

In This Issue

Guidance from the Federal Circuit on Spoliation.....	1,3-5
President's Corner.....	2
Agenda for Day of Dinner Luncheon CLE.....	5
NYIPLA Announces the 90th Annual Dinner in Honor of the Federal Judiciary.....	6
Historian's Corner.....	7
CLE Program Reviews.....	8-11
Board of Directors Meeting Minutes.....	12-14
Moving Up and Moving On.....	14
NYIPLA Calendar.....	15
New Members.....	16



Guidance from the Federal Circuit on Spoliation

By Kyle E. Friesen and Sharon A. Israel¹

Last year, in two related cases involving accusations of spoliation of evidence leveled against patent owner and declaratory judgment defendant, Rambus Inc.,² an expanded five-judge panel of the U.S. Court of Appeals for the Federal Circuit held that the duty to preserve evidence begins when litigation is “reasonably foreseeable.” The court, in a pair of decisions issued on May 13, 2011, rejected a “restrictive gloss” that the litigation be “imminent, or probable without significant contingencies.”³

These two appeals arose from decisions in two district courts (*Hynix* in California, *Micron* in Delaware) reaching opposite conclusions based on the same set of underlying facts. Finding that Rambus had committed spoliation, the *Micron* district court imposed dispositive sanctions and ruled Rambus’s patents unenforceable against Micron as a result.⁴ The *Hynix* district court, on the other hand, found that litigation was not reasonably foreseeable at the time Rambus destroyed documents, thus there

had been no spoliation;⁵ the *Hynix* court proceeded to a trial resulting in a judgment that valid claims of the patents-in-suit had been infringed and awarded damages.⁶

The Federal Circuit affirmed the *Micron* district court’s finding of spoliation and vacated the judgment of the *Hynix* district court, remanding the latter for further proceedings consistent with the standard the Federal Circuit applied in *Micron*.⁷ Notably, however, the court vacated the *Micron* district court’s judgment of unenforceability, stating that the district court applied the wrong standard in its bad faith determination, which affected the rest of the analysis of the propriety of dismissal.⁸

The Spoliation Determinations—Reasonably Foreseeable

It was undisputed that Rambus had destroyed large volumes of information, and the dates of the destruction of this information were similarly undisputed. In 1998, Rambus developed a licensing and litigation strategy for its intellectual property relating to dynamic

cont. on page 3

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January 2012

Dear Fellow Members:

As you all are aware, the United States District Courts for both the Eastern and Southern Districts of New York are participating in the Pilot Patent Program. Both Courts have announced a list of judges who have opted into the program. The two districts have a Joint Rules Committee that has been exploring harmonizing and clarifying the Courts' Local Rules. As part of that project, and in order to facilitate implementation of the Pilot Patent Program, the Courts set up a Patent Rules Subcommittee to draft Local Patent Rules. NYIPLA participated in that process and provided the initial draft of the rules with which the subcommittee worked.

The initial draft rules were vetted during a series of meetings of the Patent Rules Subcommittee. Two objectives of that subcommittee were to ensure that the Local Patent Rules were not inconsistent in form or substance with the general Local Civil Rules and to harmonize the language of the Local Patent Rules with that of the other local rules. In addition, an effort was made to ensure that the rules were limited to those truly required by patent cases and did not unnecessarily include rules that were redundant because the issue was not unique to patent cases and the Federal Rules of Civil Procedure or the general local rules of the two districts already addressed the issue. Finally, although many of the rules and procedures follow the pattern of rules adopted in other districts, the Patent Rules Subcommittee sought to bring a crispness and clarity of language to the rules. Once the Patent Rules Subcommittee signed off on the proposed Local Patent Rules, the draft rules were further reviewed and vetted by the full Rules Committee for the two districts. That process resulted in further refinements of the draft. The draft of the rules emanating from that full committee will be presented to the Board of Judges of the two districts, which will ultimately determine what rules will be adopted.

As currently proposed, the Rules provide procedures for dealing with infringement and validity contentions, *Markman* proceedings, and discovery when a defense is based on attorney-client privilege. Because flexibility is essential, the proposed rules specifically contemplate adjusting the procedures and schedule based on the circumstances of a particular case.



It is expected that Local Patent Rules will be issued as soon as the Board of Judges approves them. I want to thank the NYIPLA Patent Litigation Committee and the present and past Boards of the NYIPLA for their thoughtful input into crafting these rules.

