



# THE Newtonian<sup>®</sup>

ISSUE #37, WINTER 2024/2025

## Looking Ahead to 2025: Proactive Measures for Success

### Also in This Issue:

USPTO Implements New Trademark Fee Schedule

Federal Circuit Issues Precedential Decision Changing  
the Test for Design Patent Obviousness

Protecting a Legacy: Leveraging the Power of Common Law  
Trademarks and Name, Image, and Likeness Rights

I'm Registered—Now What? The Value of Recordation  
with U.S. Customs and Border Protection

# LETTER FROM THE EDITOR

---

Dear Friends and Colleagues,

Ideas are the gifts that keep on giving—and in 2024, we had the privilege of helping our clients uncover, protect, and celebrate the products of their ideas. May 2025 be a year of new discoveries, clever solutions, and the continued pursuit of what's possible.

Now, without further ado, we are pleased to close out 2024 with our Winter edition of The Newtonian. Along with **Firm News** and **In Case You Missed It**, here is an overview of the practice group discussions you will find.

## PATENT

Federal Circuit Issues Precedential Decision Changing the Test for Design Patent Obviousness

## TRADEMARK

USPTO Implements New Fee Schedule for Trademark Applications

## COPYRIGHT

I'm Registered—Now What? The Value of Recordation with U.S. Customs and Border Protection

## LITIGATION

Protecting a Legacy: Leveraging the Power of Common Law Trademarks and Name, Image, and Likeness Rights

As always, we hope you find value in The Newtonian. Please feel free to share it with others and to share your thoughts with us at [inquiries@leasonellis.com](mailto:inquiries@leasonellis.com).

With best wishes for the holidays,

Henry A. Gabathuler  
Partner  
Editor, The Newtonian

# FIRM NEWS

---

## Awards and Recognition

---

### **16 Leason Ellis Attorneys recognized in WIPR Leaders 2024 Directory**

We're thrilled to announce that 16 of our lawyers have been recognized in the 2024 WIPR Leaders directory, which highlights the world's top IP practitioners. This year's list includes Elizabeth Barnhard, Susie Cheng, Michael Davitz, Lauren Emerson, Joel Felber, Matthew Frisbee, Henry Gabathuler, Melvin Garner, Robert Isackson, David Leason, Michelle Levin, Yuval Marcus, Cameron Reuber, Martin Schwimmer, Karin Segall, and Peter Sloane. These professionals were carefully selected for their outstanding contributions across patent, trademark, and copyright law.

### **Leason Ellis Attorneys recognized in the 31st edition of The Best Lawyers in America**

Seven of our attorneys are making waves in the 2025 edition of The Best Lawyers in America®! Susie Cheng, David Leason, Yuval Marcus, Cameron Reuber, and Karin Segall are recognized for their experience in IP litigation, while Martin Schwimmer and Peter Sloane are honored for their work in both IP litigation and trademark/copyright law.

Also joining the ranks as Ones to Watch is Stefanie Garibyan—proof that the future of IP law is in great hands.

### **Elizabeth Barnhard recognized in 2024 IAM Strategy 300**

A big congratulations to Elizabeth Barnhard for being named to the 2024 IAM Strategy 300 for her experience in Biotech, IP management consultancy, and Pharmaceuticals/Life Sciences. As Chair of the Pharma/Biotech Practice Group, her strategic leadership in IP stands out among the best.

### **Leason Ellis attorneys recognized by Best Lawyers in Westchester Magazine**

It's exciting to see several of our attorneys recognized in Westchester Magazine's list of the top lawyers in the county, based on the 2024 editions of The Best Lawyers in America® and Best Lawyers: Ones to Watch in America®. Among those honored are Susie Cheng, David Leason, Yuval Marcus, Cameron Reuber, Karin Segall, Martin Schwimmer, and Peter Sloane, celebrated for their exceptional contributions to the legal community.

A special nod to one of our rising stars, Stefanie Garibyan, for being recognized as "Ones to Watch" in Intellectual Property Law.

### **11 Leason Ellis attorneys recognized by Super Lawyers**

We are pleased to announce the recognition of Elizabeth Barnhard, Susie Cheng, Lauren Emerson, Matthew Frisbee, Melvin Garner, Martin Schwimmer, Karin Segall, and Peter Sloane as Intellectual Property Super Lawyers. Jarryd Werts joins them as an Intellectual Property Rising Star.

In Intellectual Property Litigation, Robert Isackson, Yuval Marcus, and Cameron Reuber have also been recognized as Super Lawyers, while Tatsuya Adachi is celebrated as a Rising Star.

