LEASON ELLIS
INTELLECTUAL PROPERTY ATTORNEYS
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The Newest Additions to Our Biotech/Pharma Practice

We are pleased to announce that Adda Gogoris and Michael Davitz have joined as partners. Adda and Michael are well-known biotech and pharmaceutical patent attorneys. Also joining them are Patent Agent Jia Li and Scientific Advisor Svetlana Pavlovic. Jia and Svetlana bring us to four Ph.D.s, joining Dr. Susie Cheng and Dr. Amy Gallup Klann. The addition of the team helps to solidify our position as a powerhouse among biotech and pharmaceutical patent practices in New York and beyond.

Emily Stein joins Leason Ellis as associate

We are pleased to welcome Emily Stein to the Leason Ellis family. Emily, a graduate of Barnard College, cum laude, and the University of Texas School of Law, will work as an associate in our Trademark and Copyright Practice Group. She was formerly an associate at Baker Botts in Manhattan.

You can find her bio here

Congrats to Jordan Garner, our Rising Star!

The Business Council of Westchester has announced its 2016 class of Rising Stars, a talented and diverse group representing an array of professions, and our associate Jordan Garner is among them! The BCW's Rising Stars awards salute Westchester's "40 under 40," individuals who demonstrate exemplary leadership, creativity, innovation, dedication and professionalism. **Click here for the announcement**

We're looking good in Economic Development Guide

We're featured as a case study on relocation in the 2016 Westchester County Economic Development Guide! See **http://goo.gl/2Vr5s1**. The feature highlights the growth of Leason Ellis since its founding by David Leason and Ed Ellis in 2008. The firm is on the vanguard of professionals who previously worked in Manhattan, but chose to set up shop closer to home in Westchester. We now number over 25 attorneys and almost 50 employees.

Author Ronald Fierstein drops in to chat

We are enormously thankful to Ronald Fierstein, author of the fantastic book "Triumph of Genius: Edwin Land, Polaroid and the Kodak Patent War," for speaking at our office recently. The book chronicles, in an unprecedented inside account, Polaroid's landmark patent battle with Kodak. Polaroid's victory forced Kodak to remove its instant cameras and film from store shelves and to pay almost $1 billion in damages, one of the largest patent awards ever. You can learn more about the book at

www.triumphofgenius.com.

Yuval Marcus, Joel Felber collaborate for *Bright Ideas*

Yuval Marcus and Joel Felber teamed up to write an article titled “Navigating the Intellectual Property Landscape: A Primer for New Businesses and Businesses Readying a New Product/Service Launch,” which was recently published in Bright Ideas, the newsletter of the IP Section of the New York State Bar Association. The article is a primer on various forms of protection available to a business readying to launch a new product or service. It aims to ensure that a startup business or an established company releasing a new product or service can successfully attract capital investment and gain a competitive edge in the market. You can find the article on our website **here**.

Joel Felber Published in Today's General Counsel

Joel Felber’s article on “Fundamentals of Protecting Patents Overseas” was published in the April/May edition of Today’s General Counsel magazine. In the piece, Joel discusses how securing patent protection in foreign countries is an effective but often overlooked means to further a company’s business objectives. You can find the article **here**.

Marty Schwimmer rocks FIOS1 interview

Marty Schwimmer was recently interviewed by FiOS1 News for his view on the copyright infringement action against Led Zeppelin. In the lawsuit, the estate of the lead singer of the band Spirit alleges that the famous opening riff to “Stairway to Heaven” was copied from its earlier song “Taurus.” According to Schwimmer, the estate is barred from damages over three years old due to the statute of limitations, but royalties over just the past three years may still amount to millions of dollars.

