

NYIPLA

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Bulletin

In This Issue

Article:

New PTO Rules.... 1,3-7

President's Corner 2

Calendar of Events 7

Article: The Federal Circuit's In re Seagate Decision and Its Impact.....

8-12

Historian's Corner 13

CLE Program:

Big Questions in Recent IP Cases.....

14

News From the Board

15

New

Members 16



New PTO Rules on Continuing Applications and Claim Examination Practice: Learning to Count to 2 (+1 RCE) and 5/25

By Charles R. Macedo and Marion P. Metelski¹

On August 21, 2007, the U.S. Patent and Trademark Office (the “PTO”) published a final rule revising its rules of practice relating to continuing applications, requests for continued prosecution, and examination of claims (the “Final Rule”). See 72 Fed. Reg. 46,715 (Aug. 21, 2007) (to be codified at 37 C.F.R. pt. 1). The stated purpose of the Final Rule is to provide “a better focused and effective examination process” to reduce the extensive backlog of patent applications at the PTO and to improve the quality of issued patents. *Id.* at 46,717. The Final Rule limits the number of continuing applications that can be filed as of right, as well as the number of claims that an application can include before the applicant must conduct a prior art search and provide the PTO with a substantial amount of additional information concerning the application. The stated effective date of the Final Rule is November 1, 2007, and its provisions will apply to nonprovisional applications (including national stage applications) filed on or after that date. However, certain provisions of the Final Rule will apply to applications that are pending as of November 1, 2007.

The Final Rule is the subject of extensive controversy and much consternation to patent applicants and their

attorneys and agents. The day after the Final Rule was published, a lawsuit was filed seeking to block its implementation on the grounds that its issuance is beyond the PTO’s rulemaking authority and violates the U.S. Constitution.²

This article summarizes some key provisions of the Final Rule.

Current Continuing Application Practice

Under the current statutory framework, a later filed application can claim the benefit of the filing date of an earlier filed application (commonly known as a “parent” application)—either in whole (referred to as a “continuation” application) or in part (referred to as a “continuation-in-part” or “CIP” applications)—as long as certain requirements are met. The parent application and the later filed application (e.g., continuation or CIP application) must have at least one inventor in common. The parent application and the later filed application must have a common disclosure, at least in part. The later filed application must be filed while the parent application is pending. Finally, the later filed application must contain a specific reference to the parent application. 35 U.S.C. § 120. If the benefit of the filing date of the parent application is properly claimed, then

cont. on page 3

September 10, 2007

Dear Fellow NYIPLA Members:

It is a great pleasure and a genuine honor that I write my first letter to you as President of our Association. After the NYIPLA concluded a highly successful 2006 - 2007 year, I am very enthused to tell you about the impressive and exciting events in store for the 2007 - 2008 year.

By the time this letter will have been published in the Bulletin, many of you will have participated in many of the impressive programs provided by The Intellectual Property Owners Association ("IPO") during its Annual Meeting which was held in New York City this year. Your Association participated as a co-sponsor of the IPO event.

In October, the Court of Appeals for the Federal Circuit will be visiting New York City to hold three days of oral argument at various court houses and law schools. The Court's visit coincides with its 25th Anniversary and your Association has been working at a feverish pace to serve as the principal host for the various functions and events to commemorate the Court's visit and Anniversary. It is indeed an honor for the NYIPLA to assume this responsibility.

Looking further down the road, the Association is working on plans for many of its traditional activities and functions – from the Fall One-Day CLE Program to our monthly CLE luncheons to the Annual Dinner in Honor of the Federal Judiciary – and much more.

Finally, I urge all of you to consider participating in many of our active committees. Please consult the Association website to select one of our committees, which are listed below.

We are off to an excellent year and I look forward to great participation by the membership.

Sincerely,

Christopher A. Hughes
President



The 2007 – 2008 Committees are as follows:

- Alternative Dispute Resolution
- Antitrust, Inequitable Conduct and Misuse
- Continuing Legal Education
- Copyrights
- Design Protection
- International IP Law
- Internet Law
- Legislative Oversight and Amicus Briefs
- License to Practice Requirements
- Litigation Practice and Procedure
- Meetings and Forums
- Membership
- Patent Law and Practice
- Public and Judicial Personnel and Int'l Relations
- Public Information, Education and Awards
- Publications
- Trade Secret Law and Practice
- Trademark Law and Practice
- Young Lawyers Committee

To join one or more of these committees, please complete online the committee preference form, located at http://www.nyipla.org/member/committee_choice.cfm.

any art that is published or becomes publicly available after the filing date of the earlier application, but before the filing date of the later application, is not available as prior art against the later application.

As an alternative to filing a continuation application, applicants often choose to respond to a final Office Action in an application by filing a request for continued examination (“RCE”). See 37 C.F.R. 1.114. Under this procedure, upon the timely filing of a submission by the applicant (e.g., an information disclosure statement, an amendment, a new argument, or new evidence), the PTO will withdraw the final Office Action and will enter and consider the submission.

Each issued patent should include claims to only one invention. Cf. 35 U.S.C. § 101. If the claims in a patent application are directed to more than one invention, the PTO can issue a restriction requirement, which compels an applicant to elect only one invention, and its corresponding set of claims, to be the focus of the prosecution of that application. 35 U.S.C. § 121; 37 C.F.R. 1.142. The applicant may file additional patent applications, called “divisional” applications, to seek allowance of claims that were not elected in the earlier application (once again commonly referred to as the “parent” application). 35 U.S.C. § 121. In order to obtain the benefit of the filing date of the parent application, the divisional application must satisfy the same requirements outlined above for continuation and CIP applications. 35 U.S.C. §§ 120-21.

Under current PTO practice, an applicant is entitled to submit as many claims as he desires in a patent application. If the applicant submits more than 3 independent claims or 20 total claims for examination in an application, the applicant must pay additional filing fees. 37 C.F.R. 1.16(b)-(c).

The rule changes included in the Final Rule add additional limitations on how many continuation and continuation-in-part applications, and how many RCEs, can be filed by an applicant as of right. The rule changes also restrict when it is appropriate to file a divisional application. Finally, the rule changes impose a limit on how many claims can and will be considered by the PTO during examination of a patent application.