Notably, Peter Sloane and Yuval Marcus have also been included in the Top 25: 2024 Westchester County Super Lawyers list.

### **Leason Ellis recognized by Chambers Intellectual Property Spotlight New York**

Leason Ellis has once again been recognized by Chambers and Partners in its Spotlight Guide for 2025 in the area of Intellectual Property Law in New York. This recognition reflects our unwavering commitment to delivering exceptional IP services and strategic counsel to our clients.

# PATENT

---

## Federal Circuit Issues Precedential Decision Changing the Test for Design Patent Obviousness



By [Dexter T. Chang](#)

---

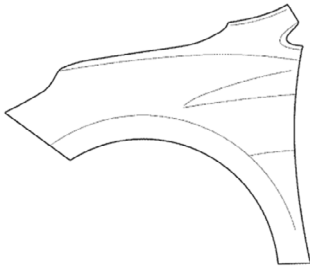
In a case concerning third-party after-market replacement parts for automobiles, the Federal Circuit recently overruled a longstanding standard for combining prior art references to determine obviousness of a claimed design in a U.S. design patent. *LKQ Corp. v. GM Global Tech. Operations LLC*, 102 F.4th 1280 (Fed. Cir. 2024) (en banc).

Before this decision, determining obviousness of a claimed design included a two-step process known as the *Rosen-Durling* test, in which the first step was identifying a primary reference “the design characteristics of which [were] basically the same as the claimed design.” *In re Rosen*, 673 F.2d 388, 391 (C.C.P.A. 1982). Absent such a primary “*Rosen*” reference, the claimed design in the design patent would be found not obvious. Once a *Rosen* reference was identified, the second step was combining one or more secondary references with the *Rosen* reference, where the *Rosen* and secondary references “[were] so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *In re Rosen*, 673 F.2d at 391. (internal citations and quotations omitted).

The *LKQ* case involved an inter partes review before the Patent Trials and Appeals Board (“PTAB”) of the United States Patent and Trademark Office brought by LKQ to challenge the validity of U.S. Design Patent No. D797,625 (the “D’625 Patent”) owned by GM Global Technology Operations LLC (“GM”) and directed to a vehicle’s front fender. LKQ asserted that the design claimed in the D’625 Patent was not novel and was obvious based on U.S. Design Patent No. D773,340 (“Lian”) and a promotional brochure depicting the design of the front fender on the 2010 Hyundai Tucson (“Tucson”).

**'625 PATENT  
CLAIMED DESIGN**

---



Appx0063, FIG. 2

*FIG. 2 of the D'625 Patent*

**LIAN  
PRIMARY REFERENCE**

---



Appx0450, FIG. 4  
(cropped, annotated)

*FIG. 4 of Lian*

**TUCSON  
SECONDARY REFERENCE**

---



Appx0464  
(cropped, rotated)

*Excerpt from Tucson*

The PTAB found that LKQ failed to establish that Lian anticipated the claim of the D'625 Patent and failed to establish that the "claim would have been obvious because LKQ failed to identify a *Rosen* reference." *LKQ v. GM*, 102 F.4th at 1288-1289. In short, the PTAB found that Lian failed to meet the criteria of a *Rosen* reference in that it did not possess design characteristics that created basically the same visual impression as the claimed design in the D'625 Patent. LKQ appealed to the Federal Circuit and a panel at the Federal Circuit affirmed the PTAB decision. The Federal Circuit granted rehearing *en banc* and the *en banc* court vacated the panel's opinion on obviousness.

Taking the Supreme Court's approach in its *KSR* decision, the *en banc* court overruled the *Rosen-Durling* test in favor of a more flexible approach that "provides that the same conditions for patentability that apply to utility patents apply to design patents." *LKQ v. GM*, 102 F.4th at 1287. (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)). In place of the *Rosen-Durling* test, an obviousness analysis under 35 U.S.C. 103 for a design patent would entail applying the *Graham* factors: scope and content of the prior art, the difference between the prior art and the claimed design, the level of ordinary skill in the pertinent art, and the obviousness or non-obviousness of the claimed design. *LKQ v. GM*, No. 102 F.4th at 1296-1300 (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966)). The *en banc* court expressly left the scope of analogous art as a "fact question to be addressed on a case-by-case basis and we 'leave it to future cases to further develop the application of this standard.'" *LKQ v. GM*, 102 F.4th at 1297-1298 (internal citations and quotations omitted).

