

Highlights From the Intellectual Property Law Institute of the Lavender Law® Conference

Written By **Erica B. E. Rogers** (ebrogers@wardandsmith.com)

August 4, 2021



I recently attended the 2021 Lavender Law® Conference, a virtual event of social networking, on-demand programming, and live sessions hosted by The National LGBT Bar Association and Foundation. The final day of the three-day virtual event featured the Intellectual Property Law Institute - a "space for the leading legal minds involved with intellectual property law, as it pertains to the LGBTQ+ community, to share ideas and network."

The quality of the Intellectual Property Law Institute, the information shared, and the respect shared between presenters and participants were incredible. This article summarizes some of the key takeaways.

Two Important Legislative Updates

1. The Trademark Modernization Act (TMA)

The TMA was signed into law on December 27, 2020. Two key components of the TMA are:

- Challenging trademark registrations at the U.S. Patent and Trademark Office (USPTO).

David Gooder, Trademark Commissioner of the USPTO was the keynote speaker of the Intellectual Property Law Institute. Mr. Gooder shared that one of the key objectives of the USPTO was to boost trademark registration protection. With this "boost" comes the need to ensure accuracy and decluttering of the USPTO register, and new procedures to challenge trademark registrations will help ensure accuracy and decluttering of the USPTO register.

Next year, in implementing the TMA, we should see two such procedures: expungement and reexamination. Expungement challenges a registration on the ground that the mark has never been used with some or all of the goods or services identified in the registration. Reexamination challenges a registration on the ground that the mark was not in use at the time of the filing date of the application or the filing date of the amendment of use.

- Accelerating examination of applications at the USPTO.

The TMA proposes flexible time periods to respond to refusals from the USPTO (called an "Office Action"). Now, all Office Actions have a deadline in six (6) months. However, the USPTO could require a shorter time to respond, anywhere from two months to six months, which accelerates examination. The USPTO could also offer extensions with payment of fees. The USPTO is currently developing rules to change the response deadlines, and as discussed during the Institute, there is some pushback on those rules.

The final USPTO rules will go into effect December 27, 2021.

Read more here: [USPTO proposes new rules to implement the Trademark Modernization Act](#)

2. The Copyright Alternative in Small-Claims Enforcement (CASE) Act.

The Copyright Alternative in Small-Claims Enforcement (CASE) Act was also signed into law on December 27, 2020. The U.S. Copyright Office is developing the Copyright Claims Board (CCB), which will be a small claims court-type system for copyright owners to seek damages, capped at \$30,000.

The CASE Act provides another avenue to assess and award damages due to copyright violations. The process is voluntary – respondents (the alleged violators) have the option to opt out. However, given the significant challenge, time, and expense of federal litigation for copyright infringement claims, the idea of this system could be appealing to both copyright owners and alleged violators.

Read more here: [Copyright Small Claims and the Copyright Claims Board](#)

Expect more information from Ward and Smith on the TMA and CASE Act when the USPTO rules are made final and when the CCB begins hearing claims.

COVID-19 Era and Intellectual Property Law

The Intellectual Property Law Institute facilitated a fascinating conversation on intellectual property and the creation and distribution of vaccines during the COVID-19 era. The tension between intellectual property rights and fair access to vaccines means a tension between business incentives and ethics. The group discussed potential waivers of IP rights or compulsory licensing as a potential solution and the need for governments and companies to work together going forward. The quality of the presenters, Ross Allen and Angela Lim, and the quality of the questions asked, made this session particularly thought-provoking. The panel was moderated by David Tsai.

The members of the Institute switched gears to discuss how the COVID-19 era resulted in a significant boom to the online marketplace. With that boom comes an increase in online bad actors and infringement, though. The group discussed "dupe influencers," artificial intelligence, and non-fungible tokens (NFTs) – both relevant and innovative areas of the online marketplace that pose risks to brand owners. Flipping the discussions on how influencers, artificial intelligence, and NFTs can be used to the advantage of brand owners' was equally helpful. The key takeaway – brand owners and intellectual property practitioners need to keep up with the changes of, and challenges to, the digital brand landscape.

LGBTQ+ Sessions

The Lavender Law® Conference provided participants access to extensive and sophisticated on-demand programming in a wide variety of legal areas. In addition to the Intellectual Property Law Institute, I attended a session on LGBTQ+ leadership in law firms and a session on better lawyering through mindfulness – both reminders of what challenges and successes exist within the LGBTQ+ and ally legal community.

I would like to extend my sincere appreciation to the planners, moderators, and speakers of this year's 2021 Lavender Law Conference®, particularly the Intellectual Property Institute, and Winterfeldt IP Group. I look forward to next year's event.

--

© 2024 Ward and Smith, P.A. For further information regarding the issues described above, please contact Erica B. E. Rogers.

This article is not intended to give, and should not be relied upon for, legal advice in any particular circumstance or fact situation. No action should be taken in reliance upon the information contained in this article without obtaining the advice of an attorney.

We are your established legal network with offices in Asheville, Greenville, New Bern, Raleigh, and Wilmington, NC.