LEASON ELLIS INTELLECTUAL PROPERTY ATTORNEYS

THE Newtonian®

ISSUE #36, SUMMER 2024

Registering Your AI-Generated Work?

Also in This Issue:

LETTER FROM THE EDITOR

Dear Friends and Colleagues,

Steve Jobs famously said, “This is what customers pay us for—to sweat all these details.” That’s pretty much the day-to-day experience of a Leason Ellis attorney, and that notion is the throughline of the case discussions in this issue. To what extent can New York employers contract to own employee inventions? How will the USPTO’s proposed trademark filing fee structure affect trademark filing strategy? How will developments in Chinese law impact brand owners in that important market? You guessed it. The answer in each of these scenarios is: it depends. The practice group insight discussions in this edition flesh out the details for you. The story featured on the cover is about another hot topic: registering a copyright on a work created using AI.

The issue kicks off with Firm News, where we share summaries of three positive results Leason Ellis has recently helped clients achieve. As usual, we wrap up with In Case You Missed It—an overview of some of the activities our attorneys have undertaken since our last issue.

We hope you find value in The Newtonian. Please feel free to share it with others and to send your thoughts to us at inquiries@leasonellis.com.

Warmly,

Henry A. Gabathuler
Partner
Editor, The Newtonian

FIRM NEWS

Leason Ellis Litigation Teams Score Substantial Motion Practice Victories for Clients

***Tianhai Lace Co. LTD et al v. Zoetop Business Co. Limited et al*, 2:22-cv-06106-HDV-MRWx**

On March 8, 2024, Leason Ellis' tremendous effort, particularly that of **Associate Stefanie Garibyan**, paid off as a win opposing a motion to enforce a settlement proposal resulting from a mediation session held in June 2023. Leason Ellis persuasively argued that ongoing negotiations indicated that the settlement was not final—for example, in a joint case management statement, the parties had communicated to the Court that negotiations and possible further litigation were still pending. The court found that the parties did not intend to be bound by the mediator's proposal without a finalized, signed agreement, determining that the proposal was not enforceable as a binding settlement. Consequently, the court denied the opposing counsel's motion to enforce the settlement and lifted the stay on the case.

***eTrailer Corporation v. Unbeatablesale.com, Inc.*, 3:21-cv-10172-RK-RLS**

On March 8, 2024, primarily as a result of adept motion practice from Leason Ellis **Partner Henry Gabathuler**, the United States District Court for the District of New Jersey, presided over by Judge Ronnie Abrams, granted motions to dismiss filed by the Leason Ellis team on behalf of their client Cequent Performance Products, Inc. The Court resolved the matter without the need for oral argument, determining that the claims within Unbeatablesale.com, Inc.'s Amended Third-Party Complaint against Cequent and five other third-party defendants did not hold.

***Interparfums Luxury Brands, Inc. v. Renee Gabet and Annie Oakley Enterprises, Inc.*, 1:23-cv-06269-PKC**

On March 13, 2024, Leason Ellis earned a favorable decision by the United States District Court for the Southern District of New York, wherein a motion by the defendants to dismiss or transfer the case to the Southern District of Indiana was denied. Leason Ellis client and Plaintiff Interparfums Luxury Brands, Inc. initiated the action seeking declaratory relief that its conduct did not infringe on the SUNSET trademark allegedly owned by defendants Renee Gabet and Annie Oakley Enterprises, Inc. and for a declaration of exceptional case status justifying attorneys' fees. Leason Ellis persuasively argued that the court should not exercise its discretion to dismiss or transfer the action, giving deference to Interparfums' choice to litigate in its home forum in New York while noting the efficiency of staying local.

PRACTICE GROUP INSIGHTS

PATENT

Employee Invention Assignment Agreements Face Stricter Scrutiny Under New York Employee Protection Laws

By Vera Glonina and Robert M. Isackson

Employment agreements, particularly intellectual property rights assignment provisions, are essential tools for employers to secure their valuable intellectual property assets. Well-crafted IP assignment provisions usually ensure that any invention created by an employee during their employment automatically belongs to the employer. However, new employee-protection laws, such as New York Labor Law Section 203-f ("Section 203-f"), require employers to reevaluate and carefully review the IP assignment provisions in agreements with their employees to address how "inventions" are defined and handled.

