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## NYIPLA PRESIDENT'S CORNER

### HEATHER SCHNEIDER



During my last column I talked about how proud I am to be a part of the dynamic and close-knit NYIPLA community. That feeling was only strengthened when we had an amazing kick-off for all of the NYIPLA committees at the September Board meeting. Board members and committee chairs were invited to the Union League Club and presented their suggested CLE programs, social mixers, and articles for the upcoming year. Above all, it was just so good to see everyone in person again.

The Legislative Action Committee has been very busy analyzing some of the proposed patent law changes such as Senator Tillis's proposal on Section 101, as well as patent quality bills and issues related to drug pricing. Chris Israel at ACG keeps us informed and guides NYIPLA to identify legislation and other areas where we can provide useful information to decision makers. We also sent a letter to Chairman Nadler urging him to support H.R. 4436, the Daniel Aderl Judicial Security and Privacy Act. These and other topics will be addressed by the Legislative Action committee at our Fall One-Day Patent CLE Seminar on November 9, 2022, at my offices of Willkie Farr & Gallagher LLP.

The Amicus Briefs Committee presented an outstanding program on Hot Topics for Congress and the USPTO: 101 Patent Eligibility and PTAB Director Review on September 14. This hybrid program was well attended and the excellent speakers presented a lot of useful information. A special thanks to Kramer Levin for hosting this program and our well-esteemed speakers; Hon. Paul R. Michel, Former Chief Judge United States Court of Appeals for the Federal Circuit; Hon. Scott Howard, Acting Lead Judge, PTAB; Hon. Donna Praiss, Administrative Patent Judge, PTAB; David J. Kappos, Cravath, Swaine & Moore, Former Director of US Patent and Trademark Office, and moderators Irena Royzman, Kramer Levin Naftalis & Frankel and Robert Rando, Greenspoon Marder.

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The PTAB Committee continues its reputation for having well-attended and active committee meetings, including a USPTO Mock Ex Parte Appeal argument on October 4, 2022. They have been doing a great job advertising their events on social media with the NYIPLA administrative office, something we encourage more committees to do.

The Women in IP Law Committee has three enthusiastic new co-chairs, who have ideas for lots of great content and events this year, with a strong focus on women's issues and networking. The Young Lawyers Committee also continued its active streak, by having a lively Happy Hour with the Corporate Committee on September 21, 2022, at Penn 6.

The IP Transactions Committee is getting off to a strong start this year by hosting a panel at the One-Day Patent CLE on Hot Topics and Pitfalls When Negotiating Commercial Agreements, that will include in-house counsel from Marsh & McLennan Companies. The Trade Secrets Committee has also organized an excellent panel on "Reasonable Measures of Protection" for trade secrets, with speakers from Alix Partners, Ernst & Young, the U.S. Department of Justice, and Becton, Dickinson and Company.

The Trademark, Copyright, and Fashion Law Committees also have big plans for the year, including Happy Hours and other events. We are all pleased to welcome the new Sports Management & Media committee, chaired by Aliya Nelson at Greenspoon Marder. I don't want to steal her thunder, but suffice it to say she has some great ideas for events this year on topics we have not typically addressed at NYIPLA.

The Patent Litigation and the Patent Law and Practice Committees will also be active this year, with panels at the One-Day Patent CLE. The Patent Law and Legislative Action Committees will also be co-sponsoring an event on the Patent Eligibility Restoration Act of 2022 on October 28, 2022, which will include a presentation by Brad Watts, Minority Chief Counsel of the Senate Judiciary Committee Subcommittee on Intellectual Property. I encourage committees to collaborate on content with other committees like this.

We continue to have a number of committees that don't necessarily sponsor events, but do a lot of hard work growing the membership, reputation, and philanthropy of the NYIPLA. The CNIPA of China-US Bar, US Bar-EPO and US Bar-Japan Patent Office committees liaise with other countries on international issues. The Hon. Giles S. Rich Diversity Scholarship, Hon. William C. Conner Writing Competition, and the Inventor of the Year Award committees celebrate and reward innovation, scholarship, and diversity. The Media Committee and the Publications Committee of course prepare a lot of the materials you see, such as this. And, last but not least, the Programs Committee, chaired by Lynn Russo and David Bomzer, helps keep all of our programming running smoothly.

I encourage all of you to make sure you are registered as members of one or more committees by clicking [HERE](#).

Also be sure to follow the NYIPLA on LinkedIn and Twitter.



## Q&A with Mark Chapman and Irena Royzman Co-Chairs of NYIPLA's Amicus Brief Committee

**What is one issue that the Amicus Brief Committee is focusing on this year?**

**Irena:** There are many issues that we have our eye on this year. Obviousness-type double patenting, which comes up almost in every case, is one of the issues.

**Mark:** More generally the committee also continues to follow and focus on interesting and important appeals to the Supreme Court in all IP areas.

**Why did you pursue a career in intellectual property law?**

**Irena:** It is a dynamic area of the law that is a perfect mix with my biotech background.

**Mark:** I switched to patent litigation after a couple of years working as a transactional lawyer because I find litigation to be interesting and patent litigation even more so because it allows me to dig in to interesting technologies.

**Do you work with a particular type of intellectual property in your practice?**

**Irena:** Yes, I focus on litigation involving biotech and pharmaceutical patents.

**Mark:** My undergraduate degree is in engineering physics, so I typically represent technology, automotive and aerospace clients in patent litigations, IPRs and related appeals.

**What do you see as a current challenge facing intellectual property attorneys?**

**Irena:** The law is rapidly changing and COVID has changed how we practice law -- from collecting documents to working with witnesses to handling depositions, hearings and trial.

**Mark:** A current challenge is navigating and

adapting to the PTAB's evolving approach to discretionary IPR denials based on parallel patent litigation.

**Are there any recent or foreseen changes (in the law or market) that will have an impact on your practice?**

**Irena:** PTAB practice continues to evolve rapidly and impacts broader strategy for patent litigation. The law of written description and enablement is continuing to develop, particularly in the context of biotech inventions, and impacts my practice.

**Mark:** An important development over the last couple of years has been the dramatic shift of new patent cases being filed in Judge Albright's court in Waco, especially given his approach Markman, transfer motions, and stays.

**What is one thing you love to do other than work?**

**Irena:** I love to take walks in Central Park with my family.

**Mark:** I enjoy downhill skiing and playing tennis with my boys.

**What advice would you give to someone considering a career in intellectual property law?**

**Irena:** My advice is to engage with IP lawyers, to find out what they love about what they do, to take classes. That is how I became interested in patent law while a Ph.D. student at MIT.

**Mark:** For those who are considering patent litigation, make sure that you are interested not only in technology but also in the law, advocacy and litigation, because that is so much of what we do.



## **2022-2023 New Board Member: Q&A with Mark Schildkraut**

### **How long have you been a member of the NYIPLA?**

I have been a member of NYIPLA for ten years at two different times in my career: first, from 2000 to 2005, when I was a younger associate in private practice in New York; and, now, from 2017 to the present as in-house counsel, as Associate General Counsel at med tech Becton, Dickinson and Company in New Jersey and presently as Chief IP Counsel for consumer products company SharkNinja in Massachusetts. These experiences have allowed me to grow professionally by attending substantive programming and by meeting colleagues in my field of practice.

### **Why did you first join the Association?**

I originally joined NYIPLA as a way to network with colleagues in other IP practices. NYIPLA membership allowed me to meet attorneys from other firms, corporate legal departments, and even within the judiciary. (I attended a number of Judges Dinners over the years allowing me to dine with federal court judges.) Seeing the large number of IP professionals at the Judges Dinner each year helped me appreciate the depth of our profession, while seeing many of the same faces at different events has allowed me to develop contacts that I have to this day.

### **Has your membership in the Association benefited your practice and, if so, how?**

NYIPLA has allowed me to accelerate my development in areas that are rapidly changing and where I can gain insights by interacting with a variety of thought leaders. The NYIPLA's Trade Secret Committee, in particular, has been a perfect venue for this. Each month, over the past

several years, I meet with colleagues where we discuss trade secret developments, practice tips and caselaw. In addition, we have had guest speakers and sometimes we have discussions around the "edges" – whether around professional development generally or on cutting-edge topics like the role that non-fungible tokens (NFTs) play in IP.

### **With which committees have you been involved during your membership?**

The first NYIPLA committee I participated in was the Honorable William Conner Writing Competition Committee. I really enjoyed seeing what sort of issues law students were thinking about. They often fleshed out a cutting-edge issue in IP and I frequently found the topics to be interesting and thought-provoking. Over the past several years, I was co-founder and co-chair of the NYIPLA's Trade Secrets Committee.

### **How did you end up on the Board?**

I have had a close relationship with former NYIPLA Board Member John Moehringer. We attended Fordham Law School together, worked together at IP firm Morgan & Finnegan, and worked together on a variety of programs and committees here at NYIPLA. John was instrumental in the formation of the Trade Secrets Committee that I co-chaired since the committee's inception. We would talk a lot about using NYIPLA as a forum for increasing the interaction of law firm IP counsel with in-house IP counsel. The overlapping and varied practices makes for rich exchange of ideas and a more valuable NYIPLA. When John informed me that NYIPLA would like me to join the Board to help advance this interaction and to find other ways to advance the organization, I was honored to serve in this capacity.

### **Why did you want to be on the Board?**

As I mentioned above, one of the keen interests I have is to increase NYIPLA's in-house counsel membership. More specifically, my sense is that having a mix of law firm IP practitioners and in-house counsel yields a varied perspective on the IP issues faced by companies. In addition, because IP work touches all industries – such as

pharmaceutical, software, financial, and so on – the organization will benefit by having in-house IP lawyers and outside counsel that are involved in a wide array of industries, technologies, and commercialization strategies.

### **What is your role on the Board?**

My role, at the outset, will be to better understand our members' interests and to then find ways I can ensure we have programs, discussions, and other activities that can advance these interests. Increasing membership and membership diversity – to effectuate diverse and as a result more valued thinking – are two key goals that are important to me. In addition, expanding the types of IP that we flesh out, advance and shape as a committed and diverse community of IP professionals – whether trade secrets or information security – will serve to enhance NYIPLA's impact on our members and IP practice in general.

