LEASON ELLIS
INTELLECTUAL PROPERTY ATTORNEYS

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NEWS

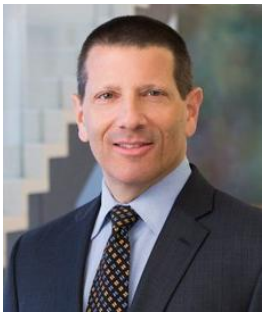
LEASON ELLIS CELEBRATES ITS TENTH YEAR AS A FIRM

On World Intellectual Property Day, we celebrated our 10th anniversary with a cocktail party for attorneys and staff. In April of 2008, we started out with just four attorneys and two staff in a small suite of offices at 81 Main Street in White Plains. Today, we have 31 attorneys and an additional 30 professionals and staff. The firm now occupies one and a half floors of office space at One Barker Avenue and we have an additional expansion in the works. Over the past ten years, Leason Ellis has rapidly grown to become the largest IP firm in Westchester and the seventh largest law firm in the county overall regardless of practice area. We look forward to another ten years and more of practice in working on behalf of our clients in their efforts to foster innovation and creativity and in enforcing and defending their IP rights in the U.S. and around the world.

DR. AMY GALLUP KLANN RECEIVES PRESTIGIOUS SERVICE MEDAL FROM THE LINN INN ALLIANCE

Dr. Amy Gallup Klann received a Distinguished Service Medal from The Linn Inn Alliance awarded at a reception preceding the NYIPLA Judges Dinner on March 23, 2018. The medal is in recognition of outstanding service over the past several years in helping to bring the American Inn of Court experience to the intellectual property community. Judge Richard Linn of the United States Court of Appeals for the Federal Circuit presented Amy with the medal.

ROBERT ISACKSON NAMED IP STAR BY MANAGING INTELLECTUAL PROPERTY



Robert Isackson has been named a "Patent Star" by Managing Intellectual Property magazine. Rob appears in its 2018 list of IP STARS, a leading specialist guide to IP firms and practitioners worldwide. Managing IP's research now covers more than 80 jurisdictions worldwide.

Click Here for More Information

LEASON ELLIS ATTENDS 2018 BIO CONVENTION

Elizabeth Barnhard and Susie Cheng represented us at the 2018 BIO International Convention in Boston where over 16,000 biotech industry attendees from around the world gathered to meet, educate, present partnering opportunities, and network.

PUBLICATIONS

TRADEMARK EXPERT GUIDE PUBLISHES ARTICLE WRITTEN BY PETER SLOANE AND CHELSEA RUSSELL

Peter Sloane and Chelsea Russell teamed up to write an article titled "Proof of Use Programs at The United States Patent and Trademark Office and the Relation to Foreign-Based Trademark Registrations" published by Euromoney in its Experts Guide series. The article discusses two recent programs initiated by the USPTO related to the trademark registration process. The first program allows the USPTO to selectively audit specimens of use beyond those originally submitted and the second enables third parties who believe that a specimen is fraudulent or falsified to contact the USPTO with such information. These two programs are aimed at combatting the systematic problems inherent in a common law use based trademark jurisdiction, particularly when contrasted with civil law jurisdictions with no use requirements.

Read the Article Here

LAW360 PUBLISHES ARTICLE BY DR. PAUL ZAGAR

Paul Zagar wrote an article titled "Praxair and the Printed Matter Doctrine," which was published in IP, Life Sciences, and Appellate Law360 on May 18, 2018 and as an expert analysis in Law 360's newsletters on May 21, 2018. The article made Law360's "10 Most Read Expert Analysis" articles for that week. The article summarizes and comments on a recent Federal Circuit decision that affirmed in part a Patent Trial and Appeal Board (PTAB) decision invalidating method of treatment claims including a "providing information" limitation by applying the printed matter doctrine.

Read the Analysis Here

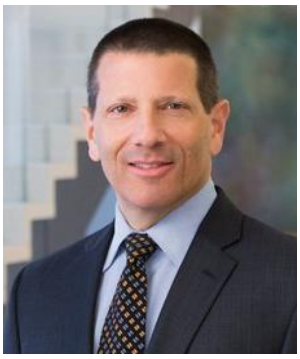
WTR BLOG PUBLISHES GUEST POST OF PETER SLOANE

The blog of the World Trademark Review published a guest post by Peter Sloane titled "'A potentially existential peril': the barriers facing the next generation of trademark lawyers." In the piece, Peter hits out at the unwillingness of firms to adequately train associates, warns that junior lawyers are missing development opportunities due to cost pressures, and outlines steps firms, associations and associates can take to combat the problem.

