

Nineteen Hundred and Twenty-two

**NYIPLA**

The New York Intellectual Property Law Association

100 YEARS

# 2021-2022 GREEN BOOKLET

ASSOCIATION ANNUAL REVIEW

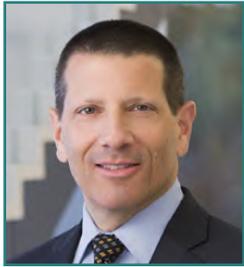
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# 2021 - 2022 BOARD OF DIRECTORS

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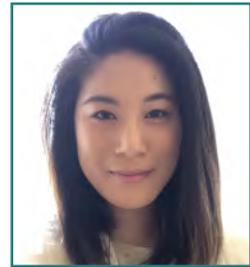
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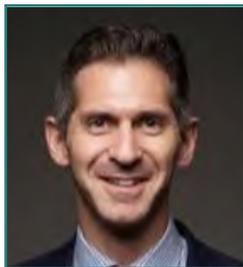
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# 2021 - 2022 YEAR IN REVIEW

BY: ROBERT M. ISACKSON, 2021 - 2022 NYIPLA PRESIDENT



Like my two immediate predecessor Presidents, Katie McCarthy and Colman Ragan, I found my now ended term as President of NYIPLA to be one of living in most interesting times. COVID 19 has certainly twisted life and will likely continue to do so for some time to come.

On the one hand, the continuance of virtual meetings saved me from the dilemma of whether to ask all the Board members to trek up to my office in White Plains for our in person monthly meetings, or I train it down to someone's Manhattan office – Zoom provided the easy time-saving solution and only the MTA lost out.

On the other hand, I had the very good fortune to be able to host in person the 100th Annual Dinner in Honor of the Federal Judiciary last March at the New York Hilton. At the beginning of my term, I felt that my greatest challenge was going to be how to top Colman's kitchen mastery, convinced that reading poetry would not work. As time passed, we kicked the can as far down the road as possible, and once we saw an ebb, we seized the opportunity and decided to go in person. Gratefully, New York State cooperated by timely dropping the mask and vaccination mandates, and there was neither poetry, cooking in my kitchen, nor worrying about whether beverages and swag would be delivered in time to virtual attendees.

Our 100th Judges' Dinner was a special event, as we basked in a full ballroom with the usual live performers, hospitality suites, and speeches – in concert with the Master Shusher. I got to hand the (heavy) Outstanding Public Service Award to Judge Leonard Stark, in recognition of his valuable contributions and innovations in IP law while serving in the District of Delaware. Circuit Judge O'Malley, unable to attend in person, kindly sent her pre-recorded congratulatory wishes. Judge Stark in turn shared his thoughts on receiving the award and then provided some useful, practical judicial guidance on how to discern whether one was in New York or Delaware. We also heard from our keynote speaker Michael Rogers, the noted

futurist, who shared his insights on what we can expect in terms of innovation in the next couple of decades. I'm particularly grateful to our judiciary, members, guests, and sponsors of hospitality suites (Allen & Ovary, Amster Rothstein & Ebenstein, Crowell & Moring, Demarais, Goodwin, Haug Partners, and Kirkland & Ellis), for trusting in our decision and ability to hold safely the event in person, and the New York Hilton team who seemed to pick up in 2022 right where we left off in 2019. Indeed, the only complaints I heard were from attendees who were having issues wearing shoes again.

This success was followed by another in-person NYIPLA event, namely our Annual Meeting, held on May 19, 2022 at the Union League Club. We began the evening with short presentations by our Committee Co-chairs, reflecting back on their recent committee activities and previewing plans for next year. One key part of that meeting (at least for me) was our annual election of Officers and Board members, which was duly certified. Bittersweetly, I handed the gavel to incoming President Heather Schneider, and she hit the ground running. I'm sure Heather will be a fabulous President.

At the dinner following the Annual Meeting, culminating the work of several committees, NYIPLA recognized the 2022 Inventor of the Year recipient, Dr. Steven Carlson, for his work in safety separators for rechargeable lithium-ion batteries widely used in electric vehicles and portable electronics, and handed out the awards to the Conner Writing competition winners, Sean Boren of St. John's University School of Law (first place for his article on [Going For Gold And Protecting It Too: Intellectual Property And The Olympic Games](#)), and Michaela Morrissey of University of Richmond School of Law (second place for [A Music Industry Circuit Split: The De Minimis Exception in Digital Sampling](#)). We also recognized the 2022 NYIPLEF Diversity Scholarship Award winners, Lydia Graham of New York University School of Law, and Kevin Liu of Cornell Law School. And of course, we were graced by Keynote Speaker Hon. Maryellen Noreika, District Judge, United States District Court for the District of Delaware.

These two events came at the end of what was another very busy and successful year in which NYIPLA committees hosted over 30 programs and events running the full gamut of IP issues for our members and guests.

Leading the charge with monthly CLE presentations was the PTAB Committee, led by co-chairs Charley Macedo and Ken Adamo, with Chris Lisiewski, Coordinator, and Rob Rando, Board Liaison, including presentations on the statistics of PTAB events, the new Director Review process after Arthrex and Appeals of Patent Trial and Board Final Written Decisions After Arthrex, insights on oral hearings before the PTAB, pending legislation concerning PTAB activities, and the issue of assignor estoppel in IPRs, to name a few. One program was together with the Young Lawyers Committee covering the key milestones in IPR, PGR and CBM proceedings before the PTAB. Many of the other programs included active participation from the PTAB, including Hon. Kal Deshpande and Hon. Scott Weidenfeller, Hon. Jessica Kaiser, and Chief Clerk Erica Swift. And Timothy Hsieh, Assistant Professor of Law, Oklahoma City University School of Law, came and spoke on APJ compensation and its ethical implications.

Particularly memorable for me was the PTAB Committee's game night presentation, an interactive trivia competition, hosted by USPTO officials, including Vice Chief Judge Kal Deshpande, Judge Amanda Weiker, and Judge Eric Jeschke, where the contestants responded to the "answers" with "questions," and the hosts elaborated with learning points in the categories covering precedential decisions, motions, and PTAB myths.

The Patent Law & Practice Committee, led by co-chairs Clint Mehall and Joy Goudie, picked up the baton and held a Fireside Chat with PTAB Judge Michael Cygan on Ex Parte Appeals at the USPTO, addressing, among other things, whether to pursue an appeal versus RCE strategy for patent applications, and the effectiveness of certain types of arguments before the PTAB on ex parte appeals. Another program presented by Fenn Matthew, Deputy Director of the USPTO Office of Petitions, who provided an overview of the Office of Petitions, its resources, data and statistics, and petitions-related updates, and helpful tips concerning petitions practice. The Committee also hosted Seana Cranston, the Deputy Chief of Staff and Legislative Director for Representative Thomas Massie, who spoke about Rep. Massie's bill, H.R.5874 – Restoring America's Leadership in Innovation Act, which proposes repeal of First-to-File System, One-Year Grace Period, Inter Partes and Post-Grant Review, as well as, abolishing inter partes and post-grant review, and PTAB. Other Patent Law & Practice committee programs involved a demonstration of some patent analytics and automation regarding commercial tools for patent prosecution and steering patent applications to particular art units, and a presentation by members of the USPTO to demonstrate the new Patent Public Search tool.

We also continued our usual activities. For example, the Trademark Law & Practice and Copyright Law & Practice Committees put on their annual trademark and copyright law CLE series featuring various updates on trademark case decisions, and legislative initiatives, including an update on the TTAB from Deputy Chief Judge Mark Thurman. Our annual Fall Patent CLE Series covered recent litigation trends from an in-house counsel perspective, updates on foreign patent law issues, patent litigation in the COVID era, legislative developments, preserving trade secrets, and artificial intelligence at the PTO. This program included a fireside chat with PTAB Chief Administrative Judge Hon. Scott Boalick, and participation from Charles Kim, Director of the Office of Petitions of the USPTO. Likewise, the Women in IP Law and Patent Litigation Committees reprised their annual Biologics and Biosimilars program, providing another year's worth of relevant updates.