### **Are you active in any other bar associations and, if so, which ones and in what capacity?**

I am a member of only one bar association – NYIPLA. I believe in the association's mission: to advance and harmonize IP laws throughout the US and internationally. And, given that New York is one of the centers for intellectual property practice, I am drawn to this organization. In addition, being in New Jersey, I am so close to the programs offered by NYIPLA and many of our members; this gives me a good opportunity to meet with my colleagues in person.

### **How does your involvement with the NYIPLA compare with your involvement in the other bar associations?**

While I am not a member of other bar organizations, I am always looking to learn from and contribute to the evolution and dissemination of IP law – especially trade secrets and information security. As such, in 2023, I will be participating on panels at other IP bar organizations relating to cybersecurity protection to help advance the discussion to other audiences in our field of practice.

### **What are your goals for your time on the Board, that is, what do you hope to accomplish?**

As described more fully above, my goal is to further increase the diversity of our organization in terms of membership backgrounds, professional experience, types of IP considerations and looking for cutting-edge impact areas in the IP field. While NYIPLA is already viewed as a leading IP bar organization, our commitment to continual evolution will ensure we create increased value for our members and the IP bar.

### **Over the longer term, what do you see as the future of the Association?**

I see NYIPLA continuing to advance the IP practice through informative programming advanced by our committees, exceptional networking at these programs – including of course the Judges Dinner – and shaping IP law through informative publications including impactful amicus briefing. But beyond that, my sense is that the NYIPLA will continue to play a role in the conversation around budding areas impacting IP practices such as widespread developing areas like information security and more specific evolutions such as the growing implementation of new technologies (such as NFTs).

### **Is there anything else that you wish to share or comment upon?**

I look forward to seeing more programs that are collaboratively hosted by multiple NYIPLA committees – whether it's patent litigation and women in IP law or trade secrets with our younger (newly admitted) lawyers, and the like. This will ensure that varying viewpoints are presented and will allow for all of us to meet more of each other as we continue to collaborate. I also look forward to seeing different program formats that are educational and engaging. For example, a few years ago, NYIPLA hosted a program through a Family Feud game format. Perhaps we can do a Jeopardy type game on a given topic - such as trade secrets and information security where there is so much to learn!



# Inventor of the Year Award 2022 Annual Meeting Speech

By: **Dr. Steve Carlson**

Union League Club, NYC, Thursday, May 19, 2022

It is difficult to express in words all of my gratitude for this great honor! For the past 30 years, I have been involved in all aspects of intellectual property law, and I have a very high admiration for your profession.

First, I want to thank my wife, Hannah, for her steadfast support. Her ability as an educator and writer inspires me. We met and married while I was a grad student in chemistry at MIT, and she was a teacher in Lexington. Our 3 children have also been strong supporters. I am so happy that our son Todd has come from Boston to be here tonight.

I'm grateful for an exceptional education at a small high school near Pittsburgh, at Principia College near St. Louis, and at MIT. I would not be here speaking to you tonight without those excellent teachers.

People often ask me, what does it take to be a successful inventor? As in many careers, I think it starts with good education but blossoms in the workplace of life with the qualities of curiosity, persistence, and teamwork.

Curiosity, a strong desire to know or learn something, is a natural quality I cherish. It's very satisfying to find something new, to work on it, and prove its novelty and usefulness. I got an early boost on spending more time being curious and thinking about a problem to be solved by our family's friendship with Theodore Edison, Thomas Edison's son. Theodore was a technical person and an inventor in his own right. He's still the best example that I know of a curious person who thought very deeply about how to solve issues. Once he showed me his early 1940's design for computers that was ahead of its time, except it was a wartime secret that the U.S. government would not release for a dozen years!

I encourage my technical team to be curious, to deeply think on solving a problem, and then to witness how many good ideas come.

My early inventions on heat stable separators for safer lithium batteries, and with longer battery lifetimes and more energy per battery weight, were done 10 years before battery fire issues emerged in the industry as the batteries became denser in energy. The separator is the insulator between the positive and the negative electrodes and is a key to battery safety. Our unique ceramic separator has no shrinkage at any temperature, which is why it enhances the safety of batteries. Today's batteries, with their even higher energy density, need even safer separators. The market has now come to our super heat stable separators, which offer the best safety and energy in the industry.

Besides curiosity, persistence is key. I had an interesting early experience that taught me about persistence. I was a R&D manager at a company where drafting film was the top product, and I was assigned to greatly improve the product. There was a lot of pressure on me, because the manufacturing department did not want to make any changes to the drafting film that was easy to coat and that they had been doing for about 15 years. Never mind, that it turned increasingly yellow and brittle with aging and was losing its 15% market share. In my hotel room that morning before going to the factory to do the large make-or-break product qualification run, I picked up the Gideon Bible on

the table for some inspiration. It opened to the Book of Nehemiah, with which I was not familiar. It turns out that Nehemiah was the model of persistence in rebuilding the wall around Jerusalem and in preventing 3 enemies from stopping their work. Holding to this encouragement to be persistent, it took 40 consecutive hours to work through challenges in the factory, but the new drafting film soon became the leader in the industry with a 35% market share which it held for over 15 years. 13 years later, I was at a competitor where I learned that their top chemist had tried for 6 months to reverse engineer this drafting film with no success.

Besides curiosity and persistence, I value teamwork. This starts with selecting the team members. Back to the Edison family, do any of you know one of Thomas Edison's main approaches to hiring? He would take the candidate to breakfast to observe whether they salted their eggs before tasting them. He wanted people who "lived in the moment." I haven't followed this approach, but fortunately I have had excellent co-inventors and technical support staff over the years and excellent patent law firms, most recently Amster, Rothstein & Ebenstein, located nearby on Park Avenue, for the past 7 years. I'm delighted that two of the partners there that we work with, Brian Comack and Brian Amos, are with us tonight.

My formula is not secret – education, curiosity, persistence, and teamwork – combine to enrich all people working on their dreams.

Dr. Steve Carlson  
Cambridge, MA



# TikTok Videos. Are These Works Entitled to Copyright Protection?

By: **Giselle Ayala Mateus, Esq.**

Short-video content became especially popular with the launch of TikTok in 2018. According to Forbes, "[i]t has reached over 2 billion downloads and has more than 100 million monthly active users in the US."<sup>[1]</sup> TikTok's short-video strategy to promote content and drive users' attention has become a multimillionaire industry. TikTok has created a revolution, and now, it is present in more than 100 countries.<sup>[2]</sup>

However, while content creators celebrate TikTok's success<sup>[3]</sup>, legal practitioners across the globe are concerned about the risks associated with the TikTok business model. TikTok features, which include using parts of videos or sound recordings to create new short videos, raise particular concerns about the copyright interests of authors. As a result of this, after its US launch, TikTok entered into a series of licensing agreements with several organizations: Sony Music Entertainment<sup>[4]</sup> and International Copyright Enterprise Services Ltd.<sup>[5]</sup> in November 2020, Warner Music Group<sup>[6]</sup> in December 2020, and Universal Music Group<sup>[7]</sup> in February 2021.

Considering this context, we will now explore three issues: (1) whether TikTok videos, i.e., videos created through the app or with the help of the TikTok app, are entitled to copyright protection as original works; (2) whether the TikTok videos can be considered derivative works; (3) and finally, to what extent TikTok videos could be infringing content.

## Are videos created through TikTok entitled to copyright protection as original works?

As we know, copyright protection exists in favor of a work of authorship that has been fixed in a tangible medium, is the result of an author's own work, and has some degree of originality. Additionally, copyright protection exists automatically from the creation of the work.<sup>[8]</sup> Considering this, would it be accurate to say that the short videos created through the TikTok App are all entitled to copyright protection?

Under US copyright law, Congress did not define "originality." However, under common law, "originality" refers to the results that come from one's labor only. US courts have explained "originality" in the following terms: "Originality in the copyright sense means only that the work owes its origin to the author [...] Therefore, a work is original and may command copyright protection even if it is completely identical with a prior work, provided it was not copied from that prior work but is instead a product of the independent efforts of its author."<sup>[9]</sup>

A work is original and entitled to protection if it is the result of the independent efforts of its author. However, this is not an analysis of skills or ability, nor is it about novelty. In *L. Batlin & Son, Inc. v. Snyder*, the Court explained the test for originality as follows: "The test of originality is concededly one with a low threshold in that all that is needed is that the author contributed something more than a merely trivial variation, something recognizably his own..." (emphasis added).<sup>[10]</sup>

In *Atari Games Corp. v. Oman*, the US Copyright Office refused to register a video game "Breakout" for lack of originality.<sup>[11]</sup> The work at issue was similar to a short video. Here, the Court sided with the copyright claimant and explained that the degree of creativity required under the US copyright laws is low, and it is not the Register's job to decide what enough creativity is.<sup>[12]</sup> The Court explained:

The requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easy, as they possess some creative spark, no matter how crude, humble or obvious it might be...It is not the Register's task to shape the protection threshold or ratchet it up beyond the 'minimal creative spark required by the Copyright Act and the Constitution.<sup>[13]</sup>

We have noted that neither uniqueness nor novelty is required to satisfy the originality requirement. If an author independently creates a work, it will still meet the threshold of originality. Thus, a person need not be the first to come up with an original work, but they must do it independently to qualify for copyright protection. Connecting these reflections to what the TikTok App is and what users can achieve through the use of TikTok, it is arguable that original TikTok videos, with at least a minimum of creativity, could be entitled to copyright protection under US law.

Originality comes from the independent efforts of the author. Through the TikTok App, users have many options to create content, like editing, adding music or other sounds, applying filters, stickers, and effects, and combining videos. Under US laws, specifically, there would be a reasonable argument in favor of the recognition of originality and the existence of copyright protection. However, it is essential to note that if someone creates something based on or using a pre-existing work, this creation might not be protected if considered an unauthorized derivative work.

### Are TikTok videos considered as derivative works?

We have already stated that the TikTok videos could be entitled to copyright protection. However, to what degree is a TikTok video protected, especially if the video is the result, at least in part, of copying a prior material? Additionally, is an author entitled to copyright protection if it uses templates or additional tools provided by the TikTok platform, or is it copyright infringement?

