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INTELLECTUAL PROPERTY ATTORNEYS

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18th Anniversary Issue

LETTER FROM THE EDITOR

Dear Friends and Colleagues,

This issue of The Newtonian is a special one for us: it marks the 18th anniversary of Leason Ellis. Reaching this milestone invites both reflection and celebration—reflection on nearly two decades of thoughtful advocacy and trusted client service, and celebration of the people whose care, insight, and attention to detail have made it all possible.

That same attention to detail is on display throughout the articles in this issue, each of which addresses evolving legal issues and the practical realities they create for innovators and brand owners alike.

COPYRIGHT

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Catherine Kim and Robert Isackson consider recent developments affecting damages analyses and their broader implications for IP litigation strategy.

As always, this issue also highlights what has been happening across the firm. In the In Case You Missed It section, you will find updates on recent awards and recognitions, as well as snapshots from time spent together—whether in the office, on the softball field, or at conferences around the world. These moments reflect the collaborative spirit and shared enthusiasm that continue to define our community.

Eighteen years in, we remain committed to delivering practical, thoughtful insight on the issues that matter to our clients and colleagues. Thank you for being part of that journey and for your continued interest in The Newtonian. As always, we welcome your feedback.

Warmly,

Henry A. Gabathuler
Partner
Editor, The Newtonian

PRACTICE GROUP INSIGHTS

COPYRIGHT

Group Registration of Two-Dimensional Artwork ("GR2D")

By Sara E. Gruber

In a move that is particularly favorable to artists and other creators, the U.S. Copyright Office recently introduced a new group registration option for two-dimensional (2D) artwork. Previously, applicants seeking to register published 2D artwork had to submit a separate application for each individual work, at a filing fee of $65 per application. Under the new rule, applicants can apply to register up to twenty works for only $85. When fully utilized, this reduces the effective filing fee to approximately $4.25 per work, nearly a ninety-three percent decrease in the cost per work.

The Copyright Office's Final Rule, which took effect on February 17, 2026, follows requests from stakeholder groups such as the Copyright Alliance and the Coalition of Visual Artists to establish a new group registration option for two-dimensional artwork. These constituents noted that 2D artworks are particularly susceptible to downstream infringement and are often created in such significant quantities that artists choose not to register their works due, in part, to cost and logistical considerations.

In response, the Copyright Office created the **Group Registration of Two-Dimensional Artwork ("GR2D")** to improve accessibility to copyright registration while balancing the Copyright Office's administrative capabilities to examine such applications. Although multiple works may be submitted together under the GR2D application, each work registered is treated as a separate work of authorship.

To take advantage of the GR2D option, applicants must satisfy several requirements and provide the Copyright Office with certain information and documentation:

- **Scope:** Eligible works are limited to "pictorial or graphic work[s] that [have] been fixed in a two-dimensional form," such as character artwork, paintings, illustrations, fabric designs, and logos. A group must include at least two and no more than twenty works that each contain a sufficient amount of original authorship.
- **Titles:** The applicant must provide a title for each individual work, along with a title for the group as a whole.
- **Publication:** All works included in the group must have been published within the same calendar year. Applicants must identify the earliest and latest publication dates among the works and also provide the month of publication for each remaining work in the group.
- **Author/Claimant:** All works in the group must be created by the same author, and that author must be named as the sole claimant. Works made for hire are eligible, but works created by common or joint authors are not
- **Deposit:** One complete copy of each work must be submitted. Each work must be uploaded in a separate file, and each file name must correspond to the title of the work as listed in the application.

The new GR2D application provides a significantly more cost-effective method for registering two-dimensional artwork. Although the new process may increase examination time due to the number of works included in each application, it is expected to make copyright registration more accessible for creators, including individual artists and small businesses, seeking to protect their works.

If you have questions about structuring cost-effective filing programs to fit your business, please contact our office.

COPYRIGHT INSIGHTS

- **The Copyright Act gives the Register of Copyrights certain authority and discretion.** Specifically, the Copyright Act gives the Register of Copyrights the authority to specify the classes of work available for registration and the deposit required for each class. Further, the Copyright Act gives the Register of Copyrights the discretion to allow groups of related works to be registered together under a single application and filing fee.

- **The Copyright Office is amenable to public input and is responsive to demonstrated industry needs.** Indeed, after receiving requests from stakeholder groups to create a new group registration option for two-dimensional works, the Copyright Office issued a Notice of Proposed Rulemaking ("NPRM") outlining the proposed requirements for registration. The Copyright Office received and considered fourteen comments to the NPRM before adopting the Final Rule, illustrating how engagement from the public can directly influence copyright policy.

- **Copyright registration can provide significant legal and commercial benefits,** including establishing a public record of ownership, enabling infringement actions, and in some cases, eligibility for statutory damages and attorney's fees. By lowering cost and administrative barriers, the GR2D option expands access to these benefits for artists and other creators.

TRADE SECRET

Trade Secrets & Employee Mobility: Mapping the Fractured Landscape of the Inevitable Disclosure Doctrine

By Robert M. Isackson, Yilan Wang

1. Background

The inevitable disclosure doctrine permits a plaintiff in a trade secrets case to "prove a claim of trade secret misappropriation by demonstrating that defendant's new employment will inevitably lead the defendant to rely on the plaintiff's trade secrets," as articulated in the seminal case *PepsiCo, Inc. v. Redmond*, 54 F.3d 1262, 1269 (7th Cir. 1995). The doctrine frequently arises in the context of temporary or preliminary injunctive relief and is controversial because it potentially "requires a court to recognize and enforce a *de facto* non-competition agreement to which the former employee is bound, even where no express agreement exists."[1] Accordingly, states with strong public policies favoring employee mobility tend either to reject the inevitable disclosure doctrine outright[2] or to construe it narrowly.

The Defend Trade Secrets Act (DTSA), enacted in 2016, advanced a more uniform federal standard for trade secret protection and clarified key contours of the law. However, the DTSA did not expressly adopt the inevitable disclosure doctrine. Instead, the DTSA includes specific limitations on injunctive relief granted by federal courts to prevent "actual or threatened misappropriation" of trade secrets. DTSA prohibits injunctions that "prevent a person from entering into an employment relationship" and requires that conditions placed on employment be "based on evidence of threatened misappropriation and not merely on the information the person knows."[3] The legislative history explains that this limitation was included because of the concern that the injunctive relief authorized under the DTSA could override state-law limitations that safeguard

1. *LeJeune v. Coin Acceptors, Inc.*, 381 Md. 288, 322, 849 A.2d 451 (2004) (quoting *Whyte v. Schlage Lock Co.*, 101 Cal. App. 4th 1443 (2002)).
2. See *Whyte v. Schlage Lock Co.*, 101 Cal. App. 4th 1443 (2002).
3. 18 U.S.C. §1836(b)(3)(A)(i)(I).

employee mobility and thus could be a substantial departure from existing law in those states.[4] Although the DTSA does not preempt state trade secret laws and is silent on whether it adopts the inevitable disclosure doctrine, federal courts have concluded that the DTSA forecloses federal courts from granting relief based solely on inevitable disclosure because such relief would restrain employment.[5]

In light of the DTSA's emphasis on protecting employee mobility, states have started to reconsider the viability and practical implementation of the inevitable disclosure doctrine under their own trade secret laws, seeking to strike an appropriate balance between trade secret protection and employee mobility.

