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Bright Ideas

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Message from the Chair

Kelly M. Slavitt

I was going to call this my Swan Song Chair's Message, but according to Wikipedia[1] I learned that a swan song is "a metaphorical phrase for a final gesture, effort, or performance given just before death or retirement." Yikes, I have two children under seven years old, so I hope death isn't around the corner, and I know retirement isn't! Reading further, I was relieved to learn that the term "has become an idiom referring to a final theatrical or dramatic appearance, or any final work or accomplishment. It generally carries the connotation that the performer is aware that this is the last performance of his or her lifetime, and is expending everything in one magnificent final effort." Whew.

I write this Swan Song Chair's Message with a sense of great accomplishment and pride to be part of a Section that continually finds new ways to provide value to its members. During my two-year tenure I was fortunate to watch the Section reach an important milestone: our twentieth anniversary as a NYSBA Section, and I am pleased to report that we are still going strong.

Becoming Section Chair was the culmination of a process that started when I was a night student at Brooklyn Law School, submitted a course paper for the Section's Law Student Writing Competition, won an award, was invited to Co-Chair the Young Lawyers Committee, and served successively as Secretary, Treasurer, and Vice-Chair of the Section. As this shows, there are many, many ways to get involved in the Section—there is no template.

By keeping pace with what's important to our members, the Section has been growing steadily for many years. When I became Chair, I promoted two new initiatives aimed at continuing this trend. The first was the In-House Initiative to promote diversity among the types of practitioners within the Section. As someone who went in-house after five years at large law firms here and abroad, I know firsthand the importance of relationships between in-house counsel and outside law firms. As a woman and former non-profit employee, I also know firsthand the importance of diversity in the membership of the Bar Association, which includes a mix of lawyers from law firms, in-house, government, academia, and non-profits. So I created this initiative with the goal of promoting new relationships, membership, and diversity. Our Committees generally have two co-chairs, and our goal is that one be a law firm practitioner and one an in-house attorney. We also strive for diversity—by including in-house attorneys—on our CLE panels. As part of the initiative, the Corporate Counsel Section now has a liaison who sits on the IP Law Section's Executive Committee.

The In-House Initiative had its successful kickoff event on June 25, 2013. The event started with a CLE program called "Social Media Risks and How to Mitigate Them" and ended with a cocktail reception. Over seventy in-house attorneys signed up to attend, and the pro-

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gram was enthusiastically received. A follow-up event is being planned.

My second initiative focused on the importance of the Section's eighteen committees, which are listed on pages 30-31 of this issue. The expertise of each Committee is what keeps the Section strong. I attribute our strong Section membership to our ability to recruit new members through Committee programs where potential/new members can meet existing members in a smaller setting and get to know the Section better. Committees have been hosting our monthly Executive Committee meetings on a rotating basis and updating us on the law in their area as well as on the events they are planning. For the first time, this year's Annual Meeting program included a panel where a Chair of each Committee gave a brief update on substantive law in each Committee's area.

Thanks to everyone who attended the Annual Meeting in January at the New York Hilton Midtown. The program focused on global changes in the IP sphere, with an impressive set of speakers addressing topics such as the changing environment for patents, financial aspects of IP assets, and IP issues arising in the digital age. The Section again hosted a reception at the end of the CLE program targeted towards Young Lawyers. This reception continues to be a great way for us to recruit and mentor young lawyers and to get them involved in the Section.

Also during the Annual Meeting, the Section again hosted a table at the very successful Diversity Reception. As a tribute to the importance of diversity and the reception, Executive Committee members were on hand to answer questions, promote the Section, encourage new memberships, and make new friends.

I am proud that the Section's diversity efforts continue to increase. The Executive Committee has a longstanding Diversity Initiative and created the Women in IP Program eleven years ago. As a huge proponent of leading by example, I take great pride in the fact that three of our four Section officers are women (me, Treasurer Erica Klein, and Secretary Robin Silverman). Thank you to all of the men and women in the Section who have encouraged and supported these efforts. Our law firm partnership and general counsel diversity statistics should be so high.

During my tenure I have been extremely proud each year to award the Miriam Maccoby Netter Fellowship. Mimi was a longstanding active member of the Section who guided me early on in my legal career. The 2013 fellowship was awarded to Volunteer Lawyers for the Arts, which enabled legal fellow Charles Chen to receive hands-on experience in copyright, trademark and patent matters. We are thrilled to see this fellowship being put to good use, both to give young attorneys a leg up in their legal careers and to benefit the community at large.

As the Section increases its influence and reach globally, we are forming partnerships with other IP groups, including the SIPO-US Bar Liaison Council and the U.S. Bar-EPO Liaison Council. We are exploring, and expect to add, additional partnerships this year.

Through the Section I have met alumni from my law schools, made new colleagues and friends, developed excellent working relationships with adversaries, found mentors, and became a mentor. For that, I want to thank everyone in the Section—this Section has made me a better lawyer and a better person. And I've had so much fun along the way!

As with this Section's previous Chairs, I look forward to my continued involvement in this Section—whatever shape that role will take as decided by the new leadership. I have truly enjoyed my tenure as Chair and thank you for all you've contributed to making this Section what it is today.

Kelly M. Slavitt

Endnote

1. Apparently, the U.S. Supreme Court still refuses to cite to Wikipedia, unlike its colleagues in the courts of appeal.

Inter Partes Review in the Patent Trial and Appeal Board: A Top Ten List

By Peter C. Schechter

I. Introduction

Since the *inter partes* review (IPR) procedure became available on September 2012 as part of the America Invents Act of 2011,[1] more than 1,000 petitions have been successfully filed[2] in the USPTO Board of Patent Trial and Appeal (PTAB) challenging the validity of patents on the basis of printed publications under 35 U.S.C. §§ 102 (anticipation) or 103 (obviousness). In contrast, in the thirteen years after *inter partes* reexamination was introduced as part of the American Inventors Protection Act of 1999, a total of 2,419 requests were filed in connection with that now-replaced mechanism for participatory validity challenges in the USPTO.[3] At the current pace of IPR petition filings, use of the new procedure will eclipse that of the old in just its third full year of availability. By any reasonable measure, IPR is becoming the "new normal" for U.S. patent validity challenges.

There are a number of important reasons why IPR has become so popular so quickly, including both procedural and substantive IPR rules viewed as favoring the patent challenger and the apparent greater ease of obtaining stays of related district court infringement litigation. While IPR is not being used equally by patent challengers across all technology sectors, for many companies in broad technological categories, IPR is definitely becoming the weapon of choice when defending against the accusations and licensing advances of patent owners, whether in correspondence or in district court.

II. IPR Is Popular and Becoming More Popular Every Day

According to statistics and data available from the USPTO's website portal for the PTAB, seventeen IPR petitions were successfully filed in the final two weeks of FY2012, when IPR first became available. In FY2013 (Oct. 1, 2012 through Sept. 30, 2013), 514 new IPR petitions were successfully filed, averaging about 43 per month. The average does not tell the whole story, however, as the pace of new filings has been steadily climbing. In the first part of FY2014 (Oct. 1, 2013 through March 6, 2014), 393 new IPR petitions were successfully filed, an average of about 75 new petitions each month. Even if the rate of new filings levels off, roughly 900 new petitions will be filed in FY2014. But there is nothing to suggest that the pace of filings will level off to a consistent monthly number anytime soon. In fact, no one knows what the eventual steady-state rate will be.

If Congress does not change any of the rules that make IPR so appealing to patent challengers, and if the PTAB continues to issue "final written decisions" that make sense to the IP community at large (and especially to the "patent defendant community"), and those decisions are affirmed (both procedurally and substantively) by the Federal Circuit, it is fair to assume we will soon see at least 100 new IPR petitions filed every month. How high can the monthly number of new petitions go? According to the PricewaterhouseCoopers 2013 Patent Litigation Study (June 2013),[4] "the number of patent lawsuits filed spiked by almost 30 percent in 2012 to over 5,000, with some of that increase attributed to the AIA's 'anti-joinder' provision." The study further noted that "[p]atent infringement litigation shows no signs of cooling off…."

In view of the effect of the AIA's anti-joinder provision, it is not reasonable to conclude that there will be 5,000 separate defendants (i.e., one per lawsuit) ready, willing, and able to file IPR petitions each year because plaintiffs now file multiple lawsuits for infringement of the same patent by different infringers rather than a single multi-defendant suit. On the other hand, many suits involve allegations concerning multiple patents. Thus, the steady-state pace of new IPR petitions per year likely falls somewhere between the 900 new petitions that will be successfully filed in FY2014 and the 5,000 (or more) new infringement suits filed each year as the IP community becomes more familiar and comfortable with the IPR process.

III. How IPR Works

By now, there have been hundreds—perhaps thousands—of presentations, speeches, articles, papers, conferences, and symposia about how IPR works, and there surely will be more in the future. This article gives only a brief overview of the procedure before focusing on the many aspects of IPR that make the procedure so attractive to patent challengers.

IPR replaced *inter partes* reexamination as the mechanism for participatory challenge in the USPTO of any issued patent under 35 U.S.C. §§ 102 and 103 based on prior art patents or printed publications.[5] A petition may be filed by anyone other than the patent owner, subject to certain restrictions.[6] The restriction coming into play most often is that IPR is available only during the one year after the petitioner (or a privy) is served with a patent infringement complaint.[7] IPR is unavailable to a party that has already filed a court action challenging patent validity.[8] These restrictions are generally unimportant to entities that take prompt action upon being accused of infringement.

The IPR petition is subject to exacting formal and substantive requirements, and the PTAB is generally unforgiving of mistakes. The details of those requirements are beyond the scope of this paper.[9] The petitioner may—and usually does—submit declarations of technical experts containing supporting evidence and opinions along with the petition. In contrast, the patent owner is prohibited from filing any opposing testimonial evidence with the optional preliminary response; such evidence may be filed at a later phase of the IPR process. However, because the substantive content of the preliminary response may not include all of the patent owner's best arguments and evidence, many patent owners are opting to not file the optional preliminary statement at all, instead waiting to see what the PTAB decides with respect to the challenge grounds set out in the IPR petition. The PTAB—the successor to the Board of Patent Appeals and Interferences—conducts IPRs. The entire motion-based process is referred to as a "trial," although it is nothing like a civil or criminal trial. The IPR is conducted by a panel of three "administrative patent judges" who make rulings regarding institution of the trial in response to the petition and any optional preliminary statement filed by the patent owner, decide certain discovery and evidentiary matters, and ultimately issue a final written decision cancelling any challenged claims, included proposed amended claims, that are deemed unpatentable. Any party dissatisfied with the final written decision may appeal to the Federal Circuit.[10]

Returning chronologically to the early stages of the IPR, upon review of the petition and any preliminary response by the patent owner, the PTAB determines whether there is a reasonable likelihood the petitioner will prevail with respect to at least one of the challenged claims.[11] Experience shows that the PTAB will likely narrow the issues by accepting only a few, or even only one, of the petitioner's asserted grounds of unpatentability; the other grounds are then denied, either substantively or on the basis that they are "redundant," and the scope of the trial is thus limited to only the accepted grounds of challenge identified in the PTAB's institution decision.

It should be noted that, unlike the USPTO examiner in *inter partes* reexamination, the PTAB does not conduct its own examination of the patent claims and does not issue any grounds of rejection of its own. In other words, IPR is an adjudicative, not an examination, process.

Along with the institution decision, the PTAB issues a scheduling order setting in motion a process that ordinarily concludes within twelve months of the date of the institution decision. Although the process may be extended for six months for good cause, the author is unaware of any IPR that has been so extended. Only limited and strictly controlled types of sequential discovery are permitted. In addition, the patent owner may submit a motion to amend the claims along with the response to the grounds of the petition adopted by the PTAB in the institution decision. A short evidentiary motions period is provided before the oral hearing. After the oral hearing, the PTAB issues a final written decision regarding the patentability of the challenged claims as well as of any proposed amended claims.[12]

Unlike in *inter partes* reexamination, the petitioner and patent owner are permitted to settle their dispute during the IPR proceeding.[13] However, the PTAB has discretion to dismiss a settling petitioner and continue the process as to the patent owner, issuing a final written decision even without any further participation of the patent owner. Settling on the proverbial courthouse steps thus is not really a viable option for the patent owner, as the patent may be cancelled anyway, notwithstanding the settlement.

Estoppel against the petitioner (and its privies) applies immediately upon issuance of the final written decision and bars a subsequent validity challenge in any forum on any ground the petitioner raised or reasonably could have raised during the IPR.[14] Estoppel also applies against the patent owner, barring it from subsequently obtaining in any USPTO proceeding (including original examination, continuation, division, continuation-in-part, reissue, or *ex parte* reexamination) a patent claim that is not "patentably distinct" from any finally refused or canceled claim.[15]

IV. Key Advantages of IPR

Many articles have touted four, five, even six reasons why IPR has quickly become so popular as compared with its predecessor, *inter partes* reexamination, and the alternative of proving patent invalidity in court. There is no reason to stop at even six reasons, however, as there are at least **ten** easily identifiable advantages of IPR:

1. Initiation (easier). Convincing the USPTO to conduct an *inter partes* reexamination required demonstration of a substantial new question of patentability (SNQ). For at least the first several years, this requirement was viewed as limiting validity challenges to those based solely on prior art not cited during original prosecution. Although the USPTO later eased up on the interpretation of the SNQ test and granted requests based on new arguments about previously cited and considered prior art references, it was still widely believed that a request for *inter partes* reexamination should rely on previously uncited prior art, given that the reexamination could be conducted by the same examiner who handled the original prosecution.

