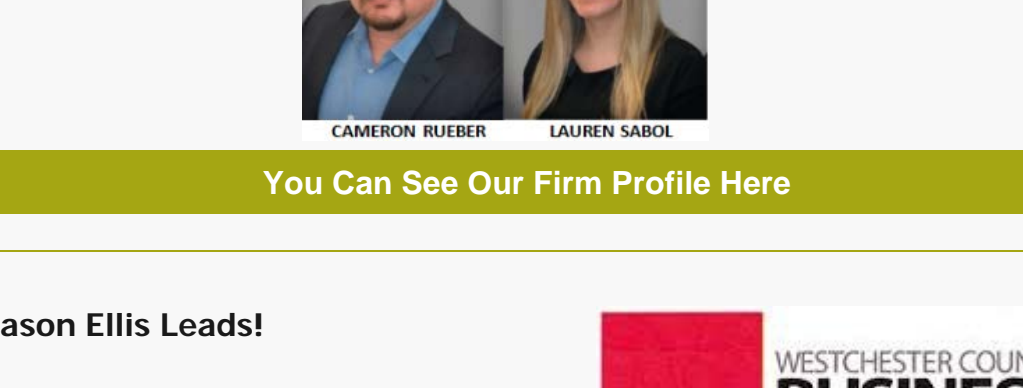


## The Newtonian®

ISSUE #19 | FALL 2016

### Seven Leason Ellis Attorneys Listed in 2016 Super Lawyers

Paul Fields, Melvin Garner, Adda Gogoris, Yuval Marcus and Peter Sloane were all named to Super Lawyers for 2016, and, in a sign of good things to come, Cameron Reuber and Lauren Sabol were named as "Rising Stars."



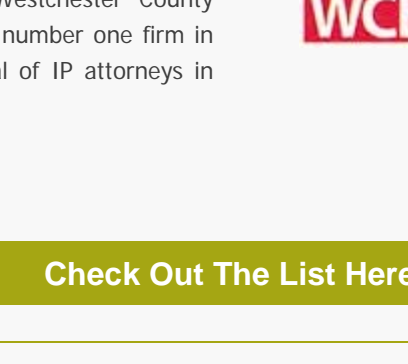
PAUL FIELDS

MELVIN GARNER

ADDA GOGORIS

YUVAL MARCUS

PETER SLOANE



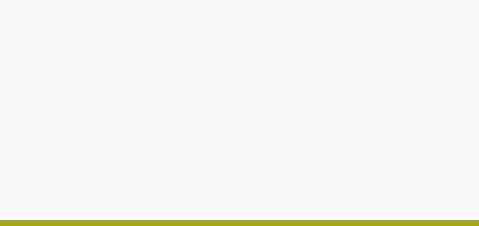
CAMERON REUBER

LAUREN SABOL

[You Can See Our Firm Profile Here](#)

### Leason Ellis Leads!

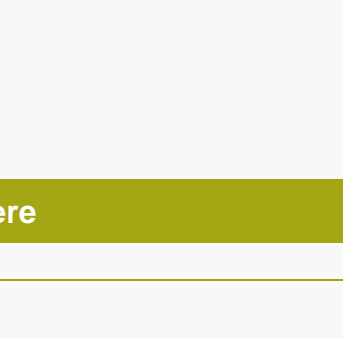
Leason Ellis leads the list of Intellectual Property Attorneys published by the Westchester County Business Journal. We are the number one firm in the County ranked by the total of IP attorneys in the firm.



[Check Out The List Here](#)

### IP for the Non-IP Practitioner

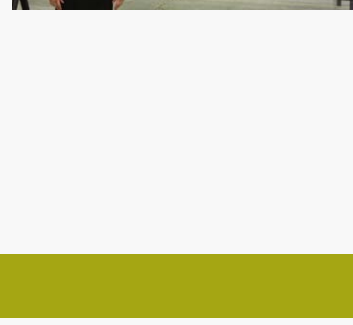
On November 3rd, we hosted a program called "IP for the Non-IP Practitioner" presented by the Intellectual Property Committee of the Westchester County Bar Association. Victoria Polidoro moderated and CLE was provided.



[See Event Details Here](#)

### Elizabeth Barnhard at the Global Biotechnology Congress

Elizabeth Barnhard presented a poster titled "Building Commercial Value in Changing Times" at the Global Biotechnology Congress in Boston on August 24th. Up to 1,000 of the world's leading scientists, researchers, industrialists and academicians, including several Nobel Laureates, in the fields of biotechnology and medical and biological sciences, attended the Congress to share and discuss new scientific ideas, products and breakthroughs.