In the *KSR* decision, the Supreme Court overruled the Federal Circuit's earlier "rigid" obviousness test for utility patent applications, known as the teaching, suggestion, and motivation (TSM) test for combining prior art references. *KSR v. Teleflex*, 550 U.S. at 415. In place of the TSM test, the Supreme Court applied the *Graham* factors and noted that what mattered was the objective reach of a patent claim and whether it extended to what was obvious, or an obvious solution to a known problem at the time of invention encompassed by the patent claim. *KSR v. Teleflex*, 550 U.S. at 419-420.

In the *LKQ* case, both the PTAB and the Federal Circuit panel found that the primary reference and the secondary reference failed to meet the *Rosen* test of creating "basically the same visual impression as the claimed design" of a front fender. These references each showed a front fender design but were found to have differing design elements that created different visual impressions. The *en banc* court found the *Rosen* test leading to this result at odds with the statutory standard for obviousness, *KSR* and other Supreme Court cases on design patents, particularly, *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 680 (1893). In the *Whitman Saddle* case, the Supreme Court considered a patented design of a saddle (U.S. Patent No. 10,844) that was a combination of the front of a known "Granger" saddle and the rear of another known "Jenifer" saddle. While the *Whitman* case mainly concerned infringement, the *en banc* court inferred that neither the "Granger" saddle nor the "Jenifer" saddle would have met the *Rosen-Durling* test. *LKQ v. GM*, 102 F.4th at 1294. The court noted that the rigid application of the *Rosen-Durling* test, therefore, could not have been reconciled with Supreme Court precedent in the *Whitman* case. *Id.*

Remanding the case to the PTAB, the *en banc* court vacated the finding of non-obviousness and further noted that for claim construction, a "tribunal is not 'obligated to issue a detailed verbal description of the design' as 'a design is better represented by an illustration.'" *LKQ v. GM*, 102 F.4th at 1301 (citing *Egyptian Goddess v. Swisa*, 543 F.3d at 679).

# PATENT INSIGHTS



The LKQ decision exposes existing design patents to potential invalidity challenges on lowered obviousness thresholds, in which cited art no longer needs to be shown to provide “basically the same visual impression” as a claimed design or “so related to” another cited reference that features in one would suggest application of those features to the other.



Amici, commentators, and, indeed, Judge Lourie in his concurrence, have all noted that broadening or adjusting the interpretation of the Rosen-Durling test would have been preferable to outright overruling this longstanding test. The *en banc* Federal Circuit took a more drastic approach modeled after the *KSR* decision by the Supreme Court in remediating the result of the PTAB and its own panel’s finding that two cited references directed to the same article of manufacture without drastic departures in visual impression were unavailable as prior art to a claimed design.



The title of a design patent application continues to be critically important because it defines both the scope of the claimed design as an article of manufacture and the relevant scope of prior art available for invalidating a design patent issuing from the application.



Applicants may consider filing multiple partial designs for broadening the scope of a claimed design while isolating certain portions of the design that may highlight differences from available prior art, especially for crowded fields with many analogous articles of manufacture.

# TRADEMARK

## USPTO Implements New Trademark Fee Schedule



By [Audrey E. Trace](#), [Matthew L. Frisbee](#), and [Lauren B. Emerson](#)

The U.S. Patent and Trademark Office (“USPTO”) has announced changes to its fee schedule for 2025. Key changes include a new pricing structure for applications and higher rates for certain services. The majority of the changes will take effect on January 18, 2025. The new application fee structure is aimed at incentivizing applicants to adopt the USPTO’s pre-approved language to identify their goods and services, and to file shorter and more complete applications. Applicants who do otherwise will face “surcharges” that will meaningfully increase their filing costs.

The USPTO is replacing its dual application system (TEAS standard and TEAS Plus) with a single basic filing system. The new basic filing fee is \$350 per class. The USPTO is also introducing new surcharges to applications, including:

- 1. A surcharge for free-form text identifications, not taken from the ID Manual, of \$200 per class.**
- 2. A surcharge for “incomplete” applications of \$100 per class.**
  - a. To be complete, an application must satisfy 19 requirements, such as Applicant’s name, domicile address, entity type, correct color claim, mark description, and more.
- 3. A surcharge for free-form identifications over 1,000 characters of \$200 for each additional 1,000 characters, per affected class.**

These surcharges will not only affect new applications, but they will also be applied to any TEAS Plus applications that are still pending on or after January 18. Standard TEAS applications filed before January 18 will not be subject to the surcharges.

