Summary descriptions of the amicus briefs I helped author during 2018

By Robert M. Isackson
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For the Intellectual Property Owners Association:

Helsinn Healthcare S.A., v. Teva Pharms. (U.S.Case 17-1229)
IPO briefed whether, in enacting the America Invents Act (AIA), Congress changed the scope of the "on-sale" bar to patentability. IPO advocated that: 1) proper application of the post-AIA on-sale bar is critically important to all industries and fields of technology; 2) the post-AIA on-sale bar provision should be interpreted to exclude secret sales; 3) excluding secret sales is consistent with Congress' intent for the AIA to harmonize U.S. patent laws with other countries and; 4) the Federal Circuit decision is inconsistent with other interpretations of the on-sale bar. Leason Ellis attorneys participating include Matthew Kaufman, Lauren Sabol, and Robert Isackson. Read Helsinn Brief here

For the New York Intellectual Property Law Association

Return Mail, Inc. *v.* United States Postal Service, et al. (U.S. Case No. 17-1594)
NYIPLA briefed whether the government is a "person" who may, under the AIA (America Invents Act), petition the PTAB (Patent Trial and Appeal Board) of the U.S. Patent and Trademark Office to institute proceedings to challenge the patentability of a patent. Filed in support of neither party, NYIPLA advocated that "person" is used in the Patent Act to have different meanings, sometimes including government entities, and sometimes excluding them, and a uniform definition would be improper. Rather, because the enabling language of the AIA provisions regarding who can petition for inter partes, post-grant, and covered business method patent reviews and derivation proceedings differ, the Court needs to evaluate the meaning of "person" for each provision in its context. Consequenlty, the government may be a person for *inter partes* review but may not be a "person" for a covered business method review. NYIPLA also urged the Court not to make broad pronouncements about whether "person" includes or excludes the government, and further to issue only a narrow holding on the scope of "person" for covered business reviews under AIA § 18(a)(1)(B) (at issue in the case) and, if at all, for inter partes reviews and post grant reviews under 35 U.S.C. §§ 311(a) and 321(a) (not at issue in the case). Leason Ellis attorney participating includes Robert Isackson. Read Return Mail Brief here

Mission Product Holdings, Inc. v. Tempnology, LLC (U.S. Case No. 17-1657)
NYIPLA briefed whether, when a trademark owner licensor declares bankruptcy and, under §365 of the Bankruptcy Code, the trustee rejects a trademark license agreement, does that rejection constitute a breach of contract, 11 U.S.C. §365(g), and terminate rights of the trademark licensee that would survive the licensor's breach under applicable non-

bankruptcy law. Currently, there is a Circuit split with the First Circuit concluding that a debtor-licensor's rejection of a trademark license terminates a licensee's right to use a trademark and the Seventh Circuit concluding that the trademark licensee's rights are not extinguished. Filed in support of Petitioner, NYIPLA argued that the circuit split on this question should be resolved such that the well-established rules of statutory construction require that the rejection of an executory trademark licensing agreement under Section 365(g) does not result in its termination. As a result, notwithstanding the rejection, the licensee should be allowed to continue to use the licensed trademarks in accordance with the terms of the license post-rejection. NYIPLA also argued that this result does not raise any quality control concerns because a trademark owner is under an obligation to monitor and police the use of the trademark independent of any contractual provision to do so. Leason Ellis attorneys participating include Marty Schwimmer, Christine Sauerborn, and Robert Isackson. Read Mission Products Brief here

Russell Brammer v. Violent Hues Productions, Ltd. (4th Cir. Appeal No. 18-1763)
NYIPLA briefed the issue, in a copyright case, of the proper scope of fair use of a photo used without permission on a third-party website. The district court found that it was fair use to use a photograph of a neighborhood for "informational" purposes, i.e., providing information about the appearance of the neighborhood. Filed in support of neither party, NYIPLA advocated against an overly broad interpretation of the fair-use doctrine for published works. Specifically, the brief pointed out a number of errors in the the district court's fair use factor analysis, including conflating motivation with purpose to find the work transformative and ignoring whether the asserted purpose actually justified defendant's taking, improperly considering the importance of defendant's good faith in its analysis, and mischaracterizing expressive images as "facts." Leaon Ellis attorneys participating include Marty Schimmer, Lauren Emerson, Robert Isackson. Read Violent Hues Brief here

Syngenta Crop Protection, LLC v. Willowood, LLC. (Fed.Cir. Appeal No. 18-1614)
NYIPLA briefed two issues, one related to patent infringement under 35 U.S.C. 271(g) and the other addressing whether the Federal Insecticide Fungicide and Rodenticide Act ("FIFRA") precludes copyright protection for the required elements of pesticide labels as against the labels of me-too-registrants. Filed in support of neither party, NYIPLA advocated first, with respect to patent infringement, that it was improper for the district court to extend the divided-infringement holding of *Akamai Techs., Inc., v. Limelight Networks*, Inc., 797 F.3d 1020, 1022 (Fed. Cir. 2015) (en banc) (per curiam) to the 271(g) context, and second, with respect to the copyright issue, that it was error for the district court to hold that FIFRA was intended to enact a per se rule precluding copyright infringement for FIFRA-compliant labels. More specifically, NYIPLA argued that neither the district court nor the parties applied *Pom Wonderful v. Coca-Cola*, 134 S. Ct. 2228 (2014), which sets forth a method for resolving perceived conflicts between federal statutes, and indicated that both FIFRA and the Copyright Act can coexist. We used some really creative graphics to support the copyright argument. Leason Ellis attorneys participating include Mel Garner, Marty Schwimmer, Lauren Emerson, and Robert Isackson. Read Syngenta Brief here