



LEASON ELLIS

INTELLECTUAL PROPERTY ATTORNEYS

Inspired by Insight®

The Newtonian®

Issue #26 | Winter 2019

NEWS

SUPER LAWYERS LISTS SEVEN LEASON ELLIS ATTORNEYS

The latest issue of Super Lawyers features Susie Cheng, Melvin Garner, Yuval Marcus and Peter Sloane under intellectual property while Peter Busch, Deirdre Clarke and Lauren Sabol are named among the rising stars of IP law. We could not be more proud of our colleagues who deserve this great recognition of their work.



[See the Publication Here](#)

LEASON ELLIS PROVIDES UPDATE TO COMMENTARY ON U.S. ADVERTISING LAW FOR 2019

Peter Sloane and Lori Cooper have updated their 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 [Advertising Q&A: US](#) (subscription only).



[Read the Full 2019 Commentary Here](#)

LEASON ELLIS ATTORNEYS AUTHOR SUPREME COURT AMICUS BRIEFS

Leason Ellis attorneys participated in drafting amicus briefs in two cases recently submitted to the U.S. Supreme Court on behalf of the

New York Intellectual Property Law Association. The first was in *Return Mail, Inc. v. United States Postal Service, et al.* Case 17-1594, a case concerning whether the US Postal Service qualifies as a “person” who could commence a covered business method review of a patent under the America Invents Act, after the patent owner commenced a taking action against the USPS under 28 USC § 1498. The second was in *Mission Product Holdings, Inc. v. Tempnology, LLC*, Case No. No. 17-1657, a case addressing the rights of a trademark licensee to continue to use a trademark after a licensor declares bankruptcy and rejects the license agreement. Rob Isackson, who is currently the Second Vice President and Liaison to the Amicus Briefs Committee of the NYIPLA, participated in the first brief. Marty Schwimmer led the Leason Ellis team on the second brief, assisted by Rob and Christina Sauerborn.



[Read the First Brief Here](#)

[Read the Second Brief Here](#)

MATT KAUFMAN HELPS STUDENTS PATENT DEVICE TO RID PONDS OF ALGAE BLOOMS

Matthew Kaufman’s work in providing pro bono IP assistance to Team HIPE Robotics, FIRST Lego League team #15651, in obtaining patent protection for its “N-Buster” nitrogen reduction device, was covered by northjersey.com, part of the USA Today network. Matt worked with the team, whose members include New Jersey middle and high school students, to draft and prosecute recently awarded [US Patent No. 10,118,847](#), which covers a device that removes contaminants by passing free flowing or semi-free flowing water through a contained bioreactor for purification. The students hope to commercialize their invention and deploy the device in waterways throughout New Jersey in an effort to rid ponds and streams of dangerous algal blooms.



[Read the Article Here](#)

SPEAKING ENGAGEMENTS

JOEL FELBER TO SPEAK ON ENGINEERING LAW AND ETHICS

Joel Felber is on the faculty for a program about Engineering Law and Ethics to be held in White Plains, New York on January 30, 2019. Joel will speak on intellectual property essentials for

engineers. His discussion will address issues such as securing ownership of designs through patents, trademarks, copyrights, and trade secrets, leveraging intellectual capital through licenses, franchises, and other technology agreements, policing intellectual property rights and preventing infringement, and resolving IP disputes.



[Upcoming Event Information Here](#)

MELVIN GARNER SPEAKS AT PLI'S IP ISSUES IN BUSINESS TRANSACTIONS 2019 PROGRAM IN NEW YORK



On January 7, 2019, Mel Garner spoke at Practising Law Institute's "IP Issues in Business Transactions" program for 2019. Mel appeared on a panel titled "Designing, Creating, and Pruning an IP Portfolio," that addressed various topics including identifying a business case and creating an IP value chain, mining IP as a strategic asset, special considerations for handling non-core assets, how to acquire and sell IP and more. The panel was part of a two-day program aimed at attorneys who confront intellectual property issues in the context of a variety of corporate, commercial and other business transactions.

[See Prior Event Details Here](#)

MATTHEW FRISBEE SPEAKS ON A WEBINAR PANEL ABOUT TRADEMARKS



Matthew Frisbee was a panelist on a Strafford Live CLE Webinar titled "Making Section 2(f) Claims: Demonstrating Acquired Distinctiveness" on November 29, 2018. As a panelist, Matt guided trademark counsel in understanding how the courts and the USPTO view the issue of acquired distinctiveness in support of a trademark application. Among other things, the panel discussed strategies that work—and those that don't work—in demonstrating acquired distinctiveness.

[View the Earlier Event Invitation Here](#)

MARTIN SCHWIMMER SPEAKS ON JOHN MARSHALL LAW SCHOOL OF CHICAGO ANNUAL IP CONFERENCE



Martin Schwimmer participated in a 'Recent Developments in Trademarks' panel at the annual IP conference organized by John Marshall Law School of Chicago on November 2, 2018. Marty discussed the recent Federal Circuit decision in *ITC v Converse*, involving secondary meaning in the Converse All Star toe cap and toe bumper. Marty began with a short semiotic discussion of what

LEGAL UPDATE

TRADEMARK LAW CHANGES ARE COMING TO CANADA

By: Michelle Levin



Big changes are coming to trademark law in Canada. In June 2019, a new law comes into effect that will significantly impact certain aspects of Canadian trademark law. First, Canada is joining the Madrid Protocol. Trademark owners will now be able to file for trademark protection through the International Registration system, which can be a very effective tool to efficiently file in many countries around the world. Second, Canada is one of the only countries that does not follow the international classification system for goods and services. The new law will implement the classification system that is followed by most other countries, including the U.S. Along with the classification system, government fees will be based on the number of classes, which could potentially increase filing fees for some trademark owners.

Next, Applicants will no longer need to include a filing or registration basis and use information will not be required at any stage in the application process. In addition, registration and renewal terms will change from 15 years to 10. If you have any questions about your trademark protection in Canada, or would like to review how this new law may affect your portfolio, please let us know.

[Leason Ellis LLP](#)

t: 914.288.0022

f: 914.288.0023

Email: inquiries@leasonellis.com

Download Brochure