This year's Presidents' Forum focused on intellectual property issues associated with name, image and likeness in the NCAA, exploring the copyright, trademark, privacy, and other intellectual property issues raised by the recent decision of the NCAA to allow collegiate athletes to profit from the use of their name, image, and/or likeness without losing their amateur status. We were fortunate to have a curated panel of experts in this area, including Gabe Feldman, Professor of Sports Law & Director, Tulane Sports Law Program, Tulane University and private practitioners Darren Heitner, Heitner Legal, Dan Lust, Geragos & Geragos, Douglas Masters, Loeb & Loeb, and Aliya Nelson, Greenspoon Marder LLP.

Among other programs, the Young Lawyer's Committee and the Women in IP Law Committee hosted a panel of founders who are innovating in the Women's Health and Life Sciences sectors, who addressed the growing momentum in the Women's Health sector and provided insights into their struggles and successes in managing IP. The Privacy, Big Data & Cybersecurity Committee put on a terrific presentation on the practical implications of the SolarWinds cyberattack, including the effects that the attack had on the allocation of risk between IT product providers and their customers and the stakes at issue at the negotiation table. The Young Lawyers Committee in collaboration with Cardozo School of Law's Intellectual Property Society presented an evening round-table discussion about intellectual property crimes and the impact on research and innovation in the U.S., discussing recent prosecutorial trends, the historical backdrop for intellectual property crimes, and how to balance overarching business and academic interests. The Trademark, Copyright, and

Transactions Committees put on a joint program about NFTs, addressing IP rights accompanying the sale of NFTs, transactional paperwork required to effectuate IP transfers associated with NFTs, IP disputes that may arise in connection with NFTs, and strategies NFT buyers and sellers might use to insulated themselves from IP-related liability.

NYIPLA also presented a Diversity Roundtable featuring distinguished speakers from in-house and private practice who discussed Career Transitions in IP and Strategies for Success for Diverse Lawyers in Technology; a seminar on a Unified Patent Court (UPC) that will handle all litigation for Unitary Patents and have parallel jurisdiction with national courts for litigation involving conventional European patents, unless the patent owner opts-out of the UPC; and a Zoom Out with NYIPLA, networking sessions with NYIPLA Board members, law firm associates and law students to share the tips and tricks to their success.

For a change of pace, NYIPLA initiated a collaboration with the San Francisco Intellectual Property Law Association and held a bi-coastal webinar on "Navigating Russian and Ukrainian IP Issues" in collaboration with the San Francisco Intellectual Property Law Association (SFIPLA), featuring speakers from across the U.S. The program encompassed multiple issues including, among other things, Russian sanctions, Russian and Ukrainian IP; key considerations in Russian IP disputes and licensing/collaboration agreements; export controls related to Russia/Belarus; and dealing with the USOFAC (U.S. Office of Foreign Assets Control). More collaborations with SFIPLA are expected in the coming year.

Lastly, and perhaps most innovatively, NYIPLA, spearheaded by the IP Transactions Committee launched our IP Transactions Bootcamp, a program geared towards junior and mid-level associates. This five-day program provided training on practical skills, covering an introduction to transactions, patents, data/tech software agreements, licensing agreements in copyright and trademark, and mergers and acquisitions and due diligence. We had an outstanding group of experienced attorneys and in-house counsel as instructors. The plan is to repeat this bootcamp, and add bootcamps in other areas, such as litigation.

With all of our programming, I want to express my particular thanks to the Programs Committee, headed by Lynne Russo and David Bomzer, who were awesome cat herders in formulating, organizing and ultimately making sure someone presented the varied continuing legal education programming that happened. Kudos and congratulations on such a successful year.

Also, we are of course grateful to all of those who contributed their valuable time to prepare for and present the programming, and share their insight and experience, for our audiences. This includes our in-house and private practice members, those in government, and all the non-NYIPLA members who participated. Thank you so much.

Our other committees were also active with regular meetings. For example, the Amicus Brief Committee met regularly and is watching a host of cases that might lead to meaningful amicus brief opportunities. During my term, however, only one case was deemed appropriate for NYIPLA to weigh in with an amicus brief, namely *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.* (Supreme Court No. 20-915, Certiorari Granted 6/2/21) – In this copyright appeal, the Supreme Court considered: “Did the Ninth Circuit err in breaking with its own prior precedent and the findings of other circuits and the Copyright Office in holding that 17 U.S.C. § 411 requires referral to the Copyright Office where there is no indicia of fraud or material error as to the work at issue in the subject copyright registration?” NYIPLA filed an amicus brief in support of neither party asserting that it is important that the Supreme Court set a uniform standard to

resolve any conflict among federal circuit courts on the issue before the court, and that the Ninth Circuit's standard below was the correct standard. The case was ultimately decided 6-3, and in Justice Breyer's majority opinion reversing the Ninth Circuit the Supreme Court held that Section 411(b) does not distinguish between a mistake of law and a mistake of fact; lack of either factual or legal knowledge can excuse an inaccuracy in a copyright registration under 411(b)(1)(A)'s safe harbor. Justice Breyer reasoned that because other Copyright Act provisions use "knowledge" to refer to knowledge of the law as well as the facts, nothing in the Act suggests that Congress sought to forgive an applicant's factual but not their legal mistakes, and if Congress had intended to impose a "scienter" requirement other than actual knowledge in the Act, it would have done so explicitly. Interestingly, the dissent (Thomas, J.) argued that the question answered by Breyer's majority was not properly presented on in the petition for a writ of certiorari.

The Legislative Action Committee (LAC) also had a busy year, regularly meeting and tracking the various pieces of IP related legislation percolating through Congress, and keeping the Board informed. But with COVID, infrastructure, and the war in Ukraine, IP issues pretty much took a back seat and not much progress was made. LAC representatives participated in Senator Tillis' continued Roundtable Talks on Section 101 Reform, and attended a Senate conference on Digital Copyright Act of 2021. The LAC, together with the Corporate, IP Transactions, Legislative Action, Patent Law & Practice, Patent Litigation and PTAB Committees, collaborated and prepared comments that were submitted to the USPTO in response to a request for comments on the current (September 2021) state of patent eligibility jurisprudence in the United States, and how the current jurisprudence has impacted investment and innovation, particularly in critical technologies like quantum computing, artificial intelligence, precision medicine, diagnostic methods, and pharmaceutical treatments. The USPTO sought comments to prepare a report on its findings to the U.S. Senate, at the behest of Senators Tillis, Hirono, Cotton and Coons. Through the LAC, the NYIPLA has been active in supporting the Daniel A. Clive Judicial Security Act, and signed on to a statement prepared by IPO and AIPLA in opposition to the TRIPS Waiver Compromise that was negotiated with respect to suspending certain IP rights concerning COVID 19. We also circulated a White Paper prepared on pending legislation concerning pay for delay settlements of Hatch-Waxman patent litigation.

For all that happened last year, I give special thanks to Feikje Van Rein and her team at RRR Associations. We are grateful for your guidance, patience, experience and execution with respect to planning, organizing, managing and executing our NYIPLA events, from the smallest committee meeting, to the monthly Board meetings, to the entirety of the Judges' Dinner. Your assistance is critical to helping NYIPLA achieve its core mission: to maintain the honor and dignity of intellectual property law, including patents, trademarks, copyrights and trade secrets; to promote the development and administration thereof; to advance the education of the members of the bar and the public in that field of law. It has been a pleasure to work with you.

Some parting comments. The NYIPLA as an organization has survived its 100th year anniversary, and I'm pleased to report it is and remains strong. During the pandemic, like most organizations, we've had some ebbs and flows in membership, engagement, and event revenues (which fund our CLE programming and other activities). But our Officers, Board, and committee leadership, and yes, our members, hung in there, overcoming zoom fatigue to maintain our excellent programming and CLE opportunities, and our networking and camaraderie. Indeed, we experienced a 17% increase in membership last year, which I'll attribute to the value our members see in participating in NYIPLA. It reflects, I believe, that those NYIPLA members who invested in the Association and did the hard work, and found that in giving back one gets back, too. I'm honored to have been entrusted with leading this terrific organization this past year (something I can assure you I never imagined when I first joined NYIPLA in 1982), I appreciate the support and counsel I've received (too many to thank by name), and look forward to NYIPLA's continued success for the next 100 years, beginning with Heather's stewardship and continuing with all the great things to come.