While some practitioners still cling to this view with respect to IPR, experience is proving them wrong in a significant number of proceedings. Thus far, only about one-third of IPR petitions have been based entirely on previously uncited prior art. The PTAB clearly is willing to take a hard second look at prior art originally deemed unworthy by the examiner who handled the original

prosecution. This is a welcome development for patent challengers who are able to focus the PTAB's attention on specific aspects or portions of individual prior art references that may have been cited by patent applicants in information disclosure statements along with tens, scores, or even hundreds of others.

2. Preponderance (easier). In IPR, the petitioner bears the burden of proving a proposition of unpatentability by a "preponderance of the evidence."[16] In contrast, patent claims in district court litigation are presumed valid under 35 U.S.C. § 282, and invalidity must be proven by "clear and convincing" evidence, a much higher burden for the challenger. The practical impact of this lowered burden of proof cannot be overstated.

3. "BRI" (easier). In addition, the complex rules of patent claim interpretation developed by the courts over the years, by which patent owners seek to assign definitions just broad enough to ensnare the accused infringer yet just narrow enough to avoid reading on the prior art, do not apply in IPR proceedings. Instead, the PTAB applies the USPTO's *In re Yamamoto* "broadest reasonable interpretation consistent with the specification" (BRI) approach used in original patent examination, which yields much broader interpretations that render claims much more susceptible to being deemed unpatentable. The rationale for applying the patent examination approach is that the patent owner may amend the claim to avoid any conflict with the prior art. (Given the difficulties of amending claims in an IPR (discussed below), however, criticism of the BRI approach is not completely unreasonable, and Congress is considering requiring the PTAB to use the same rules used by the courts to interpret the meaning of claims in granted patents.)

4. Amendment (harder). As just mentioned, it is possible for the patent owner to amend patent claims in an IPR. Specifically, for each challenged claim the patent owner can propose a reasonable number of substitute claims.[17] The PTAB considers exactly one to be a "reasonable number" in most circumstances.

In practice, one of the main advantages of IPR over *inter partes* reexamination is the extreme curtailment of the patent owner's ability to amend claims or add new claims. Nothing was more frustrating to third-party requesters than watching patent owners add limitations to rejected claims that, although not disclosed in the cited and applied prior art, were nonetheless trivial, and arguing that the newly claimed trivial features rendered the claims patentable. Worse still was helplessly watching patent owners add scores of detailed independent "picture claims," narrowly drafted to cover the challengers' products, with no apparent limit or control by the USPTO. Happily, the tactic is no longer available, at least not in an IPR; the PTAB has erected a set of truly daunting hurdles the patent owner must overcome to save unpatentable claims through amendment.

First, there are procedural hurdles. The patent owner must initiate a conference with the PTAB to discuss the proposed motion to amend the claims, and it must occur very soon after the IPR trial is instituted. In contrast to, for example, opposition proceedings in some European tribunals where the judges encourage or invite rewriting of claims during the final hearing, the patent owner's motion to amend the claims is due along with the response to the decision instituting the trial. It is not possible to "see how it goes" and then amend only later when it goes "not so well." Forgoing an early motion to amend is a serious gamble for the patent owner.

The required conference is no mere formality. The Board will explore with the patent owner the proposed claim amendments and support therefor. Specifics are required, although not in the same level of detail as is required in the ensuing motion. As for the motion itself, it is substantively demanding. Not only must the patent owner explain how the amendment overcomes a ground of patentability involved in the trial, but the motion also must explain how the amended claim is patentable *over all other prior art known to the patent owner in any context*, whether cited by the IPR petitioner or not. This requires the patent owner to imagine additional possible grounds of unpatentability previously raised by no one and then overcome them. According to a number of interim decisions of the PTAB to date, doing so requires evidence of the state of the art, the level of ordinary skill in the art, and knowledge in the art about any features sought to be added to the claims by the amendment, as well as how the proposed added claim limitations should be construed. All of this must be done within the fifteen pages allowed for the motion, including a claim listing in the body of the motion, and the PTAB has steadfastly refused to grant extra pages.

Similarly strict rules prevent patent owners from adding entirely new sets of claims that, despite not being "broadened," are still problematic for accused infringer/challengers when the new claims recite trivial features that are nonetheless absent from the specific prior art references involved in the proceeding. The patent owner estoppel rule prevents the patent owner from doing so in other USPTO contexts once the final written decision is issued, at least in theory. One wonders whether *inter partes* reexamination would have been more useful and attractive to challengers had this important feature of IPR existed previously.

5. Discovery (less). Discovery in an IPR is sequenced and limited to depositions of affiants or declarants and what is otherwise "necessary in the interests of justice."[18] Discovery motions, demands, subpoenas, and the like are not permitted without PTAB authorization.

The PTAB has taken a very restrictive view of both "necessity" and the "interests of justice." While limited discovery is occasionally permitted into the relationship

between a petitioner and other litigants who have been sued by the patent owner to determine whether the petition is timely, i.e., filed within a year after the petitioner or a real party in interest has been sued for infringement, not much other discovery has been permitted by the PTAB. The overwhelming majority of topics that are fair game for discovery by the plaintiff in court litigation are generally off limits, even including evidence of "secondary considerations" that the patent owner might use to counter an obviousness assertion.

6. Access (more). While the term "*inter partes*" in *inter partes* reexamination suggested that the third-party requester would participate in the proceeding, in practice—both by statute and by rule—the challenger's participation was significantly limited in procedurally and substantively important ways. For example, the "don't speak unless first spoken to" rule prohibited the third-party requester from having any contact with the examiner, ever, except within 30 days after the patent owner filed a paper in response to an action of the examiner. Even then, the requester was required to submit any desired comments concerning the submission by the patent owner *and* whatever USPTO action the patent owner's submission was responding to, in writing. This caused convoluted presentations in which the requester had to simultaneously argue that the examiner was mistaken and that the patent owner's response to the examiner's mistake was itself mistaken. This imbalance of access, and odd timing of submission of information by the challenger, is absent in IPR.

7. Settlement (possible). The ubiquitous availability of settlement is an important feature of American jurisprudence that was notably missing from *inter partes* reexamination. Once initiated, the proceeding could not be stopped, regardless of the wishes of the third-party requester and patent owner. An IPR trial, on the other hand, may be settled and terminated with respect to the petitioner before the PTAB's issuance of a final written decision. Whether the PTAB will terminate the IPR in its entirety, or instead proceed to issue its final written decision in the absence of continued presence of the petitioner, depends on how close it is to issuing the decision. As a general rule, the longer the parties wait to request termination, the more likely the PTAB's issuance of a final written decision becomes. A number of patent owners who assumed that the PTAB would stop the process completely upon settlement of their disputes have learned a hard lesson.

An institution decision determining that some or all of the challenged claims are likely unpatentable on the basis of the petition thus becomes a powerful negotiating tool in any settlement discussion. Because termination of the IPR without issuance of any final written decision avoids all estoppel consequences in both the district courts and in the USPTO, early settlement and termination may be equally important to both petitioner and patent owner, albeit for different reasons.

8. Speed (faster). IPR is much faster than all but the fastest district court litigation. The entire process, start to finish (excluding appeal to the Federal Circuit), takes 18-24 months, maximum, by statute. To date, the PTAB has shown distaste for doing anything, or allowing the patent owner (or petitioner, for that matter) to do anything, that slows the process in any material way. While certain deadlines set forth in the PTAB's standard scheduling order may be extended by private stipulation, others are proving to be essentially unextendible except in rare circumstances.

9. Stay (likely). A major consequence of the relative speed of IPR, as compared to the open-ended time for completion of *inter partes* reexamination, is that most district court judges are granting motions to stay infringement litigation in view of instituted IPR proceedings. While a good number of courts have granted motions to stay simply upon the filing of a petition for IPR, a significant number of judges are delaying decisions on motions to stay until after the PTAB decides whether to institute the IPR trial in response to the petition, thus resulting in as much as six months of additional district court litigation before the motion is decided. Thus, the sooner the petition is filed, the better off the defendant/IPR petitioner will fare on its motion to stay.

A motion to stay following the filing of a petition for IPR is rapidly becoming standard operating procedure for defendants when litigation is commenced. As of early January 2014, LEXIS® research indicated that there had already been 74 decisions issued on motions to stay pending IPR, a number that must be viewed as significant when the timelines of litigation cases are considered alongside the roughly 16 months that IPR had been available at that time. It is virtually certain that the percentage of new infringement actions in which a motion to stay pending IPR has been filed is rapidly climbing.

10. Cost (lower). IPR costs less than district court litigation for a variety of reasons. First, the PTAB made it clear early on that litigation-style discovery has no place in the proceeding, regardless of the use of the word "discovery" in the enabling statute or rules. Second, while the entire proceeding is called a "trial," in fact nothing happens that even remotely resembles what patent trial lawyers would call a trial. The final hearing is essentially an oral argument of counsel; exhibits, even purely demonstrative ones, generally are not permitted unless they have been filed and used or relied upon at earlier in the proceeding. Third, the process moves quickly, and since "time is money," less time means less money. Fourth, patentability is the only issue, meaning no money is spent on any other issues. All of this is good news for patent challengers.

V. IPR Is Not Being Used Equally for All Technologies

PTAB statistics indicate that about 71 percent of petitions for IPR and Covered Business Method Review (CBMR) have been for patents in the "electrical/computer" technologies, and about 15 percent of all petitions are for IPR of patents in the mechanical arts (which are necessarily IPR petitions because such patents are not eligible for CBMR). While more granular data breaking down IPR petitions by technology are not easily generated, an Alston & Bird Intellectual Property Advisory in September 2013 stated that "software, e-commerce and electrical fields" made up about 71 percent of the IPR petitions filed in the first year of the procedure's availability. A cursory review of the identities of the petitioners and patent owners involved in the IPR petitions filed since then suggests that the trend continues, with only about 15 percent of the IPR petitions relating to chemical, biotech and pharmaceutical, and design patents, combined. There are a number of possible reasons for this disparity, especially various effects of The Drug Price Competition and Patent Term Restoration Act, i.e., the Hatch-Waxman Act, in the case of pharma patents. These possible reasons, including the interplay between the litigation timing provisions of the Hatch-Waxman Act and the timetable of IPR, are beyond the scope of this article.

VI. Conclusion

All of the procedural and substantive advantages tipping in favor of the patent challenger combine to create odds of successfully invalidating a patent in IPR proceedings that are necessarily better, often by a considerable margin, than those of invalidating a patent in district court litigation—and faster and cheaper, too. In other words, if one cannot successfully challenge a patent in IPR before a 3-member panel of highly qualified PTAB administrative patent judges, then it is highly unlikely that one will successfully do so in court before a jury.

For all of the foregoing reasons, it appears that IPR is becoming standard operating procedure for defendants and others accused of infringing U.S. patents, at least generally speaking. Despite the uneven use in different technology sectors, for validity challenges in at least the mechanical and electrical arts, the question is not "Why file a petition for IPR?" but rather "Why NOT file one?"

Endnotes

1. 35 U.S.C. §§ 311 et seq.
2. Many more petitions have been filed, but the PTAB statistics include only those petitions meeting the strict procedural requirements and which were thus actually accorded filing dates. For this reason, examination of the actual case data (at (www.ptabtrials.uspto.gov)) reveals gaps in sequentially assigned proceeding numbers.
3. *Inter Partes* Reexamination Control No. 95/002,419, filed September 15, 2012, is believed to be the last of such proceedings.
4. http://www.pwc.com/us/en/forensic-services/publications/2013-patent-litigation-study.jhtml.
5. 35 U.S.C. § 311(b).
6. 35 U.S.C. § 311(a).
7. 35 U.S.C. § 315(b).
8. 35 U.S.C. § 315(a)(1).
9. The PTAB "umbrella rules" covering IPR and other post-issuance validity challenge procedures are found at 37 C.F.R. §§ 42.1–42.80 and in the Office Patent Trial Practice Guide, 77 Fed. Reg. No. 157, Part V (Aug. 14, 2012). The PTAB trial rules specific to IPR are found at 37 C.F.R. §§ 42.100–42.123. All of these rules may be found on the USPTO's website.
10. 35 U.S.C. § 319.
11. 35 U.S.C. § 314(a).
12. 35 U.S.C. § 318(a).
13. 35 U.S.C. § 317.
14. 35 U.S.C. § 315(e).
15. 37 C.F.R. § 42.73(d)(3).
16. 35 U.S.C. § 316(e).
17. 35 U.S.C. § 316(d)(1)(B).
18. 35 U.S.C. § 316(a)(5).

Peter Schechter is a partner with Osha Liang LLP in New York.

This article is based on a paper and presentation delivered at the Section's 2014 Annual Meeting.