A derivative work is a contribution of originality to a pre-existing work, to recast, transform or adapt the pre-existing work. Usually, derivative works are summaries, adaptations, arrangements, dramatizations, or translations of prior material. Derivative works may be entitled to copyright protection if the additional elements contributed to the preceding work or the manner of rearranging or otherwise transforming the prior work consists of more than a minimal contribution.<sup>[14]</sup>

Copyright in a derivative work covers only those new elements the copyright claimant contributed. The copyright protection of derivative works is still a contentious topic. However, courts agree that "[d]erivative work protection only extends to those parts of the derivative work that are novel beyond the original work and the author or authors of the underlying work retain their rights to their original work..."<sup>[15]</sup> For a work to qualify as a derivative work, it must be independently copyrightable, i.e., there must be at least some substantial variation from the underlying piece, not merely a trivial variation.

The TikTok app gives users complete freedom regarding how and where to place effects, filters, stickers, and other visual elements. Thus, user-generated videos could be entitled to copyright protection because the specific election of elements, by the TikTok user, did not exist before the TikTok user interacted with the application. Said elections involve individual judgment and correspond, to some degree, to the individual efforts of the TikTok user.

Notably, a derivative work's copyright protection requires authorization by the author of the original work. Therefore, a derivative work constitutes copyright infringement if created without the original author's permission. Under US law, copyright owners have the exclusive right to use their original work, including the right to create and control any derivative works based on their original content.

On the one hand, TikTok could argue that videos created through the platform, especially those that use templates, constitute derivative works. If those videos were derivative works, the secondary author would not be entitled to protection absent TikTok's prior authorization. On the other hand, derivative

work's protection does not cover ideas. Concerning templates, these are usually not copyright protectable because they only contain general concepts that, without the intervention of the TikTok users, cannot become protected works.<sup>1161</sup>

Another issue, which sometimes comes up in copyright litigation, is the protection of ideas. Copyright does not protect ideas. Therefore, a derivative work is not within the scope of protection provided to the author of an original work if the derivative work has borrowed only the idea that the original work expressed.

Many of the videos that TikTok users publish are inspired by topics that became popular. Then, a user generally watches the video, adopts the general concept portrayed therein, and publishes its own version. Considering this, if a user-generated video borrows an idea from a prior TikTok video, where the theme, the characters, the election of elements, and the overall concept of the video have some degree of originality, the said video may be regarded as an independent copyrightable material, and not as a derivative work requiring authorization of the author of the prior video.

Ideas for TikTok videos may come from a common source and result in two works that are substantially similar or almost identical, especially if they are related to everyday situations or circumstances. However, under US copyright law, when there is essentially only one way to express an idea, the idea and its expression are inseparable, and copyright is no bar to copying that expression. Moreover, under the *scènes-à-faire* doctrine, sequences of events that necessarily result from the choice of a setting or situation do not enjoy copyright protection.<sup>1171</sup>

To illustrate how courts have decided whether the author of a secondary work took only the ideas expressed in a pre-existing material, I will reference a couple of examples.

In *Harrison v Infinity Ward, Inc.*, Plaintiff uploaded a video name “Call of Duty Black Ops 4 Rant,” to YouTube. After that, Defendant created “2019 Call of Duty Modern Warfare Reboot”.<sup>1181</sup> Plaintiff brought a lawsuit alleging that Defendant’s video game infringed its YouTube Video.<sup>1191</sup> In this case, the Court accepted that Defendant used Plaintiff’s ideas, which came from the YouTube Video.<sup>1201</sup> However, it wasn’t enough to sustain a copyright infringement action.<sup>1211</sup> Here the Court explained:

Defendant used Plaintiff's ideas and concepts described in the YouTube Video, which led to the plot, format, and other key elements of the 2019 Call of Duty Modern Warfare Reboot. [...] However, “[n]o one can own the basic idea for a story. General plot ideas are not protected by copyright law.” Because Plaintiff's ideas and concepts are not copyrightable, this court finds that Plaintiff did not sufficiently allege facts constituting a plausible copyright infringement claim.<sup>1221</sup>

In *Manno v Campbell*, plaintiff Kelly Manno brought a copyright infringement case against defendant comedian Michael Che for the alleged infringement of two short videos she posted on TikTok, each entitled “Homegirl Hotline.”<sup>1231</sup> The Court dismissed Manno’s case.<sup>1241</sup> Although there was evidence that Che copied Manno’s work, Manno was required to demonstrate that the copying was illegal due to a substantial similarity existing between both works, especially regarding the protectable elements of Manno’s work.<sup>1251</sup> In this case, the Court explained:

Manno's claim of copyright infringement must be dismissed for its failure to plead infringement of any protectible element of either Video. [...] The idea of hiring a homegirl to fight battles, as Manno herself admits, is not protectible. [...] Manno argues that the protectible element in her Videos is the unique creative comedic depiction of a service through which a customer in need specifically summons a home girl [...] These are general unprotectable ideas [...] [Additionally,] Manno does not explain how their characters are similar and simply includes a side-by-side picture of one of the characters in her Videos [...] the only apparent similarity is that the characters are both women and both wear sneakers. Such generic and common characteristics cannot serve as the basis for an infringement claim.<sup>1261</sup>

Therefore, even if one user-generated video takes elements from a pre-existing work, if those elements are not more than general ideas or concepts, there is no derivative work and no copyright infringement claim.

Moving forward, on the issue of authorization to create derivative works, it is relevant to review TikTok's Terms and Conditions (the "Terms"). According to TikTok's Terms, users may not "make unauthorized copies, modify, adapt, translate [...] create any derivative works of ... any content included therein".<sup>[27]</sup> TikTok's basic premise regarding its intellectual property interests is that users have no rights over any content available through its platform.

However, regarding user-generated content, TikTok's Terms state that users

may upload, post or transmit (such as via a stream) or otherwise make available content... without limitation, any text, photographs, user videos, sound recordings and the musical works embodied therein [...] [and] may extract all or any portion of User Content created by another user to produce additional User Content, including collaborative User Content.<sup>[28]</sup>

Moreover, TikTok declares that users "still own the copyright in User Content sent."<sup>[29]</sup>

TikTok authorizes and encourages users to use, copy, transform and transmit TikTok's videos. Thus, it is plausible to say that TikTok user-generated videos may be independently protected as derivative works if they contain more than a trivial variation of prior material and were created with permission. In this case, that would be the permission granted by the TikTok Terms.

### To what extent could TikTok videos constitute as copyright infringement?

To establish copyright infringement, a claimant must prove (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original. In many cases, a valid copyright can be established by introducing a certificate of Copyright.<sup>[30]</sup> Moreover, it is a procedural prerequisite to start a lawsuit. A registration certificate does not create an irrebuttable presumption of copyright validity, nor is it evidence of originality.

For our analysis, if there was a conflict between two alleged authors of videos created or posted on TikTok, the pre-requisite to commence a lawsuit would be the existence of a Copyright Registration. In general, many creators fail to register. Additionally, considering the speed at which TikTok's content increases, it is unlikely that the average TikTok user would register a video before publication. However, it is not impossible. Moreover, claims of copyright infringement could come from authors who registered their work but did not publish their content on TikTok.

In *Alexey Shamraev V. Tiktok Inc. et al*, plaintiff Alexey Shamraev, a freelance online content developer, filed a lawsuit against TikTok for the unauthorized use and copyright infringement of his video template entitled "Ancient World."<sup>[31]</sup> Around 2013, Shamraev created the "Ancient World" template, which involves a demonstration of sand animation where Shamraev's hand moves across the screen, appearing to shift sand around the screen to reveal pictures underneath. The complaint states: "With the template, users can insert their own images so that they are revealed on the screen as Mr. Shamraev's hand moves the sand."<sup>[32]</sup> Shamraev filed for copyright registration soon after he allegedly discovered that TikTok had created a template called "Sand Painting 2" that illegally copied images from his template. This litigation is still pending.

To satisfy the second element of a copyright infringement action, a plaintiff must demonstrate that the defendant has actually copied the plaintiff's work, and that the copying is illegal because a substantial similarity exists between the defendant's work and the protectible elements of the plaintiff's work. Actual copying may be established by direct evidence.<sup>[33]</sup> However, direct copying is rarely demonstrated. Consequently, indirect evidence can prove actual copying, including evidence of the defendant's access to the copyrighted work.

Access means that an alleged infringer had a reasonable possibility—not simply a bare possibility—of hearing, copying, or seeing the prior work. Access cannot be based on mere speculation, which makes the plaintiff’s claim challenging. However, courts have recognized access in cases where the plaintiff demonstrates that a work was widely disseminated or that a party had a reasonable possibility of viewing the prior work.

If the pre-existing work, the “original,” was published on TikTok, evidence of access might be established by requesting records of the views generated by original work. However, it is unlikely that TikTok is willing to share that information, mainly because the application is concerned about protecting its user’s personal data. Additionally, millions of videos are posted daily on TikTok and shared across the internet in a blink of an eye. In the scenario of a potential litigation, a plaintiff could have a hard time proving access to the specific video that is the basis of a copyright litigation. It is relevant to note, that the TikTok platform provides a page where anyone can make a copyright complaint.<sup>[34]</sup> This might be the channel to request evidence that support the allegation of access to the work. However, to make a report, users must explain why they consider there is a copyright infringement and provide evidence of copyright ownership. TikTok does not expressly require a copyright registration, but it is reasonable to believe that one would be required before any content is taken down.<sup>[35]</sup>

If the plaintiff can show that defendant had access to the plaintiff’s original work, the next and final step is to demonstrate substantial similarity. The analysis of substantial similarity offers multiple venues and outcomes, primarily because federal courts are split as to the proper test to determine substantial similarity.

