

Bright Ideas

A publication of the Intellectual Property Law Section
of the New York State Bar Association

Message from the Chair

Every June brings the onset of summer as well as new people and new positions in the Section. As incoming Chair, I am but the latest in a long line of very capable predecessors. With many thanks to our prior Chair, Kelly Slavitt, for all the hard work she did for the Section, it is now time to build on her achievements and also to chart a new course for the Section and its membership.



Charles Weigell

The Section shall look to continue to bring you engaging and informative programs. These include programs covering the current and topical as well as the tried and true. For example, our June 25 presentation on “21st Century Intellectual Property Protection and Enforcement in China” was a resounding success and very well attended. For this, we thank program co-chairs Paul Garrity and Anil George as well as Kilpatrick Stockton & Townsend, LLC for hosting the event at their offices. We also thank speakers Linda Du and Sacha Tarrant for their excellent presentations. Following a twelve-year annual tradition, we held our Women in IP program on June 11 at Arent Fox. Thanks to Joyce Creidy, who is also our Diversity Initiative Committee Chair, for organizing yet another excellent program with great presenters which is widely recognized as an unparalleled networking event.

After a brief summer hiatus, in September we are planning an interactive basics IP program that will discuss tips for both U.S. and international trademark filing and prosecution practice. As part of our outreach efforts to assist the business community, we are also planning a Pro Bono IP Clinic in late September at which IP attorney volunteers will explain IP issues and strategies that are important for startups and small businesses. The program will pair attendees with attorneys for a no-fee thirty-minute consultation. We expect this event to be a big draw.

These September programs lead up to our annual Fall Meeting at the Sagamore Hotel in Bolton Landing, New York, which will take place October 24–26. The two-day CLE program has traditionally featured distinguished speakers addressing current developments in the various IP law fields. This year will be no different, as Co-Chairs Brooke Erdos Singer and Lisa Rosaya, with the assistance of our substantive law committees, are preparing a very engaging program that includes presentations on IP issues as they relate to social media and cloud computing. The beautiful location on Lake George, and the opportunity to meet and speak with many colleagues and presenters and to enjoy a great resort with all amenities, make this program an excellent way to earn CLE credits. The Lake George boat cruise and casino night scheduled during the weekend also add to the allure.

I would like to see our live programs spur more discussions of IP issues within the Section. We are review-

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ing how best to utilize the resources on the new NYSBA website and its interactive capabilities to build interest in the Section and to foster greater participation. The Section recognizes the potential benefits of utilizing the social media tools that the NYSBA provides and hopes to develop these capabilities further to provide discussion fora. We also are seeking ideas from our membership as to implementing our online presence and fostering discussion of IP topics.

Of course, the Section's new initiatives in the social media realm do not diminish our commitment to continue prior initiatives that have proven so successful. For example, we are continuing with our IP Writing Competition this Fall, open to law students, with awards given during the Annual Meeting for the two best entries. We are also continuing with our commitment to fellowships, and I welcome our new Section fellows for 2014-2015, Danielle Gorman and Alexandra Goldstein.

Like the onset of summer and the changes in our Section and its leadership rapid changes are taking place in the IP field and consequently in our IP practices. Anyone who has been following IP law knows that there has been a slew of Supreme Court IP decisions recently. The Court has ruled on the patentability of computer-aided methods and patent claim indefiniteness. It also has addressed the Lanham Act (with another trademark decision on the way that will consider the level of judicial deference to be given to *inter partes* likelihood of confusion decisions issued by the USPTO Trademark Trial and Appeal Board). And without a doubt the *Aereo* decision provides a new perspective on communications technology and copyright infringement (whichever side of the debate you are on). And it is not just Supreme Court IP decisions that are front-page news, as shown by the recent USPTO decision to cancel the REDSKINS® trademark registrations

based on claims of disparagement by Native American petitioners.

As if these cases did not give IP practitioners and students enough to talk about, social media is also quickly changing the face of IP practice. Moreover, Congressional inaction on the issue of patent suits by non-practicing entities has spurred a great deal of discussion about what else can be done to restrict frivolous patent cases. In addition, the international dimensions of IP practices are changing rapidly as the world becomes more interconnected. Witness the difficulties faced by Tesla in its attempts to resolve its longstanding trademark issues in China, which have made headlines. And consider also the impending accession by the United States to the international design filing system of the Hague Convention, which will streamline design filings in a manner similar to the filing regimes under the Madrid Protocol or Patent Cooperation Treaty.

With constant new developments, our work as a Section is cut out for us. We hope to meet these challenges and foster our membership's commitment to the IP field by keeping abreast of new developments and new trends with new programs and initiatives while maintaining the high quality and innovative style we are known for. We also want to continue the Section's commitment to bringing those who share an interest in the IP field closer together. In this, I am looking forward to my term as Chair, and to working with EC officers Erica Klein (Vice-Chair), Lisa Rosaya (Treasurer), and Robin Silverman (Secretary).

I hope you will check us out and keep tabs on our progress (and even let us know how we are doing). Thank you, dear reader, and I hope you will enjoy this issue of *Bright Ideas*.

Charles Weigell

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Supreme Court Term Features Several Significant Patent Rulings

By Douglas A. Miro and Stephen J. Quigley

I. Introduction

Near the end of its 2013-14 term, the U.S. Supreme Court issued four opinions of significance to the patent bar that (1) tightened the standards for patenting abstract concepts; (2) raised the threshold for finding liability for inducing patent infringement; (3) lowered the bar for awarding attorneys' fees in patent litigations; and (4) raised the threshold for a claim to be considered definite. The following is a summary of these rulings and a discussion of their implications.

II. *Alice Corp. Pty. Ltd v. CLS Bank Int'l*¹

Held: A method claim for a purely abstract concept is not patent eligible.

A. Background

Alice Corp. Pty. Ltd ("Alice") owns patents for "the management of risk relating to specified, yet unknown, future events" in connection with a computerized trading platform for conducting financial transactions. The claims in the patents relate to a computerized scheme designed to eliminate the "settlement risk" where one party to a transaction does not pay its obligation, leaving the paying party without either its principal or the benefit of the other party's performance. This can arise where there is a delay between when the parties enter into a contract obligating themselves to the trade and when the trade is actually executed.

Alice's patents address that risk through an "intermediated settlement" method whereby the parties rely on a trusted third party to ensure that both contracting parties' obligations are exchanged or that neither party's obligations are exchanged. The patented technology can be used to verify each party's ability to perform before actually exchanging either of the parties' agreed-upon obligations.

In 2007, CLS Bank International and CLS Services Ltd. (together, "CLS Bank") sought a declaratory judgment that all of the claims at issue from Alice's patents were invalid, unenforceable, or not infringed. Alice asserted an infringement counterclaim. After the Supreme Court issued its decision in *Bilski v. Kappos*,² the parties made cross-motions for summary judgment as to patent-eligibility under 35 U.S.C. § 101. The district court found all of Alice's claims patent ineligible on the ground that they were directed to the abstract idea of "employing a neutral intermediary to facilitate simultaneous exchange of obligations in order to minimize risk."³

The Federal Circuit, in a splintered en banc decision,⁴ affirmed, holding that Alice's computer-readable medium containing a computer instruction system that implemented those instructions was not eligible for patent protection. The court issued seven different opinions, and while no single opinion was adopted by a majority, seven judges agreed that Alice's method and the computer-readable medium claims lacked patent subject-matter eligibility.

B. The Supreme Court Affirms

In a unanimous opinion written by Justice Clarence Thomas, the Supreme Court held that Alice's business-method patents are not patentable under 35 U.S.C. § 101⁵ because they constitute a "patent-ineligible abstract idea."⁶ Although the Court noted that an invention is not rendered patent-ineligible simply because it involves an abstract concept, it stated that a distinction must be drawn between "patents that claim the building blocks of human ingenuity and those that integrate the building blocks into something more thereby transforming them into a patent-eligible invention."⁷

Referring to its 2012 ruling in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*,⁸ the Court applied a two-part test for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts:

1. Are the claims directed to one of those patent-ineligible concepts?
2. If so, are there additional elements that transform the nature of the claim into a patent-eligible application? This step entails a search for an "inventive concept," i.e., an element or combination of elements that is "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself."⁹

Citing *Bilski v. Kappos*,¹⁰ which held that a method for hedging against the financial risk of price fluctuations was a patent-ineligible abstract idea, the Court found the concept of intermediated settlement to be "a fundamental economic practice long prevalent in our system of commerce,"¹¹ and the fact that Alice's method claims require computer implementation did not transform the abstract idea into a patent-eligible invention.¹² If a patent's recitation of a computer amounts to a mere instruction to implement an otherwise abstract idea, the Court held, the addition of a computer function cannot impart patent eligibility. Otherwise, the Court stated,

an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept. Such a result would make the determination of patent eligibility “depend simply on the draftsman’s art,” ...thereby eviscerating the rule that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable,”¹³

The Court found the function performed by the computer in the Alice process to be purely conventional, as each step did “no more than require a generic computer to perform generic computer functions.”¹⁴ Accordingly, Alice’s computer system claims were “no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long warned against interpreting §101 in ways that make patent eligibility depend simply on the draftsman’s art.”¹⁵

C. U.S. Patent and Trademark Office Guidelines

Following the Supreme Court’s ruling in *CLS*, on June 25, 2014, the U.S. Patent and Trademark Office issued its *Preliminary Instructions for Analyzing Claims with Abstract Ideas*.¹⁶ Under the *Preliminary Instructions*, Patent Examiners now must apply a two-part analysis on all claims (product and process) having an abstract idea:

Part 1. Determine whether the claim is directed to an abstract idea. If so, proceed to Part 2.

Part 2. Determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. In other words, are there other limitations in the claim that show a patent-eligible application of the abstract idea, e.g., more than a mere instruction to apply the abstract idea? The claim must be considered as a whole by considering all claim elements, both individually and in combination.

III. *Limelight Networks Inc. v. Akamai Techs. Inc.*¹⁷

Held: Liability for induced patent infringement requires the occurrence of direct patent infringement.

A. Background

Akamai Technologies, Inc. (“Akamai”) is the exclusive licensee of a patent for a method that efficiently delivers electronic data using a content delivery network (CDN). Content is placed on a set of replicated servers, and website proprietors (“content providers”) contract with Akamai to deliver their websites’ content to individual Internet users. Akamai’s patent increases the

speed with which Internet users access the content of Akamai’s customers’ websites. While Limelight Networks Inc. (“Limelight”) carries out several of the steps claimed in Akamai’s patent, it also requires its customers to perform one of the steps in the patent known as “tagging,” by which the components of the customers’ websites are stored on Limelight’s servers.

Akamai sued Limelight for both direct and induced patent infringement, alleging that Limelight used Akamai’s patent for Limelight’s own network of servers to provide content delivery. Limelight, however, did not itself modify the content providers’ web pages; instead, it instructed its customers regarding the steps they needed to perform to do their own tagging.

The district court found no infringement on the ground that it was the individual users, not Limelight or its direct customers, who performed one of the steps of the claimed method.

The Federal Circuit, sitting en banc, reversed in a 6-5 ruling, holding that a defendant can be liable for inducing patent infringement under 35 U.S.C. § 271(b)¹⁸ even though it had not committed direct infringement under section 271(a).¹⁹ Limelight could be liable for induced infringement, the court held, upon a showing that it knew of the patents and induced others to perform or complete the steps of the patented methods. It was not necessary that a single induced entity perform all of the acts constituting the direct infringement of the patent.

B. The Supreme Court Reverses

In a unanimous decision, the Supreme Court reversed, holding that liability for inducing patent infringement must be predicated on direct infringement by a single entity. Where there is no direct infringement, the Court held that there cannot be an inducement of infringement under section 271(b).

In his opinion for the Court, Justice Samuel Alito stated that “[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention,” and a patentee’s rights extend only to the claimed combination of elements and no further.”²⁰ Because “[a] method patent claims a number of steps[,] under this Court’s case law, the patent is not infringed unless all the steps are carried out.”²¹ Therefore, “Limelight cannot be liable for inducing infringement that never came to pass.”²² The Court explained:

[T]he reason Limelight could not have induced infringement under §271(b) is not that no third party is *liable* for direct infringement; the problem, instead, is that no direct infringement was *committed*. *Muniauction* (which, again, we assume to be correct) instructs that a method patent is not directly infringed—and the patentee’s interest is thus not violated—unless

a single actor can be held responsible for the performance of all steps of the patent. Because *Limelight* did not undertake all steps of the '703 patent and cannot otherwise be held responsible for all those steps, respondents' rights have not been violated.²³

The Court noted that the Federal Circuit's decision would require the courts to develop two parallel bodies of infringement law: one for liability for direct infringement and one for liability of inducement.²⁴

The Court rejected the argument that liability for inducement exists where two or more defendants directly infringe, even if each defendant's conduct, standing alone, would not be actionable. This rationale did not apply in *Limelight* because it requires collective infringement by the defendants of the plaintiff's protected interests—which did not occur. Relying again on *Muniauction*, the Court found that "respondents' interest in the '703 patent ha[d] not been invaded."²⁵

The Court also found that federal aiding and abetting statute²⁶ did not apply:

[W]e think it unlikely that Congress had [the aiding and abetting] doctrine in mind when it enacted the Patent Act of 1952, given the doctrine's inconsistency with the Act's cornerstone principle that patentees have a right only to the set of elements claimed in their patents and nothing further.²⁷

C. An Invitation to Infringe?

Does the Court's interpretation of section 271(b) allow a would-be infringer to evade liability simply by dividing performance of a method patent's steps with another whom the infringer neither directs nor controls? If it does, according to the Supreme Court, it will be because of the Federal Circuit's interpretation of section 271(a) in *Muniauction*, i.e., because direct patent infringement requires a single party to perform every step of a claimed method. The potential consequences of the Supreme Court's ruling notwithstanding, the Court observed that "[a] desire to avoid *Muniauction*'s natural consequences does not justify fundamentally altering the rules of inducement liability that the text and structure of the Patent Act clearly require—an alteration that would result in its own serious and problematic consequences, namely, creating for §271(b) purposes some free-floating concept of 'infringement' both untethered to the statutory text and difficult for the lower courts to apply consistently."²⁸

D. Application of *Limelight* in the District Courts

In *Adrea, LLC v. Barnes & Noble, Inc.*,²⁹ an allegedly infringing second encryption process was performed by a non-defendant. Citing *Limelight*, the district court stated that because no individual defendant had ex-

ecuted all the steps of the method patent, even though two different businesses had executed all the steps of the method, one of the businesses could not have induced the infringement of the other because there was no direct infringement.