The Role of Market Exclusivity in Repurposing Drugs in the United States

By Sharon Reiche

I. Introduction

Broadly defined, drug repurposing—also known as drug repositioning or re-profiling—refers to the study of small molecules and biologics (a biologic is a medicinal preparation created by a biological process) approved to treat a disease or condition to determine whether they are safe and effective for treating other diseases or to the application of compounds discontinued during drug development for use in new indications.[1] Since many compounds have already been tested, information on their pharmacology, dosing, formulation, and potential toxicity may be available. Accordingly, a repurposed compound provides the opportunity for a shortened clinical program, which may result in the quicker filing of a new drug application (NDA) or biologic licensing application (BLA) for review by the Food and Drug Administration (FDA)—which, if approved, ultimately benefits society.

Due to advances in scientific understanding of diseases, many biopharmaceutical companies use drug repurposing as a drug development strategy to bring new treatments to patients and to recover some of their investment in prior drug discovery programs.[2] For companies, drug repurposing can provide a marketable drug product at a reduced cost, risk, and development time.[3] It also can attract venture capital and other investment, since some of the development risk has already been mitigated, e.g., a compound already has an acceptable safety profile. Repurposing programs are especially attractive to the rare-disease community, since it allows orphan drug development to take advantage of preexisting human-safety data sets, which can be difficult to generate *de novo* when the number of patients with the target disease is limited. For example, studies currently are under way to determine the safety and efficacy of nitisinone (which is used to treat hereditary tyrosinaemia type 1 (HT1)[4]) in patients with alkaptonuria (AKU).[5]

The decision to invest in a repurposed drug will depend in large part on having a period of market exclusivity in which to recover the investment through intellectual property (IP) protection and/or regulatory exclusivity. Obtaining patent protection for a unique aspect of a repurposed drug (e.g., dosage regimen, approved indication, etc.) can result in a significant return on investment. However, because the compound usually is not new, prior art might exist that can result in limited patent opportunities. In addition, third-party patents may exist that could hinder commercialization of the repurposed drug. When evaluating a drug for repurposing projects, the availability of patent and regulatory exclusivity must be weighed against the ease with which a competitor can enter the market.

II. Market Exclusivity in the United States

IP protection is critical to fostering innovation, as it enables rightsholders to exercise ownership rights over their products or inventions and recoup a return on their investment. Such protection includes patents for inventions, trademarks for brand identity, trade dress for product appearance, and copyright for original expression. In return for the protection granted to rightsholders, IP laws benefit society by promoting economic growth and job creation, stimulating the development and commercialization of goods and services, and increasing society's access to technical and scientific knowledge.

In the United States, patents have a 20-year term from the date the patent application is filed,[6] although additional time may be added to the patent term (no more than five years) to compensate for delays in being able to exploit the patent due to the required clinical trials and regulatory review and approval process.[7] In the biopharmaceutical industry, the strongest product protection comes in the form of a composition of matter (COM) patent, and the strongest COM patents normally cover the active pharmaceutical ingredient (API). However, many COM inventions and patent filings for the API and original formulations occur early in the development cycle of a drug. Accordingly, by the time the compound is considered for repurposing, the amount of patent life (i.e., market exclusivity for the product) left for the API can be short-lived or even may have expired, although there still may be opportunities for secondary patenting, including protecting unique aspects and different forms of the API such as polymorphs (different crystal forms of the API), API formulations, or combinations of different drug APIs. The effectiveness of these secondary patents will depend on whether they provide market exclusivity to prevent a generic company from introducing a generic drug for the approved indication(s). Method of use (MOU) patents, which may not be as effective in providing market exclusivity as COM patents, cover the use of a drug for a specific indication.[8]

Patent protection will likely be the best approach to protecting a repurposed drug, although regulatory exclusivity is normally considered as well when deciding whether to invest in a drug repurposing program (especially where patent protection is not available or is of limited duration). For example, if a small molecule product contains an API that has not received prior FDA approval

for sale in the United States, it will receive new chemical entity (NCE) exclusivity. This exclusivity will prevent another applicant from obtaining FDA approval based on the innovator's safety and efficacy data for a period of five years[9] (although applicants are free to submit independent safety and efficacy data). New use/formulation exclusivity is similar to NCE exclusivity, but the exclusivity period is only three years.[10] This type of exclusivity would apply to a repurposed drug that has undergone a significant change—e.g., addition of a new indication, delivery method, dosage strength, or form—but does not include a new API. In the United States orphan drug exclusivity provides seven years of drug exclusivity,[11] and pediatric exclusivity offers an additional six months of exclusivity beyond any existing exclusivity for the drug.[12] For biologics the FDA may not approve a biosimilar application until twelve years after the grant of the original biologic license.[13]

Appropriate incentives are necessary to attract the biopharmaceutical industry's interest in repurposing projects, and it may be difficult to engender such interest when the commercial market is small or the patent life on the drug is short or expired and thus fails to provide an adequate return on investment. In addition, once the idea for a drug has been disclosed to the public or becomes obvious, the drug is no longer patentable, and organizations may be reluctant to invest in research and development in the absence of IP protection. To incentivize entities to undertake the substantial investments of time and money required to bring a drug to market, changes to enhance the patent and/or regulatory system should be considered. If appropriate market exclusivities are not available for repurposed drugs, patients may lose the benefit of ideas that can cure or alleviate illness.

III. Changes to the Patent and Regulatory System

One possible way to incentivize research and development in repurposing drugs is to extend the length of a patent. Currently, there is a uniform period of protection for all industries—20 years—no matter how long it takes to introduce a product to the market.[14] In the technology industry, the time required to develop and commercialize a product is much shorter than it is in the biopharmaceutical industry. Developing an innovative new drug takes approximately twelve years,[15] and bringing a new molecular entity (NME) to market costs an average of $1.8 billion.[16] However, because proposing a patent system where patent terms vary by industry is likely to be met with significant opposition, other solutions need to be considered. Benjamin Roin, a law professor at Harvard University, argues that changes to the standards for assessing novelty and non-obvious of inventions or changes to the regulatory system could prove effective in encouraging the development of "unpatentable" drugs—and his arguments could in theory be applied to repurposed drugs. Although Professor Roin's suggested changes to the patentability criteria for pharmaceuticals are not advocated here, and by his own admission some of his proposals may even be unconstitutional, I discuss them briefly.[17]

The novelty requirement means that a drug cannot be patented if the idea for it was previously disclosed to the public,[18] and courts may invalidate drug patents based on minor disclosures—often made before the value of the drug was realized. Professor Roin argues that Congress could carve out an exception that allows researchers to patent drugs that have not been developed and are not protected by a valid patent or pending application.[19] He also proposes changing the law to make it more difficult for drugs to fall into the public domain.[20]

The non-obvious requirement means that a drug is unpatentable if its relevant properties were reasonably expected at the time of its invention, regardless of whether it has been proven safe and effective in clinical trials.[21] The purpose of this requirement is to prevent trivial inventions from being patented. In effect, however, it may deny patent protection to drugs that seem most promising in early research. Professor Roin suggests that Congress could tie the non-obviousness standards for pharmaceutical patents to the FDA's regulatory requirements such that a drug is not obvious if it must complete clinical trials to satisfy FDA safety and efficacy standards before the public can benefit from its use.[22]

An alternative solution that might be more palatable to various stakeholders would be to have regulatory agencies grant extended exclusivity that would allow companies time to recover research and development costs. That is, the FDA could be required to withhold regulatory approval from generic manufacturers for a time period similar to the period of market exclusivity provided by pharmaceutical patents—on average 11.5 years.[23] Since the FDA already imposes brief delays on generic manufacturers until various exclusivities expire, Congress could implement this proposal with only minor adjustments to the law. Further, the FDA could link the length of exclusivity to the burden of satisfying its own requirements—longer and more expensive clinical trials would require more protection than shorter, cheaper ones.[24]

The idea of encouraging development through regulatory channels is in fact already under consideration through the Modernizing Our Drug and Diagnostics Evaluation and Regulatory Network Cures Act (MODDERN Cures Act), which was originally introduced in 2011[25] and reintroduced in 2013.[26] The Act is intended to promote the development of meaningful treatments for patients; if passed, it would define a new class of drug called "dormant therapies"—i.e., a new drug being investigated to address one or more unmet medical needs—

and would provide additional years of marketing exclusivity to encourage the development of these therapies.[27]

IV. Current Programs

Current market conditions are leading many innovative biopharmaceutical companies and researchers to seek new and innovative partnerships to accelerate the time it takes to bring new treatments to patients.[28] As mentioned previously, repurposing programs have been identified as one such solution. I highlight two current platforms below.

In May 2012, the National Institutes of Health (NIH) launched a collaborative program that matches NIH-funded researchers with compounds from biopharmaceutical companies to explore potential new treatments for patients.[29] Administered by the National Center for Advancing Translational Sciences (NCATS), the Discovering New Therapeutic Uses for Existing Molecules program aims to spur the drug development process by finding new uses for compounds that have previously cleared key stages in the development process. Modeled in part on a 2010 program implemented by Washington University and Pfizer Inc.,[30] the NCATS initiative is a collaborative pilot program designed to develop partnerships between individual pharmaceutical companies and academic medical centers to advance therapeutics development. In June 2013, NIH awarded $12.7 million to nine academic research groups to explore new treatments for patients in various disease areas, including Alzheimer's disease, peripheral artery disease, and schizophrenia.[31]

Another creative platform, known as WIPO Re:Search, was launched in 2011 and provides researchers the opportunity to access biopharmaceutical companies assets and knowledge.[32] The World Intellectual Property Organization (WIPO), along with BIO Ventures for Global Health (BVGH), the private sector and research organizations, launched this consortium to provide, among other functions, a database of available IP assets and knowledge to advance research and development in neglected tropical diseases (NTDs), as well as malaria and tuberculosis (TB). With over eighty members worldwide and forty-six agreements in place, this initiative facilitates partnerships and provides researchers the opportunity to screen available compounds and associated knowledge for NTDs, even though many originally were intended for diseases other than NTDs, TB, and malaria.

V. Conclusion

Disease rates are accelerating globally and impacting every socioeconomic class in every region of the world. According to the World Health Organization, noncommunicable diseases (NCDs), such as heart disease, cancer, and diabetes, are the leading cause of mortality in the world.[33] Neglected diseases, including malaria and tuberculosis, are estimated to affect the lives of more than one billion people, many of whom live in the world's least developed countries.[34] Biopharmaceutical companies, research organizations, government agencies, patient advocacy groups, and many other stakeholders all share a similar goal: improving the lives of patients worldwide affected by disease. By providing incentives for biopharmaceutical companies and research organizations to engage in repurposing programs, many patients suffering from disease may find new hope for a cure.

Endnotes

1. The National Institutes of Health (NIH) has defined "repurposing" more narrowly and use the term to refer to the study of small molecules and biologics approved to treat a disease or condition to see if they are safe and effective for treating other diseases. The NIH has sometimes used the term "drug rescue" when referring to research involving small molecules and biologics whose development was stopped before they could be approved by the U.S. Food and Drug Administration. *See* National Institutes of Health, National Center for Advancing Translational Sciences website, "Rescuing and Repurposing Drugs," http://www.ncats.nih.gov (accessed Jan. 2014).
2. For example, Lamotrigine, which originally was developed for treating epilepsy, was repurposed and is approved by the FDA for treating bipolar disorder. For additional examples, s*ee* E.L. Tobinick, "The Value of Drug Repositioning in the Current Pharmaceutical Market," Drug News and Perspectives, Mar. 2009, 22(2):119-25.
3. *See* Tobinick, *supra* note 2, 119-25.
4. Hereditary tyrosinaemia type 1 (HT-1) is a rare disorder. Patients have a high lifetime risk of developing hepatocellular carcinoma (HCC).
5. Alkaptonuria (AKU), also known as Black Bone Disease, is a genetic disease which damages the bones and cartilage, causes severe pain and leads to health problems such as osteoarthritis, heart disease and kidney infections. Information on the possible treatment of AKU with nitisinone can be found at the DevelopAKUre website, http://www.developakure.eu (accessed Jan. 2014).
6. *See* 35 U.S.C. § 154(a)(2).
7. *See* 35 U.S.C. § 156.
8. For further discussion, *see* Richard Smith, "Repositioned Drugs: Integrating Intellectual Property and Regulatory Strategies," Drug Discovery Today: Therapeutic Strategies. Vol. 8, Issues 3-4, Winter 2011, pp.131-37.
9. *See* 21 U.S.C. § 355.
10. *Id.*
11. *See* 21 U.S.C. § 360cc.
12. *See* 21 U.S.C. § 355a.
13. *See* 42 U.S.C. § 262.
14. *See* 35 U.S.C. § 154(a)(2).
15. *See* Congressional Budget Office, Research and Development in the Pharmaceutical Industry (Oct. 2006).
16. *See* Steven M. Paul, et al., "How to improve R&D productivity: the pharmaceutical industry's grand challenge," Nature Reviews Drug Discovery 9: 203-14 (2010).

