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## NYIPLA PRESIDENT'S CORNER

### COLMAN RAGAN



2020 continues to be a year of twists and turns. And the NYIPLA continues to navigate them. As we are now elbow-deep in the holiday season, there is a lot to consider from the past year and the year to come. We all continue to work from our homes or live at our work, depending upon how you look at it. For those of us with children in school or college, many are dealing with the challenges of running remote schools out of their homes as well. If only that meant actual help with the chores around the house instead of triple the dishes in the kitchen!

One of our strengths has been our in-person networking and meetings. The holiday season is normally a time to get together, and the NYIPLA traditionally has been no different. However, this year we transitioned to a virtual organization—for the time being. We all hope to get back together soon, but not quite yet.

Yes, this probably means that in 2021 we will not be able to have a traditional Judge's Dinner, but fear not, we are working hard to come up with a fun alternative. Stay tuned.

The NYIPLA did a lot this year. We provided a lot of excellent webinars, many free of cost. Our committees worked together to put together an excellent two-week CLE series to replace our traditional Full Day Patent CLE that normally happens in November. We worked with the NYIPLEF, who put on a fantastic wine tasting event to raise money for scholarships to increase diversity among the ranks of IP attorneys. For those of you who saw the photos—yes those are holiday wreaths embroidered on my slacks.

The NYIPLA had the first two events in our series of President's Fora. The first of the series discussed the copyright litigation brought by the band Spirit against Led Zeppelin, accusing the iconic song "Stairway to Heaven" of copyright infringement. I am happy to report that I still think it is the greatest rock 'n' roll song of all times. The second of the series discussed California legislation 1) limiting the ability to settle patent litigation in the pharmaceutical sector and 2) allowing California to become a market participant in the supply of

generic pharmaceuticals. It was a great success and I look forward to doing more in 2021.

In 2021, I hope the NYIPLA will continue to foster diversity in the next generation of inventors, content creators, and innovators as well as the IP legal community. The NYIPLA hopes to continue to work with the next Congress and the USPTO to continue to foster legislation and policies that will foster innovation and content creation, as well as encourage diverse new voices to join our ranks. The NYIPLA will also continue to work with the NYIPLEF to present programs aimed at fostering diversity in the practice or IP law.

For 2021 the NYIPLA is still looking into designing an “IP Boot Camp” covering several aspects of IP law for our members, especially our younger lawyers and new associates. We expect that we will start our “IP Boot Camp” with sessions on IP litigation and then move to other aspects of IP, including IP transactions and Privacy.

I hope that all of you stay safe and healthy this holiday season and take time to separate yourselves from work.

Best Regards,  
Colman Ragan

## UPCOMING WEBINARS

[www.nyipla.org](http://www.nyipla.org)

### JANUARY

01/05/2021 PTAB Committee Meeting Will Cover Even More New PTAB Precedential Decisions and PTAB Rules

In the upcoming January 5, 2021 PTAB Committee Monthly Zoom Meeting, members Chandler Sturm and Devin Garrity from Amster, Rothstein & Ebenstein LLP, with Co-Chair Charley Macedo will report on the recently issued Precedential Decisions by the PTAB as well as the new PTAB Rule Changes. We will also be having representative(s) from the PTAB join again to listen to our discussions. Don't miss out – attendance is free to PTAB Committee members and 1 CLE will be available. To join the PTAB committee and participate in monthly PTAB presentations and discussions contact [admin@nyipla.org](mailto:admin@nyipla.org).

01/14/2021 Best Practices in the COVID Era

The webinar will discuss understanding the use of technology in our practices, until COVID-19 ends – and presumably beyond. One area we will discuss in this regard is maintaining relationships with attorneys, staff and clients. Another is security of communications when people are working remotely, particularly at home.

01/28/2021 NYIPLA & NYIPLEF Joint CLE Program: Paths to Equity & Inclusion in IP Law

A panel of experienced IP professionals will discuss their career journeys and the hurdles and challenges that they have experienced along the way. The panelists will also discuss current efforts to create more inclusivity in the field of Intellectual Property law at law firms, the courts, and at the USPTO. The panel will be moderated by recent winners of the NYIPLEF Diversity Scholarship.



## Remembering Howard Barnaby, Former NYIPLA President

Former NYIPLA president Howard B. Barnaby passed away on October 9, 2020, at his residence in Charlottesville, Virginia, after fighting a courageous battle against multiple debilitating illnesses. He was 71 years old.

Howard was president of the Association from 1998 to 1999 following sixteen years of dedicated service as chair of its publications committee (1982-1986), a member of its Board of Directors (1986-1989), treasurer (1989-1995) and vice-president (1995-1998).

A graduate of Boston College (class of 1971) and Boston College Law School (class of 1974), Howard started in the profession as an associate with the firm of Watson Leavenworth Kelton & Taggart, working primarily on trademark matters with former Board members Lester Taggart and Albert Robin. He left in 1979 to take a position as Trademark Counsel with Gulf + Western Industries in New York City, reuniting with Robin several years later at the firm that would become Robin Blecker Daley & Driscoll. Howard became a partner and remained there for the rest of his legal career. Suffering from the progressive effects of multiple sclerosis, Howard left the practice in 2004 to take a position at Yale University's Center for Language Studies where, among other accomplishments, he developed a copyright handbook to assist faculty in the development of pedagogical materials. He retired in 2012 and moved with his extended family to Virginia.

While practicing, Howard was considered one of the leading trademark attorneys in the country and, in addition to his work with the NYIPLA, was active in the International Trademark Association. He authored several articles and book chapters on various trademark topics, including one of the leading articles on trademark surveys, entitled "Trademark Surveys—Heads You Lose, Tails They Win," which was published in *The Trademark Reporter*. He also authored several articles in *The Merchandising Reporter* and *Licensing Journal* on the importance of trademark protection in licensing and effective litigation tactics. Some may also recall Howard's baritone solos in the "Twelfth Night" roasts of two former NYC mayors hosted by the City Bar Association.

Howard is survived by Peggy, his wife of nearly fifty years, and two sons—Edward, dean of graduate programs in the Arts & Sciences at the University of Virginia, and Daniel, a manager at Epiq in the legal services industry—as well as their spouses, Hannah and Jackie. Howard has three grandchildren and had been eagerly awaiting a fourth, due in November.

Howard was a true gentleman, admired and respected by everyone who had any dealings with him. He was the angel on the shoulders of many of his colleagues. The profession was a far better place when he was part of it, and he will certainly be missed.

# Supreme Court Roundup: A Review of the October 2019 Term's Key Intellectual Property Law Cases: NantKwest, Thryv, Romag, Lucky Brand Dungarees, Booking.com (I and II), Allen, and Public.Resource.Org

BY: CHARLES R. MACEDO AND DAVID P. GOLDBERG\*



During its October 2019 Term, the Supreme Court issued a number of significant intellectual property decisions. These include decisions in two patent cases, *Peter v. NantKwest, Inc.* and *Thryv, Inc. v. Click-to-Call Technologies, LP*, four trademark cases, *Romag Fasteners, Inc. v. Fossil Group*, *Lucky Brand Dungarees Inc. v. Marcel Fashions Group*, *U.S. Patent & Trademark Office v. Booking.com B.V.*, and *Booking.com B.V. v. U.S. Patent & Trademark Office*, and two copyright cases, *Allen v. Cooper and Georgia v. Public.Resource.Org Inc.*

With respect to patent law, in *NantKwest*, the Supreme Court held that the U.S. Patent & Trademark Office (“USPTO”) could not recover its legal personnel’s salaries as “expenses” in appeals to U.S. district courts under § 145 of the Patent Act for the review of patent application rejections. In *Thryv*, the Court reversed a Federal Circuit decision and established a clear rule precluding judicial review of time-bar challenges of USPTO Patent Trial and Appeal Board (“PTAB”) inter partes patent challenges.

In trademark law, the *Romag* decision clarified that willfulness is not required for an award of profits in federal trademark infringement cases brought under 15 U.S.C. § 1125(a). While an infringer’s mindset is an essential consideration in awarding the infringer’s profits, it is not a precondition to the award. In *Lucky Brand Dungarees*, the Court rejected the Second Circuit’s defense preclusion doctrine for certain trademark cases. The Court in *Booking.com* held that a “generic.com” term may be eligible for federal trademark registration but noted that there is no rule that adding “.com” to a generic term does not automatically render it registrable. And in a second *Booking.com* case, the Court effectively extended its ruling in *NantKwest* to also cover trademark appeals brought under 15 U.S.C. § 1071(b)(3).

With regard to copyright law, the Court held in *Allen* that U.S. states and territories are immune from federal copyright infringement, ruling that Congress lacked the constitutional power to strip away the states’ sovereign immunity. Finally, in *Public.Resource.Org*, the Court clarified that the government edicts doctrine, which specifies that materials created by courts in the performance of their official duties belong to the public domain, is also applicable to “non-binding, explanatory legal material” that is created and published by a legislative body – essentially preventing states from claiming copyright in their annotated codes.

The NYIPLA submitted amicus briefs in the *NantKwest* and *Thryv* patent cases, and in both *Booking.com* trademark cases, all of which briefs are available at <https://www.nyipla.org/nyipla/AmicusBriefsNews.asp>.



## I. PATENT DECISIONS

### A. *Peter v. NantKwest, Inc.*

*Peter v. NantKwest, Inc.*

No. – 18-801

**Granted** – Mar. 4, 2019

**Argued** – Oct. 7, 2019

**Decided** – Dec. 11, 2019

- The Court ruled that the USPTO cannot recover the salaries of its legal personnel as “expenses” when a patent applicant files a district court action to appeal a decision denying patent protection.

The Supreme Court of the United States unanimously held in *Peter v. NantKwest, Inc.* that the term “expenses” in 35 U.S.C. § 145 does not include attorney’s fees, and that the USPTO cannot recover the salaries of its attorneys and paralegals in appeals brought under that section of the Patent Act. *NantKwest* clarifies that the phrase “[a]ll expenses” does not mean that parties appealing patent rulings under this provision must also pay pro-rata portions of the salaries of the USPTO attorneys and paralegals involved in such appeals. Accordingly, such appeals will now be considerably more affordable to those having to pay for them.

#### i. Question Presented

The Court was asked to address whether the USPTO is entitled to its attorney’s fees when a patent applicant files a district court action to appeal a decision denying patent protection.

#### ii. Background

In 2001, the USPTO rejected Dr. Hans Klingerman and NantKwest, Inc.’s patent application. The PTAB affirmed this decision. The lower courts affirmed the USPTO’s rejection of their patent. Subsequently, the USPTO filed a motion for reimbursement of its attorney’s fees under § 145, which the district court denied. The Federal Circuit reversed this decision on appeal. The USPTO requested certiorari to the Supreme Court, which was granted.

When a patent application is filed, it is first reviewed by a Patent Examiner. If the applicant is not satisfied with the final conclusion of the Patent Examiner, the applicant can then file an appeal with the Patent Trial and Appeal Board. If the applicant is still dissatisfied after this appeal, it has two options: it can either file an appeal to the Court of Appeals for the Federal Circuit or file a lawsuit in federal court to overturn the application’s rejection. The patent statute authorizing the federal court action’s filing provides that the Patent Office is entitled to recoup from the applicant the expenses incurred in that action. The Patent Office recently began asserting that the expenses it is to be awarded include its attorney’s fees. The Supreme Court disagreed with the Patent Office and ruled that it cannot recover its legal personnel’s salaries as “expenses” for district court reviews of patent application rejections.

An adverse decision of the USPTO may be challenged via mutually exclusive pathways created by the Patent Act. “Unlike § 141, § 145 permits the application to present new evidence . . . not presented to the P.T.O.” *NantKwest*, 589 U.S., at \_\_\_ (slip op. at 2). A challenge under § 145 may result in a drawn-out litigation, as there is no limit on an applicant’s ability to introduce new evidence. Thus, the Patent Act “requires applicants who avail themselves of § 145 to pay ‘[a]ll the expenses of the proceedings.’” *Id.*

Further, when considering the award of attorney’s fees, a fundamental principle, known as the “American Rule,” states that “each litigant pays his own attorney’s fees, win or lose, unless a statute or contract provides otherwise.” *Id.* at 3-4. The Government argued that “[b]ecause the American Rule presumption is most often overcome when a statute awards fees to a ‘prevailing party,’ . . . the presumption applies only to prevailing-party statutes.” *Id.* Thus, the Government reasoned that

because Section 145 requires a party to pay all expenses, the presumption does not apply, regardless of the outcome.

### iii. Analysis

In determining that the American Rule did, apply to Section 145, the Court examined whether Congress intended to depart from the American Rule. There must be a sufficient “specific and explicit” indication of Congress’ intent in order to overcome the presumption; the absence of a specific reference to attorney’s fees is not enough. *Id.*

First, the Court looked to the statute’s text, specifically analyzing the meaning of the term “expenses.” *Id.* “Reading the term ‘expenses’ alongside neighboring words in the statute . . . supports a conclusion excluding legal fees from the scope of § 145.” *Id.* at 7. Traditionally, attorney’s fees have not been included in the class of expenses referred to in the phrase “expenses of the proceeding,” suggesting that the use of “expenses” would not have been understood to include attorney’s fees at the time of the statute’s enactment. *Id.* Thus, the Court held, Section 145’s plain text does not overcome the American Rule’s presumption against fee-shifting to permit the USPTO to recover attorney’s fees.