**ANNUAL MEETING**  
**MAY 19, 2022**  
**UNION LEAGUE CLUB**

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On May 19, 2022, incoming Association President Heather M. Schneider welcomed members and guests at the Union League Club. Heather expressed her appreciation for outgoing president, Robert M. Isackson.



5:00 PM - 6:00 PM

**ANNUAL MEETING OF MEMBERS**

6:00 PM - 6:30 PM

**BOARD MEETING**

6:00 PM - 9:00 PM

**COCKTAIL RECEPTION AND DINNER**

**Awards Dinner Program**

**WELCOME NYIPLA INCOMING PRESIDENT**

**Heather M. Schneider**

**KEYNOTE SPEAKER**

**Honorable Maryellen Noreika**

*United States District Court,  
District of Delaware*

**2022 INVENTOR OF THE YEAR AWARD**

**Dr. Steven Carlson**

*Recognized for his dedication to pioneering safer separators using carbon material for lithium-ion batteries.*

**2022 HON. WILLIAM C. CONNER WRITING COMPETITION AWARDS**

**Sean Boren & Michaela Morrissey**

**HON. GILES S. RICH DIVERSITY SCHOLARSHIP**

**Kevin Liu**





2022 Annual Meeting



# AWARD RECIPIENTS AT THE 2022 ANNUAL MEETING

## Inventor of the Year Award



### DR. STEVEN CARLSON

Recognized for his dedication to pioneering safer separators using carbon material for lithium-ion batteries. His contributions lead to a reduced rate of hazardous conditions when implementing batteries into commonly used devices.

## 2022 Hon. William C. Conner Writing Competition



### FIRST PLACE WINNER SEAN BOREN

From St. John's University School Of Law, for his paper entitled *Going For Gold and Protecting It Too: Intellectual Property And The Olympic Games*



### SECOND PLACE WINNER MICHAELA MORRISSEY

From University Of Richmond School Of Law, for her paper entitled *A Music Industry Circuit Split: The De Minimis Exception in Digital Samplings*

## 2022 Hon. Giles S. Rich Diversity Scholarship Award



### KEVIN LIU

Hon. Giles S. Rich Diversity Scholarship is awarded to Kevin Liu, a second year law student at Cornell Law School. Prior to law school, he graduated from the University of Toronto with an Hon. B.Sc. in biochemistry before pursuing research full-time. He served as Vice-President of the Asian Pacific American Law Students Association and the School's LGBTQ+ law students association, OutLaw. Kevin has also served as 2L Representative of the Intellectual Property and Technology Students Association and the Data, Privacy, and Cyber Law Society.

## 2022 NYIPLEF Diversity Scholarship



### LYDIA GRAHAM

NYIPLEF Diversity Scholarship is awarded to Lydia Graham, a first year law student at New York University School of Law. As a native New Yorker, Lydia's passion for media and the arts is rooted in her Jamaican culture and diverse communities. Before law school, Lydia was an entertainment paralegal at Frankfurt, Kurnit, Klein, and Selz P.C., where she worked on film financing, production, and development projects, including equity and mezzanine financings. Ultimately, her paralegal work, together with her work as an SEO Fellow at Paul, Weiss, confirmed her desire to work in Entertainment and Intellectual Property. Consequently, Lydia looks forward to continuing to pay it forward to her local communities by furthering her passion and supporting creators.

# 2021 - 2022 COMMITTEE REPORTS

## AMICUS BRIEF

**SCOPE OF THE COMMITTEE:** To coordinate the activities of the Association relating to the preparation and submission of amicus briefs, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Irena Royzman, Mark Chapman, and Jeffrey Coleman

**BOARD LIAISON:** David Goldberg

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

Since the last Annual Meeting on May 18, 2021, Amicus Briefs Committee members participated in the preparation and filing of briefs before the United States Supreme Court. The Committee filed a brief on the merits in support of the Respondent in *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, regarding whether lack of factual or legal knowledge can excuse an inaccuracy in a copyright registration under 17 U.S.C. § 411(b)(1)(A)'s safe harbor. The Committee also filed a brief on the merits in support of neither party in *The Andy Warhol Foundation for the Visual Arts, Inc. v. Lynn Goldsmith and Lynn Goldsmith Ltd.*, regarding whether a work of art is “transformative” when it conveys a different meaning or message from its source material, or whether a court is forbidden from considering the meaning of the accused work where it “recognizably derives from” its source material.

The Committee has 21 official members, but additional members of the Association and other committees have participated in our monthly meetings over the past year. Twelve Association members contributed as authors on the amicus briefs discussed above.

During the past year, the Supreme Court ruled on two cases in which the Committee filed briefs at the merits stage, namely *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.* (the Supreme Court found that an inadvertent mistake of fact or law in a copyright registration applicant's application does not render the application (and the corresponding registration) invalid), and *American Axle & Manufacturing, Inv. v. Neapco Holdings LLC* (the Supreme Court denied the petition for certiorari over a year after the Committee filed a brief in support of petitioner seeking the Court's guidance regarding the proper standards for evaluating patent eligibility under Section 101 of the Patent Act). The Committee also filed a brief in *Ericsson, Inc., Telefonaktiebolaget LM Ericsson, v. Samsung Electronics Co., LTD., Samsung Electronics America, Inc., Samsung Research America* (regarding issues of comity concerning standard essential patents subject to fair, reasonable, and non-discriminatory license terms in the United States and China), but the case settled before the Court of Appeals for the Federal Circuit issued an opinion on the merits.

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

## COPYRIGHT LAW & PRACTICE

**SCOPE OF THE COMMITTEE:** To consider all aspects of United States, foreign and multi-national copyright law and practice, and to make recommendations with respect thereto to the Board of Directors..

**CO-CHAIRS:** Mitchell Stein and Joshua Weigensberg

**BOARD LIAISON:** Scott Greenberg

The 2021-2022 NYIPLA Copyright Law and Practice Committee is comprised of attorneys and law students sharing the common goals of advancing dialogue on emerging issues in copyright law, supporting the various copyright-related initiatives of the NYIPLA and its other committees, and building a community of copyright attorneys through regularly scheduled meetings. Throughout the year, the Committee has convened for monthly videoconferences featuring presentations on notable copyright decisions, proposed rulemakings and legislation, administrative developments, and other notable issues and events in the field of copyright law.

As part of the Committee's efforts to engage actively in public discourse concerning important copyright-related issues, the Committee accomplished the following in the past year. Working with the Amicus Brief Committee, the Committee prepared and filed two amicus briefs with the United States Supreme Court, one in *Unicolors H&M Hennes & Mauritz, et al.*, and the second in the blockbuster copyright fair use case, *Warhol Foundation v. Goldsmith*. The Committee also continued working on podcasts, including one on the intersection between NFTs and Copyright law, and participated in the NYIPLA Hot Topics in Trademark & Copyright Law program held on July 13, 2022. The Committee also continues to monitor and discuss the recent launch and progress of the Copyright Claims Board.

## CORPORATE

**SCOPE OF THE COMMITTEE:** To consider intellectual property issues having an impact on in-house intellectual property counsel, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Michele Antis and Steven Purdy

**BOARD LIAISON:** Colman Ragan

## FASHION LAW

**SCOPE OF THE COMMITTEE:** To consider established and developing intellectual property issues specific to the fashion industry and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Karla Ng-Aspiras and C. Laure Sawaya

**BOARD LIAISON:** Cheryl Wang

## HON. WILLIAM C. CONNER WRITING COMPETITION

**SCOPE OF THE COMMITTEE:** To publicize and conduct a law school writing competition on intellectual property law topics, and to make recommendations to the Board of Directors with respect thereto.

**CO-CHAIRS:** Richard Brown and Timothy Caine

**BOARD LIAISON:** Jenny Lee

**MEMBERS:** Stephen Ankrom, William Valet, Palak Sharma, Matthew Abbott, Steve Fairchild, Andrew Cochran, Lauren Hamill

The Committee solicited and reviewed entries for the William C. Conner Writing Competition. The announcement of the competition was posted on the NYIPLA website in September 2021. The NYIPLA admin team sent targeted updates to professors at a number of law schools, law journals and student organizations to ask that the writing competition announcement be posted to ensure the students were aware of the opportunity.