Specifically, Section 203-f enacted in 2023 in New York renders unenforceable a provision in an employment agreement that would require an employee to assign to the employer the employee's rights to inventions that:

1. The employee developed entirely on the employee's own time and
2. Without using the employer's equipment, supplies, facilities, or trade secret information.

However, there are some exceptions to this blanket prohibition, and employers can still require an assignment from the employee under one of two conditions, namely if the invention in question:

1. Relates directly to the employer's actual or "demonstrably anticipated" research or development ("at the time of conception or reduction to the employer's business") or
2. Results from any work an employee performs for the employer.

Suppose an engineer of a large motor vehicle company that focuses on sports car production signed an employment agreement assigning their inventions to the company and works on developing automobile-related products as part of their job duties. After work hours, the engineer continues working on this project using all information available as part of their job duties. The result of this work will fall under either exception, and the company would likely have valid ownership rights to the inventions created by the engineer. However, if the engineer, without using any company's resources or confidential information, creates an innovative motorcycle in their garage, the company would likely be unsuccessful in claiming any ownership rights on this unrelated invention.

The most challenging cases, however, would arise when an employee uses certain confidential information or resources of the employer (e.g., engineer had access to auto manufacturer employer information on how to use a transmission to improve fuel mileage and acceleration in a car) to work on otherwise an unrelated project (e.g., development of motorcycles with certain similar features) or, quite the opposite, creates on their own a substantially similar development (e.g., works on automobile's safety improvements) but based on totally different information and sources than those provided by the employer. In these not so clear-cut cases, the chances for the employer to secure the rights on the developed IP asset directly depend on the proper drafting of the IP assignment provisions as well as formalization of other employment-related and confidentiality documents. Overall, Section 203-f impacts agreements with employees involved in development and production requiring employers to carefully review all processes aimed at protecting assets.

PATENT INSIGHTS

Employers might benefit from reviewing and redrafting specific provisions in employment agreements (e.g., specifying certain definitions (such as “invention”) and including clear severability provisions). Also, it might be helpful to ask employees at the time of hiring to disclose any prior and current independent inventions that might arguably be related to the company’s business, to make clear that the identified inventions are outside the scope of the employee’s obligation to assign inventions to the employer.

There is little guidance on the scope of “freedom to invent” statutes even though New York and ten other states (California, Delaware, Illinois, Kansas, Minnesota, Nevada, New Jersey, North Carolina, Utah, and Washington) have enacted similar statutes. We will see whether emerging case law interpretations will vary substantially from state to state.

Section 203-f uses the term “invention” but does not define it. Although “inventions” are typically considered within the realm of patent law, there are both patentable inventions and non-patentable inventions. Courts might interpret this term broadly to include any employee creations (e.g., designs, software code, ideas, etc.), whether patentable or not. It may require some case law development to assist in understanding what “invention” means.

It is in the realm of possibility that courts may apply Section 203-f to contracts with non-W2 employees if, under traditional totality-of-the-circumstances analysis, the degree of an employer’s control of these employees demonstrates that they are not merely independent contractors.

Section 203-f does not create a private right of action and thus is likely to arise in the case where an employer sues the employee (or former employee) to enforce its right of assignment. Nor does Section 203-f specify any other remedies, except with respect to the enforceability of the IP assignment. Section 203-f is likely to be implicated in patent infringement, trade secret, and idea misappropriation actions involving employees’ inventions.

Before enacting Section 203-f, in case of disputes involving employees' inventions, employers might rely on several defenses, including the "shop right" doctrine, which allows employers to use employees' inventions that are created with the use of employer's time, equipment and resources, although it does not grant any exclusive rights on such inventions. However, in light of the Section 203-f requirements, **courts might interpret the "shop right" requirements more restrictively and preclude employers from using employees' inventions** that are not related or anticipated, although created with the use of certain employers' resources. This concern might be especially worrying in case an employer uses overly broad language in the assignment agreement and courts might interpret this language under Section 203-f as preempting the "shop right" doctrine.