2. Summary of State Stances

In 2019, the United States District Court for the District of Oregon, in *Phoseon Tech., Inc. v. Heathcote*[6], surveyed the status of the inevitable disclosure doctrine and found that seventeen states appeared to have adopted the doctrine in one form or another, while five states appeared to have rejected it. The remaining twenty eight states had not yet decided whether to follow the inevitable disclosure doctrine. Since then, additional decisions have clarified how courts view the doctrine, and most of those later decisions have declined to adopt it.[7]

As of 2025, thirteen states have adopted some version of the inevitable disclosure doctrine, those states being Arkansas, Connecticut, Delaware, Indiana, Illinois, Iowa, Minnesota, New Jersey, New York, North Carolina, Ohio, Pennsylvania, and Utah. Twelve states appear to have rejected the doctrine, those states being California, Colorado, Florida, Idaho, Louisiana, Massachusetts, Maryland, Michigan, Missouri, Oregon, Texas, and Virginia. The remaining twenty five states have not definitively resolved whether to follow the inevitable disclosure doctrine.

In addition to the increase in jurisdictions that have expressly declined to adopt the doctrine, those states that do recognize inevitable disclosure apply it in a markedly inconsistent manner. Courts in these jurisdictions generally emphasize that injunctive relief premised on inevitable disclosure requires intensive, fact specific analysis, reflecting continuing concern about employee mobility and de facto restraints on competition. Taken together, the authorities indicate that most adopting states pair recognition of the doctrine with significant limitations on its use. These jurisdictions may be grouped into three general categories, based on how clearly they recognize the doctrine, how frequently they apply it, and how narrowly they cabin its scope.

4. S. Rep. No. 114-220 at 9 (2016).

5. *Fair Isaac Corp. v. Gurobi Optimization, LLC*, No. CV 25-00194-RGA, 2025 WL 2636403, at *5 (D. Del. Sept. 12, 2025) ("a significant number in multiple circuits across the country have found that the doctrine is not available to support an injunction of the sort that Plaintiff requests"); citing *WCG Clinical, Inc. v. Sitero, LLC*, 2025 WL 107662, at *3 (S.D. Ind. Jan. 15, 2025) ("Recently, courts in this circuit have held that '[w]hile 'inevitable disclosure' can be a viable theory under state law, it appears to be foreclosed for claims under the DTSA.' "), and *Kinship Partners, Inc. v. Embark Veterinary, Inc.*, 2022 WL 72123, at *7 (D. Or. Jan. 3, 2022) ("Pursuant to federal law, the DTSA specifically forecloses courts from granting relief based on the inevitable disclosure doctrine because such relief restrains employment.").

6. *Phoseon Tech., Inc. v. Heathcote,* No. 3:19-CV-2081-SI, 2019 WL 7282497, at *11 (D. Or. Dec. 27, 2019).

7. *See Kinship Partners, Inc. v.* Embark Veterinary, Inc., 2022 WL 72123 (D. Or. Jan. 3, 2022) ("Oregon has opined that Oregon would be unlikely to adopt the doctrine.").

Category 1—Consistent and Structured Implementation

Courts in Arkansas, Illinois, Pennsylvania, New Jersey, and Ohio expressly recognize inevitable disclosure as a valid theory of "threatened misappropriation" in circumstances where actual misappropriation cannot be established. These courts generally follow, expressly or implicitly, the framework articulated in *PepsiCo, Inc. v. Redmond*, considering, among other factors, the degree of competition between the former and new employers, the similarity between the employee's prior and new roles, and the measures undertaken by the new employer to prevent use or disclosure of the former employer's trade secrets.[8] To address the concerns surrounding restrictions on employee mobility, courts in these states repeatedly emphasize that they will not assume inevitability and require the plaintiff to show an intent or a high probably that the employee will use trade secrets,[9] the sensitivity and commercial value of the information at issue,[10] and the employee's lack of independent experience sufficient to perform the new position without resort to the former employer's trade secrets.[11]

Category 2—Narrow and Cautious Implementation

Courts in Connecticut, New York, North Carolina, and Indiana recognize inevitable disclosure doctrine as a viable theory but repeatedly stress that the doctrine is disfavored and requires a substantial factual showing to support relief.

Connecticut courts characterize the doctrine as narrow and seldom applied,[12] often requiring the presence of a non-competition agreement or a very high degree of competitive overlap.[13] Indiana courts have stated that the doctrine will be invoked only in "rare and narrow" circumstances, typically where there is evidence of bad faith in the taking or threatened taking of confidential information.[14] New York courts apply a multifactor analysis that considers, among other things, the nature of the competition, the similarity of the positions, the value and sensitivity of the information, and the industry context, while repeatedly labeling the doctrine "judicially disfavored" and reserving its use for situations presenting a particularly acute risk of misuse.[15] North Carolina courts have indicated that, although the doctrine may be applied in some circumstances, it is not clearly defined under state law and should be employed only to tailor the scope of an employee's new responsibilities, not to bar employment with a competitor entirely.[16]

8. *Packaging Corp. of Am., Inc. v. Croner*, 419 F. Supp. 3d 1059, 1070 (N.D. Ill. 2020).

9. *Saban v. Caremark Rx, L.L.C.,* 780 F. Supp. 2d 700, 734 (N.D. Ill.2011).

10. *Freedom Med. Inc. v. Whitman,* 343 F. Supp. 3d 509, 521 (E.D. Pa. 2018).

11. *Nonmacher v. Tri-State Iron & Metal Co.*, 2025 Ark. App. 356, 32, 718 S.W.3d 1, 20 (2025).

12. *Sunbelt Rentals, Inc. v. McAndrews*, 552 F. Supp. 3d 319, 330–31 (D. Conn. 2021).

13. *Aetna, Inc. v. Fluegel*, No. CV074033345S, 2008 WL 544504, at *6 (Conn. Super. Ct. Feb. 7, 2008).

14. *WCG Clinical, Inc. v. Sitero, LLC*, No. 1:24-CV-01080-JRS-MKK, 2025 WL 107662, at *3 (S.D. Ind. Jan. 15, 2025).

15. *Vortexa Inc. v. Cacioppo,* No. 1:24-CV-02065 (JLR), 2024 WL 2979313, at *11 (S.D.N.Y. June 12, 2024).

Category 3—Theoretical Adoption with Limited Implementation

Courts in Iowa, Minnesota, Delaware, and Utah have acknowledged the inevitable disclosure doctrine in principle, but there is relatively little authority applying it, and the contours of the doctrine remain indistinct. In some instances, state and federal courts within the same jurisdiction have taken divergent approaches.

The Southern District of Iowa, for example, has described inevitable disclosure as "one way of showing a threatened disclosure in cases where additional evidence showing the existence of a substantial threat of impending injury is unavailable to the movant."[17] However, the Court also noted that the Iowa Supreme Court has not adopted the inevitable disclosure doctrine.[18] Minnesota courts have stated that they have not taken a position on whether to adopt inevitable disclosure but have find "the rationale helpful when evaluating likelihood of misuse."[19] Delaware and Utah likewise lack detailed decisions explaining when inevitable disclosure will support injunctive relief and what evidentiary showing is required, leaving the practical scope of the doctrine in those jurisdictions uncertain.