The Court then looked to “the record of statutory usage” to demonstrate that the term “expenses” alone does not include attorney’s fees. *Id.* at 8. “That ‘expenses’ and ‘attorney’s fees’ appear in tandem across various statutes shifting litigation costs indicates that Congress understands the two terms to be distinct and not inclusive of each other.” *Id.* Thus, the common statutory usage of the term “expenses” alone has “never been considered to authorize an award of attorney’s fees with sufficient clarity to overcome the American Rule presumption.” *Id.*

Finally, the Court pointed to the history of the Patent Act. Citing several sections under Title 35, the Court reasoned that “when Congress intended to provide for attorney’s fees in the Patent Act, it stated so explicitly.” *Id.* at 9. Thus, since Congress did not make its intent similarly clear in Section 145, the statute does not authorize the USPTO to recover its attorney’s fees.

### iv. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case urging the Court to uphold the American Rule. The brief is available at <https://www.nyipla.org/nyipla/AmicusBriefsNews.asp>.

### v. Follow-On Cases

*Booking.com B.V. v. U.S. Patent & Trademark Office*, No. 18-1309, raises the same issues as *NantKwest* but in the trademark context. The Court disposed of the case by granting certiorari, vacating the decision below, and remanding the case for further proceedings in light of the *NantKwest* decision. The case is discussed in detail below as *Booking.com II*.

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## B. *Thryv, Inc. v. Click-to-Call Technologies, LP*

### *Thryv, Inc. v. Click-to-Call Technologies, LP*

No. – 18-916

Granted – June 24, 2019

Argued – Dec. 9, 2019

Decided – Apr. 20, 2020

- The Court established a clear rule that preliminary decisions made by the PTAB cannot be appealed.

In a 7-2 Decision in *Thryv, Inc. v. Click-to-Call Technologies, LP*, authored by Justice Ginsburg, and joined by Chief Justice Roberts and Justices Breyer, Kagan, and Kavanaugh, and joined-in-part by Justices Thomas and Alito, the Court vacated the Federal Circuit’s decision and remanded with instructions to dismiss for lack of jurisdiction.

## **i. Question Presented**

The Supreme Court accepted certiorari on the question of whether 35 U.S.C. § 314(d) precludes judicial review of a decision by the PTAB to institute inter partes review (“IPR”) even when there was purportedly a prior lawsuit that should have barred institution under 35 U.S.C. § 315(b)

## **ii. Background**

In 2013, Thryv, Inc. petitioned the PTAB to institute an IPR to challenge several claims of Click-to-Call’s patent. Click-to-Call opposed the challenge, arguing that the IPR was untimely under § 315(b) due to a 2001 infringement suit against Thryv, which suit ended in a voluntary dismissal without prejudice. The PTAB disagreed, concluding that “a complaint dismissed without prejudice does not trigger § 315(b)’s one-year limit.”

The PTAB instituted review, and after proceedings on the merits, issued a final written decision canceling claims of Click-to-Call’s patent. Click-to-Call appealed the decision to the Federal Circuit, challenging only the PTAB’s determination that the petition was not time-barred under § 315(b).

The Federal Circuit initially dismissed the appeal for lack of jurisdiction, “agreeing with Thryv and the Director (who intervened on appeal) that § 314(d)’s bar on appeal of the institution decision precludes a judicial review of the agency’s application of § 315(b).”

However, after the en banc Federal Circuit in *WiFi One, L.L.C. v. Broadcom Corp.*, 878 F.3d 1364 (2018), held that time-bar determinations under § 315(b) are appealable, the Federal Circuit granted rehearing and vacated the final written decision because Thryv’s request to institute IPR was untimely under Section 315(b).

## **iii. Analysis**

In *Thryv*, the Court found that under its precedent in *Cuozzo v. Speed Technologies, L.L.C. v. Lee*, No. 15-446 (2016), Click-to-Call’s challenge to the PTAB’s ability to institute an IPR as an alleged violation of the time-bar provisions under Section 315(b) is barred under Section 314(d). *Cuozzo* held that § 314(d) “bars review at least of matters ‘closely tied to the application and interpretation of statutes related to’ the institution decision.”

The *Thryv* Court reasoned that Section 315(b) ‘s time limitation is integral to the institution, as it “sets forth a circumstance in which ‘[a]n inter partes review may not be instituted.’” Thus, because § 315(b) expressly governs institution, a challenge to a petition’s timeliness under § 315(b) raises “an ordinary dispute about the application of’ an institution-related statute” and, therefore, “easily meets” the *Cuozzo* standard.

The Court also reasoned that the America Invent Act’s (“AIA”) “purpose and design strongly reinforce [its] conclusion.” Allowing § 315(b) appeals would go against the objective of IPR: “to weed out bad patent claims efficiently.”

In addition, “because a patent owner would need to appeal only if she could not prevail on patentability, § 315(b) appeals would operate to save patent claims.” Further, “§ 315(b) appeals [are not] necessary to protect patent claims from wrongful invalidation, for patent owners remain free to appeal final decisions on the merits.”

Ultimately, in holding that the PTAB’s decision to institute IPR proceedings cannot be appealed even if based upon a timeliness objection, the Court vacated the Federal Circuit’s judgment and remanded with instructions to dismiss for lack of appellate jurisdiction.

#### iv. Dissent

The dissenting opinion, authored by Justice Gorsuch, and joined-in-part by Justice Sotomayor, argued that the “Court takes a flawed premise—that the Constitution permits a politically guided agency to revoke an inventor’s property right in an issued patent—and bends it further, allowing the agency’s decision to stand immune from judicial review.”

Further, Justice Gorsuch, in a section of the dissent not joined by Justice Sotomayor, expressed concern with the Court’s reading of § 314(d) as it “takes us further down the road of handing over judicial powers involving the disposition of individual rights to executive agency officials.”

The dissenting opinion concluded that the majority’s reading of the statute compounds the “error” made in *Oil States Energy Services, L.L.C. v. Green’s Energy Group L.L.C.*, No. 16-712, by “not only requiring patent owners to try their disputes before employees of a political branch but limiting their ability to obtain judicial review when those same employees fail or refuse to comply with the law. Nothing in the statute commands this result, and nothing in the Constitution permits it.”

#### v. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case arguing that judicial review of time-bar determinations should be permissible under relevant Supreme Court precedent. The brief is available at <https://www.nyipla.org/nyipla/AmicusBriefsNews.asp>.

#### vi. Follow-On Cases

The Supreme Court granted certiorari, vacated, and remanded the following three cases in view of its *Thryv* decision:

- *Emerson Electric v. SIPCO*, 207 L. Ed. 2d 1049 (U.S. June 15, 2020), where the Court was asked to consider whether the Federal Circuit improperly overturned the PTAB’s determination that the patent was eligible for review under the covered business method (“CBM”) program. This decision suggests that the Federal Circuit will no longer be able to review whether the PTAB properly determined if a patent is a CBM.
- *Atlanta Gas Light Co. v. Bennett Regulator Guard Inc.*, 140 S. Ct. 2711 (U.S. Apr. 27, 2020), where the Court was asked whether the Federal Circuit properly held that the PTAB should not have instituted an IPR of a patent where there was a civil complaint, later involuntarily dismissed, that was filed outside the one-year limitation. This decision reinforces that the Federal Circuit should not be addressing what constitutes a time bar under 35 U.S.C. § 315(b).
- *Superior Communications Inc. v. Voltstar Techs. Inc.*, 140 S. Ct. 2711 (U.S. Apr. 27, 2020), where the Court was asked whether the Federal Circuit had authority to review a PTAB decision to institute that was filed more than one year after a civil complaint, which complaint was dismissed without prejudice subject to a settlement agreement that later fell apart. This reinforces that *Thryv* controls even where a civil action was filed and settled voluntarily outside of the one-year period.

Furthermore, the Federal Circuit has applied *Thryv* and its progeny to limit its own jurisdiction to hear PTAB appeals in at least the following cases:

- In *ESIP Series 2 LLC v. Puzhen Life USA LLC*, 958 F.3d 1378 (Fed. Cir. May 19, 2020), cert. denied, 208 L. Ed. 2d 178 (U.S. Oct. 13, 2020), the Federal Circuit followed *Thryv* and extended preclusion of judicial review under Section 314(d) to a determination by the PTAB concerning the real parties in interest requirement of Section 312(a)(2). ESIP indicates that decisions on “real parties in interest” are related to institution such that judicial review is precluded under Section 314(d).



- In *Ruiz Food Prods Inc. v. MacroPoint LLC*, No. 19-2113 (Fed. Cir. June 24, 2020), the PTAB instituted an IPR after a declaratory judgment action was dismissed without prejudice but later granted MacroPoint’s motion to terminate the proceedings without addressing patentability. The Federal Circuit denied Ruiz Food’s appeal under *Thryv*, holding that the dispute was related to institution. Ruiz Food stands for the proposition that *Thryv* applies to motions to terminate in addition to institution decisions.
- In *BioDelivery Scis. Int’l v. Aquestive Therapeutics Inc.*, 935 F.3d 1362 (Fed. Cir. 2019), cert. denied, 208 L. Ed. 2d 26 (U.S. Oct. 5, 2020), the Federal Circuit remanded an IPR to the PTAB with instructions to review all challenged claims under *SAS v. Iancu*. The PTAB instead terminated the instituted IPRs. The Federal Circuit dismissed the appeal of the termination decisions, holding that it lacked the authority to review those decisions. *BioDelivery* stands for the proposition that *Thryv* controls even where the Federal Circuit has remanded an IPR with instruction to review the claims.
- In *Fitbit Inc. v. Valencell Inc.*, 964 F.3d 1112 (Fed. Cir. July 8, 2020), a Federal Circuit panel found that the patent owner’s objection to petitioner’s tardy filing of an IPR petition was not reviewable on appeal under *Thryv*.
- In *Facebook Inc. v. Windy City Innovations*, 819 Fed. App’x 936 (Fed. Cir. Sept. 4, 2020), a Federal Circuit panel found that the PTAB’s joinder decisions are more like the reviewable challenges under *SAS*, which concern the manner in which instituted IPRs proceed, than non-reviewable challenges under *Thryv*, which concern decisions to institute.

It thus appears that *Thryv* is being applied to limit appeals not only where an issue is raised that is addressed in an institution decision, but also when issues are raised thereafter in motions to terminate or remands from appeals closely related to institution decisions.

## II. TRADEMARK DECISIONS

### A. *Romag Fasteners, Inc. v. Fossil Group*

<i>Romag Fasteners, Inc. v. Fossil Group</i>			
No. – 18-1233	<b>Granted</b> – June 28, 2019	<b>Argued</b> – Jan. 14, 2020	<b>Decided</b> – Apr. 23, 2020
<ul style="list-style-type: none"> <li>• The Court ruled that the mindset of the trademark infringer, although an important consideration, is not a precondition for an award of the infringer’s profits.</li> </ul>			

The Supreme Court unanimously decided that trademark infringers may be liable for their profits in actions brought under 15 U.S.C. § 1125(a), even if they did not violate the law willfully. *Romag Fasteners, Inc. v. Fossil Group, Inc.*, No. 18-1233, Slip op. at 3, 7 (U.S. Apr. 23, 2020).

This Supreme Court decision reconciles differences in statutory interpretation among the judicial circuits. It holds that “willfulness” is no longer an “inflexible precondition” to an award of profits for trademark infringement under 15 U.S.C. § 1125(a), while acknowledging that “a trademark defendant’s mental state is a highly important consideration.”

This means that defendants in federal trademark infringement actions may face more severe monetary consequences if they are successfully accused of trademark infringement. As a result, this gives added incentive for plaintiffs to file more trademark infringement actions.

Thus, it may be even more prudent to conduct thorough trademark searches for potential conflicts before adopting new trademarks and to give extra scrutiny to possible conflicts discovered in those searches. Moreover, allegations of trademark infringement need to be taken even more seriously. A common view among accused infringers that they can simply stop using an accused trademark in the event of litigation without further consequence may no longer apply.

Although the Court did not discuss in detail, the other remedies set out in 15 U.S.C. § 1114, because the Court remarked that “no one suggests [that section] contain[s] the rule Fossil seeks,” it would appear that the same logic concerning willfulness requirements (or the lack thereof) would apply there as well. *See* Slip op. at 3.

Justice Gorsuch delivered the Court’s opinion, joined by Chief Justice Roberts and Justices Thomas, Ginsburg, Breyer, Alito, Kagan, and Kavanaugh. Justice Alito wrote a concurring opinion, joined by Justices Breyer and Kagan, and Justice Sotomayor, who wrote her own concurring opinion.

### **i. Question Presented**

Because federal courts in different judicial circuits were split, the Supreme Court accepted certiorari on the question of whether willfulness was a precondition for an award of profits in trademark infringement cases brought under 15 U.S.C. § 1125(a).

### **ii. Background**

In 2002, Fossil, Inc. signed an agreement to use Romag Fasteners, Inc.’s patented magnetic snaps in its handbags. Romag later discovered that Fossil’s Chinese factories were using counterfeit Romag fasteners.

