**  
**MEETING OF THE BOARD OF DIRECTORS OF THE**  
**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**

The Board meeting was held via videoconference. President Colman Ragan called the meeting to order at approximately 4:00 p.m. In attendance were:

Colman Ragan, President, presiding  
Gene Lee  
Marc Pensabene  
Jonathan Berschadsky  
Kathleen McCarthy  
Diana Santos  
Paul Bondor (joined at 5:10 pm)  
Rob Isackson  
Rob Rando  
John Moehringer  
Patrice Jean  
Heather Schneider  
Cheryl Wang  
Abigail Struthers

Feikje van Rein attended from the Association's executive office.

The meeting was called to order by President Colman Ragan. Minutes from prior meeting were approved.

Abigail Struthers provided the Financial Report. Currently, the organization is in a holding pattern until we can generate more income. Assets are being spent down but normal operating expenses have been reduced. Additionally, there is still money being held at the Hilton & Conrad. Reissued checks added to this year as \$50k but were applied to last year. It looks worse also because of the \$660k refunded from the Judges' dinner. The figures seem skewed as a result but technically, operating with \$950k. Money from Sponsors for the Judge's dinner have started coming in. There were no new members in the last month. We are at 625 now versus 1000 members based on last year.

Colman Ragan reported that the Judge's Dinner costs have already been covered based on the \$50k that has been committed so far. 5 recipes have been submitted so far and we will see if the entrants will make a video about the recipe and potentially turn it into the competition. 35-40 judges have signed up already. Chef Michael from Princeton Club is being considered to host the event because his price point is appropriate, and he handled the NYIPLEF event well. There has not been a lot of interest in suites. Feikje mentioned that the Teva sponsorship helped secure additional law firm sponsorship. Kathleen reported that King & Spalding signed up for the Platinum sponsorship.

Amicus Briefs Committee. Rob Isackson reported that the committee met on the 4th where they discussed Surgical which involves the doctrine of assignor estoppel. Although he is conflicted out, the committee proposal take the position that the doctrine should remain. A hardline rule for assignor estoppel seems inequitable but may be appropriate on a case-by-case basis. Brief has to be filed by March 1st so the Board will need to answer by the end of business Thursday. Minerva is arguing that the whole doctrine should be thrown out and also arguing equitable argument in cert petition. The committee also talked about the Christie v. US case, where once your patent is invalidated, does it constitute a taking under the 5th Amendment that entitles one to reimbursement or fees refunded. Committee has decided to pass and will wait to see if cert is granted. Still waiting to hear on American Axle and Arthrex.

Legislative Action Committee. Colman noted that the Copyright, Trademark, and Fashion Law Committee planned to set up a call on Shop SAFE Act and INFORM Consumers Act. Copyright Office reached out to have open discussions and also requested input about the Copyright Modernization Act. Currently, not much going on because of impeachment proceedings, but afterwards, likely to be looking at drug production. More states have introduced a CA-style bill where settlements may be considered anti-competitive. Many of the legislative topics are issues where NYIPLA has whitepapers. 101 is on hold for now and legislative action will most likely be for covid funding. If the Defense Production Act is used, then LAC will consider weighing in.

NYIPLEF Bingo & Diversity Event. Patrice Jean reported that the previous diversity included 1 diversity CLE credit and was typically part of the Judges' Dinner. The event made a little over \$2k. The next event planned is Bingo on Feb 26th at 6 pm. Tickets are \$50 for the event and people can spend more with the understanding that the extra amount goes directly to scholarship funds. The next scholarship application process is already up and running. The deadline is mid-April. The Board approved a motion to split the funds from the previous diversity event.

Connor Writing Competition. Gene Lee reported that the competition launched in September and the period for submissions is closing at the end of the month. The committee already received submissions. The Board discussed and determined that it would not be fair to accept a submission from an individual with a JSD, where an underlying law degree is already required.

NYIPLA Bootcamp. Heather Schneider reported that the kickoff meeting for the core group who will work on the patent litigation bootcamp launching in June. There are 2 people in charge of each topic based on the proposal send around to the Board. The core group will get together in 2 weeks to discuss in more detail, including the idea of having guest speakers come in and give tips. Transactional groups can separately start planning in parallel.