In *Emblaze Ltd. v. Apple Inc.*³⁰ Apple was granted summary judgment of noninfringement of certain claims in light of *Limelight* on the ground that the infringement allegations had been made against more than one entity, including a content provider and an operator of a client computer such as a smart phone or tablet. Other claims survived summary judgment based on the opinion of Emblaze's expert opined that Apple had induced a single entity to perform all of the steps of those claims.

IV. *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*³¹

Held: An "exceptional case" for awarding attorneys' fees under the patent law³² is one that stands out from others with respect to the substantive strength of a party's litigation position or the unreasonable manner in which the case was litigated.

A. Background

ICON Health & Fitness, Inc. owns a patent for an elliptical exercise machine that allows for adjustments to fit the individual stride paths of users. ICON sued Octane Fitness, LLC, alleging that the Octane's exercise machines infringed several claims of ICON's patent.

The district court granted Octane's motion for summary judgment, concluding that Octane's machines did not infringe ICON's patent.³³ The court denied Octane's motion for attorneys' fees on the ground that under the test applied in *Brooks Furniture Mfg., Inc. v. Dutailier Int'l, Inc.*,³⁴ Octane could not show that ICON's claim was objectively baseless or that ICON had brought it in bad faith.³⁵

The Federal Circuit affirmed the denial of attorneys' fees, rejecting Octane's argument that the district court had applied "an overly restrictive standard in refusing to find the case exceptional under § 285."³⁶ The court declined to revisit "the settled standard for exceptionality."³⁷ In an earlier case, the Federal Circuit had held that litigation is objectively baseless only if it is "so unreasonable that no reasonable litigant could believe it would succeed" and that litigation is brought in bad faith only if the plaintiff "actually know[s]" that it is objectively baseless.³⁸

B. The Supreme Court Reverses

In a unanimous opinion written by Justice Sonia Sotomayor, the Court rejected the *Brooks Furniture* "exceptional case" test:

We hold...that an "exceptional" case is simply one that stands out from others

with respect to the substantive strength of a party's litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated. District courts may determine whether a case is "exceptional" in the case-by-case exercise of their discretion, considering the totality of the circumstances.³⁹

The Court offered direction to district courts as to "the totality of the circumstances" in a footnote setting forth a nonexclusive list of factors—drawn from its copyright attorneys' fees decision *Fogerty v. Fantasy, Inc.*⁴⁰—including "frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence."⁴¹ The Court opined that the framework established by the Federal Circuit in *Brooks Furniture* was "unduly rigid" as it "impermissibly encumbers the statutory grant of discretion to district courts."⁴² Analyzing the statutory term "exceptional," the Court reasoned that it should be accorded its ordinary meaning.⁴³

The Court also rejected the "clear and convincing" standard of review used by the Federal Circuit, finding that nothing in section 285 justified such a high standard of proof. Rather, the standard should be a "preponderance of the evidence," which is what has always governed patent infringement litigation.⁴⁴

In an opinion issued concurrently with *Octane Fitness, Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*,⁴⁵ the Court built upon *Octane Fitness* by holding that an appellate court "should apply an abuse-of-discretion standard in reviewing all aspects of a district court's §285 determination."⁴⁶

C. Effect on Trademark and Copyright Litigation?

The trademark statute incorporates identical language, i.e., the court may award attorney fees to the prevailing party "in exceptional cases."⁴⁷ It would be reasonable, therefore, to expect that going forward the new standard in *Octane* will apply in trademark litigations as well. But *Octane* is not likely to have any bearing on copyright litigation, as the Copyright Act does not require a case to be exceptional for an award of attorneys' fees.⁴⁸

D. Application of *Octane Fitness* by the District Courts

In *Lumen View Tech., LLC v. Findthebest.com, Inc.*,⁴⁹ the court applied the "nonexhaustive list of factors" set forth in footnote 6 of *Octane Fitness*⁵⁰ and found the case to be exceptional under the totality of the circumstances.⁵¹ The court first found the case "frivolous" and "objectively unreasonable" because even the most basic pre-suit in-

vestigation by the plaintiff would have revealed that the defendant did not employ one of the required steps, even under the plaintiff's own claim construction.⁵² Second, the court found that the plaintiff's motivation in bringing the litigation was "to extract a nuisance settlement from [defendant] on the theory that [defendant] would rather pay an unjustified license fee than bear the costs of the threatened expensive litigation."⁵³ Third, the court stated that finding the case exceptional would be a deterrent to engaging in such predatory litigation.⁵⁴ The court concluded that "[t]he question of whether this case is exceptional is not close, and fee shifting in this case will 'serve as an instrument of justice.'"⁵⁵

In *Cognex Corp. v. Microscan Sys.*,⁵⁶ the court found the case exceptional under *Octane Fitness* and awarded attorneys' fees to the plaintiff in part because the defendants had engaged in "unreasonable litigation tactics" that "wasted the Court's time" and "required plaintiffs to expend significant resources."⁵⁷ The court cited as an example the fact that the defendants' post-trial motions "simply relitigate[d] issues that had already been decided by this Court during trial."⁵⁸

In contrast, the court in *Realtime Data, LLC v. CME Group, Inc.*⁵⁹ held that the case was not exceptional and denied attorneys' fees to the defendants, finding the plaintiff's conduct "not so extreme or unreasonable that th[e] case '[stood] out from others.'"⁶⁰ The defendants maintained that the plaintiff should have abandoned the case following claim construction, noting that the plaintiff had lost on summary judgment. But the court reasoned that this "does not itself amount to unreasonable or baseless conduct."⁶¹ The plaintiff also submitted a privilege log that subsequently required significant revisions, necessitating a great deal of time and attention on the part of the defendants, but the court also did not consider it to be so unreasonable as to justify an award of attorneys' fees.⁶²

The court in *Kaneka Corp. v. Zhejiang Med. Co.*⁶³ also found the case not exceptional. The defendants asserted that they should be awarded attorneys' fees because the plaintiff had refused to stipulate to noninfringement after the claim construction ruling, where a similar claim construction ruling on the same patents and accused products had led to a finding of noninfringement in a previously concluded ITC case.⁶⁴ The court explained, however, that a claim construction ruling "does not suffice to end a case at the trial court" and that the claim construction order "did not legally determine the issue."⁶⁵ Without an analysis of infringement and validity, the court stated, an appellate court cannot properly exercise its appellate jurisdiction, which would put the plaintiff in an untenable position.⁶⁶ In addition, the court pointed out, the ITC determination of noninfringement was not binding on the district court.⁶⁷

V. *Nautilus, Inc. v. Biosig Instruments, Inc.*⁶⁸

Held: A patent is invalid for being indefinite if its claims fail to inform, with reasonable certainty, one skilled in the art about the scope of the invention.

A. Background

Biosig Instruments, Inc. (“Biosig”) is the assignee of a patent that involves a heart-rate monitor used with exercise equipment. Needing to measure ECG signals that accompany each heart beat, prior heart-rate monitors were inaccurate due to EMG signals, which are generated by a user’s arm movements. Biosig’s patent claims that it eliminates that impediment by differentiating between the two types of signals and filtering out the EMG signals. It accomplishes this through the use of two sets of a electrodes, with each set having one live and one common electrode mounted “in spaced relationship with each other.”⁶⁹

After claim construction, *Nautilus* moved for, and was granted, summary judgment on the ground that the term “spaced relationship” was indefinite under §112, ¶2⁷⁰ under the court’s construction, which indicated only that the “spaced relationship” must be the same for each set of electrodes. The district court concluded that this limitation “did not tell [the court] or anyone what precisely the space should be” or even supply “any parameters” for determining the appropriate spacing.⁷¹

Applying its “insolubly ambiguous” and “not amenable to construction” tests, the Federal Circuit reversed the district court and remanded because “the ’753 patent discloses certain inherent parameters of the claimed apparatus, which to a skilled artisan may be sufficient to understand the metes and bounds of ‘spaced relationship.’”⁷²

B. The Supreme Court Reverses

In another unanimous decision, this one authored by Justice Ruth Bader Ginsburg, the Supreme Court concluded that “the Federal Circuit’s formulation, which tolerates some ambiguous claims but not others, does not satisfy [35 U.S.C. §112’s] definiteness requirement.”⁷³ Replacing the Federal Circuit’s “insolubly ambiguous” and “not amenable to construction” tests, the Supreme Court held that “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”⁷⁴ The Court did not express an opinion on the validity of the patent, instead remanding that issue to the Federal Circuit under the new standard.

The Court rejected the Federal Circuit’s “not amenable to construction” or “insolubly ambiguous” test on the ground that it was “more amorphous than the statutory definiteness requirement allows.”⁷⁵

Those formulations can breed lower court confusion, for they lack the precision §112, ¶2 demands. It cannot be sufficient that a court can ascribe some meaning to a patent’s claims; the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters *post hoc*. To tolerate imprecision just short of that rendering a claim “insolubly ambiguous” would diminish the definiteness requirement’s public-notice function and foster the innovation-discouraging “zone of uncertainty,” against which this Court has warned.⁷⁶

In determining the metes and bounds of the requirement set forth in 35 U.S.C. §112—that a patent’s specification concludes with “one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention”—the Court traced the history of the statute through the Patent Acts of 1870 and 1790 all the way back to the Constitution, which states that a patent’s “boundaries should be clear.”⁷⁷ In its analysis, the Court confirmed well-known aspects of evaluating definiteness: (1) “definiteness is to be evaluated from the perspective of someone skilled in the relevant art;” (2) “claims are to be read in light of the patent’s specification and prosecution history;” and (3) “definiteness is measured from the viewpoint of a person skilled in the art at the time the patent was filed.”⁷⁸

The basic question the Court tried to settle was how much imprecision section 112 tolerates. Recognizing that section 112 “entails a delicate balance” and that “the definiteness requirement must take into account the inherent limitations of language,” the Court opined that while “the price of ensuring the appropriate incentives for innovation” is “some modicum of uncertainty,” “[a]t the same time, a patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them. Otherwise there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims.”⁷⁹ The Court also warned that “absent a meaningful definiteness check...patent applicants face powerful incentives to inject ambiguity into their claims.” The Court advised that this temptation should be eliminated and that “the patent drafter is in the best position to resolve the ambiguity in patent claims.”⁸⁰

In an attempt to balance these competing concerns, the Court came to its holding by reading “§112, ¶2 to require that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.”⁸¹

C. Application of *Nautilus* in the Courts

The new standard was applied in *Fla. Atl. Univ. Research Corp. v. Acer, Inc.*,⁸² in which the court held the patent invalid for indefiniteness on summary judgment because it did not “clearly link corresponding structure to the [claimed means].”⁸³ The court found that the plaintiffs had not rebutted the defendants’ evidence because they had not shown that one of ordinary skill in the art “would know what specific structures perform the means for recognizing function set out in the Patent.”⁸⁴

The court in *SourceProse Corp. v. AT&T Mobility*⁸⁵ found one of the claims not indefinite under the new standard because the specification’s description of one of the figures “provides a workable definition in context of a preferred embodiment.” The court held that this description provided “substantial guidance for a person skilled in the art to understand the bounds of the term.”⁸⁶

In *Hand Held Prods. v. Amazon.com, Inc.*,⁸⁷ the court refused to hold the claims indefinite, sidestepping the new Supreme Court standard for indefiniteness by stating the requirement that “[t]he party alleging that the specification fails to disclose sufficient corresponding structure must make that showing by clear and convincing evidence.”⁸⁸ Here, the alleged infringer provided no expert testimony or other evidence to assist the court in determining “whether, for a specific function, the description in the specification is adequate from the viewpoint of a person of ordinary skill in the field of the invention.”⁸⁹

Similarly, the court in *Bluestone Innovations LLC v. Nichia Corp.*⁹⁰ required evidence showing that someone skilled in the relevant art would be unable to ascertain the scope of the claims with reasonable certainty. The court stated: “[D]efendants fail to state in their brief what precisely would be unclear about the disputed term to a person skilled in the relevant art. Moreover, the term can be readily construed using general principles of claim construction as noted by plaintiff.”⁹¹

VI. Observations

The Supreme Court closed out its term taking an activist stance against the Federal Circuit and patent holders, with holdings in four cases that made it harder to obtain and enforce patent rights at different stages of a patent’s life. Applications before the USPTO and patents in court will be more highly scrutinized for whether they claim patent-eligible subject matter and for indefiniteness; a lowered bar for awarding attorneys’ fees will force patent holders to scrutinize their positions more thoroughly before filing suit and may deter some from filing meritorious lawsuits; and liability for inducing patent infringement will be harder to prove when there is more than one actor performing the steps of a method claim.