Check out the Post Here

LEASON ELLIS HELPS WRITE SUPREME COURT AMICUS BRIEF

Robert Isackson, Matthew Kaufman and Lauren Sabol co-authored an amicus brief, filed on behalf of the Intellectual Property Owners Association in Healthcare SA v. Teva Pharmaceuticals USA Inc., case number 17-1229, urging the United States Supreme Court to decide whether Congress, in enacting the America Invents Act, changed the patent law defense known as the "on sale" bar. The specific question concerns whether sales in which an invention isn't publicly disclosed can invalidate patents. IPO's brief was recognized and discussed in Law 360, which noted how the Federal Circuit's decision is inconsistent with U.S. Patent and Trademark Office guidelines, and how stakeholders need the question settled.



SPEAKING ENGAGMENTS

JOEL FELBER TEACHES AT PLI PATENT BOOTCAMP

Joel Felber participated in Practicing Law Institute's "Patent Fundamentals Bootcamp 2018: An Introduction to Patent Drafting, Prosecution, and Litigation" from June 13-15, 2018 in New York City. The program focused on teaching the basics of claim drafting, patent application preparation and prosecution, and also provided a review of recent developments in the law. Joel served as a clinic instructor in a session on patent amendment writing.

You Can See the Agenda Here

DEIRDRE CLARKE SPEAKS AT NYSBA PROGRAM

Deirdre Clarke spoke at a recent CLE program, 16th Annual Women in IP Law, co-sponsored by the Intellectual Property Law Section and the Committee on Continuing Legal Education of the New York State Bar Association. The program was held on Wednesday, June 6, 2018, at the offices of Davis Wright Tremaine LLP in New York City.

Click Here For More Information

LAUREN EMERSON TEACHES ON COPYRIGHTS FOR AIPLA

On April 24, 2018, Lauren Emerson spoke at the 2018 Design Rights Boot Camp of the American Intellectual Property Law Association in Arlington, Virginia. The Design Rights Boot Camp is a first of its kind two-day comprehensive CLE program designed for both new and experienced IP practitioners who wish to learn about protecting and enforcing designs in all areas of IP, including design patents, copyright and trademark dress. Lauren presented a "Copyright 101" program on preparing and filing copyright applications.

See the Event Calendar Here

MARTIN SCHWIMMER SPEAKS AT CARDOZO LAW SYMPOSIUM

Marty Schwimmer spoke on domain name and internet litigation at the International Comparative, Policy & Ethics Law Review Spring Symposium on April 23rd at the Benjamin N. Cardozo School of Law. Marty was joined by Paul Llewellyn of Arnold & Porter, who discussed trademark litigation, and Eleanor Lackman from Cowan Debaets, who addressed copyright litigation.

See Event Details Here

MARTIN SCHWIMMER SPEAKS AT FORDHAM IP CONFERENCE

Marty Schwimmer participated as a panelist in two seminars at the prestigious Fordham IP Conference in New York City on April 5 and 6, 2018. The first seminar, titled "Trump Administration & IP: Where is it Going?," addressed trade tensions with China. The second session, titled "The Protection of IP Online: The impact of ICANN's response to the General Data Protection Regulation (GDPR)," considered the effects of the EU GDPR on the WHOIS system, through which domain name registrant contact information is made publicly available.

See the Event Program Here

LEGAL UPDATE

EXTENSION OF NOVELTY GRACE PERIOD FOR PATENTS IN JAPAN

Like the current U.S. patent law, Japanese patent law is based on the first-to-file principle and as with most patent systems, a patent application filed in Japan is examined for novelty, inventive step and industrial application of the invention.

When examining the application for novelty and inventive step, the patent office considers the relevant prior art, which essentially consists of everything that has been made available to the public anywhere in the world regardless of the language in which the disclosure has been made. Of importance, the relevant prior art includes any disclosures made by the inventor(s) prior to the filing of the patent application.

Traditionally, patent systems either have an "absolute novelty" requirement or they provide for a limited "grace period" in examining whether an invention is novel. Absolute novelty countries require that the patent application have a filing date that precedes any prior art activities, including any prior art activities of the inventor, or else the invention will be considered to lack novelty and the patent office will refuse to grant the corresponding patent.

While the patent laws of most countries follow the absolute novelty requirement, there are a handful of countries, including the United States and Japan, that provide limited

exceptions to the absolute novelty requirement. These limited exceptions are typically characterized as being "grace periods" whereby a public disclosure is not considered to be prior art to the patent application.

