LEASON ELLIS INTELLECTUAL PROPERTY ATTORNEYS

THE

Newtonian®

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FOR THOSE WHO KNOW

Industry turns to Leason Ellis for the intellectual property insight and counsel that helps businesses thrive. Discover the insights we're sharing about some of the recent cases that matter right now.

LETTER FROM THE EDITOR

Dear Friends and Colleagues,

Hopefully, the last few months since the Spring edition of The Newtonian have been rewarding for you and have included plenty of summer fun. Fall is now upon us, children are back to school (thankfully!), and after more than two years of remote work due to COVID, our attorneys are transitioning back to the office. Many of us are spending at least a few days in the office now and are embracing this new pattern of hybrid work schedules.

The core of The Newtonian is the case insights prepared by each of our practice groups. Both Litigation cases in this issue present insights gleaned from Leason Ellis victories.

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We hope you find value in this publication and the insights it contains. Please feel free to share The Newtonian with others, and to share your thoughts with us at **inquiries@leasonellis.com**.

Warmly,

Henry Gabathuler
Senior Associate
Editor, The Newtonian

FIRM DEVELOPMENTS

Leason Ellis Ranks High in the 2022 IAM Patent 1000

We're proud to report that IAM Patent 1000, a "go-to" resource for those seeking to identify world-class, private practice patent professionals, once again recommended Leason Ellis amongst all three categories of work: patent prosecution, litigation, and transactions.

IAM NOTED:

"Superbly well-rounded in patent practice, Westchester boutique Leason Ellis garners excellent reviews."

IAM quoted a firm portfolio management client: "The firm keeps us immediately informed of the progress of our matters and ensures that we don't lose track of things at our end, which enables us to have informed internal discussions and keep our portfolio in excellent shape. We have transferred all our work to the firm because it provides total solutions and saves our time and money."

"The professionals at Leason Ellis never contort anything with a view to just telling clients what they want to hear, but develop strategies to resolve problems, with a focus on the sustainability of business."

IAM also recommended eight of our lawyers for their work in patent prosecution, patent transactions and/or patent litigation: Elizabeth Barnhard, Dr. Susie Cheng, Dr. Michael Davitz, Ed Ellis, Mel Garner, Rob Isackson, David Leason and Yuval Marcus.

Leason Ellis’ Litigation Practice Group Welcomes Sara Gruber

Sara Gruber joins Leason Ellis as an Associate in the Litigation Practice Group. Her most recent litigation cases concern the unauthorized use of copyrighted materials in the music industry. Sara also has experience practicing before the U.S. Patent and Trademark Office, where she has filed hundreds of applications and responded to numerous office actions.

Sara received her Juris Doctor from the Benjamin N. Cardozo School of Law, and her Bachelor of Science from the Pennsylvania State University with academic honors. She majored in Criminology with a focus in Legal Studies and minored in Business. Before joining Leason Ellis, Sara worked in the intellectual property industry as an intern focusing on New York trademark and copyright law.

PRACTICE GROUP-SPECIFIC

PATENT

Principal Patent Organizations Align to Strengthen and Streamline Standard Essential Patent Dispute Resolution

"International standards, and the role of patents that are essential to them, play an important role in promoting a strong national and global economy," said USPTO Director Kathi Vidal. In July, the USPTO agreed to work with the World Intellectual Property Organization (WIPO) on joint efforts to facilitate the resolution of disputes related to standard essential patents (SEPs).

Why is this so important? First, technical standards (e.g., 4G, 5G, or WiFi) are essential for the technological compatibility of modern products. SEPs are patents held by an institution that are essential to practicing a technical standard. As part of the standards-setting process, patent owners agree to license SEPs on fair, reasonable, and nondiscriminatory (FRAND) terms. Second, given the potential value of SEPs and the standardized technology they cover around the world, SEPs are often the subject of patent disputes in the US and internationally. SEP disputes commonly arise when the licensing entity and the practicing entity do not see eye-to-eye on what a "fair and reasonable" royalty for a SEP would be.

INSIGHTS

- SEPs can provide tremendous value and market power to patent owners, but present unique challenges relating to licensing and enforcement.
- While the collaboration will promote the availability of alternative dispute resolution, courts will remain the predominate venue for SEP disputes.
- Obtaining a standard essential patent requires closely coordinated strategies for patent prosecution, standard submissions and licensing/enforcement.