A comparison of the other changes is below:

Type of Filing	Current Fee	New Fees
Submission of Intent to Use Evidence (Amendment to Allege Use/Statement of Use)	\$100 PER CLASS	<b>\$150 PER CLASS</b>
5-6 Year Use Declaration	\$225 PER CLASS	<b>\$325 PER CLASS</b>
9-10 Year Renewal Declaration	\$300 PER CLASS	<b>\$325 PER CLASS</b>
Declaration of Incontestability	\$200 PER CLASS	<b>\$250 PER CLASS</b>
Letter of Protest	\$50	<b>\$150</b>
Petition to Director	\$250	<b>\$400</b>
Petition to revive an application	\$150	<b>\$250</b>
Renewal through WIPO	\$300 PER CLASS	<b>\$325 PER CLASS</b>

In addition to the changes for applications filed directly in the U.S., the new fee schedule will impact Madrid filings as well, although with some important differences. First, the fee changes for Madrid filings will not take effect until February 18, 2025. Second, the Madrid filing fee will increase from \$500 per class to \$600 per class. The USPTO believes that the \$100 increase is comparable with what Madrid applicants would pay, on average, if they were filing directly with the USPTO and paying surcharges. Finally, Madrid filings will not be subject to surcharges for “insufficient information,” “free-form text identifications not taken from the manual,” or “free-form identifications over 1,000 characters.”

# TRADEMARK INSIGHTS

The proposed fee structure increases trademark filing fees and creates a series of possible surcharges, adding more complexity when filing trademark applications.



**Applicants and the practitioners advising them will need to be diligent to avoid surcharges.** It is essential that applicants provide information about mark translations, alternate meanings, and correct address information, among other elements required in an initial application, to avoid potential surcharges for “incompleteness”. Additionally, applicants should become more comfortable with using the USPTO ID Manual. The fee structure is clearly designed to encourage use of the ID Manual and shorter identifications. Obtaining pre-filing advice from counsel will be more important and cost-effective going forward.



**Recent TEAS Plus Application Filers Should Take Notice.** The final rule clarified that TEAS Plus applications that are pending on or after January 18, 2025, will be subject to the “insufficient information” surcharge fee. Thus, TEAS Plus applications that are still pending on or after January 18, 2025 might receive an “insufficient information” surcharge fee. This is comparable with the fee that would have been applied for losing TEAS Plus eligibility.



**Be prepared for growing pains.** One purpose of the new fee schedule is to continue to reduce the pendency period for trademark filings. Since the filing boom post-COVID 2020, the USPTO has decreased the application pendency period from around 9 months to about 6.3 months as of September 2024. The ultimate goal is 4.5 months by Fiscal Year 2027. The Office is also hiring and training a greater number of Examining Attorneys than in previous years, in order to handle the increased filings. However, the USPTO anticipates an increase in filings before the final fee schedule takes effect on January 18, 2025. Thus, filers can expect to see examination pendency go back up in the months that follow. It may take some time for both new and seasoned Examining Attorneys and trademark filers to adjust to the fee schedule, and for examination pendency to go back down.

# COPYRIGHT

---

## I'm Registered—Now What? The Value of Recordation with U.S. Customs and Border Protection.



By [Sara E. Gruber](#) and [Audrey E. Trace](#)

---

Congratulations! You have secured valuable protection by obtaining a copyright or trademark registration in the United States. Perhaps you have wisely decided to institute a trademark watch service to keep an eye out for new applications for similar marks and similar offerings. You've got all angles covered...right? Wrong! You haven't considered **recording** your registration with U.S. Customs and Border Protection. In this article, we will explain why recording your registration might be one of the most valuable (and cost effective) steps that you can take to protect your brand.

A federal registration for a copyright or trademark comes with a number of benefits, including the ability to record your registration with U.S. Customs and Border Protection ("CBP"). Recording your trademark or copyright registration is beneficial because it gives CBP the legal authority to detain and destroy unauthorized merchandise at all borders and ports. Essentially, it gives you an added layer of protection against infringement by allowing CBP to police shipments of imported goods on your behalf. (Recordation is only available for goods, since services cannot be imported or exported.)

Recording your registration with CBP is especially valuable if your goods are often the subject of counterfeiting or gray market (or "parallel") imports. Counterfeit goods not only pose significant health and safety risks to consumers but can also damage your brand's reputation and the goodwill you've worked hard to build. This can negatively impact your company's bottom line through lost revenue, downtime, replacement costs, and the need to manage negative publicity. Recordation can protect your brand from third parties that hope to trade off of the valuable goodwill that you have established. "Gray market" goods are those goods that are manufactured

outside of the U.S. with authorization from the trademark owner but are then imported into the U.S. without the trademark owner's authorization. In certain cases, where the gray market goods are "physically and materially" different from the goods authorized for importation into the U.S., CBP will restrict their importation into the U.S. upon request by the trademark owner.

