

**NYIPLA<sup>®</sup>**

# Bulletin

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## Governor Cuomo's Address at the Judges' Dinner

*The highlight of the 88<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary was former New York Governor Mario Cuomo's address to the guests. Governor Cuomo opened his remarks with several amusing stories regarding his rise to national prominence. He then shifted the focus of his talk:*

There are a lot more stories I'd like to share with you, but I am under strict instructions from President Abate to remember that I'm all that stands between you and dinner and he expects me — in 20 minutes or so to talk usefully about (1) where the nation is today, (2) where we would like it to be, and (3) what we must do to get there.

Our nation is still in most ways the greatest in the world, with one of the largest economies and the most powerful military capacity. But we find ourselves confronted by an extraordinary number of significant challenges at home and abroad.

We face a badly wounded economy, extraordinary joblessness, the middle-class sliding downward, the poor growing in numbers, a healthcare system that costs too much and cures too little

with 47 million people who don't have insurance, an education system that leaves millions of young people without even a high school diploma, two wars which together have already cost us more than 5000 lives, three times as many seriously wounded Americans and the loss of over a trillion badly needed dollars, with the costs still mounting ... and a stifling deficit that concerns us — and some of our principal lenders — greatly.

To deal with all of this, our government has provided, and continues to provide, extraordinary assistance to banks, homeowners, major industries, states, citizens out-of-work, the elderly, the poor and the ill. We need that help, but more than all of that, in my opinion we need a fundamental change in the nature of our economy.

We became the world's largest and strongest economy by making

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Dear Fellow Members,

This month's column is my final as president of the NYIPLA. In this brief space, it will be impossible to thank all of the people who played such an important part in our mission, to summarize all of our tremendous accomplishments in the past year, and to express how meaningful and enjoyable it has been to serve as president. Together, we have made incredible strides in advancing the field of intellectual property, and I am proud of everything we have achieved.

Our largest event of the year, the 2010 Judges' Dinner, is now behind us and, by all measures, was extremely successful. Over 100 federal judges (including eight Federal Circuit judges) were in attendance and more than 113 firms participated this year. The keynote speaker, Governor Mario Cuomo, delighted the audience with homespun stories, political wit and lessons from the past that we should apply to ensure our nation's future. Judge Richard Linn received our Outstanding Public Service Award, focusing his remarks on a prior recipient, the past president and patron saint of the Association, Judge William C. Conner. The Judges' Dinner is a tremendous undertaking, the largest single event at the Waldorf each year, and we greatly appreciate the efforts of Michael Isaacs and his team at Star Consulting (the Executive Office of the Association) for making this event truly remarkable and special.

The Day of Dinner CLE program also was a great success. The program featured mock expert witness testimony in a patent damage case, followed by a panel discussion and critique of the direct and cross-examination. The participants included U.S. District Court judges Barbara Jones of the Southern District of New York and William Young of the District of Massachusetts, USPTO Deputy Director Sharon Barner, John Lane, Richard Rainey, Robert Krupka, Edward Vassallo and Annemarie Hassett.

I am proud to report that the Association will once again be awarding a diversity scholarship at our last event of the year, the Association's Annual Meeting in May. The scholarship will offset tuition costs for a qualified student who is interested in intellectual property law and who is attending Fordham law school. With the help of Edward Bailey, chair of the **Diversity Scholarship Committee**, the Association has started raising funds for this program. If you haven't already done so, please speak with Ed about making a donation.

A number of our committees have been very active this year, and I am grateful for the work of so many who made this year a success. Charles Miller and Daniel Archibald, members of the **Patent Law and Practice Committee** (chaired by Bruce DeRenzi), have prepared an article for publication in this bulletin.

Thanks to the efforts of the **Amicus Committee**, including Charles Weiss and John Hintz (co-chairs) and David Ryan (board liaison), the committee is preparing a draft brief for consideration by the Board in one case and is studying the possibility of filing briefs in two additional cases. The **Amicus Committee** was exceptionally active this year, filing briefs in eight cases.

The **CLE Committee** is busy planning the Spring Half-Day Trademark CLE Program, thanks to the efforts



of the co-chairs, Dorothy Auth and Richard Parke.

The **Corporate Practice Committee** has been very active this year as well. Co-Chairs Alexandra Urban and Susan McGahan enlivened this Committee with a series of meetings and teleconferences related to a host of issues affecting in-house counsel, such as patent prosecution and litigation benchmarking.

I am also proud to report that membership is up at the end of 2009 as well as in March 2010, which is greatly appreciated. Thanks are due to **Membership Committee** co-chairs Joseph DeGirolamo and Paul Bondor.

The Inventor of the Year and Conner Writing Competition Awards will be bestowed at the Annual Dinner on May 18. The Inventor of the Year, Dr. Eric Fossum, was announced at the Judges' Dinner. He is a truly worthy recipient. We are grateful to the **Inventor of the Year Committee** Chair Ira Levy and the committee members for their efforts in recognizing Dr. Fossum. We received over 30 papers for the Conner Writing Competition, which were reviewed and evaluated by the **Award Committee** and Committee Chair Maren Perry. Judge Barbara Jones of the Southern District of New York will present the Conner Writing Competition Award this year at the Annual Dinner.

Special thanks again to Stephen Quigley, Chair of the **Publications Committee**, for putting together this Bulletin and for publishing the Greenbook.

As my term as president of the NYIPLA draws to a close, I would like to thank you for all of your support and kindness over the past year. I am grateful for your many contributions to our organization's success, whether it was attending one of our industry events, participating in a committee or designing a CLE program. The NYIPLA and the greater New York intellectual property bar have been enriched by the effort of many, and I shall always appreciate your efforts.

I look forward to working with you in the future and wish you all the best. Thank you for your continued support of the NYIPLA and its mission.

