

The Newtonian®

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ScentSational Victory for Leason Ellis



Earlier this month, Leason Ellis obtained a victory in the Federal Circuit for its clients ScentSational Technologies LLC and Steven Landau. In 2014, a *pro se* plaintiff filed a complaint in the Southern District of New York alleging that he was the inventor of certain patents and patent applications that our clients invented. After numerous amended complaints in the district court, the Honorable Kenneth Karas granted our clients' motion to dismiss with prejudice in January 2016. On appeal, the Federal Circuit affirmed, agreeing that the plaintiff failed to plead a reputational injury sufficient to sustain Article III standing under *Shukh v. Seagate Tech., LLC*, 803 F.3d 659 (Fed. Cir. 2015). The published decision is available at *Kamdem-Ouaffo v. PepsiCo, Inc. et al.*, No. 2016-1668, 2016 WL 4151245 (Fed. Cir. Aug. 5, 2016).

Leason Ellis Wins Domains for Honeywell International



Following the filing of our Complaint under the Uniform Dispute Resolution Policy (UDRP), the National Arbitration Forum awarded transfer of the domain name honeywell.cloud to our client Honeywell International. The decision follows a successful Uniform Rapid Suspension System (URS) proceeding in which the domain name was first suspended. In other recent wins for Honeywell, Leason Ellis obtained transfer of the Iranian domain names honeywell.ir and garrett.ir through the World Intellectual Property Organization.

[View the UDRP Decision Here](#)

Leason Ellis Attorneys Listed in 2016 Who's Who Legal

Congratulations to Ed Ellis and Mel Garner, who are listed in Who's Who Legal: Patents, and to Paul Fields, Marty Schwimmer and Peter Sloane, who are listed in Who's Who Legal: Trademarks. Who's Who Legal identifies the foremost legal practitioners around the world in multiple areas of business law.



[Visit the Who's Who Website Here](#)

Leason Ellis wins 914INC. Small Business Award!



We're excited to share the news that we're among 914INC.'s fourth annual Small Business Award winners in the General Excellence category! The awards are presented in recognition of the critical role small businesses play in keeping Westchester County's economy thriving. A story and photo appeared in the Q3 issue of the magazine. David Leason was interviewed for the story, and David, Susie Cheng, Mel Garner and Karin Segall participated in a photo shoot held at our offices.

[Read the Story Here](#)

Also in 914INC. ... Marty Schwimmer Offers Critical Advice

Marty Schwimmer gave readers of 914INC.'s annual advice feature some excellent tips on how they can protect their innovations. Marty emphasized the importance of having a written contract – even if it's scribbled on a napkin.



[Have a Look at Marty's Advice Here](#)

Yuval Marcus, Karin Segall to Speak for Association of Corporate Counsel

Yuval Marcus and Karin Segall will join three other IP attorneys on September 16th for a panel discussion titled "Protecting and Enforcing Your Brands." The event will take place at MasterCard's corporate headquarters in Purchase, New York. Yuval and Karin will provide their perspectives on the effect of BREXIT on trademark portfolios and discuss trademark enforcement strategies, including issues that evolve online and through social media.



[View the Agenda Here](#)

New Associate Joining Our Firm

Please welcome Keyi (Alvin) Xu who is joining our firm as an Associate in September. Alvin is a graduate of Tongji University in Shanghai, where he obtained a Bachelor of Engineering degree and St. John's University School of Law, where he was a member of the Intellectual Property Law Society. He clerked at Leason Ellis last summer and continued to intern here during his third year of law school.