3. Conclusion

In summary, the current landscape reflects that adoption of the inevitable disclosure doctrine remains both inconsistent and constrained, and the number of states willing to adopt it has continued to shrink. Only five states have adopted structured approaches to implementing the doctrine, but even in these jurisdictions, courts impose rigorous, fact intensive requirements and emphasize narrowly tailored injunctive relief. Several other states recognize the doctrine only grudgingly, characterize it as disfavored, and confine its use to exceptional circumstances. A growing number of jurisdictions have either rejected inevitable disclosure or have refrained from adopting the doctrine in any meaningful way.

In light of this uneven landscape, employers should avoid relying on the doctrine of inevitable disclosure to protect their trade secrets. More effective protection lies in a systematic trade secret protection strategy: well-drafted confidentiality agreements and enforceable restrictive covenants, together with robust access controls, thorough exit interviews, and prompt enforcement when actual misappropriation is identified.

16. *Spirax Sarco, Inc. v. SSI Eng'g, Inc.*, No. 5:14-CV-519-F, 2015 WL 1810093, at *5 (E.D.N.C. Apr. 17, 2015).

17. *Smithfield Packaged Meats Sales Corp. v. Dietz & Watson, Inc.*, 452 F. Supp. 3d 843, 862 (S.D. Iowa 2020), modified in part, No. 120CV00005RGECFB, 2020 WL 5579177 (S.D. Iowa July 24, 2020), and modified, No. 120CV00005RGECFB, 2021 WL 2627454 (S.D. Iowa Apr. 23, 2021).

18. *Id.*

19. *Cambria Co. LLC v. Schumann,* 2020 WL 373599 (D. Minn. 2020).

Summary Table

State	Formal adoption? (state law)	Typical stance / use	Notable points
Arkansas	Yes (supreme court)	Available, fact specific, requires strong showing	The court in the *Cardinal Freight*[20] and *Nonmacher*[21] cases approved injunctions for "threatened or inevitable misappropriation."
Connecticut	Yes but narrow; rarely used	Disfavored, often limited to cases with non-competes	The court in the *Aetna*[22] and *Sunbelt*[23] cases recognized the doctrine but emphasized its narrowness and unsettled scope without a non-compete.
Delaware	Yes (Chancery; UTSA)	Used to show threatened misappropriation; DTSA more limited	The court in the *W.L. Gore*[24] case recognized risk based injunctions; later cases distinguished DTSA's stricter standard.
Indiana	Viable but disfavored	Only in rare bad faith situations	The court in the *Dearborn*[25] and *WCG*[26] cases required evidence of bad faith and rejected DTSA based inevitable disclosure.
Illinois	Yes (strong)	Mature, structured test, but cautious about mobility	The *PepsiCo*[27] case set the core framework; recent cases split state law vs DTSA analysis.
Iowa	Not formally, but applied	Used as method to prove "threatened" misappropriation	Federal courts under IUTSA accept inevitable disclosure as evidentiary path.
Minnesota	Neither accepted nor rejected	Factors sometimes used, but no formal doctrine	Courts note the doctrine but stop short of express adoption.
New Jersey	Yes	Actively used where actual use cannot be shown	The courts in the *Corporate Synergies*[28] and *Sunbelt*[29] cases apply inevitability under NJTSA and conceptually under DTSA.

New York	Yes, but "narrow path"	Applied in high risk cases; disfavored in marginal ones	The courts in the *EarthWeb*,[30] *Papermaster*,[31] and *Vortexa*[32] cases enforce strict factor based approach to inevitability.
North Carolina	Predictive / "soft adoption"	Used via multi factor irreparable injury analysis; no formal state adoption	The courts in *Merck*[33] and *Spirax*[34] predict adoption but caution against de facto non-competes.
Ohio	Yes (per survey and cases)	Used to show irreparable harm and threatened misuse	The court in the *Invacare*[35] case recognized inevitable disclosure as basis for irreparable harm finding.
Pennsylvania	Yes (strong)	Routinely used for threatened misappropriation	The *Bimbo Bakeries*[36] case is leading Third Circuit application under PUTSA.
Utah	Predictive adoption (federal)	Applied by federal courts on strong facts; no state appellate ruling	Federal decisions and surveys group Utah among adopters, but appellate courts have not spoken.

20. *Cardinal Freight Carriers, Inc. v. J.B. Hunt Transp. Servs., Inc.*, 987 S.W.2d 642 (Ark. 1999).
21. *Nonmacher v. Tri-State Iron & Metal Co.*, 718 S.W.3d 1 (Ark. App. 2025).
22. *Aetna, Inc. v. Fluegel*, No. CV074033345S, 2008 WL 544 (Conn. Super. Ct. Feb. 7, 2008).
23. *Sunbelt Rentals, Inc. v. McAndrews*, 552 F. Supp. 3d 319 (D. Conn. 2021).
24. *W.L. Gore & Associates, Inc. v. Wu*, 2006 WL 2692584 (Del. Ch. 2006).
25. *Dearborn v. Everett J. Prescott, Inc.*, 486 F. Supp. 2d 802 (S.D. Ind. 2007).
26. *WCG Clinical, Inc. v. Sitero, LLC*, No. 1:24-CV-01080-JRS-MKK, 2025 WL 107662 (S.D. Ind. Jan. 15, 2025).
27. *PepsiCo, Inc. v. Redmond*, 54 F.3d 1262 (7th Cir. 1995).
28. *Corp. Synergies Grp., LLC v. Andrews*, No. 18-13381, 2019 WL 3780098 (D.N.J. Aug. 12, 2019).
29. *Sunbelt Rentals, Inc. v. Love*, No. 20-17611 (RMB/AMD), 2021 WL 82370 (D.N.J. Jan. 11, 2021).
30. *EarthWeb, Inc. v. Schlack*, 71 F. Supp. 2d 299 (S.D.N.Y. 1999).
31. *Int'l Bus. Machines Corp. v. Papermaster*, No. 08-CV-9078(KMK), 2008 WL 4974508 (S.D.N.Y. Nov. 21, 2008).
32. *Vortexa Inc. v. Cacioppo*, No. 1:24-CV-02065 (JLR), 2024 WL 2979313 (S.D.N.Y. June 12, 2024).
33. *Merck & Co. Inc. v. Lyon*, 941 F. Supp. 1443 (M.D. N.C. 1996).
34. *Spirax Sarco, Inc. v. SSI Eng'g, Inc.*, No. 5:14-CV-519-F, 2015 WL 1810093 (E.D.N.C. Apr. 17, 2015).
35. *Invacare Corp. v. Nordquist*, No. 1:18-CV-62, 2018 WL 2454523 (N.D. Ohio June 1, 2018), modified in part, No. 1:18-CV-62, 2018 WL 3768278 (N.D. Ohio Aug. 9, 2018).
36. *Bimbo Bakeries USA, Inc. v. Botticella*, 613 F.3d 102 (3d Cir. 2010).

TRADE SECRETS INSIGHTS

- **State approaches toward adaptation of inevitable disclosure remain fractured and increasingly skeptical.** As of 2025, fewer than half of states recognize inevitable disclosure in any form, and recent decisions trend toward rejection or narrow application.
- **Even "adopting" states apply the doctrine sparingly.** Courts that recognize inevitable disclosure require a rigorous, fact intensive showing and narrowly tailored relief to avoid de facto non competes and protect employee mobility.
- **Practical protection requires proactive controls.** Employers are better served by enforceable confidentiality and restrictive covenant agreements, disciplined access management, careful employee exits, and prompt action when actual misappropriation arises.