Under the terms of the five-year agreement, the USPTO and WIPO will cooperate on Alternative Dispute Resolution (ADR) activities that will resolve disputed SEP matters by leveraging existing WIPO Arbitration and Mediation Center and USPTO resources. The agreement also calls for stakeholder outreach to raise awareness of the services provided by the WIPO Arbitration and Mediation Center through joint USPTO-WIPO programs.

"Our work with WIPO underscores the USPTO's view that SEP policy is an international issue of international importance," said Vidal. "This agreement will leverage existing resources at the USPTO and WIPO, supporting options to enhance the efficiency of licensing of standard essential patents, and promote resolution of disputes related to those standards."

New Canadian Patent Rules to Charge Excess Claim Fees Effective October 3, 2022

Canada has been a popular jurisdiction for patent filings because of its close relationship with the United States and reasonable filing fees. Previously, there were no fees payable based on the number of claims in a Canadian patent application, making it a relatively easy decision to file an application in Canada with a large number of claims. However, new Canadian Patent Rules, effective October 3, 2022, introduced an excess claim fee structure that requires applicants and attorneys to proceed strategically if they are keen on keeping fees down.

Under the new fee regime, excess claims fees will be payable twice during prosecution. First, CAD $100 is payable for each claim over 20 claims when the examination is requested. Second, when the issue fee is paid, CAD $100 is payable for each claim over 20 claims, based on the greatest number of claims that are pending at any time between requesting examination until the final issue fee payment. These excess claims fees apply only to applications for which examination is requested on or after October 3, 2022.

INSIGHTS

- Because Canada has relatively strict double-patenting rules and doesn't provide for continuation practice like the United States, a popular prosecution strategy has been to file an application with a large set of claims - to preserve the option to protect various invention concepts via the parent application or divisional application(s). This strategy can still be implemented, and fees mitigated by strategically amending the application to reduce the number of claims to 20 on or before requesting examination.
- Moving forward, Applicants can avoid excess claim fees by amending the application to reduce the number of claims to 20 before requesting an examination.
- When deciding a claims strategy, practitioners should consider Canada's strict double-patenting rules and lack of continuation practice.
- Applicants must ensure that the correct excess claims fees are paid at the time of requesting examination and at the time of final fee payment. Failure to pay correct fees on time can result in abandonment of the application.