17. For a comprehensive discussion of Benjamin Roin's arguments, *see* Benjamin Roin. "Unpatentable Drugs and the Standards of Patentability," 87 Tex. L. Rev. 503 (2009).
18. *See* 35 U.S.C. § 102 for statutory definition.
19. *See* Roin, *supra* note 17, at 558.
20. *See id.* at 560.
21. *See* 35 U.S.C. § 103 for statutory definition.
22. *See* Roin, *supra* note 17, at 558.
23. "It takes 10-15 years on average to develop a new medicine from the earliest stages of compound discovery through FDA approval. As a result, significant portions of the patent term for a new drug are lost before a product enters the market. In fact, the average effective patent life for medicines is 11.5 years." The Value of Pharmaceutical Patents & Strong Intellectual Property Protection, http://www.innovation.org (accessed Feb. 2014).
24. *See* Roin, *supra* note 17, at 568.
25. *See* MODDERN Cures Act of 2011, H.R. 3497 (112th Cong.) (Nov. 18, 2011).
26. *See* MODDERN Cures Act of 2013, H.R. 3091 (113th Cong.) (Sept. 12, 2013).
27. *Id.*
28. For further discussion, *see* S. M. Paul & F. Lewis-Hall, "Drugs in Search of Diseases," Sci. Transl. Med. 5, 186fs18 (2013).
29. *See* National Institutes of Health, National Center for Advancing Translational Sciences website, "Discovering New Therapeutic Uses for Existing Molecules," http://www.ncats.nih.gov (accessed Jan. 2014).
30. For more information, *see* Caroline Arbanas, "Washington University, Pfizer announce groundbreaking research collaboration" (May 17, 2010), http://news.wustl.edu (accessed Jan. 2014).
31. *See* National Institutes of Health, National Center for Advancing Translational Sciences website, "Discovering New Therapeutic Uses for Existing Molecules," http://www.ncats.nih.gov (accessed Jan. 2014).
32. *See* WIPO Re:Search website, http://www.wiporesearch.org (accessed Jan. 2014).
33. *See* World Health Organization website, "Health Topics: Chronic Diseases," http://www.who.int (accessed Jan. 2014).
34. *See* World Health Organization website, "Neglected Tropical Diseases," http://www.who.int (accessed Jan. 2014).

Sharon Reiche is Corporate Counsel, Intellectual Property Policy, at Pfizer Inc. The views expressed are those of the author and do not reflect the official policy or position of Pfizer Inc. **The author would like to acknowledge and thank Adrian Looney, Lydia Pan, and Michael Warner for their feedback and guidance during the preparation of this article.**

3D Printing: A Copyright Law Overview

By Michael Weinberg

I. Introduction[1]

3D printing provides an opportunity to change the way we think about the world around us.[2] It merges the physical and the digital. People on opposite sides of the globe can collaborate on designing an object and print out identical prototypes every step of the way. Instead of purchasing one of a million identical objects built in a faraway factory, users can customize pre-designed objects and print them out at home. Just as computers have allowed us to become makers of movies, writers of articles, and creators of music, 3D printers allow everyone to become creators of things.

3D printing also provides an opportunity to reexamine the way we think about intellectual property. The direct connection many non-IP lawyers make between "digital" and "copyright" is largely the result of a historical accident: The kinds of things that were easiest to create and distribute with computers—movies, music, articles, photos—also happened to be the types of things that were protected by copyright. It also happened that the way computers distribute things—by copying—was the conduct copyright regulated. As a result, copyright law became an easy way to (at least attempt to) control what people were doing with computers.

The connection between "copyright" and "digital" begins to break down as one moves away from movies, music, articles, and photos toward gears, cases, robots, and helicopters. As the connection frays, it serves as a reminder that not everything—not even every digital thing—is protected by copyright. In fact, most (but by no means all) physical objects are not protected by any type of intellectual property right. That means that anyone is free to copy, improve, distribute, or incorporate these objects as he or she sees fit.

This freedom is not a new development, nor is it a loophole. 3D printers do not take intellectual property rights away any more than computers grant them. But they do provide an opportunity to reexamine old assumptions about how copyright law works.

Of course, just because an object is not protected by copyright does not mean it is not protected by patent or trademark. (Readers interested in a broader discussion of the intersection of intellectual property and 3D printing (and an examination of how policy may evolve to accommodate the latter within the former) may be interested in Public Knowledge's White Paper *It Will Be Awesome if They Don't Screw it Up: 3D Printing, Intellectual Property, and the Fight Over the Next Great Disruptive Technology*.[3]) In fact, many objects are not protected by copyright precisely because they are the type of useful object that is (or can be) protected by patent.[4] That being said, copyright looms large over our digital lives.

II. Copyrightability and 3D Printing

Sometimes the intersection of 3D printing and copyright is straightforward. Purely artistic objects will be protected by copyright as sculptural works. This category includes things like 3D models of characters from movies, video games, and comics. This does not mean that every reproduction of these objects will be infringement,[5] but many will be. However, the intersection of 3D printing and copyright often is not clean, and the situation tends to get complicated quickly. As discussed below, there are at least three major areas where bright-line rules are still developing.

A. Kind of Creative, Kind of Useful: Severability

The ends of the copyright/patent spectrum are fairly easy to describe. Abstract sculpture? Protected by copyright. Breakthrough new hinge? Protected by patent.

But what about things in the middle? What about things that are kind of artistic and kind of useful? More specifically, what about things that have some artistic features and some useful features? Can they be protected by copyright?

The law addresses these questions with a seemingly simple concept called severability. If an object has both artistic and useful features, copyright does not protect the entire object. Rather, protection is limited to any artistic features that can stand alone. It protects such features by "severing" them from the rest of the object. If the artistic and functional features cannot be separated, the law errs on the side of keeping useful objects available to everyone and excludes the entire object from copyright protection.

This rule of law reflects a conscious decision by Congress. In a report accompanying the 1976 Copyright Act, Congress explained that it did not intend copyright to protect industrial products that happen to have "aesthetically satisfying and valuable" shapes.[6] Instead, only "physically or conceptually" severable elements could be protected.[7] For example, if a chair has a carving on the back, the carving can be protected, but the chair itself is not copyrightable.[8] This is because the carving can stand alone as a viable artistic creation apart from the chair.

Actually applying severability has proven challenging. Only a few cases involve elements that can be physically separated from each other in any meaningful way. More often, courts must try to identify "conceptually" separable elements, which is almost never easy.

To complicate things further, courts have not reached a consensus on how to think about conceptual severability.[9] The circuits have developed a variety of tests that have evolved over time. Although this diversity of approaches can be frustrating, reviewing them provides insight into how courts frame the inquiry. The remainder of this section describes the most important cases dealing with conceptual separability and the rules they have articulated.

The fact pattern in all of these cases is essentially the same: A person (or company) creates and successfully markets an object. Another company makes, and starts to sell, an exact copy of it. The first company sues the second company for copyright infringement. The second company claims the object is not copyrightable. Then it is up to the court to decide.

1. A Fancy Belt Buckle

The first case concerned a fancy belt buckle.[10] On one hand, a belt buckle is a useful object—it holds the ends of your belt together and prevents your pants from falling down. On the other hand, this was an artistically designed belt buckle that went well beyond what was needed to hold the belt together and the pants up. Could those fancy elements be severed from the utilitarian ones?

The court did not want to give the original manufacturer a copyright on belt buckles, which would have resulted in a monopoly on a useful object. But there arguably were severable artistic elements of the buckle. Ultimately, the court held that the buckle had "conceptually separable sculptural elements" and granted those elements—and only those elements—copyright protection.[11] The court reached this conclusion by looking at which elements of the buckle were primary and which were secondary. It found that the sculptural/ornamental elements were primary and the utilitarian functions secondary.[12] To do so, it relied on expert testimony that the buckle was creative art as well as on the fact that people had used the buckles as nonfunctional decoration on other parts of their bodies.[13] This use of the buckle in ways unrelated to its utilitarian function presumably reflected its independent aesthetic value.

Severability rule: Determine if artistic elements play a primary or secondary role in the object.

2. A Sculpted Mannequin

The second case dealt with four department store mannequins—two male and two female torsos without necks, arms, or backs.[14] One pair was shaped with bare torsos, and one was shaped with torsos wearing a shirt. They were designed this way to display various shirts and jackets to customers.

The court pointed out that "works of applied art or industrial design which have aesthetic or artistic features" are not copyrightable merely because they are "aesthetically satisfying and valuable."[15] Instead, they must have elements that are separable from the underlying industrial purpose to be copyrighable.

The fact that the mannequins were originally sculpted of clay—a technique associated with sculptural art—also did not make the mannequins copyrightable. Just because the mannequins could be *classified* as sculpture did not mean they were *protected* as sculpture.[16]

In the end, the court did not find any conceptually separable elements because any ornamentation on the mannequin was driven largely by the utilitarian purpose of displaying clothing. There was no way to imagine artistic features that were added to the complete utilitarian object. Accordingly, the defendant was free to copy the mannequin.

Severability rule: See if any potentially severable elements were driven by utilitarian needs.

3. A Bike Rack

The next case involved a bike rack you may see every day.[17] The RIBBON rack is a bike rack made of tube bent into a wavy line. It was based on a wire sculpture that was unquestionably copyrightable. However, the conversion from wire sculpture to tube bike rack required significant alteration.

Although the design is aesthetically pleasing, the court held that it was the product of an industrial design process and was not copyrightable. Even well-executed industrial design, the court concluded, remained industrial design and thus beyond the scope of copyright.[18] The court attempted to spell out a test for determining conceptual separability:[19]

> If design elements reflect a merger of aesthetic and functional considerations, the artistic aspects of a work cannot be said to be conceptually separable from the utilitarian elements. Conversely, where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences, conceptual separability exists.[20]

What does this mean? Simply being a creative designer of a useful object is not enough. If you are concerned primarily with the functionality of the object, it will be deemed a useful object. However, if there are elements designed largely without regard for functionality, they may be independently copyrightable. Although not every circuit has adopted this test, at least it provides some guidance as to how to think about the elusive concept of severability.

Severability rule: See if there are creative elements that were designed without regard for functional requirements.

4. A Beauty School Head

The final case involves a mannequin head sold to beauty schools and used to teach hair styling.[21] The head was designed to imitate what the court described as "the 'hungry look' of high-fashion, runway models."[22] The head was sold under various names with various types of hair and skin color combinations.The court assumed it was a useful article because it was a teaching aid. The real question was whether parts of the head could be protected by copyright.[23]

The court largely adopted the test from the bike rack case,[24] but it restated the test in somewhat more comprehensible language:

> If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is as much the result of utilitarian pressures as aesthetic choices the useful and aesthetic elements are not conceptually separable.[25]

In applying this rule, the court found the face of the head copyrightable. First, it found there were many ways to create a face for a mannequin, which reduced concern about granting the owner any sort of critical monopoly.[26] Second, it looked back to the original design process. The company had hired an independent artist to develop the face, but it had not given the artist any specific dimensions or any other technical requirements. That suggested that the design of the face was not particularly constrained by industrial design requirements.

Severability rule: Determine whether independent artistic judgment drove the creation of the nonfunctional elements.

5. Where Are We Now?

There is at present no single test for severability. One court identified at least six versions of the test, although it did identify the beauty school head test as the most persuasive.[27] Severability remains a highly fact-specific inquiry. While some cases are straightforward, others will depend on the circuit, judge, and even the lawyering. Frustrating as this may be, there are some important takeaways regarding severability. First, severability is a reminder that useful objects—particularly those that are the product of industrial design—fall largely outside the scope of copyright.

Second, severability reduces the pressure to classify an object as either useful or artistic and, by extension, protected or not protected by copyright. With severability, an object need not be one or the other. Parts may be copyrightable, while others may not be.

Third, severability is an area to watch as litigation involving 3D printing increases. Decisions by courts in relatively obscure cases can fundamentally change what is and is not protected by copyright. Even small shifts in the line between severable and not severable, and therefore between copyrightable and not copyrightable, could have huge ripple effects.

Although the courts have yet to settle on a clear, universal severability rule, the best rule of thumb is probably the one expressed in the beauty school head case: If the elements of the design are non-functional and were developed without regard to utilitarian considerations, they are copyrightable. However, if the design of elements was largely influenced by the practicalities of making and using the object, they are unlikely to be copyrightable.

B. Copyright on a File, Copyright on an Object

Physical objects can exist in digital form. For 3D printing, this digital form is often that of an .stl file.[28] These files can be thought of as the object equivalent of a .pdf file—they are more or less universally printable by 3D printers and allow objects to be transferred digitally around the world.[29] But are these files protected by copyright? If they are, what does that mean?

.stl files are *potentially* protectable by copyright. The Copyright Act lists "maps, globes, charts, diagrams, models, and technical drawings, including architectural plans" as types of works eligible for protection.[30] But that does not necessarily mean every design file for a physical object is actually copyrightable. For instance, if a particular diagram were the only practical way to virtually represent a physical object, a copyright on the diagram would prevent anyone from making virtual versions of the object. This would give the copyright owner considerable control over the distribution and manufacture of the object. To avoid this, copyright law protects the design of a useful article "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article."[31] In other words, designs are protected by copyright only to the extent they go beyond the utilitarian requirements of a useful article.

In practice drawing this line can be complicated. This is especially true in situations, like those described earlier, where an object combines useful and artistic elements. Although the details can become complex, the analysis is guided by a simple principle: Protect qualifying works without inadvertently using 3D printing and digital designs to expand the scope of copyright.