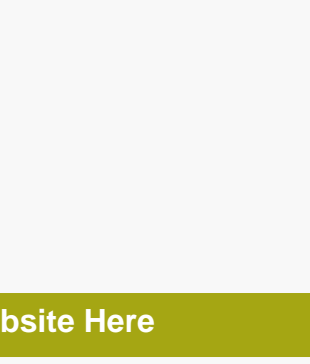
[View The Program Here](#)

### Pro Bono Litigation at Leason Ellis

We are pleased to report the settlement of a case in which we were selected as pro bono counsel by the Southern District of New York's Office of Pro Se Litigation. In this matter, Peter Sloane and Lauren Sabol represented New York-based fashion designers Matthew Mendoza and Christopher Toro in a trademark infringement case brought by a third party fashion designer over rights to the trademark LAVISH for apparel and accessories. At the close of expedited discovery, the parties reached an amicable settlement which allowed defendants to continue to use and register the trademark LAVISH NYC. In his Order of Dismissal, Magistrate Judge Cott expressed his gratitude to legal counsel for providing pro bono services. See *Villola v. Toro et al.*, No. 15-cv-4787. We look forward to serving the community and the Court on future pro bono matters.

### Michael Davitz Reflects on His Pro Bono Work

One day, I was sitting on the airplane in an aisle seat on a business trip to Germany, waiting for everyone to board. A very large man, well over 6 feet with broad shoulders, came up to me and asked to sit near the window. He squeezed into one of those small airplane seats and, atypically, as I usually sit quietly on airplane before a long flight, we struck-up a conversation. It turned-out that he worked at the Veterans Administration hospital and during his off hours had founded an organization to help wounded veterans learn to row. His stories took my breath away. By teaching wounded veterans how to row, he helped people who served our country with honor regain their independence. Over the next hour, he related stories to me about veterans who had lost their sight, arms, legs or were suffering from post-traumatic stress, who found their freedom on the open water. I knew immediately that I wanted to represent his group. Before we fell asleep on the transatlantic flight, I offered to represent Veterans Rowing *pro bono* as I wanted to give back in some small way to veterans who had given so much for our country. At Leason Ellis, we are happy to have helped Veterans Rowing obtain IP protection for its trademarks.



[Go To Veterans' Rowing's Website Here](#)

### Ed Ellis on the Challenges of Removing Infringing Products from Online Marketplaces

As online retail sales continue to grow and large e-commerce marketplaces such as Amazon and Ebay continue to dominate the e-retail experience, the increasing prevalence of counterfeit and infringing products appearing on these sites is becoming more problematic for these e-commerce giants, as well as their merchants. For the first time in its 20-plus year history, Amazon is suing merchants that are allegedly selling counterfeit items on its marketplace. On November 14, 2016, Amazon filed two lawsuits against two merchants purportedly selling counterfeits.



In the first lawsuit against ToysNet, Amazon contends that its fraud detection system flagged products from ToysNet as being fake versions of a patented moving product named Forearm Forklift. In the second lawsuit, Amazon partnered with the developers of TRX, a popular exercise fabric strap, to sue a merchant for falsely claiming that the products for sale were genuine TRX product.

In response to the lawsuit against it, ToysNet produced invoices to prove the items were not fake. However, Amazon claims that the produced invoices were forged. Given its past history of not bringing suit against merchants, the alleged passing of forged invoices may be the main impetus for Amazon's lawsuit against ToysNet. Of note, Amazon is the lone plaintiff against ToysNet and, therefore, the patent owner, which has seen a significant decline in revenue due to sales of cheaper knockoffs will have no monetary gain from the lawsuit brought by Amazon. In addition, even if Amazon is successful against ToysNet, there are still numerous other vendors on Amazon peddling fake Forearm Forklift products that will not be impacted by the decision and, thus, will continue to undercut the sales of the patentee.

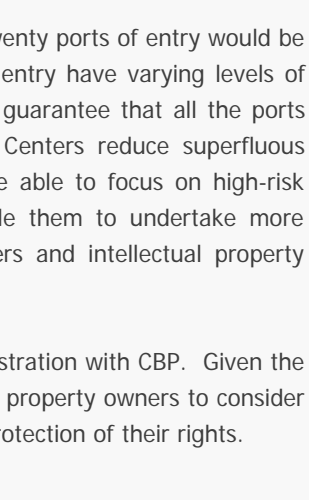
While these actions by Amazon are a step in the right direction, there are still many challenges facing merchants in trying to remove counterfeit and infringing products from the marketplace and these cases will likely have very limited implications and may be driven more by the unique set of facts presented. In particular, Amazon has been emboldened to decline takedown requests for counterfeit products by a recent court decision (*Milo & Gabby v. Amazon.com*) which held that Amazon did not "offer to sell" allegedly infringing products, and, consequently, was not liable for infringement of design patents, where Amazon did not communicate a description of products, did not set or communicate the price at which products could be purchased, did not set quantities of products for sale on its website, and did not communicate that it was willing to enter into a bargain to sell products. Despite the court's explicit discomfort in reaching its decision, this decision provided Amazon with further justification to routinely decline takedown requests submitted by merchants being harmed by counterfeit sales.