Learn more about our Patent practice and meet the team

PRACTICE GROUP-SPECIFIC

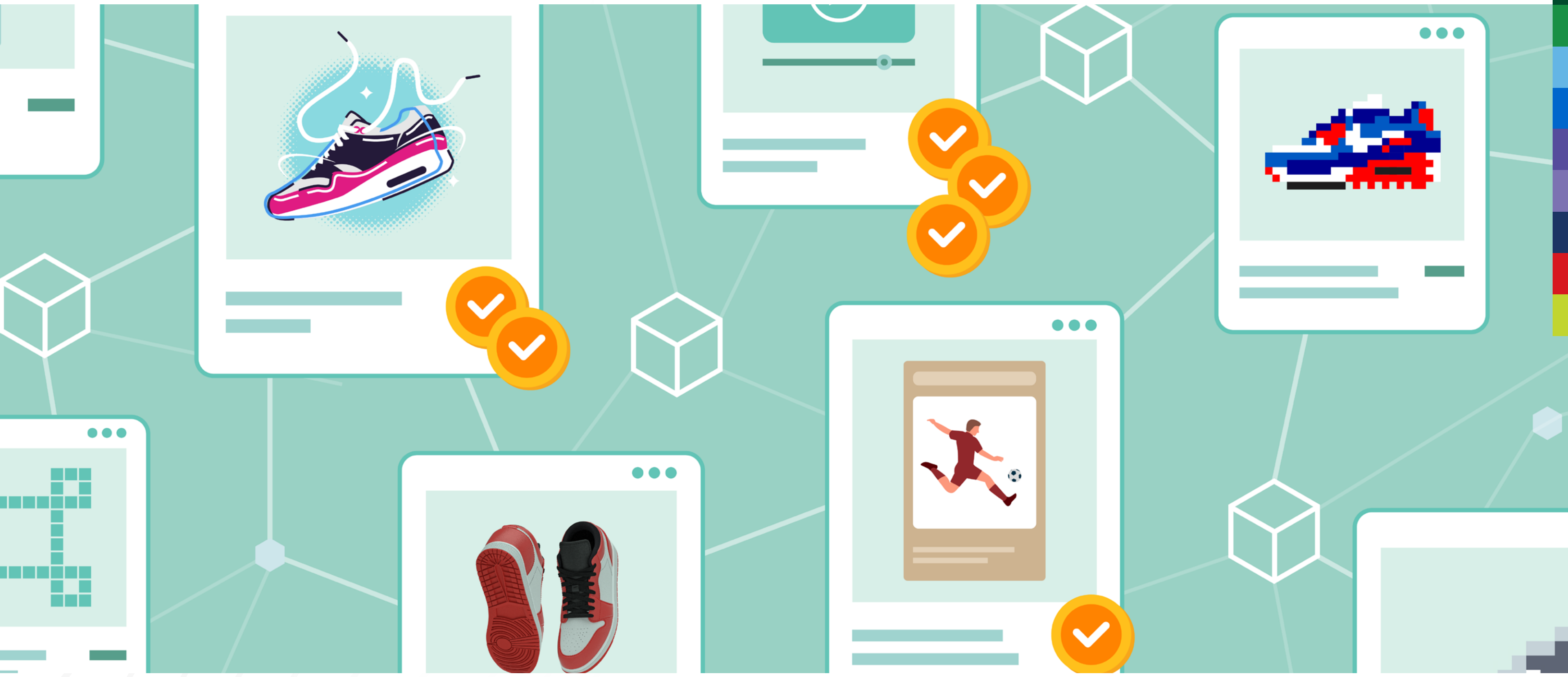
TRADEMARK

Nike Calls Foul on StockX for NFT Trademark Infringement

In a collision between a global sneaker behemoth and an online sneaker resale marketplace, Nike sued StockX in the Southern District of New York in February 2022, asserting claims including trademark infringement, unfair competition, and dilution. *Nike, Inc. v. StockX, LLC, 1:22-cv-00983-VEC.*

In its Complaint, Nike accused StockX (**https://stockx.com**), an online sneaker retailer, of using Nike's famous trademarks without authorization to market non-fungible tokens (NFTs). Specifically, Nike alleged that StockX bundled NFTs bearing Nike's trademarks with additional StockX services and unspecified benefits which Nike does not sell. Nike contended that the NFTs were branded assets that could be traded, collected, and displayed. Nike questioned whether StockX's NFTs can be readily traded in for the associated physical shoes, contradicting StockX's claims that the NFTs are simply authentication tokens for physical shoes.

In its Answer, StockX argued that Nike fundamentally misunderstood its business model. StockX explained that the NFTs in question are used merely to authenticate actual product; they "are absolutely not 'virtual products or digital sneakers'." StockX further contended that its NFTs have "no intrinsic value," functioning effectively as a "claim ticket" to access the underlying physical item. Arguing that each NFT and product page prominently displays the StockX trademark, StockX claimed that its use of Nike's trademarks and sneaker images in its NFTs constitutes nominative fair use, functioning like product pages or advertisements on any other e-commerce site depicting and describing a good for sale.



In May 2022, Nike amended its complaint to add claims for counterfeiting and false advertising. Nike pointed to changes that StockX made to its site and to the fact that Nike itself had begun marketing NFTs. Nike further alleged that it purchased counterfeit sneakers from StockX, one pair of which corresponded to the NFTs at issue. StockX answered in June 2022. The case remains pending.

As one of a handful of ongoing cases involving trademark infringement claims with respect to NFTs, this case has the potential to shape key intellectual property issues surrounding digital assets, especially the scope of a brand owner's right to regulate unauthorized uses of its trademarks in NFTs.

INSIGHTS

- Major brands are assessing if, when, and how to take the plunge into the metaverse and the world of NFTs.
- Thorny questions will continue to crop up surrounding how to protect existing IP assets in the virtual world as well as how to protect new assets created for and existing solely in digital form.
- Brands expecting to participate in this ever-expanding universe should confer with IP counsel about seeking trademark registrations protecting virtual goods and services.

Second Circuit Finds RISE a Weak Mark for Energy Drinks Based on Statements Made During Trademark Prosecution

Rise. It's something we all do in the morning, and that's an issue for anyone seeking to monopolize the term as a trademark for drinks that help consumers wake up. In *Riseandshine Corporation d/b/a Rise Brewing v. PepsiCo, Inc.*, 41 F.4th 112 (2d Cir. 2022), the United States Court of Appeals for the Second Circuit vacated a preliminary injunction against PepsiCo from using the mark MTN DEW RISE for a canned energy drink. The Court held that the district court had erred in assessing the strength of the plaintiff's RISE mark and the similarity of the products.

