THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

BULLETIN

Volume 37 | September/October 1996 | Nu mber 1

PRESIDENT'S CORNER

At this writing, there is a plethora of intellectual property legislation before Congress. What items may or may not have been considered or passed before Congress adjourns for the election, obviously, can't be determined. Among the pending Bills are those to establish the USPTO as a Government corporation; set an 18 month time for publication of U. S. patent applications; extension of the 20 year term for patents; granting of prior user rights; protection of the public from invention promoters; expanded patent reexamination; limitation of granting of patents on medical procedures; imposition of criminal penalties for theft of trade secrets; and market power presumption from the ownership of intellectual property.

It is far beyond the scope of this column to consider each of these items, but I would like to focus on only one, which is not mentioned in the prior list, the funding of the Patent and Trademark Office.

It has been stated that if the United States did not have a patent system, one would have to be developed. Many economic studies and reports point out that the existence of the patent system is, truly, one of the engines which drives our economy. The incentive which the existence of a patent provides to industrial entities, and industrial entities-to-be, has created many jobs and, indeed, even industries.

Some years ago, Congress determined that the Patent Office should be made self-sufficient by setting the user fees at such a rate that independent funding by the Federal Government would not be necessary. Over the course of years, the fees have been increased several times to reflect changes in the cost of living. Of course, this meant that inventors, or their corporate employers or sponsors, were paying for various services made available to the public at large, such as the research capabilities provided by the public search room.

Notwithstanding the decision to make the Patent and Trademark Office self-supporting, the user fees do not go directly to the USPTO. Rather, they are collected by the Treasury Department and then returned to the United States Patent and Trademark Office in whatever amounts Congress has authorized.

With the various spending reduction acts, Congress has seen fit to take some of the user fees and use them to fund programs which have nothing to do with intellectual property, much less the more narrow scope of the operations of the United States Patent and Trademark Office. For example, a recently passed House Bill has diverted over 54 million dollars of the money which the United States Patent and Trademark Office will collect to be used for the Legal Services Corporation, public broadcasting, and various unspecified government programs.

In my view, this is unconscionable, in effect placing a tax on inventors for services which Congress deems to be for the public good. This diversion of funds also acts to prevent certain necessary and desirable expansions of the Patent Office, or improvements in services.

While some of the national associations have taken a position against this "skimming," there is the belief that Senators and Representatives might be more responsive to complaints from their own constituents. I will be recommending to our Board that we take a position on this issue, and I urge each of you, as individuals, to contact your own Representatives and Senators on this point.

– Martin E. Goldstein

CALENDAR OF EVENTS

October 23-24, 1996	International Intellectual Property Association (IIPA) Annual Meeting, The Willard Inter-Continental Hotel, Washington, DC
October 25, 1996	NYIPLA Luncheon Meeting "Markman Hearing" Speaker: Tom Creel, Yale Club, New York City
October 24-26, 1996	American Intellectual Property Law Association, Annual Meeting, J.W. Mariott Hotel, Washington, DC
November 22, 1996	NYIPLA Luncheon Meeting "View from the Bench" Judge Ward, SDNY, Yale Club, New York City

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■

NEWS FROM THE BOARD OF DIRECTORS

by John F. Sweeney

The Board of Directors met at The Yale Club on Thursday, September 12, 1996. Martin Goldstein presided. Greg Battersby presented the Treasurer's Report. He reported that the Association's balance is greater than this time last year. Upon motion by Howard Barnaby, the Treasurer's Report was approved.

Alice Brennan raised the possibility of the Association accepting voluntary contributions. She reported that approximately thirty percent of the members of the City Bar Association make voluntary contributions and also that approximately three percent of the members of the Association of Corporate Secretaries make voluntary contributions. Ms. Brennan noted that before the Association could accept voluntary contributions, it would have to be determined what the funds would be used for, e.g., charitable purposes, educational purposes, etc. The Board agreed to consider the possibility of such contributions at a future meeting.

John Olivo reported on simplifying the membership application procedure. The new application procedure will not require a proposer. The application forms will be made available at meetings and functions of the Association. Susan McHale raised the possibility of using the ABA list as a way of attracting members. Edward Vassallo suggested that faculty members could be contacted at law schools to facilitate applications for membership by students.

Both William Gilbreth and Frank Ford have recently retired from the practice of law. Mr. Goldstein informed the Board that Mr. Gilbreth and Mr. Ford, both former Presidents of the Association, have requested consideration for election as life members of the New York Intellectual Property Law Association under Article III, Section 3. Upon motion of Mr. Battersby, Messrs. Gilbreth and Ford were elected to life membership in the Association.