PRACTICE GROUP INSIGHTS

PATENT

Navigating Subject Matter Eligibility §101 for Diagnostics in a Changing Patent Landscape

By Dr. Susie S. Cheng

Subject matter eligibility under 35 U.S.C. §101 has long been a challenging hurdle for biotech and pharmaceutical innovators. Diagnostic method claims have been especially difficult, with federal courts invalidating virtually every diagnostic assay patent challenged post-*Mayo* (*Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). But recent USPTO actions signal a meaningful shift in how eligibility is evaluated at the examination stage, creating new opportunities for applicants who act strategically and leverage evolving USPTO guidance.

A recently issued U.S. Patent, U.S. Patent No. 12,419,201, directed to cancer diagnostic methods, illustrates this shift. Since late 2025, our firm has observed this change firsthand. Diagnostic patent applications that previously faced persistent §101 rejections are now either advancing to allowance or no longer receiving eligibility rejections. The following strategies reflect developments in USPTO practice and PTAB review and are designed to help applicants secure and maintain strong, enforceable diagnostic patents.

1. Leverage the August 2025 Kim Memo in Prosecution

On August 4, 2025, USPTO Deputy Commissioner Charles Kim issued guidance reminding examiners that: (i) §101 rejections should be made only when there is a clear basis for concluding that a claim is more likely than not ineligible-mere uncertainty is insufficient; (ii) claims must be evaluated as a whole, rather than isolating individual claim limitations; and (iii) an advantageous technological outcome should be recognized as a technological improvement for eligibility purposes.

Reminding an examiner of this guidance may help to address reflexive or inadequately supported §101 rejections in diagnostic applications. It provides a strong framework for challenging conclusory eligibility rejections in written responses and is useful during examiner interviews involving diagnostic claims.

2. Consider Filing a Subject Matter Eligibility Declaration (SMED)

Consistent with recent USPTO guidance to the Patent Examining Corps, including the April 30, 2026 USPTO memorandum, Subject Matter Eligibility Declarations ("SMEDs") may be used to present objective evidence specifically directed to the §101 analysis. A well-prepared SMED acts as a "constructive model" that helps examiners understand real-world technological application, such as diagnostics, where traditional working models are impractical.

A specification need not explicitly set forth an improvement, as long as it describes the invention in a manner from which one skilled in the art would recognize the technical advancement. When such improvements are not explicitly stated in the specification, they may still be addressed during prosecution. When properly prepared and grounded in the specification, SMEDs are most effective when they provide a clear nexus between the claimed invention and the factual assertions in the declaration. For example, a SMED may: (i) establish the state of the art as of the filing date; (ii) explain why the claimed detection steps cannot practically be performed in the human mind; (iii) present objective evidence, such as performance metrics, demonstrating technological improvements over conventional methods; or (iv) clarify how the claimed method provides a concrete and practical clinical application.

The April 30 memo further emphasizes best practices including avoiding supplementation of the specification, and submitting SMEDs as separate Rule 132 declarations, rather than combining them with obviousness and enablement assertions. A well-prepared SMED can help shift the eligibility inquiry in the applicant's favor. One consideration, however, is that the declarant may be subjected to deposition if the patent is later litigated.

3. Understand the Litigation-USPTO Gap

While the USPTO's more favorable examination posture is encouraging, the federal courts are not bound by USPTO guidance. Patents obtained under current USPTO practice may still face heightened invalidity risk in litigation. Diagnostic innovators should work closely with experienced counsel to ensure the claims are defensible under Federal Circuit precedent and not solely under USPTO guidance standards. Until Congress acts or the Supreme Court revisits §101, careful planning in view of the litigation-USPTO gap remains essential.

4. Monitor PTAB Trends and Learn from Successful Appeals

Since Director John A. Squires took office in September 2025, PTAB treatment of §101 issues have shifted noticeably. PTAB decisions issued since October 2025 have shown an increased rate of reversals of examiner eligibility rejections. Many of these reversals provide lessons for how to better combat §101 rejections during prosecution.

For example, in view of *Ex Parte Desjardins*, Appeal 2024-000567 (PTAB Sept. 26, 2025) a specification that identifies a technical improvement reflected in the claims remains one of the strongest defenses against §101 eligibility rejections. For diagnostic applications, this means articulating how the claimed method improves upon existing detection techniques. For example, does the method enable faster processing, reduce false positives, permit detection at lower analyte concentrations, or integrate previously incompatible assays?

The precedential *Desjardins* decision makes clear that improvements in system functionality or operational efficiency can constitute patent-eligible technological advances. For diagnostics, this principle may extend to improvements in assay design, detection methodology, or clinical workflow. If your application receives a §101 rejection and you have objective evidence of technical improvements, an appeal to the PTAB may be more favorable now than in prior years.

5. Tie Diagnostic Claims to Specific Clinical Actions

Method of treatment claims continue to fare better than pure diagnostic claims under the Mayo/Alice framework. Cases like *Vanda Pharmaceuticals v. West-Ward Pharmaceuticals*, 887 F. 3d 1117 (Fed. Cir. 2018) demonstrate that claims integrating a diagnostic finding into a specific therapeutic action have a better chance of satisfying §101. Where appropriate, applicants should structure claims to include actionable clinical steps. For example, administering a specific therapy based on diagnostic results. This transforms a potentially ineligible observation into a patent-eligible treatment method. One important consideration, however, is enforcement. Claims tying diagnostics to treatment actions may raise questions regarding the proper infringement target, such as whether liability lies with the diagnostic company, the treatment provider, or both.

6. Reassess Previously Abandoned Diagnostic Applications

The current examination environment creates a renewed opportunity to revisit diagnostic innovations that were previously on hold. To the extent companies have pending patent families with disclosures directed to diagnostic methods that were previously rejected or on hold due to §101 concerns, companies should contemplate filing a continuing application as they may have a higher chance of success moving forward.

A Call to Action: Secure Patent Protection for True Innovation

At the USPTO level, the §101 landscape for diagnostics is the most favorable that it has been in over a decade. But success requires strategic execution. Applicants that draft specifications emphasizing technical improvements, integrate diagnostics findings with therapeutic actions, and leverage evidentiary tools, such as separately filed SMEDs, are best positioned to secure enforceable patents without sacrificing claim scope. With careful planning and informed prosecution strategies, diagnostic innovations once deemed patent ineligible can now be meaningfully protected.

PATENT INSIGHTS

The following strategies based on recent developments in USPTO practice and PTAB review could help applicants secure and maintain strong, enforceable diagnostic patents:

- Cite the August 2025 Kim memo when challenging reflexive §101 rejections to remind examiners that uncertainty alone is insufficient to sustain a subject matter eligibility rejection.
- Draft technical improvements into specifications by clearly describing advances in the art, such as faster processing, reduced false positives, lower detection limits, or integrated workflows.
- Use SMEDs strategically by presenting objective evidence of technical improvements and by filing SMEDs separate from other types of evidence.
- Plan for the litigation-USPTO gap by drafting claims to withstand Federal Circuit scrutiny, not just USPTO examination.
- Monitor PTAB Trends to determine the best arguments for addressing future §101 rejections.
- Integrate diagnostics into treatment methods where possible to strengthen chances of eligibility.
- Reassess pending patent families describing diagnostic methods that previously received §101 rejections, as they may now warrant continued prosecution or continuation filings.