The facts of the case showed that the plaintiff had launched the first cans of its RISE branded nitro-brewed coffee in 2016. It now sells the canned beverages nationwide and has registered the mark "RISE BREWING CO" with the United States Patent and Trademark Office (the "USPTO"). In January 2021, Rise Brewing learned that PepsiCo planned to launch a fruit-flavored canned energy drink under the mark MTN DEW RISE ENERGY. Undeterred by Rise Brewing's cease-and-desist letter, the defendant launched its MTN DEW RISE ENERGY beverage in March 2021 and sold it in over 170,000 retailers across the country. The plaintiff subsequently filed suit and moved for a preliminary injunction, which the district court granted, enjoining the defendant from using the challenged mark in the market pending trial. On appeal, the appellate court vacated the injunction.

Plaintiff had argued that the defendant's use of the word "Rise" created a likelihood of "reverse" confusion in that PepsiCo's use of the word "Rise" was likely to result in consumers mistakenly concluding that plaintiff's coffee drink was a Mountain Dew product. To evaluate claims of consumer confusion, whether forward or reverse, the court employed the familiar eight factors set out in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961):

1. **The strength of the plaintiff's mark**
2. **The degree of similarity between the two marks**
3. **The proximity of the products**
4. **The likelihood that the plaintiff will bridge the gap**
5. **Actual confusion**
6. **Defendant's good faith in adopting its own mark**
7. **The quality of the defendant's product**
8. **The sophistication of the buyers**

Upon evaluating these factors, the district court found that plaintiff had established a likelihood of success on the merits and granted the injunction.

The appellate court disagreed. It found the district court had abused its discretion when evaluating what is often considered the most crucial factor—the strength of the plaintiff's mark (as well as in its finding of similarity in the appearance of the products). The appellate court found no error in the district court's determination that the plaintiff's mark is "suggestive," but that, despite being a suggestive mark, because the word "Rise" is so tightly linked with the perceived virtues of coffee (e.g., after consuming caffeine, one's energy levels can be expected to "rise"), the mark is inherently weak and commands only a narrow scope of protection.

In granting the preliminary injunction, the district court had discounted the weight of the plaintiff's statements to the USPTO regarding third-party coexistence because "courts do not bind parties to their statements made or positions taken in ex parte application." However, the appellate court took a decidedly more skeptical view: "Now, having registered its trademark, Plaintiff argues that there is no such room for multiple 'Rise' marks to coexist peacefully, even outside the coffee sector. That is not persuasive. If there were room for plaintiff's use of 'Rise' in the already crowded coffee field, there would also be room for defendant's. . ." Thus, the plaintiff had hoisted itself up by its own petard. The arguments it asserted to obtain registration came back to haunt it in its ability to enforce its rights against others.

INSIGHTS

- The decision is a reminder that arguments made in prosecuting trademark applications are a matter of public record.
- When defending clients against cases of a likelihood of confusion, it's important to scour the prosecution history of the trademark owner to find whether it has made admissions against interest. When found, they can be compelling evidence to raise in response to a demand letter or to rely upon in litigation.

Learn more about our Trademark practice and meet the team ▸

COPYRIGHT

No, It Can't Wait: Copyright Office Recommends Against Creating Deferred Registration Examination Option

In May 2021, Senate Judiciary Intellectual Property Subcommittee Ranking Member Thom Tillis requested that the Copyright Office study the costs, benefits, and feasibility of creating a new option for copyright registration where the examination of a claim could be deferred until requested by the applicant.

Proponents of a deferred examination option cite the costs of registering multiple works that photographers and other visual artists face as a deterrent from registering a significant portion of their works under the current registration scheme. Proponents also cite the potential benefit of conserving the Copyright Office's resources by eliminating the need to examine every application upon receipt. Other stakeholders, however, oppose a deferred examination option citing 1) potential adverse effects, including eroding the reliability of the public record given that many applications might never be examined, and 2) interference with the Library of Congress' collection by creating a scenario where the Copyright Office holds deposit copies of works indefinitely if the examination is deferred.

Ultimately, the Copyright Office did not recommend moving forward with a deferred examination option. The Copyright Office found that offering such an option would not necessarily result in cost savings since the registration system's efficiency would be lost when the full examination is delayed to a later date. In addition, such an option would create the risk of confusion regarding parties' rights, negatively impacting the reliability of the public record.