**In order to record your rights with CBP, you will need to submit the following documentation and information:**

- **A valid U.S. registration certificate**

Recordation is only available to federally registered trademark or copyright owners. Trademark owners must have a registration issued by the United States Patent and Trademark Office ("USPTO") on the Principal Register. Copyright owners must have a registration issued by the United States Copyright Office ("USCO").

- **Images of the work or mark as used in commerce**

You will be required to upload images of the work or mark on a product as it would appear when entering the United States at the border.

- **A list of the parties authorized to use the work or mark**

This can include parent/subsidiary companies, manufacturers, distributors, licensees, and more. You should be especially careful in curating this list as any inaccuracies may result in delays at border processing.

- **The country (or countries) of manufacture**

This is the country (or countries) where the goods are made.

- **Point of contact information**

This is who CBP will communicate with regarding enforcement of the recordation. This can be your intellectual property attorney.

- **Fee**

For trademarks, the fee is \$190 per class of goods identified in the trademark registration, and the recordation will remain in effect concurrently with the USPTO registration, if renewed along with the trademark registration. Renewals cost \$80 per class.

For copyrights, the fee is \$190 per copyright, and the recordation will remain in effect concurrently with the USCO registration, if renewed with CBP every 20 years. Renewals cost \$80 per copyright.

In addition to the required submissions, you will have the opportunity to submit a product authentication manual and conduct trainings with CBP. The purpose of the manual is to describe your trademark and/or copyright and to provide clear images of your goods to help CBP identify legitimate goods and to distinguish them from counterfeit merchandise. You can even take it a step further by hosting a live training with CBP to educate them about your goods, which will help them enforce your rights at the border.

Once your registration is recorded, you should be sure to keep up with the required renewals and keep your information (especially as it relates to who is authorized to use the registered rights) up to date. Failing to do so could result in your legitimate products being held up at the border. Having an up-to-date Point of Contact for the records is also important as that person will be contacted by CBP regarding any potentially counterfeit or otherwise potentially infringing goods found at the border.

Consult your intellectual property attorney for more information on recording your registration with U.S. Customs and Border Protection.

# COPYRIGHT INSIGHTS



Recordation of trademark and copyright registrations with U.S. Customs and Border Protection is an impactful and cost-effective way to prevent counterfeit goods from being imported into the United States.



Recordation with CBP affords enhanced protections that unrecorded registrations do not receive, including:

- Enforcement against unauthorized works or “confusingly similar” marks;
- Pre-seizure exchange of information and images;
- Disclosure of information post-seizure (i.e., notice of the name and address of parties associated with seized goods); and
- Penalties to deter future violations.



U.S. Customs and Border Protection is willing to learn (from the registered rights owners themselves) how to quickly identify unauthorized merchandise at the border and there are opportunities to educate U.S. Customs and Border Protection to make enforcement at the border effective.



# LITIGATION

---

## Protecting a Legacy: Leveraging the Power of Common Law Trademarks and Name, Image, and Likeness Rights



By [Vera Glonina](#)

---

Lauren Emerson (Partner & Lead counsel), Cameron Reuber (Partner), and Vera Glonina (Associate) recently represented heirs of a prominent New Jersey civil rights activist, the late Russell Graddy, and helped them successfully resolve a commercial dispute concerning the unauthorized use of Mr. Graddy's name and the family's intellectual property. The civil action was styled *Food Service Solutions LLC et al v. MR. Gs MYMY LLC et al*, 2:24CV08513 (DNJ).

Russell Graddy, known locally simply as "Mr. G", was a prominent African American civil rights activist, successful businessman, and beloved leader of the Paterson, New Jersey community. Mr. G and his family operated the iconic Mr. G's Diner in Paterson, which received widespread acclaim, inclusive of special features in multiple publications as well as thousands of positive reviews.

After Mr. Graddy's passing in December 2021, his family sold the Paterson diner facility and real estate to a local developer before relocating to Catskill, New York to begin preparations to reopen there. Notably, the sale did not include any intangible assets associated with Mr. Graddy, including intellectual property. The new owners subsequently sought the family's permission to open a new diner by the same name, but the Graddy family declined. Unwilling to take "No" for answer, the new owners persisted in moving forward with plans to stage a "Grand Re-Opening" of the Mr. G's Diner at the same location as the original, but with completely new ownership and no connection whatsoever to the Graddy family.