1. Useful Objects

Purely useful objects, like screws, are not copyrightable. They may be patentable, but generally speaking the

existence of a digital file should not be used to claw useful objects out of the public domain.

There are at least two ways to create digital design files for useful objects. One is to scan an existing object. Another is to design the useful object in a virtual universe with a computer-aided design (CAD) program. How the file was created may very well impact its copyright status.

a. Scanning a useful object

Incredibly precise laser scanners can create highly accurate virtual models of physical objects.[32] Among other things, they allow people to turn existing physical objects into portable—and alterable—digital files. Although there is a limited amount of case law on the question, it appears that such scans are not independently copyrightable because they are not sufficiently "original" to be copyrightable.[33] There is no question that 3D scanning is labor-intensive and complicated, but this does not by itself warrant copyright protection.[34] Good 3D scans create exact replicas of physical objects, not creative interpretations of them. As a result, there does not appear to be an independent copyright in the file containing a 3D scan of a useful object (which also is not copyrightable). This means that anyone is free to reproduce, change, or use a digital file of a physical object created by scanning the object.

b. Creating a useful object in CAD

Instead of being transferred from the physical world to the digital world via a scanner, useful objects created in CAD software exist first in digital form. Again, the useful object itself (as it would exist physically) is not copyrightable. Even if the design file were copyrightable, creating a physical version would not infringe the copyright in the file; copyright in the design of a useful object does not protect the object itself.[35]

As noted earlier, diagrams and technical drawings are copyrightable to the extent creative elements exist independent of the utility of the diagram. In order to determine the copyrightability of a design file, a court may do a severability analysis. The analysis would not focus on the object itself but rather on the contents of the design file. Purely artistic elements of the file, such as photographs in the background or shading and coloring, could potentially be severed from more utilitarian elements that describe shapes, sizes, and relationships. This analysis would help establish the existence of independent artistic elements that may be protectable.[36]

It can be hard to predict the outcome of a severability analysis, but many 3D design files that simply represent an object lack severable creative elements. CAD environments give designers a standard way to show sizes, shapes, and relationships. If there is only one way to represent a given useful object in a CAD program, it is unlikely a court would find the design file copyrightable, which would prevent anyone else from representing that useful object digitally.

No matter how a court decides to treat the file, it would not affect production of the useful object represented by the file.[37] It has been held that copying a file of a useful object protected by copyright in order to create the useful object is not copyright infringement.[38]

2. Creative Objects

The copyright issues surrounding creative objects are much more straightforward; there is no concern that granting copyright protection to a design file will expand the scope of copyright because the object itself is already copyrightable. But it is worth considering who owns which parts of this puzzle.

a. Scanning a creative object

As with scans of useful objects, scans of creative objects do not create a new copyright.[39] However, unlike scans of useful objects, scans of creative objects are reproductions of works protected by copyright, which has two ramifications. First, anyone scanning a creative object needs the permission of the rightsholder of the object. The scanner is not creating a copyrightable work, but she is reproducing a copyrightable object. Second, because the file is a copy of a copyrightable creative work, copying and/or distributing the file therefore requires permission from the owner of the copyright in the original object.

b. Creating a creative object in CAD

When a creative object is created in a CAD program, the file is copyrightable. Copying and/or distributing the object requires permission, as does creating the creative object in physical form because the object is a copy or derivative work of the CAD design. Unlike the case of useful objects, copying the physical version of a creative object designed in CAD also infringes the copyright in the CAD design.

III. Does Licensing Matter?

One way to avoid some of these thorny copyright issues is by distributing objects and designs subject to permissive licenses such as those provided by Creative Commons. Unfortunately, this can break down when applied to physical objects, many of which are not copyrightable.

A. Licensing Uncopyrightable Objects

Licensing of uncopyrightable files can serve at least two useful purposes, one legal and one cultural. The legal purpose is something of a hedge against future legal change. As discussed above, there are many open questions surrounding just what types (and parts) of objects are copyrightable. Granting a license clarifies the usage conditions without regard to copyright law. As long as the creator does not believe granting the license gives him the right to control uncopyrightable parts of the work,

there is little downside to future-proofing the status of the object.

The second, cultural purpose is probably more important. Licensing can be an important signaling device even when not legally enforceable. Attaching a Creative Commons license is a signal that the creator wants to include her work in an ever-expanding and evolving network of creativity. It gives the rest of the community confidence that they can build on the object.

There are already strong examples of this type of community understanding bearing fruit in the world of 3D printing. Thingiverse, a website dedicated to sharing 3D design files, is centered on the notion of sharing one's own work and building on the work of others. Every object on Thingiverse lists information about what it is derived from and what has been derived from it. This has created a rich ecosystem of creation, design, and innovation. There are, however, potential downsides to licensing objects not protected by copyright. These are especially clear when you move away from permissive licenses towards more restrictive licenses. Attaching restrictive licenses to objects that are not protected by copyright could discourage lawful uses and allow creators to intimidate others.

When used responsibly and realistically, licensing uncopyrightable objects can be worthwhile, but the enforceability of such licenses must be regarded skeptically.

B. Licensing Design Files

By and large, licensing design files raises the same questions and concerns as licensing the objects themselves. As discussed earlier, not all design files are protected by copyright. For those that are, the owner is free to license as he sees fit. For those not protected by copyright, licensing can serve as a useful social signal to others who might want to use the file.

This signal can be socially productive if a Creative Commons-type license is involved, because it invites people to use what they are already allowed to use. It can be socially counterproductive, however, if a restrictive license prevents people from using an object they have a right to use.

It is unlikely a license for a copyrighted design file could be used to assert copyright-style control of an uncopyrightable object. In cases where the maker of a physical object does not need permission from the creator of the design file, even Creative Commons-style restrictions on a design file could not force a maker of the object to share it.

IV. Conclusion

Many of the questions raised in this article do not have simple answers. That is in large part a function of the way the law tackles new questions. At this point in the history of 3D printing and consumer access to digital manufacturing, many of the most interesting questions are only beginning to surface. Although it is possible to draw guidance and principles by analogy from cases not involving 3D printing, it is too early to state confidently how courts will apply those principles to 3D printing.

The opportunity to create—and the responsibility for creating—reasonable, workable rules for 3D printing lies in three places. The first two are legislatures and the courts. As described in *It Will Be Awesome*, there are many ways 3D printing and digital manufacturing can be handled poorly by both. Legislatures could pass laws against an imagined dystopic future that would probably never arrive, thereby cutting off unanticipated positive developments. Courts may react by expanding intellectual property rights and infringement liability in counterproductive ways.

But both legislatures and courts can take steps to protect innovation. Legislatures can say no when incumbents try to push laws designed to criminalize new technology. And courts can protect legally defensible, but culturally novel, ways of doing business. After all, it was the Supreme Court's refusal to hold the creator of the Betamax liable for copyright infringement that gave us VCRs, DVRs, MP3 players, and more.

The third—and perhaps most important—source of new rules is the public. Community norms matter. This is especially true when it is unclear exactly how traditional intellectual property laws apply—if at all. Developing a means of recognizing and rewarding true innovators without relying on long and costly legal battles is the most effective way to stave off the creep of copyright expansion. If there is a system that already works, people will grasp for novel copyright theories.

Ultimately, the burden is on the public not to blindly assume copyright covers everything. This is not to say that copyright should be disregarded or court rulings ignored. Instead, it is a reminder of the value of healthy skepticism. If someone asserts copyright in an object, be skeptical and publicize infringement claims so the public can be aware of who is claiming rights.

For better or worse, the burden will fall heaviest on sites that host design files and provide a forum for 3D designers to gather, share, and sell their wares. The way they react to takedown notices will heavily influence the willingness of rightsholders to assert dubious claims. While these sites would be prudent to comply with all proper DMCA takedown requests, what they do after taking something down (and how they handle marginal cases) will have a disproportionate impact on how the public thinks about copyright and 3D printing. Until there is greater legal clarity, cultural clarity is the best way to protect the development of 3D printing.

Endnotes

1. This article adapted from the white paper *What's the Deal with Copyright and 3D Printing?*, available at http://www.publicknowledge.org/Copyright-3DPrinting.
2. Although this white paper is expressed in the language of 3D printing, much of it is applicable to an entire host of technologies that can broadly be categorized as "digital manufacturing." These digital manufacturing technologies—which include things like low cost computer aided design (CAD) programs, digital scanners, CNC mills, and laser cutters—bring high precision manufacturing into the hands of individuals and small business owners in a way that may fundamentally change the economics of manufacturing and creation. While 3D printing tends to get the most attention, the real change will come as people become comfortable with all of these technologies.
3. Available here: http://www.publicknowledge.org/it-will-be-awesome-if-they-dont-screw-it-up.
4. Unless otherwise mentioned, for the purposes of this paper discussion of "patents" is limited to traditional utility patents, not design patents. While design patents can protect works that are also protected by copyright, s*ee, e.g.*, *Mazer v. Stein*, 347 U.S. 201, 217 (1954), they are also relatively narrow and easily avoided by manipulating the digital design for a physical object.
5. If it is protected by a limitation and exception to copyright, such as fair use, even literal copying is not an infringement.
6. *See,* H.R.Rep.No. 1476, 94th Cong., 2d Sess. 55 (1976).
7. *Id.*
8. *Id.*
9. The absence of a single rule does not mean that there are no rules. Each circuit has its own rule that is enforced within that circuit. But those rules can change depending on the circuit.
10. *Kieselstein-Cord v. Accessories by Pearl, Inc*., 632 F.2d 989 (2d Cir. 1980).
11. *See id.* at 993.
12. *Id*.
13. *See id.* at 993-994.
14. *Carol Barnhart Inc. v. Econ. Cover Corp*., 773 F.2d 411 (2d Cir. 1985).
15. *Id.* at 418.
16. *See id*.
17. *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co*., 834 F.2d 1142 (2d Cir. 1987).
18. *See id.* at 1147.
19. Actually, the court borrowed a test first proposed by Professor Robert Denicola. *See id.* at 1147-48.
20. *Id.* at 1145.
21. *Pivot Point Int'l, Inc. v. Charlene Prods.*, 372 F.3d 913 (7th Cir. 2004).
22. *Id.* at 915.
23. *See id.* at 920.
24. *See id.* at 927.
25. *Id.* at 931 (internal citations and quotations omitted).
26. *Id.*
27. After which, of course, the court declined to apply that test. *See Galiano v. Harrah's Operating Co*., 416 F.3d 411, 417-18 (5th Cir. 2005).
28. The .stl file is usually the final version of an object, but oftentimes the object is first created in another program with another file extension. For example, the free program SketchUp saves files as a .skp. Free online 3D design programs such as Tinkercad allow you to send designs directly to third-party 3D printing services or download the file as a .stl or .vrml (or two-dimensional .svg). These other types of files can be converted into .stl.
29. Although, like .pdf files, they can be hard to modify once they have been created.
30. 17 U.S.C. § 101.
31. 17 U.S.C. § 101 (emphasis added).
32. While scanning capability has traditionally been limited to purpose-build scanners, that is beginning to change. Microsoft's Kinect accessory has been used for 3D scanning. Other services, such as Autodesk's 123D Catch, can take photos taken by any digital camera and turn them into 3D digital representations suitable for 3D printing.
33. *See Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc*., 528 F.3d 1258 (10th Cir. 2008) (considering a 3D scan of a truck for use in commercials); *Bridgeman Art Library, Ltd. v. Corel Corporation*, 25 F. Supp. 2d 421 (S.D.N.Y. 1987), *modified*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999) (high quality photographs of public domain works are not independently copyrightable). It is worth noting that this lack of originality was originally used to justify excluding photographs from copyright protection. The theory was that photographs merely captured the world as it existed, and therefore were not sufficiently original for protection. In time, courts recognized that most photographs are the result of a number of creative decisions made by the photographer with regard to framing, lighting and arrangement. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884). It is impossible to say if the law will grow to recognize similar artistry in 3D scanning. However, the purely functional application of 3D scanning to capture physical objects for production or replication purposes may reduce the likelihood of this happening. The fact that many 3D scanners explicitly try to reproduce the scanned object as faithfully as possible further undermines claims of originality.
34. This "sweat of the brow" justification for copyright protection was famously rejected in a case where the Supreme Court denied copyright protection for a phone book. *See Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991).
35. *See, e.g., Robert R. Jones Assoc. v. Nino Homes*, 858 F.2d 274 (6th Cir. 1988) (copying a house is permitted even if plans are protected by copyright); *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972) (copying a house is permitted even if plans are protected by copyright); *Victor Stanley, Inc. v. Creative Pipe, Inc*. Case No. MJG-06-2662, 2011 U.S. Dist. LEXIS 112846 (D. Md. 2011) (copying of copyright-protected plans is infringement, using authorized plans to create unauthorized articles is not); *Morgan v. Hawthorne Homes, Inc*., Civil Action No. 04-1809, 2009 U.S. Dist. LEXIS 31456 (W.D. Pa. Apr. 14, 2009) (copyright in design protects design, does not prevent creation of building based on design); *Gusler v. Fischer,* 580 F. Supp. 2d 309 (S.D.N.Y. 2008) (using copies of technical drawings to create article not infringement, creating copies of technical drawings can be infringement); *Niemi v. Am. Axle Mfg. & Holding Co.,* No. 05-74210, 2006 U.S. Dist. LEXIS 50153 (E.D. Mich. 2006) (no copyright violation when defendant made multiple objects after obtaining plans and permission to make only one); *Eliya, Inc. v. Kohl's Dept. Stores*, No. 06 Civ 195 (GEL), 2006 U.S. Dist. LEXIS 66637 (S.D.N.Y. 2006) (copyright in pictorial representation of useful article does not grant rights in article); *National Medical Care Inc. v. Espiritu*, 284 F. Supp. 2d 424 (S.D.W.Va. 2003) (copying structure without copying plans is not infringement).
36. *See, e.g., Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458 (5th Cir. 1990) (map in dispute was the only way to represent a pipeline's location); *Tensor Group Inc. v. Global Web Sys., Inc.,* No. 96 Civ. 4606, 1998 U.S. Dist. LEXIS 19596 (N.D. Ill. 1998) (defendants must show that there is only one way to express the part to be free of copyright liability)*; Guillot-Vogt Assoc., Inc. v. Holly & Smith,* 848 F.Supp. 682 (E.D.La. 1994) (defendant must show that plans are the only meaningful way to depict an article to avoid infringement liability). However, at least one court has held that blueprints themselves are not useful articles and therefore a severability test would be improper. *See Gemel Precision Tool Co. v. Pharma Tool Co.*, 1995 U.S. Dist. LEXIS 2093 (E.D.Pa. 1995).
37. *See* note 35 *supra*.