In three of the four cases discussed above, the Supreme Court reversed the Federal Circuit unanimously and leveled some severe criticism at the lower court. For example, it derided the Federal Circuit for “fundamentally misunderstanding what it means to infringe a method patent.”⁹² It also called the framework established by the Federal Circuit for section 285 “unduly rigid [and] impermissibly encumber[ing] the statutory grant of discretion to district courts” by “superimpos[ing] an inflexible framework onto statutory text that is inherently flexible.”⁹³ The Court further accused the Federal Circuit of “leav[ing] courts and the patent bar at sea without a reliable compass” by maintaining a formulation that “tolerates some ambiguous claims but not others [and] does not satisfy [section 112’s] definiteness requirements.”⁹⁴

With these decisions, the Supreme Court seems to be telling the Federal Circuit that it cannot continue to take patent law in a direction of its choosing but instead needs to refocus on the statutory text.

Endnotes

1. — U.S. — (2014), 2014 U.S. Lexis 4303.
2. 561 U.S. 593 (2010).
3. *CLS Bank Int’l v. Alice Corp. Pty, Ltd.*, 768 F. Supp. 2d 221, 252 (D.D.C. 2011).
4. *CLS Bank Int’l v. Alice Corp. Pty*, 717 F.3d 1269 (Fed. Cir. 2013).
5. “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title [35 USCS §§ 1 et seq.].”
6. *Alice Corp. Pty. Ltd v. CLS Bank Int’l*, 2014 U.S. Lexis 4303, at *7.
7. *Id.* at *15 (citations omitted).
8. 566 U. S. — , 132 S. Ct. 1289, 2012 U.S. Lexis 2316 (2012).
9. *Alice Corp. Pty. v. CLS Bank Int’l*, 2014 U.S. Lexis 4303, at *16.
10. 561 U. S. 593 (2010).
11. *Alice Corp. Pty. Ltd v. CLS Bank Int’l*, 2014 U.S. Lexis 4303, at *20.
12. *Id.* at *22.
13. *Id.* at *27 (citations omitted).
14. *Id.* at *29.
15. *Id.* at *31.
16. http://www.uspto.gov/patents/announce/alice_pec_25jun2014.pdf.
17. — U.S. — (2014), 134 S. Ct. 2111.
18. “Whoever actively induces infringement of a patent shall be liable as an infringer.”
19. “Except as otherwise provided in this title [35 USCS §§ 1 et seq.], whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”
20. *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. at 2118 (citation omitted).
21. *Id.*
22. *Id.*

23. *Id.* at 2118-19 (emphases in original). In *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1330 (Fed. Cir. 2008), the Court held that the defendant was not liable for direct infringement because it did not exercise control or direction over its customers' performance of those steps of the patent that the defendant itself did not perform.
24. *Id.* at 2118.
25. *Id.* at 2119.
26. 18 U.S.C. § 2. Where two parties divide all the necessary elements of a crime between them they are both guilty.
27. *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S.Ct. at 2119.
28. *Id.* at 2120. The Court declined Akamai's invitation to review the merits of *Muniauction*.
29. 2014 U.S. Dist. LEXIS 92698 (S.D.N.Y. June 30, 2014).
30. 2014 U.S. Dist. LEXIS 84414 (N.D. Cal. June 18, 2014).
31. ___ U.S. ___ (2014), 134 S. Ct. 1749.
32. 35 U.S.C. § 285: "The court in exceptional cases may award reasonable attorney fees to the prevailing party." The patent statute does not define an "exceptional case."
33. *Icon Health & Fitness, Inc. v. Octane Fitness, LLC*, 2011 U.S. Dist. LEXIS 64770 (D. Minn. June 17, 2011).
34. 393 F.3d 1378, 1381 (2005).
35. *Icon Health & Fitness, Inc. v. Octane Fitness, LLC*, 2011 U.S. Dist. LEXIS 100113 (D. Minn. Sept. 6, 2011).
36. *Icon Health & Fitness, Inc. v. Octane Fitness, LLC*, 496 Fed. Appx. 57, 65 (Fed. Cir. 2012).
37. *Id.*
38. *iLOR, LLC v. Google, Inc.*, 631 F.3d 1372, 1377-78 (Fed. Cir. 2011).
39. *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. at 1756.
40. 510 U.S. 517 (1994).
41. *Id.* at 1756 n.6 (quotations omitted).
42. *Id.* at 1755.
43. *Id.* at 1756.
44. *Id.* at 1758.
45. 572 U.S. ___ (2014), 134 S. Ct. 1744.
46. 134 S. Ct. at 1749.
47. 15 U.S.C. § 1117(a).
48. 17 U.S.C. § 505: "[T]he court may also award a reasonable attorney's fee to the prevailing party as part of the costs."
49. 2014 U.S. Dist. LEXIS 74209, 14 (S.D.N.Y. May 30, 2014).
50. 134 S. Ct. at 1756, n. 6.
51. *Lumen View Tech., LLC v. Findthebest.com, Inc.*, 2014 U.S. Dist. LEXIS 74209, at *13-14.
52. *Lumen View Tech.*, 2014 U.S. Dist. LEXIS 74209, *14-15.
53. *Id.* at *16-17.
54. *Id.* at *17.
55. *Id.* at *19.
56. 2014 U.S. Dist. LEXIS 91203, 2014 WL 2989975 (S.D.N.Y. June 29, 2014).
57. *Id.* at *11.
58. *Id.*
59. 2014 U.S. Dist. LEXIS 91051 (S.D.N.Y. June 24, 2014).
60. *Id.* at *9, quoting *Octane Fitness*.
61. *Id.*
62. *Id.* at *10-11.
63. 2014 U.S. Dist. LEXIS 91659 (C.D. Cal. May 23, 2014).
64. *Id.* at *10.
65. *Id.* at *11.
66. *Id.* at *12-13.
67. *Id.* at *12.
68. ___ U.S. ___ (2014), 134 S. Ct. 2120.
69. U.S. Patent No. 5,337,753, claim 1.
70. 35 U.S.C. §112, ¶2: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Similarly worded, this is now referred to as 35 U.S.C. § 112(b) in accordance with America Invents Act.
71. 134 S. Ct. at 2127.
72. *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 899 (Fed. Cir. 2013).
73. 134 S. Ct. 2124.
74. *Id.*
75. *Id.* at 2130-31.
76. *Id.* at 2130 (citations omitted).
77. *Id.* at 2124-25.
78. *Id.* at 2128.
79. *Id.* at 2128-29 (quotations omitted).
80. *Id.* at 2129.
81. *Id.*
82. 2014 U.S. Dist. LEXIS 88702 (S.D. Fla. June 30, 2014).
83. *Id.* at *4.
84. *Id.*
85. 2014 U.S. Dist. LEXIS 87194 (W.D. Tex. June 24, 2014).
86. *Id.* at *40-41.
87. 2014 U.S. Dist. LEXIS 85345 (D. Del. June 24, 2014).
88. *Id.* at 14 (quoting *TecSec, Inc. v. Int'l Bus. Machs. Corp.*, 731 F.3d 1336, 1349 (Fed. Cir. 2013)).
89. *Id.* (quoting *Elcommerce.com, Inc. v. SAP AG*, 745 F.3d 490, 506 (Fed. Cir. 2014)).
90. 2014 U.S. Dist. LEXIS 87182 (N.D. Cal. June 24, 2014).
91. *Id.* at *36.
92. 134 S. Ct. at 2117.
93. 134 S. Ct. at 1755-56.
94. 134 S. Ct. at 2124, 2130.

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The Day the Streaming Died: Aereo Loses in the Supreme Court

By Nyasha S. Foy

I. Introduction

On June 25, 2014, the Supreme Court held that Aereo, the start-up service that allowed users to watch and record live broadcast television signals via the Internet, violates the public performance rights of the broadcasters whose programs it transmits to its subscribers without authorization. In *American Broadcasting Cos., Inc., et al. v. Aereo, Inc.*,¹ in a majority opinion written by Justice Stephen Breyer, joined by Justices Ginsburg, Kagan (the only Justice who uses email), Kennedy, Roberts, and Sotomayor (who owns a Roku), the Court concluded that Aereo's activities were "substantially similar"² to the cable television systems found to be noninfringing in *Fortnightly Corp. v. United Artists Television, Inc.*³ and *Teleprompter Corp. v. Columbia Broadcasting System, Inc.*⁴—both of which were legislatively overturned by the Copyright Act of 1976—and therefore that Aereo publicly performed copyrighted works within the meaning of the Copyright Act's "Transmit Clause."⁵

The Copyright Act provides a copyright owner with the exclusive right to perform a copyrighted work publicly.⁶ The "Transmit Clause" in section 101 of the Act defines the right to perform a work publicly as the right to "transmit or otherwise communicate a performance... to the public, by means of any device or process, whether the members of the public capable of receiving the performance... receive it in the same place or in separate places and at the same time or at different times."⁷ Aereo presented the question of whether this definition applied to the unique manner in which Aereo transmitted programming to its subscribers.

II. Background

Key to understanding why Aereo ran afoul of the law is understanding how the service worked. The following is a capsule overview:

1. A subscriber visits Aereo's website and selects a show from a list of local programming.
2. One of Aereo's servers selects an antenna dedicated to the subscriber for the duration of the selected show.
3. The server tunes the antenna to the over-the-air broadcast carrying the show.
4. The antenna receives the broadcast, and an Aereo transcoder translates the signals received into data that can be transmitted over the Internet.
5. The server saves the data in a subscriber-specific folder on Aereo's hard drive, thereby creating a "personal" copy for the subscriber.
6. Once several seconds of programming have been saved, the Aereo server streams the saved copy of the show to the subscriber over the Internet to the subscriber's Internet-connected device.

Aereo claimed that it developed its service to "enable consumers to accomplish remotely what they could otherwise do at home."⁸ Aereo claimed to protect the right of American consumers, "who [could not] afford to pay for a cable or satellite bundle," to access the broadcast television programming that "belongs to the American public" by providing "a smarter, convenient [cloud-based] antenna."⁹

The major network broadcasters, who own the copyrights in many of the programs Aereo streamed, were concerned that Aereo was designed to circumvent copyright law—in particular their public performance rights—in order to avoid paying statutory broadcast retransmission fees. They sued Aereo in the Southern District of New York, arguing, *inter alia*, that Aereo's service infringed their right to publicly perform their television programming as well as their reproduction rights. The plaintiffs moved for a preliminary injunction on the ground that Aereo's "live" streaming service was directly liable for infringing the plaintiffs' public performance rights.¹⁰ Relying on the Second Circuit's decision in *Cartoon Network LP, LLLP v. CSC Holdings, Inc.* ("*Cablevision*"),¹¹ which held that automated copying and transmission of content by a remote storage digital video recorder (DVR) at a user's request did not constitute a public performance, Aereo asserted that its technology was materially identical to the system at issue in *Cablevision* and therefore did not violate the broadcasters' public performance rights because it did not transmit "to the public." Instead, Aereo maintained, it streamed a unique "private" transmission that was available only to an individual subscriber.¹²

In July 2012, the district court denied the broadcasters' motion for a preliminary injunction.¹³ The court found that although the plaintiffs had demonstrated a likelihood that they would suffer irreparable harm in the absence of the preliminary injunction, it concluded that they failed to demonstrate a likelihood of success on the merits because Aereo's service was not materially distinguishable from the DVR system that was found to be lawful in *Cablevision*. The court also found that an injunction would harm Aereo's business, likely leading the company to shut down.

In April 2013, a divided panel of the Second Circuit affirmed, with Judge Denny Chin—who had been the district court judge in *Cablevision*—dissenting.¹⁴ Applying its interpretation of the Transmit Clause from *Cablevision*, the court found that Aereo’s system created a unique copy of each program that an Aereo customer recorded and that the transmission of the recorded program generated from that unique copy was made available only to that customer, such that the audience for each transmission was the user who requested the transmission, not the public.¹⁵

In January 2014, the Supreme Court granted certiorari.

III. Supreme Court Ruling

The Supreme Court was faced with two questions. The first was whether Aereo performed the plaintiffs’ copyrighted television programs at all. The second was, if it did perform, whether the performances were “to the public.” With respect to the first question, Aereo argued that only the individual subscriber performed the works when he or she used its equipment to stream broadcast television programs. The Court, relying on the legal history of cable broadcast transmissions, in particular Congress’s response to *Fortnightly* and *Teleprompter*, disagreed.¹⁶

In *Fortnightly*, the Supreme Court considered whether a cable television system, which carried local television broadcasting to its subscribers via antennas and cables, infringed the broadcasters’ public performance rights. The Court reasoned that under the then-current definition of public performance in the Copyright Act of 1909, the cable provider was “more like a viewer than a broadcaster,” that viewers do not perform, and therefore that the cable television system did not publicly perform the broadcast programming.¹⁷ In *Teleprompter*, the Court reached the same conclusion with respect to another cable television provider that carried broadcast television programming to its subscribers, once again holding that this type of activity fell outside the scope of the Copyright Act.