Sincerely,  
Mark J. Abate

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things and selling them to our own population and to the rest of the world, and by lending to foreign buyers so that they could afford to purchase from us. Then, gradually, we began to lose our primacy as manufacturers, to nations that made things cheaper and in some cases better. This was allowed to happen in part because some of our leaders believed we could go from a technology-based exporting nation to a services-dependent consumption-based economy ... and still expect to remain the world's strongest economic hegemon. We tried it and wound up de-emphasizing technology and our manufacturing and becoming a debtor nation that buys much more than it sells. We need to return to what made us economically strong in the first place.

With that in mind I spent 12 years as Governor pushing the State of New York to excel in all kinds of high technology with Centers of Advanced Technology around the state. We reached out for and supported inventors, investors, manufacturers and merchants trying to build a base in computers, software, electronic products, imaging, high-speed fiber optic information pathways, ceramics and developing new age batteries. I believe that is the direction the nation needs now — with a distinct “Green” emphasis that would include making and selling turbines for wind farms, solar panels, clean coal and nuclear power plants. New York — as you probably know — has been an important nuclear power state for years. Now the rest of the nation should be as well.

How are we meeting these needs today? Not very well! Why not? To put it simply, the biggest problem has been that our elected officials have been stymied by inflexible ideology and a lack of collaboration instead of engaging in compromise and practical problem-solving.

I suspect lawyers may understand the problem better than most. In my early years as a lawyer I enjoyed the struggle called “litigation” immensely. After years of experience I concluded that relentless insistence on rigorous litigation is often not as effective and a lot more expensive than alternate dispute devices like mediation and arbitration. It's clear to me our political system needs collabora-

tion, cooperation and compromise even more than the legal system does. The lack of it is inexcusable because it is clear that we can achieve the political collaboration we need — especially with respect to our domestic economic and fiscal problems — if we try hard enough.

Our history proves it. Just think back to the year 2000 when we experienced great post-millennial progress. Technology was booming. We had just completed eight years of economic growth and the creation of 22 million new jobs. We had an ascending middle-class, fewer poor Americans, the best four years in our stock market's history, a balanced federal budget and a projected surplus of — hold your breath — 5.4 trillion dollars.

Although Bill Clinton had been the President from 1993 through 2000, his record was by no means an exclusively Democratic achievement: It required a good deal of “collaboration” with the Republicans in Congress, including with the ultra-conservative Newt Gingrich. We've done it before, and we can do it again. But to do it our elected leaders need a more supple and realistic approach to policymaking.

Theoretically, our political parties are distinguished from one another by their ideologies — which are supposed to be neat collections of principles and rules which, if followed as political recipes, would serve the common good and produce a better America. It hasn't worked out that way. Their so-called ideologies frequently serve more to define the special interests of party members than the common good. That's why George Washington argued so strongly against the formation of political parties.

Actually, there is a place in today's politics for what the parties call their “ideologies”, if by ideology they mean broad and flexible inclinations in one direction or another. But none of the highly pretentious ideologies — Liberalism, Conservatism, or the “constitutionalism” of the new wave of “Tea Party” dissidents — deserve “first place”. First place should go to common sense and a benign pragmatism that works to advance the common good of the entire community.

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Indeed, for 200 years the American people have endorsed that proposition by coming together from time-to-time to make ourselves stronger through collaboration, convincing the government to take down walls that divided us — be they cultural, racial, religious or chronological — and developing new synergisms to benefit — not just the favored few — but the larger community. That’s the way our system is supposed to work and when it does we grow stronger.

Abraham Lincoln and Adam Smith before him didn’t define themselves as being for “big government” or “little government.” They both pointed out that individualism, private charity and the market system are indispensable to our success as a nation ... but they are not sufficient to provide all we need to thrive as a society: That requires interventions by government that represents all the people.

Despite shifting rhetoric about so-called “political ideologies” that is what our government has managed to do — when it is operating as it should — coming together from time-to-time to create public education, Medicare and Medicaid, Social Security, the Marshal Plan, the highway program, the space program and other essential interventions in the market system ... like occasional bail-outs, and stimula-

tion when the economy is soft. All these things made sense. And because they did, for more than half-a-century no president, Democrat or Republican, has worked against any of these collaborations.

That’s how we should be making our decisions today – collaborating for the common good. Clearly, we are not doing it as well as we could and ... we should.

Let me conclude with one other thought. One of the things that makes the reliance on technology-based manufacturing so appealing to me and many others was memorably demonstrated by a visit I made to Rochester as Governor. I was there because one of my Centers of Advanced Technology had produced a new type of lens that was potentially worth a fortune. Having viewed it I asked whether others might be able to copy the unique design. I was told it would take about a year, but they would. I said, “What can we do about that?” ... and they said — “We’re working on a new lens!”

That’s what’s so exciting ... there is no ceiling on technology. It’s all one great race to new realities reaching ever further to the benefit of the whole nation and all of its people. That’s what we have been as a nation. That’s what we can be again. If only we can get together.

## NYIPLA Calendar

### 2010 SPRING HALF-DAY TRADEMARK and COPYRIGHT CLE PROGRAM AND LUNCHEON

► Thursday, July 15, 2010 ◀

The Princeton Club

James Madison Room, 15 West 43rd Street, New York, New York

Earn a minimum of 3.0 NYS CLE Credits

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# The Proposed Patent Reform Act of 2010: The Negative Consequences for Patent Owners in Ex Parte Reexaminations

Charles E. Miller and Daniel P. Archibald<sup>1</sup>

America's patent system, currently administered by the Patent and Trademark Office ("PTO"), was created when Congress enacted the Patent Act of 1790<sup>2</sup> pursuant to its power "to promote the Progress of . . . the useful Arts by securing for limited Times . . . to Inventors the exclusive Right to their . . . Discoveries."<sup>3</sup> Over the ensuing 220 years, Congress has continued to exercise that power through successive legislative enactments, the most recent comprehensive manifestation of which is the Patent Act of 1952,<sup>4</sup> codified as Title 35 of the *United States Code*.<sup>5</sup> Subsequently, the Patent Act of 1952 has been revised a number of times by amending and deleting certain sections, and adding others.