PRACTICE GROUP INSIGHTS

TRADEMARK

USPTO Proposes New Fee Schedule for Trademark Applications

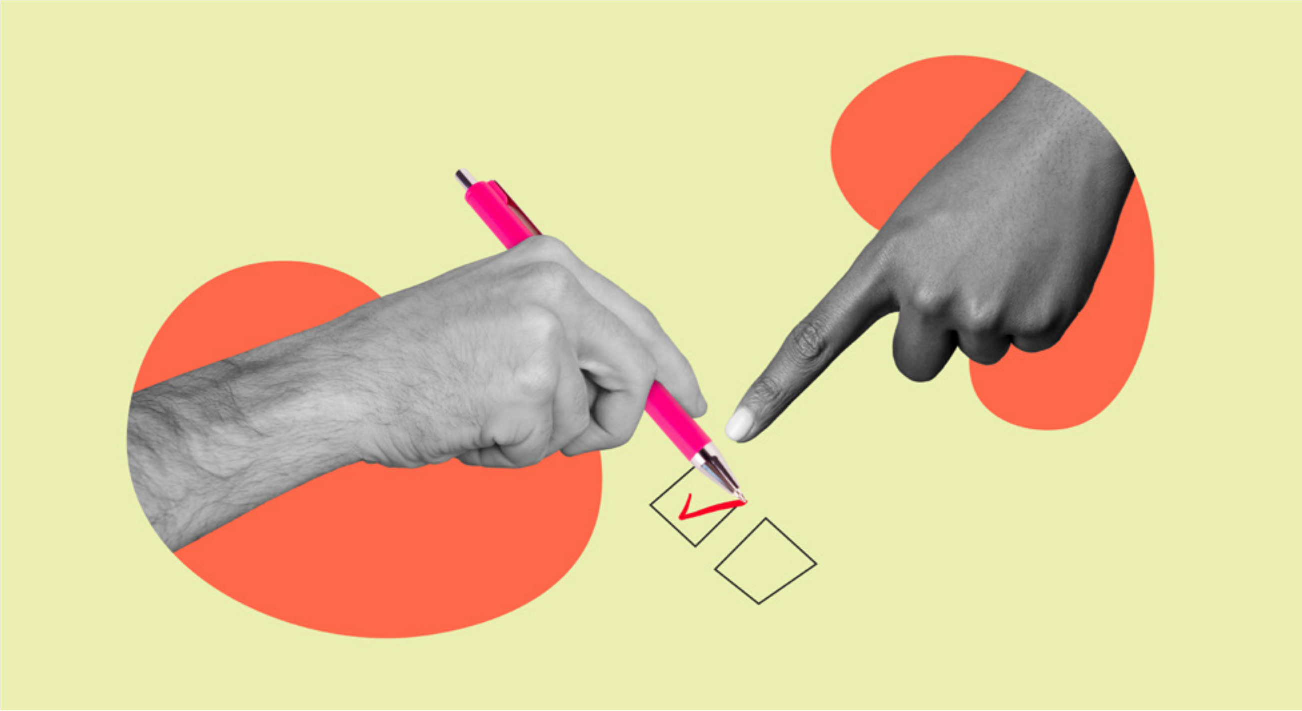
  

By Kevin M. Wallace, Audrey E. Trace, Matthew L. Frisbee

On March 26, 2024, the U.S. Patent and Trademark Office ("USPTO") issued a notice of proposed rulemaking to increase fees for many types of trademark filings. The proposal is subject to public comments, and the subsequent Final Rule is set to go into effect on November 15, 2024, the start of the USPTO's next fiscal year.

The proposed fee changes include:

1. **Application filing fees**
    a. Eliminating the TEAS Plus and TEAS Standard distinction.
    b. Replacing TEAS with a basic filing fee of $350 per class.
    c. Discontinuing the $500 per-class filing fee for extensions of protection from International Applications and replacing it with the standard $350 per class basic application fee.
    d. New surcharge for free-form text identifications, not taken from the ID manual, of $200 per class.
    e. A new surcharge for "incomplete" applications of $100 per class.
    f. A new surcharge for free-form identifications over 1,000 characters of $200 for each additional 1,000 characters, per affected class.
2. **Intent to use application fee increases:**
    a. Amendment to Allege Use and Statement of Use fee increase from $100 to $150 per class.
3. **Letter of Protest fee increases from $50 to $250.**



4. Petition to Director fee increases from $250 to $400.

The USPTO's rationale for the fee structure includes four objectives: recoup the costs of processing applications and other filings, encourage applicants to file more "complete" applications, recoup costs for IT improvements, and reduce pendency.