Changes to Practice for Continued Examination Filings

Under the Final Rule, 37 C.F.R. 1.78(d) provides that an applicant may, as a matter of right, file two continuing applications, as defined in 37 C.F.R. 1.78(a)(1), from an initially filed nonprovisional patent applica-

tion. A continuing application may be a continuation application or a CIP application, which are respectively defined in 37 C.F.R. 1.78(a)(3) and 1.78(a)(4). The initially filed patent application and its continuation and CIP applications constitute an “application family.” 72 Fed. Reg. at 46,716. In addition to the two continuing applications, an applicant may, as a matter of right, file one RCE in an application family. 37 C.F.R. 1.114(f).

Any additional continuations, CIPs, or RCEs that are “filed to obtain consideration of an amendment, argument, or evidence that could not have been submitted during the prosecution of the prior-filed application” must be accompanied by a petition, a fee, and “a showing that the amendment, argument, or evidence sought to be entered could not have been submitted during the prosecution of the prior-filed application.” 37 C.F.R. 1.78(d)(1)(vi). The petition must be filed within four months of the actual filing date of the continuing application or, if the continuing application is entering the national stage in the U.S. from a PCT application, four months from the date the continuing application enters the national stage. *Id.*

Under the Final Rule, an applicant may only file a divisional application, which is defined in 37 C.F.R. 1.78(a)(2), of an initially filed application if the initially filed application is subject to a restriction requirement. 37 C.F.R. 1.78(d)(1)(ii)(A). The filing of the divisional application is subject only to the copendency requirement of 35 U.S.C. § 120, i.e., the divisional application does not need to be filed during the pendency of the application that is subject to the restriction requirement. 37 C.F.R. 1.78(d)(ii). Any divisional application that is not filed in response to a restriction requirement (i.e., a “voluntary” divisional) will be treated as continuation application. See 37 C.F.R. 1.78(d)(1)(ii)(A); 72 Fed. Reg. at 46,720.

An applicant may, as a matter of right, file two continuation applications, in addition to one RCE, in the application family of the divisional application. 37 C.F.R. 1.78(d)(1)(iii); 37 C.F.R. 1.114(f)(2). A continuation of a divisional application can only disclose and claim the invention or inventions that were disclosed and claimed in the divisional application. 37 C.F.R. 1.78(d)(1)(iii)(B). One cannot file a CIP of a divisional application. 37 C.F.R. 1.78(d)(1)(iii); 72 Fed. Reg. at 46,732.

If the patent application contains claims drawn to more than one invention, the applicant may submit a suggested restriction requirement (“SRR”). 37 C.F.R.

1.142(c). The applicant must file the SRR before the examiner issues a restriction requirement or a first Office Action on the merits, whichever comes first. *Id.* The SRR must include an election, without traverse, of one of the inventions, and an identification of the claims that correspond to that invention. *Id.* The number of elected claims cannot exceed five independent claims and twenty-five total claims. *Id.*

Applicants should exercise care when filing divisional applications when the Final Rule takes effect. In the event that a restriction requirement is withdrawn in an application, any divisional application of that application would be improper. *See* 37 C.F.R. 1.78(a)(2), 1.78(d)(1)(ii); *see also* PTO presentation slide set entitled Claims and Continuations Final Rule, Slide 48, available at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ccfrslides.ppt>. In addition, any reinstatement or rejoinder of the non-elected claims in the application may result in greater than five independent claims and greater than twenty-five total claims, the consequence of which are discussed in the next section of this article.

The provisions of the Final Rule relating to the filing of continuing applications are only applicable to any applications (including continuing applications) that are nonprovisional or national stage applications filed on or after November 1, 2007. Thus, any third or subsequent continuing application filed on or after November 1, 2007 must include a petition and a showing as to why the filing of the continuing application is justified. 37 C.F.R. 1.78(d)(1)(vi). If, however, the third or subsequent continuing application filed on or after November 1, 2007 claims the benefit of the filing date of nonprovisional applications filed before August 21, 2007, or PCT applications that entered the national stage in the U.S. before August 21, 2007, and there are no intervening continuing applications filed after August 21, 2007, then a petition and showing is not required for that third or subsequent continuing application. 72 Fed. Reg. at 46,716-17.

In other words, for nonprovisional applications or national stage applications that are pending on August 21, 2007, the applicant is entitled to file a single (i.e., “one more,” not “an extra”) continuation or CIP application of such pending application as a matter of right, regardless of the number of continuation or CIP applications of such pending application had been previously filed, so long as no continuation or CIP application of such pending application has been filed between

August 21, 2007 and November 1, 2007. 72 Fed. Reg. at 46,736-37.

The provisions of the Final Rule relating to RCEs will apply to any pending application in which a second or subsequent RCE is filed after November 1, 2007. 72 Fed. Reg. at 46,717. Unlike the provisions of the Final Rule relating to the filing of continuation and CIP applications on or after November 1, 2007, there is no provision in the Final Rule permitting the filing of “one more” RCE as a matter of right on or after November 1, 2007.

Changes to Practice for Examination of Claims in Patent Applications

Under the Final Rule, an applicant must file an “examination support document” for any nonprovisional application that contains, or is amended to contain, more than five independent claims or more than twenty-five total claims. 37 C.F.R. 1.75(b)(1).³ The examination support document must be filed prior to the issuance of the first Office Action on the merits, and must cover all of the claims of the application, i.e., both independent and dependent claims. *Id.* (The requirements of a dependent claim are provided in 37 C.F.R. 1.75(b).) If the nonprovisional application has more than five independent claims or more than twenty-five total claims, and an examination support document has not been filed prior to the issuance of the first Office Action on the merits, the applicant may be able to submit an examination support document. *See* 37 C.F.R. 1.75(b)(3). Otherwise, the applicant will be required to cancel claims from the application. *See* 37 C.F.R. 1.75(b)(1).

If a nonprovisional application contains a claim that is patentably indistinct from at least one claim in one or more other pending nonprovisional applications, and all of these applications are commonly owned, or are subject to an obligation of assignment to the same person, then the PTO will aggregate the claims of each application and treat them as though they were present in each application for purposes of 37 C.F.R. 1.75(b). 37 C.F.R. 1.75(b)(4).