38. Prior to a law passed to specifically protect buildings, blueprints were protected by copyright but buildings were not. In cases where defendants were accused of copying the blueprints and a building, courts generally found infringement for the blueprint copying but not for the building copying. However, defendants who could show that they did not need to copy the blueprint (if, for example, they had an authorized copy already) in order to copy the building were not held liable. This balancing allowed the copyright for the blueprint to coexist with the lack of copyright protection for the building. Unfortunately, the nature of digital technology—where everything is copied countless times—could make this distinction harder to maintain. Hopefully future courts will recognize the underlying wisdom of preventing a copyright in a design from granting protection for the object depicted in the design, and find a way to advance it even as technology changes. *See, e.g., Forest River, Inc. v. Heartland Rec. Vehicles, LLC*, 753 F. Supp. 2d 753 (N.D.Ind. 2010) (expressing disinclination to recognize a distinction between creating an article with original or duplicated plans); *Gusler v. Fischer*, 580 F. Supp. 2d 309 (S.D.N.Y. 2008) (using copies of technical drawings to create article not infringement, creating copies of technical drawings can be infringement); *Niemi v. Am. Axle Mfg. & Holding Co.*, No. 05-74210, 2006 U.S. Dist. LEXIS 50153 (E.D. Mich. 2006) (no copyright violation when defendant made multiple objects after obtaining plans and permission to make only one); *National Medical Care Inc. v. Espiritu*, 284 F. Supp. 2d 424 (S.D.W.Va. 2003) (copying structure without copying plans is not infringement). *But see Robert R. Jones Assoc. v. Nino Homes*, 858 F.2d 274 (6th Cir. 1988); *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972) (although both cases are pre-Architectural Works Copyright Protection Act and therefore may have limited instructional utility today).

39. *See Bridgeman Art Library, Ltd. v. Corel Corporation*, 25 F. Supp. 2d 421 (S.D.N.Y. 1987), *modified*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

Michael Weinberg is a Vice President at Public Knowledge, a nonprofit digital advocacy group in Washington, DC and the author of "It Will Be Awesome If They Don't Screw It Up: 3D Printing, Intellectual Property, and the Fight Over the Next Great Disruptive Technology" and "What's the Deal with Copyright and 3D Printing?," White Papers that examine the intersection of 3D printing and intellectual property law.

The Problem of Scandalous, Immoral, and Disparaging Trademarks

By David Rodrigues

I. Introduction

Among the grounds for the United States Patent and Trademark Office (PTO) to refuse to register a trademark are those identified in section 2(a) of the Lanham Act, which provides that a trademark may be refused registration if it "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."[1] The Lanham Act also allows for the cancellation of a mark that violates section 2(a).[2]

Section 2(a) is ambiguous and subjective; what may be disparaging to some may be innocuous to others. A good example of this is the ongoing dispute concerning the Washington Redskins trademarks. The term "Redskin" is offensive to many people, including those of Native American descent, but registrations for trademarks comprising the term "Redskin" subsist. This article discusses how the PTO determines whether a mark violates section 2(a), with a particular focus on the cancellation proceeding involving, and continuing public controversy surrounding, the Redskins marks.

II. Section 2(a)

A. Immoral and Scandalous Matter

The terms "immoral" and "scandalous" are not defined in the Lanham Act. The Court of Customs and Patent Appeals has cited a dictionary definition of "scandalous" as shocking to the sense of propriety, offensive to the conscience or moral feelings, or calling out for condemnation.[3] The statutory term "scandalous" has been construed to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude."[4] The cases have placed "immoral" in the same category as "scandalous,"[5] and the term "vulgar" has been held to connote immoral or scandalous matter within the meaning of section 2(a).[6]

When the PTO examines a mark, its meaning is evaluated in the context of the contemporary attitudes.[7] An Examining Attorney need only prove that the term would be perceived and understood by a substantial portion of the purchasing public as vulgar to justify refusal.[8] A vulgar, scandalous, or immoral meaning may be established by reference to court decisions, decisions of the Trademark Trial and Appeal Board (the "Board"), or dictionary definitions.[9]

The PTO will refuse registration if the mark "would be offensive to the conscience or moral feelings of a substantial composite of the general public."[10] A substantial composite of the general public is not the same as a majority;[11] it is instead an objective standard that involves the use of evidence, including dictionary definitions, newspaper articles, and magazine articles, to determine whether the general public finds a mark immoral. The test was established in *In re McGinley*, but the court neither justified nor explained it. Indeed, the dissent expressed exasperation as to what a "substantial composite" means or how one can have a "composite" of "the general public."[12] In any event, where the only definition of a term is vulgar, the term likely will not be registrable.[13] For example, the marks BULLSHIT for handbags and wallets[14] and JACK OFF for adult phone conversations[15] were found scandalous and immoral and therefore unregistrable.

This standard also applies to trademarks that consist only of a visual image. In one instance, an applicant attempted to register a beverage bottle in the shape of a hand with the middle finger extended.[16] The Board held that the gesture was the visual equivalent of an extremely offensive expletive and refused registration.[17]

However, when there is doubt as to whether a term is vulgar, the Board and the Federal Circuit both resolve doubt in favor of the applicant or registrant.[18] To resolve ambiguity as to whether a mark is scandalous or immoral, the Federal Circuit has adopted the "substantial composite" test. The determination of whether the applied-for trademark is scandalous or immoral is determined based on whether a "substantial composite" of the general public would perceive the mark to have a vulgar meaning in context of the applied-for goods or services.[19]

An example of an examination of a trademark under this standard involved the BLACK TAIL trademark for an adult magazine featuring photos of naked African-American women. The Federal Circuit held that the PTO had failed to provide sufficient evidence that a "substantial composite" would see the word "tail" in its vulgar sense.[20] The PTO and the Board relied solely on dictionary evidence showing that the term "tail" had a sexual connotation and, as such, deemed the mark scandalous. However, the Board and PTO both failed to factor non-vulgar definitions for the term "tail" into the substantial composite test. Since doubts are resolved in favor of the applicant, in view of the absence of evidence as to which of definition the substantial composite would choose, the

court held that the PTO had failed to meet its burden of establishing that the mark was scandalous.[21]

The Federal Circuit has rejected First Amendment challenges to refusals to register trademarks under section 2(a). The court has explained that because no conduct is proscribed and no expression suppressed, an applicant's First Amendment rights are not abridged by a refusal to register a mark under section 2(a).[22] As the Board has explained, the refusal to register a mark "does not impede [the] right to use the mark" and thus "does not suppress any tangible form of expression."[23]

B. Disparaging Marks

Section 2(a) provides that a trademark cannot be registered if it "may disparage…persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute." Although such a mark also may be immoral or scandalous, disparagement is a separate basis for a refusal to register.[24]

The Board applies a two-part test to determine if a proposed trademark is disparaging:

(1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services? and

(2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, is that meaning disparaging to a substantial composite of the referenced group?[25]

To justify a refusal to register, the Examining Attorney has the burden of establishing that the mark is disparaging. Once the Examining Attorney makes a prima facie showing that a substantial composite of the referenced group would find the mark disparaging in the context of contemporary attitudes,[26] the burden shifts to the applicant to rebut the prima facie case.[27]

An opposer in an opposition proceeding bears a similar burden to that of an Examining Attorney in an *ex parte* proceeding. However, in a cancellation proceeding, the petitioner must establish by a preponderance of evidence that the term violated section 2(a) *as of the date the challenged mark was registered*.[28]

Use of a religious term in a trademark may be disparaging. The Board refused to register the trademark KHORAN for wine because it resembled the sacred text of Islam, the Koran. The Board found that KHORAN mark was disparaging to a substantial portion of the follows of Islam because alcoholic beverages are prohibited by the Koran.[29] By contrast, the mark AMISH for cigars was found registrable based on proof that smoking cigars is not prohibited by the Amish.[30]

In another matter, the Board found the mark HEEB for clothing disparaging as anti-Semitic. Although evidence showed that younger Jewish people did not find the term HEEB offensive, it showed that the older generation took offense. Applying the substantial composite test, the Board held that the reaction of a minority of the relevant group was a sufficient basis to find the mark disparaging.[31]

Recently, the Board found the mark THE SLANTS for live musical performances by a band disparaging.[32] The Board noted dictionary evidence that the term "slant" is a derogatory term used to refer to those of Asian descent. In addition, the record showed that the public perceived the term THE SLANTS to be a derogatory reference to people of Asian descent.

Other marks that may have a negative connotation in relation to an ethnic group but were held not to be disparaging under section 2(a) include THE MEMPHIS MAFIA for entertainment services (found not to disparage Italian-Americans);[33] MOONIES and a design incorporating a "buttocks caricature" for dolls whose pants can be dropped (found not to be disparaging because the mark "would, when used on a doll, most likely be perceived as indicating that the doll 'moons' and would not be perceived as referencing members of The Unification Church");[34] and "JAP" for clothing.[35]

What is considered scandalous, immoral, or disparaging can change over time.[36] For example, the mark MADONNA for wine was deemed scandalous and refused registration in 1938 and 1959.[37] But MADONNA for wine was successfully registered in 2008.[38]

III. The Redskins Dispute

Given the law concerning disparaging marks, how are the Washington Redskins and the National Football League able to maintain federal trademarks registrations to the REDSKINS marks? "Redskin" is an offensive term used to refer to Native Americans,[39] and the PTO recently rejected applications comprising the term "Redskin" within a trademark on the ground that they are disparaging.[40] Because, as discussed, section 2(a) can be used to cancel a registration, why do the National Football League and Pro-Football, Inc. maintain rights in the Redskin trademarks?

Pro-Football, Inc. currently has six registered "Redskin" trademarks, most of which were filed between 1966 and 1976 (REDSKINNETTES was filed in 1989).[41] Pro Football, Inc. also has a number of "live" applications on file, but they have been suspended by the Commissioner of Trademarks in response to letters of protest filed prior to publication of the marks.[42]

To establish standing to oppose or seek to cancel a trademark under sections 13(a) or 14 of the Lanham Act, a person must establish that he or she has a "real interest" in the case,[43] that is, a direct and personal stake in the outcome.[44] A mark may be opposed by members of an offended non-commercial group. For example, the Board held that two women established standing to oppose ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND for chicken restaurant services. Although they suffered no commercial harm, standing was established on the ground that the mark brought women in general into contempt and disrepute.[45] In the subsequent *inter partes* cancellation proceedings, the Federal Circuit rejected the requirement that an opposer have an interest beyond that of the general public, holding that any member of the public who has feelings of moral outrage has standing to oppose under section 2(a).[46] The Board has required an opposer alleging moral outrage to carry the burden of showing that his or her view is reasonable and that others share it.[47]

In the *Harjo* case,[48] seven petitioners of Native American descent filed a petition in 1992 to cancel the six Redskin marks under section 2(a).[49] In 1999, the Board granted the petition on the ground that the marks were disparaging, finding that the term "Redskin" was derogatory toward Native Americans at all relevant time periods. The relevant evidence included newspaper articles and the testimony of a film expert that Western genre films produced up to and including the 1970s used the term in conjunction with negative adjectives such as "dirty" or "lying" and survey evidence showing that 36 percent of Native Americans interviewed found the term offensive. The Board also found that the word "redskin(s)" has dropped out of written and most spoken language as a reference to Native Americans.[50]

Pro-Football, Inc. appealed that determination, and in 2003, the D.C. district court reversed on two grounds: (1) the evidence did not establish a disparagement claim under section 2(a), and (2) the petition was barred by laches.[51] The court concluded that the Board's finding that the marks disparaged Native Americans was not supported by substantial evidence that a substantial composite of Native Americans perceived the term as disparaging when used as the name of a football team at the time the Redskins marks were registered. The court also found that the petitioners' delay of twenty-five years in filing the action from the date of first registration of the marks was unreasonable and would cause both judicial and economic prejudice to Pro-Football, Inc.