As we have already noted, TikTok is present in more than 100 countries.<sup>[36]</sup> This means that before an individual can file a lawsuit for copyright infringement, the potential plaintiff will have to determine which is the applicable copyright law and who has jurisdiction. Assuming the copyright issues of the potential litigation are within the subject matter jurisdiction of the US courts, substantial similarity could be established by using one of many tests, such as the: ordinary observer test<sup>[37]</sup>, more discerning test<sup>[38]</sup>, total concept and feel test<sup>[39]</sup>, comprehensive nonliteral similarity test<sup>[40]</sup>, fragmented literal similarity test<sup>[41]</sup>, or quantitative and qualitative significance test.<sup>[42]</sup>

The determination of what constitutes substantial similarity presents one of the most difficult questions in copyright law. Therefore, it may only be resolved on a case-by-case basis. It is clear that the existence of slight or trivial similarities between two works cannot amount to copyright infringement, but there is no rule of thumb as to what constitutes substantial similarity.

TikTok videos are influenced by numerous variables such as the TikTok editing, sharing, and combining features, and the multiple elections that the TikTok users can make to create new content or replicate preexisting trends. Therefore, until proven otherwise, TikTok videos and templates could be but are not necessarily infringing works. To illustrate this, in response to Mr. Shamraev’s lawsuit, TikTok answered with a basic denial of substantial similarity.

### Final thoughts...

The TikTok app, as it is stated on its website, has the mission of inspiring creativity and bringing joy.<sup>[43]</sup> Accordingly, it gives users the freedom to publish all kinds of content, edit videos using multiple features, save other users’ content, and transfer content to other apps. Under these circumstances, it is arguable that the user-generated TikTok videos are entitled to copyright protection. The prerequisite of originality is low under US law. Therefore, as long as the TikTok user has contributed more than a trivial amount of creativity to the video, by the exercise of her individual judgment, there is a viable copyright claim.

That said, there is a difference between entitlement to copyright protection and a real possibility of collecting damages in litigation. Thus, before considering their options and legal remedies, TikTok users should take into account that TikTok is present in more than 100 countries, that jurisdiction and venue may be a problem, that litigation is expensive, and that there is no certainty of collecting on a judgment.

- [1] Lisa Montenegro, *The Rise of Short-Form Video: TikTok Is Changing the Game*, Forbes (Aug. 27, 2021), <https://www.forbes.com/sites/forbesagencycouncil/2021/08/27/the-rise-of-short-form-video-tiktok-is-changing-the-game/?sh=4e6c14b15083>.
- [2] Mahnoor Sheikh, *30 TikTok Stats Marketers Need to Know In 2022*, Sprout Social (Mar. 17, 2022), <https://sproutsocial.com/insights/tiktok-stats/>.
- [3] Sarika, *135 Video Marketing Statistics You Can't Ignore in 2022*, InVideo (Jun. 20, 2022), <https://invideo.io/blog/video-marketing-statistics/>.
- [4] Tim Ingam, *TikTok and Sony Music Ink Licensing Deal for Major's 'Roster of Global Superstars and Exciting Emerging Artists'*, Music Business Worldwide (Nov. 2, 2020), <https://www.musicbusinessworldwide.com/tiktok-and-sony-music-ink-licensing-deal-for-majors-roster-of-global-superstars-and-exciting-emerging-artists/>.
- [5] Murray Stassen, *TikTok Inks Multi-Year Licensing Deal with ICE*, Music Business Worldwide (Nov. 27, 2020), <https://www.musicbusinessworldwide.com/tiktok-inks-multi-year-licensing-deal-with-ice/>.
- [6] Murray Stassen, *Warner Music Group Inks Licensing Deal with TikTok*, Music Business Worldwide (Jan. 4, 2021), <https://www.musicbusinessworldwide.com/warner-music-group-inks-licensing-deal-with-tiktok/>.
- [7] *TikTok and Universal Music Group Announce Expanded Global Alliance*, Universal Music Group (Feb. 8, 2021), <https://www.universalmusic.com/tiktok-and-universal-music-group-announce-expanded-global-alliance/>.
- [8] 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 2.01 (Matthew Bender, Rev. Ed.).
- [9] 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 2.01[A][1] (Matthew Bender, Rev. Ed.) (citing *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (citation omitted)).
- [10] *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir 1976).
- [11] *Atari Games Corp. v. Oman*, 979 F.2d 242 (1992).
- [12] *Id.*
- [13] *Id.* at 244, 247 (citations omitted).
- [14] 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 3.01 (Matthew Bender, Rev. Ed.).
- [15] *Brownstein v. Lindsay*, 742 F.3d 55, 67 (3d Cir. 2014).
- [16] Courts have sustained that authorship involves the exercise of judgment by the author. In *Warren Publ'g, Inc. v. Microdos Data Corp.*, 115 F.3d 1509, 1520 n.31 (11th Cir. 1997), the Court explained that "[f]or a compilation to be creative, and hence copyrightable, the compiler must exercise individual judgment."
- [17] 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 3.01 (Matthew Bender, Rev. Ed.).
- [18] *Harrison v. Infinity Ward, Inc.*, No. 1:20CV728, 2021 U.S. Dist. LEXIS 177174 (M.D.N.C. Sep. 17, 2021).
- [19] *Id.*
- [20] *Id.*
- [21] *Id.*
- [22] *Id.* (citing *Moore v. Lightstorm Ent.*, 992 F. Supp. 2d 543, 556 (D. Md. 2014)).
- [23] *Manno v. Campbell*, No. 21cv10642 (DLC), 2022 U.S. Dist. LEXIS 110877 (S.D.N.Y. June 22, 2022).
- [24] *Id.*
- [25] *Id.*
- [26] *Id.*
- [27] *Terms of Service*, TikTok (Feb. 2019), <https://www.tiktok.com/legal/terms-of-service-us?lang=en>.
- [28] *Id.*
- [29] *Id.*

[30] *Manno v. Campbell*, No. 21cv10642 (DLC), 2022 U.S. Dist. LEXIS 110877 (S.D.N.Y. June 22, 2022)

[31] *Shamraev v. TikTok Inc. et al.* Case 2:22cv1811. Pacer Document 01. Complaint.

[32] *Id.*

[33] 4 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* § 13.03 (Matthew Bender, Rev. Ed.).

[34] *Report Copyright Infringement*, TikTok, <https://www.tiktok.com/legal/report/Copyright?lang=en>.

[35] *Intellectual Property Policy*, TikTok (Jun. 7, 2021), <https://www.tiktok.com/legal/copyright-policy?lang=en>.

[36] Mahnoor Sheikh, *30 TikTok Stats Marketers Need to Know In 2022*, Sprout Social (Mar. 17, 2022), <https://sproutsocial.com/insights/tiktok-stats/>.

[37] Under the ordinary observer test, substantial similarity is determined considering whether an ordinary observer, someone without a predisposition to look for differences, would be disposed to overlook them and regard the aesthetic appeal of two works as the same. When courts apply this test, the basic question is whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work. See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101 (2d Cir. 2001).

[38] Under the "more discerning" test court consider the protectable and unprotectable elements of the works at issue. Here, the court attempts to put aside the unprotectable elements of the works and determine whether the protectable elements, standing alone, are substantially similar. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995).

[39] Under the total concept and feel test, courts have taken the position that the analysis of substantial similarity must consider the two works as a whole and not as their separate components taken individually. This test is used, particularly, in those instances where the defendant may have infringed on a plaintiff's work by appropriating the author's aesthetic decisions embodied in the original work. See *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970).

[40] Under the comprehensive nonliteral similarity test, courts examine whether the fundamental essence of the plaintiff's work was duplicated by the defendant. See *Sid & Marty Krofft TV Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

[41] Under the fragmented literal similarity test, courts consider the portions of the plaintiff's work taken by the defendant and determine whether the copying goes to trivial or substantial elements of the original work. See *Ringgold v. Black Entm't TV, Inc.*, 126 F.3d 70 (2d Cir. 1997).

[42] Under the quantitative and qualitative significance test, courts consider the type of elements copied by the defendant and the amount of copying. Thus, if the copying was minimal or trivial, the law will not impose legal consequences. See *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data*, 166 F.3d 65 (2d Cir. 1999).

[43] *About TikTok*, TikTok, <https://www.tiktok.com/about?lang=en>.



# Notable Trademark Decisions, July 2022

By: **Scott Greenberg** and **Vrudhi Raimugia**

## **Coca-Cola’s victory order reversed by the United States Court of Appeals for the Federal Circuit**

The present case is an appeal before the United States Court of Appeals for the Federal Circuit (“Appeals Court”) by Meenaxi Enterprises Inc. (“Meenaxi”) from a decision of the Trademark Trial and Appeal Board (“TTAB”). The TTAB issued an order in favor of The Coca-Cola Company (“Coca-Cola”) and cancelled Meenaxi’s registrations for the marks “THUMS UP” and “LIMCA”. In a precedential decision, the Appeals Court reversed the TTAB on the ground that Coca-Cola failed to establish a statutory cause of action under Section 14(3) of the Lanham Act based on lost sales or reputational injury. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602 (Fed. Cir. 2022).

Coca-Cola distributes a Thums Up cola and Limca lemon-lime soda in India and other foreign markets. Meenaxi, on the other hand, has distributed a Thums Up cola and a Limca lemon-lime soda in the United States since 2008 and registered the “THUMS UP” and “LIMCA” marks in the United States in 2012. Coca-Cola brought cancellation proceedings under § 14(3) of the Lanham Act, 15 U.S.C. § 1064(3), asserting that Meenaxi was using the marks to misrepresent the source of its goods.

Coca-Cola began operating in India in 1950. Parle (Exports), Limited of Bombay, India introduced the Thums Up cola in India in 1977 and the Limca lemon-lime soft drink in India in 1971. Coca-Cola purchased Parle in 1993 and acquired Parle’s Indian registrations of the “THUMS UP” and “LIMCA” marks. The Indian High Court of Delhi found in 2014 that the “THUMS UP” mark was “famous” and “well known” in India, J.A. 3165, 3174, and previously found in 2011 that the “LIMCA” mark was “well known” in India, J.A. 3256, 3258.

Coca-Cola claimed that its Thums Up and Limca beverages were imported and sold in the United States by third parties who purchased the products in India since at least 2005 and Meenaxi had been selling beverages to Indian grocers in the United States since 2008 using the “THUMS UP” and “LIMCA” marks.