Michael Davitz Reflects on Pro Bono

In 1977, I spent 6 months living and working in Tanzania and Kenya with Iain Douglas-Hamilton, the founder of Save the Elephants. Iain is part of a long tradition of naturalists who worked in East Africa studying the great wildlife there. Tragically, the elephant population in Africa has collapsed as elephants have been killed for their ivory. It is a terrible tragedy as elephants are beautiful animals who can live for as long as we do. They live in large family groups and communicate over vast distances like whales using subsonic communication. Over the last 50 years, Iain and his wife Oria have fought for the survival of the herds. They founded [Save the Elephants](#) to bring the plight of these magnificent animals to the attention of the world. During the course of the last 50 years, Iain and Oria have captured the attention of governments across the world and get them involved in the cause. As a result of their efforts, Save the Elephants has been the prime mover in implementing a worldwide ban on ivory sales. Their work has also attracted the interest and contributions of celebrities such as Yao Ming, Bill and Hillary Clinton and Leonardo DiCaprio. Over dinner with Iain in New York, I suggested that we represent Save the Elephants *pro bono*. At Leason Ellis, we have helped Save the Elephants obtain registration for several trademarks and continue to advise them on IP protection. For me, it has been a very special personal journey being able to represent a group trying to save elephants founded by an old friend.



IN BRIEF

New USPTO Post-Prosecution Pilot (P3) Program

The US Patent and Trademark Office (USPTO) recently announced a new pilot program that is part of its Enhanced Patent Quality Initiative, which is designed to improve the patent procurement experience. More specifically, the P3 program follows in the footsteps of the After Final Consideration Pilot (AFCP) program and both programs are geared to improving patent practice during the period after receiving a final rejection and prior to the filing of a notice of appeal.

Every seasoned patent practitioner has been in a situation in which there is a fundamental disagreement with the assigned patent examiner over how one or more prior art references are being interpreted and/or applied to the pending patent claims as a basis for rejecting the patent claims. Prior to the recent USPTO initiative, an applicant was forced to appeal the final rejection in order to have other sets of eyes, in this case a panel of three administrative patent judges, review the merits of the case. A patent appeal is costly to the applicant and also given the large backlog at the USPTO, it can be many years until a decision is rendered. The P3 program provides an attractive alternative to the patent appeal process.

Under the P3 program, a request form must be filed within two months of the mailing date of the final rejection and prior to filing a notice of appeal. As part of the request, the applicant states that he/she is willing and available to participate in a P3 conference with a panel of examiners and the applicant is required to submit a response of no more than five pages. The applicant is also given an opportunity to submit a proposed non-broadening amendment to one or more patent claims. If the request is approved, a P3 conference is scheduled with a panel of examiners. During the P3 conference, the applicant makes an oral presentation (which lasts no more than 20 minutes) to the panel of examiners. The applicant will be informed, in writing, of the panel's decision and depending upon the outcome, the applicant can choose how best to proceed.

While the P3 program is not intended to be used in all situations in which a final rejection is received by an applicant, the P3 program offers an attractive opportunity for applicants that have exhausted reasonable efforts to work with the assigned patent examiner to obtain allowance of the patent application. The P3 program thus provides a mechanism by which the applicant can have other examiners, besides the assigned patent examiner, review the merits of the final rejection without the headaches associated with proceeding with an appeal. In addition, there is no government fee to participate in the P3 program.

Upcoming Changes to U.S. Trademark Forms and Practice

In order to assess and promote the accuracy and integrity of the Trademark Register, the USPTO has proposed to amend its rules concerning the examination of affidavits or declarations of continued use or excusable nonuse filed pursuant to section 8 of the Trademark Act, or affidavits or declarations of use in commerce or excusable nonuse filed pursuant to section 71 of the Trademark Act. Specifically, the USPTO has proposed to require the submission of information, exhibits, affidavits or declarations, and such additional specimens of use "as may be reasonably necessary" for the USPTO to ensure that the Register accurately reflects marks that are in use in the United States for all the goods/services identified in the registrations, unless excusable nonuse is claimed in whole or in part. The proposed rules, if implemented, would allow the USPTO to require additional proof of use to verify the accuracy of claims that a trademark is in use in connection with particular goods/services identified in the registration.

In another effort to promote the accuracy and integrity of the Trademark Register, the USPTO is reformatting the declaration and signature portion of the forms for applications for registration, allegations of use, and affidavits or declarations of continued use or excusable nonuse (post-registration affidavits) in order to make it more likely that signatories will read the verified statements and understand them before signing. To accomplish this, the statements will be separated to improve readability and users will be required to check a box next to each statement in order to validate an electronic submission. The change is intended to address the USPTO's belief that the current formatting of the declaration paragraphs may not promote sufficient reflection on the language by the signatory before he or she signs a document.



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