The possible removal of the Committee on Education from the standing committees of the Association was raised by Mr. Goldstein. Herbert Schwartz suggested that this could be deferred until a full evaluation of the committee structure could be made. A committee, including Tom Creel, Marilyn Brogan and Jerry Dainow, and chaired by Mr. Schwartz, was established to investigate the committee structure.

Mr. Goldstein noted that it has been reported that some $54 million in United States Patent and Trademark Office fees have been siphoned off to fund items having nothing to do with intellectual property. He raised the issue of whether the Association should write to Congress as a group to protest the siphoning off of fees. Thomas Spath expressed the view that the Association should make such a submission to Congress. Upon motion of Mr. Spath, Mr. Goldstein was authorized to send a letter of protest to Congress on behalf of the Association, and Bill Brunet was appointed to work out a joint plan of action with the AIPLA and ABA.

Howard Barnaby reported that Professor Hugh Hanson of Fordham University was planning to attend the WIPO meeting in Geneva in December 1996. The Board agreed to appoint Professor Hanson as the representative for the Association at the December meeting. Mr. Goldstein will write to the WIPO to advise of Professor Hanson's appointment.

Mr. Goldstein and Brian Poissant observed that a major malpractice insurance provider, AIG, will be going out of the intellectual property law business by the end of the year. Meyer Gross, chairman of the committee for economic affairs, was appointed to investigate recent developments in the malpractice insurance area and to report.

Committee reports were then made by the Chairs of the following committees: Admissions; Alternative Dispute Resolution; Continuing Legal Education; Consonance and Harmonization; Copyrights; Design Protection; Economic Matters; Foreign Trademark Law and Practice; Harmonization; License to Practice; Litigation Practice and Procedure; Meetings and Forums; Public Information and Education; U.S. Trademark Law and Practice and Trade Secret Law and Practice. Upon motion by Mr. Battersby, the meeting was adjourned.

■

NAPP SCHEDULES FIRST ANNUAL MEETING

The National Association of Patent Practitioners (NAPP) is having its first annual meeting, amidst the scenic fall foliage in Williamsburg, Virginia, at the George Washington Inn and Conference Center. The meeting will run from Sunday, October 20 - Tuesday, October 22, 1996. Practical topics to make patent prosecution easier, and more cost-effective, will be handled in a seminar atmosphere which encourages lively, but voluntary, audience participation. These topics will benefit patent agents, patent attorneys and those involved in developing or licensing technology. For example, Karen Bovard, Director of USPTO Office of Enrollment and Discipline will speak on Patent Practice Ethics, and Janice Howell, Director of Patent Examining Group 2500 will speak on Patent Office Reengineering. Also, speakers will teach successful PCT practice for beginners and intermediates, how to build a patent practice, how to use the Internet, and other practical topics. A trade show for vendors to the patent industry will also run during this meeting. CLE credit has been requested

and the meeting fee is extremely reasonable. For the meeting agenda, visit NAPP's home page at http://www.napp.org, for registration information or information on the Trade Show contract: Joy Bryant by phone at (800) 216-9588, by fax at (757) 874-6278 or on the Internet at NAPP @ norfolk.infi.net. ■

THE LIGHTER SIDE OF THE BAR

The following "transquips" were included in the Canonical List of Lawyer Jokes on the Internet:

Q: Mrs. Jones, is your appearance this morning pursuant to a deposition notice which I sent to your attorney?
A: No. This is how I dress when I go to work.

* * *

Q: When he said, had you gone and had she, if she wanted to and were able, for the time being excluding all the restraints on her not to go, gone also, would he have brought you, meaning you and she, with him to the station?
Mr. Brooks: Objection. That question should be taken out and shot.

* * *

Q: And lastly, Gary, all your responses must be oral. Okay? What school do you go to?
A: Oral.
Q: How old are you?
A: Oral.

* * *

Q: Were you acquainted with the deceased?
A: Yes, sir.
Q: Before or after he died?

* * *

Q: Now, Mrs. Johnson, how was your first marriage terminated?
A: By death.
Q: And by whose death was it terminated?

* * *

Q: Doctor, how many autopsies have you performed on dead people?
A: All of my autopsies have been performed on dead people.

* * *

Q: Did he pick the dog up by the dog's ears?
A: No.
Q: What was he doing with the dog's ears?
A: Picking them up in the air.
Q: Where was the dog at this time?
A: Attached to the ears.

* * *

Q: Could you see him from where you were standing?
A: I could see his head.
Q: Just where was his head?
A: Just above his shoulders.

