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LEASON ELLIS
INTELLECTUAL PROPERTY ATTORNEYS

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NEWS

IAM 1000 RECOGNIZES LEASON ELLIS AS ONE OF THE TOP PATENT FIRMS IN NEW YORK



We are proud to be recognized once again by IAM Patent 1000: The World's Leading Patent Professionals. The review describes us as "[h]arnessing deep technical expertise and excellent business judgement." It also highlights our practices in life sciences and litigation. Individual attorneys singled out for mention include David Leason, Elizabeth Barnhard, Susie Cheng, Michael Davitz, Melvin Garner and Robert Isackson.

[View the Ranking Here](#)

DR. BRUCE WAGAR JOINS LEASON ELLIS AS ASSOCIATE IN THE PATENT PRACTICE GROUP

Bruce joins us most recently from Finch & Maloney in Manchester, New Hampshire where he was an associate patent attorney. Previously, Bruce worked at Lewis Roca Rothgerber Christie. At both firms, he focused his practice on patent application preparation and prosecution in the areas of electrical, computer hardware and software, semiconductor, and mathematical sciences. Prior to his law firm positions, Bruce was a senior



Programmer/Engineer at IBM for 15 years and a graduate teaching assistant under an IBM Fellowship at the University of Michigan for 6 years. He earned his J.D. at Arizona State University College of Law, his Ph.D. in Electrical Engineering and Computer Science from the University of Michigan, Ann Arbor, and his B.S. in Mathematical Sciences from SUNY Binghamton.

FROM BIG LAW TO BOUTIQUE: THE RISKS AND OPPORTUNITIES OF A CAREER-CHANGING MOVE



For trademark counsel in private practice, the move from a large law firm to a boutique is a daunting one. In an exclusive interview with World Trademark Review, our own Lauren Emerson tells us about why the move, for her, was worth the risk.

[Read the Interview Here](#)

LEASON ELLIS HOSTS PRE-INTA ANNUAL MEETING RECEPTION

On April 11th, we hosted a reception in advance of the Annual Meeting of the International Trademark Association in Boston this May. Attendees exchanged valuable learning experiences and success stories from past Annual Meetings, networked and met new professionals with a common interest in trademark law, and chatted with friends and peers over cocktails and appetizers. Pictured here from left to right are Peter Sloane, Lauren Emerson, Deirdre Clarke, Chelsea Russell, Christina Sauerborn and David Leason.



MARTIN SCHWIMMER QUOTED IN NEW YORK TIMES ARTICLE ON TRADEMARK DISPUTE



On March 16, 2019, The New York Times ran an article titled "The Battle for the One, True 'Fire Cider,'" about a trademark dispute between a cider company and a group of herbalists. The herbalists claim that "fire cider" is a tangy and hot concoction which has been made for decades. Nevertheless, a cider company, Shire City, had registered the trademark FIRE CIDER for drinks and had asked that others not use the mark when selling commercially. In the article, our own Marty Schwimmer is quoted as saying that the herbalists are right to worry about their ability to continue to use the term: "The trademark owner might interfere with non-trademark use, such as the use of the term to describe a recipe in a cookbooks." Marty added that if the herbalists could document their use of fire cider before 2010, when Shire City claims to have first used its mark, they had a decent shot of winning.

[Read the Article Here](#)

SPEAKING ENGAGEMENTS

LAUREN EMERSON SPEAKS AT CONVENTION FOR BOOK LOVERS

On May 16th, Lauren Emerson spoke at Book Lovers Con in New Orleans, Louisiana. In an informative 90-minute session, Lauren and her co-panelist Margarita Coale broke down legal issues that every author needs to understand. Their talk was titled "Literature & The Law: What Every Author Should Know about Contracts, Copyright, Trademarks & More!" Attendees learned about contracts, business structure and intellectual property law.



MARTIN SCHWIMMER LECTURES AT FORDHAM IP CONFERENCE

The 27th Annual Intellectual Property Law & Policy Conference kicked off at Fordham Law School on April 25, 2019. On April 26th, Marty Schwimmer appeared on a panel discussing ICANN and rights protection mechanisms. Founded by Professor Hugh Hansen, and supported by the Intellectual Property Institute at Fordham Law, the Conference was one of the premier events in the IP community.

[See Event Details Here](#)

REAL TALK: HOW TO BUILD & PROTECT YOUR BRAND

Leason Ellis attorneys Yuval Marcus and Lauren Emerson participated on a panel on trademark law for the Westchester/Southern Connecticut chapter of the Association of Corporate Counsel at Mastercard on April 10, 2019. In-house lawyers from Mastercard, Charter Communications and One Jeanswear Group shared best practices for clearing, registering and enforcing their brands.