However, Congress overturned both *Fortnightly* and *Teleprompter* in the Copyright Act of 1976. During the copyright revision process, Congress sought to adapt copyright protection to the then-current technological developments (i.e., television, radio, sound recordings, etc.). Specifically with respect to the public performance of broadcast transmissions, the legislative history shows that Congress intended to bring cable retransmissions of broadcast television programming within the scope of the public performance right.¹⁸ Justice Breyer pointed to three specific amendments Congress made to bring these transmissions within the scope of the Act: (1) it clarified that both a broadcaster and a viewer of a television program “perform” because they both show a program’s

images and make a program’s sounds audible; (2) it added the Transmit Clause, which specified that an entity performs publicly when it transmits a performance to the public; and (3) it created in section 111 a compulsory licensing scheme pursuant to which cable systems can retransmit broadcasts.¹⁹ Based on this history, Justice Breyer reasoned that “Aereo’s activities [as a commercial enterprise whose basic retransmission operations are based on the carriage of copyright program material] are substantially similar to those of the companies that Congress amended the Act to reach” and concluded that Aereo, like those cable systems, performed copyrighted works.²⁰

As for whether Aereo performed *publicly*, Aereo argued that it transmitted each performance privately because each streamed performance by a subscriber was only capable of being received by that subscriber.²¹ The Court reasoned, however, that “in light of the Act’s purposes,” an entity transmits “to the public” when it communicates the same contemporaneously perceptible images and sounds to multiple people regardless of the number of discrete (or unique and individual) transmissions.²² Further, each subscriber to whom Aereo transmits television programs is a member of the public because, taken together, they constitute “a large number of people who are unrelated and unknown to each other” who are not owners or possessors of the copyrighted material.²³ The Court thus concluded that Aereo transmitted the copyrighted programs publicly.

In addressing the concerns raised by Aereo and several of its amici that a ruling against Aereo would discourage innovation and the emergence or use of different kinds of technologies, specifically cloud storage services, the Court explicitly limited its holding:

We cannot now answer more precisely how the Transmit Clause or other provisions of the Copyright Act will apply to technologies not before us. We agree with the Solicitor General that “[q]uestions involving cloud computing, [remote storage] DVRs, and other novel issues not before the Court, as to which ‘Congress has not plainly marked [the] course,’ should await a case in which they are squarely presented.”²⁴

In dissent, Justice Antonin Scalia, joined by Justices Alito and Thomas, agreed that Aereo’s services “ought not to be allowed.”²⁵ But he disagreed with the Court’s reasoning, criticizing it for adopting a “cable-TV look-alike” standard, which he referred to as “guilt by resemblance,”²⁶ and for failing to provide a framework to determine which services run afoul of the law, which, he warned, will lead to “confusion for years to come.”²⁷

In Justice Scalia’s view, the only question was whether Aereo’s performances involved volitional conduct by Aereo. Courts, including the Second Circuit in *Cablevision*,

have held that direct copyright liability requires “some aspect of volition” directed at the copyrighted material; the defendant itself must have “trespassed on the exclusive domain of the copyright owner.”²⁸ Believing that Aereo found a loophole in the law, Justice Scalia analogized Aereo to a “copyshop that provides its patrons with a library card,” a service provider that operates nothing more than a user-controlled system. In his view, it is the user, not Aereo, who performs the programs because the user “calls all the shots” and makes the choice of content.²⁹

IV. Discussion

One interesting aspect of *Aereo* is the case law relied on by the majority and by the dissent. While Justice Breyer’s majority opinion cited *Fortnightly* and *Teleprompter*—decades-old cases that dealt with cable television systems—Justice Scalia’s dissent relied on more recent cases in which newer technological advances (i.e., VCR, file-sharing, DVR)³⁰ have threatened intellectual property stakeholders and their traditional business models. Justice Scalia pointed out how close the Court came to declaring the VCR illegal over thirty years ago.³¹ By pitting these lines of cases against each other, the Court may have provided practitioners with the next battleground.

Aereo also highlights the need for Congress to review and revise the Copyright Act once again. The justices acknowledged and agreed that the time has come for Congress to “take a fresh look” and “upgrade” the Act, calling on all practitioners and stakeholders to “identify and plug loopholes.”³² For example, the term “stream,” which is used by the Court no less than thirteen times in *Aereo*, is not defined in the Copyright Act.³³

With *Aereo*, the Court essentially preserved the status quo, forcing Aereo to suspend its service, while the major network broadcasters rejoiced. Yet, despite the Court’s decision, the rules for who can stream television programming over the Internet remain blurry. On July 9, 2014, in a letter to a district court judge on the issue of whether the court would lift the stay that allowed Aereo to remain in business in New York, Aereo indicated its intention to move forward as a lawful Internet cable service provider. Aereo claimed that under the Supreme Court’s decision, it should be considered a cable system entitled to a compulsory license under section 111,³⁴ suggesting that it was prepared to file the requisite paperwork to obtain such a license and pay its licensing fees.³⁵ However, on July 16, 2014, in a letter to Aereo, the Copyright Office halted Aereo’s license application, claiming that Internet retransmission of broadcast television falls outside the scope of the section 111 compulsory license and that “[nothing] in the Supreme Court’s recent decision in [*Aereo*] would alter this conclusion.”³⁶

Meanwhile, on July 14, 2014, the Ninth Circuit in *Fox Broadcasting Company et al. v. Dish Network LLC*³⁷ upheld a

lower court’s decision allowing satellite TV company Dish to continue selling “Dish Anywhere,” a service similar to Aereo that allows consumers to record broadcast network programming on a DVR and stream the programming over the Internet to an Internet-connected device.

In light of the recent judicial activity, Aereo’s attempt to become a cable provider may be the only way to save its business. Whatever the outcome of that effort, *Aereo* is likely to be on Congress’s radar screen as it considers updating the Copyright Act.

Endnotes

1. *American Broadcasting Cos. et al. v. Aereo Inc.*, No. 13-461, 2014 WL 2864485 (U.S. June 25, 2014).
2. *Aereo*, 2014 WL 2864485, at *2.
3. *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390 (1968).
4. *Teleprompter Corp. v. Columbia Broadcasting System, Inc.*, 415 U.S. 394 (1974).
5. The Court’s decision addressed only the legality of Aereo’s watch, or streaming function. The Court did not address whether Aereo’s record, or DVR function, infringed the Broadcasters’ public performance and reproduction rights. See *infra* n.10.
6. 17 U.S.C. §106(4).
7. 17 U.S.C. §101.
8. Brief for Defendant-Counterclaimant-Appellee Aereo, Inc., 12786-cv, at 17. See also *WNET, Thirteen v. Aereo, Inc.*, 712 F.3d 676, 682 (2013) (“Aereo’s system thus provides the functionality of three devices: a standard TV antenna, a DVR, and a Slingbox-like device. These devices allow one to watch live television with the antenna; pause and record live television and watch recorded programming using the DVR; and use the Slingbox to watch both live and recorded programs on Internet-connected mobile devices.”).
9. See <http://www.protectmyantenna.org>.
10. See *WNET, Thirteen* 712 F.3d 676, 686 n.9 (2013). Plaintiffs also asserted that transmissions of their programs via Aereo’s DVR service also infringed their public performance and reproduction rights; however, they did not assert these claims in their motion for preliminary injunction, and therefore neither the district court nor the Second Circuit considered these issues.
11. *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121 (2d Cir. 2008).
12. The Ninth Circuit expressly disagrees with *Cablevision*. In *On Command Video Corp. v. Columbia Pictures Industries*, 777 F. Supp. 787 (N.D. Cal. 1991), the court held that a hotel system transmitting movies played from individual videotapes from a central bank in a hotel equipment room violated the copyright holder’s public performance right. In *Fox Television Stations, et al. v. BarryDriller Content Systems, PLC, et al.*, 915 F. Supp. 2d 1138 (C.D. Cal. 2012), the district court, following *On Command*, issued a preliminary injunction against Aereo competitor FilmOnX. The D.C. Circuit found *BarryDriller* persuasive and issued a nationwide injunction against FilmOnX. See *Fox Television Stations, Inc. v. FilmOn X LLC*, 966 F. Supp. 2d 30 (D.D.C. 2013).
13. *American Broad. Co., Inc. v. Aereo, Inc.*, 874 F. Supp. 2d 373 (S.D.N.Y. 2012).
14. *WNET*, 712 F.3d 676.
15. *Id.* at 687 (“[I]n determining whether a transmission is to the public it is important ‘to discern who is ‘capable of receiving’ the performance being transmitted.’ *Cablevision* then decided that ‘capable of receiving the performance’ refers not to the performance of the underlying work being transmitted but rather to the transmission itself, since the ‘transmission of a performance

is itself a performance.’ The Court therefore concluded that “the transmit clause directs us to examine who precisely is ‘capable of receiving’ a particular transmission of a performance.”).

16. *Aereo*, 2014 WL 2864485, at *12 (“The history of the cable broadcast transmissions that led to the enactment of the Transmit Clause informs our conclusion that Aereo performs.”).
17. See 17 U.S.C. §1(c), (d) (1964 ed.).
18. See H.R. Rep. 94-1476, at 63 (1976) (“[A broadcasting network is performing when it transmits his or her performance (whether simultaneously or from records); a local broadcaster is performing when it transmits the network broadcast; a cable television system is performing when it retransmits the broadcast to its subscribers; and any individual is performing when he or she plays a phonorecord embodying the performance or communicates it by turning on a receiving set.”).
19. *Aereo*, 2014 WL 2864485, at *7-8.
20. *Id.* at *8 (citing H.R. Rep. 94-1476, at 89 (1976)).
21. Its system does not transmit data saved in one subscriber’s folder to any other subscriber. When two subscribers wish to watch the same program, Aereo’s system activates two separate antennas and saves two separate copies of the program in two separate folders. It then streams the show to the subscribers through two separate transmissions from the subscriber’s personal copy. *Aereo*, 2014 WL 2864485, at *4.
22. *Aereo*, 2014 WL 2864485, at *12.
23. *Id.* at *12.
24. *Id.* at *13.
25. *Id.* at *19.
26. *Id.* at *16-19.
27. *Id.* at *13. See also *id.* at Post *19 (“That leaves as the criterion of the cable TV resemblance nothing but th’ol’ totality-of-the-circumstances test (which is not a test at all but merely assertion of an intent to perform test-free, ad-hoc, case-by-case evaluation.”).
28. *Id.* at Post *14.
29. *Id.* at Post *16-*17.
30. See *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984); *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930 (2005); *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 130 (2d Cir. 2008).
31. *Sony*, 464 U.S. at 441 n.21.
32. *Aereo*, 2014 WL 2864485, at *19 (“It is not the role of this Court to identify and plug loopholes. It is the role of good lawyers to identify and exploit them, and the role of Congress to eliminate them if it wishes.”).
33. Streaming is the “process of providing a steady flow of audio or video data so that an Internet user is able to access it as it is transmitted.” *Aereo Inc.*, 2014 WL 2864485, *4, quoting A Dictionary of Computing 494 (6th ed. 2008).
34. See 17 U.S.C. § 111.
35. Letter to District Court Judge Alison Nathan, <http://blog.aereo.com/2014/07/3784/>.
36. See *Aereo Hits Roadblock in Effort to Become Cable System*, <http://www.hollywoodreporter.com/thr-esq/aereo-hits-roadblock-effort-become-719266> (July 17, 2014).
37. *Fox Broadcasting Company et al. v. Dish Network LLC et al.*, 2014 WL 3398107 (9th Cir. July 14, 2014).

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Seventh Circuit Finds Michael Jordan Congratulatory Advertisement Is Commercial Speech

By Sara Edelman and Kathleen Perell

I. Introduction

As every sports fan and award-show viewer knows, advertisers frequently engage with athletes and celebrities by running congratulatory ads or by sending tweets and posts commenting on their performance or appearance. Arby's tweets with Pharrell Williams during the Grammys, Duane Reade's Twitter post featuring a photograph of Katherine Heigl, and the legions of brands commenting on the bite taken by Uruguayan soccer star Luis Suarez during the World Cup, illustrate that brands' interactions with athletes and celebrities are occurring on a routine basis.

With the line between what is and what is not advertising becoming increasingly blurred, courts are struggling to distinguish between commercial and noncommercial speech. In *Jordan v. Jewel Food Stores, Inc.*,¹ the Seventh Circuit provided some important guidance on this issue.

II. Background

In 2009, Michael Jordan was inducted into the Basketball Hall of Fame. To honor the occasion, Time Inc. published a special edition of *Sports Illustrated Presents* devoted entirely to celebrating Jordan's career.² The commemorative issue was not distributed to regular *Sports Illustrated* subscribers but was sold separately in stores.³ Time offered Jewel Food Stores, Inc. ("Jewel"), an operator of supermarkets in the Chicago area, free advertising in the issue in exchange for agreeing to sell the magazine in its stores. Jewel accepted Time's offer and ran a full-page ad congratulating Jordan on his induction into the Hall of Fame.⁴ The ad, reproduced below, featured a pair of basketball shoes with Jordan's number 23 on a basketball court under text reading:

A Shoe In! After six NBA championships, scores of rewritten record books and numerous buzzer beaters, Michael Jordan's elevation in the Basketball Hall of Fame was never in doubt! Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was "just around the corner" for so many years.

The ad also prominently featured Jewel's logo and slogan "Good things are just around the corner."