Japan recently enacted legislation to extend the novelty grace period for a patent in Japan from six (6) months to twelve (12) months. The revised patent law will be applied to patent applications filed on or after June 9, 2018 and applies to both utility and design patent applications, as well as utility models.

The grace period in Japan does not apply to a foreign priority patent application, such as a U.S. patent application from which a later filed Japanese patent application claims priority. Therefore, in order to avail oneself of the protections accorded by the Japanese grace period, either a PCT (international) application or a domestic Japanese patent application must be filed within the grace period. Thus, as illustrated in the following example, if an applicant relies upon a grace period in order to file an initial patent application in a foreign country outside of Japan, the due date for filing a patent application in Japan must be docketed as one (1) year from the date of the loss of novelty event.

As a result, if a U.S. applicant is interested in procuring Japanese patent rights and a loss of novelty event has occurred (such as a publication or public disclosure), the applicant must carefully docket the deadline by which the Japanese patent application must be filed. For example, assume on June 13, 2018, an inventor makes a pre-filing public disclosure (a loss of novelty event) in the United States and then relies on the one-year U.S. grace period to file a U.S. patent application on June 13, 2019. In order for the Japanese grace period to apply, the applicant must file a patent application directly in Japan or file a PCT application on or before June 13, 2019, which is twelve (12) months from the date of the loss of novelty event. If the applicant files a PCT application after June 13, 2019 but before June 14, 2020, the Japanese grace period will not apply even though the PCT filing is technically proper since it was filed within twelve (12) months from the U.S. priority patent application filed on June 13, 2019.

An applicant seeking to avail itself of the Japanese grace period must also comply with other nuances of the Japanese patent law, such as submitting a "Proof of Disclosure" within thirty (30) days from the filing date (or from the date of entering the Japanese national phase from an earlier filed PCT application).

US PRIVACY CHANGES ACCELERATED BY GDPR

By now, most have heard about Europe's General Data Protection Regulation, also known as the GDPR, but might not be aware of its profound impact on nearly every aspect of commerce and the open digital lifestyle to which many of us have become accustomed. Passed by the European Parliament in April 2016 and coming into full force on May 25, 2018, the GDPR replaces the previous EU Data Protection Directive and aims to give consumers full control over their personal data and the manner in which it can be used by companies. The catch for Americans, however, is that the new law will affect not only organizations within Europe, but also those outside the EU who offer goods or services to, or monitor the behavior of, individuals within the EU.

In granting consumers control over their personal data, the GDPR requires consent from individuals in response to clearly delineated requests for collection or use. Consumers now also have rights to data portability, far greater control over their personal data, such as

where such data is being processed and towards what ends, as well as the right to be forgotten altogether. Additionally, the GDPR places affirmative obligations on data processors to provide notice to data protection authorities within 72 hours of becoming aware of a data breach and notify customers without any undue delay. Long gone are the days when data processors could determine how, when and why they would notify the public or affected individuals regarding data breaches.

Now that the implementation period has expired and the GDPR comes into full force, organizations must immediately gain a firm grasp of what data they acquire, hold and process, as well as the legal basis for such activities. Ignorance can come with a price, and it can be a steep one: entities processing personal data in violation of GDPR rules face potential fines up to four percent (4%) of global turnover or 20 million Euros, whichever is greater. Companies must further determine what procedures require adoption or updating, introducing complaint rules quickly and educating employees to ensure conformity with the law.

In the end, data protection and the GDPR is about understanding what data your organization possesses, why it is engaging the processing of such data and what consent it has obtained to possess or process such data in the first instance. Clearly obtaining consent and providing notice as to how data is being used are big first steps (among several) in obtaining and maintaining GDPR compliance.

THE .BOT TOP LEVEL DOMAIN

The .BOT Top Level Domain is intended to be a discovery platform of 'verified and trusted artificial intelligence applications,' commonly known as 'bots.' All .bot domain names must first pass an eligibility check by the registry operator, Amazon, consisting in part of documenting the existence of a 'published' bot program, built on one of several approved bot platforms. This requirement has hobbled trademark owners in reserving .bot domain names.

Leason Ellis researched the issue and, working with a .bot registrar, we can now create a bot program with an approved bot platform and then obtain a corresponding .bot domain name on your behalf. This can be done in a single day.

As bots grow in popularity, a .bot domain name may become an increasingly attractive target of infringers. Contact us to discuss protecting your valuable brands.

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