MEL GARNER SPEAKS AT PLI PROGRAM ON ADVANCED LICENSING ISSUES

On March 5, 2019, Melvin Garner participated on a panel at Practising Law Institute's "Advanced Licensing Agreements 2019" program. The panel addressed a breakout session titled "Analysis of a Technology License Agreement" and discussed topics such as key technology license provisions, avoiding common pitfalls, addressing confidentiality and trade secret issues, exclusivity, and more. The panel was part of a two-day program geared towards those who devote a substantial amount of their practice to licensing.



[Check Out the Event Overview Here](#)

ROBERT ISACKSON SPEAKS ON PATENT ISSUES FOR IPO

On February 13th, Rob Isackson served as a panelist in a live webinar of the Intellectual Property Owners Association titled "Technology Transactions after *Helsinn*." The panel provided insights on the Supreme Court's recent decision in *Helsinn v. Teva*, and recent Federal Circuit decisions, such as *Barry v. Medtronic* and *Medicines Company v. Hospira*, and practical tips on how to navigate on-sale bar issues in light of them.



[See the Event Information Here](#)

MATTHEW FRISBEE PARTICIPATES IN A WEBINAR PANEL ABOUT PRODUCT TRADE DRESS



On February 6, 2019, Matthew Frisbee spoke in a Strafford Live CLE Webinar titled "Product Trade Dress After Converse: Secondary Meaning and Infringement Redefined." The panel guided IP counsel on protecting product trade dress after the Federal Circuit's decision in *Converse Inc. v. Int'l Comm'n* (2018). It also discussed the court's new test for secondary meaning, factors to consider in determining whether a mark has acquired distinctiveness, and how the Converse decision places limits on trade dress infringement.

[View the Event Here](#)

LEGAL UPDATE

LEASON ELLIS SHOWS MEDICAL DIAGNOSTIC PATENTS CAN STILL BE OBTAINED IN THE U.S.

By Elizabeth Barnhard

The past several years have been very difficult for applicants seeking patent protection for medical diagnostic and prognostic tests in the United States. Such tests have value because their utilization of correlations based on biological material and/or data and diseases provides patients and their healthcare providers with information on the presence or absence of disease, the likelihood of progression, remission or survival, and other details that can be used to determine the best options for care and treatment of the patient. Prior to the U.S. Supreme Court decisions in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012) ("*Mayo*") and *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014) ("*Alice*") on subject matter eligibility of patents under Section 101 of the U.S. Patent Act, patents for novel and non-obvious medical diagnostics and prognostic tests could be obtained without issues of subject matter eligibility being raised. That paradigm changed after the *Mayo* and *Alice* decisions.

Jordan Garner and I successfully appealed the rejection of our client's invention on the ground of ineligible patent subject matter in *Ex parte Michael Donovan et al.*, Appeal No. 2017-005993 (PTAB March 2019). The invention is directed to methods for determining the effective treatment to administer to a subject with a cancer type by measuring protein values for that subject using an immunoassay imaging device and evaluating those values using an effective treatment model generated by using a machine learning application to evaluate the effects that the presence of multiple biomarkers within a population have on that population's resistance to specific cancer treatments. The machine learning application uses a linear discriminant analysis of population data to generate these models and as a result of this comparison to the population model, a treatment that will be clinically effective is selected for the subject. The original application was filed in 2010 before the *Mayo* and *Alice* decisions. When we filed the appeal in 2016, it was not foreordained that we would succeed. To understand why, some background is necessary.

Since 2012, the U.S. Supreme Court's *Alice/Mayo* test on subject matter eligibility of inventions has resulted in medical diagnostic and prognostic patents being invalidated by the courts and in patent applications not being granted by the U.S. Patent and Trademark Office ("USPTO") because the medical diagnostic and prognostic methods are determined to be directed to a natural law or to an abstract idea or both. Under the *Alice/Mayo* test, a claim is analyzed and if an element directed to a judicial exception is deemed to be present, then that element is extracted from the claim and the remainder of the claim is analyzed for an inventive concept to determine whether the additional elements "transform the nature of the claim" into a patent eligible application. If the answer is no to the analysis of the second step, then the claim will be held as patent-ineligible for being directed to a judicial exception.