In 2012, Meenaxi sought to register the THUMS UP and LIMCA marks in the United States. It was granted Registration No. 4,205,598 (“598 Registration”) for the “THUMS UP” standard character mark in International Class 32 for “Colas; Concentrates, syrups or powders used in the preparation of soft drinks; Soft drinks, namely, sodas,” and Registration No. 4,205,597 (“597 Registration”) for the “LIMCA” standard character mark, also in International Class 32. J.A. 10.

On March 8, 2016, Coca-Cola brought a claim under § 14(3) of the Lanham Act to cancel Meenaxi’s registrations for misrepresentation of source. Section 14(3) provides:

A petition to cancel a registration of a mark, stating the grounds relied upon, may ... be filed as follows by any person who believes that he is or will be damaged ... by the registration of a mark on the principal register[.] . . .

(3) At any time . . . if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

15 U.S.C. § 1064.

Under the Supreme Court’s decision in *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014), entitlement to a statutory cause of action under the Lanham Act requires demonstrating (1) an interest falling within the zone of interests protected by the Lanham Act and (2)

an injury proximately caused by a violation of the Act. The Appeals Court pointed out that in the Lexmark case, the activities involved were solely within the United States.

Meenaxi argued that Coca-Cola lacked any cause of action under the Lanham Act because of the territoriality principle. The Appeals Court held that Meenaxi was correct in claiming that the territoriality principle was well established in trademark law: “Under the territoriality doctrine, a trademark is recognized as having a separate existence in each sovereign territory in which it is registered or legally recognized as a mark.” McCarthy on Trademarks § 29:1.

With respect to international usage, a trademark right generally extends only to countries in which the mark is used. However, the Appeals Court stated that, irrespective of the above, the extent to which the Lanham Act applies to activities outside the United States was not a question implicated in the case because Coca-Cola based its claim entirely on alleged injury occurred in the United States. In this respect, Meenaxi contended that Coca-Cola lacked a statutory cause of action under Lexmark because, as a result of Meenaxi’s activity, (1) there were no lost sales in the United States and (2) there was no reputational injury in the United States.

With regard to lost sales, the Appeals Court tilted in favor of Meenaxi because the only evidence Coca-Cola could provide regarding sales of their products in the United States related to either third party testimony or third party unauthorized sales. Further, Coca-Cola could not show that it had lost any sales in the United States as a result of Meenaxi’s activities.

Regarding the question of reputational injury, the Appeals Court would have been required to decide whether famous marks were entitled to protection from reputational injury in the United States even though the marks were used solely outside of this country, had Coca-Cola relied upon such a claim. However, in this case, Coca-Cola did not rely on such a potential “famous-mark exception” to the territoriality rule. Coca-Cola mainly focussed on the reputational injury it had incurred because (1) members of the Indian American community in the United States were aware of the “THUMS UP” and “LIMCA” marks and (2) Meenaxi traded on Coca-Cola’s goodwill with Indian-American consumers in those marks by misleading them into thinking that Meenaxi’s beverages were the same as those sold by Coca-Cola in India.

However, the Appeals Court rejected the foregoing argument because a cognizable “economic and reputational injury” generally “occurs when deception of consumers causes them to withhold trade from the plaintiff” (quoting *Lexmark International, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 133, 134 S. Ct. 1377, 188 L. Ed. 2d 392 (2014)), and, as previously noted, Coca-Cola alleged no lost U.S. sales as a result of the claimed reputational injury in the Indian-American community.

Further, the Appeals Court declined to decide what other types of commercial injury to reputation among the United States’ consumers would be sufficient to establish a Lanham Act cause of action because substantial evidence did not support the finding that the Indian-American community was aware of the “THUMS UP” and “LIMCA” marks.

Finally, the Appeals Court held that substantial evidence did not support the TTAB’s finding that the reputations of Coca-Cola’s “THUMS UP” and “LIMCA” marks extended to the United States. Without such evidence, Coca-Cola failed to establish reputational injury in the United States, or a cause of action under § 14(3) of the Lanham Act. Resultant, the Appeals Court reversed the TTAB’s decision cancelling the ’597 Registration and the ’598 Registration. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602 (Fed. Cir. June 29, 2022) (precedential). [VR]

### **CAFC Affirms TTAB’s Upholding of Barclays Capital’s Rights In The LEHMAN BROTHERS Trademark**

In March 2013 and June 2014, respectively, Tiger Lily Ventures Ltd. (“Tiger Lily”) filed two United States trademark applications for “LEHMAN BROTHERS”, one in connection with beer and spirit products and the other in connection with bar and restaurant services. These applications were opposed by Barclays Capital Inc. (“Barclays”), which had acquired various assets of the Lehman Brothers investment bank, including the rights to the LEHMAN BROTHERS mark, when the latter investment

bank financially collapsed and filed for bankruptcy in 2008. Barclays based its oppositions on likelihood of confusion with asserted common law rights in the LEHMAN BROTHERS name and mark (Barclays had not maintained the existing US registrations for “LEHMAN BROTHERS”). Barclays also filed, in October 2013, a new intent-to-use application to register LEHMAN BROTHERS in connection with various financial services, which was opposed by Tiger Lily on the ground of lack of a bona fide intention to use the mark. The USPTO’s Trademark Trial and Appeal Board (the “Board”), in a consolidated proceeding, sustained Barclays’ oppositions to Tiger Lily’s applications, rejecting Tiger Lily’s defense that Barclays had abandoned the LEHMAN BROTHERS mark, and dismissed Tiger Lily’s opposition to Barclays’ application. On appeal, the United States Court of Appeals for the Federal Circuit (“CAFC”), in a precedential decision, affirmed the Board’s ruling on all counts. *Tiger Lily Ventures Ltd. v. Barclays Capital Inc.*, 35 F.4th 1352, 2022 USPQ2d 513 (Fed. Cir. 2022).

#### Barclays Did Not Abandon The “LEHMAN BROTHERS” Mark

The CAFC panel ruled that substantial evidence supported the Board’s determination that Barclays had not abandoned the “LEHMAN BROTHERS” mark.

The Court noted that, under 15 U.S.C. §1127, a trademark is considered “abandoned” if its “use has been discontinued with intent not to resume such use.” Thus, there are two elements to a claim for abandonment: (1) nonuse; and (2) intent not to resume use. In the present case, the Court affirmed the Board’s holding that Barclays’ ongoing use of the mark had been established, and therefore Tiger Lily’s abandonment defense must fail. 35 F.4th at \_\_\_, 2022 USPQ2d 513 at \*4-6.

The evidence supporting Barclays’ ongoing use of the mark included the facts that (a) after Lehman Brothers assigned its trademark rights to Barclays, Barclays licensed back to Lehman Brothers a right to use the LEHMAN BROTHERS mark in connection with various financial services, and (b) at the very least, one Lehman Brothers entity continued to use the mark in connection with financial services as part of its winding down process, selling off various financial and real estate assets in connection with its bankruptcy proceedings. *Id.*

Although Tiger Lily conceded that the above-mentioned use was being made, it argued that it did not constitute trademark usage of the type that would preclude a holding of abandonment because the bankruptcy proceedings will eventually end and Lehman Brothers is involved in the type of bankruptcy from which it will not emerge as a continuing enterprise. However, the CAFC panel rejected this argument:

Regardless whether Lehman Brothers will cease to exist after the bankruptcy concludes, it is not disputed that the bankruptcy has not yet concluded, and the record lacks clear evidence as to when any such conclusion is expected. Thus, any evidence about Lehman Brothers’ intentions after the conclusion of the bankruptcy proceedings relates only to the second element of Tiger Lily’s abandonment claim—i.e., whether Barclays intends not to resume use of the LEHMAN BROTHERS mark. As discussed above, Tiger Lily has failed to show that use of the mark has yet been discontinued, and indeed Tiger Lily appears to concede that it has not. Evidence relating to the second element, post-bankruptcy use, is thus irrelevant. *Id.* at \*6.

The Court further noted that Barclays was making some use of the LEHMAN BROTHERS mark on its own, including use on legacy Lehman Brothers research products. *Id.*

The CAFC panel therefore concluded that the ongoing use of the mark defeated Tiger Lily’s claim of abandonment, noting that “continued use of the mark, even if limited, is sufficient to avoid a finding that the mark has been abandoned.” *Id.*

#### Likelihood of Confusion Was Established

The above-discussed ongoing use of the LEHMAN BROTHERS mark by Barclays and its licensees gave Barclays the required priority of use for an opposition claim based on likelihood of confusion. *Id.* On the issue of whether confusion is likely, the Court affirmed the Board’s ruling that it was, noting that substantial evidence supported the Board’s findings of fact on the relevant factors to be considered, and the Court’s *de novo* review agreed with the Board’s weighing of those factors and ultimate conclusion. *Id.* at \*7.

The Court agreed with the Board that, in this case, the most important factors were the identical nature of the parties' marks, the fame of Barclays' LEHMAN BROTHERS mark and Tiger Lily's intention to benefit from that fame. *Id.* at \*7-9.

In particular, the Court noted the following:

- Because Barclays' LEHMAN BROTHERS mark is famous, it is entitled to a broad scope of protection. *Id.* at \*8.
- The Board relied on Barclays' extensive evidence showing examples of companies that have promoted financial services through use of their trademarks in connection with alcohol, food, and beverages. Moreover, in marketing its own banking products and services, Lehman Brothers used its LEHMAN BROTHERS mark in connection with products that are related to whisky and alcoholic beverages, such as a whiskey decanter and a beverage cooler. *Id.*
- “[T]he evidence shows that, by referencing the Lehman Brothers history in its marketing materials and by copying Lehman Brothers' logo, Tiger Lily is seeking to take advantage of the widespread consumer recognition of Barclays' LEHMAN BROTHERS mark.” *Id.* at \*9.

#### Barclays Has a Bona Fide Intention To Use the Mark

The CAFC also affirmed the Board's dismissal of Tiger Lily's opposition to Barclays' intent-to-use application for LEHMAN BROTHERS in connection with various financial services. The Court held that substantial evidence supported the Board's findings that Lehman Brothers and Barclays have continued to use the LEHMAN BROTHERS mark since 2008, and further that Barclays currently offers in connection with other marks that it owns, and has the capacity to continue to offer, the goods and services identified in its application for registration, which are precisely the types of goods and services with which the LEHMAN BROTHERS mark has been associated in the past. *Id.* at \*10.