The Committee received 26 submissions in for the 2021-22 competition, a decrease of three over the previous year when the contest deadline was extended. From those submissions, the Committee made recommendations, and the NYIPLA Board selected the following papers as the first and second place submissions:

1. Winner: *Going for Gold and Protecting It Too: Intellectual Property and Olympic Games* by Sean Boren
2. Runner-up: *A Music Industry Circuit Split: The De Minimis Exception in Digital Sampling* by Michaela Morrissey

The Committee notified the winner and runner-up, and the NYIPLA followed up with the authors for a presentation at the May 19 annual meeting and dinner.

## INVENTOR OF THE YEAR (IOTY) AWARD

**SCOPE OF THE COMMITTEE:** To consider intellectual property issues having an impact on in-house intellectual property counsel, and to make recommendations with respect thereto to the Board of Directors.

**CHAIR:** Christopher Lisiewski and Ksenia Takhistova

**BOARD LIAISON:** Paul Bonder

## IP TRANSACTIONS

**SCOPE OF THE COMMITTEE:** To consider issues and agreements that IP practitioners frequently encounter in connection with intellectual property and technology licensing, development, ownership, and sale including in M&A transactions, and to make recommendations to the Board of Directors regarding emerging issues and educational topics related thereto.

**CHAIR:** Andrew Chein and Christopher Loh

**BOARD LIAISON:** Jonathan Berschadsky

In 2021, the IP Transactions Committee conducted periodic conference calls, and assisted in the preparation of the IP Transactions Bootcamp. This was a well-attended event spread out over five days between October and November 2021, and featured a number of prominent in-house speakers. In April 2022, the Committee also organized and hosted a CLE event titled “The Intersection of NFTs and Transactional IP”. The CLE event took place on April 12, 2022 and featured speakers Robert deBrauwere, Partner of Pryor Cashman, Joshua Kaufman, Partner of Venable, Marty Schwimmer, Partner of Leason Ellis and Penny Williams, Vice President, Associate General Counsel of Sotheby’s. The Moderator was Hilary McDonnell, Associate of Hughes Hubbard & Reed. The CLE event was well attended and discussed emerging issues and current case law around Non-Fungible Tokens (NFTs).

Members of the Committee participate in periodic committee meetings and discuss IP transaction-related topics that are of interest, as well as solicit ideas for future meetings. Going forward, the Committee plans to continue having committee meetings, explore the possibility of future webinars, participation in CLE panels and organize in-person meetings.

## LAW FIRM MANAGEMENT

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

**CO-CHAIRS:** Mark Bloomberg and Keith McWha

**BOARD LIAISON:** Paul Bonder

## LEGISLATIVE ACTION

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

**CO-CHAIRS:** Anthony Lo Cicero and Jeanna Wacker

**BOARD LIAISON:** Robert Isackson

As it has since its inception, the Committee continues to monitor proposed and pending legislation of interest to Association members and the intellectual property committee in general. We advance this mission by communicating with Members of Congress and their staffs, producing white papers and other documents, and contributing to Association programs.

This past year, we continued to support efforts to enhance judicial security in general and passage of the Daniel A. Clive Judicial Security and Privacy Act in particular. We have also continued to monitor developments relating to life sciences-related intellectual property, including proposed legislation and the WHO COVID-19 patent policies as well as ongoing efforts in the fields of patent eligibility, PTAB reform and attempts to improve the America Invents Act.

In the coming year, the Committee expects to focus on legislation proposed by Senator Tillis relating to patent eligibility, legislation introduced by Senators Leahy and Tillis regarding quality and other relevant proposals. We will also begin a series of fireside chats and will assist the Board with the Presidents' Forum and other programs.

## MEDIA

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

**CHAIR:** Brian Doyle

**BOARD LIAISON:** Gene Lee

## PATENT LAW & PRACTICE

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

**CO-CHAIRS:** Joy Gaudie and Clint Mehall

**BOARD LIAISON:** Jonathan Berschadsky

## PATENT LITIGATION

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

**CO-CHAIRS:** Brett Cooper and Leslie Spencer

**BOARD LIAISON:** Christopher Loh

**MEMBERS:** Abby Parsons, Alan Bornstein, Alex Chachkes, Anthony Giaccio, Brian Doyle, Brian Siff, Bruce Haas, Chi Eng, Corey Tam, Daniel Huttler, Derrick Carman, Drew B. Hollander, Gonzalo Merino, Heather Schneider, Iyah Chen, James Higgins, Jennifer Cieluch, John Kenneth Felter, Jonathan Caplan, Jonathan Yim, Kenneth Adamo, Lauren Kim, Laurie Stempler, Matthew Langer, Maya Bourgeois, Melanie Sharp, Melvin Garner, Micah Rappazzo, Michael Rader, Mitchell Epner, Quintin Cassady, Ryan Singer, Seth Hasenour, Stephen Latuso, Steven J. Rizzi, Stuart Pollack, Taskeen Aman, Youngik Moon

The Patent Litigation Committee enjoyed an active and successful 2021-2022 committee season. We held teleconference meetings during many months of the year, which provided for discussion among the members of relevant and timely issues. These discussions focused on legal issues directly concerning the practice of patent litigation.

On February 10, 2022, the Committee together with the Women in IP Law Committee jointly sponsored the annual Biologics and Biosimilars program. The program was well attended and resulted in a lively discussion of current issues. We want to again thank all the panelists – Andrew Allen, Dr. Reddy’s Laboratories; Rachel Moodie, Fresenius Kabi; Abby Struthers, Sandoz; Alexandra Valenti, Goodwin; and Lauren Fornarotto, McKool Smith – and, of course, the participants.

The Committee also wanted to express special appreciation to both Dan Bagatell, Perkins Coie, for his discussion of court analytics and to Karen Keller, Shaw Keller, for her presentation of Delaware updates to the Committee during a couple of our monthly meetings.

It was great to see many of the Committee members at the 100th Annual Dinner on March 25, 2022, and we will look forward to another successful year.

## PRIVACY, BIG DATA & CYBERSECURITY

**SCOPE OF THE COMMITTEE:** To consider all aspects of internet and privacy law in the United States, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Jessica Copeland and David Leichtman

**BOARD LIAISON:** Diana Santos

## PROGRAMS

**SCOPE OF THE COMMITTEE:** To formulate and present a series of monthly continuing legal education programs of interest to the broad spectrum of the Association's membership, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** T. David Bomzer and Lynn Russo

**BOARD LIAISON:** Heather Schneider

## PTAB

**SCOPE OF THE COMMITTEE:** To provide thought leadership in legislation, rules and litigation relating to post-issuance proceedings before the Patent Trial and Appeals Board ("PTAB"), and to make recommendations to the Board. Also to provide lectures and information on latest trends and practice pointers for practice before the PTAB and appeals from PTAB decisions.

**CO-CHAIRS:** Kenneth R. Adamo and Charles R. Macedo

**BOARD LIAISON:** Robert J. Rando

**COMMITTEE COORDINATOR:** Christopher Lisiewski

In 2018, the Association established the Patent Trial and Appeals Board ("PTAB") Committee to provide thought leadership regarding legislation, rules, and litigation practice with respect to post-issuance proceedings before the PTAB, and to make recommendations to the Board in connection therewith. Since then, the PTAB Committee has consistently attracted over 30 members (including counsel working in-house and attorneys in private practice) each year and has been active both in developing a forum where practitioners can discuss legal developments affecting post-issuance proceedings, and in providing practical recommendations to improve PTAB practice by submitting comments on U.S. Patent & Trademark Office ("USPTO") proposed revisions to PTAB rules.