INSIGHTS

While a deferred examination filing option may not be on the horizon, the Copyright Office intends to evaluate a variety of new approaches, including:

1. Establishing a dynamic fee structure that could include lower fees for small-entity or individual filers
2. Expanding group registration options for certain types of visual artworks
3. Increasing the 750-word limit for the group registration option for photographs.

Copyright Office Announces Study to Evaluate Best Edition Rules

The Copyright Office has announced a study to evaluate the “best edition” rules as they apply to both the mandatory deposit requirement under 17 U.S.C. 407 and to applications to register copyrights under Section 408. By way of background, Section 407 requires copyright owners submit two copies of the best edition of a work to the Library of Congress within three months of publication. Under 408, copyright applicants must submit deposit copies of their works along with their applications; often, the deposit must be the best edition available. The Library relies on both sections to build up its collections. Notably, the legal obligation in 407 is separate from the option that copyright owners have to register their copyrights but registering a work with the Copyright Office will satisfy the mandatory deposit requirement. While some categories of works (but notably not the requirement to submit deposits) are exempt from the best edition rule in the context of copyright applications, many are not—and the best edition rules have been criticized as onerous. Best editions are generally physical copies of works; among other issues, this can result in increased expense and processing time for applications. The new study will explore whether additional categories of works should be exempt from the best edition requirement, how un-linking 407 and 408 might impact applicants and the Library of Congress, whether the Copyright Office should expand the options for submitting electronic deposits, what applicants would prefer, security concerns relating to these issues, and whether “best edition” under the Copyright Act can be interpreted to include digital files.

INSIGHTS

Unless and until the rules change, copyright owners should note the following:

- Failure to comply with 407 can result in fines.
- For deposits submitted with copyright applications, unpublished works and works that have only been published online are generally exempt from the best edition requirement. If a work has been published both electronically and in hard copy, the best edition rule will apply.
- Since the beginning of the pandemic, the Copyright Office has offered helpful relief to those who must submit physical deposit copies; https://www.copyright.gov/coronavirus/.
- The rules surrounding deposit requirements can be tricky. If you have questions about compliance with the Mandatory Deposit requirement or about what type of deposit is required with your copyright application, our attorneys can help.