Unable to settle the dispute amicably, Romag sued Fossil in 2010 in the U.S. District Court for the District of Connecticut for trademark infringement under 15 U.S.C. § 1125(a). Following Second Circuit precedent, the District Court rejected Romag’s request for an award of profits because the jury found that Fossil’s behavior was “in callous disregard” of Romag’s rights but was not willful. Slip op. at 2.

Romag appealed to the U.S. Court of Appeals for the Federal Circuit. The Federal Circuit, applying the Second Circuit’s trademark precedent, affirmed the District Court’s decision.

### **iii. Analysis**

The Court began by noting that the critical issue, in this case, was whether a categorical rule that willfulness is required as a precondition for an award of profits “can be reconciled with the statute’s plain language.” Slip op. at 1. The relevant section of the Lanham Act governing remedies, 15 U.S.C. § 1117(a), states in pertinent part:

When . . . a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established . . . the plaintiff shall be entitled . . . subject to the principles of equity, to recover (1) defendant’s profits . . . .

The Court clarified that this section of the statute explicitly requires a showing of willfulness in order for plaintiffs in actions brought under 15 U.S.C. § 1125(c), for trademark dilution, to recover a defendant’s profits. However, the Court found that such a showing is clearly not required for plaintiffs in actions brought under 15 U.S.C. § 1125(a) such as for infringement of an unregistered trade dress, or for false or misleading use of trademarks.

The Court rejected Fossil’s contention that the term “subject to the principles of equity” implicitly includes a willfulness requirement because “equity courts historically required a showing of

willfulness before authorizing a profits remedy in trademark disputes.” Slip op. at 4. First, because the Lanham Act “speaks often and expressly about mental states,” the Court disagreed that Congress would use coded language here to import a willfulness requirement that is expressly prescribed in other sections of the Act.

Second, the Court doubted that the “principles of equity” could be stretched to include “a narrow rule about a profits remedy within trademark law.” Third, the Court did not find the evidence in the record supported that “trademark law historically required a showing of willfulness before allowing a profits remedy.” Slip op. at 5.

That said, in language that many defendants will undoubtedly point to in the future to try to forestall an award of profits, the Court wrote: “We do not doubt that a trademark defendant’s mental state is a highly important consideration in determining whether an award of profits is appropriate.” Slip op. at 7.

The Court concluded its opinion with a curt dismissal of the policy arguments made by both sides, noting that the Court’s “limited role is to read and apply the law.”

#### iv. Concurrence

Justice Alito, joined by Justices Breyer and Kagan, noted that pre-Lanham Act cases “show that willfulness is a highly important consideration in awarding profits under 15 U.S.C. § 1117(a), but not an absolute precondition.”

Justice Sotomayor wrote a concurring opinion disagreeing that courts of equity were just as likely to award profits for willful infringement as for innocent infringement but finding “that 15 U.S.C. § 1117(a) does not impose a ‘willfulness’ prerequisite for awarding profits in trademark infringement actions.”

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### B. *Lucky Brand Dungarees, Inc. v. Marcel Fashions Group*

<i>Lucky Brand Dungarees, Inc. v. Marcel Fashions Group</i>			
No. – 18-1086	Granted – June 28, 2019	Argued – Jan. 13, 2020	Decided – May 14, 2020
<ul style="list-style-type: none"><li>The Court ruled that a defendant is not precluded from raising a defense it could have raised, but never litigated or resolved, in an earlier trademark action against the same party.</li></ul>			



In a unanimous decision, the U.S. Supreme Court held that, in a later trademark action challenging different conduct and raising different claims from an earlier trademark action between the parties, Defendant Lucky Brand was not precluded from raising new defenses. *Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp.*, No. 18–1086, slip op. at 1 (2020).

The decision reverses a Second Circuit decision that barred Lucky Brand from raising a defense that it allegedly “could have” raised in an earlier phase of the almost twenty-year dispute between the parties under the doctrine of res judicata. The Court stressed the importance of the decision in the trademark context, “where the enforceability of a mark and likelihood of confusion between marks often turns on extrinsic facts that change over time.” *Id.* at 9.

Justice Sotomayor delivered the unanimous opinion of the Court in Lucky Brands that resolved a circuit split regarding the existence of the so-called “defense preclusion” principle. Instead, the Court has limited judicial preclusions to traditional claim and issue preclusion doctrines as the guideposts for barring certain defenses in trademark cases.

## **i. Question Presented**

The Supreme Court accepted certiorari on the question of whether, when a plaintiff asserts new claims, federal preclusion principles can bar a defendant from raising defenses that were not litigated and resolved in any prior case between the parties.

## **ii. Background**

Plaintiff Marcel and Defendant Lucky Brands both sell jeans and other apparel using the word “Lucky” in their trademarks on clothing. Marcel received a federal trademark registration for “Get Lucky” in 1986, while Lucky Brand began selling apparel using the trademark “Lucky Brand” (and other marks that include the word “Lucky”) in 1990. These trademarks led to nearly twenty years of litigation between the parties, proceeding in three phases beginning in 2001.

In the initial conflict between the parties, Marcel sued Lucky Brand alleging trademark infringement and unfair competition by Lucky Brand’s use of the phrase “Get Lucky.” The parties settled in 2003 with Lucky Brand agreeing to “desist henceforth from the use of ‘Get Lucky’ as a trademark” and pay Marcel \$650,000. In exchange, Marcel agreed to release any claims it had or might have arising out of or relating to Lucky’s right to “use, license and/or register” the trademark “Lucky Brand” or any other marks that it “owned, registered, and/or used” at the time.

The next round of litigation began in 2005. Lucky Brand was on the offensive, alleging that Marcel and its licensee infringed its trademarks by copying its designs in a new clothing line. Marcel filed several counterclaims in response based on Lucky Brand’s continued use of the “Get Lucky” phrase. Marcel also asserted counterclaims based on the Settlement Agreement’s release of “any and all claims arising out of or in any way related to [Lucky’s] right to use, license and/or register the trademark “Lucky Brand” and/or any other trademarks, trade names, brands, advertising slogans or tag lines owned, registered and/or used by [Lucky] as of the date of this Agreement.” On the face of Marcel’s counterclaims, it appeared that some of Lucky Brand’s allegedly infringing marks were not registered until after the Settlement Agreement. The district court accordingly denied Lucky’s motion to dismiss. Lucky Brand did not renew its “release” defense in the 2005 action, and the case proceeded to trial, which resulted in a final order and judgment under which Lucky Brand was permanently enjoined from using the “Get Lucky” mark. However, the final judgment did not address whether the Settlement Agreement barred some or all of Marcel’s counterclaims in the 2005 action.

The third round of litigation began in 2011 with Marcel suing Lucky Brand again for trademark infringement. This time Marcel sought a new injunction prohibiting Lucky from “using the Lucky Brand marks,” which Marcel claimed Lucky Brand had continued to use after the final judgment in the 2005 action. Notably, the 2005 action did not involve any alleged use of the “Get Lucky” slogan. Lucky moved for summary judgment on the ground that the final judgment barred Marcel’s new claims. The district court granted the motion, concluding that Marcel’s claims in the 2011 action were essentially the same as its counterclaims in the 2005 action. However, the Second Circuit vacated and remanded the decision, holding that Marcel’s counterclaims in the 2005 action were for “infringements that occurred ‘after May 2003’ but before” the 2011 action, which meant that they could not have been raised in the 2005 action.

On remand to the district court, Lucky Brand moved to dismiss Marcel’s amended complaint, arguing—for the first time since its motion to dismiss and answer in the 2005 action—that all of the marks at issue in the current action were “registered and/or used by [Lucky] . . . as of the date of th[e Settlement] Agreement,” and thus covered by the agreement’s release. In response, Marcel argued that “the res judicata or collateral estoppel effect” of the final judgment in the 2005 action precluded Lucky



Brand from relying on the Settlement Agreement in the current action because the same defense could have been resolved in the 2005 action for different claims. The district court disagreed, stating that “[i]ssue preclusion does not apply, because the applicability of the Settlement Agreement’s release provision was not litigated and resolved in the 2005 action.” The district court also held that claim preclusion did not apply because Marcel’s claims in the 2011 action differed from its claims in the 2005 action.

The Second Circuit vacated and remanded the decision, concluding that a doctrine called “defense preclusion” barred Lucky Brand from raising the release defense in 2011. The Second Circuit reasoned that a defendant should be precluded from raising a defense where: “(i) a previous action involved an adjudication on the merits”; “(ii) the previous action involved the same parties”; “(iii) the defense was either asserted or could have been asserted, in the prior action”; and “(iv) the district court, in its discretion, concludes that preclusion of the defense is appropriate.” 898 F. 3d, at 241. The Supreme Court granted certiorari to resolve the differences among Circuits regarding “when, if ever, claim preclusion applies to defenses raised in a later suit.”

### iii. Analysis

The Court began by noting that it has never explicitly recognized “defense preclusion” as a standalone category of *res judicata*, “unmoored from the two guideposts of issue preclusion and claim preclusion.” Slip op. at 7. Further, any preclusion of defenses must, at a minimum, meet the same requirements of issue preclusion or claim preclusion. *Id.*

The decision turned significantly on the finding that the 2005 action and the 2011 action were grounded in different conduct, involved different marks, and occurred at different times, and thus, did not share a “common nucleus of operative facts.” *Id.* at 8. For example, the 2005 action alleged that Lucky Brand infringed Marcel’s “Get Lucky” mark by using the phrase to create consumer confusion. However, the 2011 action did not involve any alleged use of the “Get Lucky” phrase. Instead, Marcel alleged in the 2011 action that Lucky Brand’s infringement was based only on the use of Lucky Brand’s own marks containing the word “Lucky.”

The Court also wholly rejected Marcel’s claim preclusion argument, stating that “[e]vents that occur after the plaintiff files suit often give rise to new ‘[m]aterial operative facts’ that ‘in themselves, or taken in conjunction with the antecedent facts,’ create a new claim for relief.” *Id.* at 9 (quotation omitted). Importantly, the Court agreed that this principle carries considerable weight in trademark context because “liability for trademark infringement turns on marketplace realities that can change dramatically from year to year.” *Id.* at 9. The Court accordingly held that claim preclusion did not and could not bar Lucky Brand from asserting its settlement agreement defense in the 2011 action.

Marcel argued that a version of “defense preclusion” should apply to the facts of its case in its briefing. However, the Court dismissed the argument, finding that the authorities referenced by Marcel likely did not stand for anything other than traditional claim - or issue - preclusion principles that may bar defenses raised in a subsequent suit. The Court pointed to a hypothetical involving judgment enforcement, where a party takes action to enforce a prior judgment already issued against another. If a different outcome in the second action “would nullify the initial judgment or would impair rights established in the initial action,” preclusion principles would apply. *Id.* at 10. However, a court would still simply apply claim or issue preclusion in that scenario to bar a claim or defense that would attack a previously decided claim.

Because the Court held that Lucky Brand’s defense in the 2011 action did not threaten the judgment of the 2005 action, the judgment enforcement principles would not apply to the case, regardless.

### C. *U.S. Patent and Trademark Office v. Booking.com B.V. (“Booking.com I”)*

*U.S. Patent and Trademark Office et al. v. Booking.com B.V.*

No. – 19-46

**Granted** – Nov. 8, 2019

**Argued** – May 4, 2020

**Decided** – June 30, 2020

- The Court ruled that adding “.com” to the end of a generic term can possibly transform the term into a federally registrable trademark.

The Supreme Court held in an 8-1 decision that “[a] term styled ‘generic.com’ is a generic name for a class of goods or series only if the term has that meaning to consumers.” *U.S. Patent and Trademark Office et al. v. Booking.com B.V.*, No. 19-46, Slip op. at 1 (U.S. Jun. 30, 2020).

In *Booking.com*, the Court’s decision rejects a nearly per se rule against trademark protection for a “generic.com” term. Under the “mark as a whole” test adopted by the Court, there will likely start to be a lot more applications for “generic.com,” “generic.org,” and the like trademarks. Once again, the Court’s rejection of a *per se* rule in favor of a flexible approach will likely result in more disputes down the road to be resolved.

This decision upholds the Eastern District of Virginia’s ruling, which was affirmed by the Fourth Circuit, that the primary significance of “Booking.com” to consumers was not as a generic term, but a term for a specific online hotel reservation site, and that the addition of “.com” could evolve an otherwise generic term into something distinctive. The Court did, however, highlight that regardless of this ruling, it would not embrace a bright-line rule that automatically classifies all “generic.com” terms as non-generic. Instead, the decision in any given case depends on whether consumers perceive that particular term as a source indicator. Slip op. at 11.

Justice Ginsberg delivered the Court’s opinion, in which Chief Justice Roberts and Justices Thomas, Alito, Sotomayor, Kagan, Gorsuch, and Kavanaugh joined. Justice Breyer filed a dissenting opinion. Justice Sotomayor filed a concurring opinion.

#### **i. Question Presented**

The Supreme Court accepted certiorari to resolve the issue of whether combining a generic term with “.com” yields a generic term as well. Slip op at 6.

#### **ii. Background**

In 2011 and 2012, Booking.com, an online travel and reservation company, filed federal trademark applications to register marks containing the term “Booking.com.” However, both the examining attorney at the USPTO and the Trademark Trial and Appeal Board (“TTAB”) refused registration, concluding that “Booking.com” was a generic term when applied to online hotel-reservation services and was not registrable. Slip op. at 4. The TTAB further noted that “customers would understand the term ‘BOOKING.COM’ primarily to refer to an online reservation service for travel.” Slip op. at 5. The TTAB went further, stating that even if “Booking.com” were descriptive and not generic, it would still be unregistrable because it lacked the requisite distinctiveness. Slip op. at 5.