Despite the *Milo & Gabby* decision, companies continue to challenge Amazon in court regarding the sale of allegedly infringing products. For example, Daimler AG filed a lawsuit against Amazon in early 2016 for infringement of its intellectual property, including design patent infringement, for allegedly selling replica Mercedes wheels that were not authorized or sold by Daimler. The lawsuit is of interest since it claims that not only were the alleged infringing products available for sale on Amazon, but they were actually sold by Amazon itself. As a result, Daimler is trying to distinguish its case over the *Milo & Gabby* decision.

While Amazon and other e-commerce retailers invest millions in anti-counterfeiting efforts, more is needed to protect merchants that face many hurdles in removing fake products from the marketplace. *Milo & Gabby* appealed its case to the Federal Circuit, which will hear arguments from both sides this month, and therefore, the broad effect of this decision is still uncertain at this time. Moreover, Congress may be the true actor that can address this issue since, as the court properly expressed in the *Milo & Gabby* case, this is an example of where "the law lags behind technology."

### Emily Stein On U.S. Customs and Border Protection Centralizing IP Rights Enforcement Efforts

In 2016, U.S. Customs and Border Protection (CBP) added six new Centers of Excellence and Expertise (Centers) to the existing four in an effort to coordinate enforcement of intellectual property rights country-wide. Each Center specializes in a specific industry, such as electronics, allowing importers and intellectual property owners to deal with their assigned Center only, instead of each port of entry individually. The Centers are virtual, which means goods may be imported through multiple ports, regardless of industry. In addition, importers dealing in multiple industries can coordinate with multiple Centers according to their needs. The program provides a boon to importers and intellectual property owners tasked with the onerous burden of intercepting and policing counterfeit and grey market goods.



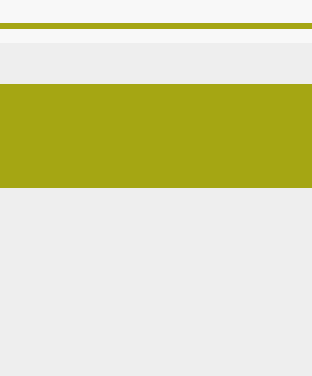
Previously, if an issue was discovered, an importer bringing goods through twenty ports of entry would be required to submit a protest in all twenty ports. Worse, because ports of entry have varying levels of experience and knowledge as to different types of products, there was no guarantee that all the ports would issue consistent decisions. By creating one point of contact, the Centers reduce superfluous transaction costs and provide more certainty. In addition, the Centers are able to focus on high-risk shipments which, together with the Centers' specialized knowledge, enable them to undertake more complex enforcement work and provide more support for smaller importers and intellectual property owners.

To enforce intellectual property rights, an owner is required to record its registration with CBP. Given the foregoing improvements in enforcement efforts, it would behoove intellectual property owners to consider recording all their relevant trademarks and copyrights in order to maximize protection of their rights.

[Learn About The New Centers Here](#)

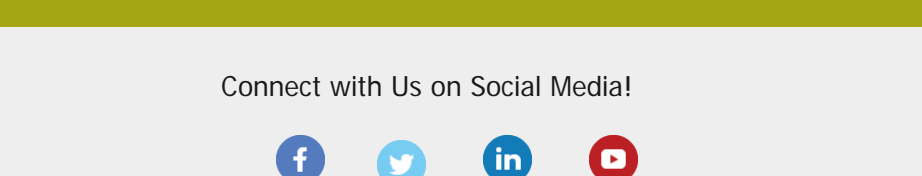
### Yuval Marcus on New Changes Under the DMCA

The U.S. Copyright Office has implemented a new online registration system for DMCA agent designations. This change affects online service providers, which includes any company that allows users to post or store material on the company's systems, such as customer comments and reviews. Under the DMCA, online service providers may avoid liability for copyright infringement if they follow the DMCA's safe harbor provisions. One requirement is to designate an agent to receive notices of claimed copyright infringement. The designated agent's contact information must be made available on the company's website and must also be submitted to the Copyright Office.



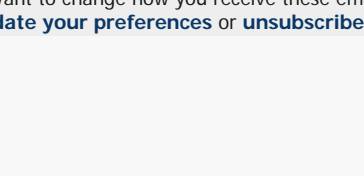
Under the new rules effective December 1, 2016, the Copyright Office will no longer accept paper agent designation submissions. All prior designations will be effective until December 31, 2017, at which point new designations will have to be made or the company will lose the safe harbor protections. In addition, the designated agent's contact information must be kept up to date and the agent designation must be renewed every three years or it will become invalid.

[Find the DMCA Designated Agent Directory Here](#)



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One Barker Avenue, Fifth Floor  
White Plains, New York 10601-1526  
United States of America (USA)  
Email: [inquiries@leasonellis.com](mailto:inquiries@leasonellis.com)

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