Subsequently, the Federal Circuit Court of Appeals has repeatedly affirmed district court rulings finding a medical diagnostic patent invalid for being directed to ineligible subject matter. See, *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) ("*Ariosa*") (method for detecting paternally inherited cell-free fetal DNA (cffDNA) in maternal plasma or serum to determine fetal characteristics); *Cleveland Clinic Found. v. True Health Diagnostics LLC*, 859 F.3d 1352, 1361 (Fed. Cir. 2017) ("*Cleveland Clinic I*") (methods for characterizing the risk of atherosclerotic cardiovascular disease); *Athena Diagnostics v. Mayo Collaborative Services*, 2017-2508, (Fed. Cir. Feb. 6, 2019) ("*Athena*") (methods of diagnosing neurological disorders by detecting MuSK autoantibodies); *Cleveland Clinic Found. v. True Health Diagnostics LLC*, 2018-1218 (Fed. Cir. April 1, 2019; non-precedential) ("*Cleveland Clinic II*") (methods of identifying elevated levels of myeloperoxidase in blood). While recognizing that "promoting patent protection to novel and non-obvious diagnostic methods would promote the progress of science and the useful arts," and that "the public interest is poorly served by adding disincentive to the development of new diagnostic methods" (*Athena*, majority opinion at p. 15), the Federal Circuit has stated that its hands are tied by the U.S. Supreme Court's *Mayo* opinion that correlations between the presence of a biological material and a disease are laws of nature, and conventional or obvious steps employed in addition to the natural law is not enough to transform an unpatentable law of nature into a patent-eligible application of the natural law (*Ariosa*, concurring opinion; *Athena*, majority opinion). This line of reasoning is problematic for medical diagnostic inventions, which are often applying a newly discovered natural correlation, which may not involve improvements to existing techniques for detecting natural correlations, to deliver a tangible benefit to patients and healthcare providers.

The two step analysis in the *Alice/Mayo* test has been criticized because, as applied, the claim is analyzed piecemeal in two steps and is not being analyzed as a whole, an analysis that is detrimental when applied to medical diagnostic inventions. See, *Athena*, dissenting opinion at pp. 4-5. USPTO examiners have struggled to apply the *Alice/Mayo* test, with medical diagnostic and business method inventions rejected as subject matter ineligible at a very high rate. Part of the examiners' struggle is due to the increasing number of Federal Circuit decisions that identify subject matter as abstract or non-abstract in the context of specific cases, with similar subject matter being found to be abstract or not abstract in different cases. These conflicting decisions make it hard for patent examiners to apply the subject matter eligibility standard in a predictable manner.

To address this problem, in January 2019 the USPTO published revised examination guidelines on the application of patent subject matter eligibility in matters before the USPTO in an effort "to improve the clarity, consistency, and predictability of actions across the USPTO". Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 51 (Jan. 7, 2019) ("Revised Guidance"). The Revised Guidance defines the abstract idea exception to include mathematical concepts, certain methods of organizing human activity, and mental processes. The Revised Guidance provides a two-prong analysis to determine whether a claim is directed to a judicial exception. In the first prong, the examiner will evaluate the claim to determine if the claim recites any of the judicial exceptions, i.e., laws of nature,

natural phenomena and abstract ideas as defined in the Revised Guidance. In the second prong, the examiner will determine if the additional claim elements integrate the judicial exception into a practical application. This two-prong analysis analyzes the claim as a whole. If the examiner finds that the judicial exception is integrated in a practical application, then the analysis is finished and the claim is patent eligible. If the claim recites a judicial exception and does not integrate that exception into a practical application, then the examiner must continue the analysis under the second step of the *Alice/Mayo* test.

When we filed our appeal in 2016, the Examiner had rejected the claims as patent ineligible, asserting that the claims are directed to the abstract idea of “observing naturally occurring levels of protein biomarkers in patient samples and correlating them to a therapeutic response.” We argued that the pending claims were not simply directed to the abstract idea of observing naturally occurring levels of protein biomarkers in patient samples and correlating them to a therapeutic response, but instead carried out a specific, technology-based solution that overcame the problems in the prior art by increasing the amount of biomarkers used in an analysis while avoiding the increase in cost or complexity associated with adding another biomarker assay and further evaluating the patient against an analytical model generated from a population of patents instead of basing the treatment selection on direct measurement of biomarker values from samples from the patient and using the patient as the analytical reference. The only favorable court decision at the time we filed the appeal was *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) (“*Enfish*”), which held that the critical analysis for the subject matter eligibility of claims rests on the whether the claims are directed to an improvement in the technology field or the functionality of computers, or is directed to an abstract idea, for which computer are merely used as a tool.