Following this ruling, Booking.com sought review in the U.S. District Court for the Eastern District of Virginia, which reversed the TTAB. Slip op. at 5. Booking.com introduced in the District Court new evidence in the form of a “Teflon” consumer survey, which concluded that roughly 75% of participants viewed “Booking.com” as a brand name and not as a generic term for online hotel reservation services.

Based on this evidence, the District Court concluded that “Booking.com” was not a generic term for online hotel reservations to the relevant consumers. Slip op. at 5. Additionally, the District Court found that “Booking.com” had acquired secondary meaning regarding hotel-reservation services, and thus met the distinctiveness requirement for trademark registration. Slip op. at 5.

The USPTO appealed to the U.S. Court of Appeals for the Fourth Circuit (“the Fourth Circuit”) but disputed only the District Court’s classification of “Booking.com” as not generic. Slip op. at 5. The Fourth Circuit affirmed, rejecting the USPTO’s argument that the combination of “.com” with a generic term like “booking” is necessarily generic. *Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171 (4th Cir. 2019).

### **iii. Analysis**

The Court began by noting that whether “Boooking.com” is generic turns on whether that term, taken as a whole, signifies to consumers a class of online hotel-reservation services. Slip op. at 7. It concluded that because consumers do not perceive “Booking.com” in that manner, “Booking.com” is not generic. Slip op. at 7.

The Court also rejected the USPTO’s proposal of a nearly *per se* rule that when a generic term is combined with a generic top-level domain like “.com” the resulting combination is generic as well. Slip op. at 7. If accepted, this rule would have rendered “Booking.com” ineligible for registration, regardless of any surveys or other evidence of consumer perception. Slip op. at 7. The Court additionally found the USPTO’s argument inconsistent with the USPTO’s past practices, which registered both “ART.COM” and “DATING.COM.” Slip op. at 8.

Although the USPTO warned that a ruling in favor of Booking.com would grant the company and others like it a monopoly, the Court stated that those fears were exaggerated, emphasizing that trademark law had its inherent safeguards to address such concerns. Slip op. at 12.

Further, in reaching its decision, the Court rejected the USPTO’s reliance on the hundred and thirty-year-old *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598, 602 (1888) case. That decision held that adding a generic corporate designation like “Company” to a generic term does not confer trademark eligibility. The Court found the analogy faulty because only one entity can occupy a particular internet domain name at a time, so a “generic.com” term could convey to consumers an association with a particular website. Slip op. at 9. Moreover, “an unyielding legal rule that entirely disregards consumer perception” is incompatible with a bedrock principle of the Lanham Act. Slip op. at 10. It is questionable if Goodyear would be decided the same way today.

### **iv. Concurrence**

Justice Sotomayor filed a concurring opinion focusing on the nature of the evidence required to demonstrate that a term may be generic. She noted that even though finding value in the dissent’s point that consumer-survey evidence “may be an unreliable indicator of genericness,” she also grasps that the Court was correct in its assessment that sources like dictionaries and consumer and competitor usage reports have value in evaluating genericness.

She further stressed that had the USPTO used such sources as evidence, the Court may have rightfully found that “booking.com” was generic. This, however, was not the question before the Court.

## v. Dissent

Justice Breyer filed the only dissenting opinion which gave more credence to the USPTO's concerns about monopolization. He concluded that although the Lanham Act altered the common law in certain respects, "it did not disturb the basic principle that generic terms are ineligible for trademark protection." *U.S. Patent and Trademark Office et al. v. Booking.com B.V.*, No. 19-46, slip op. at 4 (U.S. Jun. 30, 2020) (Breyer, J., dissenting).

He also emphasized his fears that the majority "decision will lead to a proliferation of 'generic.com' marks, granting their owners a monopoly," and that "[t]his result would tend to inhibit, rather than to promote, free competition in online commerce." Slip op. at 13 (Breyer, J., dissenting).

## vi. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case, addressing the proper role of survey evidence in assessing whether a proposed ".com" trademark is federally registrable, which brief is available at <https://www.nyipla.org/nyipla/AmicusBriefsNews.asp>.

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## D. *Booking.com B.V. v. U.S. Patent and Trademark Office* ("Booking.com II")

### *Booking.com B.V. v. U.S. Patent and Trademark Office*

No. – 18-1309      **Granted, Vacated, and Remanded** – July 2, 2020

- The Court effectively extended its ruling in *NantKwest*, that the USPTO cannot recover the salaries of its legal personnel as "expenses" in appeals to U.S. district courts, to trademark actions brought under 15 U.S.C. § 1071(b)(3).

In this second *Booking.com* case, the Court granted certiorari, vacated the judgment below, and remanded the case to the United States Court of Appeals for the Federal Circuit for further consideration in light of *Peter v. NantKwest*, 589 U.S. \_\_\_, 140 S. Ct. 365 (2019).

When *Booking.com* filed its petition regarding the issue of whether the USPTO could recover the salaries of its attorneys and paralegals in trademark appeals brought in district courts under 15 U.S.C. § 1071(b)(3), the above discussed case *Peter v. NantKwest*, which posed the same question in the patent context, was already pending. Nevertheless, the Court did not consolidate the two actions. Instead, the Court held in *Peter v. NantKwest, Inc.* that the term "expenses" in Section 145 of the Patent Act does not include attorney's fees, and that the USPTO cannot recover the salaries of its attorneys and paralegals in appeals brought under that section of the Patent Act, and subsequently granted certiorari, vacated the Federal Circuit's judgment, and remanded *Booking.com* for further proceedings in light of the *NantKwest* decision.

In effect, this decision means that the USPTO will no longer be able to recover the salaries of its attorneys and paralegals in trademark appeals brought under 15 U.S.C. § 1071(b)(3).

## i. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case, advocating that the Court should reach the same decision here as it did in *NantKwest*, which brief is available at <https://www.nyipla.org/nyipla/AmicusBriefsNews.asp>.



### III. COPYRIGHT DECISIONS

#### A. *Allen v. Cooper*

<i>Allen v. Cooper</i>			
No. – 18-877	Granted – June 3, 2019	Argued – Nov. 5, 2019	Decided – Mar. 23, 2020
<ul style="list-style-type: none"><li>The Court ruled that state governments have sovereign immunity from copyright lawsuits notwithstanding a federal statute authorizing copyright lawsuits against states.</li></ul>			

The Supreme Court unanimously decided in *Allen v. Cooper* that Congress lacked authority and invalidly abrogated states’ sovereign immunity when it enacted the Copyright Remedy Clarification Act (“CRCA”) of 1990. *Allen v. Cooper*, No. 18-877, 2020 U.S. LEXIS 1909 (U.S. Mar. 23, 2020). This ruling’s practical effect is that copyright holders cannot sue states for federal copyright infringement damages.

The Court’s opinion was authored by Justice Kagan and joined by Chief Justice Roberts and Justices Alito, Sotomayor, Gorsuch, Kavanaugh, and Thomas (in part). Justice Breyer also filed an opinion concurring in the judgment, joined by Justice Ginsburg.

##### i. Question Presented

The Supreme Court granted certiorari on the question of whether Congress validly abrogated states’ sovereign immunity through the Copyright Remedy Clarification Act of 1990, which allows authors of original expression to sue states who infringe their federal copyrights.

##### ii. Background

The CRCA, 17 U.S.C. § 511(a), provides that any state (or state instrumentality, officer or employee in their official capacity) “shall not be immune, under the Eleventh Amendment of the Constitution or any other doctrine of sovereign immunity,” from federal copyright infringement lawsuits by “any person.” The statute was enacted at the same time as the Patent Remedy Act (“PRA”) with “basically identical” language that eliminated the states’ sovereign immunity from patent infringement suits. However, the Supreme Court struck down the PRA as lacking a valid constitutional basis in 1999 in *Florida Prepaid Postsecondary Ed. Expense Bd. v. College Savings Bank*, 527 U.S. 627 (1999).

As relevant here, petitioner Fredrick Allen documented the salvage of Blackbeard’s flagship vessel Queen Anne’s Revenge, which sank off the coast of North Carolina in the early 1700s. Allen brought suit against North Carolina when the state published some of Allen’s photos and videos without his permission and payment. North Carolina moved to dismiss the lawsuit on the ground of state sovereign immunity. Allen argued that the CRCA removed the states’ sovereign immunity in copyright infringement cases. The district court denied the motion to dismiss, agreeing with Mr. Allen that the CRCA clearly abrogated state sovereign immunity, and that such abrogation had a proper constitutional basis. 244 F. Supp. 3d 525, 533 (E.D.N.C. 2017). On interlocutory appeal, the Fourth Circuit reversed, relying on the Supreme Court’s *Florida Prepaid* decision to find that the CRCA was unconstitutional because the abrogation of state sovereign immunity was not “congruent and proportional” to the injury it sought to remedy. 895 F.3d 337, 350 (4th Cir. 2018).

##### iii. Analysis

First, the Court rejected Mr. Allen’s argument that the Intellectual Property Clause of the Constitution, Art. I, Sec. 8, Cl. 8 permits abrogation of sovereign immunity in connection with federal copyright suits. Significantly, the Court noted that it rejected that same theory in *Florida Prepaid*, and disagreed that any subsequent jurisprudence has modified that result. The Court noted that there was no “special justification” to overrule *Florida Prepaid*.

Then the Court addressed Allen’s second argument that the CRCA was a valid exercise of Congressional power under Section 5 of the Fourteenth Amendment. The Court noted that Section 5 of the Fourteenth Amendment can authorize Congress to strip states of immunity but any abrogation statute “must be tailored to remedy or prevent conduct infringing” that amendment’s substantive prohibitions.

For Congress to validly abrogate state sovereignty, “there must be a congruence and proportionality between the injury to be prevented or remedies and the means adopted to that end.” However, the CRCA did not validly abrogate because it lacked the necessary “congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end.” The Court concluded that nothing in the legislative record or other relevant histories of the CRCA suggested any significant or widespread infringement of copyrights by states that warranted a broad abrogation of their sovereignty. Thus, the CRCA failed the “congruence and proportionality” test, as the PRA did in *Florida Prepaid*.

Ultimately, the Court left the door open to future legislation noting that Congress could pass a valid copyright abrogation statute in the future, provided that it does so in a congruent and proportional manner. The Court also recognized that a tailored statute could “effectively stop States from behaving as copyright pirates” and “bring digital Blackbeards to justice.”

#### iv. Concurrences

Justice Thomas concurred in the judgment and concurred in the principal opinion in part. Significantly, Justice Thomas took issue with the majority’s “special justification” standard for overruling the Court’s precedent, its endorsement of future Fourteenth Amendment abrogation legislation, and its acknowledgment that copyrights could qualify as property deprived thereunder.

Justice Breyer also wrote a concurring opinion, joined by Justice Ginsburg. The opinion maintained that the Court “went astray” in *Seminole Tribe* and “erred again” in *Florida Prepaid*. In Justices Breyer’s and Ginsburg’s views, the Intellectual Property Clause provides a sufficient basis to abrogate state sovereign immunity. However, they ultimately joined the Court’s judgment, recognizing that “their longstanding view has not carried the day” and that the precedent controls.

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### B. *Georgia v. Public.Resource.Org, Inc.*

<i>Georgia v. Public.Resource.Org, Inc.</i>			
No. – 18-1150	Granted – June 24, 2019	Argued – Dec. 2, 2019	Decided – Apr. 27, 2020
<ul style="list-style-type: none"><li>The Court clarified that the government edicts doctrine applies to “non-binding, explanatory legal material” that is created and published by a legislative body and may prevent states from claiming copyright in their annotated codes.</li></ul>			

In a 5-4 decision, the Court found that the government edicts doctrine (which generally holds that works authored by certain federal public officials in the course of their official duties are in the copyright public domain) applies to the States, territories, and the District of Columbia. *Georgia v. Public.Resource.Org, Inc.*, No. 18-1150, slip op. at 1, 5 (U.S. Apr. 27, 2020).

This decision further clarified that the doctrine applied even to “annotated” versions of the law text to prevent a situation where there is “first class” versus “economy class” access to the law. To be clear, this decision will not stop those states and territories that currently charge for access to such materials from doing so. However, those states and territories will not now prevent third parties from providing free access to such materials by bringing copyright infringement actions.

This decision clarifies that under the government edicts doctrine, official statutes (and their annotations) promulgated by the U.S. States, territories, and the District of Columbia are in the public domain copyright-eligible, even if annotated. Accordingly, those states and territories currently charged for access to such materials may no longer do so. This decision will directly affect those states and territories that have negotiated contracts with legal publishers regarding the issuance of official annotated copies of their statutes. Additionally, the Supreme Court’s reasoning would seem to extend beyond annotated codes to more broadly reach and impact similar arrangements by the states to other public documents, such as state zoning or flood maps.

Of note was Justice Thomas’ dissenting policy concern that states may stop producing annotated codes altogether, thus hindering quality judicial access to both rich and poor. Time will tell if such concerns are justified and whether high-quality annotated state codes continue to be written.