The USPTO responded to commenter criticism by including a detailed list of information that, when missing from an application, would render the application "incomplete." This includes information such as applicant's domicile address, legal entity type, a signature on the application, and an acceptable identification of goods.

Ultimately, the USPTO's intentions are good: to increase efficiency of examination and to encourage accurate and complete trademark filings. However, effecting these intentions with surcharges and other fee increases creates a system that is more complex and less user friendly. Once implemented, trademark practitioners will need to reset client expectations on fees and prepare clients for the possibility of unexpected surcharges and fee increases as applications are examined under the new fee schedule.

TRADEMARK INSIGHTS

The proposed fee structure increases trademark filing fees and creates a series of possible surcharges, creating more complexity when filing trademark applications.

Initial Application filing fees increase for standard applications. The USPTO's proposed changes will increase the initial application fees for what was known as TEAS Plus to the current fee under TEAS Standard. The TEAS Plus filing fee was $250 per class if applicants used pre-approved identification language. The new basic filing fee of $350 per class covers this exact type of application for $100 more per class. The TEAS Standard filing fee of $350 per class for free-form identification now increases to $550 per class when adding the basic filing fee ($350) and the free form surcharge ($200).

The new surcharges add complexity to initial applications and prosecution. Under the proposed fee structure, per class application fees could range from $350 for a "perfect" application to as much as $850 or more if an applicant utilizes a free-form identification with 1,000+ characters and inadvertently omits information. There are multiple different combinations of surcharge fees that could apply to every application, although Applicants may not know what surcharges apply until the application is examined months later.

Applicants and the practitioners advising them will need to be diligent to avoid surcharges. It is essential that Applicants provide information about mark translations, alternate meanings, and correct address information, among other elements required in an initial application, to avoid potential surcharges. It is unclear if these new surcharges will be applied to applications filed only after November 15, 2024, or will be applied retroactively to applications filed before then, given the long examination pendency at the PTO.

The requirements apply to all application types, including those filed under the Madrid System, even though some of the required information is incompatible with Madrid-based filings. For example, an applicant cannot submit a consent to use of a living person's name or likeness through WIPO. Likewise, 37 C.F.R. 2.22(a)(19) would require an applicant domiciled outside the U.S. to designate a U.S. attorney as its representative, although there is no section for designating a U.S. attorney in a request for extension of protection. If the rule is applied literally, every extension of protection will be subject to a surcharge.

Applicants should be diligent and work closely with their counsel when preparing new applications. Applicants can create some sense of confidence in this new filing system by working closely with their trademark counsel to draft applications that meet the USPTO's high standards.

PRACTICE GROUP INSIGHTS

TRADEMARK

China: Two Things Brand Owners Should Keep in Mind in 2024

By Tommas F. Balducci

There have been two notable developments in the Chinese legal landscape, an important market for brand owners.

First, there has recently been uncertainty in the Chinese courts about whether original equipment manufacturers (OEM), which only export branded products without offering or advertising the goods in China, are subject to claims of trademark infringement.

Historically, Chinese courts have taken the position that simply manufacturing branded goods in China, without engaging in the Chinese market, did not qualify as "trademark use." In 2019, the Chinese Supreme Court held in the "Honda Decision" that OEM production in China alone qualifies as "trademark use." *Honda Motor Co Ltd v Chongqing Hengsheng Group Company & Chongqing Hengsheng Xintai Trading Co Ltd*, 2019. Various lower courts since followed suit, including the Ningbo Intermediate Court's "Juratek Decision" in 2021. *Laizhou Baoyi Machinery Co., Ltd. v Suzhou Runjun Trade Co., Ltd., 2022*.

Most recently, however, in the Zhongshan Intermediate Court's 2023 "FTSS Decision," the court held that such use was not "trademark use" subject to infringement claims because manufacturing products is an inward facing activity, rather a public market facing one, and as the OEM had exercised a certain amount of due diligence before manufacturing the allegedly infringing products. *Fila Sports Co., Ltd. v Hunan Jiahui Technology Co., LTD, 2023*. That said, it is anticipated that the FTSS Decision will be further appealed, and so this is surely an issue to watch in 2024.