The requirements for the examination support document are provided in 37 C.F.R. 1.265:

(1) The document must include a statement that a preexamination search was performed. The statement must include the date of the search and an identification of the field of search by U.S. class and subclass. If an online database search was performed, the statement must identify the names of the database service, the databases that were searched, and the search terms

that were used. 37 C.F.R. 1.265(a)(1). The applicant must search issued U.S. patents, published U.S. patent applications, foreign patent documents, and non-patent literature, unless the applicant includes in the statement a justification “with reasonable certainty that no references more pertinent than those already identified are likely to be found” in the category of prior art that the applicant has not searched. 37 C.F.R. 1.265(b).

(2) The document must include a listing of the references that the applicant believes are “most closely related” to the subject matter of each claim (i.e., independent and dependent). 37 C.F.R. 1.265(a)(2),-(c). A reference is most closely related to the subject matter of an independent claim if it discloses the greatest number of limitations recited in that independent claim, or if it discloses a limitation recited in the independent claim that is not disclosed in any other reference. *See* PTO presentation slide set entitled Claims and Continuations Final Rule, Slide 81, *available at* <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ccfrslides.ppt>. A reference is most closely related to the subject matter of a dependent claim if it discloses a limitation recited in the dependent claim that is not disclosed in any other reference. *Id.*

For each of these references, the applicant must identify all of the limitations of each claim (i.e., independent and dependent) that are disclosed by the reference. 37 C.F.R. 1.265(a)(3). “Small entities,” as defined in the Regulatory Flexibility Act, 5 U.S.C. § 601, are exempt from this requirement. 37 C.F.R. 1.265(f); *see also* PTO presentation slide set entitled Claims and Continuations Final Rule, Slide 91, *available at* <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ccfrslides.ppt>. The applicant and his representative should be aware that a small entity for purposes of paying reduced patent fees under 37 C.F.R. 1.27 is not necessarily a small entity for purposes of the examination support document under 37 C.F.R. 1.265(f). *See* PTO presentation slide set entitled Claims and Continuations Final Rule, Slide 91, *available at* <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/ccfrslides.ppt>.⁴

(3) The document must include a detailed explanation of why each independent claim is patentable over each of the listed references. 37 C.F.R. 1.265(a)(4).

(4) The document must include a showing as to where each limitation of each claim (i.e., independent and dependent) finds support under 35 U.S.C. § 112, ¶ 1, in the written description of the specification of the

instant application, as well as, if applicable, the written description of the specification of any application to which the instant application claims priority or the benefit of the earlier filing date under Title 35 of the U.S. Code. 37 C.F.R. 1.265(a)(5).

If an examination support document is required, but the examiner deems the document or the underlying prior art search to be insufficient, or if, due to claim amendments, all of the pending claims are no longer accounted for in the examination support document, then the applicant will have a non-extendable period of two months after receiving a related notification from the PTO to either file a revised or supplemental examination support document or cancel claims such that the remaining claims contain no more than five independent claims and no more than twenty-five total claims in total. 37 C.F.R. 1.265(e).

The provisions of the Final Rule relating to the number of claims in an application and the examination support document will apply retroactively to those nonprovisional applications (including national stage applications) filed before November 1, 2007 in which a first Office Action on the merits was not mailed before November 1, 2007. 72 Fed. Reg. at 46,716.

Changes To Practice For Patent Applications Containing Patentably Indistinct Claims

The Final Rule also include provisions that prevent applicants from filing multiple applications that are based on the same disclosure and contain patentably indistinct claims in an attempt to get around the Final Rule’s limitations on the number of claims that can be included in the same application. Under the Final Rule, for a nonprovisional application that has not been allowed, the applicant must identify other pending applications or patents that:

(1) have a claimed filing date or priority date that is the same as, or within two months of, the claimed filing or priority date of the application (37 C.F.R. 1.78(f)(1)(i)(A));

(2) have at least one common inventor (37 C.F.R. 1.78(f)(1)(i)(B)); and

(3) are commonly owned, or are subject to an obligation of assignment to the same person (37 C.F.R. 1.78(f)(1)(i)(C)).

The applicant must provide this identification within the later of:

(1) four months from the actual filing date for a non-provisional application filed under 35 U.S.C. § 111(a) (37 C.F.R. 1.78(f)(1)(ii)(A));

(2) four months from the date on which a PCT application enters the national stage in the U.S. under 35 U.S.C. § 371(b) or (f) (37 C.F.R. 1.78(f)(1)(ii)(B)); or

(3) two months from the mailing date of the initial filing receipt in the other application that needs to be identified under 37 C.F.R. 1.78(f)(1)(i) (37 C.F.R. 1.78(f)(1)(ii)(C)).

The requirements of 37 C.F.R. 1.78(f) do not vitiate the applicant's duty to inform the examiner of other applications that, despite having a claimed filing or priority date that is not within two months of the claimed filing or priority date of the instant application, are nonetheless material to the patentability of the instant application. 72 Fed. Reg. at 46,721-22.

Under 37 C.F.R. 1.78(f)(2)(i), the PTO will presume that a nonprovisional application and another pending nonprovisional application or patent have patentably indistinct claims if the nonprovisional application and the other nonprovisional application or patent:

(1) have the same claimed filing or priority date (37 C.F.R. 1.78(f)(2)(i)(A));

(2) have a common inventor (37 C.F.R. 1.78(f)(2)(i)(B));

(3) are commonly owned, or are subject to an obligation of assignment to the same person (37 C.F.R.

1.78(f)(2)(i)(C)); and

(4) have "substantial overlapping disclosures." 37 C.F.R. 1.78(f)(2)(i)(D). This occurs when the written description of the other nonprovisional application or patent supports at least one claim of the nonprovisional application. *Id.*

The applicant may rebut this presumption by explaining how the claims are patentably distinct. 37 C.F.R. 1.78(f)(2)(ii)(A). Otherwise, the applicant must file a terminal disclaimer(s), and must explain why there are multiple applications that have patentably indistinct claims. 37 C.F.R. 1.78(f)(2)(ii)(B). The applicant must act within the later of:

(1) four months from the actual filing date for a nonprovisional application filed under 35 U.S.C. § 111(a) (37 C.F.R. 1.78(f)(2)(iii)(A));

(2) four months from the date on which a PCT application enters the national stage in the U.S. under 35 U.S.C. § 371(b) or (f) (37 C.F.R. 1.78(f)(2)(iii)(B));

(3) the date on which a patentably indistinct claim is presented in the nonprovisional application (37 C.F.R. 1.78(f)(2)(iii)(C)); or

(4) two months from the mailing date of the initial filing receipt in the other nonprovisional application or patent (37 C.F.R. 1.78(f)(2)(iii)(C)).