Chief Justice Roberts delivered the majority opinion of the Court, joined by Justices Sotomayor, Kagan, Gorsuch, and Kavanaugh. Justice Thomas filed a dissenting opinion, joined in full by Justice Alito, and joined in part by Justice Breyer. Justice Ginsburg issued a separate dissenting opinion, joined in full by Justice Breyer.

### **i. Question Presented**

The Supreme Court granted certiorari on the question, does the government edict doctrine extend to—and thus render uncopyrightable—works that lack the force of law, including the annotations in the Official Code of Georgia?

### **ii. Background**

The State of Georgia has one official code called the Official Code of Georgia Annotated (“OCGA”). The OCGA includes the text of all current Georgia statutes as well as annotations to the text. The annotations, which are not officially binding, typically include summaries of judicial opinions construing the provisions of the statutes. The annotations to the current OCGA were produced as a work for hire by Matthew Bender & Co., Inc., a third-party publisher of law books, for the Georgia Code Revision Commission (“CRC”).

The CRC is a state-entity composed mostly of state legislators, funded by legislative branch appropriations, and staffed by Georgia’s Office of Legislative Counsel.

In 2013, the non-profit organization Public.Resource.Org, Inc. (“PRO”) purchased a full copy of the OCGA and posted it online, allowing free public access to the OCGA on various websites. After sending PRO several cease-and-desist letters, the CRC filed an action for infringement of its copyright in the OCGA annotations in the U.S. District Court for the Northern District of Georgia.

The Northern District ruled in favor of the CRC, reasoning that the annotations were eligible for copyright protection because the legislature did not enact them. The U.S. Court of Appeals for the Eleventh Circuit reversed, rejecting the CRC’s argument under the government edicts doctrine, whose animating principle is that no one can own the law. The U.S. Supreme Court affirmed.

### **iii. Analysis**

The Court found that the annotations in the OCGA were not eligible for copyright protection under the government edicts doctrine, which holds that “officials empowered to speak with the force of law cannot be the authors of—and therefore cannot copyright—the works they create in the course of their official duties.” Slip op. at 1.

The doctrine, based on the Court’s prior decisions in *Wheaton v. Peters*, 8 Pet. 591 (1834), *Banks v. Manchester*, 128 U.S. 244 (1888), and *Callaghan v. Myers*, 128 U.S. 617 (1888), derives from the basic principle that, in a democracy, the people are “the constructive authors” of the law and judges and legislators are merely draftsmen “exercising delegated authority.” Slip op. at 5 (quoting *Georgia v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1239 (11th Cir. 2018)).

The Court here clarified that the appropriate test is “based on the identity of the author . . . judges—and, we now confirm, legislators—may not be considered the ‘authors’ of works that they produce in the course of their official duties as judges and legislators.” Slip op. at 5-6. Just as judges who have the authority to interpret the law cannot claim copyright in their decisions under *Banks*, the same holds for legislative bodies who have the authority to make the law. In short, “copyright does not vest in works that are (1) created by judges and legislators (2) in the course of their judicial and legislative duties.” Slip op. at 9.

Applying this two-step test to the case’s facts, the Court found that Georgia’s annotations are not copyrightable. First, the Court determined that the CRC “is not identical to the Georgia Legislature, but functions as an arm of it to produce the annotations.” *Id.* This, thought the Court, was eminently clear from the membership, staffing, funding, and procedure followed by the CRC in approving the annotations, as well as from state law precedent that the CRC “is within the sphere of legislative authority.” *Id.* at 10 (quoting *Harrison Co. v. CRC*, 24 Ga. 325, 330 (1979)).

Second, the Court found that, although the annotations are not enacted into law, their preparation is an act of “legislative authority” and they provide “commentary and resources that the legislature has deemed relevant to understanding its laws.”

The Court rejected Georgia’s argument that by listing “annotations” as copyrightable works in Section 101 of the Copyright Act, Congress exempted this type of work from the government edicts doctrine. The majority ruled that Section 101 only applied to “annotations . . . which . . . represent an original work of authorship.”

The Court also rejected Georgia’s argument that an adverse inference should be made because the Copyright Act explicitly precludes copyright protection for federal officials’ works but not for state officials. Instead, the Court opined, “the federal rule does not suggest an intent to displace the much narrower government edicts doctrine with respect to the States.” *Id.* at 12.

Finally, the Court noted its concern with Georgia’s argument in favor of limiting the government edicts doctrine based on content and not authorship. Taken strictly, such an argument would exclude not just annotations but also consenting and dissenting opinions, headnotes, and syllabi prepared by judges, proposed bills and committee reports prepared by legislators, and other materials supplementary materials that “do not have the force of law, yet . . . are covered by the doctrine.” *Id.* at 15. These materials, although they are without the force of law, are immensely important. “Imagine a Georgia citizen” reading an unannotated copy of Georgia’s Code “criminalizing broad categories of consensual sexual conduct . . . with no hint [from annotations] that important aspects of those laws have been held unconstitutional by the Georgia Supreme Court.” *Id.* at 17. Adopting Georgia’s argument, the court concluded, might lead to an unfair justice system based on the ability to pay for copyrighted material.



#### iv. Dissents

Justice Thomas objected to the majority's interpretation of the 19th Century cases that form the basis of government edicts doctrine, due to the narrower understanding of authorship and copyright protection current at the time, and agreed with Georgia's arguments that the annotations should be eligible for copyright protection under the terms of the Copyright Act because the legislature did not enact them. In response to the majority's policy concerns, he noted that the practical effect of the majority's decision may well be that states would stop producing annotated codes altogether, which would render obtaining quality legal assistance even more expensive than it is now.

Justice Ginsburg agreed with the two-part test outlined in the Majority Opinion regarding whether the government edicts doctrine should apply. However, she disagreed with the majority's finding that the OCGA's annotations were drafted by legislators "in the course of their . . . legislative duties." She argued that since the annotations were not created contemporaneously with the statutes, are descriptive rather than prescriptive, and were drafted for the public's convenience, and they should not satisfy the second prong of the test.

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#### IV. CONCLUSION

Due to the COVID-19 pandemic, the Supreme Court could not hear or decide all of the IP cases on last term's docket. Accordingly, there are some important IP cases from last term that are still pending. These include, for example, *Google L.L.C. v. Oracle America Inc.*, where the issues to be resolved involve copyright protection and fair use with respect to software interfaces. Additionally, the Court has recently granted certiorari to new IP cases with far reaching repercussions, such as *U.S. v. Arthrex, Inc.*, which regards the constitutionality of PTAB Administrative Patent Judges. Thus, we expect the Court's October 2020 Term to be just as significant for IP practitioners as its past term was.

\* Charles R. Macedo is a partner and David P. Goldberg is an associate at Amster, Rothstein & Ebenstein LLP. Mr. Macedo is the Co-chair of the NYIPLA's PTAB Committee and Mr. Goldberg is the Co-chair of the NYIPLA's Amicus Briefs Committee. Additionally, Mr. Macedo was counsel of record and Mr. Goldberg participated in the NYIPLA's amicus briefs in the NantKwest and second *Booking.com* cases. The authors wish to thank Chester Rothstein, Douglas A. Miro, Benjamin Charkow, Christopher Lisiewski, Chandler Sturm, Devin Garrity and Herbert A. Blassengale IV of Amster, Rothstein & Ebenstein LLP for their permission to use prior case alerts as a partial basis for this article. The opinions expressed in this article are those of the authors, and not of Amster, Rothstein & Ebenstein LLP or the NYIPLA.



## Stand by Your Appeal (from the PTAB)

BY: **KENNETH R. ADAMO AND EUGENE GORYUNOV**

Any party to an AIA trial “shall have the right to be a party to the appeal.”<sup>[1]</sup> Even though the statute gives a party an appellate right, that party, the party initiating the appeal, must still establish it has Article III standing to maintain the appeal.

In *Consumer Watchdog v. Wis. Alumni Research Found.*,<sup>[2]</sup> Consumer Watchdog filed a request for *inter partes* reexamination against a patent owned by Wis. Alumni Research Found. (“WARF”). Consumer Watchdog claimed the patent allowed WARF to preempt all uses of human embryonic stem cells. Consumer Watchdog was unsuccessful in the reexamination and filed an appeal to the Federal Circuit. The court, however, concluded that Consumer Watchdog had not established an injury in fact sufficient to confer Article III standing and dismissed the appeal.<sup>[3]</sup>

Consumer Watchdog is a not-for-profit public charity dedicated to providing a voice for taxpayers and consumers in various special-interest groups. It did not allege in its appeal that it had any involvement in research or commercial activities involving human embryonic stem cells that could serve as the basis for an infringement claim or that it had any intention to engage in such activities. Consumer Watchdog also did not allege it was a licensee (actual or prospective) of the patent it challenged.<sup>[4]</sup>

The court observed that U.S. district courts may only adjudicate Article III “cases” and “controversies.” A party seeking U.S. district court involvement must show it suffered an “injury in fact” that is both concrete and particular and actual or imminent. The injury must be shown to be fairly traceable to the challenged action and it must be shown that favorable judicial decision will likely redress the injury. At bottom, the party attempting to invoke U.S. district court review must have a “personal

stake in the outcome.” The Article III standing requirements “apply with equal force to appeals from administrative agencies,” such as the USPTO. Although Article III standing may not be needed to appear before an administrative agency, as is the case with reexaminations, “the constitutional requirement that [a party] have standing kicks in” once it seeks U.S. district court review.<sup>[5]</sup>

Consumer Watchdog relied on the PTAB’s denial of its reexamination to establish it had proper Article III standing to maintain its appeal. The court concluded this was not enough. The PTAB’s disagreement with Consumer Watchdog “did not invade any legal right conferred by the *inter partes* reexamination statute.” The statute “did not guarantee a particular outcome” favorable to Consumer Watchdog; it merely permitted it to challenge the patent and participate in the reexamination proceeding.<sup>[6]</sup>

Consumer Watchdog also argued that it was entitled to maintain its appeal because the reexamination statute permitted it to do so. The court disagreed, stating that the *inter partes* reexamination statute permitting an appeal “does not eliminate the requirements of Article III.” A statute may relax certain basic standing requirements but a procedural right granted by statute does not eliminate the requirement that Consumer Watchdog have a particularized, concrete stake in the outcome of the reexamination.<sup>[7]</sup>

The court also rejected Consumer Watchdog’s argument that the estoppel provisions relating to *inter partes* reexaminations established an injury in fact sufficient for Article III standing. Consumer Watchdog did not argue it was engaged in any activity that would give rise to a potential infringement suit or that it would file another request to cancel claims of the patent with the USPTO. The court found that Consumer Watchdog

thus had nothing more than “a general grievance” with the patent and the estoppel provisions did not confer standing.<sup>181</sup>

The Federal Circuit predictably extended *Consumer Watchdog* to AIA trials in *Phigenix, Inc. v. ImmunoGen, Inc.*<sup>191</sup>

In view of *Consumer Watchdog* and *Phigenix*, Article III standing to maintain a direct appeal from the PTAB in an AIA trial requires a showing of an injury in fact that is both concrete and particularized. Injuries that are “conjecture or hypothetical” will not provide standing.<sup>1101</sup>

Article III requires the appellant to “show that it is engaged or will likely engage ‘in an[] activity that would give rise to a possible infringement suit,’ or has contractual rights that are affected by a determination of patent validity.” The fact that the appellant “has no product on the market at the present time does not preclude Article III standing.” Where the appellant relies on potential infringement liability as a basis for an injury in fact, but is not currently engaging in an infringing activity, “it must establish that it has concrete plans for future activity that creates a substantial risk of future infringement or likely cause the patentee to assert a claim of infringement.” It is not enough for the appellant and appellee to be “competitors generally,” where appellant does not have any concrete product in development that would expose it to an infringement risk. Now, to be sure, “IPR petitioners need not concede infringement to establish standing to appeal.” But actual products or products in development must create a concrete and substantial risk of infringement or likelihood that they would lead to claims of infringement.<sup>111</sup>

Where standing is in doubt, the appellant must satisfy the “summary judgment burden of production” by submitting sufficient evidence:

in some cases, **an appellant’s standing to seek review of administrative action is self-evident**; no evidence outside the administrative record is necessary for the court to be sure of it. Self-evident standing typically arises when an appellant is an object of the action (or forgone action) at issue.

**When the [appellant]’s standing is not self-evident, however, the [appellant] must supplement the record to the extent necessary to explain and substantiate its entitlement to judicial review.** In so doing, an appellant may submit arguments and any affidavits or other evidence to demonstrate its standing. Taken together, an appellant must either identify record evidence sufficient to support its standing to seek review or, if there is none because standing was not an issue before the agency, submit additional evidence to the court of appeals, such as by affidavit or other evidence.

The appellant “must identify the relevant evidence demonstrating its standing ‘at the first appropriate’ time, whether in response to a motion to dismiss or in the opening brief” because standing involves threshold questions over a court’s authority to hear the case.<sup>1121</sup>

The Federal Circuit has issued numerous decisions clarifying factual circumstances that are sufficient, and insufficient, to confer Article III standing in AIA trial appeals.

