

# LEASON ELLIS

INTELLECTUAL PROPERTY ATTORNEYS

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## The Newtonian®

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### NEWS

#### **LEASON ELLIS WELCOMES SAFET METJAHIC, DR. PAUL M. ZAGAR, AND LAUREN BETH EMERSON**

Leason Ellis LLP is pleased to announce that patent attorneys Safet Metjahic and Dr. Paul M. Zagar have joined the firm as Partners and Lauren Beth Emerson, a trademark and copyright attorney, has joined as Counsel.

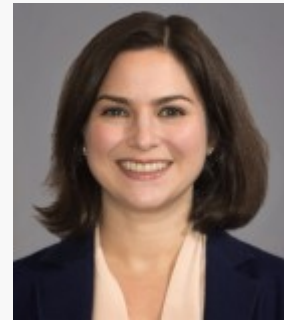
Safet Metjahic joins us from McGuireWoods LLP, where he was a Partner and head of the Patent Prosecution Group. Prior to joining that firm in 2007, he served more than 16 years with the U.S. Patent and Trademark Office, where he was a Supervisory Patent Examiner. Safet has more than 22 years of experience in reexamination practice. He has trained and led teams in the handling and examination of high-profile reexamination applications.



Paul Zagar, M.D., previously a Partner with Blank Rome LLP, focuses his practice on all aspects of patent law. Prior to his legal career, Paul was a practicing general and vascular surgeon. As such, he has been an end user for many medical devices and has used this experience to advance the prosecution of medical device patent applications.



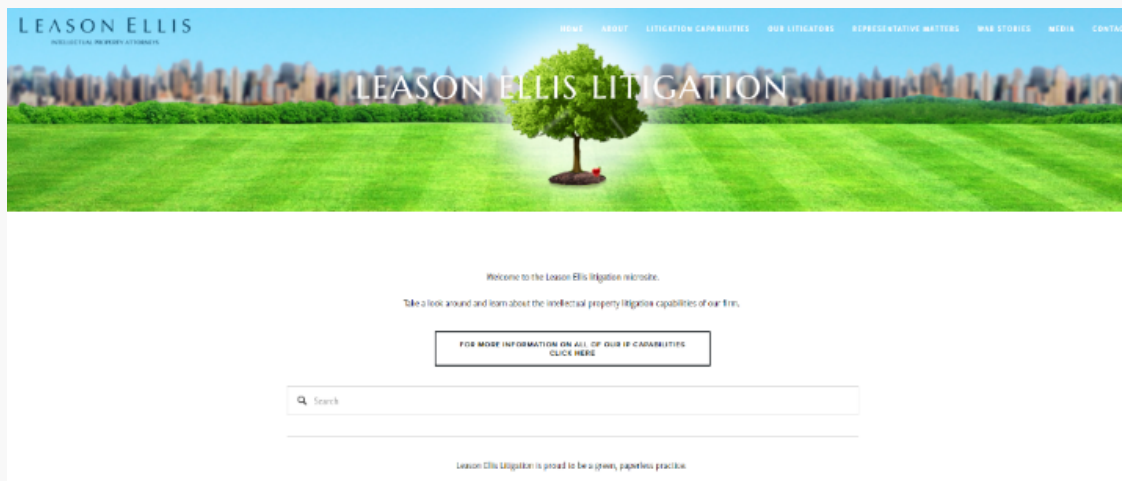
Lauren Beth Emerson joins us from Baker Botts LLP, where she spent 10 years as an Associate. Prior to that, she enjoyed a career in branding, licensing, and marketing at Pokémon USA, Inc. Lauren's practice as a trademark and copyright attorney includes IP clearance, client counseling, portfolio management, agreement work and due diligence, as well as litigation and enforcement. Lauren currently serves as co-chair of the Copyright Law and Practice Committee of the New York Intellectual Property Law Association.



[See Law360's Write-Up Here](#)

## LEASON ELLIS LAUNCHES LITIGATION MICROSITE

Leason Ellis has launched a microsite for its litigation practice! The [lelitigation.com](#) microsite highlights some of the favorable results we have obtained for our clients in federal district and appellate courts throughout the country, as well as in administrative proceedings before the USPTO. The site also provides in depth information about our highly-experienced litigation team, the firm's extensive IP litigation capabilities, and more. Click the picture below to visit the site.