These changes to 37 C.F.R. 1.78(f)(1) and 37 C.F.R. 1.78(f)(2) will apply to all nonprovisional applications that are pending on November 1, 2007, or filed thereafter. *See* 72 Fed. Reg. 46,717. For those applications filed prior to November 1, 2007, applicants will have until February 1, 2008 to comply with 37 C.F.R. 1.78(f)(1) and (f)(2). *Id.*

If the PTO is not satisfied with the applicant's explanation as to why multiple applications have patentably indistinct claims, it may require the applicant to cancel the patentably indistinct claims from all but one of the applications. 37 C.F.R. 1.78(f)(3).

The time periods specified in 37 C.F.R. 1.78 are not extendable. *See* 37 C.F.R. 1.78(i).

Changes in PTO Practice Relating to Making Second Office Actions Final

In addition to the more widely discussed provisions of the Final Rule relating to the filing continuing applications and to claim examination, the PTO also changed its practice relating to making second or later Office Actions final.

Under the Final Rule, an examiner may make a second or later Office Action final if it includes a new

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ground of rejection based on double patenting (whether of the statutory or obviousness-type variety). 72 Fed. Reg. at 46,722. This change in PTO practice is based on the PTO's view that the applicant is responsible for helping to resolve double patenting situations because the applicant is in the best position to know whether he has other applications or patents that contain patentably indistinct claims. *Id.*

A second or later Office Action may be made final if it includes a new ground of rejection that was necessitated by the applicant's showing that its claims should be examined under 35 U.S.C. § 112, ¶ 6, even though the claim language does not include the phrase "means for" or "step for." 72 Fed. Reg. at 46,722-23.

The Final Rule requires the applicant to identify those claims in a continuation-in-part application that are supported by the disclosure of the prior-filed (i.e., parent) application under 35 U.S.C. § 112, ¶ 1. 37 C.F.R. 1.78(d)(3). A second or later Office Action may be made final even if it includes a new ground of rejection based on prior art if the rejection was necessitated by the applicant's identification of those claims in a continuation-in-part application that are supported by the disclosure of the prior-filed (i.e., parent) application under 35 U.S.C. § 112, ¶ 1. 72 Fed. Reg. at 46,723.

A second or later Office Action may be made final if it includes a new ground of rejection that was necessitated by the applicant's amendment of the claims, even if the claim amendments eliminate unpatentable alternatives. 72 Fed. Reg. at 46,723.

Finally, under the Final Rule, a second or later Office Action may be made final if it includes a new ground of rejection based on information submitted in an information disclosure statement that is filed during the time period set forth in 37 C.F.R. 1.97(c) (i.e., after the first Office Action but before the close of prosecution, whether by a final Office Action, notice of allowance, or otherwise). 72 Fed. Reg. at 46,723.

Conclusions

Although the Final Rule is, for now, being challenged, Applicants and Patent Practitioners alike must prepare to comply with the new rule changes that the PTO is implementing. It can be anticipated that the rule changes will impose an increased cost and burden on applicants as they prepare and prosecute their patent applications. The rule changes will result in more, and more extensive, patent searches being conducted, with a resulting increase costs to the applicant. They will also require applicants to provide additional, detailed information regarding their inventions to the PTO. The more restrictive continuation and RCE procedures that the PTO is implementing are likely to increase the number of appeals to the Board of Patent Appeals and Interferences, which may result in even longer delays in issuing patents. Only time will tell whether the Final Rule and the resulting rule changes will achieve the PTO's stated objectives.

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² See *Tafas v. Dudas et al.*, No. 07 Civ. 846 (E.D. Va. filed Aug. 22, 2007).

³ Under the terms of the Final Rule, the examination support document appears to be comparable to the accelerated examination support document that is currently required to obtain accelerated examination of an application under the rules the PTO implemented last year. See 37 C.F.R. 1.102(d); MANUAL OF PATENT EXAMINING PROCEDURE § 708.02(a) (8th ed., rev. 5, Aug. 2006).

⁴ A "small entity" is defined in the PTO rules to be a person (e.g., an independent inventor), a small business concern, or a nonprofit organization. 37 C.F.R. 1.27(a); MANUAL OF PATENT EXAMINING PROCEDURE § 509.02 (8th ed., rev. 5, Aug. 2006). A small business concern is a company that has no more than 500 employees. 13 C.F.R. 121.802. In order to retain its status, a small entity cannot transfer its rights in an invention to a party that does not qualify as a small entity. 37 C.F.R. 1.27(a).

NYIPLA CALENDAR

Save the Dates:

Friday, November 16, 2007
CLE Fall One-Day Program
Princeton/Columbia/NYU Club
15 West 43rd Street
New York, NY

Friday, March 28, 2008
The 86th Annual Dinner
in Honor of the
Federal Judiciary

In re Seagate: The Federal Circuit Scuttles Underwater Devices and Narrows Privilege/Immunity Waiver

By Susan M. Gerber and John Evans¹

The Federal Circuit's recently issued *en banc* decision in *In re Seagate Technology* (Fed. Cir. Aug. 20, 2007) overruled the court's previous standard for finding willful infringement, eliminated the previous affirmative duty to exercise due care to avoid infringing activity, and replaced it with a heightened standard of objective recklessness. Further, recognizing the significant role that opinions of counsel almost always play in the willfulness analysis, the Federal Circuit also took the opportunity to clarify the scope of the waiver for attorney-client privileged communications and work product when an accused infringer elects to rely upon its opinions of counsel to defeat an allegation of willful infringement. This decision marks a substantial departure from the Federal Circuit's willfulness jurisprudence of nearly 25 years. Setting a new standard creates a clean slate for litigants and judges alike to design new proofs.