The CAFC therefore affirmed the Board's decision in all respects. *Tiger Lily Ventures Ltd. v. Barclays Capital Inc.*, 35 F.4th 1352, 2022 USPQ2d 513 (Fed. Cir. June 1, 2022) (precedential).[SG]

#### **Bacardi's use of “UNTAMEABLE” remains untamed - The United States Court of Appeals for the Ninth Circuit affirms the District Court's decision**

The United States Court of Appeals for the Ninth Circuit (“The Appeals Court”) recently decided on a trademark infringement action brought by Lodestar Anstalt (“Lodestar”) against Bacardi U.S.A., Inc. (“Bacardi”) for alleged infringement of the trademark “UNTAMED”. The District Court entered summary judgment against Lodestar and eventually, the Appeals Court had to consider two major aspects of the case namely: (i) scope and priority of rights granted by an “extension of protection” for a trademark under the Madrid Protocol; and (ii) likelihood of confusion factors. Upon considering these issues, the Appeals Court affirmed the District Court's decision in favor of Bacardi. *Lodestar Anstalt v. Bacardi & Co.*, 31 F.4th 1228, 2022 USPQ2d 389 (9th Cir. 2022).

A key feature of the Madrid Protocol is that applicants with trademark protection in other countries may obtain an “extension of protection” in the U.S., which is generally equivalent to a trademark registration—without first having used the mark in commerce in the United States. Instead, an extension of protection may be granted under Title XII based on the applicant's declaration of a bona fide intent to use its foreign-registered mark in the U.S.

In this case, Lodestar obtained in 2011 an extension of protection for its Liechtenstein registered trademark in the use of the word “UNTAMED” in connection with whiskey, rum, and other distilled spirits. In November 2013, Bacardi began an advertising campaign using the phrase “BACARDI UNTAMEABLE” to promote its rum products. Thereafter, in 2016, Lodestar brought a trademark infringement suit against Bacardi. Bacardi defended by alleging that Bacardi could not claim right to use the “UNTAMED” Word Mark by virtue of non use of the mark by Lodestar at the time of Bacardi's abovementioned advertising campaign.

The Appeals Court held that even assuming that Lodestar did not actually use the “UNTAMED” Word Mark in commerce before Bacardi launched its allegedly infringing campaign, the amendments to the Lanham Act implementing the Madrid Protocol modified the priority of trademark rights that might otherwise flow from the parties' various uses of their respective marks. Under those amendments, Lodestar's post-November 2013 bona fide use of the “UNTAMED” Word Mark, coupled with the earlier

“constructive use” date afforded to Lodestar under the Madrid Protocol, was sufficient to give it priority of rights.

The Appeals Court opined that under the distinctive regime established for the Madrid Protocol, Lodestar’s subsequent bona fide use of its registered mark on certain rum products gave rise to a priority of right that it could seek to enforce in an action under the Lanham Act.

After the determination of priority rights in favor of Lodestar, the Appeals Court had to determine whether there was likelihood of confusion in the said case. Further, according to the Appeals Court, Lodestar’s claim here was not that Bacardi was trying to pass off its goods as those of Lodestar. Instead, Lodestar’s claim was one of so-called “reverse confusion,” in which “a person who knows only of [a] well-known junior user comes into contact with [a] lesser-known senior user, and because of the similarity of the marks, mistakenly thinks that the senior user is the same as or is affiliated with the junior user.” *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1160 (9th Cir. 2021). The Appeals Court stated that in assessing the likelihood of confusion here, the question to be asked was “whether consumers doing business with [Lodestar] might mistakenly believe that they were dealing with [Bacardi].” *Dreamwerks Prod. Grp. v. SKG Studio*, 142 F.3d 1127, 1128, 1130 n.5 (9th Cir. 1998).

The District Court, after evaluating the relevant factors enumerated in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), held that there was no evidence in the record that a reasonably prudent consumer in the marketplace would have mistakenly affiliated Lodestar’s product and mark with that of Bacardi (The eight so-called “Sleekcraft factors” include (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines).

Here, the Appeals Court agreed with the District Court’s conclusion that Lodestar failed to carry its burden to show a likelihood of confusion under the Sleekcraft factors, although the Appeal Court’s reasoning differed in some respects from the District Court’s. In the Appeals Court’s view, the District Court improperly assessed two of the eight Sleekcraft factors: (1) strength of the mark; and (2) the defendant’s intent. Nevertheless, these errors did not alter the Appeals Courts’ ultimate conclusion.

With respect to the strength of the mark, the Appeals Court agreed with the District Court that the “UNTAMED” Word Mark is more suggestive than arbitrary. The District Court erred, however, in then concluding that the strength-of-the-mark factor “weighs against confusion because Lodestar’s UNTAMED word mark is conceptually weak.” In the Appeals Court view, given the overwhelming commercial strength of Bacardi’s “UNTAMEABLE” mark, this factor weighs in favor of a likelihood of confusion in this reverse confusion case.

Regarding the party’s intent, the Appeals Court held that because it is undisputed that Bacardi knew about the “UNTAMED” Word Mark prior to its campaign, the District Court erred in concluding that the intent factor did not weigh, on balance, in Lodestar’s favor.

However, the Appeals Court agreed with the District Court that, based on the manner in which consumers actually encounter the parties’ respective marks, the factor of similarity of the marks weighs against any likelihood of confusion. In particular, Lodestar uses the UNTAMED Word Mark in conjunction with its “The Wild Geese Irish Soldiers & Heroes” brand of whiskey. Bacardi uses “Untameable” within the tag-line “Bacardi Untameable”. The Appeals Court held that in such a case, where each party is using the same or similar mark merely as a tagline to their distinctive business names, the subordinate position of each tagline mark to the housemark weighs against any likelihood of confusion.

Further, the Appeals Court emphasized that from the time that Bacardi learned of Lodestar’s mark to the time that Bacardi began its campaign, Lodestar had made little use (if any) of the “UNTAMED” Word Mark in U.S. commerce.

Considering all of the above factors, the Appeals Court finally issued an order in favor of Bacardi by stating that Lodestar failed to prove likelihood of confusion allegedly caused by the use of Bacardi’s mark. *Lodestar Anstalt v. Bacardi & Co.*, 31 F.4th 1228, 2022 USPQ2d 389 (9th Cir. April 21, 2022) (precedential). [VR]



## 'As Time Goes By - Inn Like Linn Redux'

BY: DALE CARLSON\*

Back in 1973, Chief Justice Warren Burger voiced his concern regarding diminishing courtroom skills of litigators at that time. He commented that "We do not disparage the law as a profession when we insist that, like a carpenter or an electrician, the advocate must know how to use the tools of his 'trade.'"<sup>(1)</sup>

His visit to England back then inspired Justice Burger as to how to remedy the situation as he saw it. He stated "[H]ow lawyers are trained - during and after law school - will determine their skills as advocates and ultimately the quality of our justice. That fact is nowhere better revealed than in the English experience."<sup>(2)</sup>

Of course, he was alluding to the English Inns of Court. In short order, American Inns of Court began cropping up across our country. In a nutshell, the Inns have the admirable objective of fostering civility, excellence and professionalism via mentoring among law students, new and experienced practitioners, and judges.

While many of the general Inns hold meetings at members' law firms, the IP Inns that formed more recently hold their gatherings at federal courthouses, which are ideal settings for honing legal practice skills.

Within the tri-state region, there are three IP Inns, namely the Hon. John C. Lifland Inn in NJ, the Hon. William C. Conner Inn in NY, and the Hon. Janet Bond Arterton Inn in CT.

When the Conner Inn held its inaugural gathering at the Union League Club of New York on January 15, 2009, there were six other IP Inns nationally, including the Hon. Giles S. Rich Inn of Washington, DC, named after an NYIPLA past president [1950-51].

By the time of the Arterton Inn inaugural gathering at the Richard C. Lee Federal Courthouse in New Haven on May 13, 2013, the number of IP Inns had grown to twenty-three, including one in Tokyo, Japan.

The inspiration for having a network of IP Inns came from Judge Richard Linn of the Federal Circuit. The Chicago IP Inn is named after him. Judge Linn inspired the creation of the "Linn Inn Alliance". The Alliance serves to facilitate the exchange of program information and other materials among the IP Inns. It also serves as a vehicle for members of one Inn to visit a gathering of another Inn.

Fortunately, we are at a point in the Covid pandemic where in-person gatherings are happening again. The Linn Inn Alliance held an in-person gathering on October 28th at National Harbor in Washington, DC. The Arterton Inn held and in-person "IP trivia night" on October 24th at Quinnipiac Law School. May in-person gatherings continue!

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

(1)Warren E. Burger, "The Special Skills of Advocacy: Are Specialized Training and Certification of Advocates Essential to our System of Justice?", 42 Fordham L. Rev., 227,233 (1973).

(2)Warren E. Burger, "The Skills of Advocacy", Trial Lawyers Quarterly 0 (1974); 8-20.

## MINUTES OF JUNE 21, 2022

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

The Board meeting was held via virtual format with members in-person through Zoom and over telephone conference. In attendance were:

Heather Schneider, President, presiding  
Rob Isackson, Immediate Past President  
Patrice Jean  
Jenny Lee  
Cheryl Wang (joined at approx. 5:45 pm ET)  
Scott Greenberg  
Abigail Struthers  
Rob Rando  
Mark Schildkraut  
Linnea Cipriano  
David Goldberg

Feikje van Rein attended from the Association's executive office. Eric Greenwald attended from the Associate Advisory Council. Diana Santos, Jonathan Berschadsky, Paul Bondor, Chris Loh, John Mancini, Marc Pensabene, as well as Christine-Marie Lauture and Khalil Nobles from the AAC, were unable to attend.

The meeting was called to order by President Heather Schneider around 5:05: pm.

Motion to waive reading of minutes was approved. A motion to approve minutes was passed, subject to amendment of some spelling mistakes and correction to Board Liaisons to list Patrice Jean as liaison for the Publications Committee.