Second, authentication of legal documents for use in China is now possible by apostille. Previously, Americans making trademark related filings in China had to have certain paperwork authenticated by a competent governmental agency. Documents like a Power of Attorney were required to be authenticated via legalization through a Chinese Embassy or Consulate in a process that could cost several hundred dollars per document and was cumbersome. As of November 7, 2023, China has begun accepting authentication of documents via apostille, an international system set up by the 1961 Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents. Each U.S. state has a designated office which handles apostille requests (usually the “Department of State” or “Department of Treasury” for the given state). The process to obtain an apostille is typically less expensive and quicker than legalization and, as of October 2023, estimated time frames for apostille requests in each of the 50 states and Washington D.C. was between one to four weeks.

TRADEMARK INSIGHTS

OEM: Manufacture of products under a mark not registered in China could potentially expose a party to infringement liability. Brand owners should consider securing a trademark registration in China before manufacturing products under that mark to mitigate such risk.

Authentication: China's adoption of the apostille makes preparing required paperwork for prosecuting and enforcing trademarks in China easier, faster, and somewhat less costly than legalization, and it better enables foreigners to meet strict deadlines for formality requirements and evidence.

PRACTICE GROUP INSIGHTS

COPYRIGHT

Claiming Copyright: What to Know Before You Apply to Register Your AI-Generated Work

By Sara E. Gruber

The Copyright Office has plans to update the Compendium of U.S. Copyright Office Practices to include AI-related registration examples. The Office will also be issuing a report on AI and Copyright, the second section of which will address issues related to copyrightability of works containing AI-generated elements. In the interim, the Office has released guidance on this issue (Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence, 88 Fed. Reg. 16,190, 16,192 (Mar. 16, 2023) ("AI Registration Guidance")), and it has published a handful of Review Board decisions regarding particular works that give insight into what the Office will and will not register.

The Office has consistently denied registration to works lacking human authorship. Per the Compendium of U.S. Copyright Office Practices, "The U.S. Copyright Office will register an original work of authorship, provided that the work was created by a human being … the Office will refuse to register a claim if it determines that a human being did not create the work." U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 306 (3d ed. 2021). The recent proliferation of generative AI tools has not changed this. Thus, the Office will not register works solely created by AI. The Office takes a more nuanced approach to works that are created in part by AI. As an initial matter, the AI generated aspects will not be protectable even if the overall work merits registration. Applicants are required to disclose (generally, and at a high-level) that AI was used if the AI-generated portions are more than *de minimis*, and applicants must limit their claims to the non-AI generated aspects. Refusal to do so is grounds for denial. Notably, two Review Board decisions address scenarios where the applicant did not disclose their use of AI, but the Office learned about it anyway.

By way of example, the work below was denied registration. (Second Request for Reconsideration for Refusal to Register Théâtre D'opéra Spatial, Copyright Review Board, SR No. 1-11743923581, September 5, 2023.) The applicant, Mr. Allen, did not disclose to the Office that the image below was created using the AI platform, Midjourney. The Office discovered the work's genesis because it garnered press for being the first AI-generated work to win the 2022 Colorado State Fair's annual fine art competition. When asked to disclaim the AI generated portion, Mr. Allen refused. Mr. Allen maintained that refusal over the course of two appeals arguing unsuccessfully, among other things, that he authored the underlying image created in Midjourney. The Office disagreed because, notwithstanding the myriad of prompts Mr. Allen entered to generate the image, prompts are not instructions that yield predictable results. Mr. Allen also contended that the Office's disclosure requirement was burdensome; the Office, however, does not require all of the explicit details regarding the use of AI in creating a work, it merely requires a brief statement.

Théâtre D'opéra Spatial

Mr. Ankit Sahni's Photograph (Input)

Vincent Van Gogh's The Starry Night (Input)

Suryast (Output)

Where AI is used and disclosed, the Office asks "whether the 'work' is basically one of human authorship, with the computer [or other device] merely being an assisting instrument, or whether the traditional elements of authorship in the work (literary, artistic, or musical expression or elements of selection, arrangement, etc.) were actually conceived and executed not by man but by a machine." U.S. Copyright Office, Compendium Of U.S. Copyright Office Practices § 313.2 (3d ed. 2021) (quoting U.S. Copyright Office, Report to The Librarian of Congress by The Register of Copyrights 5 (1966)).