On appeal, the D.C. Circuit remanded the ruling as to laches with respect to one petitioner,[52] but on remand the district court reaffirmed the finding on the ground that the petitioner had waited too long (nearly eight years) after having knowledge of the marks before seeking to cancel them,[53] and the court of appeals affirmed.[54] With respect to the REDSKINETTES mark, which was registered in 1990—just over two years before the petition was filed—the Court of Appeals held that in addition to two years being an unreasonable delay, a laches defense concerning a recently registered mark may be based on the failure to challenge an earlier, substantially similar mark.[55]

The related *Blackhorse* cancellation proceeding, filed in 2006[56] and suspended until the final disposition of *Harjo*, currently is pending before the Board. Because the clock for laches runs only from the time a party has reached the age of majority,[57] the petitioners in *Blackhorse* are much younger than those in *Harjo*—clearly reflecting the use of younger petitioners to defeat a laches defense. However, it remains to be seen whether the *Blackhorse* petitioners can convince the Board that the REDSKINS marks were disparaging when adopted.

It is worth noting that trademarks also can be registered under state law, although registrations in most states have little legal significance other than serving as proof that on a certain date the registrant filed a claim that it was using a mark.[58] According to McCarthy, a state registration "may have little more than a psychologically soothing effect on the owner."[59]

New York has codified its own trademark laws in the New York General Business Law.[60] This portion of the General Business Law reflects the Model Acts written by the International Trademark Association,[61] which were intended to reflect the standards adopted and used in the Lanham Act.[62]

Under section 360-a of the GBL, a mark cannot be registered if it consists of or comprises immoral, deceptive, or scandalous matter or comprises matter which may disparage persons.[63] Hence, a mark comprising the term "REDSKIN" likely would be ineligible for registration in New York.

IV. Public Pressure Regarding the REDSKINS Marks

In addition to the litigation, there have been widespread calls for the NFL and Pro-Football, Inc. to change the name of the team.[64] In 2013, a bill was introduced in the U.S. House of Representatives that would amend the Lanham Act to conclusively presume that any mark using the term "redskin" or any derivation of it is disparaging and to require the Director of Trademarks to cancel all registrations containing the term "redskin."[65] The bill currently is before the House Subcommittee on Courts, Intellectual Property, and the Internet. In February 2014 two members of Congress wrote to Commissioner Roger Goodell urging him to change the name of the team.[66] A host of articles have been published urging the NFL and Pro-Football, Inc. to stop using the marks.[67] NBC sports

announcer Bob Costas stated on the air during halftime of a game between the Washington Redskins and Dallas Cowboys that although no offense may have been intended, the term "'Redskins' can't possibly honor a heritage or noble character trait, nor can it possibly be considered a neutral term. It's an insult, a slur, no matter how benign the present day intent."[68] President Obama said that if he owned the team, he would consider changing a name that was offending a sizeable group of people.[69]

However, the Redskins' owner, Dan Synder, declared publicly that he would never change the name of the team.[70] And in a June 2013 letter Commissioner Goodell stated that name "has…from its origin represented a positive meaning distinct from any disparagement that could be viewed in some other context. For the team's million[s] of fans and customers, who represent one of America's most ethnically and geographically diverse fan bases, the name is a unifying force that stands for strength, courage, pride and respect."[71]

If the *Blackhorse* petitioners succeed in cancelling the REDSKINS marks, the NFL and Pro-Football, Inc. could continue to use the marks, but the loss of federal enforcement rights and the threat of losing licensing fees and other revenue might make the league and the team reconsider.

V. Conclusion

The *Harjo* and *Blackhorse* cases highlight how section 2(a) of the Lanham Act is a mechanism for keeping the Lanham Act congruent with societal norms. The term REDSKINS may have not have been offensive when registered, but now it is. As a practitioner, it is important to be mindful of terms that may have offensive racial, religious, or vulgar connotations. The potential loss of federal trademark rights because of a violation of section 2(a) is a significant incentive to avoid immoral, scandalous, or disparaging trademarks.

Endnotes

1. 15 U.S.C. §1052(a).
2. 15 U.S.C. §1064(3).
3. *In re McGinley*, 660 F.2d 481, 486, 211 U.S.P.Q. 668, 673 (C.C.P.A. 1981) (holding a mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a "newsletter devoted to social and interpersonal relationship topics" and for "social club services" as scandalous).
4. *In re Runsdorf,* 171 U.S.P.Q. 443, 444 (TTAB 1971).
5. *See In re McGinley*, 660 F.2d at 484 n.6 (C.C.P.A. 1981), *aff'g* 206 U.S.P.Q. 753 (TTAB 1979) ("Because of our holding…that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark is 'immoral.' We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied.").
6. *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003) (affirming denial of registration to JACK-OFF as a mark for adult phone conversations as being immoral or scandalous because it is an offensive and vulgar name for masturbation).
7. *See In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994) (insufficient evidence on record to establish that BLACK TAIL, used on adult entertainment magazines, comprises scandalous matter; although there were both vulgar and non-vulgar definitions of "tail," the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose in the context of the relevant marketplace); *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (TTAB 1993) (holding not scandalous OLD GLORY CONDOM CORP. and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag); *In re Thomas Laboratories, Inc.*, 189 U.S.P.Q. 50, 52 (TTAB 1975) ("[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.").
8. *In re Luxuria, s.r.o.*, 100 U.S.P.Q.2d 1146, 1149 (TTAB 2011); *In re Fox*, 702 F.3d 633, 638, 105 U.S.P.Q.2d 1247, 1250 (Fed. Cir. 2012).
9. *In re McGinley*, 660 F.2d at 485, 211 U.S.P.Q. at 673.
10. *In re Wilcher Corp.*, 40 U.S.P.Q. 2d 1929 (TTAB 1996).
11. *In re McGinley*, 660 F.2d at 485.
12. *Id.* at 487 (Rich, J., dissenting). *See also* Anne Gilson LaLonde and Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral,* 101 Trademark Reporter 1476, 1493.
13. *In re Boulevard Entertainment, Inc.*, 334 F.3d at1340; *see Boston Red Sox Baseball Club Limited Partnership v. Brad Francis Sherman,* 88 U.S.P.Q.2d 1581 (TTAB 2008).
14. *In re Tinseltown, Inc.*, 212 U.S.P.Q. 863 (TTAB 1981).
15. *In re Boulevard Entertainment, Inc.*, 334 F.3d at 1340.
16. *In re Luxuria, s.r.o.*, 100 U.S.P.Q.2d 1146.
17. *Id.*
18. *In re Mavety Media Group*, 33 F.3d 1367; *In re Hines*, 32, U.S.P.Q.2d 1376 (TTAB 1994).
19. *In re Fox*, 702 F.3d at 638; *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340; *In re McGinley*, 660 F.2d at 485 ("[T]he Lanham Act does not require, under the rubric of 'scandalous,' any inquiry into the specific goods or services not shown in the application itself."); *In re Star Belly Stitcher, Inc.*, 107 U.S.P.Q.2d 2059 (TTAB 2013) (sufficient evidence provided to establish prima facie that the term "aw shit" is scandalous or vulgar to the conscience of a substantial composite of the general public); *In re Luxuria s.r.o.*, 100 U.S.P.Q.2d 1146 (mark consisting of a bottle in the shape of a hand with middle finger extended upwards comprised matter that would be considered vulgar by a substantial composite of the general public); *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (TTAB 1988) (graphic design of a dog defecating, as applied to polo shirts and T-shirts, given the broad potential audience that may view applicant's mark in sales establishments and "virtually all public places" was scandalous); *In re Hepperle,* 175 U.S.P.Q. 512 (TTAB 1972) (ACAPULCO GOLD not scandalous when used as a mark for suntan lotion even though the words might be a reference to marijuana).
20. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367.
21. *Id. at* 1373-74.
22. *In re Boulevard Entertainment, Inc.*, 334 F.3d at 1343; *In re Mavety Media Group Ltd.*, 33 F. 3d 1367 at 1374; *In re McGinley*, 660 F.2d at 484.

23. *In re Pamela Getter and Robert B. Spencer,* 2013 WL 2365001 (TTAB 2013) (STOP THE ISLAMISATION OF AMERICA for providing information regarding understanding and preventing terrorism found to disparage persons of Islam faith).

24. 4 J. Thomas McCarthy, Trademarks and Unfair Competition, §19:77.25.

25. *See In re Tam*, 108 U.S.P.Q.2d 1305 (TTAB 2013); *In re Lebanese Arak Corp.,* 94 U.S.P.Q.2d 1215, 217 (TTAB 2010); *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (TTAB 2006); *Order Sons of Italy in Am. v. The Memphis Mafia, Inc.*, 52 U.S.P.Q.2d 1364, 1368 (TTAB 1999).

26. *See In re Tam*, 108 U.S.P.Q.2d at 1310; *In re Lebanese Arak,* 94 U.S.P.Q.2d at 1218 (citing *In re Heeb Media LLC,* 89 U.S.P.Q.2d 1071, 1074 (TTAB 2008)).

27. *In re Squaw Valley Development Company*, 80 U.S.P.Q.2d 1264.

28. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1741 (TTAB 1999); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 125 (D.D.C. 2003).

29. *In re Lebanese Arak Corporation*, 94 U.S.P.Q.2d 1215.

30. *In re Waughtel*, 138 U.S.P.Q. 2d 1376 (TTAB 1963).

31. *In re Heeb Media, LLC.*, 89 U.S.P.Q. 2d 1071; *see also Boston Red Sox Baseball Club Ltd. P'ship v. Sherman*, 88 U.S.P.Q.2d 1581 (TTAB 2008) (finding SEX ROD, using the distinctive lettering used by the RED SOX trademark, disparaging of the RED SOX trademark. SEX ROD was vulgar and offensive on its own, but the use of the distinctive lettering used by the RED SOX trademark in the SEX ROD trademark disparaged the Red Sox Baseball Club).

32. *In re Tam*, 108 U.S.P.Q.2d 1305 (TTAB 2013).

33. *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 U.S.P.Q.2d 1364.

34. *In re In Over Our Heads Inc.,* 16 U.S.P.Q.2d 1653, 1654 (TTAB 1990).

35. *In re Condas S. A.*, 188 U.S.P.Q. 544 (TTAB 1975).

36. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d at 1219; *see also In re Mavety Media Group Ltd.*, 33 F.3d at 1371 ("[W]e must be mindful of ever-changing social attitudes and sensitivities. Today's scandal can be tomorrow's vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast.").

37. *See In re P.J. Valckenberg, GmbH*, 122 U.S.P.Q. 334 (TTAB 1959); *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938).

38. See Federal Trademark Registration No. 3,545,635 (2008).

39. *See* Yahoo Education, http://education.yahoo.com/reference/dictionary/entry/redskin (last visited Mar. 3, 2014), Collins English Dictionary, http://www.collinsdictionary.com/dictionary/english/redskin (last visited Mar. 3, 2014), Vocabulary.Com., https://www.vocabulary.com/dictionary/Redskin (last visited Mar. 3, 2014), Oxford Dictionary, http://www.oxforddictionaries.com/us/definition/american_english/redskin?q=redskin (last visited March 3, 2014), Dictionary.Com, http://dictionary.infoplease.com/redskin (last visited March 3, 2014), National Congress of American Indians, *NCAI Report: Redskins Name Has "Ugly and Racist Legacy*," http://indiancountrytodaymedianetwork.com/2013/10/11/ncai-report-redskins-name-has-ugly-and-racist-legacy-151714 (last visited Mar. 3, 2014).

40. *See* Federal Trademark Serial No. 86052159, REDSKINS HOG RINDS, 12/29/2013 Office Action; *see* Federal Trademark Serial No. 85394731, REDSKIN, 9/22/2011 Office Action.

41. See Federal Trademark Registration Nos. 0987127 (THE REDSKINS), 0836122 (THE REDSKINS), 0986668 (WASHINGTON REDSKINS), 0978824 (WASHINGTON REDSKINS), 1085092 (REDSKINS); 1606810 (REDSKINETTES).

42. Federal Trademark Serial Nos. 74300713 (WASHINGTON REDSKINS), 75771166 (REDSKINS BROADCAST NETWORK R), 76228476 (WASHINGTON REDSKINS CHEERLEADERS).

43. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999).

44. *Id.* at 1026 and 1027; *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q.2d 1212, 1215 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. denied*, 552 U.S. 1109 (2008).

45. *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. 176 (TTAB 1978).

46. *Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999). *Accord Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600 (TTAB 1999).

47. *Michael J. McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q. 1212 (TTAB 2006), *aff'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007), *petition for cert. filed* (U.S. Oct. 9 2007).

48. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1746, *rev'd*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225, *remanded on laches alternative ground*, 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46, 87 U.S.P.Q.2d 1891 (D.D.C. Cir. 2008), *aff'd*, 565 F.3d 880, 90 U.S.P.Q.2d 1593 (D.C. Cir. 2009).

