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LEASON ELLIS
INTELLECTUAL PROPERTY ATTORNEYS

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NEWS

LEASON ELLIS OBTAINS FAVORABLE SETTLEMENT AGAINST TRADEMARK SCAMMER

We have obtained a favorable settlement in our civil action against Patent & Trademark Association, Inc., a New Jersey corporation, after filing a multi-count Complaint in the U.S. District Court for the Southern District of New York. Our Complaint alleged that defendant had engaged in false advertising, unfair competition, deceptive acts and practices, and tortious interference with prospective economic relations by marketing to trademark owners prospective "publication" of their trademark registrations in a database. This "service" offered no commercial value, as published trademark information is freely available in the online records of the U.S. Patent and Trademark Office. Our Complaint further alleged that defendant was confusing consumers into believing that the database was legitimate by sending unsolicited notices designed to make it appear as though it was an official government enterprise. In successfully resolving the dispute, we negotiated a settlement in which PTMA is permanently barred from ever engaging in trademark or intellectual property-related activities in the U.S. and in which we recovered several of its domain names including ptma.us (www.ptma.us). This victory follows in the steps of our previous triumphs against other companies whose disreputable practices preyed on unsuspecting trademark owners, as we previously secured consent judgments against Patent & Trademark Agency LLC and USA Trademark Enterprises, Inc. By vigorously taking legal action to combat these predatory companies, we continue to be an industry leader in the fight for fairer business practices and in the battle to protect trademark goodwill and trust from unjust exploitation.

DON'T TOUCH MY TRADEMARK: BEST PRACTICES FOR PROTECTING YOUR IP

We are pleased to have organized a panel discussion on trademark law for the Westchester/Southern Connecticut chapter of the Association of Corporate Counsel that took place on March 2, 2018. A panel of all-star trademark lawyers discussed issues including trade dress, trademark issues in e-commerce, social media and advertising, counterfeiting enforcement, and working with Customs. Our own Yuval Marcus and Marty Schwimmer were among the featured speakers.

[Click Here for Program Details](#)

LEASON ELLIS ANNOUNCES ITS NEW SECURE ONLINE PAYMENT PORTAL!

Leason Ellis has partnered with Heartland Payment Systems and we are now pleased to offer our clients the convenience of making payments online through our new secure Client Payment Portal. If making payments by credit card is preferable, we invite you to visit our secure Client Payment Portal on our homepage at <http://www.leasonellis.com> or at <https://securepayment.link/leasonellis>.



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Make a one-time payment with your credit or debit card.

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Set Up A Recurring Monthly Payment

Start a recurring monthly payment with your credit or debit card.

[Start A Monthly Payment](#)

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LEASON ELLIS ANNOUNCES THE ADDITION OF ROBERT M. ISACKSON

We are very pleased to announce that Robert M. Isackson has joined the firm as a Partner effective February 1, 2018. Rob is an intellectual property law litigator with nine patent trials under his belt, including four as first chair. He has led trial teams in over forty patent litigations and in more than ten non-patent IP cases and arbitrations, including those in trade



secret, trademark, trade dress and copyright matters. He also handles IP counseling and procurement work as well as transactional matters. Rob built his career at Orrick, Herrington & Sutcliffe LLP where, during his twenty year tenure there, he headed the New York IP Group from 2002 to 2008 and served as Co-Chair of its Life Science Practice from 2009 to 2013.

[Read His Full Bio on Our Website](#)

LEASON ELLIS WELCOMES NEW ASSOCIATE CHELSEA A. RUSSELL

We are happy to announce the addition of Chelsea A. Russell, an Associate in the Trademark and Copyright Practice Group. Chelsea is experienced in trademark, copyright, and litigation matters including district court, federal circuit, and TTAB proceedings. She earned her J.D. from the University of Connecticut School of Law and B.A. in History from Southern Connecticut State University. Prior to joining Leason Ellis, Chelsea was an Associate at Whitmyer IP Group in Stamford, CT.



[Read Her Full Bio on Our Website](#)

LEASON ELLIS ONCE AGAIN A HIGHLY RANKED FIRM IN THE WTR 1000



The World Trademark Review just came out with its list of leading trademark professionals for 2018. The write up of New York firms said that we offer “an in-depth service for a broad variety of IP-related issues at rates far more competitive than most rival firms” and that our “lean size belies the immense talent housed here, with all its lawyers boasting stellar credentials.” It went on to single out Marty Schwimmer, Peter Sloane, Yuval Marcus and Karin Segall as prime examples.

[See the Listing Here](#)

LEASON ELLIS PROVIDES U.S. ADVERTISING LAW UPDATE FOR 2018

Peter Sloane and Lori Cooper have updated the commentary on advertising law in the U.S. for Practical Law, a Thomson Reuters business. The article is framed as a question and answer session, providing U.S.-specific information concerning the key legal issues that need to be considered when designing an advertising campaign.

[See the Commentary Here](#)

FRONT AND CENTER

MELVIN GARNER SPEAKS ON ADVANCED LICENSING AGREEMENTS FOR PLI

Practicing Law Institute held a two day seminar on advanced licensing agreements on March 5th and 6th at its state-of-the-art New York Conference Center. The seminar provided an overview of critical developments in licensing. Mel Garner spoke on the first day as part of a breakout session on the analysis of a technology license agreement.