An application to register *Suryast* was denied for lack of human authorship. (*Second Request for Reconsideration for Refusal to Register SURYAST*, Copyright Review Board, SR No. 1-11016599571, December 11, 2023). A human, Mr. Ankit Sahni, took the photo and used an AI tool to create a new image based on the photograph and Vincent van Gogh's *The Starry Night*. Mr. Sahni also chose the "variable value determining the amount of style transfer." In other words, he determined how much "Starry Night-ness" the output should have. The Office considered *Suryast* to be a derivative work of the original photograph. Notably, a registration for a derivative work only protects the new authorship, not the underlying work. Thus, the inquiry was whether the new work, *Suryast*, contained protectable authorship. Ultimately, the Office concluded that it did not. While Mr. Sahni had control over the input, he did not maintain sufficient control over the output. More specifically, he did not control the stylistic choices made by the AI platform, such as whether the sunset, clouds, and buildings from the original image would be included in the output, how they would appear if they were included, and in what color scheme they would appear. As the new elements in *Suryast* were authored by the AI, registration was denied.

COPYRIGHT INSIGHTS

Knowing what tools your employees/contractors use to create works, and how a work is created may impact copyrightability.

When applying to register a work containing more than *de minimis* expression created by AI, disclaim it.

Document how works are created so that you can substantiate human authorship claims.

For more relevant decisions regarding copyright and artificial intelligence, see the Copyright Office's decision in Zarya of the Dawn, U.S. Copyright Office, Registration No. VAu001480196, February 21, 2023 and the Review Board's decision in the Second Request for Reconsideration for Refusal to Register A Recent Entrance to Paradise, Copyright Review Board, SR No. 1-7100387071, February 14, 2022 (currently on appeal before the U.S. Court of Appeals for the District of Columbia Circuit).

PRACTICE GROUP INSIGHTS

LITIGATION

Federal Circuit Applies Extraterritoriality Analysis from WesternGeco to Find Patent Owner Not Entitled to Recover Royalties on Foreign Sales of Infringing Products Exported from U.S.

By Roland Rivera-Santiago, Ph.D.

United States Patent rights are territorial, and thus ordinarily apply to acts within the U.S. In limited circumstances, patent owners can overcome the presumption against extraterritorial application of patents to seek damages from foreign sales. Notably, in *WesternGeco LLC v. ION Geophysical Corp.*, 585 U.S. 407 (2018) (“*WesternGeco*”), the Supreme Court established a two-part analysis to determine whether a patent owner was entitled to recover lost profits damages on foreign sales of a product found to be infringing under 35 U.S.C. § 271(f)(2), which makes it an act of infringement to supply a component “especially made” for use in a patented invention from the U.S. knowing and intending that such component will be combined abroad in a manner that would infringe the patent if such combination occurred within the United States.

The *WesternGeco* two-part framework for deciding whether the application of a statute is impermissibly extraterritorial begins with the rebuttable presumption that the extraterritorial application of patent rights is not permitted. This presumption can be rebutted by clear congressional action, such as a statute that provides a clear indication of an extraterritorial application. If the presumption has not been rebutted, the analysis then proceeds to the second prong, where the “focus” of the statute, e.g., the conduct it seeks to regulate, is examined to determine whether the case involves “a domestic application” of the statute. “‘If the conduct relevant to the statute’s focus occurred in the United States, then the case involves a permissible domestic application’ of the statute, ‘even if other conduct occurred abroad.’” *Id.,* at 413 (quoting *RJR Nabisco, Inc. v. European Community*, 579 U.S. 325, 337 (2016)).

Recently, in *Brumfield v. IBG LLC*, 97 F.4th 854 (Fed. Cir. 2024) ("*Brumfield*"), the U.S. Court of Appeals for the Federal Circuit applied the *WesternGeco* extraterritoriality framework to a case in which the patent owner sought damages from foreign sales flowing from domestic infringement under 35 U.S.C. § 271(a), which makes it an act of infringement to make, use, offer to sell, or sell a patented invention within the United States. 35 U.S.C. § 271(a).