Amicus Briefs Committee. Heather asked everyone to review the Conflict of Interest in the Board book regarding amicus brief approval. David Goldberg reported for the Amicus Briefs Committee and mentioned the filing The Andy Warhol Fdn. For the *Visual Arts, Inc. v. Goldsmith*, Amicus Brief on Friday June 17. The decision on the American Axle case is still pending.

Legislative Action. Rob Isackson reported for the LAC. He highlighted the resources from ACG that NYIPLA has access to.

101st Judges' Dinner – March 31, 2022 Feikje van Rein reported that she is working with the Hilton to secure space for the 101st Judges' Dinner. There are some challenges regarding other groups in house and timing which need to be resolved before the contract.

Previous and Upcoming:

- a) 07/05 PTAB program - Rob Rando reported that there will be a 2-part bootcamp with the Young Lawyers committee
- b) 07/13 TTAB Update (Half-Day Trademark CLE) Scott Greenberg mentioned the topics and the keynote of TTAB judge Jonathan Hudis
- c) 07/28 Moot Court program - Rob Rando reported that he is planning ahead with the Moot Court program and has 3 firms confirmed to participate
- d) Fall IP Transactions Bootcamp - Heather Schneider reported that the program will be held by Zoom over 3 days with a in-person closing reception. We also will invite the participants from last year.

Committee Reports:

5:45 pm ET

New Business

Linnea asked board members to recommend a co-chair for the Women in IP Committee.

David Goldberg proposed that an ad hoc committee be formed to plan the organization's centennial celebration. Volunteers for ad hoc committee include Abigail Struthers, Heather Schneider, Rob Rando and scheduling permitting, Patrice Jean & Rob Isackson.

Executive Session None.

Motion to adjourn meeting was passed. Meeting adjourned at 6 pm.

## MINUTES OF JULY 12, 2022

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

The Board meeting was held via virtual format with members in-person through Zoom and over telephone conference. In attendance were:

Heather Schneider, President, presiding  
Patrice Jean  
Jonathan Berschadsky  
Jenny Lee  
Diana Santos (left briefly between 4:45 and 5:10 pm)  
Cheryl Wang  
Scott Greenberg (left at 5:00 pm)  
Abigail Struthers (left at 5:00 pm)  
Rob Rando  
David Goldberg  
Chris Loh (joined at 4:30 pm)

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

Khalil Nobles and Eric Greenwald attended from the Associate Advisory Council. Mark Schildkraut, Paul Bondor, John Mancini, Marc Pensabene, Linnea Cipriano, Rob Isackson, as well as Christine-Marie Lauture from the AAC, were unable to attend.

The meeting was called to order by President Heather Schneider around 4:05 PM ET.

Motion to waive reading of minutes was approved. A motion to approve minutes, subject to minor edits was passed.

Financial Report – Exact financials are pending annual audit. Looks good so far in light of Judge's Dinner revenue, pending audit to get exact financials. Estimated \$64k from the dinner went into membership and overall this year, nearly \$80k in membership revenue.

New Members Motion to waive reading of new member names and to admit new members passed. Board discussed ideas to engage new students who were awarded membership as entrants in the Connor Writing Competition and finalists for NYIPLEF scholarships. Also discussed various membership initiatives such as personal letter from President to law schools & associated contacts in the area. Board also discussed benefits of outreach extending to D.C.

Amicus Briefs Committee. David Goldberg reported that American Axle did not move forward. He discussed 2 cases with early August deadlines that the ABC is monitoring. 1) Tropp vs Travel Centric a Section 101 case that the committee is monitoring where briefs in support of petition for cert due Aug 5th. Discussed very fact specific nature so best to monitor if issues evolve; if issues evolve, may update American Axle brief to the extent relevant. 2) OpenSkye and Intel – opened up in PTAB finding Intel infringed patents, Kathy Vidal asked for amicus briefs for 2 IPRs. Question presented relates to IPRs & jury verdicts, and what actions amount to abuse of process. Requested input from PTAB but general sense is that given the potential conflicts and varying positions, it may be challenging to reach consensus by August 4th.

Heather asked board members who may have lengthier conflicts checks to do so earlier where possible. Feikje noted that the Conflict of Interest Policy for board members to sign has been circulated through JotForm.

Legislative Action. Rob Isackson not able to attend today. Heather reported receiving inquiries about NYIPLA's position on Judicial Privacy Act per Past President Colman's letter. Otherwise, LAC is monitoring but not much moving forward given Congress's non-IP concerns. Board discussed the patent thickening issue recently revisited as another avenue to advocate for life sciences, a focus of President Schneider's term.

101st Judges' Dinner – March 31, 2023 Discussed nominations for OPS award. Justice Breyer and Judge Koh (now on the 9th Circuit) were suggested.

Previous and Upcoming:

- a) 07/05 PTAB program - Rob Rando reported that many young students and lawyers attended part 1 of the 2-part bootcamp.
- b) 07/13 TTAB Update (Half-Day Trademark CLE) Scott Greenberg reported program is ready to go for tomorrow including Judge Hudis. Currently, over 30 attendees signed up and it will be in-person only.
- c) 07/28 Moot Court program - Rob Rando reported that the event will be cancelled due to various conflicts or unavailability. Discussed ways to ensure the work product already produced does not go to waste e.g., potentially in lieu of IP Litigation Bootcamp for this year.
- d) Fall IP Transactions Bootcamp - Heather Schneider reported that the program will be held by Zoom over 3 days with an in-person closing reception depending on the situations at the time. We also will invite the participants from last year.

Committee Reports:

Committee co-chair obligations will be recirculated prior to President's call with individual committee chairs.

Fashion Law Cheryl Wang reported co-chairs have programming ideas. Scheduling has been challenging.

Patent Litigation Chris Loh reported the outgoing chairs are helping to get both new co-chairs set up.

IP Transactions Jonathan Bershinsky reported committee is planning bootcamp for fall 2022.

Publications Patrice reported that newsletters & other content such as podcasts are ongoing; NYIPLEF scholarships awarded.

Connor Writing Jenny Lee reported the committee will be planning this year's competition & outreach; the committee just awarded at the recent Annual Meeting.

Privacy, Data & Cybersecurity Diana reported Privacy Program planning is in discussions.

Associate Advisory Council Khalil reported no updates this month.

New Business

Executive Session None.

Motion to adjourn meeting was passed. Meeting adjourned at 6:15 pm.

## MINUTES OF SEPTEMBER 13, 2022

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

The Board meeting was held at the Union League Club via hybrid format with members attending in-person on-site, through Zoom and over telephone conference. In attendance were:

Heather Schneider, President, presiding  
Patrice Jean (Zoom)  
Jonathan Berschadsky  
Jenny Lee (Zoom)  
Diana Santos (joined at 4:10 pm - Zoom)  
Linnea Cipriano (Zoom)  
Cheryl Wang  
Scott Greenberg  
Abigail Struthers  
Rob Rando (Zoom)  
Paul Bondor  
David Goldberg  
Rob Isackson (Zoom)  
Mark Schildkraut (Zoom)

Feikje van Rein attended from the Association's executive office. Eric Greenwald attended from the Associate Advisory Council. Christopher Loh, as well as Khalil Nobles and Christine-Marie Lauture from the AAC, were unable to attend.

The meeting began around 4:00 pm ET with Stephanie Crosenzi from Satty & Partners giving the Auditor's Presentation. A motion to approve the financial report was passed.

The meeting was called to order by President Heather Schneider around 4:30 PM ET.

Motion to waive reading of minutes was approved. A motion to approve minutes, subject to President Schneider's edits, was passed.

Financial Report & New Members – Following Auditor's Presentation, Scott Greenberg reported that membership is up by about 40 people, which is up 50% from the previous year. Corporate Membership has gone down and the Corporate Committee needs new co-chairs. The board discussed factors that impact corporate membership, and ways to address. Our Young Lawyers and Corporate Committees are a core part of NYIPLA and the board discussed relevant programming of value, such as engaging with our Legislative Action Committee and through fireside chats with in-house counsel about career paths. Motion to waive reading of new member names and to admit new members passed.

Amicus Briefs Committee. David Goldberg reported that the ABC is monitoring cases pending cert, including Juno and BioGen which involve Section 112 issues. Warhol case is still pending results and the committee is looking into putting together a program or panel to discuss.

Legislative Action Committee. Rob Rando and Heather Schneider reported that the judiciary has called for the Judicial Security & Privacy Act to be revisited. The LAC will send out white papers and letters in place of the Presidential Forum that was previously planned under Past President Colman. President Heather Schneider reported that there will be a call with Chairman Nadler's staff to discuss his concerns.

Committee Updates: President Heather Schneider discussed social media and potential opportunities to amplify NYIPLA's visibility and messaging. The board discussed the ideas she shared such as press

releases, opportunities for Op-Ed placement, as well as leveraging IP360, NY Law Journal, etc. For social media, discussed ways to engage our membership on their preferred platforms and agreed that immediate amplification can start with panelists and program hosts directly involved with each event to post/re-post/like content.

101st Judges' Dinner – March 31, 2023 Pricing was discussed and the board passed a motion to increase ticket prices by \$20 and leave table pricing the same as this year. Discussed nominations for award and the board agreed to start with Justice Breyer.

Associate Advisory Council Diana Santos and Eric Greenwald reported the AAC met last month to discuss increasing engagement and have planned an upcoming Happy Hour event with the Young Lawyers and Corporate members. Other events include Surviving Your First Year in the Office, and Zoom Out with NYIPLA. The AAC and YLC will collaborate on a Program Communications Plan for early Spring roll-out to support earlier discussion on social media amplification.

Past Presidents Dinner Discussed moving November board meeting to allow for programming & holiday timeline.