A. Holdings of *In re Seagate*

On some issues, the Federal Circuit's unanimous *en banc* decision is clear. The court explicitly overruled its previous decision in *Underwater Devices v. Morrison-Knudsen Co.* (1983) and held that "proof of willful infringement permitting enhanced damages requires at least a showing of objective recklessness." The court also emphasized that there is no affirmative obligation to obtain an opinion of counsel to avoid allegations of willful infringement.

Relying on a number of nonpatent decisions from the United States Supreme Court, the Federal Circuit provided some guidance as to the meaning of "objective recklessness," although it left development of the standard to future cases:

[T]he civil law generally calls a person reckless who *acts in the face of an unjustifiably high risk of harm that is either known or so obvious that it should be known*. Accordingly, to establish willful infringement, a patentee must show by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its

actions constituted infringement of a valid patent. The state of mind of the accused infringer is not relevant to this objective inquiry. If this threshold objective standard is satisfied, the patentee *must also demonstrate that this objectively-defined risk . . . was either known or so obvious that it should have been known to the accused infringer*. We leave it to future cases to further develop the application of this standard (emphasis added; internal citations and punctuation omitted).

The court also clarified that if an accused infringer elects to waive the attorney-client privilege and work-product immunity to rely on the advice-of-counsel defense, the scope of the waiver will not extend to privileged communications between the client and trial counsel. As to the waiver of work product, the court held that "as a general proposition, relying on opinion counsel's work product does not waive work product immunity with respect to trial counsel."

Thus, this decision fundamentally affects the law concerning willful infringement and the attorney-client privilege. First, in order to prove willfulness, a patentee must show (by clear and convincing evidence) (1) that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent, and (2) that the infringer knew or should have known about this objectively defined risk. Second, accused infringers can now rely on the advice-of-counsel defense without fear of triggering a broad waiver of attorney-client communications involving trial counsel and without fear that trial counsel's work product will necessarily be disclosed (although, as is always the case, factual work product may be discoverable upon the requisite showing of good cause).

B. Background

Section 284 of the Patent Act permits patentees to recover enhanced damages for infringement, but the statute does not give any guidance for determin-

ing when enhanced damages are appropriate. That determination has been left to the discretion of the courts, and the Federal Circuit has held that one such basis for awarding enhanced damages is a finding of willful infringement.

Nearly 25 years ago, in *Underwater Devices*, the Federal Circuit set the standard for willful infringement, imposing an affirmative duty to exercise due care to determine whether or not one is infringing. That affirmative duty included, among other things, the duty to seek and obtain competent legal advice from counsel before engaging in a potentially infringing activity, if the accused infringer had had “actual notice of another’s patent rights.” Because of this affirmative duty, it became common practice for patent owners to send a potential defendant a “charge letter” in an effort to put them on notice of the patent rights and trigger this duty of care. The recipient of such a letter would typically seek an opinion letter from counsel so that, if sued, the advice-of-counsel defense could be invoked to rebut any charge of willful infringement.

In asserting the defense, these accused infringers immediately encountered problems because the advice-of-counsel defense, and its attendant subject-matter waiver, clashed with the principles of protecting attorney-client privileged communications. Courts would not allow parties to use attorney-client privilege as both “a sword and a shield,” selectively disclosing favorable information while claiming privilege as to unfavorable information. Consequently, accused infringers often faced a Catch-22: either forgo the advice-of-counsel defense and maintain attorney-client privilege and work-product immunity, or invoke the defense but risk exposure of potentially damaging communications. Indeed, because the adverse consequences of a willful-infringement verdict were so severe (potentially trebled damages as well as attorney fees), accused infringers were under great pressure to waive the privilege and introduce opinions of counsel at trial.

If an accused infringer decided not to invoke the advice-of-counsel defense, it then risked an adverse-inference jury instruction until the Federal Circuit struck down that practice in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.* (2004). Moreover, because the boundaries as to the scope of the waiver remained unsettled for many years, invoking the advice-of-counsel defense could result

in broad and unpredictable disclosures of privileged and protected information, going far beyond the accused infringer’s response to the charge letter. After years of avoiding that issue, the Federal Circuit finally addressed the scope of the waiver in *In re EchoStar Communication Corp.* (2006). There, the court held that the accused infringer not only waived the attorney-client privilege as to in-house counsel, but also waived the attorney-client privilege and work-product immunity for all related information, except for work product never communicated to those relying on the legal advice.

EchoStar, however, did not specifically address the advice-of-counsel defense as applied to trial counsel’s communications and work product. In the absence of clear guidance from the Federal Circuit, trial courts split over the proper scope of the waiver with respect to trial counsel. Some refused to extend the waiver to trial counsel’s communications; others did extend the waiver, but only for those communications that would undermine the advice-of-counsel defense. A third viewpoint extended the waiver to all trial counsel materials.

It is against this legal backdrop that Convolve, Inc., and its coplaintiff, the Massachusetts Institute of Technology, sued Seagate, alleging infringement of two patents and later adding a third. Before the lawsuit, Seagate had hired independent counsel, separate from Convolve’s trial counsel, to provide three opinions regarding Convolve’s patents. These opinions concluded that many of the asserted claims were invalid, that one patent was potentially unenforceable, and that Seagate’s products did not infringe.

In accordance with the trial court’s scheduling order, Seagate gave notice of its intention to invoke the advice-of-counsel defense at trial. Seagate disclosed all of its opinion counsel’s work product and made its opinion counsel available for deposition. Convolve then moved to compel discovery of any relevant communications with and work product of Seagate’s other counsel, including its trial counsel. The trial court concluded that because Seagate had waived the attorney-client privilege, it would be compelled to produce all communications concerning the opinions with any counsel, including in-house and trial counsel. The trial court ordered an *in camera* review of certain documents to prevent disclosure of trial strategy but stated that even those communications would be disclosed if they contained advice that undermined the reasonable-

cont. on page 10

ness of Seagate's reliance on the opinions. Lastly, the trial court ruled that work product communicated to Seagate was not immune from discovery.

In light of the district court's order, Convolv demanded production of Seagate's *trial* counsel opinions relating to infringement, validity and enforceability of the patents and noticed *trial* counsel for deposition. Seagate requested a stay and certification of an interlocutory appeal to seek relief from the discovery orders, which the trial court denied. Out of other options, Seagate petitioned the Federal Circuit for a writ of mandamus to stop the broad compulsory disclosure of its privileged communications with its trial counsel.