In 2020, the pandemic reshaped the way lawyers and legal professionals function and communicate on a daily basis. Adapting to this changing landscape, the PTAB Committee began hosting interactive Zoom Video Conference CLE webinars the first Tuesday of each month to discuss new developments in PTAB practice at the USPTO, recent case findings and PTAB proceedings, and other relevant interesting information related to PTAB practice at the USPTO. Over the past year, the PTAB Committee continued the monthly interactive Zoom Video Conference CLE webinars the first Tuesday of each month. During these interactive webinars, the PTAB Committee has been thrilled to be joined by numerous distinguished members of the USPTO, including Vice Chief Judges, PTAB Administrative Patent Judges, and PTAB Attorneys. In addition, the PTAB Committee again also partnered with the Young Lawyers Committee of the Association to reach and educate a wider audience and provide the Association's younger practitioners with the ability to speak on PTAB practice at the USPTO. The PTAB Committee's activities continue to ensure that the intellectual property community actively debates important issues affecting PTAB practice, and that the intellectual property community's voice is heard by the USPTO in their deliberations on PTAB-related issues. The PTAB Committee will continue its commitment to represent the Association's interests at the PTAB in the year to come.

## **PUBLICATIONS**

**SCOPE OF THE COMMITTEE:** To prepare, edit, publish and disseminate such publications as may be requested by the Board of Directors, and to make recommendations to the Board of Directors.

**CO-CHAIRS:** Giselle Ayala, Kyle Koemm and Margaret Welsh

**BOARD LIAISON:** Patrice Jean

Currently, the NYIPLA Publications Committee is lead by three co-chair members, Margaret Welsh, Giselle Ayala and Kyle Koemm. The Committee has published two issues in 2022, the Winter Issue and the Spring Issue.

As part of our continuous mission to bring to the NYIPLA useful, interesting and cutting edge information regarding intellectual property law we have been working with the different committee to provide a content that is both diverse and practical.

The Winter Issue was focused on the challenges that the legal community faces in times post-covid and post-election. The publication focused also on trademark law, recent cases and new upcoming litigation. Our then NYIPLA president, Robert Jackson highlighted that important role of the legislative in promoting innovation, special in the areas of public policies directed to protect IP in the health industry, which has the potential to affect IP legal practitioners.

The Spring Issue was the first for our new NYIPLA president Heather Schneider. Our new president gave her remarks about the Judge's Dinner, where we had the opportunity to meet again in person with colleagues and old friend and expressed NYIPLA's interest focusing this year on legal issue related to IP in Life Sciences. The Spring issues was especially diverse in content, our members wrote about the Olympics and the debate around the "Olympic" trademarks, the split between federal Circuit courts regarding sampling and copyright infringement and the ongoing litigation between the Andy Warhol Foundation and Lynn Goldsmith.

Now, the committee is in the process of putting the together the Summer Issue, we will bring to our members new and interesting content.

## **SIPO OF CHINA / US BAR LIAISON COUNCIL**

**DELEGATES:** Wansheng Liu and Brian Rothery

## TRADE SECRETS

**SCOPE OF THE COMMITTEE:** To consider all aspects of internet and privacy law in the United States, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Laura Chubb and Mark Schildkraut

**BOARD LIAISON:** John Mancini

The trade secret committee continues to be an active and engaging committee. We conduct monthly meetings (with two in-person lunches) where we discuss the latest happenings in trade secret law, as well as related topics of interest like professional development matters.

This fall we participated in NYIPLA's Fall One-Day CLE. Our panel provided a view on "How Not to Destroy Your Trade Secret" which covered twenty considerations for preserving your clients' trade secrets. The considerations covered five general areas: (I) The Basics, (II) The Workplace, (III) Some Unique Circumstances, (IV) Agreements, and (V) Litigation. We had panelists from both in-house and private practice.

We look forward to our continued participation in NYIPLA CLE events, hosting speakers on trade secret relevant topics, updating our members on new developments in both US and foreign trade secret topics, and collaborating with other committees in meaningful ways in the future.

## TRADEMARK LAW & PRACTICE

**SCOPE OF THE COMMITTEE:** To consider all aspects of trademark law and practice, and to make recommendations with respect thereto to the Board of Directors.

**CO-CHAIRS:** Deirdre Clarke and Lauren Emerson

**BOARD LIAISON:** Scott Greenberg

The Trademark Law & Practice Committee has approximately 12 active members who are attorneys in private practice and in-house as well as law students. Members participate in monthly calls where we discuss emerging issues in trademark law and recent noteworthy decisions at the Trademark Trial and Appeal Board as well as the federal courts.

This past term, the committee has been engaged in a number of activities on behalf of NYIPLA. Most notable, the committee drafted comments for the board's consideration and submission to the USPTO on proposed changes in relation to the Trademark Modernization Act of 2020. We also had the pleasure of collaborating with the IP Transactions Committee to put on a webinar regarding NFTs. Further, committee member Jim Bikoff, represented NYIPLA at the Shop Safe Act roundtable. Moreover, to have some live engagement in light of loosening of Covid protocols, members met for a happy hour. Last but not least, the committee put on its annual half-day CLE, *Hot Topics in Copyright & Trademark Law*, which was held at the New York office of King & Spalding LLP. The program kicked off with an update on the TTAB followed by a thought-provoking panel discussion on NFTs and IP, a stimulating presentation on *Combating Misrepresentations in Trademark Prosecution and Maintenance*, an update from the Copyright Office and finally, a presentation on understanding sanctions as it relates to IP in Russia.

## **US BAR – EUROPEAN PATENT OFFICE LIAISON COUNCIL**

**DELEGATES:** Laura Brutman and Thomas Spath

## **US BAR – JAPAN PATENT OFFICE COUNCIL**

**DELEGATES:** Raymond Farrell and John Pegram

### **WOMEN IN IP LAW**

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

**CO-CHAIRS:** Alexandra Awai and Linnea Cipriano

**BOARD LIAISON:** Abigail Langsam

### **YOUNG LAWYERS**

**SCOPE OF THE COMMITTEE:** To address the concerns and needs of minorities, women and newly-admitted lawyers, and to report with respect thereto to the Board of Directors

**CO-CHAIRS:** Margaret Mortimer, Jennifer Deneault, and Jasmine De Cock

**BOARD LIAISON:** Marc Pensabene

This year the Young Lawyers Committee successfully organized a virtual panel with the NYIPLA Women's Committee and an in-person panel follow by a cocktail reception. The subject of the virtual panel was on "Insights from Trailblazing Women Inventors". Panelists discussed the growing women's health and wellness industry, start-up client management, and unique IP and financial considerations for businesses in women's health. The subject of the in-person panel at the NY law office of Dechert LLP was "IP Crimes and U.S. Innovation." Panelists discussed the rise and trends of IP crimes, as well as its impact on R&D and future implications. The Young Lawyers Committee also continued its tradition of networking over happy hours with a Fall in-person gathering to bring old and new members together.

**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**  
**STATEMENTS OF FINANCIAL POSITION**  
**APRIL 30, 2022 AND 2021**

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	<u>2022</u>	<u>2021</u>
<b>ASSETS:</b>		
Cash and cash equivalents	\$ 1,057,016	\$ 927,700
Accounts receivable	-	21,500
Prepaid expenses	26,000	154,031
	<hr/>	<hr/>
TOTAL ASSETS	<u>\$ 1,083,016</u>	<u>\$ 1,103,231</u>
<b>LIABILITIES AND NET ASSETS:</b>		
Accounts payable and accrued expenses	\$ 83,977	\$ 32,387
Deferred revenue	75,090	11,544
	<hr/>	<hr/>
TOTAL LIABILITIES	<u>159,067</u>	<u>43,931</u>
<b>NET ASSETS:</b>		
Without donor restrictions	<u>923,949</u>	<u>1,059,300</u>
	<hr/>	<hr/>
TOTAL NET ASSETS	<u>923,949</u>	<u>1,059,300</u>
	<hr/>	<hr/>
TOTAL LIABILITIES AND NET ASSETS	<u>\$ 1,083,016</u>	<u>\$ 1,103,231</u>

**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**  
**STATEMENTS OF ACTIVITIES**  
**FOR THE YEARS ENDED APRIL 30, 2022 AND 2021**