By way of background, at the district court level, IBG LLC ("Defendant-Appellee") was found to infringe software patents owned by Mr. Harris Brumfield ("Plaintiff-Appellant") by making and selling an infringing software product in the United States. See *Trading Technologies International, Inc. v. IBG, LLC*, 201 WL 2473809 (N.D. Ill. June 17, 2021). A jury awarded $6.6M to Plaintiff-Appellant for domestic infringement under § 271(a). The District Court, however, excluded a damages theory put forth by Plaintiff-Appellant's damages expert, namely, that Plaintiff-Appellant was also entitled to a reasonable royalty on foreign sales of software products that IBG developed in the U.S. and sold abroad. See *Brumfield, Trustee for Ascent Trust v. IB LLC*, 586 F.Supp.3d 827, 830-31 (N.D. Ill. 2022) (Post-Trial Opinion).

Plaintiff-Appellant appealed seeking, inter alia, a new trial on damages to expand their damages award to include a reasonable royalty on foreign sales of the software products and arguing that the district court should have applied the *WesternGeco* extraterritoriality analysis, rather than the principles the district court relied on from the Federal Circuit's previous decision in *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc*., 711 F.3d 1348 (Fed. Cir. 2013).

On appeal, the Federal Circuit affirmed the District Court's decision to exclude the damages theory involving foreign sales. However, in so doing the Federal Circuit applied the extraterritoriality framework set forth in *WesternGeco* which involved a foreign lost profits damages claim stemming from infringement under §271(f)(2), to the claims seeking foreign reasonable royalty damages stemming from infringement under §271(a). See *Brumfield v. IBG LLC*, 97 F. 4th at 870 (2024).

The Brumfield Court ultimately denied Plaintiff-Appellant's request for a new damages trial on grounds including that Plaintiff-Appellant's damages theory failed to establish proximate cause between the damages sought for foreign sales and a domestic act, as is necessary under *WesternGeco*. *Id.*, at 877-879. Specifically, the Court noted that "[t]he requirement of the [*WesternGeco*] framework that is dispositive here is that 'the infringement'—the focus of § 284, as the Court in *WesternGeco* repeatedly stressed—have the needed causal relationship to the foreign conduct for which recovery is sought." *Id.*, at 878. The Court further acknowledged that the necessary proximate causation is more than but-for causation, including the absence of remoteness*. Id.*, at 877. As for Plaintiff-Appellant's damages theory, the *Brumfield* Court concluded that Plaintiff-Appellant "… presented no focused, coherent explanation of the required causal connection to domestic infringement." *Id*., at 880.

LITIGATION INSIGHTS

The circumstances are limited in which patent owners can overcome the presumption against extraterritorial application of patents to seek damages relating to foreign sales.

Brumfield is the first example of the Federal Circuit applying the *WesternGeco* framework to a patentee's claim seeking a reasonable royalty on foreign sales of products accused of infringing under 35 U.S.C. § 271(a).

Brumfield reiterates that the *WesternGeco* framework requires a sufficient causal connection between the domestic act of infringement and the foreign conduct for which royalty damages are sought.

IN CASE YOU MISSED IT

Leason Ellis Associates Audrey Trace (Left) and Sara Gruber (Center) with Queen Elizabeth (Right) at FBA Conference

Leason Ellis Trademark Associates Attend Federal Bar Association Fashion Law Conference

Leason Ellis Trademark Associates Audrey Trace and Sara Gruber attended the Federal Bar Association Fashion Law Conference on February 15th & 16th. The conference was designed for attorneys interested in the intersection of art, fashion, and the law, and included several informative sessions on related topics.

Vera Glonina (Left), Audrey Trace (Center), and Sara Gruber (Right)

Leason Ellis Attorneys Attend INTA 2024 Pre-Annual Meeting Reception

Leason Ellis Trademark attorneys Lauren B. Emerson, Kevin Wallace, Audrey E. Trace, Sara Gruber, and then Law Clerk now Associate Vera Glonina attended the INTA 2024 Pre-Annual Meeting Reception in New York on March 20th. The reception, hosted by INTA, provided a great opportunity to connect with colleagues in advance of the INTA 2024 Annual Meeting in Atlanta in May.

Leason Ellis Partner Rob Isackson Moderates Panel of Federal Judges at Private Luncheon Prior to NYIPLA Judges Dinner

On March 22nd, Leason Ellis Partner Rob Isackson moderated a panel of judges at an exclusive NYIPLA event focused on "The Effects of Recent and Pending IP Law Developments on Case Management," specifically designed for the Federal Judiciary and select members. Former Undersecretary of Commerce for IP and ex-USPTO Director, Andrei Iancu, delivered opening remarks providing insight into patent legislation. The panel included Honorable Christopher J. Burke, Honorable J. Rodney Gilstrap, and Honorable Rebecca R. Pallmeyer, and discussed the impact of IP law changes on case management.