* * *

Q: . . . any suggestions as to what prevented this from being a murder trial instead of an attempted murder trial?
A: The victim lived.

* * *

Q: Are you qualified to give a urine sample?
A: Yes, I have been since early childhood.

* * *

Q: (Showing man picture). That's you?
A: Yes, sir.
Q: And you were present when the picture was taken, right? ■

FEDERAL CIRCUIT BAR ASSOCIATION NEW YORK MEETING

The Federal Circuit Bar Association will hold a New York regional meeting in conjunction with the Customs and International Trade Bar Association on November 20 at the Harvard Club, 27 West 44th Street (between 5th and 6th Avenues), New York, New York. Judges of the United States Court of Appeals for the Federal Circuit, United States Court of International Trade and United States District Court for the Southern District of New York along with prominent members of the New York bar will participate in the meeting.

The meeting will kick-off at noon with a luncheon and address by Judge Randall R. Rader of the Federal Circuit. Two panel discussions will follow. One panel will address the Federal Circuit's application of various standards of review to the many types of cases falling within its jurisdiction. The panel will be moderated by David H.T. Kane of Kane, Dalsimer, Sullivan, Kurucz, Levy, Eisele & Richard and currently includes Judge Rader of the Federal Circuit, Judges Gregory W. Carman and Thomas J. Aquiline, Jr. of the Court of International Trade, Richard W. Clary of Cravath Swaine & Moore and Patrick D. Gill of Rode & Qualey.

The other panel will address the practical effects of *Markman v. Westview Instr. Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (in banc), *aff'd*, 116 S. Ct, 1384 (1996) on discovery, trial and appeal in patent cases. The panel will be moderated by Douglas W. Wyatt of Wyatt, Gerber, Burke & Badie and currently includes Judge Rader, Judge Miriam G. Cedarbaum of the Southern District, John F. Sweeney of Morgan & Finnegan and Leora Ben-Ami of Rogers & Wells.

For more information about the program call Mark Abate at Morgan & Finnegan (212) 758-4800. ■

FEDERAL CIRCUIT BAR ASSOCIATION NEW YORK REGIONAL MEETING *REGISTRATION FORM*

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MEETINGS COMMITTEE ANNOUNCES LUNCHEON SCHEDULE

The NYIPLA Committee on Meetings and Forums recently announced the topics for the 1996-1997 luncheon schedule. The dates, topics and speakers are as follows:

- October 25, 1996 "Markman Hearing" Speaker: Tom Creel
- November 22, 1996 "View from the Bench" Speaker: Judge Ward (S.D.N.Y.)
- December 13, 1996 "Appellate Arguments" Speaker: Nancy J. Linck, PTO Solicitor
- January 17, 1997 "Internet Licensing" Speaker: Liz Blumenfeld (America Online)
- February 21, 1996 "Trademarks"
- March 28, 1997 "Trademarks" Speaker: Judge Rice, TTAB
- April 25, 1997 "Design Patents" Speaker: Perry J. Saidman
- May 23, 1997 "CAFC Practice" Speaker: Judge Newman, CAFC

All NYIPLA luncheon meetings are held at the Yale Club in New York City. For more information on attending, contact Susan McHale, Chair, Committee on Meetings and Forums. ■

RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

PATENTS

Claim Interpretation

In *Vitronics Corporation v. Conceptronics, Inc.*, 1996 U.S. App. Lexis 18587 (Fed. Cir. 1996), the Court of Appeal for the Federal Circuit reversed the trial court's decision of noninfringement which was based on an improper claim interpretation. The Federal Circuit found that ambiguities in a claim term could be resolved by an analysis of intrinsic evidence. Therefore, the trial court's reliance on extrinsic evidence was improper.

The parties disputed the meaning of the claim term "solder reflow temperature." In support of their respective claim constructions, the parties discussed the patent specification, expert testimony, prior testimony and writings of the defendant and its employees, and technical references.

The Federal Circuit held that the meaning of the disputed claim term was clear from a review of the specification. The Federal Circuit's interpretation of the term was inconsistent with the trial court's interpretation. According to the Federal Circuit:

> Since the claim, read in light of the patent specification, clearly uses the term "solder reflow temperature" to mean the peak reflow temperature, rather than the liquidus temperature, *that should have been the end of the trial court's analysis.* Only if there were still some genuine ambiguity in the claims, after consideration of all available intrinsic evidence, should the trial court have resorted to extrinsic evidence, such as expert testimony, in order to construe claim 1. Moreover, even if the judge permissibly decided to hear all the possible evidence before construing the claim, *the expert testimony, which was inconsistent with the specification and file history, should have been accorded no weight." Id.* at 20-21 (footnote omitted) (emphasis added).