Nominating Committee. Kathleen McCarthy reported that Feikje, Pete, and Katie will set up a call for the Nominating Committee. Suggestions needed for people to consider for nomination. Timing to keep in mind: 40 days before annual meeting, scheduled for May 18. Nominations should consider a mix of large and boutique firms, patent prosecution & enforcement, as well as keeping diversity in mind.

Centennial Project. Rob Rando reported that the logo has been finalized and that this project will take off after the Judge's Dinner in April. Launch for promotion will take place at the Annual Meeting in May. For content, considering videos of past presidents and a unique event such as updating judge's robe designs through Fashion Law committee and CFDA to design something. Feikje will find out about moving the deposit with Hilton; it would be better to move out to 2023 but seems likely we will have to move to 2022 and use that place to hold the Centennial Project.

Programs: Feb 17th IP Student Note Poetry Slam Marc Pensabene reported that a great program is in place, there are still a couple of slots open so recommendations are welcome. Paul Bondor reported that Feb 24th, there will be a panel to discuss best practices in the COVID era among mid-size, smaller and boutique firms. 24 people have registered for the program so far. Rob Rando reported that on Feb 25th the Getting Ready for Arthrex Oral Arguments will launch. Charles Macedo put together video clips of arguments for Arthrex, which features various perspectives from filers. There are 6 submissions at least so far with videos due Fri. Abigail and Marc reported that on the panel set up for March 10th Biologics & Biosimilars event. There is a good lineup of speakers to address developments in the last year, including Linda Nguyen from Regeneron, HuiYa Wu from Goodwin. There are already 25 people registered for the program.

# MOVING UP & MOVING ON



## **SHEILA MORTAZAVI AND MARK CHAPMAN**

Formerly of Hunton Andrews Kurth LLP, have joined Haug Partners LLP as Partners.



## **DAVID MORENO**

Formerly of Spar & Bernstein PC, has joined Brown Rudnick LLP as a Partner.



## **MARK BERKOWITZ, TUVIA ROTBERG, AND SANDRA HUDAK**

Formerly of Amster Rothstein & Ebenstein LLP, have joined Tarter Krinsky & Drogin LLP, with Berkowitz and Rotberg joining as Partners and Hudak joining as an Associate.



## **PAUL FALKER**

Formerly of Orrick Herrington & Sutcliffe LLP, has joined Mayer Brown LLP as a Partner.



## **TYLER DOH**

Formerly of Goodwin Procter LLP, has joined Steptoe & Johnson LLP as an Associate.



## **STEVEN FELDMAN**

Formerly of Hueston Hennigan LLP, has joined Latham & Watkins LLP as a Partner, resident in New York and Los Angeles.



## **STEPHEN YANG**

Formerly of Alston & Bird LLP, has joined Steptoe & Johnson LLP as a Partner.



## **ROBERT HANEY JR.**

Formerly of Covington & Burling LLP, has joined Foley Hoag LLP as a Partner.



# UPCOMING WEBINARS

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

## APRIL

04/22/2021 99<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary

## MAY

05/05/2021 Creating Value from IP Assets: Legal Finance Perspectives

05/12/2021 NYIPLEF Virtual Bingo Night!

05/18/2021 NYIPLA Annual Meeting

## JUNE

06/04/2021 Patent Litigation Bootcamp

## RENEW YOUR MEMBERSHIP TO NYIPLA

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- Share and learn best practices with peers & senior IP professionals

- Explore a practice area & develop new strategies with a committee

- Advice Congress on challenges facing the IP community

[RENEW ONLINE](#)

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Margaret Welsh

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John Kenneth Felter  
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Richard Koehl  
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Keith McWha  
Clint Mehall  
Suzanna Morales  
Calvin Wingfield

## NYIPLA Executive Office

2125 Center Avenue,  
Suite 616  
Fort Lee, NJ 07024, USA  
Tel: 1.201.461.6603  
Email:  
[admin@nyipla.org](mailto:admin@nyipla.org)  
Web: [www.nyipla.org](http://www.nyipla.org)