Previous and Upcoming Programs:

- a. 7/5 & 8/ 2 PTAB Bootcamp Pt 1 & Pt 2 Robert Rando reported event was well-received; PTAB with PTO and judges available at each of the meetings
- b. 7/13 Hot Topics In Trademark & Copyright Law Scott Greenberg reported event went well; Judge Yudas gave overview of proceedings; USPTO fraud filings update; Copyright; Sanctions & Russia; panel for latest on NFTs & IP issues
- c. 8/2 Patent Law Committee Meeting Jonathan Berschadsky reported Nicholas Bertram discussed updates on Canada patent rules; Sen. Tillis Section 101 bill discussed in 2nd half; Harmonized patent filings with WIPO structure/system
- d. 9/6 PTAB Committee Meeting Robert Rando reported the event engages practitioners in very hands-on manner for programming
- e. 9/14 Hot Topics for Congress and the USPTO Robert Rando reported event will be hybrid in-person with Irina and PTAB judge, Rob co-moderating with judge to discuss Sen Tillis updated bill; 20 in-person & 19-25 via Zoom signed up so far
- f. 9/21 YLC/Corporate Happy Hour Diana Santos reported the event is on-schedule; Need additional support & corporate members attend; location is Pennsylvania Six
- g. 10/6, 12, 19 IP Transactions Bootcamp Heather Schneider reported decision to do it virtually; no longer hybrid; In-person element: after event at some point for graduation / reunion for cocktail party
- h. 11/09 One Day Patent Program – Willkie Farr Heather Schneider Princeton Club closed permanently
- i. Presidents Forum Heather Schneider Life Sciences & Drug Industry focus; cases in S. CT.; recent statements from Patent Office; Instead of Biosimilars annual event maybe hold it as a President's Forum; Inflation Reduction Act & consequences of that on Biosimilars; Linnea mentioned interest has evolved towards legislative / policy driven

New Business Jenny Lee mentioned working on outreach list with Cheryl Wang and asked if there are any specific areas/targets to focus on. Feikje to send school list from last year.

Meeting was adjourned at 5:45 pm with a break before annual committee reports at 6:30 pm.

## Patent Law and Practice Meeting

BY: **PATENT LAW AND PRACTICE COMMITTEE**

On June 24, 2022, the Patent Law and Practice Group held their monthly meeting featuring a guest speaker, Dr. Julie Burke.

In 2020, Dr. Burke founded IP Quality Pro LLC, a patent prosecution consulting venture, providing guidance to help patent practitioners efficiently and effectively navigate procedural obstacles with the USPTO. From 1995-2015, Julie served as a Primary Examiner, Special Program Examiner and then as Quality Assurance Specialist in Technology Center 1600 of the USPTO, where she drafted petition decisions, reviewed quality of Office Actions and allowances and evaluated patent examination practices to identify targets for quality improvement.

Dr. Burke spoke to The Patent Law and Practice Group about special examiners in Search and Classification Art Units 1699, 1759, 2189, 2419, 2699, 2899, 3619, and 3799. These Art Units are not listed in USPC. Applications are routed to the best examiner in these art units via Cooperative Patent Classification(CPC) as identified by a C\* internal indicator.

The examiners in these units are all experienced examiners who perform additional searches and spend additional time reviewing the applications. Dr. Burke was not able to determine why these Art Units were formed and what determines if an application is sent to one of these units.

If you find your application is in one of these units or if you are having any examiner problems, Dr. Burke suggested the following:

- Note any procedural issues and bring these issues to the supervisor's attention. Once you are in front of the senior examiner you have an opportunity to present your prosecution points; and
- In the case of a supervisor issue, try writing the group director on a policy clarification mat.

## PTAB Bootcamp: A Primer of Milestones in a PTAB Trial

BY: **PTAB AND YOUNG LAWYERS COMMITTEES**

On Tuesday, July 5, the PTAB Committee and Young Lawyers Committee of the New York Intellectual Property Law Association held a joint virtual PTAB Bootcamp meeting.

In Session 1 of the PTAB Bootcamp, our panelists lead by Co-Chairs Charley Macedo and Ken Adamo, walked through the key procedural steps in a PTAB Trial, including both Inter Partes Review and PGR.

Our young lawyers discussed different steps in the process.

This primer is a great review on the latest in PTAB Procedures for newly admitted attorneys and experienced counsel.

## Hot Topics In Trademark & Copyright Law

BY: **TRADEMARK COMMITTEE**

On Wednesday, July 13, the NYIPLA Trademark Committee hosted the 2022 Half-Day CLE Program at King & Spalding LLP. Speakers discussed the latest topics in Trademark Law, which included:

- Update from the Trademark Trial and Appeal Board
- NFTs & IP - It's Complicated
- Combating Misrepresentations in Trademark Prosecution and Maintenance
- Update from the Copyright Office
- Understanding Sanctions - Prosecuting Inventions and Trademarks in Russia

## PTAB Bootcamp: A Primer Review Of PTAB Decisions

BY: **PTAB AND YOUNG LAWYERS COMMITTEES**

On Tuesday, August 2, the PTAB Committee and Young Lawyers Committee of the New York Intellectual Property Law Association held their second joint virtual PTAB Bootcamp meeting.

In Session 2 of the PTAB Bootcamp, our panelists lead by Co-Chairs Charley Macedo and Ken Adamo, walked through the key procedural steps for review of PTAB Decisions, including final written decisions in both Inter Partes Review and PGR.

Our young lawyers discussed different review options available for final written decisions by the PTAB from trials.

## Patent Law: Amendments to the Canadian Patent Law Rules

BY: **PATENT LAW AND PRACTICE COMMITTEE**

The Patent Law & Practice's Committee held their meeting on Friday, August 5th, 2022. Nick Bertram, an NYIPLA member and Canadian patent lawyer, discussed amendments to the Canadian Patent Rules. Nick discussed the amendments, which includes the possibility of requesting examination before October 3, 2022 to avoid the new fees; double patenting issues caused by the new changes; the lack of limit in the number of independent claims; and that multiple dependencies are not counted as extra claims for the purpose of calculating claim fees.

# Hot Topics for Congress and the USPTO: 101 Patent Eligibility and PTAB Director Review

BY: **AMICUS BRIEF COMMITTEE**

On Wednesday, September 14, the NYIPLA Amicus Brief Committee had a discussion on two hot topics: patent eligibility and Director review. The panel discussed patent eligibility across technologies, including in life sciences, after the Supreme Court's denial of certiorari in *American Axle* and the impact of the views expressed by the United States - urging the Court to grant certiorari to address what it views as the Federal Circuit's clearly incorrect interpretation of the Court's *Alice/Mayo* patent eligibility framework - going forward.

The panel also discussed attempts to remedy the current state of patent eligibility jurisprudence by the legislation in view of the Supreme Court's denial of certiorari. In particular, the panel discussed Senator Tillis' recent patent eligibility reform proposal, crafted specifically to address the Federal Circuit's application of *Alice/Mayo*.

The speakers also addressed the Director review process at the PTAB, created to implement the Supreme Court's decision in *Arthrex*, including available guidance, scope for review, interplay with Precedential Opinion Panel (POP) review, and the role of amici.

# WELCOME NEW MEMBERS

Last	First	Firm/Company/Law School	State	Membership
Abdool	Allaric	Rutgers School of Law- Newark	New Jersey	Student
Adrienne	Hennemann	New York University School of Law	New York	Student
Annabel	Kwek	New York University School of Law	New York	Student
Casey	Mefford	Brooklyn Law School	New York	Student
Christopher	Coulson	Skadden, Arps, Slate, Meagher & Flom LLP	New York	Active 3+
Dorothy	Whitney	Cowan Liebowitz & Latman, PC	New York	Active 3+
Francis	Rushford	Pretium Partners LLC	New York	Active 3+
Geiger	Caroline	Debevoise & Plimpton	New York	Active 3+
Hargreaves	Xanthia	New York University School of Law	New York	Student
Ilana	Faibish	Masur Griffiths Avidor LLP	New York	Active 3-
Jeffrey	Chery	Cowan Liebowitz & Latman, PC	New York	Active 3+
Jones	Daniel	Benjamin N Cardozo School of Law	New York	Student
Joshua	Mertzlufft	Mertzlufft Law PLLC	New York	Active 3+
Laurin	Buettner	Greenberg Traurig LLP	New Jersey	Active 3+
Lee	David	Carter, DeLuca & Farrell LLP	New York	Active 3+
Luo	Shijing	Jones Day	New York	Active 3-
Ogunrinde	Tola	George Washington University Law School	New York	Student
Onyebeke	Lynn	Willkie Farr & Gallagher LLP	New York	Active 3-
Orrantia	Sofia	Quinnipiac University School of Law	Connecticut	Student
Redding	Kate	Villanova University Charles Widger School of Law	Pennsylvania	Student
Remy	Leelike	Benjamin N. Cardozo Law School	New York	Student
Rosenthal-Larrea	Sasha	Cravath, Swaine & Moore LLP	New York	Active 3+
Samantha	Katze	Manatt, Phelps & Philips, LLP	New York	Active 3+
Sherli	Furst	Hunton Andrews Kurth LLP	New York	Active 3+
Sophia	Dudgeon	Benjamin N. Cardozo School of Law	New York	Student
Taylor	Green	Mandelbaum Barrett P.C.	New York	Active 3+
Tola	Ogunrinde	George Washington University Law School	New York	Student
Tracy	Remy	St. Johns University School of Law	New York	Student
Vera	Glonina	Benjamin N. Cardozo Law School	New York	Student
Weild	David	Locke Lord LLP	New York	Retired
Yann	Rim	Loyola Marymount University	California	Student

## MOVING UP & MOVING ON

- ▶ **Wendi Opper Uzar** has been promoted to partner at Riker Danzig Scherer Hyland & Perretti LLP.
- ▶ **Vanessa Hew**, formerly of Duane Morris LLP, has joined Cozen O'Connor LLP as a Member.

# EVENTS AND ANNOUNCEMENTS

## OCTOBER

10/28/2022

Patent Law: Patent Eligibility Restoration Act of 2022

## NOVEMBER

11/01/2022

PTAB Committee Meeting: USPTO Discuss Presenting Technology to the Patent Trial and Appeal Board

11/09/2022

One-Day Patent CLE Seminar

## NYIPLA Publications Committee Editorial Team

### *Committee Co-Chairs*

Kyle Koemm and  
Margaret Welsh  
Giselle Ayala Mateus

### *Board Liaison*

Patrice Jean

### *Committee Members*

Heather Bowen  
Dale Carlson  
Jayson Cohen  
William Dippert  
John Kenneth Felter  
Robert Greenfeld  
Richard Koehl  
Kyle Koemm  
Keith McWha  
Clint Mehall  
Suzanna Morales  
Calvin Wingfield  
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