#### I. Decisions that **Found** Article III Standing

The Federal Circuit has found that an actual or concrete future launch of a product that might trigger an infringement lawsuit is generally sufficient to give rise to Article III appellate standing. The threat of a lawsuit or dismissal of an earlier lawsuit without prejudice may also constitute a sufficiently concrete and particularized injury in fact, even where the appellant had divested itself of the potentially infringing products, so long as the appellant retains exposure for infringing acts that occurred prior to the divestment.

These and other fact patterns that were sufficient to establish Article III standing were shown in the following Federal Circuit decisions:

- *PPG Indus., Inc. v. Valspar Sourcing, Inc.* (Feb. 9, 2017):<sup>1131</sup> PPG established standing to maintain its appeal where it demonstrated that it had already launched a commercial product and received at least one inquiry from a customer

- suggesting that Valspar was planning to sue PPG for infringement.
- *Altaire Pharms., Inc. v. Paragon Biotech, Inc.* (May 2, 2018):<sup>[14]</sup> Altaire demonstrated that it had the requisite standing when it presented evidence of its intent to resume marketing its product and, on that basis, believed that Paragon would inevitably sue it for patent infringement when Altaire filed an Abbreviated New Drug Application with the FDA.
  - *E.I. DuPont de Nemours & Co. v. Synvina C.V.* (Sept. 17, 2018):<sup>[15]</sup> DuPont had standing to maintain its appeal because it had demonstrated that it had built a plant capable of infringing the challenged patent, Synvina alleged before the PTAB that DuPont's processes were embraced by the claims, and Synvina, DuPont's avowed competitor, rejected DuPont's request for a covenant not to sue.
  - *Google LLC v. Conversant Wireless Licensing S.A.R.L.* (Nov. 20, 2018):<sup>[16]</sup> Google and LG had standing to maintain the appeal because LG was previously sued for allegedly infringing the challenged patent as a result of selling one of its products, Google's Map application was directly implicated in Conversant's infringement contentions, and Conversant refused to grant a covenant not to sue.
  - *Amerigen Pharms. Ltd. v. UCB Pharma GmbH* (Jan 11, 2019):<sup>[17]</sup> Amerigen demonstrated that it had standing by presenting evidence that the launch of its generic product was blocked by the challenged patent, cancellation of the patent would "advance [the] drug's launch," and removing the patent from listing in the FDA's Orange Book would allow Amerigen to begin marketing its product.
  - *Mylan Pharms. Inc. v. Research Corp. Techs., Inc.* (Feb. 1, 2019):<sup>[18]</sup> Time-barred parties joined by the PTAB to an instituted IPR, under 35 U.S.C. § 315(c), as co-Petitioners had standing to participate in the appeal because, once joined, they were parties to an IPR and fell "within the zone of interests of § 319."
  - *Sony Corp. v. Iancu* (May 22, 2019):<sup>[19]</sup> Sony had standing to appeal the PTAB finding claims of its patent unpatentable as obvious even though the patent had expired, Petitioner had elected not to defend its victory, and Sony and Petitioner had settled the co-pending related U.S. district court case.
  - *Samsung Elec. Co., Ltd. v. Infobridge Pte. Ltd.* (July 12, 2019):<sup>[20]</sup> Samsung had standing where the challenged patent was licensed as part of a patent "pool" that included patents owned by Samsung. Royalties received from licensing the pool were divided among its members such that members would receive higher royalties if one of the patents, e.g., the challenged patent, was found unpatentable. The court found that Samsung's injury in the form of deprived royalties, at least in these specific circumstances and under the particular terms of the pool license agreement, "can be traced directly to the validity of Infobridge's patent and would be redressed by a favorable decision for Samsung."
  - *Grit Energy Solutions, LLC v. Oren Techs., LLC* (Apr. 30, 2020):<sup>[21]</sup> Grit had standing to maintain its appeal even though Oren had dismissed its infringement action asserting the challenged patent without prejudice, Grit had transferred ownership of all products previously accused of infringement, and Grit failed to identify any concrete plans for future activity that would create a substantial risk of future infringement lawsuits. According to the court, the dismissal of the earlier lawsuit without prejudice left Oren free to pursue its previous claims of infringement in the future. And, although Grit transferred ownership of the accused products, that did not absolve Grit of liability for actions it took before the transfer.
  - *Adidas AG v. Nike, Inc.* (June 25, 2020):<sup>[22]</sup> Adidas had standing to maintain its appeal despite there being no accusation of infringement in the U.S. The fact that the parties are direct competitors, Nike



accused Adidas of infringing a German patent covering relevant technology, and Nike refused to grant Adidas a covenant not to sue supported a finding of an injury in fact.

- *FitBit, Inc. v. Valencell, Inc.* (July 8, 2020):<sup>[23]</sup> Joined challenger that, in its own Petition, challenged less than the claims challenged by Petitioner in the joined proceeding, had standing to appeal “the entirety” of the PTAB’s Final Written Decision as a joined party.

## II. Decisions that **Did Not Find** Article III Standing

On the other hand, the Federal Circuit has found unsupported allegations regarding upcoming products, market competition, and the potential for litigation to be insufficient to give rise to Article III appellate standing. Such allegations are at most conjecture or hypothetical and cannot establish, under a “summary judgment” standard, a concrete and particular and actual or imminent injury in fact. Factual evidence, e.g., declarations, is not guaranteed to save the day. Declarations must be sufficiently detailed to allow the court to evaluate the merits of the claims of injury or infringement risk before allowing the appeal to proceed.

These and other fact patterns that did not amount to Article III standing were shown in the following Federal Circuit decisions:

- *Phigenix, Inc. v. ImmunoGen, Inc.* (Jan. 9, 2017):<sup>[24]</sup> Phigenix did not establish that it had standing to maintain its appeal where its briefs relied on unsupported allegations that Phigenix had suffered actual economic injury because the challenged patent increased competition between it and ImmunoGen. In other words, the court dismissed Phigenix’s allegations that if the patent were invalidated, at least a portion of ImmunoGen’s licensing revenue would inure to Phigenix.
- *RPX Corp. v. Chanbond LLC* (Jan. 17, 2018):<sup>[25]</sup> RPX failed to demonstrate that it had standing because RPX was not

engaged in any potentially infringing activities regarding the challenged patent. RPX’s evidence did not demonstrate that the PTAB’s final written decision “increased or aids the competition in the market of the non-defendant IPR petitioners” or that RPX suffered any quantifiable reputational or economic harm as a result of the decision.

- *JTEKT Corp. v. GKN Auto. Ltd.* (Aug. 3, 2018):<sup>[26]</sup> JTEKT lacked standing because it did not establish that it had a product in the market or that its planned product would create a substantial risk of infringement. JTEKT’s Chief Engineer admitted that JTEKT was still validating its design, and that its product concept would continue to evolve and might change until it was finalized, such that nothing could yet be analyzed for potential infringement.
- *Momenta Pharms., Inc. v. Bristol-Myers Squibb Co.* (Feb. 7, 2019):<sup>[27]</sup> Momenta lacked standing because the evidence of record established that Momenta’s prior proposed biosimilar product, that would potentially expose it to a claim of infringement, had failed clinical trials and had been withdrawn. The fact that Momenta did not abandon its intent to produce the product was overshadowed by Momenta terminating its participation in the program to develop it.
- *AVX Corp. v. Presidio Components, Inc.* (May 13, 2019):<sup>[28]</sup> AVX lacked standing, despite evidence tending to show that it was Presidio’s competitor, because AVX failed to present specific evidence of a “present or nonspeculative interest in engaging in conduct even arguably covered by the patent claims at issue.” The court rejected AVX’s argument that standing exists because Presidio had sued AVX before and would do so again to assert the challenged patent if it had a reasonable basis: AVX’s suspicion “does not mean that there is any reasonable basis right now” for doing so.
- *Gen. Elec. Co. v. United Techs. Corp.* (July 10, 2019):<sup>[29]</sup> GE lacked standing because it

had no definite plans to produce a product that might infringe the challenged patent. The court dismissed GE's submitted evidence, a declaration from GE's Chief IP Counsel and GC of Engineering for GE Aviation, finding that it did not establish that GE "lost bids to customers" or suffered any "lost business or lost opportunities" because it did not offer a product that could potentially infringe the challenged patent.

- *Fisher & Paykel Healthcare Ltd. v. ResMed Ltd* (Nov. 27, 2019):<sup>[30]</sup> Fisher & Paykel lacked standing despite claiming that it "continues to develop products" that ResMed "may at some future date allege infringe" the patent. Fisher & Paykel failed to "provide[] any, let alone sufficient, detail regarding features of its future products to enable [the court] to determine that its activities create a substantial risk of future infringement."
- *Argentum Pharms. LLC v. Novartis Pharms. Corp.* (Apr. 23, 2020):<sup>[31]</sup> Argentum lacked standing even though it submitted declarations that established it formed a partnership with a third party that intended to file an ANDA and release a generic product covered by the challenged patent. The court, however, held that Argentum failed to show that it was substantially involved in developing the generic product or that it bore any risk from any future infringement suit against its partner.
- *Pfizer Inc. v. Chugai Pharma. Co., Ltd.* (Apr. 27, 2020):<sup>[32]</sup> Pfizer failed to present evidence to establish that it had standing throughout the entire appeal. Pfizer provided evidence that it had concrete plans to market a biosimilar as early as July 2019. The notice of appeal, however, was filed on January 30, 2019, and Pfizer "failed to supply any evidence that it was suffering from an injury in fact when this appeal began."

Importantly, **standing to initiate** the appeal is not to be conflated with **standing to participate** in an appeal. In *Pers. Audio, LLC v. Elec. Frontier*

*Found.*<sup>[33]</sup> Petitioner Electronic Frontier Foundation ("EFF") challenged and ultimately demonstrated a collection of Personal Audio's claims to be unpatentable. Personal Audio appealed the PTAB's Final Written Decision. The Federal Circuit requested the parties brief whether EFF, the prevailing party at the PTAB, had standing to participate in the appeal in view of the court's holding in *Consumer Watchdog*. The court observed "that standing to appeal is measured for the party 'seeking entry to the federal courts for the first time in the lawsuit.'" In this case, Personal Audio, the party invoking judicial review, had Article III standing as a result of the PTAB cancelling its patent claims. And, with Article III standing being satisfied by Personal Audio, EFF was "not constitutionally excluded from appearing in court to defend the PTAB decision in its favor."<sup>[34]</sup>

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Practitioners must remember that Article III standing, not required to institute or maintain PTAB proceedings, is still required for appellate review of a PTAB decision to proceed. Under the current state of the law, Article III standing requires a showing that the appellant engages or will likely engage in some activity that would give rise to an infringement lawsuit or have some other contractual right affected by the PTAB's determination. Competitor status, by itself, is likely not enough to confer Article III standing. Appellant must have an actual product, or concrete future plans for a product that can trigger an infringement lawsuit.

Importantly, an appellant, under *Mylan*, is not deprived of standing merely by being time-barred (but joined) on the underlying AIA petition. Article III standing to maintain the appeal exists if the appellant otherwise demonstrates an injury in fact.

Practitioners should also keep in mind that a successful Petitioner defending a PTAB decision on appeal need not have Article III standing because Article III standing is satisfied by the appealing Patent Owner.

[1]35 U.S.C. § 319.  
[2]753 F.3d 1258 (Fed. Cir. 2014).  
[3]*Id.* at 1260.  
[4]*Id.* at 1260-61.  
[5]*Id.*  
[6]*Id.* at 1261-62.  
[7]*Id.* at 1262.  
[8]*Id.* at 1262-63.  
[9]845 F.3d 1168 (Fed. Cir. 2017).  
[10]*JTEKT Corp. v. GKN Auto.Ltd.*,898 F.3d 1217, 1220 (Fed. Cir. 2018).  
[11]*Id.* at 1220-21.  
[12]*Id.* at 1172-73.  
[13]679 Fed. Appx. 1002 (Fed. Cir. 2017).  
[14]889 F.3d 1274 (Fed. Cir. 2018).  
[15]904 F.3d 996 (Fed. Cir. 2018).  
[16]753 Fed. Appx.890 (Fed. Cir. 2018).  
[17]913 F.3d 1076 (Fed. Cir. 2019).  
[18]914 F.3d 1366 (Fed. Cir. 2019).  
[19]924 F.3d 1235 (Fed. Cir. 2019).  
[20]929 F.3d 1363 (Fed. Cir. 2019).  
[21]21 957 F.3d 1309 (Fed. Cir. 2020).  
[22]963 F.3d 1355 (Fed. Cir. 2020).  
[23]964 F.3d 1112 (Fed. Cir. 2020).  
[24]845 F.3d 1168 (Fed. Cir. 2017).  
[25]780 Fed. Appx.866 (Fed. Cir. 2018).  
[26]898 F.3d 1217 (Fed. Cir. 2018).  
[27]915 F.3d 764 (Fed. Cir. 2019).  
[28]923 F.3d 1357 (Fed. Cir. 2019).  
[29]928 F.3d 1349 (Fed. Cir. 2019).  
[30]789 Fed. Appx.877 (Fed. Cir. 2019).  
[31]956 F.3d 1374 (Fed. Cir. 2020).  
[32]812 F. App'x 979 (Fed. Cir. 2020).  
[33]867 F.3d 1246 (Fed. Cir. 2017).  
[34]*Id.* at 1247, 1249-50.