PRACTICE GROUP INSIGHTS

PATENT

Fewer Performance Credits, Fewer Conversations? How the USPTO’s FY2026 Performance Appraisal Plan Could Change Examiner Interviews

By Anthony J. Natoli

Patent examiners are central to the quality and efficiency of U.S. patent examination and grant. The way that examiners approach their work, however, is shaped by how the U.S.P.T.O. measures their job performance with “performance credits” for specific tasks. For Fiscal Year 2026, the U.S.P.T.O. adjusted its Performance Appraisal Plan (the FY2026 PAP) which determines how examiners earn such performance credits in conducting interviews with patent applicants. These changes reduce the incentive for examiners to conduct multiple interviews, and could likely impact the interview strategy of patent applicants and practitioners.

The Role of Examiner Interviews

The U.S.P.T.O. has long encouraged examiner interviews with patent applicants as a valuable tool in patent prosecution. The Manual of Patent Examining Procedure (MPEP) expressly recognizes that interviews can help bridge the gap between an examiner and an applicant on substantive issues, and can help to advance examination and to identify patentable subject matter. MPEP §713.

Historically, examiner interviews have often served as an efficient way to clarify issues, test proposed claim amendments, and shorten prosecution by resolving disputes that might otherwise require multiple written exchanges with the U.S.P.T.O.

What Changed Under the FY2026 PAP

Prior to the FY2026 PAP, examiners received one hour of performance credit for each interview held with an applicant. Under the FY2026 PAP, an examiner receives only a single hour of credit for all interviews conducted during a single round of examination. Credit for additional interviews is available only with supervisory approval, or if the application goes into a further round of examination, for example, by the applicant filing a Request for Continued Examination (RCE) for utility inventions, or a Continued Prosecution Application (CPA) for designs, and paying the associated RCE or CPA fees.

Practically, these changes reduce the incentive for examiners to conduct multiple interviews and increases the likelihood that an examiner will schedule just a single interview between the filing of an application and a final rejection or advisory action.

Practical Impact on Patent Applicants

With fewer interviews likely to be available, applicants face a more constrained opportunity to engage and work with an examiner to advance prosecution. Limited access to interviews might lead to increased reliance on written office actions and responses, more back-and-forth exchanges with the examiner, and increased cost and longer pendency of applications.

While a noticeable trend against multiple interviews has not yet become apparent, patent practitioners should plan on only one interview per round of examination, and make the first interview count. Submitting a concise interview agenda to the examiner in advance, which outlines key arguments and proposed claim amendments, can help focus the discussion and facilitate a productive interview. By working with a patent professional having knowledge of such changes to examiner interviews and the below insights, applicants will ensure the best possibility to obtain a positive outcome in the examination of their invention.

PATENT INSIGHTS

- **Plan on only one interview per round** of examination, and make the interview count.
- **Provide the examiner with a concise but specific agenda for the interview** including key arguments and proposed claim amendments in advance, to make the most of the interview.
- **Avoid providing a non-specific agenda to the examiner**, or using the interview as a fishing expedition to feel out the examiner's position.
- **Use available examiner statistical tools** to evaluate their allowance rates and other metrics to understand the examiner's mode of operation.
- **If requesting an additional interview, provide good cause to encourage the examiner, or their supervisor, to grant the additional interview.** Justification might include, for example: the remaining issues are minor and can be easily resolved in an additional interview; an additional interview will advance prosecution; or resolution of the remaining issues requires little preparation on the examiner's part.

PRACTICE GROUP INSIGHTS

TRADEMARK

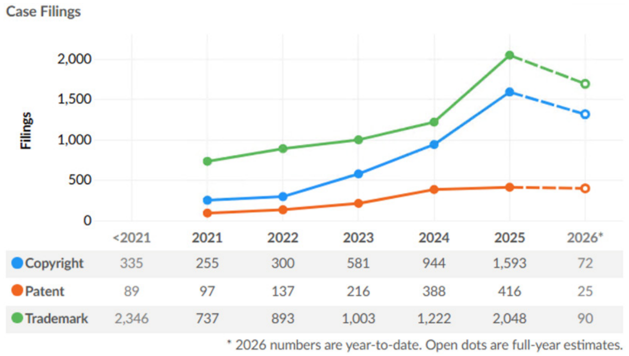
Schedule A Litigation in 2026: Evolving Limits


By Vera Glonina, Peter Sloane

Schedule A litigation refers to cases where intellectual property owners sue multiple online sellers identified in a sealed attachment to the Complaint (the "Schedule A"). As noted by Judge Durkin in *Roblox Corp. v. Bigfinz*, 2023 WL 8258653 (N.D. Ill. Nov. 29, 2023), Schedule A filings are permitted "because… it is the most efficient way to address the epidemic of counterfeit goods being sold in the United States on the internet by defendants located outside the United States."

The structure of a typical Schedule A case enables plaintiffs to seek early *ex parte* relief, including financial account freezes and orders that direct payment processors and marketplaces to disable storefronts, including those operated from outside of the U.S. In many cases, defendants never appear, thereby allowing plaintiffs to leverage default judgments that include permanent injunctions (e.g., disabling defendants' accounts and/or advertisements with respect to counterfeiting goods on major e-commerce platforms) and substantial statutory damages (e.g., $50,000-250,000 per defendant).

According to LexMachina, the total number of Schedule A cases has grown steadily year over year, with trademark cases, especially counterfeiting claims under the Lanham Act, representing the overwhelming majority.



	<2021	2021	2022	2023	2024	2025	2026*
Copyright	335	255	300	581	944	1,593	72
Patent	89	97	137	216	388	416	25
Trademark	2,346	737	893	1,003	1,222	2,048	90

* 2026 numbers are year-to-date. Open dots are full-year estimates.

Source: Lex Machina (March 2026)

While the Northern District of Illinois has emerged as the epicenter of Schedule A litigation, Schedule A cases are not limited to a single jurisdiction. Each year, the number of Schedule A cases filed in different courts across the United States continues to rise.

The widespread rise of Schedule A cases in recent years has engendered critiques, particularly within the academic community. Much of the criticism centers on the tension between the mechanics of Schedule A cases and the traditional framework of the Federal Rules of Civil Procedure, as well as the constitutional guarantees of due process. For example, Professor Eric Goldman of Santa Clara Law School has observed that "[t]he SAD[1] Scheme capitalizes on weak spots in the Federal Rules of Civil Procedure, judicial deference to IP rightsowners, and online marketplaces' liability exposure." Additionally, Professor Sarah Fackrell of Chicago-Kent College of Law asserts that "everyone has a constitutional right to due process, even if they are counterfeiters." The debate relevant to trademark cases frequently concerns the following four aspects:

- Personal jurisdiction. It is disputed whether specific personal jurisdiction can be established only based on a defendant's online activities and/or a single purchase. In particular, courts have increasingly scrutinized whether such allegations establish "purposeful availment" by the defendant, particularly when defendants are foreign sellers operating through third-party online marketplaces (e.g., Amazon, eBay), without otherwise targeting the forum state.
- Rule 65 *ex parte* relief. Scholars and courts in Schedule A cases have increasingly examined the sufficiency of plaintiffs' efforts to establish particularized facts that would warrant ex parte relief in Schedule A cases as required under Fed. R. Civ. P. 65(b)(1)(A).
- Service of process under Rule 4(f). While numerous courts (including the Seventh Circuit) have held electronic service of process on foreign defendants is permissible under Fed. R. Civ. P. 4(f)(3) (especially when physical addresses are not available), some courts have denied relief when plaintiffs have not even attempted to comply with the Hague Service Convention's requirements.
- Joinder under Rule 20(a). In the landmark case of *Bose Corporation v. Partnerships and Unincorporated Associations Identified on Schedule* "A," 334 F.R.D. 511 (N.D. Ill. Feb. 19, 2020), Judge Durkin noted that "[s]eeking relief against each member of the swarm one by one defies common sense, because it is the swarm—the fact that all Defendants are attacking at once—that is the defining aspect of the harm from which Bose seeks relief." Indeed, courts generally permit joinder where plaintiffs plausibly allege coordinated activity among defendants. More recently, however, courts have increasingly rejected the proposition that common ownership of an intellectual property right, combined with similar online conduct, is sufficient to satisfy this standard.