## I.

### INTRODUCTORY BACKGROUND

The March 4, 2010 "Manager's Amendment" of S.515 is the current Senate version<sup>6</sup> of the pending "Patent Reform Act of 2010." Despite the generally favorable reaction to the Manager's Amendment as a whole by various commentators and bar associations, certain provisions in Section 6 and Section 8 of the Manager's Amendment, if enacted, will abolish the fundamental statutory right of patent owners, as plaintiffs, to *de novo* judicial review by *court trial* of adverse decisions of the PTO in *ex parte* patent reexaminations, leaving owners with appeals to the CAFC as their only recourse. Because of the CAFC's highly deferential "substantial evidence" standard of review, in the absence of reversible legal error, the PTO's Patent Trial and Appeal Board (newly named) would, in effect, become the tribunal of last resort in such cases. These changes could send the patent system down a slippery slope toward the eventual eradication of all statutory provisions for *de novo* judicial review in other types of *ex parte* matters decided by the PTO, including patent applications, patent term adjustments,<sup>7</sup> and disciplinary proceedings,<sup>8</sup> thereby attenuating long-standing rights to specific judicial relief for those aggrieved by the agency's rulings.

#### A. Patent Reexamination

"Patent reexamination" is a statutory proceeding

conducted in the PTO at the request of the patent owner, or any third party,<sup>9</sup> during the period of enforceability of the patent,<sup>10</sup> whereby the PTO re-evaluates the validity of one or more claims in the patent in light of published prior art cited by the requester as raising "a substantial new question of patentability" of the patented (claimed) subject matter.<sup>11</sup> Reexamination can be either "*ex parte*" in which active participation during the prosecution phase is restricted to the patent owner and the PTO, or "*inter partes*" in which both the requester (always a third party) and the patent owner participate actively throughout the proceeding.<sup>12</sup> *Ex parte* and *inter partes* proceedings have become a recognized adjunct to court enforcement litigation by which the patent owner, or a party challenging the patent, may seek to administratively validate or invalidate the patent(s)-in-suit.<sup>13</sup>

#### B. Judicial Review of PTO Decisions on Patent Applications and in *Ex Parte* Patent Reexaminations

Currently, patent applicants<sup>14</sup> or owners of patents in *ex parte* reexaminations<sup>15</sup> who are dissatisfied with the PTO's decisions can seek judicial review in either of two fora. This is because the PTO is one of the agencies within the Executive Branch of the federal government whose final decisions in certain types of *ex parte* cases are statutorily subject to separate, dual jurisdictional review by Article III courts.<sup>16</sup> Thus, inventors and patent owners who are dissatisfied with PTO rulings<sup>17</sup> on examiners' rejections of patent applications and claims in issued patents can seek judicial review by appealing directly to the U.S. Court of Appeals for the Federal Circuit ("CAFC")<sup>18</sup> or by suing the PTO for *de novo* review in the U.S. District Court for the District of Columbia.<sup>19</sup> These alternative routes of judicial review are non-redundant and mutually exclusive.<sup>20</sup>

#### C. Civil Actions in District Court for *De Novo* Review of PTO Decisions

Under 35 U.S.C. § 306, a patent owner in an *ex parte* reexamination can seek judicial review of an adverse PTO decision by either of the two aforementioned routes. *De novo* review by trial in district court can be

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had by commencing a civil action against the Director of the PTO under Section 145 which is incorporated by reference in Section 306. Unlike a direct appeal to the CAFC under 35 U.S.C. § 306/§ 141, a civil action under § 306/§ 145 in an *ex parte* reexamination is an intermediate trial proceeding<sup>21</sup> because the losing party at the district court can appeal to the CAFC as of right.<sup>22</sup> A civil action under § 306/§ 145 seeks to set aside the PTO's decision as being wrong on the facts, wrong on the law, or both, and allows for the introduction of new evidence, in addition to the evidence that was of record before the Patent Trial and Appeal Board.

The availability of *de novo* district court review of PTO decisions in *ex parte* reexaminations is crucial to the public interest in the enforceability of valid patents and promotes fairness in the overall process. First, an appeal to the CAFC is decided on a closed fact record. In contrast, at the district court, the parties may adduce new evidence such as live testimony, affidavits, test results, and the like, while being subject to cross-examination in an adversarial courtroom proceeding unlike that at the PTO. Second, the trial judge in a district court action has the power to subpoena third parties and compel production of evidence that would otherwise be unavailable. Third, while the CAFC defers to PTO fact-findings, the district court reevaluates the totality of the evidence and fact-findings *de novo* when further evidence is presented.<sup>23</sup> This type of judicial review thus serves as an important check on PTO decision making, and tends to promote the accuracy of ultimate rulings.

## II. THE MARCH 4, 2010 MANAGER'S AMENDMENT OF S.515 --

### A Pandora's Box of Negative Consequences

The Manager's Amendment of S.515 would end the statutory right of patent owners to district court trial *de novo* review in *ex parte* reexaminations on an open record (35 U.S.C. § 145/§ 306) as an alternative to appeals in the CAFC under 35 U.S.C. § 141 on a record fixed below (*id.* at § 144) at the PTO. Nowhere is this mentioned in the Senate Press Release<sup>24</sup> accompanying the Manager's Amendment<sup>25</sup> even though it would extinguish an existing right of judicial review that has always been important to the inventive community.