## MORE LEASON ELLIS ATTORNEYS THAN EVER MAKE THE SUPER LAWYERS LIST!

Leason Ellis attorneys Mel Garner, Yuval Marcus and Peter Sloane all made the list of Super Lawyers in Intellectual Property Law for 2017. We had a record number of Rising Stars listed this year including Peter Busch, Deirdre Clarke, Lauren Emerson, Michelle Levin, Lauren Sabol and Emily Stein.



[Find the List Here](#)

## FRONT AND CENTER

### **MARTIN SCHWIMMER SPEAKS ON BLOCKCHAIN TECHNOLOGY AND TRADEMARKS**

On November 29th, 2017, Marty Schwimmer was one of two panelists in a webinar about what brand owners need to know about blockchain. Multiple industries are now exploring the possibilities with blockchain technology. The webinar explored blockchain, smart contracts and the Internet of Things, and how it will affect brand owners and trademark protection.



[Listen to the Webinar Here](#)

### **MELVIN GARNER SPEAKS AT NYIPLA PATENT CLE SEMINAR**

Melvin Garner was a panelist at The New York Intellectual Property Law Association's (NYIPLA) one-day patent CLE Seminar on November 16, 2017. The panel, entitled "Patent Rights: Public or Private; Whose Thoughts and Ideas Are They Anyway?", focused on the issues surrounding the US Supreme Court deciding whether Inter-partes review of issued patents by the Patent Trial and Appeal Board (PTAB) is constitutional. The PTAB is an administrative agency within the United States Patent & Trademark Office (USPTO), which by an act of Congress was given the power to find that an issued patent is invalid. The petitioner, Oil States, argues that this is unconstitutional and the property right in a patent cannot be taken away except by an Article III court (e.g., a US District Court) with a jury. The counterargument is that the patent right was created by the USPTO, so it can correct its error in granting the patent in the first place.



[See the Schedule Here](#)

### **DR. AMY KLANN SPEAKS AT AMERICAN CONFERENCE INSTITUTE PROGRAM ON IP**

## DUE DILIGENCE

Amy Gallup Klann, Ph.D., co-chaired the final session of the ACI's Summit on IP Due Diligence in Philadelphia on Friday, November 3, 2017. The session, titled "Best Practices for Managing the Entire Due Diligence Process from Both Sides' Perspectives," discussed best practices and tips for completing a thorough, cost-effective due diligence analysis in today's evolving life sciences climate.



[Find the Agenda Here](#)

## DR. SUSIE CHENG SPEAKS AT THE 15TH OPTICS VALLEY OF CHINA INTELLECTUAL PROPERTY FORUM & THE 2ND YANGTZE INTELLECTUAL PROPERTY FORUM

On November 1, 2017, Dr. Susie Cheng gave a presentation at the 15th Optics Valley of China Intellectual Property Forum and the 2nd Yangtze Intellectual Property Forum in Wuhan, China. The topic of her presentation was "Cross-Border Trade and Intellectual Property Protection in the Eyes of Foreign Investors—Intellectual Property Rights and Trade Secrets." The three-day expo attracted nearly 500 companies from 15 countries and regions to showcase their innovative products and technologies. The photo below includes some of the speakers at the event.



[Check Out the Event Details Here](#)

## CHINA HUBEI PROVINCIAL IP BUREAU DELEGATION VISITS LEASON ELLIS

On September 27th, we welcomed visiting delegates from provincial and municipal offices of the China Hubei Intellectual Property Bureau. The picture below is a group photo of the delegation with Dr. Susie Cheng (far left), Dr. Jia Li (sixth from the right) and Keyi Xu (fourth from right-back). Dr. Cheng and Mr. Xu

gave a presentation on the risks in intellectual property financing and how to minimize such risks through due diligence investigations. The meeting was conducted in Chinese.



During Dr. Cheng's November 2017 trip to China, she had a reciprocal visit with the Hubei Intellectual Property Bureau. The picture below is a group photo from her November visit.



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## **MARTIN SCHWIMMER SPEAKS IN INTA WEBCAST ABOUT TRADEMARK LITIGATION**

Marty Schwimmer was a featured speaker during the International Trademark Association's webcast titled "Practical Considerations in Improving Your Trademark Litigation Practice" on September 27, 2017. Presented by INTA's Law Firm Committee, this webcast focused on a variety of litigation-related topics including (1) using software and technology to be more effective in winning your next case; (2) updates on discovery practices in the United States and abroad; (3) ethical issues that may arise when working with investigators, particularly in foreign countries; and (4) best practices in helping clients during contentious litigation.