The Court later stated that the trial court would not be in error if it relied on the expert testimony and other extrinsic evidence solely to help it understand the underlying technology. But the Court cautioned that other expert testimony:

> may only be relied upon if the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms. *Such instances will rarely, if ever, occur.* . . . Even in those rare instances, prior art documents and dictionaries, although to a lesser extent, are more objective and reliable guides. Unlike expert testimony, these sources are accessible to the public in advance of litigation. They are to be preferred over opinion testimony, whether by an attorney or artisan in the field of technology to which the patent is directed. Indeed, *opinion testimony on claim construction should be treated with utmost caution,* for it is no better than opinion testimony in the meaning of statutory terms." *Id.* at 25-26 (emphasis added).

Accordingly, the court reversed the judgment of noninfringement and rewarded the case for further proceedings consistent with the Federal Circuit opinion.

Means-Plus-Function Interpretation

In *I. Melbourne Greenberg, M.D. v. Ethicon Endo-Surgery, Inc.*, 1996 U.S. App. LEXIS 20109 (Fed. Cir. 1996), the CAFC discussed whether using the phrase "detent mechanism" required the use of "means-plus-function" interpretation. The Court held that while the use of the term "means" generally invokes section 112(6), in this case the use of a different formulation did not.

Often a surgeon needs to operate under conditions which make it undesirable or impossible to make large openings in the patient's body. A common problem with the surgical instruments utilized in the necessarily small openings is manipulating the cutting end of the instrument. U.S. Patent 4,674,501 ('501) addresses this problem through the use of a "detent mechanism" which holds the instrument shaft in a set position relative to a swiveling blade at the cutting end. Dr. Greenberg, inventor of the '501 patent, filed suit against Ethicon, claiming that Ethicon had made and sold a number of devices that infringed the '501 patent. Following discovery, Ethicon moved for, and was granted, summary judgment based primarily on the "detent mechanism" element of claim 1 of the '501 patent.

The district court concluded that the claim element containing the term "detent mechanism" set forth a means for performing a specified function and thus was subject to the provisions of 35 U.S.C. § 112, paragraph six (hereafter, 112(6)). Accordingly, the claim element was construed to cover only the corresponding structures described in the specification and equivalents thereof. Because the court concluded that the Ethicon devices utilized a detent means not described in the '501 specification, Ethicon's motion for summary judgment was granted.

The district court gave two principal reasons to support its ruling. First, the district court concluded that "detent mechanism" in itself invoked 112(6) because the term did not describe a particular structure but described any structure that performed a detent function. On appeal the Court disagreed with this reason, holding that a particular mechanism may be defined in functional terms (i.e., clamp, screwdriver, lock, or brake) without converting the element into a 112(6) "means for performing a specified function." The second basis of the district court's conclusion was that the summary of the '501 patent twice used "detent means" when referring to the detent. The Court also rejected this argument on appeal. A review of the patent language showed that the drafter of the patent used the word "means" throughout the '501 summary to refer in shorthand to each of the key structural elements of the invention.

The Federal Circuit was careful to point out that the triggering of section 112(6) does not *necessarily* require the word "means;" however, the use of the word "means" has come to be so closely associated with "means-plus-function" claiming that the use of the term "means" *generally* invokes section 112(6). Generally, the use of a different formulation of "means" *does not* invoke section 112(6). The Court then held that "detent mechanism" could not result in a section 112(6) interpretation. Accordingly, the Court vacated the district court's summary judgment to Ethicon and remanded the case for further proceedings. ■

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Connecticut Intellectual Property and Entertainment boutique with fun practice seeks associate with 1-3 years experience. Must be self-starter with demonstrable record of independent achievement. Trademark and litigation experience preferred. Send resumé and writing sample to Grimes & Battersby, P.O. Box 1311, Stamford, CT 06904-1311.

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White Plains, NY law firm seeks attorneys with chemical and mechanical expertise and 5 years minimum experience. Law firm background with clientele following preferable for fast track to partnership. Respond in confidence to: Charles Rodman, Rodman & Rodman, 7 South Broadway, White Plains, NY 10601 or fax information to (914) 993-0668.

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The New York Intellectual Property Law Association, Inc.
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September/October 1996
Volume 37 Number 1

The BULLETIN is published periodically for the members of The New York Intellectual Property Law Association. Annual Non-Member Subscription is $15.00/yr. Single copies $2.00. Correspondence may be directed to the Bulletin Editor, Gregory J. Battersby, P.O. Box 1311, Three Landmark Square, Stamford, CT 06904-1311. Telephone No. (203) 324-2828.