Recent judicial scrutiny, much of it informed by academic criticism, has not resulted in less Schedule A litigation, but, rather, it has narrowed the scope and circumstances under which it can be pursued successfully.

Overall, Schedule A litigation continues to present one of the most cost effective and efficient ways for brand owners to combat online counterfeiting, although judicial pushback has increased the importance of being strategic rather than blunt in their filing. For defendants with valid defenses who may find themselves inappropriately lumped together with bad actors, the judicial questioning of the typical Schedule A playbook represents a welcome opportunity to be heard.

1. According to Professor Goldman, the "SAD Scheme" stands for "Schedule A Defendants Scheme."

TRADEMARK INSIGHTS

1. For Rights Holders:

- **Conduct thorough pre enforcement investigations and limit use of sealed filings and redactions.** Plaintiffs must ensure that all allegations are supported by adequate factual investigations and that Complaints are filed in good faith.
- **Be strategic about joinder.** Plaintiffs should plead concrete factual connections among defendants (e.g., shared operators, coordinated activity, or overlapping transaction patterns). When appropriate, consider narrowing the defendant list by platform, type of conduct, or transactional overlap. Simply alleging infringement of the same trademark is increasingly insufficient.
- **Anticipate personal jurisdiction challenges.** Complaints should ideally include forum specific facts (e.g., shipments into the forum, targeted advertising, or shipping/price settings showing U.S. or forum targeting).
- **Tailor requests for relief.** Judges tend to apply greater scrutiny to *ex parte* TROs, sealing requests, and asset restraints. Plaintiffs should provide specific facts demonstrating why such relief is necessary and ensure the scope is narrowly tailored. In some cases, seeking only equitable remedies may be the more defensible approach.
- **Avoid serial refiling and "judge shopping".** Courts are increasingly alert to attempts to refile identical defendant groupings after joinder challenges. Voluntarily dismissing a case and refiling it in hopes of a more favorable assignment may be treated as a concession of misjoinder and can result in dismissal with prejudice.

2. For Defendants and Platforms:

- **Do not ignore correspondence from rights holders.** Early engagement reduces the risk of default judgments, account freezes, or missed procedural opportunities.

- **Move early to challenge misjoinder and/or personal jurisdiction.** Early motions to dismiss or sever can significantly narrow the scope of the case and reduce exposure. In particular, defendants could request specific proof (such as shared IP addresses, payment processor information, or logistics data) and move to sever if such linkage is unsupported.

- **Challenge blanket asset freezes and overbroad TROs**. Courts increasingly require a showing that restrained assets are tied to the alleged infringing sales and that relief is proportionate to anticipated equitable remedies. Accordingly, challenging TRO requests is usually efficient.

- **Seek unsealing where appropriate.** Where possible, defendants should request the unsealing of filings and insist on adversarial briefing before preliminary injunctions are entered.

PRACTICE GROUP INSIGHTS

LITIGATION

Musings about the Impact of *Ecofactor* and its Progeny on Patent and Trade Secret Damages


By Catherine Kim, Robert M. Isackson

1. Introduction

The Federal Circuit's decisions in *EcoFactor v. Google (en banc* 2025)[2], *Jiaxing Super Lighting v. CH Lighting* (2025)[3], and *Rex Medical v. Intuitive Surgical* (2025)[4] collectively reinforce a stricter application of Federal Rule of Evidence 702 to damages experts. While they do not alter existing damages law, they significantly tighten the evidentiary threshold for admissibility—particularly when experts rely on settlement agreements, portfolio level licenses, or apportionment assumptions unsupported by concrete facts.

These cases respond to recurrent problems: reliance on inferred royalty rates, apportionment without evidence, and portfolio licenses offered as comparables without allocation. They also reflect increasing concern over large jury verdicts and inconsistent gatekeeping across favored patent venues. The Federal Circuit's directive is clear: district courts must rigorously assess factual sufficiency before letting damages theories reach the jury.

1. Disclaimer: The views expressed in this article are those of the authors alone and do not necessarily reflect the views of Leason Ellis, its attorneys, staff, or clients.

2. *EcoFactor, Inc. v. Google LLC,* 127 F.4th 1333 (Fed. Cir. 2025) (en banc).

3. *Jiaxing Super Lighting Electric Appliance v. CH Lighting Technology,* 146 F.4th 1098 (Fed. Cir. 2025).

4. *Rex Med., L.P. v. Intuitive Surgical, Inc.*, 156 F.4th 1289, 1295 (Fed. Cir. 2025).

2. *EcoFactor*: Requirement of Mutual or Documented Royalty Evidence

A. Background

EcoFactor asserted a single smart thermostat patent and relied on three lump sum settlement agreements (Daikin, Schneider, Johnson). Each agreement stated that *EcoFactor* believed the lump sum corresponded to an "$X/unit" royalty—but also explicitly said the sum was not a royalty and not based on sales. *EcoFactor* offered no sales data, no negotiation records, and no licensee testimony. Its CEO testified only to a "general understanding" that $X/unit reflected the parties' intentions. The expert adopted this rate. The jury awarded $20 million.

B. *En Banc* Holding

The Federal Circuit reversed:

1. Unilateral belief on reasonable rate is NOT evidence. *EcoFactor's* self serving statement could not establish a mutually agreed rate.
2. General recollection on what is reasonable in the industry is NOT factual basis. Unsupported testimony cannot substitute for documents or contemporaneous data.
3. Rule 702 requires evaluating factual sufficiency at admissibility, NOT weight. Courts must exclude opinions lacking evidentiary grounding.
4. Settlement agreements remain usable—but ONLY with corroborating evidence. Experts must show that the rate was mutually agreed or independently supported.

C. Significance

EcoFactor significantly limits the use of settlement agreements to infer royalty rates. Experts must present actual evidence connecting lump sum payments to per unit rates. Uncorroborated impressions or inferred arithmetic no longer suffice.

3. *Jiaxing*: Rejecting Qualitative Adjustments as apportionment

A. Background

Jiaxing's expert relied on two portfolio level licenses (TCP and Lunera) and attempted to apportion their portfolio wide rates to three asserted LED patents by asserting certain patents "drove" negotiations and applying qualitative upward/downward adjustments.