	<b>Without Donor Restrictions</b>	
	<b>2022</b>	<b>2021</b>
OPERATING ACTIVITIES:		
<b>REVENUE AND OTHER SUPPORT:</b>		
Continued Legal Education (CLE)	\$ 18,138	\$ 16,282
Membership dues	136,200	134,606
Other programs and events	920	10,451
Special events	670,667	189,200
Less: direct costs	(426,953)	(68,037)
Special events, net	<u>243,714</u>	<u>121,163</u>
Interest income	<u>189</u>	<u>562</u>
<b>TOTAL REVENUE AND OTHER SUPPORT</b>	<u>399,161</u>	<u>283,064</u>
<b>EXPENSES:</b>		
PROGRAM SERVICES:		
Member services	<u>68,764</u>	<u>85,027</u>
<b>TOTAL PROGRAM SERVICES</b>	<u>68,764</u>	<u>85,027</u>
SUPPORTING SERVICES:		
Management and general	<u>465,748</u>	<u>455,992</u>
<b>TOTAL EXPENSES</b>	<u>534,512</u>	<u>541,019</u>
<b>CHANGE IN NET ASSETS FROM OPERATING ACTIVITIES</b>	(135,351)	(257,955)
<b>NET ASSETS:</b>		
Beginning of year	<u>1,059,300</u>	<u>1,317,255</u>
End of year	<u>\$ 923,949</u>	<u>\$ 1,059,300</u>

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

## *Friday, March 25, 2022*

The New York Intellectual Property Law Association held its 100<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary on March 25, 2022, at the New York Hilton Midtown Hotel. President Robert Isackson welcomed the honored guests, members of the NYIPLA, and their guests. The Association's Twentieth Annual Outstanding Public Service Award was presented to the Honorable Leonard P. Stark, Circuit Judge for the United States Court of Appeals for the Federal Circuit. The Keynote address was given by Michael Rogers, Futurist in Residence for The New York Times.









# EVENTS

## Insights on Ethics Issues at the USPTO

May 4, 2021

During the May 4 meeting of the of the PTAB Committee of the New York Intellectual Property Law Association (NYIPLA), a distinguished group of USPTO officials, including Lead Administrative Patent Judge Amanda Wieker, from the PTAB and Kimberly Weinreich and Steven Fulk, from the USPTO returned for a special ethics presentation on patent bar admission at the USPTO, pro hac vice admission before the PTAB and the Legal Experience and Advancement Program (LEAP) at the PTAB.

The presentation included:

- USPTO Patent Bar Admission - led by Kimberly Weinreich, Attorney at the Office of the Enrollment and Discipline
- Pro Hac Vice Admission before PTAB - led by Steven Fulk, Patent Attorney, PTAB; and
- Legal Experience and Advancement Program (LEAP) - led by Judge Amanda Wieker, Administrative Patent Judge

## Creating Value from IP Assets: Legal Finance Perspectives

May 5, 2021

This round table discussed the use of third-party financing to unlock monetization potential from innovation. Our panel of industry leaders and practitioners dived into recent trends in financing, including applications to corporate portfolio management and transactional matters, and use of legal finance as a business development tool for prospective clients. They also devoted some discussion to value creation in the Life Science patent litigation and transactional practices.

## NYIPLEF Virtual Bingo Night!

May 12, 2021

On May 12, 2021, the NYIPLEF and Princeton Club of New York invited NYIPLA members to a Virtual Bingo Night! There was an evening of friendly competition as they played 4 rounds of Bingo, hosted by Chef Michael Bourquin (he put down his paring knife and picked up the emcee mic for this one). The winner of each round received a prize!

## NYIPLA Annual Meeting & Presidents' Forum To Waive or Not to Waive, Is that Really the Question? COVID-19 Waivers in the Global Community

May 18, 2021

On October 2, 2020, WTO members from India and South Africa proposed a “Waiver from Certain Provisions of the TRIPS Agreement for the Prevention, Containment and Treatment of COVID-19.”

The proposal notes that COVID-19 is a global health emergency and that is imperative for WTO Members to ensure that IP rights “do not create barriers” to medical products such as vaccines and medicines, as well as other medical products, and points to reports about IP rights “hindering or potentially hindering timely provisioning of affordable medical products to the patients.” The proposal suggests a waiver of enforcement of sections of the TRIPS Agreement “in relation to the prevention, containment, or treatment of COVID-19.”

# EVENTS

The result has been a firestorm between developed countries and developing nations. Many have weighed in on both sides of the issue. For example, the NYIPLA joined the IPO, AIPLA, and LES organizations in a letter to U.S. Trade Representative Katherine Tai dated March 30, 2021.

The letter supports the equitable distribution of “vaccines, medicines, diagnostics... and other measures” to address COVID-19, but notes the lack of “data to suggest that patents and other IP rights are hindering vaccine development or delivery.” The letter points to examples of innovator companies “partner[ing] and shar[ing] IP to create tools to address this pandemic” and urges the U.S. to oppose the TRIPS waiver proposal, warning that an IP framework is necessary to mitigate risk and provide confidence.

This discussion included participants on both sides of the issue. They discussed whether IP protections are necessary guardrails protecting the quality and sharing of pandemic resources, or unnecessary hindrances that are costing human lives.

## Explore PTAB Successes, Outcomes and Results with Docket Navigator

June 1, 2021

On June 1, 2021, the New York Intellectual Property Law Association (NYIPLA)’s PTAB Committee reviewed the PTAB statistics provided by Docket Navigator.

In this interactive presentation, co-chairs Charley Macedo and Ken Adamo along with coordinator Chris Lisiewski and other members explored PTAB statistics provided by Docket Navigator, including:

- Yearly analysis of PTAB petitions filed
- Outcomes and determinations at the institution and final written decision
- Motion Practice at the PTAB
- Review by the Federal Circuit
- Review by the Supreme Court

Amy Towell from Docket Navigator was available to answer questions on how to customize their data for your specific requests.

## SolarWinds – Pandora’s Box of Cybersecurity and Data Risks

June 15, 2021

In December 2020, SolarWinds Inc., a US company that builds products for IT management disclosed that its product Orion, with thousands of private and public sector customers, had been exploited to share malware. The cyberattack has been characterized as the largest and most sophisticated attack ever and having taken thousands of engineers to create. The risk of the SolarWinds attack comes not only from the direct use of Orion, but the indirect use of Orion through vendors and supply chain. This panel discussed the practical implications of the SolarWinds attack, including the effects that the attack have had on the allocation of risk between IT product providers and their customers and the stakes at issue at the negotiation table.

# EVENTS

## **PTAB and Young Lawyers Committees Key Milestones in IPR, PGR, and CBM Proceedings**

July 6, 2021

On July 6, 2021, the New York Intellectual Property Law Association (NYIPLA) PTAB and Young Lawyers Committees examined Patent Trial and Appeal Board (PTAB) Trial Milestones.

In this interactive presentation, PTAB Committee co-chair Charley Macedo, coordinator Chris Lisiewski, and other members of the PTAB Committee along with Young Lawyers Committee co-chair Jenna Deneault provided a refresher on key milestones in post-grant patentability challenges at the PTAB under the Leahy-Smith America Invents Act (AIA).

They reviewed typical timelines and procedures at key milestones in inter partes review (IPR), post-grant review (PGR) and covered business method (CBM) patentability challenges before the PTAB.

## **Annual Trademark & Copyright CLE Series**

July 13 - July 28, 2021

From July 13, 2021 to July 28, 2021, the NYIPLA Trademark Law & Practice and Copyright Law & Practice Committees hosted a virtual CLE series. Panel sessions included:

- Trademark Case Decisions: The Past Year in the Courts & at the TTAB
- Legislative Initiatives: Digital Copyright Act, CASE Act, SHOP SAFE Act, and INFORM Acts
- Punny and Functional: When a Play of Words Fails to Identify Source
- Google v. Oracle
- TTAB Update

## **PTAB & Young Lawyers Committees on Review of PTAB Final Decisions**

August 3, 2021

On August 3, 2021, the PTAB Committee and Young Lawyers Committee followed up on their previous webinar regarding Patent Trial and Appeal Board (PTAB) Trial Milestones and examined the new Director Review process after Arthrex and Appeals of Patent Trial and Board Final Written Decisions After Arthrex.

In this interactive presentation, the PTAB Committee and Young Lawyers Committee were joined by a group of distinguished members of the USPTO to share insights on the new Director Review process after Arthrex. PTAB Committee co-chair Charley Macedo, coordinator Chris Lisiewski, and other members of the PTAB Committee along with Young Lawyers Committee co-chair Jenna Deneault explained motion for reconsideration options, appeal options, and key milestones with appeal process along with the types of arguments that can be heard/not heard after the Supreme Court's recent decision in Arthrex.