Subsection (c) of Section 6 on pages 67-68 is entitled "CIRCUIT APPEALS" which under the heading "(1) IN GENERAL," would rewrite 35 U.S.C. § 141 into four parts (a) - (d). Part (b) would limit ju-

dicial review of all PTO decisions in patent reexaminations to appeals before the CAFC. Thus, the proposed revision of Section 141 would expressly do away with the right of patent owners in *ex parte* reexaminations to *de novo* review in district court that has existed under 35 U.S.C. § 306/§ 145 since the inception of *ex parte* reexaminations in 1981. Subsection (c)(2) of Section 6 on page 69 under the heading "JURISDICTION" would alter the CAFC's jurisdiction under 28 U.S.C. § 1295(a)(4)(A) to synchronize it with the proposed amendment of 35 U.S.C. § 141.

Because of the procedural similarities between *ex parte* reexamination and the prosecution of patent applications, if the Manager's Amendment is enacted, then the abolition of *de novo* district court review of PTO decisions in patent applications could be next on the legislative agenda. Thus, the patent system now stands at the edge of a precipice. If the CAFC in its forthcoming *en banc* rehearing of *Hyatt v. Kappos*<sup>26</sup> -- a case involving the prosecution of a patent application -- does not reverse its earlier panel decision, then the purpose of providing § 306/§ 145 district court trial *de novo* civil actions as an alternative to Section 141 appeals to the CAFC would be undercut and the distinction between them would become blurred and indistinguishable and only embolden the PTO in its actions.<sup>27</sup>

## CONCLUSION

The Manager's Amendment of S.515 has as one of its provisions the elimination of the right of patent owners in *ex parte* reexaminations to seek correction of erroneous agency decisions and insulates the PTO from meaningful *de novo* review. Because the PTO's decisions are subject only to a highly deferential "substantial evidence" standard of review by the CAFC, the presumptively renamed "Patent Trial and Appeal Board" for all intents and purposes would become the review tribunal of last resort from which there would be no recourse in the form of *de novo* review. The Manager's Amendment of S.515 would accomplish this by abrogating the fundamental, meaningful and necessary right of patent owners seeking judicial review of adverse PTO decisions in *ex parte* reexaminations to choose *either* civil actions in the district court *or* appeals to the CAFC. Such legislation would destroy existing rights and should be stricken from the current Manager's Amendment of S.515.

## ENDNOTES

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<sup>2</sup> Act of Apr. 10, 1790, ch. 7, 1 Stat. 109-12.

<sup>3</sup> Among the exclusive powers given to Congress by the U.S. Constitution, the power to enact laws relating to patents is set forth in Art. I, § 8, cl. 8. This was a major departure from the Articles of Confederation (1777-1789) entered into by the original thirteen states. Those Articles did not mention the granting of patents by the central government. See James Madison's commentary in *The Federalist* No. 43 (January 23, 1788). For a contemporary analysis of the "Science and Useful Arts" clause of the Constitution, see Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Anatomy of a Congressional Power*, 43 IDEA 1-81 (2002).

<sup>4</sup> Act of Jul. 19, 1952, ch. 950, § 1, 66 Stat. 803.

<sup>5</sup> The 1952 Act currently consists of four parts encompassing 35 U.S.C. §§ 1-376. Part I is entitled "United States Patent and Trademark Office" and includes §§ 1-42; Part II is entitled "Patentability of Inventions and Grant of Patent Rights" and includes §§ 100-212; Part III is entitled "Patents and Protection of Patent Rights" and includes §§ 251-318; and Part IV is entitled "Patent Cooperation Treaty" and includes §§ 351-376. The lacunae numbering of the sections indicates provisions that have been deleted since their enactment, or sections that have yet to be added.

<sup>6</sup> 111th Congress, document GRA10134, the full text of which can be found at: [http://judiciary.senate.gov/legislation/upload/Patent ReformAmendment.pdf](http://judiciary.senate.gov/legislation/upload/Patent%20Reform%20Amendment.pdf).

<sup>7</sup> 35 U.S.C. § 154(b)(4).

<sup>8</sup> *Id.* § 32.

<sup>9</sup> A third-party requester is statutorily defined as "a person requesting . . . reexamination . . . who is not the patent owner." 35 U.S.C. § 100(e).

<sup>10</sup> The period during which a patent can be enforced lasts six (6) years following the expiry of the statutory term of the patent under 35 U.S.C. § 154(a)(2) after which time a claim for money damages cannot be asserted. *Id.* § 286. See *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 225 U.S.P.Q. 243, 249 (Fed. Cir. 1985).

<sup>11</sup> 35 U.S.C. § 303(a) [*ex parte* reexamination]; *id.* § 313 [*inter partes* reexamination]. See also the PTO's *Manual of Patent Examining Procedure* ("MPEP") at §§ 2216 and 2242.I.

<sup>12</sup> The history, similarities, and differences between *ex parte* and *inter partes* reexamination are explained in chapters 2200 and 2600, respectively, of the MPEP.

<sup>13</sup> Nationwide, about 60% of all contested motions to stay U.S. district court proceedings pending the reexamination of patents-in-suit are currently being granted. *LegalMedia Nationwide Report on Stays Pending Reexamination Decisions* (Sept. 2009). See, e.g., *E-Z-Go v. Club Con Inc.*, Fed. Cir. Case No. 1-09-cv-00119 (Jan. 12, 2010) ("[T]he court is particularly mindful that were it to decide that the [patent-in-suit] is valid, such finding is not binding on the PTO, and a contrary [prior] decision by the PTO could result in a substantial saving of judicial resources").

<sup>14</sup> 35 U.S.C. §§ 111-133.

<sup>15</sup> 35 U.S.C. §§ 302-307.