B. Federal Circuit Holding

The court expressed concerns about admissibility under *EcoFactor*:

1. Apportionment requires factual evidence. Experts must show how specific patents contributed to negotiation value.
2. Qualitative adjustments are inadequate without data. "Upward for competition" or "downward for breadth" is not evidence based apportionment.
3. Portfolio reliance requires documented allocation. Experts need transaction records, negotiation evidence, licensee input, or technical valuation tying value to specific patents among the entire portfolio.

C. Significance

Jiaxing reinforces that portfolio licenses cannot be used as comparables to infer a reasonable royalty rate for specific patent(s), without quantitative, evidence based apportionment. Unsupported "driver patent" assertions will not survive Rule 702 scrutiny.

4. *Rex Medical*: Failure to Apportion Leads to Nominal Damages

A. Background

Rex Medical relied on a $10 million portfolio settlement with a third party (Covidien), even though the '650 patent asserted in this case had been dropped from that earlier suit against Covidien. The expert offered no evidence allocating any portion of the settlement to the '650 patent. With the expert excluded, the jury still awarded $10 million based on lay testimony; the district court reduced damages to $1 nominal damages, and the Federal Circuit affirmed.

B. Holding

1. Apportionment is mandatory. Experts may not assign portfolio level value to a single patent without evidence.
2. Lay testimony cannot establish damages. Unsupported statements about value of a patent cannot substitute for expert analysis.
3. Without admissible damages evidence, nominal damages are appropriate.

C. Significance

Rex Medical is a stark reminder: failure to apportion can eliminate damages entirely.

5. Possible Reason for Increased Scrutiny in Patent Damages Awards

One possible reason for Federal Circuit's reversal of the large damages awards might be because the patent verdicts—particularly in EDTX and WDTX—have increasingly reached hundreds of millions or more. The Federal Circuit might have felt the need to demand higher standard for district courts' "gatekeeping" role.

Another possibility is that the disparity between pro-patent forums and other forums has become wider. For example, six out of ten largest patent damages awards issued by jury in 2025 were returned by EDTX juries.[5] The difference in pro-patent tendencies of juries in different districts may have incurred a sense of need for check by the appellate court. In fact, *EcoFactor* and its progeny reflect the Federal Circuit's demand for a shift toward front loaded gatekeeping: district courts must scrutinize damages opinions at the Rule 702 stage rather than rely on appellate correction.

6. Implications for Trade Secret Damages

Recent trade secret cases show similar trends. Courts now require:

- apportionment of damages to the trade secret at issue (e.g., *Motorola v. Hytera*[6]),
- exclusion of revenue not tied to the misused secret (e.g., *Appian v. Pegasystems*[7]),
- damages models matching only the secrets the jury finds misappropriated out of all asserted secrets (e.g., *Trinseo* [8] *v. Kellogg*), and
- quantitative allocation where products combine secret and non secret technology (*In re Avaya*[9]).

This suggests that *EcoFactor* style evidentiary rigor will increasingly apply in DTSA and state trade secret actions.

7. Conclusion

EcoFactor, *Jiaxing*, and *Rex Medical* impose a stricter evidentiary threshold for damages experts. Opinions must rest on:

- mutually agreed royalty rate or structure,
- quantitative apportionment, and
- a clear link to the value of the specific asserted IP.

These decisions respond to rising jury awards and reaffirm the centrality of the court's gatekeeping function. Going forward, parties must prepare damages cases with the expectation that Rule 702 will be rigorously enforced.

5. https://www.rpxcorp.com/data-byte/east-texas-still-in-first-place-saw-bulk-of-2025s-high-dollar-verdicts/#:~:text=The%20Eastern%20District%20of%20Texas,posttrial%20motion)%20have%20yet%20materialized
6. *Motorola Sols., Inc. v. Hytera Commc'ns Corp. Ltd.,* 108 F.4th 458, 468 (7th Cir. 2024), reh'g and reh'g in banc dismissed, No. 22-2370, 2024 WL 4416886 (7th Cir. Oct. 4, 2024), and cert. denied, 145 S. Ct. 1182, 221 L. Ed. 2d 257 (2025).
7. *Appian Corp. v. Pegasystems, Inc.,* 924 S.E.2d 621, 641 (Va. 2026).
8. *Trinseo Eur. GmbH v. Kellogg Brown & Root, L.L.C.*, 165 F.4th 399, 405 (5th Cir. 2026).
9. *TIn re Avaya Inc.,* No. 17-10089 (SMB), 2018 WL 1940381, at *3 (Bankr. S.D.N.Y. Apr. 23, 2018), aff'd, 602 B.R. 445 (S.D.N.Y. 2019).

LITIGATION INSIGHTS

To satisfy the stricter evidentiary thresholds established by *EcoFactor* and its progeny:

- **Move beyond "unilateral belief" in settlement negotiations:** Ensure any per-unit royalty rate derived from a lump-sum settlement is corroborated by mutual agreement or documented intent. A patentee's subjective "understanding" of a rate is no longer legally sufficient evidence of a "meeting of the minds."
- **Provide quantitative apportionment:** When using portfolio-level licenses as comparables, experts must provide a data-driven allocation to the specific patent at issue. Avoid relying on broad "upward" or "downward" adjustments based on industry impressions without supporting transaction records or technical valuations.
- **Document "driver" patents with contemporaneous evidence:** If claiming a specific patent drove the value of a larger deal, support this with negotiation history, licensee testimony, or internal valuation documents. Conclusory statements about a patent's importance will likely be excluded.
- **Bridge the gap between lump sums and royalty rates:** Do not allow experts to "reverse-engineer" a royalty rate from a settlement if the agreement explicitly states the payment is not based on sales. Such "arithmetic" is now viewed as an inadmissible inference rather than a factual basis.
- **Prepare for "front-loaded" gatekeeping:** Expect district courts to scrutinize damages models aggressively at the Rule 702 stage. Ensure expert reports are trial-ready with factual sufficiency, as the Federal Circuit has signaled it will no longer defer to a jury's "weighting" of flimsy evidence.
- **Apply patent-level rigor to trade secret models:** In trade secret litigation, mirror the *EcoFactor* approach by ensuring damages are strictly tied to the specific secrets found to be misappropriated, excluding revenue tied to non-secret technology or unrelated products.
- **Avoid reliance on lay testimony for valuation:** Do not assume a CEO or inventor can fill the gap if a damages expert is excluded. Without a surviving expert model, courts are increasingly likely to award only nominal damages ($1), even in the face of lay testimony regarding value.

IN CASE YOU MISSED IT

INTA 2026 Annual Meeting in London, England

Leason Ellis **Partners Melissa Alcantara**, **Lauren Emerson**, **Matt Frisbee**, **Jordan Garner**, **Yuval Marcus**, **Karin Segall**, **Peter Sloane,** and **Associate Vera Glonina** headed home from the 148th INTA Annual Meeting in London, England with fresh insights, new connections, and inspiration for the year ahead. The conference brought together over 10,000 IP professionals from more than 100 countries.

On Tuesday, May 5, the firm hosted a reception at the Museum of Brands—a "marked" highlight. The reception provided a fitting backdrop to host esteemed guests from the global trademark community.