Jordan did not react favorably to Jewel's congratulatory message. Instead, he sued Jewel for over \$5 million in damages in the Northern District of Illinois, alleging

violations of the Lanham Act, the Illinois Right of Publicity Act, the Illinois deceptive practices statute, and common law unfair competition. In response, Jewel argued that it was simply exercising its First Amendment right to congratulate Jordan and that the ad was noncommercial speech, entitled to full First Amendment protection and thus immunized from all of Jordan's claims.⁵



III. The District Court and Seventh Circuit Decisions

The district court agreed with Jewel that the ad was noncommercial speech. Relying in large part on Supreme Court precedent holding that commercial speech is "speech that proposes a commercial transaction,"⁶ the court found that the ad did not propose a commercial transaction because it did not refer to, focus on, or praise any specific Jewel product or service and thus that "readers would be at a loss to explain what they had been invited to buy."⁷ Instead, the court concluded that Jewel's ad was simply a tribute by one Chicago business to Chicago's most accomplished athlete and that Jewel's logo and slogan were merely used to identify the speaker and ensure that the congratulatory message "sounded like" it was coming from Jewel.⁸

Not accustomed to losing, Jordan appealed to the Seventh Circuit. Jewel and Jordan agreed that if Jewel's ad were noncommercial speech, the First Amendment barred Jordan's claims, but the Seventh Circuit, reversing the district court, held that Jewel's ad was commercial speech. In reaching this conclusion, the court of appeals, in an opinion by Judge Diane S. Sykes, noted that the question of whether the speech at issue proposes a commercial transaction "is just a starting point" of the analysis because commercial speech is not limited to speech that proposes a commercial transaction.⁹ The Seventh Circuit found *Bolger v. Youngs Drug Prods. Corp.*,¹⁰ which describes the factors relevant to classifying speech that contains both commercial and noncommercial elements, to be particularly instructive. Those factors include whether (1) the speech is an adver-

tisement; (2) the speech refers to a specific product; and (3) the speaker has an economic motivation for the speech.¹¹ The Seventh Circuit emphasized that these factors provide “just a general framework” for determining whether speech is commercial; that no one factor is dispositive; and that an analysis of all three factors may not be necessary for speech to be considered commercial.

The court of appeals rejected Jewel’s argument, and the district’s court’s finding, that the ad did not propose a commercial transaction. In contrast to the district court, the Seventh Circuit found it irrelevant that the ad did not promote a specific product. Today’s advertising, the court recognized, is far more nuanced and subtle:

Modern commercial advertising is enormously varied in form and style. We know from common experience that commercial advertising occupies diverse media, draws on a limitless array of imaginative techniques, and is often supported by sophisticated marketing research. It is highly creative, sometimes abstract, and frequently relies on subtle cues. The notion that an advertisement counts as “commercial” only if it makes an appeal to purchase a particular product makes no sense today, and we doubt that it ever did.¹²

The court concluded that the ad was a form of “image” or “brand” advertising aimed at promoting the Jewel brand generally rather than a particular Jewel product. But while the ad fell within a “different genre of advertising,” the court found that it nevertheless was commercial speech.¹³ The Seventh Circuit answered the district’s court question “What does the ad invite readers to buy?” with “Whatever they need from a grocery store—a loaf of bread, a gallon of milk, perhaps the next edition of *Sports Illustrated*—from Jewel-Osco, where ‘good things are just around the corner.’”¹⁴

The court also found significant the use of Jewel’s logo and slogan in the ad, recognizing them as valuable “advertising tools.” The court noted not only the size and placement of Jewel’s logo and slogan—which were prominently featured in the center of the ad—but also the fact that Jewel’s slogan was repeated in the congratulatory text—describing Jordan as “a fellow Chicagoan who was ‘just around the corner’ for so many years.” The court concluded that linking Jewel’s slogan with Jordan only made “sense if the aim [of the ad] is to promote shopping at Jewel-Osco stores.”¹⁵

Having found that the ad proposed a commercial transaction, the court proceeded to analyze the ad through the prism of the *Bolger* factors, which further confirmed that the ad was commercial speech, as: (i) the ad qualified as an advertisement; (ii) although no spe-

cific product was advertised, it promoted patronage of Jewel stores generally; and (iii) the ad served an economic purpose: to burnish the Jewel brand name and enhance consumer goodwill.¹⁶ Having thus disposed of Jewel’s constitutional defense, the court remanded the case for further proceedings on Jordan’s claims.

IV. Analysis: Is “Commercial Speech” Synonymous with the Lanham Act and the Right of Publicity’s Commercial Elements?

In assessing the significance of the Seventh Circuit’s decision to the advertising community, it is important to note that the sole issue on appeal was whether Jewel’s ad constituted noncommercial speech. Because Jewel and Jordan agreed that if it did, the First Amendment protected Jewel against all of Jordan’s claims, the Seventh Circuit “took the point as conceded” but commented that “we’re not sure that’s right, but for now we note that issue and leave it for another day.”¹⁷

The Seventh Circuit’s skepticism is justified. While both the Lanham Act and the Illinois Right of Publicity Act have a “commercial” element to them, the term “commercial speech” is not used in either statute. It is a violation of the Illinois Right of Publicity Act to use a person’s likeness for “commercial purposes” without that person’s written consent.¹⁸ Likewise, the Lanham Act provides a remedy against any person who, in connection with goods or services, “uses *in commerce* any word, term, name, symbol, or device...or any false designation of origin...which is likely to cause confusion, mistake, or to deceive as to the affiliation, connection, or association...of his or her goods, services, or commercial activities.”¹⁹ The Seventh Circuit appeared to disagree with treating the term “commercial speech” as a proxy for the Lanham Act’s “use in commerce” or the Illinois Right of Publicity Act’s “commercial purposes” requirements. Indeed, the court noted that courts across the country engage in variety of a complex balancing tests when evaluating Lanham Act and right of publicity claims asserted in the context of First Amendment-protected works.²⁰ The court acknowledged this complex legal landscape, observing that “there is no judicial consensus on how to resolve conflicts between intellectual-property rights and free-speech rights; instead, the courts have offered ‘a buffet of various legal approaches to [choose] from.’”²¹

Thus, the Seventh Circuit suggested that a finding that Jewel’s ad was noncommercial speech would not necessarily have barred Jordan’s claims, thus calling into question the necessity of categorizing a work as “commercial” or “noncommercial” in the first instance when evaluating Lanham Act or right of publicity claims. But while we wait for that issue to be resolved, the Seventh Circuit’s *Jordan* ruling serves to remind advertisers that no matter the congratulatory or benevolent intent, advertisers should be cautious before disseminating messages

featuring or referencing famous individuals that also promote their own brand or products.

Endnotes

1. 743 F.3d 509 (7th Cir. 2014).
2. *Jordan v. Jewel Food Stores, Inc.*, 851 F. Supp. 2d 1102 (N.D. Ill. 2012).
3. *Id.* at 1104.
4. *Id.*
5. *Id.* at 1105.
6. *Id.* at 1106 (quoting *Board of Trustees of State University of New York v. Fox*, 492 U.S. 469 (1989)).
7. *Supra* note 2, at 1107.
8. *Id.*
9. 743 F.3d at 516.
10. 463 U.S. 60 (1983).
11. *Id.* at 66-67.
12. 743 F.3d at 518.
13. *Id.* at 519.
14. *Id.*
15. *Id.*
16. *Id.*
17. *Id.* at 515.
18. 765 ILCS § 1075 (1998).
19. 15 U.S.C. § 1125(a) (1946).
20. 743 F.3d at 519.
21. *Id.* at 514.

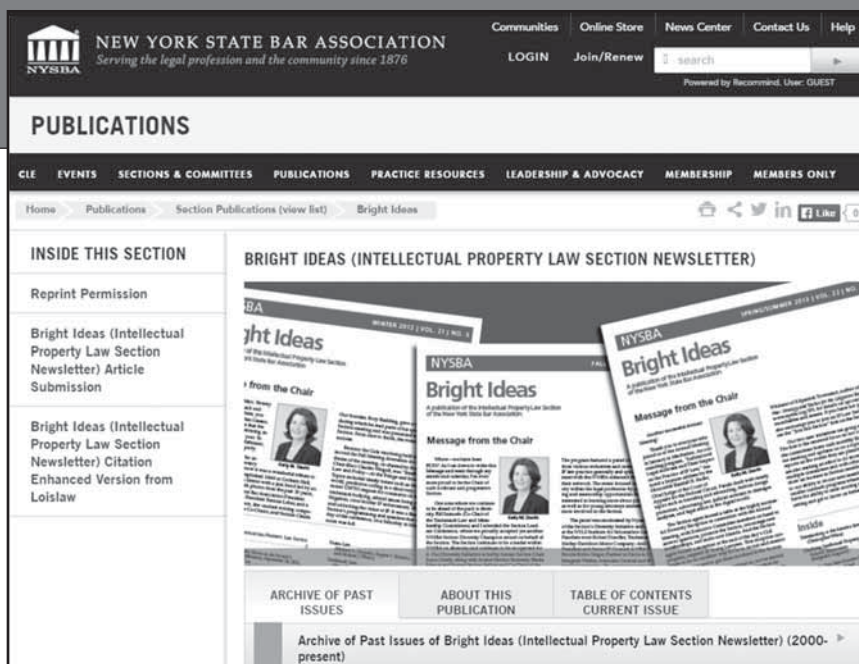
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Opportunistic Registrations of Domain Names: What Is Going On, and What Tools Are Available for Trademark Owners?

By Gerald M. Levine

I. Introduction

In June 2011, the Board of the Internet Corporation for Assigned Names and Numbers (ICANN)¹ adopted policy recommendations to expand the number of generic top level domains (gTLDs) from the familiar abbreviations, .com (commercial), .edu (education), .biz (business), and .gov (government), to include whole words or “strings” (for “strings of characters” in ICANN’s lexicon).² The initial filing window for applications to operate these new gTLDs closed on May 20, 2012. While it was open, ICANN received 1,930 applications for 1,409 different strings. The approved list is mostly dictionary words such as “club,” “events,” “link,” and “email,” but there is also an “xyz” as well as Chinese characters.³

There are two distinct periods that precede new gTLDs becoming generally available to all registrants: Sunrise and Landrush. During the Sunrise period, registration of new gTLD extensions is limited to trademark owners, while during Landrush any person may pre-register a domain name, although if there is competition it goes to auction at the end of the period. A trademark owner’s failure to secure a domain name in Sunrise or Landrush does not bar it from challenging an infringing registration, although it may be prudent to act promptly in securing domain names corresponding to trademarks. In this regard, ICANN has made it easier to protect against opportunistic registrations. It has also anticipated any uptick in infringements with new initiatives.

This article briefly examines the magnitude of cybersquatting and the rising apprehension that it will only worsen as ICANN approves new gTLDs for the domain name system. It also looks at the arbitral and statutory regimes available to combat abusive registrations of domain names and the very different remedies they offer. It concludes with a summary of the Trademark Clearinghouse, which is designed as an early warning system of potentially infringing domain registrations.

II. Magnitude of Abusive Registrations

Some sense of the threat from abusive registrations, or cybersquatting, can be gleaned from the stratospheric number of disputes ICANN-certified providers have administered since the inception in 1999 of the Uniform Domain Name Dispute Resolution Policy (UDRP or the “Policy”). UDRP panelists have filed over 45,000 decisions, of which roughly 85 percent have resulted in a finding of cybersquatting. The four current ICANN-certified service providers process approximately 4,000 decisions annually, of which at least 600 are dismissed or denied. Good-faith registrations include domain names

that are being used for bona fide purposes—including nominal fair use and protected speech—and those composed of generic terms or descriptive phrases that may coincidentally correspond with later-registered trademarks.

In a release dated March 17, 2014, the World Intellectual Property Organization (WIPO) noted that “[t]he unprecedented expansion of the Internet domain name space, until now dominated by .com and a handful of other generic toplevel domains (gTLDs), is likely to disrupt existing strategies for trademark protection on the web.”⁴ Some of the new gTLDs, such as .sucks (due Q2/2015) and .gripe (date of Sunrise registrations not yet announced), will certainly test trademark owners and raise thorny infringement, free speech, and defamation issues when they become generally available.⁵ But, as trademark owners have learned from challenging registrations under the UDRP, domain name holders also have rights or legitimate interests that can trump trademark rights. Six hundred complaints denied or dismissed is proof that not all registrations alleged to be abusive are, in fact, cybersquatting.

While it is obviously too soon to judge whether WIPO’s concerns are warranted, it is not too soon to briefly review the available remedial tools and ICANN’s dispute-resolution initiatives as well as to reflect on the rights at stake in challenging domain name registrations.

III. Remedial Measures and ICANN’s Protective Initiatives

The UDRP, which ICANN implemented in 1999, and the Anticybersquatting Consumer Protection Act (ACPA)⁶ that Congress enacted in the same year have until now been the sole administrative and statutory regimes for challenging alleged cybersquatters. The ACPA is nested in the Trademark Act of 1946 and is thus, by association with other provisions in section 1125, a species of trademark infringement, but proof of cybersquatting requires a less demanding factual showing. A domain name holder may be liable for cybersquatting even where its conduct does not constitute traditional trademark infringement.

However, anticipating an increase in cybersquatting, in 2013 ICANN implemented two protective initiatives, namely the Uniform Rapid Suspension System (URS)⁷ and the Trademark Clearinghouse (TMCH).⁸ The URS expands the remedial administrative universe, but it is geared to alleged infringements for which there is clear and convincing proof. While the three regimes are designed to combat cybersquatting, their orientations are different.⁹ The UDRP/URS regimes are limited to violations of trademark owners’ rights as defined in the UDRP. While trademark owners are nominally entitled to exclu-

sive use of their marks on the Internet, those composed of generic and descriptive terms have less protection than suggestive, arbitrary, and fanciful ones. Also, if the issues tack to trademark infringement, a UDRP/URS complaint will be dismissed as outside the scope of the Policy; adjudication of trademark infringement, as distinct from cybersquatting, is reserved to the courts.