The Federal Circuit stayed discovery and *sua sponte* ordered *en banc* review of the petition. Ultimately, the court granted Seagate's writ of mandamus, holding that the trial court's determination of the scope of waiver was an abuse of discretion. The Federal Circuit did not limit its decision to the discrete discovery issue presented, but instead took the opportunity to revamp the standard for willful infringement and to opine upon the proper reach of the waiver if an accused infringer elects to rely on its opinions of counsel. It justified its decision to reach the question of the proper legal standard by "recognizing the functional relationship between our willfulness jurisprudence and the practical dilemmas faced in the areas of attorney-client privilege and work-product protection."

C. Objective Recklessness: The New Standard for Willful Infringement

In reaching its ultimate conclusion that the proper standard for finding willful infringement is recklessness, the Federal Circuit looked to other circuits and the Supreme Court for guidance. The fact that the court declined to cite its own precedent in support of its primary conclusion is evidence of this decision's substantial departure from 25 years of established Federal Circuit precedent. (The *Seagate* decision's heavy reliance upon Supreme Court authority is atypical of previous Federal Circuit decisions and may reflect a tacit acknowledgment of the unusually active role the Supreme Court has taken to shape the contours of patent law in recent years.)

Not only did the Federal Circuit look to different courts for guidance, it looked beyond patent law. For example, the court cited copyright cases, noting

that other circuits employ a recklessness standard for enhancing statutory damages for "willful" copyright infringement and recognizing that the Supreme Court had drawn parallels between copyright law and patent law in several of its recent decisions. The court also looked to the Supreme Court's recent interpretation of "willful" behavior in *Safeco Insurance Co. of America v. Burr* (2007), which concluded that the standard usage of the term "willful" includes recklessness in the context of the Fair Credit Reporting Act.

The court sharply contrasted its standard for willfulness in *Underwater Devices* with these precedents and concluded that the old standard, which was "more akin to negligence," was inconsistent and should be overruled. In place of the old standard, the court promulgated a new, two-part test for willful infringement. First, under the new test, a patentee must show that "the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent." The court noted that "[t]he state of mind of the accused infringer is not relevant to this objective inquiry." Second, if the objective threshold is met, the patentee must also demonstrate that the accused infringer knew or should have known of this objectively defined risk. The Federal Circuit declined to develop the test further, but rather "le[ft] it to future cases to further develop the application of this standard."

This portion of the court's decision inspired two separate concurrences. Judge Newman wrote a separate opinion emphasizing her view of the "objective standards" that potential infringers should use to evaluate potentially adverse patents. According to Judge Newman, these standards "should be the fair standards of commerce, including reasonableness of the actions taken in the particular circumstances." Judge Gajarsa's opinion, joined by Judge Newman, argued that, absent support in statutory language, the court should discontinue reading a "willful infringement" standard into Section 284.

D. Scope of the Waiver of Attorney-Client Privilege

In defining the scope of the privilege waiver, the Federal Circuit rejected the district court's broad decision that compelled disclosure of communications with trial counsel; instead, it "conclude[d] that the significantly different functions of trial counsel and opinion counsel advise[d] against extending

waiver to trial counsel.” Opinion counsel, the court reasoned, provides an objective assessment to businesses for making informed business decisions. Trial counsel’s role, on the other hand, focuses on litigation strategy and developing the most successful way to present a case to a court. These divergent roles weigh against broad subject-matter waiver, because fears of “sword and shield” gamesmanship do not arise where the only communications sought to be introduced come from opinion counsel.

The adversarial system is better served by protecting communications between an accused infringer and its trial counsel. For this reason, then, the court further found that “communications of trial counsel have little, if any, relevance warranting their disclosure, and this further supports generally shielding trial counsel from the waiver stemming from an advice-of-counsel defense to willfulness.” The court based this conclusion on the assumption that enhanced damages for willful infringement ordinarily depend on an accused infringer’s pre-litigation conduct. To support this assumption, the court reasoned that if an accused infringer’s post-filing conduct were reckless, a patentee could move for a preliminary injunction as a remedy for that willful infringement. If the accused infringer could defeat a preliminary injunction by demonstrating a substantial question of the patent’s validity or infringement, then it follows that the infringement cannot be willful. Indeed, the court went so far as to suggest that “[a] patentee who does not attempt to stop an accused infringer’s activities in this manner should not be allowed to accrue enhanced damages based solely on the infringer’s post-filing conduct.”

In the end, the court held that asserting the advice-of-counsel defense and disclosing communications with *opinion* counsel does not waive the attorney-client privilege for communications with *trial* counsel, at least under most circumstances. The rule is not absolute; trial courts have the discretion to extend the waiver to trial counsel in unique circumstances, such as, in the words of the Federal Circuit, if a party or counsel engages in “chicanery.”

E. Work-Product Immunity

Generally speaking, the work-product immunity provides a lesser degree of protection from disclosure than the attorney-client privilege. Even absent waiver, both facts and trial counsel’s thoughts and

mental processes are potentially discoverable upon a sufficient showing of need and hardship, although the latter is available only in the rarest of circumstances. Like the attorney-client privilege, however, work-product immunity can be waived, though that waiver is likely to be narrow in scope.

The Federal Circuit concluded that reliance on opinion counsel’s work product does not waive work-product immunity with respect to trial counsel, absent unique circumstances such as if a patentee or its counsel engages in chicanery. Further, whether or not there has been a waiver, the general discoverability principles applicable to work product remain in force—facts may be discoverable upon a sufficient showing of need and hardship, with a higher standard applicable to trial counsel’s thoughts and mental processes.

F. What’s Next?

In the face of this departure from longstanding precedent, both patent holders and accused infringers alike must carefully consider the consequences of the Federal Circuit’s decision in *In re Seagate*. First, trial courts will have to handle the substantive implications of this decision. Has the Federal Circuit eliminated enhanced damages for anything other than the most egregious cases of willful infringement with this new, objective recklessness standard? Are patentees required to seek a preliminary injunction in order to recover enhanced damages for post-suit willful infringement? If so, how will that requirement affect conventional litigation and enforcement strategies? With the elimination of the affirmative duty of care, are there circumstances that will constitute “notice” such that an accused infringer

cont. on page 12

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cont. from page 11

should consider obtaining an opinion of counsel? Will obtaining an opinion still be advisable upon notice, or will that be unnecessary—or even inadvisable? And is sending a charge letter still a good idea for patent owners, or will it just expose the patent owner to the risk of a declaratory judgment action under the Federal Circuit’s current interpretation of *MedImmune v. Genentech*?