Jordan Garner Speaks at JETRO Seminar on AI legal issues

The Japan External Trade Organization (JETRO), in collaboration with the New York Intellectual Property Law Association (NYIPLA), hosted an IP seminar on April 16, 2026 at their Manhattan office. The program focused on "*AI utilization and legal issues in the U.S. intellectual property practice,*" presented by **Partner Jordan Garner** and Leason Ellis alumni Deirdre Clarke. The event was coordinated by **Patent Agent Mitsu Haraguchi**, Group Manager of Leason Ellis' Japan Practice Group. The program also featured the results of an extensive survey on AI utilization by IP practitioners in Japan and the US, conducted by the JETRO New York constituency.

Leason Ellis Contingent Attends NYIPLA Judges' Dinner

The 104th Annual NYIPLA Dinner in Honor of the Federal Judiciary was held March 27, 2026, at the Midtown Hilton in Manhattan. The evening featured the presentation of the Outstanding Public Service Award to Hon. Raymond T. Chen and a dinner address by Pulitzer Prizewinning author and humorist Dave Barry. Numerous Leason Ellis attorneys, clients, and colleagues from across the profession were in attendance, including special guests seated at tables hosted by various Leason Ellis members. The dinner remains one of the most anticipated gatherings in the IP bar each year.

Melissa Alcantara Moderates Panel at INTA's "The Business of M&A" Conference

Partner Melissa Alcantara moderated a panel at INTA New York's "*The Business of M&A: Navigating the Convergence of Intangible Assets and Capital in the Age of AI*" conference at Columbia University on March 18-19. The event brought together 200-250 practitioners, including IP counsel, corporate attorneys, economists, and business professionals from the U.S. and abroad. Melissa's panel on valuation and risk allocation for traditional and AIrelated assets, covering methodologies, financial modeling, and developments in representations, warranties, and indemnification practices. **Associate Vera Glonina** also attended.

Vera Glonina Presents on AIGenerated Works and Copyright

Associate Vera Glonina delivered a guest presentation for a foreign educational organization on the legal challenges surrounding AI-generated works and recent U.S. copyright decisions. Her presentation provided an overview of authorship, originality standards, and ongoing litigation at the intersection of AI and copyrightability.

Audrey Trace Presents Ladder Award at CBA Women in the Law Dinner

Associate Audrey Trace, in her role as chair of the Connecticut Bar Association Young Lawyers Women in the Law Committee, presented the 2026 Ladder Award at the Pathways to Leadership for Women Lawyers Dinner to Nancy Kennedy, a partner at Stites & Harbison PLLC. The Ladder Award recognizes a distinguished woman attorney who has "left the ladder down" by mentoring and supporting the next generation of lawyers.

Conner Inn of Court Hosts 18th Annual Reception & Dinner

The Hon. William C. Conner Inn of Court held its 18th Annual Reception & Dinner on January 21 in New York City, where numerous Leason Ellis attorneys, including **Partners Yuval Marcus**, **Melvin Garner**, **Rob Isackson**, **Jordan Garner**, and **Lauren Emerson** and **Associates Jarryd Werts**, **Vera Glonina**, **Yilan Wang**, and **Catherine Kim**, were in attendance. **Partner Melvin Garner**, an Executive Committee Member of the Inn, delivered both the opening and closing remarks summarizing the Inn's efforts and programming throughout 2025. The event's journal documenting activities for the year is available here: https://pub.marq.com/b397237f-4506-445d-b5be-18af2ef6404b/#7q2tIOykCzJ, and photos from the evening can be viewed here: https://www.connerinn.org/18th-Annual-Conner-Inn-Dinner.

Vera Glonina Coauthors Articles for the INTA Bulletin

Associate Vera Glonina recently coauthored two INTA Bulletin articles addressing emerging issues in the trademark and advertising landscape. The first, "Lack of Transparency in Influencer Marketing," explores risks associated with undisclosed sponsorship arrangements and the increasing regulatory scrutiny around online endorsements. The second, "*AI Washing: An Emerging Topic*," examines the widespread trend of companies overstating their use of artificial intelligence and the related legal and reputational risks.

Leason Ellis Continues Support of WESEF

Partner Ralph Crispino once again served as a judge at the Westchester Science & Engineering Fair (WESEF), which hosted more than 800 student researchers from 46 high schools, supported by over 500 adult judges. This year, Leason Ellis proudly supported WESF as a Gold Donor, and sponsored the fair's 4th Place Awards.

Ralph evaluated nine environmental science projects and highlighted his admiration for the depth of research, creativity, and commitment shown by participating students. He was joined by an interdisciplinary team organized by **Associate Josh Montgomery**, including Heather Milder (Certified Registered Nurse Anesthetist, Ramapo Anesthesiologists), Matthew Cyr (Senior Project Engineer, Collins Aerospace), Mike Clark (Moon Lander Rocket Designer, Blue Origin), Alex Kasmeier (Senior Industrial Engineer, Collins Aerospace), and Blake Clark (Horticulturist and Park Technician, City of Des Moines). The firm has supported WESEF since 2016, and photo galleries from the event may be viewed here: https://meganzupanphotography.pixieset.com/wesef2026/.

Matthew Frisbee Participates in MARQUES Spring Team Meeting

Partner Matthew L. Frisbee attended the MARQUES Spring Team Meeting in Frankfurt, Germany, the country's financial center and an important hub for European commerce. As a member of the MARQUES Design Team, Matt contributed to ongoing initiatives focused on design law harmonization, enforcement practices, and global collaboration among practitioners.

Vera Glonina Serves as New York Delegate to ABA YLD Assembly

Associate Vera Glonina represented New York as a delegate to the ABA Young Lawyers Division Assembly held during the ABA Midyear Meeting in San Antonio.

Leason Ellis Group Attends 2026 Legalweek Conference

Associate Emily Rice, along with **Partner Jordan Garner**, **Associate Vera Glonina**, **Litigation Paralegal Lyndsey Ibarra**, and **System Administrator Ajay Patel**, attended the 2026 Legalweek conference, one of the industry's most influential legal technology events. The group met with leading legal tech vendors to examine the latest workflow automation systems, AI-enhanced research platforms, and operational efficiency tools. Additional information about the conference is available at the following link: https://www.event.law.com/legalweek.

Henry Gabathuler Attends IAM Live: Auto IP USA Conference in Detroit

Partner Henry Gabathuler recently attended the IAM Live: Auto IP USA conference in Detroit, Michigan. Auto IP USA is a premier industry event focused on intellectual property strategies within the automotive sector. The topics covered included legal strategies in light of the sharp increase of discretionary *Inter Partes* Review denials at the Patent Office, standards essential patent licensing strategies and the impact of AI on the automotive and legal sectors.

Peter Sloane Attends WTR Europe Program in London

This March, **Partner Peter Sloane** attended a twoday program in London sponsored by World Trademark Review, featuring attendees from the UK, EU, and the US. Roughly 40-45% of participants were in-house attorneys, with many attending at no cost through WTR's outreach efforts. Peter observed that while the U.S. contingent was small, the crossborder exchange of ideas proved valuable.

WHAT'S NEXT

Softball Season to Run from April 21 through August Playoffs

The firm's coed softball team began its 12-game season on April 21, will play every Tuesday evening through August, and is welcoming both returning players and new participants. This season will debut brand-new team jerseys designed by **Patent Agent Mitsu Haraguchi**, adding a fresh look to the team's identity. More updates will follow as the season progresses.

LEASON ELLIS INTELLECTUAL PROPERTY ATTORNEYS

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.

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.

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