Apart from this jurisdictional difference, there are two other notable differences between the administrative and statutory regimes. First, the UDRP and URS regimes are modeled on proof that the respondent both registered *and* is using the domain name in bad faith a trademark owner prevails only by proving bad faith in the conjunctive.¹⁰ In contrast, the ACPA requires only that the trademark owner prove *either* registration in bad faith *or* use in bad faith.¹¹ Second, the UDRP is asymmetrical: only the complainant has a substantive remedy—a mandatory injunction—whereas under the ACPA both parties are treated equally for purposes of injunctive and monetary remedies.¹² An ICANN panel, by contrast, has no authority to assess damages or to grant equitable remedies

Which of the three regimes to use is the complainant's decision. Proceedings under the UDRP/URS are quick and efficient. A UDRP complainant can expect an award within sixty days of commencing the proceeding. By contrast, the ACPA is lumbering and expensive, although it has been invoked successfully by domain name holders and trademark owners alike challenging UDRP awards. It exposes the losing party to substantial damages, as illustrated most recently by a case in which the domain name holder brought a declaratory judgment action against Donald Trump claiming that his registrations of <trumpabudhabi.com>, <trumpbeijing.com>, <trump-india.com>, and <trumpmumbai.com> were lawful. Not surprisingly, the court took the domain name holder to task for cybersquatting and awarded Trump \$32,000.¹³ There also have been a number of federal actions brought under the ACPA by trademark owners whose UDRP complaints were denied in which courts have found cybersquatting with respect to domain names registered in good faith but used in bad faith.¹⁴

IV. The Distinction Between the UDRP and URS

There are two principal differences between the UDRP and the URS: (1) they operate under different evidentiary standards—preponderance of the evidence for the UDRP versus clear and convincing proof for the URS, and (2) they provide different remedies—suspension for the duration of the registration under the URS versus cancellation or transfer of registration to trademark owner under the UDRP. These differences aside, the non-exclusive circumstances of bad faith and the respondent's nonexclusive defenses under the URS track paragraphs 4(b) (i-iv) and 4(c)(i-iii) of the UDRP.¹⁵

As its name implies, the URS has certain remedial advantages over the UDRP for the trademark owner. Notably, "rapid suspension" means what it says: the re-

spondent has fourteen days to respond to the complaint. The stated goal is for the examiner to render his or her decision within three days from when the examination began, which means the procedure can be wrapped up in as little as twenty days from the filing of the complaint.¹⁶ Thereafter, service of the award upon the registrar will result in an immediate shutdown of the website. But there are also disadvantages. For example, since infringing domain names are suspended only for the duration of the registration, not permanently removed, they may be acquired in the future by different registrants, triggering a repeat of the proceedings. In contrast, the UDRP provides for a transfer remedy whereby the domain name can be removed from circulation permanently. For example, complainants in the <h-p.bike> and <guess.clothing> disputes chose the UDRP over the URS in order to gain control over the domain names, while IBM was satisfied with simply having <watson.technology> suspended.

The URS comes with a caveat, namely that it "is not intended for use in any proceedings with open questions of fact," only "clear cases of trademark abuse."¹⁷ Early post-Sunrise challenges offer instruction on what "clear cases of trademark abuse" means. So far, there have been challenges to registrations for .bike, .clothing, .company, .guru, .land, and .ventures.¹⁸ Most of these cases have involved blatant cybersquatting, but there have been a few cases in which complainants have failed in the absence of clear and convincing proof of trademark abuse. An example is the proceeding involving <heartland.ventures>, in which the panel found nothing in the record establishing that the mark was exclusively or most commonly associated with the complainant and no evidence that the domain name was currently being used in a manner associated with that trademark.¹⁹

The URS evidentiary demands are illustrated by an unsuccessful claim brought by Richard Branson, the founder of Virgin Enterprises. In a recent URS proceeding the Panel denied his complaint concerning <branson.guru> on the ground that Branson "fail[ed] to establish in the record that the relevant trademark is strong [even assuming he has a trademark at all in the name 'branson'] plus the absence of any evidence that the domain name is currently being used in a manner that is associated with that trademark."²⁰ A summary of the evidence indicates that Branson would have failed even under the lower evidentiary standard of the UDRP—Branson being a geographic location in Missouri—but because dismissal of a URS complaint has no res judicata effect against a later UDRP or legal infringement proceeding, a complainant has the right to later file a UDRP or ACPA action.²¹

V. The Trademark Clearinghouse

The TMCH is a fee-based service designed for trademark owners to have their trademarks registered in its centralized database. The one quirk is that while the registration can be made by the owner itself or through an

agent, it cannot be made by an attorney on behalf of his or her client unless he or she has paid TMCH an agent's fee.²² Trademarks are eligible for inclusion in the database if they are nationally registered on the principal or primary register in the mark's jurisdiction.²³ Unregistered marks may be eligible on proof of acquired distinctiveness, but, as its title implies, the TMCH is not available for applied-for but unregistered trademarks. Importantly, inclusion in the database is not proof of priority, nor does it create any legal rights. The database is simply a repository of verified rights. This is consistent with the jurisprudence developed under the UDRP: only trademark owners have standing to maintain UDRP and URS proceedings.

TMCH's service initially tracks requests for domain name registration during the Sunrise and Landrush periods and notifies third-party registrants of likely infringements. It reports a ninety-five percent record of deterring unauthorized registrations through its notifications, but since it has no enforcement authority, it is up to trademark owners to protect their interests upon notification.

In effect, once the new gTLDs become generally available, the TMCH becomes a notification service that warns trademark owners to initiate either a URS or a UDRP. Owners of trademarks that are not inherently distinctive have a heavier burden of proving abusive registration; generic and descriptive trademarks that have acquired secondary meaning can be trumped by corresponding domain names acquired and used for goods or services consistent with the ordinary meaning of the words or phrases.

VI. Conclusion

The expansion of gTLDs will undoubtedly (as WIPO fears) "disrupt existing strategies for trademark protection on the web." But is the virtual marketplace really any different from the actual marketplace in having to contend with infringers bent on taking advantage of a trademark's reputation and goodwill? There have always been opportunists taking advantage of others' marks.

There is always a need for change. It was true in June 1998, when the National Telecommunications and Information Administration (NTIA), an authority within the U.S. Department of Commerce, issued a Statement of Policy to that effect.²⁴ The government's approach to the Internet, it stated, had to change: "Conflicts between trademark holders and domain name holders...[were] becoming more common...[while] [m]echanisms for resolving these conflicts [were] expensive and cumbersome." That call led to the creation of ICANN and the involvement of the World Intellectual Property Organization (WIPO), which produced the reports that have been said to be the "closest equivalent to a legislative history for the Policy."²⁵ And Congress's concern with cybersquatting led it to pass a law (the ACPA) designed to suppress it.

"Given the human capacity for mischief in all its forms,"²⁶ it is unrealistic to believe that cybersquatting can be eliminated. Nevertheless, the administrative and statutory regimes outlined above, and particularly the UDRP, have proved their effectiveness in shutting down infringing websites. Although cybersquatting cannot be deterred entirely, the TMCH shortens the time between the infringing act and the demand that the registration be suspended, cancelled, or transferred. Like the fire alarm at a fire house, when it rings the engines are ready to go.

Endnotes

1. ICANN is "an internationally organized, non-profit corporation [formed in 1998] that has responsibility for Internet Protocol (IP) address space allocation, protocol identifier assignment, generic (gTLD) and country code (ccTLD) Top-Level Domain name system management, and root server system management functions." ["Background Points" posted by ICANN on its web site at <icann.org/general/background.htm>.] Its mission "is to coordinate, at the overall level, the global Internet's systems of unique identifiers, and in particular to ensure the stable and secure operation of the Internet's unique identifier systems."
2. Defined in the ICANN glossary as a "string of characters comprising an applied for gTLD."
3. *International Business Machines Corporation v. Denis Antipov*, FA1402001542313 (Nat. Arb. Forum Feb.12, 2014) (<ibm.guru> and ibm.ventures>) (URS). Registries may opt into the URS. See *Facebook Inc. v. Radoslav*, FA130800 1515825 (Nat. Arb. Forum Sept. 27, 2013) (<facebook.pw>. Dot pw is the suffix for Palau).
4. The full text of the Release is available at http://www.wipo.int/pressroom/en/articles/2014/article_0003.html.
5. Statistics of currently available new gTLDs are available at <<http://ntldstats.com/>>. At the top of list for popularity is .xyz followed by .berlin, .club, .guru and .photography.
6. 15 U.S.C. § 1117(d) provides for damages up to \$100,000 per domain name, but the statute is symmetrical so that a domain name holder is entitled to equal damages for reverse domain name hijacking (§ 1114 (2)(D)(iv)).
7. ICANN implemented the URS in March 2013 and its Rules in June 2013. URS, Art. 13: The procedure is available at <http://newgtlds.icann.org/en/applicants/urs>. A couple of inaugural disputes under the URS were filed in 2013 and they are beginning to show up more frequently on the docket.
8. TMCH was initially described in a circular dated January 11, 2012. It is a centralized database of validated trademarks. Further information is available at the <http://trademarkclearinghouse.com/> and <http://www.icann.org/en/gsearch/Trademark%2BClearing%2BHouse>.
9. *Web-Adviso v. Trump*, 11-cv-1413 (E.D.N.Y. Mar. 7, 2013) (rejecting plaintiff's argument he had reasonable grounds to believe his conduct was lawful). See also *Lahoti v. Verichack*, C06-1132JLR (WDWA, 2007), *aff'd*, 586 F.3d 1190 (9th Cir. 2009).
10. UDRP, Par. 4(a)(iii) and URS Art. 8.2.
11. 15 U.S.C. § 1125(d)(1)(A): "A person shall be liable in a civil action by the owner of a mark...if, without regard to the goods or services of the parties, that person
(i) has a bad faith intent to profit from that mark...; and
(ii) registers, traffics in, or uses a domain name [that violates the rights of a trademark owner]."
12. The ACPA grants statutory damages to the prevailing party discretionary with the court up to one hundred thousand dollars (\$100,000) plus reasonable attorney's fees for either party's misjudgment of its rights, 15 U.S.C. §§ 1114(2)(D) and 1117(d).

13. *Web-Adviso v. Trump*, 11-cv-1413 (E.D.N.Y March 7, 2013) for unsuccessful declaratory judgment action in which the district court rejected plaintiff's argument he had reasonable grounds to believe his conduct was lawful. The court awarded Trump damages in the amount of \$32,000.) See also *Lahoti v. Verichek*, C06-1132JLR (W.D. Wash. 2007), *aff'd*, 586 F.3d 1190 (9th Cir. 2009).
14. *DSPT International v. Nahum*, 624 F.3d 1213 (9th Cir. 2010). The Court held that "[e]ven if a domain name was put up innocently and used properly for years, a person is liable under 15 U.S.C. § 1125(d) if he subsequently uses the domain name with a bad faith intent to profit from the protected mark by holding the domain name for ransom." Also, *Newport News Holdings Corporation v. Virtual City Vision, Incorporated, d/b/a Van James Bond Tran*, 650 F.3d 423 (4th Cir. 2011).
15. URS Rules, 1.2.6.3. (tracking UDRP 4(b)) and 5.7 tracking UDRP 4(c)).
16. URS, para. 9.6.
17. URS, para. 8.5.
18. *HD U.S.A., LLC v. norman galarneau*, FA1403001547561 (Nat. Arb. Forum Apr. 12, 2014) (<h-d.bike>); *Christian Dior Couture v. aris koulaidis*, FA1402001546033 (Nat. Arb. Forum Apr. 1, 2014) (<dior.clothing>); *Duck Bites Holdings, LLC v. john kennedy*, FA140300 1550405 (Nat. Arb. Forum April 11, 2014) (<ripoffreport.com>); *International Business Machines Corporation v. Denis Antipov*, FA1402001542313 (Nat. Arb. Forum Feb. 12, 2014) (<ibm.guru>); *Accenture Global Services Limited v. azan tengku et al.*, FA140300 549011 (Nat. Arb. Forum Apr. 7, 2014) (<accenture.ventures>).
19. *Heartland Payment Systems, Inc. v. Redwood Capital*, FA1403001547419 (Nat. Arb. Forum March 27, 2014).
20. *Virgin Enterprises Limited v. Lawrence Fain*, FA1402001545807 (Nat. Arb. Forum Mar. 20, 2014).
21. URS Art. 8.6: "If the Examiner finds that any of the standards have not been satisfied, then the Examiner shall deny the relief requested, thereby terminating the URS proceeding without prejudice to the Complainant to proceed with an action in court of competent jurisdiction or under the UDRP."
22. Cost and other information about becoming an agent is available at <http://www.trademark-clearinghouse.com/content/trademark-agent>.
23. A copy of the TMCH Guidelines is available at <http://trademark-clearinghouse.com/sites/default/files/downloads/TMCH%20guidelines%20v1.2.pdf>.
24. Statement of Policy on the Management of Internet Names and Addresses, U.S. Department of Commerce, National Telecommunications and Information Administration (June 5, 1998) (White Paper). The Policy is available on the Internet at <http://www.ntia.doc.gov/federal-register-notice/1998/statement-policy-management-internet-names-and-addressesere>.
25. *Broadcom Corporation v. Michael Becker*, FA0108000098819 (Nat. Arb. Forum Oct. 21, 2001).
26. *Worldcom Exchange, Inc. v. Wei.com, Inc.*, D2004-0955 (WIPO Jan. 5, 2005).