<sup>16</sup> U.S. Const. art. III. 35 U.S.C. §§ 141, second sentence; *id.* § 145, first sentence; *id.* §§ 146 & 306; and 28 U.S.C. § 1295(a)(4)(a). Dual routes of court review are not unique to the patent system. For example,

decisions of the Department of Agriculture involving plant variety protection certificates (7 U.S.C. §§ 2321-2582) may be appealed directly to the U.S. Court of Appeals for the Federal Circuit ("CAFC") (*id.* § 2461) or by civil action against the Secretary of Agriculture (*id.* § 2462). Another such agency is the Internal Revenue Service (review by the U.S. Court of Federal Claims or by the U.S. Tax Court depending on whether or not the amount of the tax in dispute has been paid). 28 U.S.C. §§ 1346 and 1507. Also, contractor's claims under the *Contract Disputes Act of 1978* (41 U.S.C. §§ 601-613) may be appealed either to a tribunal within the Federal Contracts Dispute Board, or to the Court of Federal Claims. (28 U.S.C. §§ 1346(a)(2) and 1491(a)(2)). The contractor thus has a choice of fora from either of which an appeal to the CAFC may be taken. *Id.* § 1295(a)(3) and (a)(10).

<sup>17</sup> 35 U.S.C. § 134.

<sup>18</sup> *Id.* § 141 (patent applications); *id.* § 306/§ 141 (*ex parte* reexaminations).

<sup>19</sup> *Id.* § 145 (patent applications); *id.* § 306/§ 145 (*ex parte* reexaminations).

<sup>20</sup> *Id.* § 141, second sentence; *id.* § 145, first sentence; 28 U.S.C. § 1295(a)(4)(A).

<sup>21</sup> Such trials are invariably bench trials because the Seventh Amendment right to trial by jury generally does not apply to civil actions against the Federal Government. See Jon L. Craig, *Civil Actions Against The United States Its Agencies, Officers, and Employees*, 2d ed., vol. 1, § 1:37 (2002).  
<sup>22</sup> 28 U.S.C. § 1295(a)(4)(C).

<sup>23</sup> *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1345-46 (Fed. Cir. 2000).

<sup>24</sup> See 79 PTCJ 560 (03/12/10).

<sup>25</sup> The PTO's historic aversion to being a defendant in a civil action as opposed to being an appellee in the CAFC was discussed in Judge Moore's dissent in *Hyatt v. Doll*, 576 F.3d 1246, 1254-68, 1280-82, 91 U.S.P.Q.2d 1865, 1871-85, 1891-92 (Fed. Cir. 2009), *vacated and en banc rehearing granted sub nom. Hyatt v. Kappos*, 93 U.S.P.Q.2d 1871 (Fed. Cir. 2010).

<sup>26</sup> *Sigram Schindler Beteiligungsgesellschaft MbH v. Kappos*, 93 U.S.P.Q.2d 1756 (E.D. Va. 2009) is the first case in which the question was raised regarding district court trial de novo/review-jurisdiction over BPAI decisions in *ex parte* patent reexaminations requested following the November 29, 1999 effective date of the AIPA. In *Sigram Schindler*, the defendant in a patent infringement action (Cisco Systems Inc.) requested *ex parte* reexamination of the patent-in-suit in 2007. The PTO granted the request, and reexamined the patent. Following the examiner's final rejection of the claims, the patent owner appealed to the BPAI. During that administrative appeal, the patent owner sued the PTO in a declaratory judgment action under the APA, 5 U.S.C. § 706(2)(C), challenging on *Chevron* grounds and under 35 U.S.C. § 2(b)(2) the legality of the agency's interpretive rule, 37 C.F.R. § 1.303(d) which purports to preclude district court trial de novo/review-jurisdiction in *ex parte* reexaminations requested post-November 28, 1999. In response to the parties' cross-motions for summary judgment, the court dismissed the action only because the Complaint did not present a justiciable case or controversy due to non-ripeness since the BPAI had not yet rendered a decision which, if adverse to plaintiff, would allow court review. And the fact that the BPAI's decision had not yet been handed down rendered plaintiffs purported injury contingent and speculative. Hence, the decision in *Sigram Schindler* left this important question unresolved.

<sup>27</sup> See *Tafas v. Dudas*, 541 Fed. Supp. 2d 805, 86 U.S.P.Q.2d 1623 (E.D. Va. 2008), *aff'd in part and vacated in part sub nom Tafas v. Doll*, 559 F.3d 1345, 90 U.S.P.Q. 2d 1129 (Fed. Cir. 2009), *en banc rehearing granted July 6, 2009; motion to dismiss appeal granted and motion for vacatur denied sub nom. Tafas v. Kappos*, November 13, 2009. This was a consolidated civil action against the PTO by Triantafyllos Tafas and by GlaxoSmithKline (GSK) under the APA, 5 U.S.C. § 706, challenging the agency's final rules implementing (i) a limitation on the number of continuations and requests for continued examination of applications and (ii) a restriction on the number of claims as an alternative to submitting "examination support documents" in applications. The district court enjoined the implementation of the rules as being beyond the PTO's rulemaking authority under 35 U.S.C. § 2(b)(2). The PTO later rescinded the rules by voluntarily removing them from the *Code of Federal Regulations*. 74 Fed. Reg. 52686 (Oct. 14, 2009). At the same time, the PTO together with one of the plaintiffs (GSK) sought to end the case by moving to dismiss the agency's appeal from, and to vacate, the district court's summary judgment (injunction). The CAFC denied the motion insofar as it sought to vacate the district court's summary judgment, thereby happily preserving the status of the case as precedent in opposing future PTO attempts at *ultra vires* rulemaking.



## “As Time Goes By - ‘Stability in Times That Are A Changin’ “

*“by Dale Carlson*

As my fifth year of serving as our Association’s Historian draws to a close, there’s an opportunity to reflect on where we’ve been, and where we’re headed as an Association.