49. TTAB Proceeding No. 92021069.

50. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705.

51. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225.

52. *Pro-Football, Inc. v. Harjo,* 415 F.3d 44, 75 U.S.P.Q.2d 1525.

53. *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46, 87 U.S.P.Q.2d 1891.

54. *Pro Football, Inc. v. Harjo*, 565 F.3d 880, 90 U.S.P.Q.2d 1593.

55. *Id.* at 885, citing *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.,* 971 F.2d 732, 734 (Fed. Cir. 1992) and *Copperweld Corp. v. Astralloy-Vulcan Corp.,* 196 U.S.P.Q. 585, 590-91 (TTAB 1977).

56. TTAB Proceeding No. 92046185.

57. *Pro-Football, Inc. v. Harjo*, 415 F. 3d 44, 48 ("The Supreme Court first embraced this principle in 1792, holding in a case dealing with conflicting 1761 land grants that "*laches* cannot…be imputed" as the "rights do not seem to have been abandoned; for in 1761, the children were infants, and were hardly of age, when this action was brought." *Gander's Lessee v. Burns,* 4 U.S. (4 Dall.) 122 (1792). The Court has since held to this principle. *See Hoyt v. Sprague,* 103 U.S. 613, 636-37, 26 L.Ed. 585 (1880) (evaluating laches "after [complainants] came of age"); *Wetzel v. Minn. Ry. Transfer Co.,* 169 U.S. 237, 240 (1898) (acknowledging "that the minors were not affected by laches until they became of age"); *cf. Wagner v. Baird,* 48 U.S. (7 How.) 234, 242, 12 L.Ed. 681 (1849) (noting that equity makes allowances for "circumstances to account for [a party's] neglect, such as imprisonment, infancy, coverture, or by having been beyond seas"); 2 Joseph Story, *Commentaries on Equity Jurisprudence, as administered in England and America,* 844 n.(b) (photo. reprint 1988) (Melville M. Bigelow, ed. 13th ed. 1886) (stating that "[i]t is not laches to wait until 49*49 one is in a legal condition to sue"); William MacPherson, *A Treatise on the Law Relating to Infants* 338-39 (Philadelphia, John S. Littel 1843) (observing that "[i]t is a maxim of law that laches is not to be imputed to an infant, because he is not supposed to be cognizant of his rights, nor capable of enforcing them").

58. 4 J. Thomas McCarthy, Trademarks and Unfair Competition § 22:1; *see Vision Center v. Opticks, Inc.*, 596 F.2d 111, 202 U.S.P.Q. 333 (5th Cir. 1979), *cert. denied*, 444 U.S. 1016, 62 L. Ed. 2d 646, 100 S. Ct. 668, 204 U.S.P.Q. 696 (1980) (Louisiana registration grants only procedural advantages). *Accord Givens Jewelers, Inc. v. Givens*, 380 So. 2d 1227, 211 U.S.P.Q. 571 (La. App. 1980), *cert. denied*, 383 So. 2d 800 (La. 1980).

59. 4 J. Thomas McCarthy, Trademarks and Unfair. Competition §22:1. Only a federal trademark registration grants rights under federal

law, including: that the mark may become incontestable five years after registration (15 U.S.C §1065); the right to use the mark with the ® (15 U.S.C. §1111); acting as prima facie evidence of the validity of the registered mark and the owner's exclusive right to use the mark (15 U.S.C. § 1115(a)); the ability of recovering profits, damages, treble damages, and costs against infringers (15 U.S.C. §1117); and automatic access to federal courts in suits against infringers (28 U.S.C. §1338).

60. N.Y. GBS. LAW §360 *et seq*.

61. *See* INTA Model Acts, www.inta.org/Advocacy/Documents/INTAModelLawGuidelines.doc, http://www.inta.org/Advocacy/Documents/INTAModelStateTrademarkBillGuide.docx (last visited Mar. 4, 2014).

62. INTA Model Act, 1992 version, §19; INTA Model Act, 2007 version, §19(b).

63. N.Y. GBS. Law §360-a ("A mark by which the goods or services of any applicant for registration may be distinguished from the goods or services of others shall not be registered if it: (a) consists of or comprises immoral, deceptive or scandalous matter; or (b) consists of or comprises matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or or disrepute…").

64. National Congress of American Indians, Commending Efforts to Eliminate Racist Stereotypes in Sports and Calling on the U.S. President and Congress to Combat These Continuing Affronts to Native Peoples, http://www.ncai.org/resources/resolutions/commending-efforts-to-eliminate-racist-stereotypes-in-sports-and-calling-on-the-u-s-president-and-congress-to-combat-these-continuing-affronts-to-native-peoples (last visited Mar. 4, 2014).

65. Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act of 2013, H.R. 1278, 113th Cong. (2013).

66. Emmarie Huetteman, *Lawmakers Press N.F.L. on Name Change for Washington Redskins*, N.Y. Times, Feb. 9, 2014; Wash. Post, http://apps.washingtonpost.com/g/page/politics/letter-to-roger-goodell-on-redskins-name/803/ (last visited Mar. 4, 2014).

67. *See, e.g.*, Dan Steinberg, *When Tony Kornheiser wrote about the Redskins nickname*, Wash. Post, Feb. 14, 2013; Robert McCartney, *Drop "Redskins" name? Time to take a stand*, Wash. Post, Feb. 6, 2013; Cortland Milloy, *What's in a name? The Redskins' bad karma*, Wash. Post, Jan. 8, 2013; Phil Mushnick, *Nothing gained in keeping shameful Redskins name*, N.Y. Post, Oct. 17, 2013; Tony Norman, *Redskins term just keeps piling on insult*, Pittsburgh Post-Gazette Oct. 15, 2013; Leonard Pitts Jr., "*Redskins" is an offensive word, period*, Miami Herald, June 16, 2013; Bill Plaschke, "*Redskins" is no honor, it's an insult*, L.A. Times, Sept. 18, 2009.

68. Brett Logiurato, *Bob Costas on Redskins name: "Insult," "slur,"* Sports Illustrated, Oct. 14, 2013.

69. David Nakamura, *Obama: "I'd think about changing" Washington Redskins team name*, Wash. Post, Oct. 5, 2013, http://www.washingtonpost.com/politics/obama-id-think-about-changing-washington-redskins-team-name/2013/10/05/e8d5cb4a-2dcd-11e3-b139-029811dbb57f_story.html?hpid=z2 (last visited Mar. 3, 2014).

70. Erik Brady, *Daniel Snyder says Redskins will never change name*, USA Today, May 10, 2013.

71. *Id.*

David Rodrigues is an associate attorney at W.R. Samuels Law, PLLC.

Scenes from the Intellectual Property Law Section

ANNUAL MEETING

Tuesday, January 28, 2014 • New York Hilton Midtown

Panelist Rebecca Griffith

Program Co-Chair Michael Oropallo

Panelist Jason Nardiello

(Left to right) Program Co-Chair Michael Oropallo, Panelists Rebecca Griffith and Jason Nardiello, and Program Co-Chair Rory Radding

(Left to right) Program Co-Chair Rory Radding, Panelists Dominick Conde and Peter Schechter, and Program Co-Chair Michael Oropallo

Young Lawyers Fellowship Award Winners Alexandra Goldstein (left) and Danielle Gorman (center), with Section Chair Kelly Slavitt (right)

Student Writing Contest Winners Mara Wilbe (left) (1st place) and Alexander Stark (center) (2nd place), with Section Chair Kelly Slavitt (right)

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Mikko Olavi Amper
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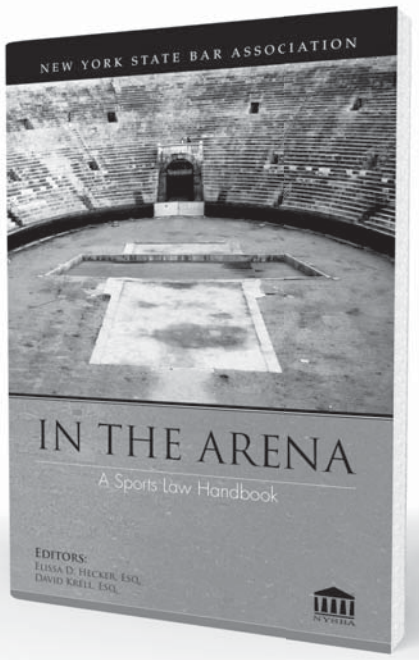

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L'Oreal USA, Inc
575 Fifth Avenue, 34th Fl.
New York, NY 10014
csehgal@us.loreal.com

Brooke Erdos Singer
Davis & Gilbert LLP
1740 Broadway
New York, NY 10019
bsinger@dglaw.com

Copyright Law
Oren J. Warshavsky
Baker & Hostetler LLP
45 Rockefeller Plaza
New York, NY 10111
owarshavsky@bakerlaw.com

Paul Matthew Fakler
Arent Fox LLP
1675 Broadway
New York, NY 10019
paul.fakler@arentfox.com

Diversity Initiative
Sheila Francis Jeyathurai
Rouse
2 Post Oak Central
1980 Post Oak Blvd, Ste. 1500
Houston, TX 77056
sfrancis@inta.org

Ethics
Rory J. Radding
Edwards Wildman Palmer LLP
750 Lexington Avenue
New York, NY 10022
RRadding@edwardswildman.com

Greentech
Rory J. Radding
Edwards Wildman Palmer LLP
750 Lexington Avenue
New York, NY 10022
RRadding@edwardswildman.com

Gaston Kroub
Kroub, Silbersher & Kolmykov PLLC
1699 E 2nd Street
Brooklyn, NY 11223-1822
gkroub@gmail.com

In-House Initiative
Chehrazade Chemcham
Colgate-Palmolive
300 Park Avenue
New York, NY 10022
Chehrazade_Chemcham@colpal.com

Sarah Crutcher Preuss
Nickelodeon Digital Media
1515 Broadway
New York, NY 10036
Sarah.Preuss@viacom.com

International Intellectual Property Law
Sujata Chaudhri
House 23, Sector 37
Arun Vihar Noida
UTTAR PRADESH 201303
INDIA
sujatachaudhri@ipgurus.in

Anil V. George
NBA Properties, Inc.
645 5th Ave
New York, NY 10022-5910
avgeorge@nba.com

Internet and Technology Law
Richard L. Ravin
Hartman & Winnicki, PC
115 West Century Rd
Paramus, NJ 07652
rick@ravin.com

Eric E. Gisolfi
Sabin Bermant & Gould LLP
4 Times Square
New York, NY 10036
egisolfi@sabinfirm.com

Litigation
Marc A. Lieberstein
Kilpatrick Townsend & Stockton LLP
1114 Avenue of the Americas
21st Floor
New York, NY 10036-7709
mlieberstein@kilpatricktownsend.com

Paul W. Garrity
Sheppard, Mullin, Richter & Hampton LLP
30 Rockefeller Plz, Fl. 39
New York, NY 10112-0015
pgarrity@sheppardmullin.com

Membership
Robin E. Silverman
Golenbock Eiseman Assor Bell & Peskoe LLP
437 Madison Avenue
New York, NY 10022
rsilverman@golenbock.com

William Robert Samuels
W.R. Samuels Law PLLC
8 W. 40th Street, 12th Fl.
New York, NY 10018
bill@wrsamuelslaw.com

Patent Law
Michael A. Oropallo
Hiscock & Barclay LLP
One Park Place
300 South State Street
Syracuse, NY 13202-2078
moropallo@hblaw.com

Pro Bono and Public Interest
Debra Resnick
FTI Consulting
Three Times Square, 11th Fl.
New York, NY 10036
debra.resnick@fticonsulting.com

Dr. Paula Joanne Estrada De Martin
Wilmer Cutler Pickering Hale & Dorr LLP
7 World Trade Center
New York, NY 10007
paula.estradademartin@wilmerhale.com

Trade Secrets
Andre G. Castaybert
Trokie Landau LLP
11 Martine Avenue
White Plains, NY 10606
castaybert@gmail.com

Douglas A. Miro
Ostrolenk Faber LLP
1180 Avenue of the Americas
7th Floor
New York, NY 10036
dmiro@ostrolenk.com

Trademark Law
William Robert Samuels
W.R. Samuels Law PLLC
8 W. 40th Street, 12th Fl.
New York, NY 10018
bill@wrsamuelslaw.com

Transactional Law
Robin E. Silverman
Golenbock Eiseman Assor Bell & Peskoe LLP
437 Madison Avenue
New York, NY 10022
rsilverman@golenbock.com

Joseph John Conklin
Coty Inc.
2 Park Avenue
New York, NY 10016-5675
Joseph_Conklin@cotyinc.com

Young Lawyers
Teige Patrick Sheehan
Heslin Rothenberg Farley & Mesiti P.C.
5 Columbia Circle
Albany, NY 12203
tps@hrfmlaw.com

Nyasha S. Foy
2816 8th Avenue
New York, NY 10039
nyasha.foy@law.nyls.edu

NEW YORK STATE BAR ASSOCIATION
INTELLECTUAL PROPERTY LAW SECTION
One Elk Street, Albany, New York 12207-1002

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