Second, trial courts will have to determine how this new two-part test is supposed to work. Is the accused infringer’s intent relevant to the second prong of the test announced in *Seagate*? Are opinions of counsel helpful or not? Is the testimony of opinion counsel relevant to the inquiry? Will there be more summary judgments of nonwillfulness based on the objective threshold inquiry?

Third, as trial courts “further develop the application of this standard,” where will those courts look for guidance? Is regional circuit precedent, Supreme Court precedent, or Federal Circuit law more applicable? For example, will courts continue to apply the *Read v. Portec* factors in evaluating willfulness, or will that list of factors need to be revised? Because this decision calls into question the continued precedential value of almost all Federal Circuit law on the issue of willfulness, future litigants will have to ask which law should be cited in support of their positions, and why.

Finally, there is no question that patent issues are generating a tremendous amount of interest in the Supreme Court, and it has not hesitated to chart

a course in the direction it sees fit. But is there something deeper driving these decisions? See, for example, *MercExchange v. eBay* (rejecting the mandatory injunction); *MedImmune v. Genentech* (allowing licensees to bring a patent challenge without breaching the licensing agreement); *KSR v. Teleflex* (removing rigid application of the TSM test); and *In re Seagate* (raising the standard for willful infringement). Do these decisions evidence an underlying attitude toward restricting patent rights? Or are they simply the product of the continuing efforts of the judiciary to maintain a proper balance of the competing interests while staying true to the statutory framework enacted by Congress?

G. Conclusion

As a result of the Federal Circuit’s decision in *In re Seagate*, patentees, accused infringers, their counsel, and the courts now find themselves in the same boat, sailing on virtually uncharted waters. Patentees seeking enhanced damages may be tacking into stiffer wind in light of the new recklessness standard. For accused infringers, the advice-of-counsel defense may now be invoked with less risk. Rather than facing the choice between a broad waiver of attorney-client privilege and work-product protection or forgoing the defense altogether, accused infringers can now rest reasonably assured that their communications with trial counsel will remain privileged and trial counsel’s work product will remain immune, under most circumstances.

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to the IP bar.

Please direct

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by e-mail to:

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“As Time Goes By - Re-tuning Patent Reform at the Fork in the Road”

by Dale Carlson

Yogi Berra once observed “when you come to a fork in the road... take it.” It seems that we may have come to a fork in the road, so to speak, as far as efforts to change the patent system are concerned.

During the last few months, proposed legislation has been introduced into Congress that would, if enacted, dramatically alter the legislative landscape for patents. The proposed legislation was introduced against a back-drop of recent rulings from the Supreme Court that have dramatically altered the judicial landscape for patents.

Some critics say that the 1952 Patents Act is outmoded. Perhaps ironically, critics made that charge back in 1964 - only a dozen years after the legislation was enacted. As is the case now, back then our country was experiencing a “technological explosion”, resulting in a mounting backlog of patent applications that in percentage terms mirrors the backlog that the patent office is currently experiencing.

A patent reform proposal being considered in 1964, presumably as an alternative to hiring more patent examiners, was so-called “deferred examination” whereby some patent applications would effectively be put in “limbo” for a period of time, thus reducing the backlog.

Paul Rose, a co-author of the 1952 Act, questioned the motivation behind the proposal. He offered advice as to how to distinguish a good patent reform proposal from a bad one. He said: “We should be thinking in terms of operating our system to increase its incentive force, rather than in terms of how we can amend it so as to operate it more cheaply and easily.”

Query: do the current reform proposals in Congress serve to enhance the patent system by



increasing its incentive force; or are they primarily intended to make the system operate more cheaply

Dale Carlson, a partner at Wiggin & Dana, serves as the NYIPLA Historian, and as a member of the Board of Directors.

and easily? The answer to this question may be found in the opening salvo of a July 19, 2007 Wall Street Journal squib entitled “Broad Patent-Law Overhaul Wins House Panel’s Backing”: “The House Judiciary Committee passed a sweeping overhaul of U.S. patent laws, a move long sought by technology companies eager to streamline the process and reduce the costs of patent-infringement lawsuits”.

Sadly, it is not clear that the “incentive force” value of patents is foremost in the minds of the proponents of the reform legislation now; nor was it back in 1964 according to Mr. Rose.

The fate of the 1964 reform initiative is instructive. We don’t have a deferred examination system to this day. Even so, the “parade of horrors” propounded by reform proponents then, including one predicting that the Patent Office would collapse under its own weight without streamlining of the patent examination process, didn’t materialize. Instead, the Patent Office has survived and thrived.

Moreover, the U.S. economy has continued to flourish, despite the absence of any “sweeping” changes to the 1952 Act. Perhaps the 1952 Act is more resilient than some would lead us to believe.

Nonetheless, recent Supreme Court decisions raise the specter of tougher times ahead for our patent system. The Ebay decision calls into question the patentee’s entitlement to a permanent injunction. The KSR decision calls into question the validity of all patents issuing prior to the time of that decision.

The likely consequence of these decisions may be unintended ones, inasmuch as the decisions increase the level of uncertainty about the strength and value of patents. One is hard-pressed to believe that uncertainty is a good thing for the patent system, or a good thing for our clients having a need to know the value of the patents they have, or would like to have.

Our Association needs to rise to the challenge posed by the recent case law developments and patent reform initiatives. With the echoes of our Amicus Brief submission in KSR still ringing in our ears, there is one thing that is certain. Our Association’s voice, albeit sometimes a lone one, can be heard. We can only hope that it will be heard, and heard in time to keep the current “golden age of patent law” from becoming a dim memory. ■

April 20, 2007 CLE Luncheon Program

Topic: Big Questions in Recent IP Cases

On April 20, 2007, the NYIPLA hosted a CLE luncheon program at the Princeton/Columbia Club to examine the topic of “Big Questions in Recent IP Cases.” The speakers at this program included: Thomas Creel, past-President of the NYIPLA and Partner at Goodwin Procter LLP in New York; William G. Jenks, Associate Solicitor at the U.S. Patent and Trademark Office; and Nicholas Groombridge, Partner at Weil, Gotshal & Manges LLP in New York, and co-chair of the firm’s Patent Litigation practice. The meeting was moderated by Peter G. Thurlow, Jones Day, LLP, Chairperson of the NYIPLA’s Meetings and Forums Committee.