[View the Invite Here](#)

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## **LAW360 QUOTES LAUREN BETH EMERSON**

On September 1, 2017, Lauren Beth Emerson was quoted in Law360's three-part series on the biggest open questions in trademark law. The open question at issue is whether a trademark owner must prove that an infringer acted willfully to win an award of profits. According to Emerson, "[w]hile some courts have held that a finding of willfulness is a prerequisite, many consider it merely a relevant factor to be considered in balancing the equities." Adding to the gravity of the uncertainty over willfulness is the importance that profits play in trademark litigation. "Given the difficulty many plaintiffs have in establishing actual financial damage in trademark cases, the potential ability to go after an infringer's profits is significant," Emerson said.

[Read the Article Here](#)

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## **LEASON ELLIS WINS MOTION TO DISMISS/TRANSFER ON PERSONAL JURISDICTION GROUNDS**

On August 16, 2017, Leason Ellis attorneys Peter Sloane and Lauren Sabol, representing New York-based defendants, obtained a decision from the United States District Court for the District of Delaware granting a motion to dismiss and/or transfer a trademark infringement and unfair competition action. In granting our motion to dismiss, Chief Judge Leonard Stark agreed that one "trap buy" orchestrated by the plaintiff's counsel was insufficient to confer personal jurisdiction. Leason Ellis worked with local Delaware counsel, Elizabeth Wilburn Joyce of Pinckney, Weidinger, Urban & Joyce LLC, to obtain this favorable result for our clients. The case is Joseph G. McDonough v. Deborah A. Gorman, Be Positive Works, LLC, and B+ Foundation, Inc., No. 1:16-cv-00203 (LPS).

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## **PETER SLOANE WRITES "IT'S ALL ABOUT WHO" FOR THE FBC QUARTERLY**

The fall edition of the Federal Bar Council Quarterly features Peter Sloane's review of the U.S. District Court for the Southern District of New York's decision in a case involving a parody of Dr. Seuss' beloved classic "How the Grinch Stole Christmas." In that decision, the Court found fair use in a raunchy off-Broadway play parodying the story. *Matthew Lombardo and Who's Holiday LLC v. Dr. Seuss Enterprises, L.P.*, 2017 WL 4129643. The opinion made note to distinguish the decision last year in *TCA Television Corp. v. McCollum*, 839 F.3d 168, in which the Second Circuit found no fair use in the recitation of Abbott and Costello's treasured "Who's on First" routine as a theatrical device within a Broadway show.



[Read the Article Here](#)

## LEGAL UPDATE

### **YUVAL MARCUS ON THE DECEMBER 31 DMCA AGENT DESIGNATION DEADLINE**

At the end of last year, the U.S. Copyright Office implemented a new online registration system for DMCA agent designations which replaces paper designations with online registration. At the end of this year, agent designations made under the old system will no longer be valid.



This 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.

Accordingly, all online service providers seeking to retain the benefits of the safe harbor protections of the DMCA must make new agent designations by December 31, 2017. If we can help, please reach out to one of our trademark attorneys.

[Learn More About the DMCA Designated Agent Directory Here](#)

## IN BRIEF

### **Amazon's Revamped Brand Registry Program Provides Options For Client Enforcement**

By: Peter Busch

If you own a trademark registration, and have issues with Amazon listings either selling unauthorized copies of your products or using your trademarks to sell competing products, then the Amazon Brand Registry program might be right for you. The Brand Registry program streamlines the process for lodging complaints against unscrupulous, IP-infringing sellers, thereby avoiding the need to resort to costly litigation. For example, using the Registry, trademark owners can quickly search the Amazon



platform for unauthorized uses of their trademark or copyrighted images, and submit complaints requesting removal of infringing listings with ease. Please note, if your brand was registered with a previous incarnation of the Brand Registry, you will need to reapply to obtain full enforcement capabilities. Also, at this time, Amazon is only accepting standard character trademark registrations, and not design or font-specific trademarks. Our trademark attorneys can provide you with more information and help with filing for a trademark registration and/or setting up your brand on the Amazon Brand Registry.



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