Learn more about our Copyright practice and meet the team

PRACTICE GROUP-SPECIFIC

LITIGATION

It's a Matter of Fact: Judicial Notice May Disprove Conclusory Pleadings

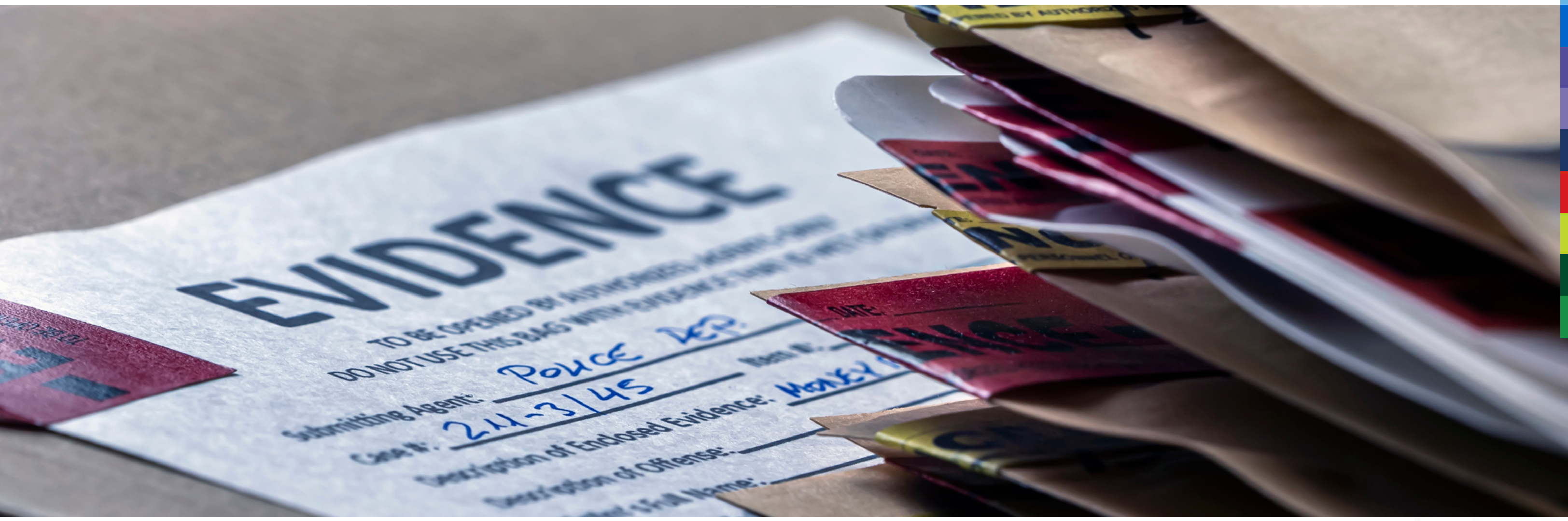
A LEASON ELLIS CASE

On behalf of a non-profit dedicated to preserving the legacy of Paul Rudolph, the late famed architect, Leason Ellis defeated a countersuit at the pleading stage and, in the process, prevented a former Board member and his copycat organization from reclaiming copyrights that Rudolph dedicated to the public.

The Paul Rudolph Foundation v. Paul Rudolph Heritage Foundation et al., No. 20 Civ. 8180 (CM) (S.D.N.Y.).

In a scathing 24-page opinion, Judge Colleen McMahon of the Southern District of New York agreed with Leason Ellis that the defendants had not only failed to plead eight of nine affirmative defenses plausibly but also each element of their copyright infringement counterclaim. While observing the defendants' repeated "failure to proofread their pleading" and improper usage of "upon information and belief" pleading, Judge McMahon further observed that the defendants' counterclaim was still conclusory, internally inconsistent, failed to give notice, and otherwise implausible based on public records, among other things. The defendants' argument that an Article III judge should decline to take judicial notice of publicly-available government records was also not well-received.

Critical to this early victory was Leason Ellis' ability to present judicially noticeable evidence in the form of pictures from the Library of Congress that disproved the defendant's specious ownership allegations. This crucial evidence showed that certain Rudolph materials that the defendants were claiming copyright in were already in the public domain, rendering the defendant's copyright registration "totally ineffective" and "not worth the paper on which it is written," according to Judge McMahon.



Judge McMahon dismissed the defendants' claims with prejudice, further denying leave to amend because, among other things, the defendants failed to submit a proposed second amended pleading. This failure eliminated the Court's ability to evaluate the futility of further amendments.

INSIGHTS

- Diligence relating to the chain of title and infringements is necessary before seeking registration or asserting a claim.
- Properly pleading one's case to a federal judge can often be equal parts art and science.
- Instances of copyright infringement must be pleaded with specificity; providing examples is insufficient.
- Pleading "upon information and belief" is inappropriate for matters within the pleader's knowledge or public record.
- While motions challenging the sufficiency of a claim are generally limited to the four corners of the pleading, external evidence can be used to disprove conclusory allegations if it is integral to the complaint, referenced in the complaint, in the pleader's possession, or judicially noticeable such as a public record.
- A pleader cannot create an "issue of fact" by pleading inconsistent statements regarding claim elements and then argue that the inconsistency bars dismissal at the pleadings stage.
- Requests for leave to amend must be specific and can often benefit from attaching the proposed amended pleading.

Strategic Motion Practice Sets the Stage for Courthouse Steps Settlement

A LEASON ELLIS CASE

On the eve of a bench trial before the Honorable Judge Lewis Liman in the Southern District of New York, Leason Ellis helped its client, Town & Country Living, amicably resolve its patent, trade secret and idea misappropriation, copyright, and breach of contract claims against HSN, Ingenious Designs and Joy Mangano after four years of hard-fought litigation.

Town and Country Linen Corp. et al. v. Ingenious Designs LLC et al., No. 1:18-cv-05075-LJL.

Leason Ellis obtained key victories for its client throughout the case. Early in the case, Defendants obtained dismissal of Town and Country's misappropriation of ideas claim—a significant monetary claim that carried the potential for punitive damages, based on an incorrect legal analysis by the Court. Recognizing the error and importance of the claim, Leason Ellis timely sought reconsideration. In a rare decision, the Court granted Leason Ellis' motion and reinstated the claim. This claim further survived the Defendants' summary judgment challenges and was headed to trial for a decision on the merits.