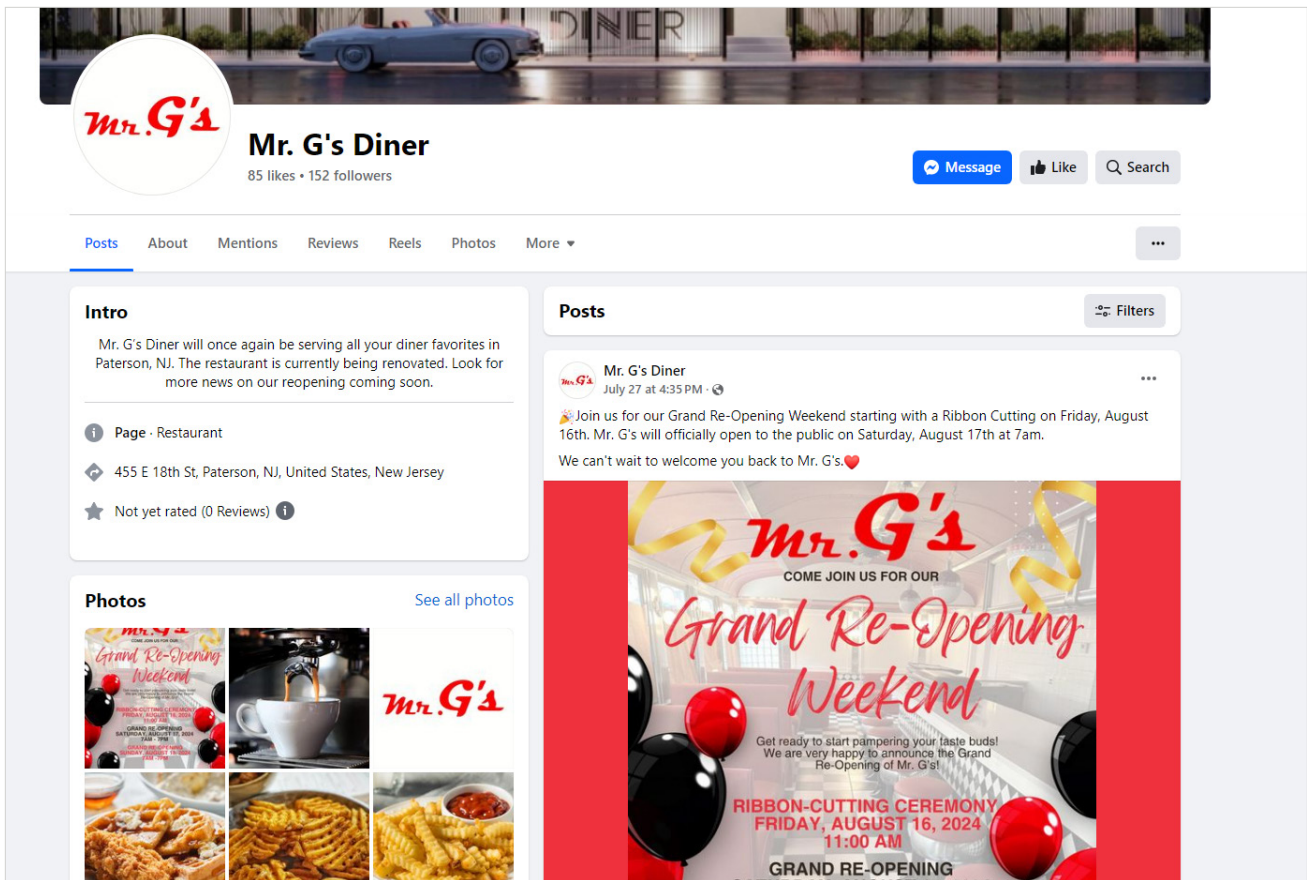


Image Source: <https://www.facebook.com/mrgsdiner> (08/12/2024)

This “re-opening” of a copycat diner that never previously existed was actively promoted on social media and included various instances of the name and likeness of Mr. Graddy being exploited for commercial gain, often with the copycat diner purporting to trade off the consumer goodwill earned by the original Mr. G’s. This proved to be the last straw for Mr. Graddy’s heirs, who sought counseling and assistance from Leason Ellis.

Ultimately, after diplomatic efforts failed, Leason Ellis prepared and filed a complaint for, *inter alia*, trademark infringement, false advertising, and misappropriation of right of publicity. Concurrently therewith, a motion for preliminary injunction was filed on the same day as the copycat diner’s “re-opening” celebration. Shortly thereafter, the new property owners decided to comply with the family’s wishes and voluntarily ceased all business activities and closed the diner. The parties eventually settled their differences regarding who owns the exclusive rights to Mr. G’s name, image, likeness, and trademark rights: Mr. Graddy’s family.