Nationally, the last five years has been nothing short of a roller coaster ride in terms of economic swings – up-cycle followed by down-cycle. Thankfully, our Association continues to be financially stable and structurally sound. This stability and soundness allows our Association to steadfastly protect, not one or another group of clients’ interests, but rather the best interests of our national patent, trademark and copyright systems as a whole, as reflected by the majority of our Board members speaking in a collective voice on our members’ behalf.

The Association’s voice can be heard above the fray in numerous amicus briefs submitted to the Federal Circuit and the Supreme Court, as well as in periodic commentary to the Patent and Trademark Office and testimony before Congress on issues of relevance to our IP systems and our profession. The soundness and sophistication of our Association’s voice is largely attributable to the diverse IP expertise of our members, as well as to their wisdom, individually and collectively.

As true New Yorkers, our members thrive on speaking out on important IP issues of the day. One of our senior statesmen, Sam

Helfgott, recently offered a compelling lecture on how the Supreme Court has reframed its approach toward patents in response to political changes over the half-century window of time coinciding with the length of his career so far. Sam presented the lecture, entitled “The Supreme Court’s Reshaping of the IP Landscape in Recent Years,” to a full house paying rapt attention, at the AIPLA’s 2010 Mid-Winter Institute.

Now it’s time for me to change hats from that of serving as our Historian to that of President. In doing so, I hope to follow in the footsteps of President Mark Abate in terms of keeping the Association on an even keel financially and organizationally. Mark has done an excellent job in both respects, and he has done so with good grace, decorum, and a kindly sense of humor.

I cherish my role as Historian, and am most thankful to Past President Ed Vassallo for making that opportunity possible in the first instance. So it is with reluctance, albeit of necessity, that I step down from it now.

Thankfully, my stepping down may be only temporary. The reason is that Past President John Pegram has expressed a willingness to serve as “Interim Historian” for one year during my presidential term. I am most pleased to have John serve in this role, and look forward to the wisdom that he is sure to impart to us.

As we peer deeply into the Association’s crystal ball, we can be confident that Terri Gillis, Tom Meloro and Charlie Hoffman will perform their leadership roles well during their successive administrations, always mindful of their fiduciary obligations to the membership.

Irrespective of whether we encounter smooth sailing or rough seas, the helm of the ship we call “NYIPLA” is in steady hands for as far ahead as the eye can see. Bon Voyage!



*Dale Carlson, a partner at Wiggan & Dana, serves as the NYIPLA Historian, and as President-Elect.*



# Does the World Really Need an Unlimited Number of Top Level Domains?

By Dyan Finguerra-DuCharme\*

The Internet may be about to get even bigger. The Internet Corporation for Assigned Names and Numbers (“ICANN”), the entity that is essentially in charge of the Internet, has been working on a plan to allow an unlimited number of “top-level domains” (e.g., .com, .net, .info) to applicants that meet set financial and technical criteria (and can afford the \$185,000 application fee).

The proposal has been met with concern by brand owners who worry that rapid or uncontrolled growth of the domain name space could create a bottomless (and costly) pit for cybersquatters, phishers and other bad actors to play in. On the other hand, the proposal is supported by those who see an opportunity to create the next “dot com” or who believe that the top-level domain space can be used to promote expression and self-regulation, or to support communities. This article explores the history of the top-level domain system and presents both sides of the debate as to whether the world really needs an unlimited number of top-level domains.

## *Background*

ICANN was founded in 1998 as a not-for-profit organization responsible for coordinating the technical aspects of the Internet’s addressing system. In order for the Internet to function, computers need to communicate with each other through a series of numbers commonly called an “IP address” – each individual IP address is linked to a particular device. Given that remembering a series of numbers is a difficult endeavor, the domain name system (“DNS”) was created to use letters to form words that are easy to remember as domain names.

A domain name consists of two parts: one before and one after the dot. The part after the dot, such as “com”, “net”, “org”, etc., is known as a “top-level domain” or TLD. Some TLDs are “generic” and take all-comers as registrants, while others such as .museum offer registration opportunities to a specific community. For each gTLD, one operator maintains the central “registry” of all second-level domains (e.g., WilmerHale.com). The element before the dot is the domain name used to provide online systems such as websites and email. These domains are sold by “registrars” who pay a fee to the particular registry operating the top-level domain in which the string is being registered.<sup>1</sup>

Currently, there are 21 top-level domains. The initial set of these gTLDs included .com, .edu, .gov, .int, .mil, .net, .org, and .arpa. In November 2000, ICANN introduced seven new domains (.aero, .biz, .coop, .info, .museum, .name, and .pro), and then six more in 2003 (.asia, .cat, .jobs, .mobi, .tel, and .travel).

According to ICANN, the introduction of these top-level domains over the years has not stopped the demand for more. One of ICANN’s key mandates has been “to create competition in the domain name marketplace while ensuring Internet security and stability.”<sup>2</sup> ICANN believes that competition and innovation best occur when a stable and open platform is available and the barriers to entry are reduced.<sup>3</sup> In ICANN’s view, expanding the number of gTLDs “will allow for more innovation, choice and change to the Internet’s addressing system.”<sup>4</sup> After consulting with ICANN’s Government Advisory Committee, non-commercial interest groups and civil society representatives, individuals, businesses, technology groups and intellectual property constituencies, ICANN decided to expand the number of gTLDs in an unlimited manner.