# Notable Trademark Decisions

NOVEMBER 2020

BY: SCOTT GREENBERG

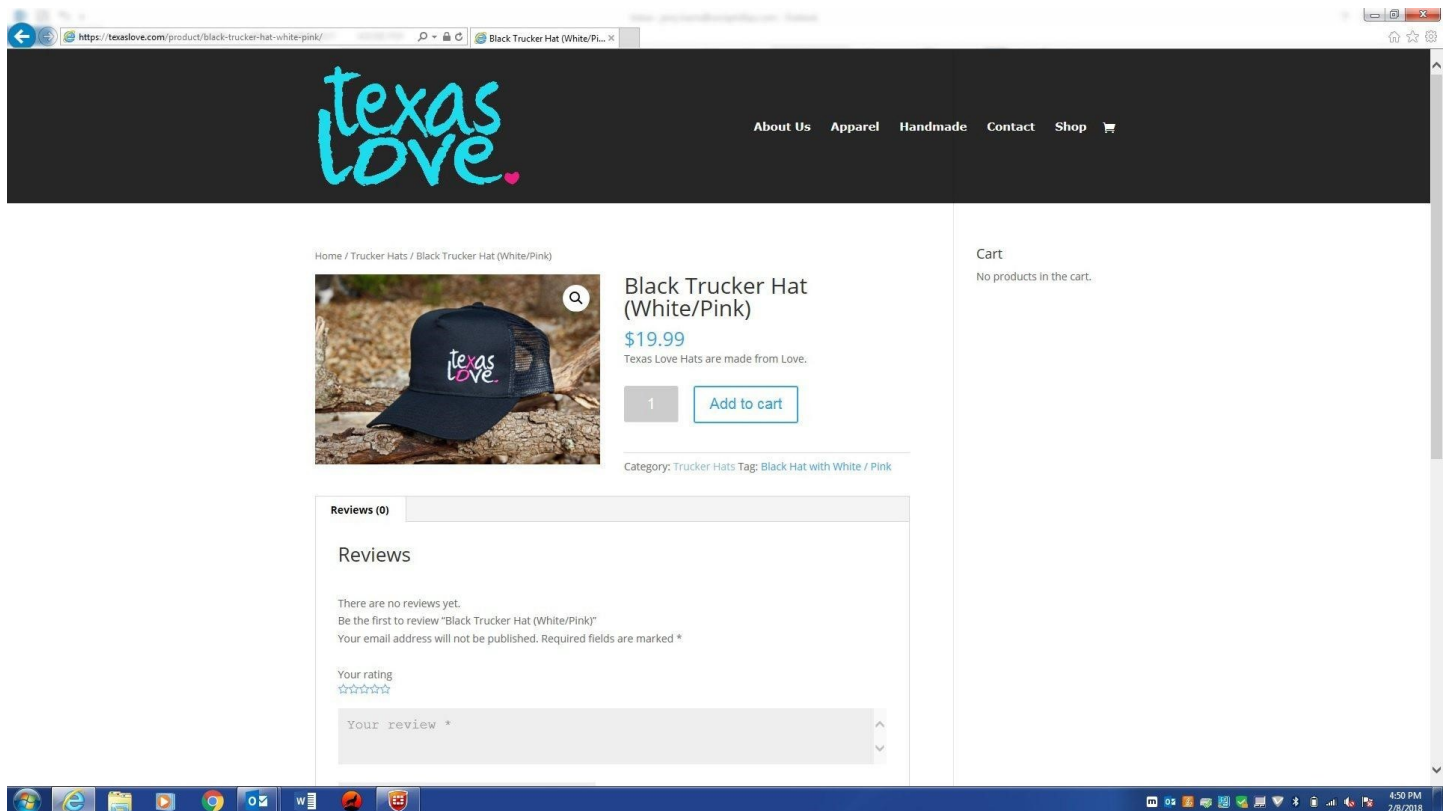
## Can A Commonly Used Phrase Be a Trademark?: Three Recent Board Decisions

In three recent decisions of the USPTO’s Trademark Trial and Appeal Board, the Board reviewed Examining Attorneys’ failure-to-function refusals in cases where the applied-for marks were phrases that were in use by the public to some extent. In two of these decisions, issued on October 29, 2020 and designated as precedential, the Board affirmed the refusals: *In re Texas With Love, LLC*, 2020 USPQ2d 11290 (TTAB Oct. 29, 2020); *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298 (TTAB Oct. 29, 2020). In the other case, a nonprecedential opinion from November 13, 2020, the Board panel cited to the other two decisions but reached the opposite conclusion and reversed the refusal: *In re Rodeowave Entertainment, LLC*, Ser. No.87801076 (TTAB Nov. 13, 2020).

To understand how the Board distinguished *Rodeowave* from the other two cases, it is worthwhile to view the three decisions together, considering among other things, the evidentiary track record .

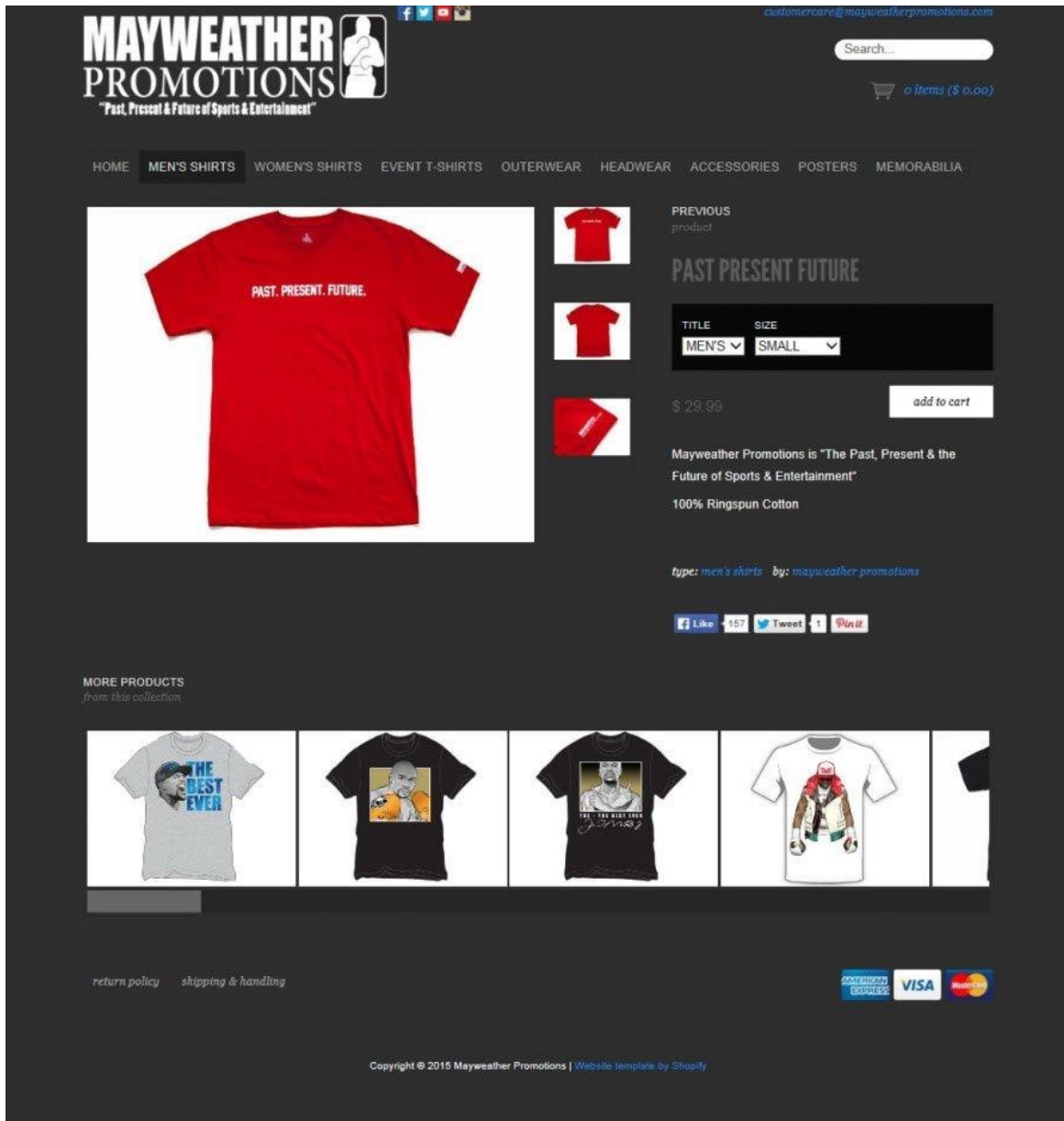
### A. The Marks, Goods and Specimens of Use

**Case 1: *In re Texas With Love, LLC*** In *Texas With Love*, the mark was TEXAS LOVE for hats and shirts in Class 25. The applicant’s specimens of use of the mark were point-of-sale website pages that displayed the mark at the top of the page and also included photos of the clothing goods bearing the mark on their surface, as in the following example:





**Case 2: *In re Mayweather Promotions, LLC*:** In *Mayweather*, the mark was PAST PRESENT FUTURE for t-shirts in Class 25. Here the specimen of use was a point-of-sale website excerpt displaying the mark on the ordering page and a photo of a shirt bearing the mark on its surface:



**Case 3: *In re Rodeowave Entertainment, LLC*:** In *Rodeowave*, the mark was JUST ANOTHER DAY IN PARADISE, for various household goods and furnishings in multiple classes. In contrast to the other cases, this application was based on an intent-to-use the mark in commerce.

**B. The Examiners' Refusals, Supporting Evidence and The Board's Rulings in Texas With Love and Mayweather**

In all three of these cases, the Examining Attorney refused registration under Sections 1, 2 and 45 of the Trademark Act (15 U.S.C. §§ 1051, 1052 and 1127), on the ground that the applied-for matter fails to function as a mark, i.e. the claimed mark is not capable of indicating the source of applicant's goods, or identifying and distinguishing them from those of others, but instead conveys a well-recognized and

widely used concept, message, expression, slogan or sentiment. *Texas With Love*, supra at \*1; *Mayweather*, supra at \*1; *Rodeowave*, supra, slip op. at 2.

In each case, the Examiner's supporting evidence included examples of third-party use of the phrase in question. In *Texas With Love* and *Mayweather*, this third-party use evidence was coupled with evidence of the applicant's own use of the asserted mark. However, in *Rodeowave*, there was no specimen of the applicant's trademark use in the record because the application was in the intent-to-use stage.

In affirming the refusal in *Texas With Love*, the Board was persuaded by the Examiner's evidence, which included at least eight third-party uses of either "Texas Love" or the word "Love" combined with a map of Texas (which the Board considered to be legally equivalent) on the surface of clothing products, plus at least another three third-party uses on the surface of art-display products, the Board finding that "[w]hen confronted with so many similar uses of a term to convey essentially the same concept or sentiment, consumers will perceive the term as a common message rather than a source identifier." *Texas With Love*, supra at \*6. Specifically, the Board concluded that the foregoing evidence showed that "Texas Love" expresses a well-recognized sentiment, namely "enthusiasm and support for or from Texas or Texans, and would be perceived as such when used on Applicant's identified goods [... therefore] it does not function as a mark for those goods." *Id.* The Board further held that, aside from whether the foregoing evidence establishes that "Texas Love" is a well-recognized sentiment, the evidence shows, at any rate, that the term "is widely used by Applicant's competitors in the clothing field and other third parties" and that such "widespread use of a term or phrase may be enough to render it incapable of functioning as a trademark, regardless of the type of message." *Id.* at \*6 and \*7. Considering this, the Board affirmed the failure-to-function refusal on both bases. It found the applied-for term to be incapable of functioning as a trademark for the applicant's goods due to (a) the term's expression of a particular well-recognized sentiment, and (b) its widespread use on similar goods. *Id.* at \*7 and \*8.

In *Mayweather*, the Examiner's evidence included nine third-party t-shirts displaying the phrase "Past Present Future" on their surface, as well as eight third-party web pages or articles using the phrase. *Mayweather*, supra at \*2. The Board agreed with the Examiner that "the weight of the evidence does demonstrate ubiquitous third-party use of the phrase PAST PRESENT FUTURE to refer to the past, present and future of people, things, ideas and concepts." *Id.* at \*4. The Board further held that the foregoing evidence demonstrated that "in the clothing industry, this common message is used on t-shirts as a feature such that the display itself is an important component of the product and customers purchase the product not associating it with a particular source but because of the message." *Id.* Therefore, as in *Texas With Love*, the Board panel in *Mayweather* affirmed the failure-to-function refusal on both potential bases:

In this case, the Examining Attorney's evidence establishes not only that PAST PRESENT FUTURE is a widely used message that conveys a concept, but also that consumers are accustomed to seeing that message displayed in a non-source identifying manner on t-shirts. Taken together, these two forms of evidence strongly support a finding that PAST PRESENT FUTURE is not perceived as a mark when used in connection with t-shirts. *Id.*

### **C. Rodeowave: Inherent Ambiguity As A Distinguishing Factor**

The Board's opinion in *Rodeowave* included examples, from the evidence of record, of twelve third-party uses of the subject phrase "Just Another Day In Paradise" on the surface of various home décor and household goods such as those identified in the application, an additional seven uses of the phrase within various media sources including books, articles and record albums, and numerous media references to a song entitled "Just Another Day In Paradise". *Rodeowave*, supra, slip op. at 5-10.