The program began with Mr. Creel’s summary of the *In re Seagate Technologies* case. In this case, the U.S. Court of Appeals for the Federal Circuit ordered *en banc* review and set out the following three questions:

1. Should a party’s assertion of the advice of counsel defense to willful infringement extend waiver of the attorney-client privilege to communications with that party’s trial counsel? See *In re EchoStar Commc’n Corp.*, 448 F.3d 1294 (Fed. Cir. 2006).
2. What is the effect of any such waiver on work-product immunity?
3. Given the impact of the statutory duty of care standard announced in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983), on the issue of waiver of attorney-client privilege, should this court reconsider the decision in *Underwater Devices* and the duty of care standard itself?

Mr. Creel discussed the scope of the waiver of the attorney-client privilege and work-product immunity. In doing so, Mr. Creel reviewed the cases leading up to *In re Seagate* including *Underwater Devices*, in which the Federal Circuit set the standard for willful infringement, imposing an affirmative duty to exercise due care to determine whether or not one is infringing a patent, and *In re EchoStar Communication Corp.* (Fed. Cir. 2006). In *Echostar*, the court held that an accused infringer not only waived the attorney-client privilege as to in-house counsel, but also waived the attorney-client privilege and work-product immunity for all related information, except for work product never communicated to those rely-

ing on the legal advice. Mr. Creel also discussed the positions of some of the amici submitted to date, the “duty of care” standard and proposed legislation in Congress re the standard for evaluating “willful” infringement.

Mr. Jenks discussed the *Amgen v. Hoechst* case and in particular, whether all aspects of a district court’s claim construction should be subject to *de novo* review or instead should the Federal Circuit review the factual determinations underlying a district court’s claim construction deferentially? Mr. Jenks also discussed whether the Federal Circuit effectively resurrected the categorical bar to a claim of infringement under the doctrine of equivalents that was expressly rejected in *Festo* and *Warner-Jenkinson* by restricting the ways in which a presumption of “prosecution history estoppel” may be rebutted, and engaging in *de novo* review of a district court’s determinations that the presumption has been rebutted? Mr. Jenks reviewed the U.S. Supreme Court’s possible grant of certiorari in this case, the government’s amicus brief and more generally, the Solicitor General’s Office role in this and other important patent cases.

Mr. Groombridge’s presentation focused on “The Aftermath of *MedImmune* and *eBay*: When Can You Sue and When Can You Get an Injunction.” In *MedImmune*, Mr. Groombridge pointed out that the question presented in the case was whether “the ‘actual controversy’ requirement of the Declaratory Judgment Act requires a patent licensee to terminate or be in breach of its license agreement before it can seek a declaratory judgment that the underlying patent is invalid, unenforceable, or not infringed.” The U.S. Supreme Court held, Mr. Groombridge noted, that “[a licensee] was not required, insofar as Article III is concerned, to break or terminate its license agreement before seeking a declaratory judgment in federal court that the underlying patent is invalid, unenforceable, or not infringed.” In *eBay*, Mr. Groombridge noted that the Supreme Court held that according to well-

established principles of equity, a plaintiff seeking a permanent injunction must satisfy the traditional four-factor test before a court may grant such relief. He also noted that the Supreme Court rejected the Federal Circuit’s general rule that a permanent injunction will issue once infringement and validity have been adjudged.



Left to Right: Nicholas Groombridge, Thomas Creel, William G. Jenks, and Peter G. Thurlow.

Meeting Of The Board Of Directors

MINUTES OF MAY 23, 2007 MEETING

The meeting of the Board of Directors was called to order at the Princeton/Columbia Club at 4:45 p.m. by President Christopher Hughes. Anthony Giaccio, Mark Abate, Dale Carlson, Theresa Gillis, Charles Hoffmann, Marylee Jenkins, Philip Shannon, W. Edward Bailey, Ronald Clayton, Thomas Meloro, Alexandra Urban, Anthony LoCicero, David Ryan, and Michael Isaacs from Star Consulting were present.

The minutes of the Board of Directors meeting held on May 8, 2007 were approved.

Christopher Hughes presented some opening remarks, including discussion of some upcoming events and activities for the 2007-2008 year. The Court of Appeals for the Federal Circuit will be sitting in New York for one full week this fall in October and the recollection was that the Court has not been present in New York since one of its predecessor courts, the CCPA, sat in New York twenty-five years ago. Mark Abate pointed out that the NYIPLA is to be the primary host.

During the week, appeals will be heard at the United States District Court for the Southern District of New York, New York University School of Law, the Court of International Trade, Fordham Law School and Columbia Law School.

It was suggested that the NYIPLA host a reception for the nine judges, perhaps at the Starlight Room at the Waldorf Astoria.

Members of the Board are to consider this possibility as well as developing other ideas for the week's activities for discussion at the next Board meeting.

Other events under consideration for the coming year are the CLE spring half day program and luncheon on Monday, June 18, 2007 at the Princeton/Columbia Club, the NYIPLA and IPO co-sponsorship of a program in September, the Judge's Dinner at the Waldorf Astoria for 2008 and the corresponding CLE program on that day, other programs are also in consideration including one in which a judge from the ITC will appear.

Christopher Hughes proposed that the Board meetings for the following year should be on a monthly basis as a lunch meeting on a Tuesday of each month. He will prepare a schedule of meetings for the forthcoming year for distribution to the members of the Board.

Theresa Gillis, as Treasurer, requested the approval of the transfer of \$500,000 from the checking to the money market account to improve the rate of return for the NYIPLA funds. She also requested approval of transfer of \$20,000 from the money market account to the checking account for payment of current disbursements for the association. Both proposals were approved by the Board.

The meeting was adjourned at 5:50 p.m.

The views expressed in the Bulletin are the views of the authors except where Board of Directors approval is expressly indicated.

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