## *The Proposal*

ICANN’s Generic Names Supporting Organization (“GNSO”) was tasked with the responsibility to develop a policy for the introduction of the new gTLDs. In June 2008, the ICANN Board approved the GNSO recommendations for introducing new gTLDs to the Internet’s addressing system. In October 2008, ICANN released version 1 of its Draft Application Guidebook (“DAG”), which sets forth proposed policies and procedures for new gTLDs. The DAG is designed to guide potential applicants through the new gTLD application process by providing detailed information about the technical and operational criteria, financial criteria, evaluation fees, required documentation, evaluation processes and objection procedures. ICANN encouraged feedback on the proposals and had commentary periods for all released versions of the DAG. ICANN released the last version of the DAG (version 3.0) in October 2009. ICANN expects to open the application period in 2010 following the publication of the final Application Guide.

*cont. on page 10*

Some highlights from the latest proposal include the following:

- There will be an open application period during which time the applicant must submit an application demonstrating that it has a strong technical capability and sufficient financial support. An applicant must also submit a \$185,000 evaluation fee. In certain cases, refunds of a portion of the evaluation fee may be available if applications are withdrawn before the application process is complete.
- The current DAG allows for either a community-based gTLD, which is intended to operate for the benefit of a clearly delineated community, or a standard application, which can be used for any purpose consistent with the requirements of the application and evaluation criteria. Designating the gTLD as either community-based or standard has different implications for the application process and the ultimate obligations of the registry.

- Internationalized Domain Names (“IDNs”) will be available at the top level, which will allow new extensions in different scripts such as Arabic, Chinese, Greek and Hindu. These domains could use characters with diacritical marks or characters from non-Latin scripts, which are currently not available for use with any of the existing gTLDs.
- The new ICANN policy relies on an objection-based system to resolve potential conflicts, meaning brand owners must monitor for newly applied-for top-level domains and object to domains that may violate existing legal rights. A trademark owner may file a formal objection to an application during the initial evaluation period with a two-week window of time between the posting of the initial evaluation results and the close of the objection filing period. ICANN will review disputed gTLDs under a legal analysis similar to that used to determine trademark infringement by cybersquatters.
- Domains registered with the new gTLD must be subject to ICANN’s Uniform Domain Name Dispute Resolution Policy (“UDRP”). In addition, ICANN is currently discussing additional post-delegation dispute resolution policies.<sup>5</sup>
- If two applicants apply for the same gTLD, and neither has rights superior to the other, ICANN will award the gTLD to the highest bidder.

#### *The Reaction to the Proposal*

Brand owners have long advocated a controlled, gradual expansion of the top-level domain space rather than the rapid introduction of a large number of top-level domains arguing that allowing new domains will increase the likelihood of consumer confusion and the proliferation of malicious conduct on the Internet.<sup>6</sup> The International Trademark Association (“INTA”) has played a leading role in the opposition, and has achieved some success in terms of affecting and shaping the DAG. For example, ICANN recently announced its decision to abandon plans to institute a system of “Expressions of Interest” (“EOI”), which would have involved a pre-registration process for those interested in applying for a new gTLD.<sup>7</sup> INTA had opposed the pre-registration process arguing that it would have “harmful ramifications such as forcing trademark owners to defensively pre-register to protect their trademarks.”<sup>8</sup>

The trouble for trademark owners is that the new gTLDs open the door for new ways in which



## CLE PROGRAM

### CLE Day of Dinner Program March 26, 2010

Calculating patent damages was the focus of this year’s program.

The day opened with a mock argument based on the century old *Wright Brothers v. Curtis-Herring* case. U.S. Patent and Trademark Deputy Director Sharon Barner presided with Richard L. Rainey of Covington & Burling representing the Wright Brothers and Robert G. Krupka of Kirkland & Ellis representing Curtis-Herring. John R. Lane of Frommer Lawrence & Haug testified as the expert for the accused infringer.

A discussion moderated by Ira J. Levy of Goodwin Procter followed. Panelists were Judge Arthur J. Gajarsa of the U.S. Court of Appeals for the Federal Circuit, Judge Barbara S. Jones of the District Court for the Southern District of New York, Judge William G. Young of the District Court for Massachusetts, Edward E. Vassallo of Fitzpatrick Cella Harper & Scinto and Annemarie Hassett of Goodwin Procter LLP.

their marks can be exploited and infringed through counterfeiting, phishing, typosquatting and cybersquatting, to name a few. Of course, this additional Internet enforcement work will increase costs and resources that brand owners must expend to protect their marks. For example, on average, a brand owner spends approximately \$10,000 in legal fees and costs to file a UDRP complaint.<sup>9</sup> Even if the new registries have “sunrise periods” that allow the brand owner to secure domains with their popular brands, this usually comes at a premium price and results in the accumulation of unwanted domains that must be maintained or else they can be captured by a cybersquatter.

In contrast, proponents of the proposal to expand gTLDs believe that doing so “is good for the Internet, for consumers, and [is] central to ICANN’s founding promise.”<sup>10</sup> Proponents, including eNom, Network Solutions, Tucows, and Minds + Machines, argue that introducing new top-level domains will meet consumer demand, “provide lower prices for domain names, avoid chaos that will ensue from alternative addressing schemes that have no community input, and foster innovation and competition in the domain name space.”<sup>11</sup> As an example of how competition and innovation will be advanced, proponents assert that gTLDs “will create new businesses (each new registry is a new business) and enhance competition, which will result in innovation and associated consumer benefits, as well as significant financial investment and job creation.”<sup>12</sup>

It also cannot be overlooked that the expansion of gTLDs is a new opportunity to make money. Operating a new registry for a popular new gTLD can be a very lucrative endeavor, especially given that the registry will be able to set the purchase price for the new domains. For example, Neustar, a publicly-traded company that operates the .biz registry, reported that “in less than a decade, over two million domain names have been officially registered within the .biz Internet domain, while more than one million domain names have been registered within the .us Internet domain.”<sup>13</sup> The registries operating the new gTLDs will therefore profit greatly from the surge in new registrations by those in the business of owning portfolios of domain names (fittingly called “domainers”), as well as the anticipated purchase of defensive registrations by brand owners.