[Check Out the Program Here](#)

LAUREN EMERSON SPEAKS ON TRADEMARK ISSUES IN CHINA

Lauren Emerson was a featured speaker for a webinar presented by Strafford Live titled "Trademark Prosecution in China: Key Considerations When Seeking Brand Protection" on February 6th. Lauren and her fellow co-panelist, and Paul D. Jones, a Principal at Jones & Co., provided guidance to counsel for companies with products in China to ensure IP protection through trademark registration. They examined the considerations and procedures involved with securing trademark protection in China and taking actions against infringers there.



[See Event Details Here](#)

MELVIN GARNER PRESIDES OVER HON. WILLIAM C. CONNER INN OF COURT ANNUAL DINNER

Attorneys from Leason Ellis attended the Hon. William C. Conner Inn of Court Annual Dinner at the Union League Club of New York on January 17, 2018. As a Member of the Conner Inn Executive Committee and Annual Dinner Co-Chairperson, Mel Garner presided over the event and made numerous introductions and award announcements. The dinner has become a tradition for the Hon. William C. Conner Inn to open its operating year.



YUVAL MARCUS AND LAUREN SABOL WRITE FOR NYSBA IP PUBLICATION

Yuval Marcus and Lauren Sabol teamed up to write an article titled "IP Cease and Desist Letters: Minimizing Declaratory Judgment Risks." The article, published by the New York State Bar Association in its Bright Ideas publication, Winter 2017, Volume 26, Number 3, provides an in-depth analysis of strategic considerations and guidance for the drafting of intellectual property cease and desist letters.

[Read the Article on our Site Here](#)



DEIRDRE CLARKE WRITES ON TRADEMARK CASE FOR WTR DAILY

On November 24, 2017, WTR Daily, part of World Trademark Review, published a synopsis of the decision in Board-Tech Electronics Co, Ltd v Eaton Electric Holdings LCC, 2017 WL 4990659 (SDNY October 31, 2017). In that case, the court found that the plaintiff lacked an actionable claim in alleging that defendant falsely advertised its product as "UL Certified" just because it had failed plaintiff's own independent testing. In dismissing the case, the court expressed concern that to allow such a suit to go forward would invite third parties to



police certification marks in order to gain access to competitive information.

See the Case Summary Here

LEGAL UPDATE

MARTY SCHWIMMER'S TAKE ON COPYRIGHT CASE ABOUT USE OF EMBEDDED PHOTOS IN SOCIAL MEDIA

A recent copyright decision in the Southern District of New York about displaying a photo of quarterback Tom Brady in a Tweet embedded in news stories calls into question the *Perfect 10* "server" test, thus challenging the legality of using "inline" or "embedded" content. *Goldman v Breitbart, et. al.*, 17-cv-3144 (February 15, 2018) (Forrest, J.). Accordingly, managing risk attendant in using third-party content requires either obtaining authorization or structuring the use of such content so that it easily falls within fair use.



The prevailing test on whether the use of images displayed on a webpage using "inline linking" or "embedded links" is the "server test" as articulated in *Perfect 10 v Google*, 487 F.3d 701 (9th Cir. 2007). Google indexed allegedly infringing thumbnail images, which Google copied and stored. This copying for purposes of indexing was held to be a fair use. Google also "framed" displays of full versions of images that were stored on third-party servers. Because Google did not store a copy of the image on its own server, and because the user was literally viewing a display of an image stored on the third party's server, Google was not liable under the "server" test.

In *Breitbart*, Judge Forrest, citing a sentiment expressed by Justice Scalia in the *Aereo* decision, rejected what she sees as technological sophistry, if an argument based on the precise method a process works circumvents common-sense IP protection.

Here, plaintiff took a photo of Tom Brady, in a chance encounter, and uploaded it to his Snapchat account. The photo went viral and unauthorized third persons tweeted the photos. Various news organizations embedded the Tweets and, in so doing, displayed the photo. This is what an embedded Tweet looks like on a website:

www.schwimmerlegal.com/2018/02/this-is-an-example-of-a-tweet-embedded-on-a-webpage.html .

Does this form of displaying a copyrightable work infringe the display right? Judge Forrest said yes, because the server test is wrong, or at least distinguishable from *Perfect 10* in that the user at a search engine must take an affirmative action to access the full image. Here, the news organizations were in effect "seamlessly" displaying the full image to the user.

Judge Forrest addressed an underlying rationale of the server test in that a defendant must maintain a copy of a work in order to display it. The judge cited the "home stereo" exemption of public performance by small businesses, and argued that the existence of the exemption implies that the act would otherwise be deemed to be a

performance. Accordingly, the user's radio or television doesn't copy a work but merely transmits it. By analogy, as enforcement of the performance right is not dependent on the physical location of a copy of the work, neither should enforcement of the display right be so concerned. You don't need to make a copy of an image on a computer to display it.

The decision does not discuss defenses, as defenses were split from the infringement decision per agreement by the parties. However, bear in mind the nature of the use. The photo in question depicted Tom Brady talking to the general manager of the Boston Celtics, at a time when there were rumors as to whether the Celtics would ask Brady to assist in recruiting Kevin Durant to join the Celtics. Thus, a photo of the two men was relevant to the rumors, and even the depiction of a Tweet was relevant to reporting the scope of the "vitality" of the rumors. There seems to be a very plausible argument that the photo itself was news, and display of the photo as embedded in Tweets, was relevant and necessary to reporting the news.

This decision has incited some "this is the end of the internet" reactions, because of social media's heavy reliance of inline or embedded use of other content (think Tumblr and Pinterest). A more realistic response is that users of third party content should polish up their understanding of the principles of third party fair use and abandon the view that if they use such content, it's fair.

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