Attendees of the NYIPLA U.S. Patent Office luncheon in New York City

Leason Ellis Associate Roland Rivera-Santiago, Ph.D., Attends Luncheon with USPTO Commissioner Vaishali Udupa

On March 21st, USPTO Commissioner Vaishali Udupa and several other members of the U.S. Patent Office attended a luncheon in New York City to participate in a discussion on topics concerning the Office as part of an event sponsored by the New York Intellectual Property Lawyers' Association (NYIPLA). The luncheon, which Leason Ellis Associate Roland Rivera-Santiago, Ph.D., attended, touched upon a wide array of topics, such as upcoming initiatives and guidance documents, the status of proposed legislation governing patents, the USPTO's efforts to improve consistency of examination across art groups, and best practices for the filing of documents before the Patent Office.

Leason Ellis Trademark Associate Audrey Trace Spearheads Connecticut Bar Association Dinner Celebrating Pathways to Leadership for Women Lawyers

In March 2024, the Connecticut Bar Association celebrated the Pathways to Leadership for Women Lawyers Dinner. During this notable annual event, as a co-chair of the Young Lawyers Section Women in Law Committee, Leason Ellis Associate Audrey Trace had the honor, alongside her fellow co-chairs, to present the Ladder Award to Judge Evelyn M. Daly. The recipient is recognized for her dedication to "leaving the ladder down" for future generations of women lawyers, serving as a mentor and supporting the professional growth of less experienced colleagues in their legal careers.

Leason Ellis Associate Audrey Trace Leads NYIPLA Events Covering Summer Internships and Deposition Training

In April 2024, Audrey was featured as a speaker on the NYIPLA Young Lawyer's Committee Summer Internship Advice panel during the last committee meeting of the month. Additionally, on June 5th, 2024, Audrey Trace moderated a New York Intellectual Property Law Association panel discussion on deposition skills. The program featured a panel of three skilled attorneys who discussed deposition best practices, as well as their favorite tips and tricks for successfully handling a deposition. It also featured videos of depositions with a pause for commentary by the panelists.

Leason Ellis Trademark Partner Matt Frisbee Speaks on Making Section 2(f) Claims through Demonstration of Acquired Distinctiveness

On April 9th, Matt Frisbee spoke on a Strafford Publications panel in a program titled "Making Section 2(f) Claims: Demonstrating Acquired Distinctiveness." Matt and his co-panelist guided trademark counsel in understanding how the courts and the USPTO view the issue of secondary meaning in support of trademark registration. The panelists outlined approaches that work (and those that don't) in proving a protectable reputation.

Leason Ellis Life Science Patent Team Members Susie Cheng, Ph.D. and Jarryd Werts Attend Summer 2024 BIO International Convention

Leason Ellis Partner Susie Cheng, Ph.D., and Associate Jarryd Werts attended the BIO 2024 International Convention in San Diego June 3-6, 2024. The BIO International Convention is the largest and most comprehensive event for biotechnology, representing the full ecosystem of biotech with over 20,000 industry leaders from across the globe.

Leason Ellis Patent Counsel Elizabeth Barnhard Elected for Directorship in Westchester Women's Bar Association

Leason Ellis Counsel Elizabeth Barnhard has been elected to be a Director of the Westchester Women's Bar Association, a chapter of the Women's Bar Association of the State of New York, for the 2024-2025 term.

Leason Ellis Partners with Legal Services of the Hudson Valley to Support Low-Income Westchester Residents

This Spring 2024, Leason Ellis Associate Josh Montgomery began a bi-weekly partnership with Legal Services of the Hudson Valley (LSHV) to provide assistance to low-income and disadvantaged Westchester residents through LSHV's Pro Bono Housing Advice Clinic.

Leason Ellis "Monsters" Co-Ed Softball Team Back for 2024 Summer Season

On the heels of its greatest season ever (with a record of 3 wins and 11 losses), the Leason Ellis "Monsters" Co-Ed Softball Team is back on the diamond for its fourth season in the White Plains Co-Ed Spring/Summer Softball League. Here's to scoring as many "funs" as we do "runs!"

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 at 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 at leasonellis.com.

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