## Conclusion

The launch of the application process for new gTLDs seems likely to happen before the end of this year. Whether brand owners will invest in defensive registrations or take a “wait and see” approach remains to be seen. The extent to which competition is fostered and innovation is enhanced will also be something to watch. At the end of the day, it is more likely than not that the new registries will be turning a profit – the IP community’s concern will be whether there are enough protective mechanisms in place to ensure that these profits won’t be earned at the expense of brand owners.



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<sup>1</sup>See <http://www.icann.org/en/participate/what-icann-do.html#cctlD>

<sup>2</sup> ICANN, *New gTLD Program*, March 2009.

<sup>3</sup> See also *Preliminary Report of Dennis Carlton Regarding Impact of New GTLDs on Consumer Welfare*, dated March 2009.

<sup>4</sup> ICANN, *New gTLD Program*, March 2009.

<sup>5</sup> See ICANN Board Resolution Minutes, March 12, 2010, available at <http://www.icann.org/en/minutes/resolutions-12mar10-en.htm>.

<sup>6</sup> *Trademark & Cybersquatting Update – INTA Makes the Argument Against Unlimited New gTLDs*, <http://tcattorney.typepad.com/domainnamedispute/2010/01/trademark-cybersquatting-update-inta-makes-the-argument-against-new-gtlds.html>

<sup>7</sup> *ICANN Board Stats on Course for Launch of New gTLD Program*, <http://www.icann.org/en/announcements/announcement-15mar10-en.htm>

<sup>8</sup> INTA’s Letter to Members dated January 13, 2010.

<sup>9</sup> *Brokering Peace Between Brand Owners and Domainers*, New York Times, July 14, 2009.

<sup>10</sup> Letter to ICANN from dozens of members of the “Internet community” dated September 21, 2009.

<sup>11</sup> *Id.*

<sup>12</sup> *Id.*

<sup>13</sup> <http://www.neustar.biz/solutions/solutions-for/domain-name-registry-services>.



# *88th Annual Dinner in Honor of the Federal Judiciary*

The New York Intellectual Property Association held its 88th Annual Dinner in Honor of the Federal Judiciary on March 26, 2010 at the Waldorf=Astoria.

President Mark Abate welcomed the honored guests, members of the NYIPLA, and their guests. Students from The Juilliard School opened the evening's events with a magnificent rendition of the National Anthem.

The Association's Eighth Annual Outstanding Public Service Award was presented to the Honorable Richard Linn, Judge of the U.S. Court of Appeals for the Federal Circuit. Judge Linn's acceptance remarks are reprinted on page 15 of this Bulletin.

The Keynote Speaker was three-term New York Governor Mario M. Cuomo whose timely and insightful address focusing on where the United States is today, where it should be, and what must be done to get there is reprinted beginning on the first page of this Bulletin.











## Outstanding Public Service Award

*The NYIPLA'S Eighth Annual Outstanding Public Service Award was conferred at the 2010 Judges' Dinner on the Honorable Richard Linn, Judge of the U.S. Court of Appeals for the Federal Circuit. In accepting the Award, Judge Linn gave the following remarks:*

Governor Cuomo, fellow judges, members of the bar, and distinguished guests: I thank the New York Intellectual Property Law Association for honoring me with this award. I am very grateful. As a simple patent attorney from Brooklyn, I am humbled to be recognized in this special way before such an incredible hometown crowd.

In many ways, this award is not only about me but about all of us in this room. Public service is what those of us in the legal profession do. It is one of the things that distinguishes us as a profession and is certainly one of the things that makes the practice of law rewarding and fulfilling.

As Mark mentioned in his kind introduction, I have worked across the country to help form new Inns of Court focused on intellectual property. With the collaboration of many outstanding people, we have nearly tripled the number of Inns focused on intellectual property in the past four years and have greatly expanded the opportunities for judges and experienced lawyers to give to the next generation of leaders an understanding of what it really means to practice law—with civility, ethics, and professionalism. This has been a wonderfully rewarding

and fulfilling experience for me. As an example of just what I mean, I want to share with you one particularly poignant moment that has special relevance to this audience.

I was very gratified two years ago when Anthony Giaccio responded to my inquiries about forming a new IP-focused Inn in New York and was particularly pleased when the organizers decided to name the Inn after my long-time friend, Judge William C. Conner.

I remember vividly the look on Bill Conner's face when he got the news about the formation of the Inn and the joy both he and his wife, Janice, showed at the inaugural dinner meeting a year and a half ago. He attended almost all of the meetings and loved the idea of the Conner Inn and the ideals it represented. But it was only later that I found out just how much this new Inn meant to him.

When my wife, Patti, and I attended the graveside service for Judge Conner at Arlington Cemetery last November, we learned that his family had requested that a gold medallion bearing the seal of the Conner Inn be placed beside the Navy seal and the seal of the Southern District of New York on Judge Conner's urn. These medallions represented three aspects of his professional life that were most meaningful to him. Needless to say, I was deeply moved that the Conner Inn seal was included and extremely gratified to have played a small part in making the Conner Inn a reality in Bill Conner's lifetime. Naming the Inn after him was a wonderful and altogether fitting tribute to an outstanding judge, a caring family man, and a cherished friend, who tonight—on the eve of what would have been his 90th Birthday—is truly missed.

Judge Conner was the first recipient of this award, and to stand this evening in his company is more meaningful to me than words can ever express. I thank the New York Intellectual Property Law Association for honoring me with this special award, and I gratefully accept it with a salute to the memory of Judge Conner. ■



President Mark Abate presents the NYIPLA's Outstanding Public Service Award to Judge Richard Linn.

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# ARTICLES

The Association welcomes articles of interest to the IP bar.

Please direct all submissions by e-mail to:

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