As another example, Leason Ellis obtained dismissal at the pleading stage and on summary judgment of numerous counterclaims and affirmative defenses. These victories included the dismissal of Defendants' breach of contract claim—the only counterclaim with potential monetary liability. Procedurally, the case was unique because the Defendants moved to dismiss the complaint, and because that motion was not decided until after the close of discovery, Defendants never filed an answer and counterclaims during discovery. Upon Leason Ellis' timely challenge to Defendants' Answer and Counterclaims, the Court granted Leason Ellis' request for sanctions for Defendants' failure to timely disclose their breach of contract counterclaim during discovery. Rather than pay Leason Ellis' fees to reopen discovery, Defendants chose to dismiss their claim with prejudice.

INSIGHTS

- Targeted reconsideration motions can be powerful mechanisms to correct errors without adding the significant expense and delay of an appeal.
- Timely disclosure of claims or defenses during discovery is necessary to avoid potential sanctions.
- Do more with less. Lean litigation teams help reduce redundancy and costs while keeping the entire team well versed in all aspects of the case.

Learn more about our Litigation practice and meet the team ▶

OF INTEREST

IN CASE YOU MISSED IT

Robert Isackson Joins Panel Discussion Titled “Hold On To Your Trade Secrets: The Winds Of Change Are Howling Around Employee Non-Compete Agreements” At The 2022 Intellectual Property Owners Association Annual Meeting

With today’s geographically dispersed workforce in mind, the panel discussed how companies can best comply with conflicting state and federal laws seeking to curtail employee non-compete agreements and provided guidance on how to protect trade secrets to the extent employee non-compete and related clauses are restricted and unavailable.

Yuval Marcus And Jordan Garner Interview On The New York Business Leaders Podcast Hosted By Gordon Coyle

The show focused on how Leason Ellis conducts intellectual property (IP) due diligence in mergers and acquisitions (M&A) transactions to help its clients understand the IP risks in a proposed acquisition or investment.

https://youtu.be/uFCCsxn3MEY

Joel Felber Speaks at TRTCLE Continuing Legal Education Webinar

In an event sponsored by TRTCLE, Joel Felber presented a 2-hour continuing legal education program addressing intellectual property law issues arising prior to, during, and after development of intellectual property, and strategic uses of intellectual property to gain a competitive edge, raise revenue, and be well-positioned for possible acquisition.

https://www.trtcle.com/live-cle/ny/2218/lifecycle-of-intellectual-property-creation-and-protection

Elizabeth Barnhard Sworn In As Director on the Board of Directors of the Westchester Women's Bar Association

Elizabeth Barnhard is proud to serve as Director of this chapter of the Women's Bar Association of the State of New York for a one-year term from June 1, 2022 through May 31, 2023. Elizabeth was sworn in by U.S. Magistrate Judge (retired) Lisa Margaret Smith.

Mel Garner Testifies as An Expert Witness on Behalf Of Fraunhofer-Gesellschaft before the World Intellectual Property Organization (WIPO) Arbitration Board — *Bastille LLC v. Fraunhofer-Gesellschaft*

Mel Garner testified as an expert witness on behalf of Fraunhofer in this arbitration, which was in the form of a trial that lasted five days and was conducted entirely by Zoom. The panel of the Board was in London and consisted of two attorneys from the UK and one from Texas. In its decision, the Tribunal credited Mel's opinions on three key topics: 1) filing of foreign patent applications, 2) the sufficiency of a U.S. Patent Application prepared by another firm, and 3) Fraunhofer's disclosure of nearly 30 inventions to the opposing party.

Bastille LLC v. Fraunhofer-Gesellschaft before the WIPO Arbitration Board

Mel Garner Testifies as An Expert Witness on Behalf of Skechers USA Before the Wisconsin Tax Appeals Commission — *Skechers USA v. Wisconsin Department of Revenue*

The question at issue is whether Sketchers USA's payment of IP license fees to its subsidiary IP holding company was deductible. The deduction of license payments to a subsidiary is acceptable so long as the subsidiary has a valid business purpose other than the avoidance of taxes, and Mel testified that the subsidiary did have other business purposes such as organizing and licensing the IP to third parties and management of the creation of the IP.

Marty Schwimmer Co-Authors the International Trademark Association's (INTA) Amicus Curiae Brief To The Supreme Court Urging The Court To Granting Certiorari Of The Petition By Jack Daniel's Properties Inc.