# LITIGATION INSIGHTS



Trademark rights accrue by law through priority of commercial use of a trademark. 5 U.S.C. § 1125(A). See *United Drug Co. v. Theodore Rectanus, Co.*, 248 U.S. 90, 97 (1918) (“There is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.”).



Trademark rights can only be considered “abandoned” when such “use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127. A party seeking to adopt another’s mark on the basis of abandonment must either provide evidence of three consecutive years of nonuse or prove discontinued use and intent not to resume use.



To mitigate risks of inadvertent violation of third parties’ common law trademark and publicity rights, it is crucial to conduct a *comprehensive* clearance search before exploiting any trademarks and/or filing an application for a federal trademark registration.

# IN CASE YOU MISSED IT

---

## **Leason Ellis Partner Melvin Garner Participates in PLI Panel on Patent Licensing**

On September 11, 2024, Melvin Garner participated in a panel titled “A Deeper Look at Real Deal Terms: Analysis of a Patent License Agreement” at the Practising Law Institute’s “Advanced Patent Licensing 2024” program.

## **Leason Ellis Attorneys Participate in AIPLA 2024 Annual Meeting—Partner Lauren Emerson Appointed to the AIPLA Board of Directors**

Leason Ellis attorneys Lauren Emerson, Melvin Garner, Vera Glonina, and Cameron Reuber attended the AIPLA Annual Meeting 2024 held from October 24 to 26, 2024, at the Gaylord National Resort and Conference Center in National Harbor, Maryland. The meeting included various educational sessions for IP law practitioners as well as networking events.

During the event, Leason Ellis Partner Lauren Emerson spoke on a panel entitled Trademarks, Upcycling, and Reuse hosted by the Online IP Enforcement and Anti-Counterfeiting Committee. Lauren’s co-panelist was Peter Schramm of MLL Legal in Zurich.

Lauren also spoke at the AIPLA IP Practice in Japan Pre-Meeting on trademark prosecution issues involving “Consent Agreements and Names of Living Individuals” on October 23. Additionally, The Newtonian is proud to report that Lauren has been elected to the AIPLA Board of Directors for the upcoming three-year term.

## **Leason Ellis Attorneys Win UDRP Proceeding for Client**

Leason Ellis Partner Peter Sloane and Associate Audrey Trace represented Respondent in a UDRP proceeding before WIPO, *6805183 Canada, Inc. v. izzet zakuto, Ghetto Teknoloji Yazilim Anonim Sirketi*, Case No. D2024-3018. The Complainant in the case operates a website at [www.rabbitscams.com](http://www.rabbitscams.com) and owns a federal registration of the mark RABBITS CAMS for internet streaming and telecommunications services. Our client, the Respondent, owns a website at [www.rabbitvideochat.com](http://www.rabbitvideochat.com), which allows users to meet new people and chat with each other by video. In response to the Complaint, we filed a brief which argued that our client’s domain name is not identical or confusingly similar to complainant’s mark, our client has a legitimate interest in its domain name, and the domain name was not registered or used in bad faith. The panelist with the National Arbitration Forum agreed with our position and denied the Complaint in a decision dated September 17, 2024. The win was extremely important to our client, which was able to maintain its online business without interruption.

### **Peter Sloane Publishes Article on Trademark Portfolio Management**

Leason Ellis Partner Peter Sloane's article, "Global Trademark Portfolio Management: A Primer for Inside and Outside Counsel," was published in IPOwners Quarterly on October 8, 2024. The piece provides strategies for effective collaboration between in-house and outside legal counsel in managing trademark portfolios. You can find a copy on our website at <https://leasonellis.com/global-trademark-portfolio-management-a-primer-for-inside-and-outside-counsel>.

### **Matt Frisbee Attends Marques Conference in Stockholm**

Matt Frisbee recently attended the 38th Annual Marques Conference in September in beautiful Stockholm, Sweden, a vibrant city renowned for its numerous prestigious brands.

### **Leason Ellis Team Attend INTA Leadership Conference in New Orleans**

Leason Ellis attorneys Melissa Alcantara, Lauren Emerson, Matt Frisbee, Sara Gruber, Yuval Marcus, Marty Schwimmer, Peter Sloane, and Audrey Trace attended the INTA Leadership Meeting in New Orleans in mid-November and hosted an event for clients and friends of the firm in the Big Easy on November 12, 2024.