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In an ongoing effort to connect women in the Intellectual Property Law field, the 12th annual **Women in Intellectual Property Law** event on June 11, 2014 proved to be an enriching event. Hosted by Arent Fox LLP in New York City and organized by Joyce L. Creidy, the event was attended by female attorneys practicing and interested in intellectual property. An hour-long reception preceded the program, allowing attendees to network with each other and with the panelist speakers. The panel included Marylee Jenkins, partner at Arent Fox LLP; Jane Chuang, partner at Lee Anav Chung White & Kim LLP; Paula T. Calhoun, Senior Vice President and General Counsel at Music Choice; and Deborah Robinson, Vice President of Viacom Media Networks Anti-Piracy department.

Ms. Creidy began the program by highlighting the topic of whether women should “lean in” to their careers—a term popularized by Sheryl Sandberg in her book of that title. The panelists then shared their experiences as women in the legal field and how their business strategies and choices brought them success. Jenkins noted how choosing not to reject certain assignments during her career led to unexpected opportunities. She also revealed the misgivings women experienced in her early days as an associate for their choice in pantsuit attire. Chuang remarked how the legal path can be a roller-coaster ride and that accepting assignments in unfamiliar areas of the law can be rewarding. She also expressed appreciation for her firm’s flexibility during her pregnancy and as a working mother. Calhoun started out as an associate at a time when female associates were few

and female partners nonexistent. She had no initial plan to become an intellectual property lawyer, nor did she map out her career goals. Her story showed how one’s path can perfectly fall into place when one is willing to accept opportunities as they arise. She stressed the importance of creating great business relationships and expressed support for female mentoring in the legal profession. On the other hand, Robinson planned her every career move. She advised that one should find one’s passion before creating a plan and then execute the plan diligently. She said that whatever one’s career choice, it is important to be happy with your work and to maintain a positive outlook. Even with their various career strategies and experiences, all of the panelists noted the importance of networking and memberships in associations as a valuable part of a successful legal career.

Desserts and coffee followed the program, creating more opportunities to network. It was truly a worthwhile event that ended one a wonderful note with the raffling of numerous prizes.

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DISCOUNTS AND SCHOLARSHIPS: New York State Bar Association members and non-members may apply for a discount or scholarship to attend this program, based on financial hardship. This discount applies to the educational portion of the program only. Under this policy, any member of our Association or non-member who has a genuine basis for his/her hardship, if approved, can receive a discount or scholarship, depending on the circumstances. To apply for a discount or scholarship, please send your request in writing at least 10 business days prior to the meeting to Catheryn Teeter at: New York State Bar Association, One Elk Street, Albany, New York 12207 or cteeter@nysba.org

For more information about this program or to register, visit www.nysba.org/ipi or contact Catheryn Teeter at 518-487-5573.

UPCOMING SECTION EVENTS:

Friday, December 5, 2014: IP Law Section Annual Law Student Writing Contest submissions deadline. Call 518-487-5587 or visit the IP Section page at www.nysba.org/IPWritingCompetition for contest rules.

Tuesday, January 27, 2015: IP Law Section Meeting during NYSBA Annual Meeting. The Hilton, 1335 Avenue of the Americas, New York, NY. 9 am to 5:30 pm with Luncheon. Call 518-463-3200 for more information or visit www.nysba.org/ipi in November.

SCHEDULE OF EVENTS

Thursday, October 23

- 7:00 - 10:00 pm** **Buffet Dinner *for Sagamore Hotel Guests Only***
Mr. Brown's Pub, Downstairs, Main Hotel
Attendees, Guests & Children Staying at the Sagamore Thursday Evening are Welcome!
Children must be signed up on the meeting registration to attend.

Friday, October 24 *All Sessions will be held in the Sagamore Conference Center*

- 7:00 - 10:00 am** **Breakfast on Your Own** - Ala Carte or Buffet at La Bella Vita Restaurant, Main Hotel
Breakfast is not included in the Meeting Registration fee or Hotel Rate Plan.

- 9:00 am - 1:00 pm** **Registration** - Conference Center Foyer

- 12:00 - 1:00 pm** **Lunch** - Shelving Rock Terrace, Main Hotel

GENERAL SESSION - Wapanak Room, Conference Center

- 1:05 - 1:15 pm** **Welcome & Introductory Remarks**

David P. Miranda, Esq., President-Elect, New York State Bar Association
Charles T.J. Weigell, III, Esq., Intellectual Property Law Section Chair

- 1:15 - 2:30 pm** ***THE ADVERTISING LAW COMMITTEE PRESENTS:***
HOT TOPICS IN SOCIAL MEDIA

This panel will discuss FTC Guidelines governing online reviews and endorsements, including recent FTC actions that have focused on the use of social media and online marketing; best practices related to monitoring the activities of spokespersons, affiliate marketers, bloggers, and other vendors; how to minimize legal risk while maximizing the benefits of social media as a marketing or advertising tool; and incorporating social media into sweepstakes or contest.

Panelists:

Joseph J. Lewczak, Esq., Partner, Davis & Gilbert LLP, New York, New York
Aron Weiss, Esq., Counsel, Fast Retailing USA, New York, New York
Kesari Ruza, Esq., Vice President & Senior Counsel, HBO, New York, New York

- 2:30 - 3:20 pm** ***THE PRO BONO AND PUBLIC INTEREST COMMITTEE PRESENTS:***
ETHICAL ISSUES IN PRO BONO REPRESENTATION

This panel will discuss common ethical issues involved in pro bono representation from conflicts of interest to duty of care. Our panelists will use both hypotheticals and actual cases decisions to help guide you in your efforts to help those in need.

Panelists:

To Be Announced

SCHEDULE OF EVENTS

Friday, October 24, *Continued*

3:20 - 3:35 pm **Coffee Break** - Conference Center Foyer

3:35 - 4:50 pm ***THE TRADEMARK LAW & INTERNATIONAL IP LAW COMMITTEES PRESENT:
HOW TO ENFORCE AGAINST COUNTERFEITERS: STRATEGIES AND REALITIES
IN THE CONNECTED GLOBAL MARKETPLACE***

This panel of in-house counsel, outside counsel, and law enforcement will discuss steps taken by global brands and the federal government to protect rights holders and to prevent counterfeit goods from entering the U.S. and other markets. Topics will include insights on current efforts by Major League Soccer to combat counterfeiting, cutting edge work by outside counsel to develop and implement efficient and cost-effective approaches to brand protection in the digital space and other strategies, as well as measures taken by the government's National Intellectual Property Rights Coordination Center and the Department of Homeland Security on this front.

Panelists: **Harley Lewin, Esq.**, Partner, McCarter & English, LLP, New York, NY
Olivier Manigat, Esq., Legal Counsel, Major League Soccer, New York, NY

4:50 - 5:40 pm ***THE COPYRIGHT LAW COMMITTEE PRESENTS:
DIGITAL COPYRIGHT DEVELOPMENTS: THE INCREASING IMPORTANCE OF
COPYRIGHT PROTECTION FOR DIGITAL MARKETS AND MEDIA***

In the past year several important cases have been decided, which demonstrate the scope and strength of copyright in the digital world and the increasing importance of copyright as a key source of intellectual property protection as we head into the future. Prominent copyright practitioners will discuss these recent cases, including *ABC v. Aereo*, *Capitol Records v. ReDigi*, and *Oracle v. Google*, as well as other recent cases and developments related to digital copyright law.

Panelists: **Oren Warshavsky, Esq.**, Partner, Baker Hostetler LLP, New York, NY
Lisa W. Rosaya, Esq., Partner, Baker & McKenzie LLP, New York, NY

6:00 - 9:00 pm **Children's Dinner**

6:30 - 7:30 pm **Cocktail Hour** - Shelving Rock Terrace

7:30 - 9:00 pm **Dinner** - Shelving Rock Terrace

9:00 - 11:00 pm **Join us for After Dinner Drinks in Mr. Brown's Pub** - Downstairs, Main Hotel
Sponsored by: KILPATRICK TOWNSEND & STOCKTON LLP

SCHEDULE OF EVENTS

Saturday, October 25 *All Sessions will be held in the Sagamore Conference Center*

7:00 - 10:00 am **Breakfast on Your Own** - Ala Carte or Buffet at La Bella Vita Restaurant, Main Hotel
Breakfast is not included in the Meeting Registration fee or Hotel Rate Plan.

8:00 - 9:00 am **Registration with Coffee and Pastries** - Conference Center Foyer
Sponsored By: DAVIS & GILBERT LLP

MORNING SESSION - Wapanak Room, Conference Center

9:00 - 10:15 am **THE IP LITIGATION COMMITTEE PRESENTS:**
YOU PAID WHAT??? A LOOK AT THE VALUE OF YOUR INTELLECTUAL PROPERTY IN TRANSACTIONS VS. LITIGATION

Our distinguished panel will identify and compare intellectual property values in transactions and litigation. This evaluation is crucial because transactional attorneys often turn to comparable agreements to determine appropriate royalty rates and deal structures in different industries and for different types of licensed properties. Our panel will discuss various criteria and factors considered for measuring intellectual property value in actual transactions and provide a review of recent cases addressing this question in litigation.

Panelists: **Marc Lieberstein, Esq.**, Partner, Kilpatrick Townsend & Stockton LLP, New York, New York
David Haas, Managing Director, Dispute Advisory & Forensic Services, Stout Risius Ross, Chicago, IL
Laurie J. Gentile, Esq., Nine West Corporation, White Plains, New York
Nelson DeCunha, Esq., Pratt & Whitney, East Hartford, Connecticut

10:15 - 11:30 am **THE INTERNET AND TECHNOLOGY LAW COMMITTEE PRESENTS:**
UNDERSTANDING HOW TO ACQUIRE AND USE SOCIAL MEDIA EVIDENCE AND RECENT LEGAL DEVELOPMENTS IN THE CLOUD, INTERNET AND MOBILE COMPUTING

Social media can be a treasure trove of material for your case in chief and cross-examination. Learn how to obtain social media information without breaching your ethical obligations, avoid spoliation, and get the evidence admitted in court. Find out the latest developments in online and technology law, including recent Supreme Court cases, presented by a renowned Internet Law treatise author.

Moderator: **Richard L. Ravin, Esq.**, Partner, Hartman & Winnicki, P.C., Ridgewood, New Jersey
Panelists: **Ian Ballon, Esq.**, Author, E-Commerce and Internet Law Treatise, Greenberg Traurig LLC, Los Angeles, California
 Michael R. Holt, Esq., Partner, Rumberger Kirk & Caldwell, Miami, Florida

11:30 - 11:45 am **Coffee Break** - Conference Center Foyer

SCHEDULE OF EVENTS

Saturday, October 25, *Continued*

- 11:45 - 12:35 pm** ***THE TRADE SECRETS LAW COMMITTEE PRESENTS:***
**PROTECTING TRADE SECRETS FROM INDUSTRIAL ESPIONAGE
AND CYBER THEFT**
An attorney investigator from the FBI and the Office of the National Counterintelligence Executive ("ONCIX") will speak about the current threat to public and private organizations posed by industrial espionage and cyber-theft and strategies to counter this growing threat to corporate trade secrets protection. In her presentation, she will outline the nature and extent of the threat, review recent cases, explore risk management and corporate counterintelligence strategies, and outline the ONCIX recommendations to protect trade secrets from industrial espionage.
- Panelists:** **Elizabeth Stan, Deputy Director for Research,** Federal Bureau of Investigation
Office of the National Counterintelligence Executive ("ONCIX"), Washington, DC
Andre G. Castaybert, Esq., Castaybert PLLC, New York, NY
- 12:35 - 1:35 pm** **Attorneys' Lunch** - Nirvana Room, Conference Center
- 4:30 pm** **Cocktail Boat Cruise Around Lake George on "THE MORGAN"**
Sponsored by: THOMSON COMPUMARK
THOMSON REUTERS
Boarding begins at 4:30 pm at the dock behind the Main Hotel
THE MORGAN ***departs promptly at 4:45 pm!***
- 6:30 - 8:30 pm** **Dinner** - Wampanak Room, Conference Center
Wine Sponsored by: STOUT RISIUS ROSS
- 8:30 - 10:30 pm** **Casino Night** - Wampanak Room, Conference Center
Join us for an evening of fun and games...Try your luck at blackjack and roulette.

Sunday, October 26

- 7:00 - 10:00 am** **Breakfast on Your Own** - Ala Carte or Buffet at La Bella Vita Restaurant, Main Hotel
Breakfast is not included in the Meeting Registration fee or Hotel Rate Plan.
- 11:00 am** **Departure**

THE SECTION THANKS THE
FOLLOWING FALL MEETING
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NEW YORK STATE BAR ASSOCIATION

MEETING REGISTRATION FORM

Name of Attorney _____

Nickname/Attorney _____

Name of Spouse or Guest _____

Nickname/Spouse/Guest _____

Names & Ages of Children _____

Firm/Affiliation _____

Address: _____

Phone _____ Fax _____

E-mail address _____

FEES

Section Member Registration fee: \$300.00 per attorney\$ _____

Non-Section Member Registration fee: \$400.00 per attorney\$ _____

Spouse/Guest Registration fee: \$200.00 per spouse/guest\$ _____

Are You A First Time Attendee? ☐

ACTIVITIES

IMPORTANT INFORMATION: Registrants, Spouse/Guests and Families staying at the hotel are expected to attend the private group dinner events. If you choose to eat dinner at any of the hotel restaurants on your own, you will be charged ala carte for food and will not be rebated money from the meal plan.