See the full interview here

More Marty: Tackling LeBron's tattoos

In This Week in Law, hosted by Denise Howell, Marty Schwimmer spoke about the protectability of LeBron James’ tattoos, which were reproduced without authorization in a video game, the potential fair use of a South Park clip that depicted a performance of a Rush song (the clip was then itself displayed at a Rush concert), the DMCA tussle involving WE RATE DOGS, and a little bit about the Trump University case. Listen to the podcast **here**.

Peter Sloane dispels trademark myths

Trademarks may seem easy, but there is nuance to the practice. Whether it is trademark naming strategy, searching options, or crafting the identification of goods in an application, businesses and entrepreneurs may have some misconceptions about the issues and risks. In an article for the Westchester County Business Journal, Peter Sloane highlighted some of those misapprehensions and

provided answers to clear up the facts. You can find the article **here**.

IN BRIEF

Susie Cheng Presents to AABANY

Dr. Susie Cheng was one of the featured speakers at an Asian-American Bar Association of New York (AABANY) event on March 7. The event, titled "Strategic & Tax Considerations in International IP Licenses & Portfolios," was held at Seward & Kissel LLP in Manhattan. The title of Dr. Cheng's presentation was "How to Prepare Your Clients for Technology Transfer and Intellectual Property Protection in China."

Michelle Levin, Deirdre Clarke talk trademarks

Michelle Levin and Deirdre Clarke spoke at the "Grow Conference" at Westchester Community College on April 29. Michelle and Deirdre took part in a session called "**#THISISHOWITRADEMARK**." Their discussion delved into the world of intellectual property, trademarks and marketing brands in a way that both maintains their image and keeps them safe.

LEGAL UPDATE

Anticipated Guidelines from the USPTO Concerning Design Patent Applications

New guidance is expected from the USPTO on the issue of the type of amendments and/or continuing applications which fall astray of the written description requirement (WDR) by pursuing protection of only a selected subset of design elements that were presented as part of the original disclosure in a design patent application in order to broaden the scope of protection.

Both utility and design patent applications must satisfy the WDR. The test for the sufficiency of the written description has been

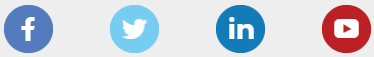
expressed as “whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” ***Ariad Pharm., Inc. v. Eli Lilly & Co.,*** 94 USPQ2d 1161, 1172 (Fed. Cir. 2010)(***en banc***). In design patents, the drawings provide the written description of the invention.

Over the past three years, the USPTO has struggled with how the WDR is to be applied to certain specific situations in design applications, namely, an amended claim or a claim in a continuing design application that includes only a subset of originally disclosed elements. Even in those situations in which a subset of originally disclosed elements is claimed, the USPTO has recognized that in a vast majority of cases, the WDR is satisfied. However, in certain situations, the subset of originally disclosed elements sets forth a design that, while technically visible in the original disclosure, might not be recognized by an ordinary designer as such.

An initial effort by the USPTO several years ago to bring some clarity to this issue proved unsuccessful in that its proposed factors-based approach for determining whether the WDR is satisfied was met with strong opposition by patent practitioners based on it being overly complex and contrary to precedent. In response, the USPTO elected not to pursue such an approach and is now once again eliciting comments on a new proposed approach in which the examiner will consider what the original/earlier application in its totality would have reasonably conveyed to an ordinary designer at the time of the invention, and how an ordinary designer in the art would have designed the article that is being claimed.

While the pendulum appears to be moving away from a heightened WDR standard, which was initially perceived by patent practitioners to be the direction in which the USPTO was heading, the actions and words of the USPTO indicate that the USPTO is still concerned as to whether it is fair and proper for applicants to be able to claim any conceivable subset of elements (***e.g.***, a knob and speaker grill from a disclosure of an entire clock radio).

Patent practitioners are once again left to wait for the USPTO to provide clearer guidance on this topic. In the meantime, design applications should be carefully drafted in light of the foregoing. In particular, if there is a subset of design elements that is important to a client, then the design application should be drafted and a strategy set in place in view of such disclosure.



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