The petition in *Jack Daniel's Properties Inc. v. VIP Products LLC., 22-148*, seeks an appeal of a Ninth Circuit decision regarding the application of the Artistic Relevance test, best known as the Rogers Test, and whether the test should be applied to ordinary consumer products, in this case, dog toys. In the amicus brief, INTA proposes a definition for "Expressive work" under the Rogers Test, as previously argued by INTA in the Second Circuit appeal in *Vans, Inc. v. MSCHF Product Studio, Inc*.

Elizabeth Barnhard and Dr. Janet Falk (Falk Communications and Research) Deliver CLE Program "Why THAT Attorney and Not ME? How YOU Can Be the Attorney Reporters Call"

Elizabeth Barnhard spoke about ethical issues for attorneys of dealing with the media. She reviewed applicable New York Rules of Professional Conduct and Ethics Opinions and ABA Model Rules, and discussed illustrative examples.

Rob Isackson And Lauren Emerson Speak at The 38th Annual Joint Patent Practice Seminar June 15, 2022

Rob spoke about *Arbutus Biopharma Corporation et al v. Moderna, Inc. et al*. on whether claims for patent infringement related to the U.S. Government funded COVID vaccine purchases from Moderna are subject to suit in U.S. District Court or the Court of Federal and "Claims."

Lauren Spoke about *SAS Institute, Inc. v. World Programming Ltd* which concerns the copyrightability of software, and is regarded by some as the the highly anticipated sequel to *Google LLC v. Oracle America, Inc*.

https://www.jppcle.org/2022seminar.html

Lauren Emerson and Megan Bussy (Kilpatrick Townsend & Stockton) Presented panel on "IP and Your Next Deal" for the Dartmouth Lawyers Association

The panel discussed IP considerations in M&A transactions, the mechanics of due diligence and the types of issues that tend to arise.

Lauren Emerson Speaks along with Lesley Grossberg (Ice Miller) and Florian Traub (Pinsent Masons) on a Strafford CLE Webinar "Bad Faith in Trademark Registrations: Navigating Recent Changes in the U.S., EU and China"

The panel explored combatting bad faith filings in various jurisdictions. Lauren's portion focused on the types of filings and actions that are considered "bad faith" in the U.S. in a variety of contexts and highlighted recent actions taken by the United States Patent and Trademark Office to address particularly egregious filers.

https://www.straffordpub.com/products/bad-faith-in-trademark-registrations-navigating-recent-changes-in-the-u-s-eu-and-china-2022-07-12

Lauren Emerson Presents "Updates in Trademark Law" at the 47th Annual Intellectual Property Law Institute Program co-sponsored by the ICLE and the Intellectual Property Law Section of the State Bar of Michigan

Lauren's talk covered litigation and prosecution highlights and developments from the past year including the new *ex parte* proceedings available at the Trademark Office, the Office's administrative sanctions activities, Ohio State's registration of the word "THE", and recent court decisions.

https://www.icle.org/modules/store/seminars/schedule.aspx?PRODUCT_CODE=2022CI4710

Melvin Garner of Leason Ellis is joining David Kappos (of Cravath, Swaine & Moore LLP and former Director of the USPTO) and others on a panel discussion titled "Celebrating 125 years – Looking Back and Looking Ahead" at the American Intellectual Property Law Association's 2022 Annual Meeting on October 28, 2022, 9:00 AM – 10:00 AM, National Harbor, MD 20745

WHAT'S AHEAD

Lauren Emerson is teaching two courses at the AIPLA Design Rights Boot Camp (Virtual) (November 3, to 17, 2022).

Lauren will be presenting an introduction to copyright course, *"Copyright 101,"* and advanced course *"Crumbling the Cookie and Splitting the Banana: Lettuce Discuss Challenging Separability in Copyright and Functionality in Trade Dress Litigation."*

https://www.aipla.org/detail/event/2022/06/23/default-calendar/2022-design-rights-boot-camp

Drop Us A Line

We're always thinking and know you are too, so we welcome your comments, questions, and suggestions. As a firm dedicated to the application of keen insight in intellectual property law and business, our goal is to make The Newtonian a useful periodical that you read and share. Reach us here:
inquiries@leasonellis.com

About Leason Ellis

Clients engage Leason Ellis to obtain outstanding legal counsel to protect and enforce their intellectual property rights. Our specialized practice area excellence comes from a keen appreciation for inventiveness, creativity, branding, a profound understanding of the law, and a powerful commitment to using IP to help our clients achieve their business objectives. Learn more about Leason Ellis here:
www.leasonellis.com

Leason Ellis LLP
One Barker Avenue
White Plains, New York 10601
T 914.288.0022