Friday Luncheon _____ # of registered adults/children attending

Friday Cocktail Reception and Dinner _____ # of registered adults attending
Preferred entree: Fish _____ Beef _____

Saturday Attorney Luncheon _____ # of registered attorneys attending

Saturday Cocktail Cruise _____ # of registered adults/children attending

Saturday Dinner _____ # of registered adults/children attending

Attorneys and Guests NOT staying at the Sagamore must purchase tickets for dinner if they wish to attend at \$86.00 per person per dinner. Please include payment with registration fees.

Children's Dinner Pricing is per dinner per each night:

\$15 (age 1-5) \$25 (age 6-12) \$50 (age 13-18)

Children in diapers are **NOT** allowed to attend children's dinner on Friday.
Please include payment with registration fees.

Name of Child(ren): _____

of Children attending Ages

Thursday _____

Friday _____

Saturday _____

Intellectual Property Law Section

Fall Meeting

October 23 - 26, 2014

The Sagamore
Bolton Landing, NY

➤ Please note any address
corrections on the left.

Attorney Registration fees include:

Friday lunch & Saturday **attorney only** lunch,
Friday cocktail reception & after dinner drinks,
Saturday Cocktail Boat Cruise and Casino
Night, all coffee breaks, costs associated with
programming and program materials.

Attorneys attending MCLE sessions must pay
the Attorney Registration Fee.

Spouse/Guest Registration fees include:

Friday lunch, cocktail reception & after dinner
drinks, Saturday Cocktail Boat Cruise and
Casino Night.

Cancellation Notice:

To receive a refund, notice of cancellation
must be received on, or before, **Thursday,
October 9, 2014.**

**Return this form with registration fee(s)
to:**

Catheryn Teeter
Meetings Representative
New York State Bar Association
One Elk Street
Albany, New York 12207
Telephone: 518-487-5573
Fax: 518-463-5993



PAYMENT INFORMATION

Check or money order enclosed in the amount
of \$ _____

(Please make checks payable to the
New York State Bar Association.)

- ☐ Charge \$ _____ to
☐ American Express ☐ Visa
☐ Discover ☐ MasterCard

Expiration date _____

Card number: _____

Authorized Signature

NEW YORK STATE BAR ASSOCIATION

ACCOMMODATIONS REQUEST FORM

PERSONAL INFORMATION

Please print or type names of all persons who will occupy the room

Name (s) _____

Names/Ages of Children _____

Firm _____

Address _____

City _____ State _____ Zip _____

Phone (_____) _____ Email _____

HOTEL INFORMATION

European Plan Room Rate Per Night Includes Private Group Dinner Nightly. Plan cannot be used in the Hotel Restaurants. If you choose to eat dinner at any of the hotel restaurants on your own, you will be charged ala carte for food and will not be rebated money from the plan included in the room rate.

A **limited** number of rooms is available in each rooming category. **Please indicate your first, second and third room choice:**

	SINGLE	DOUBLE
_____ Walk-In Lodge Room	\$245.00	\$331.00
_____ Lower Lodge Suite	\$345.00	\$431.00
_____ Walk-In Lodge Suite	\$365.00	\$451.00
_____ Hotel Room Garden View	\$295.00	\$381.00
_____ Hotel Room Lake View	\$315.00	\$401.00
_____ Hotel Suite Garden View	\$385.00	\$471.00
_____ Hotel Suite Lake View	\$415.00	\$501.00

Arrival date: _____

Departure date: _____

Check-In Time 4:00 p.m.

Check-Out Time 11:00 a.m.

Additional charges apply to above rates for more than 2 adults sharing a room. State and local taxes on the room, food, beverage and incidentals is 7%. Additionally, there is a 4% Warren County occupancy tax applicable to the room portion of the above rates.

Please Note: Hotel reservations can only be made by mail or fax using this form. Meeting registration form and fee(s) must accompany accommodations request.

PAYMENT INFORMATION

☐ Check or money order enclosed in the amount of \$ _____
(Make checks payable to **THE SAGAMORE.**)

☐ Charge \$ _____ to ☐ American Express ☐ MasterCard

☐ Visa Expiration date _____

Card number: _____

3-4 Digit Security Code on Back of Card _____

Authorized Signature _____

GROUP BOOKING CODE: ILP014

Intellectual Property Law Section

Fall Meeting

October 23 - 26, 2014

**The Sagamore Resort
Bolton Landing (Lake George), NY**

Cut-Off Date:

September 29, 2014

Reservations received after the above date will be accepted on a space and rate availability basis.

Children's Rates:

For each additional person (over two people) age 13 and up sharing a room, there will be an additional room charge of \$25.00 per person plus tax, per day. Meals for children age 17 and under will be á la carte except for group dinners - children must be registered for these using the meeting registration form.

Deposit Policy:

A credit card is required for all reservations. A non-refundable \$35.00 processing fee will be charged at the time of booking. At 14 days prior to arrival, the remaining balance due for the duration of guest's stay will be charged to credit card.

Cancellation Policy:

Cancellations and reservation changes must be made at least 14 days in advance of your arrival date. Guests will be responsible for payment of original reserved length of stay if changes are made less than 14 days prior to original reserved arrival date. \$35.00 processing fee will be incurred for reservations cancelled outside 14 days prior to arrival.

Please return this form with deposit information to:

Catheryn S. Teeter
Meetings Representative
New York State Bar Association
One Elk Street
Albany, New York 12207
Phone: 518-487-5573
Fax: 518-463-5993
cteeter@nysba.org



From the NYSBA Book Store



Entertainment Law

Fourth Edition



"The definitive text in the burgeoning field of entertainment law. It provides an in-depth analysis of the key issues currently confronting the practitioners of its various specialties. For both its breadth and depth, I highly recommend Entertainment Law to students, academics and professionals alike."

"This is a must for anyone who is seriously involved in the entertainment business."

EDITOR-IN-CHIEF

Howard Siegel, Esq.

PRODUCT INFO AND PRICES

2013 / 986 pp.,
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NYSBA Members	\$140
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***Discount good until October 31, 2014.**

Entertainment Law, Fourth Edition, updates and expands the coverage of the previous edition, including the historical changes in the music industry, and features a new chapter on Exhibitions.

Edited by Howard Siegel, Esq., this book's 10 chapters cover the principal areas of entertainment law, including the Recorded Music Industry, Music Publishing, Television, Film, Commercial Theater, Book Publishing, Minors' Contracts, Personal Management, and Exhibitions.

The authors, from the New York, California and Nevada Bars, are some of the most successful entertainment law practitioners in the country.

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Save the Dates! ***NYSBA 2015 Annual Meeting*** ***January 26-31, 2015***



Intellectual Property Law Section ***Annual Meeting/Reception/Luncheon*** ***Tuesday, January 27, 2015*** ***New York Hilton Midtown***

From the NYSBA Book Store >

Counseling Content Providers in the Digital Age

A Handbook for Lawyers

For as long as there have been printing presses, there have been accusations of libel, invasion of privacy, intellectual property infringements and a variety of other torts. Now that much of the content reaching the public is distributed over the Internet, television (including cable and satellite), radio and film as well as in print, the field of pre-publication review has become more complicated and more important. *Counseling Content Providers in the Digital Age* provides an overview of the issues content reviewers face repeatedly.

Counseling Content Providers in the Digital Age was written and edited by experienced media law attorneys from California and New York. This book is invaluable to anyone entering the field of pre-publication review as well as anyone responsible for vetting the content of their client's or their firm's Web site.

Table of Contents

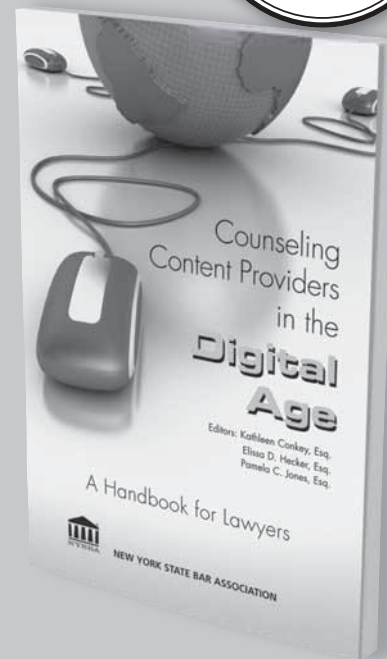
Introduction; Defamation; The Invasion of Privacy Torts; Right of Publicity; Other News-gathering Torts; Copyright Infringement; Trademark Infringement; Rights and Clearances; Errors and Omissions Insurance; Contracting with Minors; Television Standards and Practices; Reality Television Pranks and Sensitive Subject Matter; Miscellaneous Steps in Pre-Broadcast Review.

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PRODUCT INFO AND PRICES

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*Discount good until October 31, 2014.



MEMBERSHIP APPLICATION

New York State Bar Association

INTELLECTUAL PROPERTY LAW SECTION

Membership in the New York State Bar Association's Intellectual Property Law Section is a valuable way to:

- enhance professional skills;
- keep up-to-date with important developments in the legal profession;
- join colleagues in exciting Section events.

OPPORTUNITIES FOR EDUCATION

The Intellectual Property Law Section offers both the experienced and novice practitioner excellent opportunities to enhance their practical and legal knowledge and expertise. Through Section activities, including conferences on intellectual property (an annual Winter event), members may examine vital legal developments in intellectual property law. The Section's Web site provides current information regarding Section events and offers "members only" access to current issues of *Bright Ideas* and current Committee bulletins providing updates on intellectual property law. The Section sponsors continuing legal education (CLE) credit-bearing programs for Section members at reduced rates. Recent programs offered by the Section related to computer software and biotechnology protection, conducting intellectual property audits, and practical considerations in trade secret law. Now, with Mandatory Continuing Legal Education (MCLE) requirements, Intellectual Property Law Section membership is more valuable than ever before! The Section also sponsors joint programs with Law Schools including an annual writing contest for law students wherein the winning articles appear in an issue of *Bright Ideas*.

OPPORTUNITIES FOR PROFESSIONAL DEVELOPMENT

Intellectual Property Law Section committees address unique issues facing attorneys, the profession and the public. The Section offers opportunities to serve on committees such as Copyright Law; Diversity Initiative; Ethics; Greentech; International IP Law; Internet & Technology Law; Legislative/Amicus; Litigation; Patent Law; Pro Bono and Public Interest; Trademark Law; Trade Secrets; Transactional Law; and Young Lawyers.

Committees allow you to network with other attorneys from across the state and give you the opportunity to research issues and influence the laws that can affect your practice. Committees are also an outstanding way to achieve professional development and recognition. Law students are automatically members of the Young Lawyers Committee. Section members may join more than one committee.

A VOICE IN THE ASSOCIATION

The Intellectual Property Law Section takes positions on major professional issues that affect practitioners and advocates those positions within the New York State Bar Association, the legislature, and the public.

See page 37 to become a member of the Intellectual Property Law Section

COMMITTEE ASSIGNMENT REQUEST

Please designate, from the list below, those committees in which you wish to participate. For a list of Committee Chairs and their e-mail addresses, please refer to pages 34-35 of this issue.

- | | |
|---|--|
| ___ Advertising Law (IPS3000) | ___ Litigation (IPS2500) |
| ___ Copyright Law (IPS1100) | ___ Membership (IPS1040) |
| ___ Diversity Initiative (IPS2400) | ___ Patent Law (IPS1300) |
| ___ Ethics (IPS2600) | ___ Pro Bono and Public Interest (IPS2700) |
| ___ Greentech (IPS2800) | ___ Trademark Law (IPS1600) |
| ___ In-House Initiative (IPS2900) | ___ Trade Secrets (IPS1500) |
| ___ International Intellectual Property Law (IPS2200) | ___ Transactional Law (IPS1400) |
| ___ Internet and Technology Law (IPS1800) | ___ Young Lawyers (IPS1700) |
| ___ Legislative/ Amicus (IPS2300) | |

Please e-mail your committee selection(s) to IntellectualProperty@nysba.org

* * *

To be eligible for membership in the Intellectual Property Law Section, you first **must** be a member of the NYSBA.

- ☐ As a member of the NYSBA, I enclose my payment of \$30 for Intellectual Property Law Section dues.
(Law student rate: \$15)
- ☐ I wish to become a member of the NYSBA and the Intellectual Property Law Section. I enclose both an Association and Section application with my payment.
- ☐ Please send me a NYSBA application. No payment is enclosed.

Name _____

Office _____

Office Address _____

Home Address _____

E-mail Address _____

Office Phone No. _____

Office Fax No. _____

Home Phone No. _____

Please return payment and application to:

Membership Department
New York State Bar Association
One Elk Street
Albany, New York 12207
Telephone: 518/487-5577
FAX: 518/487-5579
<http://www.nysba.org/membership>

Section Committees and Chairs

The Intellectual Property Law Section encourages members to participate in its programs and to contact the Section Officers or Committee Chairs for information.

Advertising Law

A. Cassidy Sehgal-Kolbet
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

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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

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joyce.creidy@thomsonreuters.com

Ethics

Rory J. Radding
Edwards Wildman Palmer LLP
750 Lexington Avenue
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RRadding@edwardswildman.com

Philip Furgang
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750 Lexington Avenue
New York, NY 10022
RRadding@edwardswildman.com

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

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Chehrazade_Chemcham@colpal.com

Sarah Crutcher Preuss
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Sarah.Preuss@viacom.com

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sujata@sc-ip.in

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

Internet and Technology Law

Richard L. Ravin
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115 West Century Rd
Paramus, NJ 07652
rick@ravin.com

Legislative/Amicus

Charles Eric Miller
Sills, Cummis & Gross, P.C.
30 Rockefeller Plaza
New York, NY 10112
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