However, the Board panel in *Rodeowave* determined that the evidence failed to demonstrate that "Just Another Day In Paradise" is "used in everyday parlance" or that it consistently "conveys a common

social, political, patriotic, religious or other informational message.” Regarding the examples of record of use of the phrase in the media, the Board noted that these primarily constitute use of the phrase “as the title of creative works rather than for any apparent common informational message.” *Id.* at 11-12.

Moreover, the Board took note of the Examining Attorney’s statements in various Office Actions that the phrase “Just Another Day In Paradise”, rather than conveying a clear and specific message, actually is subject to a number of different interpretations, as follows:

- taking pleasure in small things;
- getting away from one’s troubles;
- taking things for granted and being grateful;
- getting away for a vacation;
- recognizing that one’s self is lucky;
- enjoying what life brings to a person;
- contentment even if things are not perfect; and
- living in just the right place for one’s self. *Id.* at 12-13.

The Board held that this “potential ambiguity of the applied-for-mark makes it less likely that consumers would perceive it as conveying a particular informational message and distinguishes it from the types of well-recognized and unequivocal expressions found to be incapable of serving as source identifiers.” *Id.* at 13 (citing *Texas With Love* and *Mayweather* as examples of the latter).

As to the other potential basis for a failure-to-function refusal, i.e. widespread use on the surface of goods such as the applicant’s, the Board panel in *Rodeowave* noted: “in our view, use of the applied-for mark is not sufficiently widespread such that we can find it inherently incapable of serving as a source identifier even though the record does not demonstrate that the applied-for-mark is a familiar expression with a generally understood meaning.” *Id.* at 14.

Thus, the *Rodeowave* panel’s determination that the quantity of third-party use on similar goods present in the record was insufficient to support the failure-to function refusal seems to be dependent to some extent on the panel’s concomitant determination that the phrase “Just Another Day In Paradise” does not always convey a single specific message. This holding leaves open the possibility that the panel may have deemed the quantity of evidence of third-party use on similar goods to be sufficient to support the refusal if the phrase at issue consistently conveyed one specific message.

Additionally, the Board panel in *Rodeowave* pointed out that, by reversing the Examiner’s failure-to-function refusal, the panel was determining “only that the applied-for-mark is **capable** of functioning as a trademark”, and that its determination “does not foreclose the possibility that the applied-for mark may be refused as ornamentation once specimens of use are submitted with a statement of use.” *Id.* at 14, n.13 (emphasis in original). Therefore, the possibility remains that, once the *Rodeowave* applicant files its proof of use, the Examiner’s evidence of third-party use on the surface of similar goods may support a refusal of registration on a different ground, at least with regard to the Principal Register, namely that the applied-for mark lacks distinctiveness as a source-indicator because it will be perceived by consumers as ornamentation of the product.

*In re Texas With Love, LLC*, 2020 USPQ2d 11290 (TTAB Oct. 29, 2020) (precedential); *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298 (TTAB Oct. 29, 2020) (precedential); *In re Rodeowave Entertainment, LLC*, Ser. No. 87801076 (TTAB Nov. 13, 2020) (non-precedential). [SG]

**MINUTES OF OCTOBER 13, 2020**  
**MEETING OF THE BOARD OF DIRECTORS OF THE**  
**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**

The Board meeting was held via videoconference. President Colman Ragan called the meeting to order at approximately 4:00 p.m. In attendance were:

Colman Ragan, President, presiding  
Gene Lee  
Marc Pensabene  
Jonathan Berschadsky  
Kathleen McCarthy  
Diana Santos  
Paul Bondor  
Rob Isackson  
Rob Rando  
John Moehringer  
Patrice Jean  
Heather Schneider  
Abigail Langsam  
Cheryl Wang (left call at 5 pm)

Alicia Russo and John Mancini were excused and absent. Feikje van Rein attended from the Association's executive office.

The meeting was called to order by President Colman Ragan. Minutes from prior meeting were approved.

Abigail Langsam presented the financial report with the continuing trend of not having much income. The RRR contract, which has been renegotiated, pending some small details to be ironed out, provides some reprieve.

Abigail reported 5 new members – 4 students from Cardozo. Motion to waive reading of names and to approve new members was passed.

Amicus Briefs Committee: Rob Isackson reported that in Arthrex, the Supreme Court accepted cert in 3 of the cases, which address constitutionality of ABJs and severability. The Committee will review and come up with proposals for a brief that NYIPLA can submit. GSK vs. Teva – discussed participating pending board quorum. FTC vs Abby, which examines whether reverse payments are acceptable under anti-trust, is pending board quorum.

Legislative Action Committee: Colman Ragan noted that the issue of discretion at PTO keeps coming up but not much is expected to happen other than ACB confirmation and mainly watching what next Congress will look like.

Copyright & Trademark: Kathleen McCarthy reported that Section 230 and online platform liability has been gaining attention. Also being discussed is the efficacy of DMCA notice & takedown procedures and application of irreparable harm from eBay case. Congress may pass the Trademark Bill.

Judge's Dinner 2020 & 2021: Colman Ragan noted that given the news and pandemic status, it is very unlikely we can have an in-person event. Next steps will involve determining the best technology for facilitating a virtual judge's dinner. The Board discussed how to get sponsorships from tech vendors such as by having vendors host break-out rooms, or perhaps putting together gift bags and packages for attendees and potential clients. Some ideas discussed included having clerks from various jurisdictions and attendees can virtually visit different courts, honoring RBG to draw more judiciary



attendees, supporting Judge Salas's initiative for the privacy and safety of federal judiciary, having Jane Ginsburg as a guest speaker and honoring the US Marshalls for protecting judges. Colman will reach out to Judge Salas's clerk.

Colman Ragan requested a Board vote to change the format of the 2021 Judges Dinner from in-person to virtual which got approved.

President's Forum Series: Stairway to Heaven 10/21 panel with musicologists and some practitioners in the area with Katie and Colman moderating. Patent topic for 12/08 or 12/09 not yet titled but will discuss CA legislative that effectively bans settlements of patent litigation based on presumption of anti-competition; CA will participate in Hatch Waxman. Mike Johnson will reach out to Judge Noreika.

Programs: Heather Schneider gave an update on the upcoming programs; the Patent CLE series scheduled for November and the Bootcamp for January 2021. Patrice Jean updated the Board on the planning of the NYIPLF virtual wine and food event scheduled for December 3, 2020.

Centennial Project: Rob Rando mentioned that the project team will reconvene and continue planning.

The meeting was adjourned at 5:25 p.m.

**MINUTES OF NOVEMBER 10, 2020**  
**MEETING OF THE BOARD OF DIRECTORS OF THE**  
**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION**

The Board meeting was held via videoconference. President Colman Ragan called the meeting to order at approximately 4:00 p.m. In attendance were:

Colman Ragan, President, presiding  
Gene Lee  
Marc Pensabene  
Jonathan Berschadsky  
Kathleen McCarthy  
Diana Santos  
P Bondor  
Rob Isackson  
Rob Rando  
John Moehringer  
Patrice Jean  
Colman Ragan  
Heather Schneider  
Abigail Langsam  
Cheryl Wang (joined call at 4:33 pm)

Feikje van Rein attended from the Association's executive office.

The meeting was called to order by President Colman Ragan. Minutes from prior meeting were approved.

Abigail Langsam presented the financial report with the continuing trend of not having much income.

Abigail reported 7 new members – 4 students and 2 active 3-. Motion to waive reading of names and to approve new members was passed.

Amicus Briefs Committee: Rob Isackson - The Board discussed the issue of reaching a quorum with general agreement that the organization should weigh in important issues. Ultimately, the board decided it was unnecessary to redo the bylaws. Instead, the board approved a motion to fix the guidance by creating a 2-step procedure. The first step is to determine whether the organization should weigh in. Where there's a super majority, then the organization will take a public position. Board members who need to recuse themselves can do so from step two which involves the position that the organization may take.

Legislative Action Committee: Colman Ragan proposed that the organization write a letter to support Senate Bill 4711, protecting federal judges in light of Judge Salas and more recently, Judge Chekjie, to get ACG rep to bring it to the attention of NY state representatives. Colman pointed out that judges in NY are barred from lobbying. Given the organization's relationship with various judges and the nature of our annual dinner event, the board members agreed that it made sense for us to support the bill. The first step is for the board to approve the letter circulated for review.

Judges' Dinner 2020 & 2021: The Board discussed platforms for hosting a large-scale virtual meeting as well as programming format. The members largely agreed on keeping the event to a manageable length – a couple of hours, starting with an initial presentation from the guest speaker and then breakout rooms. The Board discussed various activities and formats for breakout rooms, such as having law firm sponsors host the breakout sessions.

The Board discussed potential guest speakers. It was confirmed that Justice Sotomayor would not be able to make it. One of the board members knows someone from Justice Thomas's office and will put together a write up for outreach. The board decided that Chief Justice as guest speaker would be best option, followed by Justice Thomas and then Justice Kagan.

Colman discussed nominating Judge Prost for the OPS award since she is rotating off this year. She has always attended the dinner and been willing to give some time to the organization. Colman asked the Board to determine whether there would be any hint of impropriety for him to present the award to a judge who has issued opinions involving his client. The Board agreed unanimously that it would not be improper particularly because the award is given on behalf of the organization itself.

President's Forum Series: Stairway to Heaven 10/21 panel with musicologists and some practitioners in the area with Katie and Colman moderating. Colman noted that the event went well, and was well-attended with robust conversation about the ramifications of latest legislation on the music industry.

Patent topic for 12/08 or 12/09 discussing states rights as it relates to the tandem CA and NY legislation that will place limitations on ability for parties to settle. There will be a reps from pharma such as Novartis, the person who wrote the brief challenging the legislation. The committee has reached out to the NY AG office and is still looking for judges to participate.

Heather Schneider reported that for NYIPLA Bootcamp, she will be sending out emails to volunteers and plans to hold a kick-off call after the patent series programming is wrapped up.

Centennial Project Rob Rando reported that the final logo design for the program should be determined shortly and after that the project can move forward with the marketing materials.

#### Previous and Upcoming Programs:

PTAB Arthrex Program: Rob Rando reported that over 30 people attended and the event generated signups for membership.

11/10 - 11/19 Fall Patent CLE Series: Heather Schneider noted that there were 65 people in attendance for the first day. Judge Prost's talk was well-received as it was great to hear from her in an informal manner. The diversity panel was great as well as the PTAB panel. The price point was \$150 and generated \$11,200.

11/12 Young Lawyers Social Mixer: Marc Pensabene noted that the committee's call last week was well attended but that there were not a lot of signups for the social mixer. The Board discussed various ways to further engage the young lawyers and students in the organization.

12/3 6 pm Diversity Fundraiser: Patrice Jean reported that the event will feature a diverse sommelier and winery owner, which was done through the Princeton Club at an excellent rate.

The meeting was adjourned at approximately 6 p.m.

# WELCOME NEW MEMBERS

Last	First	Firm/Company/Law School	State	Membership
Aronoff	Jane	Jane Aronoff, P.C.	New York	Active 3-
Balestra	Lydia	Benjamin N. Cardozo School of Law	New York	Student
Bloom	Andrew	Benjamin N. Cardozo School of Law	New York	Student
Chan	Keala	Chan Hubbard PLLC	New York	Active 3+
D'Amore	Cecily	Benjamin N. Cardozo School of Law	New York	Student
Gerstner	Kyle	Northern Illinois College of Law	Illinois	Student
Klipper	Efram	Brooklyn Law School	New York	Student
Leach	Christopher	Benjamin N. Cardozo School of Law	New York	Student
Maffei	Olivia	Benjamin N. Cardozo School of Law	New York	Student
Margulis	Aaron	Benjamin N. Cardozo School of Law	New York	Student
Singh	Deepa	American University Washington College of Law	Washington, D.C.	Student
Xi	Meng	Susman Godfrey LLP	California	Associate

## MOVING UP & MOVING ON



### BRIAN O'REILLY, MICHAEL FURROW, AND ERICA KUO

Formerly of DLA Piper, have joined Kilpatrick Townsend & Stockton LLP, with O'Reilly and Furrow joining as Partners and Kuo joining as Counsel



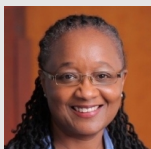
### KEVIN MCNISH

Formerly of Desmarais LLP, has formed his own firm, McNish PLLC



### ABBY MARKESON

Formerly of Venable LLP, has joined Kilpatrick Townsend & Stockton LLP as Counsel



### WANDA FRENCH-BROWN

Formerly of McGuireWoods LLP, has joined Loeb & Loeb LLP as a Partner

## NYIPLA Publications Committee Editorial Team

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Margaret Welsh

*Board Liaison*  
Patrice Jean

*Committee Members*  
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Heather Bowen  
William Dippert  
John Kenneth Felter  
Robert Greenfeld  
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Kyle Koemm  
Clint Mehall  
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Calvin Wingfield

**NYIPLA Executive Office**  
2125 Center Avenue, Suite 616  
Fort Lee, NJ 07024, USA  
Tel: 1.201.461.6603  
Email: [admin@nyipla.org](mailto:admin@nyipla.org)  
Web: [www.nyipla.org](http://www.nyipla.org)