### **Leason Ellis Partner Lauren Emerson Spoke at the Copyright, Trademarks & Fashion Session of NYIPLA Bootcamp**

Lauren Emerson spoke at the Copyright, Trademarks & Fashion session of the IP Transactions Bootcamp held by the New York Intellectual Property Law Association (NYIPLA) on October 8, 2024. The session addressed critical trademark and copyright issues that professionals must consider when negotiating agreements like licenses, assignments, and co-branding ventures. As co-chair of the Trademark and Copyright Practice Group at Leason Ellis, Lauren's experience provided fellow professionals with valuable guidance on navigating these complex transactions to effectively protect and leverage intellectual property. Lauren also serves on the Board of Directors for the NYIPLA.

### **Leason Ellis Partner Lauren Emerson Spoke at Romance Author Mastermind Event in Houston**

Leason Ellis Partner Lauren Emerson spoke at the Romance Author Mastermind conference held in October in Houston. Lauren's presentation "Signing Smart: Essential Contract Tips for Today's Romance Writer" emphasized the importance of fully comprehending the terms of agreements, being aware of the rights gained or forfeited and the potential risks involved. Lauren delved into a discussion of trademark licensing and art agreements, including those for pre-made cover designs. The talk was replayed at a virtual version of the conference in November and was followed by a live Q&A.

## **Leason Ellis Associate Vera Glonina Publishes Article Titled “Back to the Future with Blockchain Domain Names: Toward a Global Policy to Fight Cybersquatting in Web 3.0” in INTA Trademark Reporter**

Vera Glonina’s article discusses blockchain domain names and shortcomings of the trademark protection framework in Web 3.0. Blockchain domain names are a new and evolving technology at the heart of Web 3.0. However, blockchain domain names present numerous challenges from a legal perspective, including those related to trademark law and specifically cybersquatting. The article explores these challenges and various potential solutions, including reexamining cybersquatting regulations and developing industry-specific measures.

## **Leason Ellis Associate Audrey Trace Named Vice President of Inn of Court in New Haven**

Audrey Trace has been appointed Vice President of the Judge Janet Bond Arterton Inn of Court in New Haven, Connecticut. The Arterton Inn is one of twenty-three American Inns of Court in the United States and Japan with a focus on Intellectual Property.

## **Leason Ellis Sponsors ACC Westchester-Southern Connecticut Golf Outing**

Leason Ellis proudly sponsored the Association of Corporate Counsel (ACC) Westchester-Southern Connecticut’s 4th Annual Golf Outing at Rye Golf Club on October 7, 2024. Leason Ellis Partners Melvin Garner and Yuval Marcus participated alongside Steve Klocinski of MasterCard and George MacDonald of Hubbell.

## **Leason Ellis Sponsors ACC Westchester Brewery Event**

Leason Ellis recently sponsored an Association of Corporate Counsel (ACC) Westchester brewery outing, held on September 24, 2024, at Wolf & Warrior Brewery. This engaging evening featured a fun-filled night of trivia and games, reinforcing our firm’s commitment to fostering community connections and networking opportunities among legal professionals.



## **Leason Ellis Team Participates in Summer Fun Run**

The Leason Ellis team participated in the Westchester 5K Corporate Fun Run over the summer, which provided a night of running/walking, team building, and fun for companies large and small in Westchester County.

## **Leason Ellis Softball Team Finishes Historic Season in Second Place**

After a last place finish in 2023, the Leason Ellis co-ed softball team finished in second place during the spring/summer softball season, falling 2-1 in a mid-August three-game championship series.

## **Leason Ellis Partner Melvin Garner to Participate in PLI Panel on IP Portfolio Management**

Melvin Garner is set to speak at another PLI panel on “Designing, Creating, and Pruning an IP Portfolio” on January 9-10, 2025, where he will present live.

### **Drop Us A Line**

We're always thinking and know you are too, so we welcome your comments, questions, and suggestions. As a firm dedicated to the application of keen insight in intellectual property law and business, our goal is to make The Newtonian a useful periodical that you read and share. Reach us at [inquiries@leasonellis.com](mailto:inquiries@leasonellis.com).

### **About Leason Ellis**

Clients engage Leason Ellis to obtain outstanding legal counsel to protect and enforce their intellectual property rights. Our specialized practice area excellence comes from a keen appreciation for inventiveness, creativity, branding, a profound understanding of the law, and a powerful commitment to using IP to help our clients achieve their business objectives. Learn more about Leason Ellis at [leasonellis.com](http://leasonellis.com).

Leason Ellis LLP  
One Barker Avenue  
White Plains, New York 10601  
T 914.288.0022

*Attorney Advertising*