The USPTO Patent Trial and Appeal Board (PTAB) decided our appeal nearly three years later in March 2019 and two months after the Revised Guidance was issued. Reversing the Examiner’s rejection of these claims as patent ineligible under Section 101, the PTAB in its analysis cited cases decided after our appeal was filed and the Revised Guidance, concluding that under the *Alice/Mayo* test and the two-prong analysis of the Revised Guidance, the claims contain a judicial exception that is integrated into a practical application and are therefore patent eligible. [The decision can be viewed here.](#) The Examiner subsequently allowed the claims. Our successful appeal demonstrates that, while still challenging, it is possible to obtain U.S. patents for inventions directed to medical diagnostic/prognostic tests and methods, and applicants should not be quick to give up on obtaining U.S. patents for these technologies.

TOWARDS A MORE MODEST MODICUM OF ORIGINALITY?

By Lauren Emerson

The Copyright Review Board (“CRB”) may be recalibrating toward a more permissive approach to registerability. This spring, the CRB issued a total of ten decisions; five reversed refusals to register designs previously deemed insufficiently original.

Notably, three of these decisions pertain to logos. Logos became a hot topic among practitioners last year when American Airlines sued the U.S. Copyright Office under the Administrative Procedures Act (“APA”) over its refusal to register a new logo:



The dispute was ultimately resolved when the CRB cited higher quality images of the design at issue (which allegedly emphasized the work's shading and color gradients) as a basis for reconsideration of the initial refusals, but the entire episode only seemed to confirm a long-perceived reluctance on the part of the Copyright Office to register logos.

In the most recent CRB reversal, the Board deemed two of three NBA Properties logos registerable.



Detroit Pistons Logo



Orlando Magic Logo



San Antonio Spurs Logo

Finding the Pistons logo registerable, the CRB pointed to "numerous colors" as well as "stylized shading." The Board also found significant the interaction of the basketball and the letter "D." Likewise, the Magic logo features four colors and shading. The design also includes a "double border in black and white that incorporates numerous star designs, an arrangement that is not common or intuitive." The Board cautioned, however, that because the Magic logo is "still relatively simple," it merits only thin protection, such as would protect against virtually identical copying. In contrast, the Spurs logo was refused registration. The CRB maintained the lines "merely conform[] to the size of the circle and help[] to create the standard appearance of a basketball." In sum, the combination of this design with a simple two-color presentation and letters failed to yield a protectable image.

With respect to all three designs, the CRB was not swayed by arguments concerning the symbolic associations of the logos, noting that the author's intent is irrelevant.

Unlike the NBA, neither the applicant seeking to register *Band of the Red Hand* nor the applicant for *Sandy Starfish* appear to have referred to their respective works as "logos" notwithstanding that the designs are also the subject of a trademark application and registration, respectively; rather, the decisions refer to "two-dimensional art," suggesting that the applicants may have sought to downplay this aspect of their designs before the Copyright Office.



Band of the Red Hand



Sandy Starfish

In reversing the refusals to register both of these designs, the CRB explicitly noted that its decisions were based "on the low standard for copyrightability articulated in *Feist*." The Board also made clear that each decision pertained only to the totality of the designs, and not to the designs' individual elements. The Board further expressed that the copyright in *Sandy Starfish* is "thin."

The two other recent reversals concerned sneaker designs and jewelry.

The first refusal to register adidas' Yeezy Boost 350 sneakers found that the designs lacked copyrightable authorship. The second refusal reversed course on that issue, but found the works lacked sufficient originality. On appeal, the CRB determined that the separable 2D and 3D designs were sufficiently creative and original.



Here, again, the CRB caveated that its decision concerned the registerability of the works as a whole and not the line, stripe, or swirl elements individually. Though the analysis was terse and offers little insight, the initial descriptions of the works as consisting of: "irregular black lines of various lengths and shapes on a gray fabric with a black semi-circle in the arch and an orange dotted stripe on an off-white heel loop" and "several grey lines in a wave pattern with a thick orange stripe on the outsole that fades towards the heel of the sneaker. . . [u]nderneath the outer cloth layer is an inner orange layer that adds intermittent orange coloring" perhaps shed some light on what persuaded the CRB to register the sneaker designs.

Finally, in a somewhat perplexing but not entirely atypical jewelry decision, the CRB addressed two applications to register bracelet designs filed by Ronaldo Designer Jewelry, Inc. Noting the nonstandard braiding pattern, the different colored beads, and the interaction of textured, smooth and beaded strands, the CRB found Ronaldo's *Forget Me Not* bracelet design possessed sufficient originality.



Forget Me Not



The Explorer

In contrast, the CRB found Ronaldo's *The Explorer* contained "few elements [...] arranged in a standard manner" and was not registerable.

Time will tell whether this slew of reversals truly signals a new approach. At a minimum, however, these recent decisions suggest that arguments highlighting shading, interactivity between various design components and irregularity may be an applicant's best bet when facing a refusal to register based on lack of originality.

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