# EVENTS

## Insights on Oral Hearings Before the PTAB

September 7, 2021

On September 7, 2021, the PTAB Committee discussed oral hearings before the PTAB.

In this interactive presentation, a distinguished group of USPTO officials, including Lead Judge Jessica Kaiser and Chief Clerk Erica Swift, shared insights on oral hearings before the PTAB with particular emphasis on new features available to the public, such as virtual hearings (rather than telephonic) for ex parte appeals.

## PTAB Committee to Examine Open and Unresolved Issues after the *Arthrex* Decision

October 10, 2021

On October 5, 2021, the PTAB Committee discussed open and unresolved issues after the Supreme Court's *Arthrex* decision.

In this interactive presentation, PTAB Committee co-chair Charley Macedo, co-chair Ken Adamo, and other members of the PTAB Committee discussed and explained open and unresolved appellate issues that still exist after the Supreme Court's June 21, 2021 decision in *U.S. v. Arthrex Inc.* Specifically, in its decision, the Supreme Court held that APJs are principal officers. However, the Supreme Court did not agree with the Federal Circuit's remedy and determined that final written decisions of APJs must be subject to review by the Director of the USPTO.

## IP Transactions Bootcamp

October 7 - November 4, 2021

The IP Transactions Bootcamp was a five-day bootcamp geared towards junior and mid-level associates. Attendees learned practical skills from experienced attorneys and in-house counsel. Attendees learned how to identify and navigate key issues in various types of agreements that touch upon IP, and engage in frequent mock negotiations. Topics included

- Introduction to Transactions
  - In-house day-in-the-life panel
  - Overview of standard responsibilities
  - IP and IP-related provisions, licensing and other agreements
  - Overview of types of IP issues in agreements
  - Negotiating postures of each party
  - Choice of law/ADR arbitration and steps
- Patents
  - Overview of ownership, assignment, & license issues
  - Control of generated IP
  - Managing investments/payments
  - Common agreement terms
  - Unique circumstances
  - Choice of law, choice of venue, & conflict resolution
  - Arbitration choices

# EVENTS

- Data-Tech Software Agreements
  - IP ownership
  - Scope of licenses
  - Defense and enforcement
  - Financial terms
  - Reps and warranties
  - Indemnification and insurance
  - Source code escrow
  - Assignment and change of control
  - Terminations and bankruptcy
  - Data rights and usage
- License Agreements - Copyright, Trademarks, and
  - Fundamentals of trademark & copyright rights
  - Matching the fundamentals with transaction goals
  - Quality control in a trademark license
  - Transfer of goodwill in a trademark assignment
  - Misunderstood concept of "Work for Hire" in copyright law
  - Bankruptcy-related provisions post-*Mission Products*
  - Negotiation exercises, putting topics into practice
- Mergers & Acquisitions & Due Diligence
  - Diligence Basics
  - Data Room Diligence
  - Non-Data Room Diligence
  - Substantive IP Analysis
  - Reviewing Deal Documents
  - Problem Solving
  - Ethics

## PTAB Committee to Examine Constitutionality Challenges After Arthrex and APJ Compensation

November 2, 2021

On November 2, 2021, the PTAB Committee discussed constitutionality challenges after *Arthrex* (as discussed in *Mobility Workx v. Unified Patents*) and APJ compensation.

The PTAB Committee was joined by Professor Timothy Hsieh, Assistant Professor of Law at the Oklahoma City University School of Law to the Federal Circuit's October 13, 2021 decision in *Mobility Workx, LLC v. Unified Patents, LLC*. Specifically, in its decision, the Federal Circuit examined several constitutionality challenges after *Arthrex*, including whether the Director's delegation of his/her responsibility to make final unreviewable institution decisions to the same APJ's who make the Final Written Decision violates the Administrative Procedures Act and/or the Due Process Clause of the Constitution. Professor Hsieh discussed the issue of APJ compensation and its ethical implications with our co-Chairs Charley Macedo and Ken Adamo, and board liaison Rob Rando.

# EVENTS

## Fall Patent CLE Series

November 9-18, 2021

From Tuesday, November 9, 2021 to Thursday, November 18, 2021, NYIPLA hosted a series of webinars that allowed attendees to explore the latest issues and trends in intellectual property. Panel topics included:

- Recent Litigation Trends from an In-House Counsel Perspective
- Fireside Chat with Chief Administrative Judge Boalick, PTAB, USPTO
- Foreign Updates on Patent Law
- Litigating Patents in the COVID Era: Updates from the Top District Courts for Patent Litigation
- Legislative Developments 2021: Pending & Proposed Legislation That Would Affect IP Rights
- Preparing an Amicus Brief Submission on Behalf of the NYIPLA
- How Not to Destroy Your Trade Secrets
- Artificial Intelligence and the USPTO

## Diversity Roundtable

December 2, 2021

On Thursday, December 2, 2021, NYIPLA featured distinguished speakers from in-house and private practice who discussed Career Transitions in IP & Strategies for Success for Diverse Lawyers in Tech. Attendees had an opportunity to join one of the small group discussions, each led by one of the speakers.

## PTAB Committee Tackles Congressional Bills Relating to PTAB Reform

December 7, 2021

On Tuesday, December 7, 2021, the PTAB Committee tackled a summary of the currently pending (and soon to be expected) bills in congress addressing potential reform of the PTAB, which includes:

- S.2891 (Restoring the American Invents Act),
- H.R. 5874 (Restoring America's Leadership in Innovation Act),
- H.R. 5902 (Conducting Legally Efficient Administration and Resolution of Patents) and
- the old S.2082 (Stronger Patents Act of 2019),

as well as the upcoming hearings on Kathi Vidal as next Director.

## Fireside Chat with Judge Michael Cygan on Ex Parte Appeals at the USPTO

December 17, 2021

On Friday, December 17, 2021, Patent Law & Practice Committee Co-chairs Clint Mehall and Joy Goudie had a Fireside Chat with PTAB Judge Michael Cygan on Ex Parte Appeals at the USPTO. Among other things, the Patent Law & Practice Committee discussed appeal vs. RCE strategy for patent applications, and the effectiveness of certain types of arguments before the PTAB on ex parte appeals.

# EVENTS

## **USPTO Returns to the NYIPLA PTAB Committee to Host PTAB Game Night to Kick Off the New Year**

January 4, 2022

On Tuesday, January 4, 2022, the NYIPLA PTAB Committee was joined by a distinguished group of USPTO officials, including Vice Chief Judge Kal Deshpande, Judge Amanda Weiker, and Judge Eric Jeschke, to host the PTAB Game Night. The distinguished panel of judges elaborated on each answer with a few learning points in categories covering precedential decisions, motions, and PTAB myths.

## **Zoom out with NYIPLA!**

January 13, 2022

Are you excited about achieving your goals in 2022? Do you need to refocus or recharge mentally? Are you just plain tired of networking over Zoom? Well, we can answer yes to all of these questions, but we promise that our networking event, which was held on Thursday, January 13, 2022, will leave you anything but tired of Zoom! This refreshing event allowed attendees to network with NYIPLA board members, law firm associates and law students right before Dr. MLK weekend. Additionally, attendees had access to a wide array of accomplished attorneys, many of whom were willing to share the tips and tricks to their success. Presented by the Associate Advisory Counsel: Eric Greenwald, Wolf, Greenfield & Sacks, Christine-Marie Lauture, Lauture IP and Khalil Nobles, Gunderson Dettmer.

## **Using Petitions Effectively in Patent Prosecution**

January 28, 2022

The NYIPLA was honored to have Fenn Matthew, Deputy Director of the USPTO Office of Petitions host a presentation on Friday, January 28, 2022. It provided attendees with a high level overview of the Office of Petitions, including electronic resources, a brief discussion of ePetitions, where to find relevant petitions related data and statistics, and petitions-related updates. The latter half of the presentation provided helpful tips concerning petitions practice.

## **PTAB Committee Explores Latest PTAB POP Panel Decision on Timing of Fedwire Transfer for Purposes of PTAB Proceedings**

February 1, 2022

On Tuesday, February 1, former PTAB APJ Brian Murphy, partner at Haug Partners LLC, discussed the most recent PTAB POP Panel Decision in *Toshiba America Electronic Components, Inc. v. Monument Peak Venture, LLC*, IPR 2021-00330, Paper No. 20 (PTAB Jan. 14, 2022).

In *Toshiba America*, the POP Panel addressed the question:

Does Fedwire confirmation of payment constitute sufficient evidence of payment under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a)?

In this Precedential Decision, the Panel concluded “a Fedwire confirmation of payment constitutes sufficient evidence of payment under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a).”

# EVENTS

## **Recent Developments in the Law of Biologics and Biosimilars**

February 10, 2022

On Thursday, February 10, the NYIPLA was joined by speakers Andrew Allen, Senior Director, Legal Counsel, Dr. Reddy's Laboratories, Rachel Moodie, Vice President, Head of Legal and Intellectual Property, Biosimilars, Fresenius, Abigail Struthers, Senior IP Litigation Counsel, Sandoz, Alexandra Valenti, Partner, Goodwin, and moderator Lauren Fornarotto, Principal, McKool Smith for our Biologics & Biosimilars program

## **Presidents' Forum: Intellectual Property Issues Associated with Name, Image & Likeness in the NCAA**

February 17, 2022

The NYIPLA held the Presidents' Forum on Thursday, February 17. This forum discussed the copyright, trademark, privacy, and other intellectual property issues raised by the recent decision of the NCAA to allow collegiate athletes to profit from the use of their name, image, and/or likeness without losing their amateur status.

- What do young athletes, their parents and guardians, and even agents need to know about intellectual property while negotiating with schools;
- How will this decision change IP considerations for video games and advertising;
- What are the IP implications of entering the “transfer portal”?

## **Seana Cranston, Congressman Massie's Deputy Chief of Staff and Legislative Director, Will Discuss the Introduction of H.R.5874 – Restoring America's Leadership in Innovation Act**

February 25, 2022

Representative Thomas Massie, holder of multiple patents, has introduced H.R.5874 – Restoring America's Leadership in Innovation Act. The Bill proposes repeal of First-to-File System, One-Year Grace Period, Inter Partes and Post-Grant Review, as well as, abolishing inter partes and post-grant review, and PTAB. Seana Cranston, Congressman Massie's Deputy Chief of Staff and Legislative Director, discussed H.R. 5874 during a meeting of the Patent Practice Group on Friday, February 25.

## **NYIPLA PTAB Committee to Discuss Scope of IPR Estoppel After California Institute v. Broadcom**

March 8, 2022

On Tuesday, March 8, the PTAB Committee explored the scope of IPR estoppel in view of California Institute of Technology v. Broadcom Ltd. (Fed. Cir. Feb. 4, 2022).

In this interactive presentation, former PTAB APJ Brian Murphy, Partner at Haug Partners LLC, PTAB Committee Co-Chairs Charley Macedo, Partner at Amster Rothstein & Ebenstein, and Ken Adamo, Law Offices of Kenneth R. Adamo, and Robert Rando, Partner, Greenspoon Marder LLP, lead a discussion on the implications of CalTech, after an explanation of the background and holding of CalTech. Specifically, in CalTech, the Federal Circuit overruled its prior precedent to clarify “that estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not in the IPR but which reasonably could have been included in the petition.”

# EVENTS

## Insights from Trailblazing Women Inventors

March 9, 2022

On Wednesday, March 9, the Young Lawyer's Committee and the Women in IP Law Committee co-hosted a panel of founders who are innovating in the Women's Health and Life Sciences sectors. Delphine O'Rourke, partner at Goodwin, moderated a discussion with panelists Dr. Meesha Dogan of CardioDiagnostics, Melanie Cristol of Lorals, and Amrita Saigal of Kudos.

These entrepreneurs discussed the growing momentum in the Women's Health sector and provided insights into their struggles and successes in managing IP.

## Patent Analytics and Automation

April 1, 2022

Patent Bots provided a demo of its legal tech tools that help patent attorneys be more efficient and obtain better outcomes for their clients. Their tools include:

- Prep & Pros Pro -- patent drafting automation and proofreading
- Art Unit Predictor -- steer your applications to a desired art unit before filing
- PatentPlex -- a one-stop shop for patent info including family trees and image file wrapper access
- Examiner Statistics -- examiner insights to obtain broader patents in less time

The demo was presented on Friday, April 1, by Jeff O'Neill, the founder of Patent Bots and a practicing patent attorney. Jeff O'Neill has been a patent attorney for about 16 years and his experience includes both in-house and law-firm roles. Prior to becoming a patent attorney, Jeff O'Neill completed a Ph.D. in signal processing, and Jeff is able to leverage his tech background to provide advanced processing of the language of patent applications.

## PTAB Committee Meeting: Arthrex Round II

April 5, 2022

Last year, the U.S. Supreme Court issued its decision in *U.S. v. Arthrex, Inc.*, 141 S.Ct. 1970 (2021), where it saved the PTAB by providing for Director Review. Thereafter, a slew of pending appeals results in remands to the Acting Director of the U.S. Patent and Trademark Office to conduct a review, if requested.

In the lead case, *U.S. v. Arthrex*, the prior decision of the Federal Circuit was vacated, proceedings were remanded for the Acting Director to conduct director review, and then the Acting Director summarily denied review. The appeal is now back in full swing, with another round of briefing directed to whether Acting Director/Commissioner Hirshfeld had the authority to act as a Principal Officer when he denied Arthrex's request for Director Review.

On March 30, 2022, the Federal Circuit will hear oral argument on this issue, and the PTAB Committee discussed it on Tuesday, April 5.

# EVENTS

## **Intellectual Property Crimes and U.S. Innovation**

April 5, 2022

On Tuesday, April 5, the NYIPLA had a round-table discussion about intellectual property crimes and the impact on research and innovation in the U.S. White-collar defense attorneys and intellectual property specialists discussed recent prosecutorial trends, the historical backdrop for intellectual property crimes, and how to balance overarching business and academic interests.

## **The Intersection of NFTs and Transactional IP**

April 12, 2022

Interest in non-fungible tokens, or “NFTs,” as vehicles for conducting IP-related transactions has exploded over the past year. While NFTs have been touted as offering the possibility of “frictionless” transactions, the sale and purchase of NFTs involves traditional IP rights subject to traditional legal IP principles, including copyright, trademark and rights of publicity. The clash between NFTs and traditional IP rights has been illustrated by recent high-profile lawsuits involving NFTs for virtual Birkin bags and Nike shoes.

On Tuesday, April 12, our speakers Penny Williams (Sotheby’s), Joshua Kaufman (Venable), Marty Schwimmer (Leason Ellis), and Robert deBrauwere (Pryor Cashman) discussed the intersection between NFTs and traditional IP principles, including what IP rights that may accompany the sale of NFTs, what transactional paperwork may be required to effectuate IP transfers associated with NFTs, what IP disputes may arise in connection with NFTs, and what strategies NFT buyers and sellers might use to insulated themselves from IP-related liability.

## **What You Need to Know About the EU Unitary Patent and Unified Patent Court**

April 26, 2022

Starting later this year, patent owners will be able to elect a “European patent with unitary effect” (Unitary Patent or UP) for at least 17 EU states at grant of a European patent application, instead of national patents. Simultaneously, a Unified Patent Court (UPC) will be established for those EU states. The UPC will handle all litigation for Unitary Patents and will have parallel jurisdiction with national courts for litigation involving conventional European patents, unless the patent owner opts-out of the UPC.

On Tuesday, April 26, program outlined the UP and UPC, their potential advantages and disadvantages for different types of patents, and the points of consideration that owners of existing and new European patents and applications should consider now.

## **Patent Public Search**

April 29, 2022

The new Patent Public Search tool launched on February 1, 2022 and is available on USPTO.gov. This new search tool is a convenient way to search three U.S. patent databases at once and has many features that new and regular patent searchers will appreciate. The new tool will replace legacy patent search tools PatFT, AppFT, PubEAST, and PubWEST as early as Q3 of FY2022 (estimated).

On Friday, April 29, Tom Turner and Sara Butts of the USPTO demonstrated new features and taught us how to use the new patent public search feature.



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