A question was raised recently by AIPLA regarding opinions expressed in the NYIPLA Bulletin. For clarity, on behalf of the NYIPLA Board, I want to emphasize that the Bulletin content reflects the views of the authors of the various articles appearing in the Bulletin, as is expressly stated in the Bulletin. Opinions expressed in the Bulletin do not reflect the views of the NYIPLA unless an article expressly so states.¹

The NYIPLA CLE programs continue to be a success, and all members of the Association are encouraged to attend upcoming programs. Those who attended the December 2011 CLE luncheon were treated to an extemporaneous speech by Chief Judge Rader on a range of topics, including his personal views on the impact of certain recent Supreme Court decisions and the state of patent litigation. We thank Chief Judge Rader for taking the time to share his thoughts with us. Thanks also to the hard-working committees who put the program together.

With kind regards,
Terri Gillis

(Footnotes)

¹ AIPLA raised the question because AIPLA disagreed with one author's characterization of its role in dissolving the NCIPLA in 2002. It is AIPLA's view that the dissolution of that group was recommended by the Executive Board of NCIPLA because NCIPLA no longer served a meaningful function.

random access memory (DRAM) technology. The strategy also involved implementing a document retention policy.⁹ In accordance with this policy, in May 1998, Rambus began keeping email back-up tapes for only three months, and erased all but one of its 1269 tapes, preserving the one tape it knew contained a document helpful to establish the priority date of its patents.¹⁰ In September 1998, Rambus instituted “shred days”; at one shred day in August 1999, Rambus “destroyed between 9,000 and 18,000 pounds of documents in 300 boxes.”¹¹ Notably, a timeline prepared in July 1999 indicated that Rambus “planned to file a patent infringement complaint on October 1, 1999,” although Rambus did not ultimately initiate litigation until January 18, 2000.¹²

Because these facts were not disputed, the question of whether Rambus’s destruction constituted spoliation turned on the date when litigation became “reasonably foreseeable.” According to the Federal Circuit, “[w]hen litigation is ‘reasonably foreseeable’ is a flexible fact-specific standard that allows a district court to exercise the discretion necessary to confront the myriad factual situations inherent in the spoliation inquiry.”¹³ The court also noted that this is an objective standard, focusing on “whether a reasonable party in the same factual circumstances would have reasonably foreseen litigation.”¹⁴

The court rejected Rambus’s proposal to further limit the standard and found no clear error in the district court’s spoliation finding.¹⁵ Instead, the Federal Circuit recited, at length, reasons supporting the *Micron* district court’s decision.

First, it was not clear error for the *Micron* district court to find that Rambus created its document retention policy “to further [its] litigation strategy by frustrating the fact-finding efforts of parties adverse to Rambus.”¹⁶ Preparation of the policy was one of “Rambus’s ‘IP Litigation Activity’ goals in the second and third quarters of 1998.”¹⁷ Rambus even implemented the policy with an eye toward litigation, such as erasing email backup tapes because of a concern that they were discoverable information, while instructing personnel to look for and preserve “helpful documents to keep” among documents that would otherwise be destroyed under the policy.¹⁸

Second, Rambus was “on notice of potentially infringing activities” at least as soon as its first patent issued.¹⁹ “[T]he knowledge of likely infringing

activity by particular parties makes litigation more objectively likely to occur because the patentee is then more likely to bring suit.”²⁰ Here, Rambus had used its position in the relevant standard-setting body to obtain information about the developing standard in order to write patent claims to cover the products complying with the emerging standard.²¹

Third, Rambus had begun taking material steps to prepare for litigation before holding what was termed its second “shredding party.” In fact, organizing the “shredding party” was one of the “IP 3Q ’99 Goals,” which also included “preparing a litigation strategy” for pursuing one of Rambus’s targets and being “ready for litigation with 30 days notice.”²²

Fourth, as the patentee, Rambus had the potential to control the date of litigation against alleged infringers.²³

Finally, Rambus had taken the position internally that its licensees were eventual targets for infringement litigation once those licensees either rejected Rambus’s technology or were too invested in it to back out. For this reason, the ongoing business relationships between Rambus and its licensees did nothing to make litigation less foreseeable.²⁴

The panel majority noted that “most document retention policies are adopted with benign business purposes,” and that “destruction that occurs in line with” an established “policy motivated by general business needs, which may include a general concern for the possibility of litigation . . . is relatively unlikely to be seen as spoliation.”²⁵ The court also noted that the relationship between Rambus and its licensees could be distinguished from other licensor/licensee business relationships, and that “document destruction occurring during the course of a long-standing and untroubled licensing relationship relating to the patents and the accused products that ultimately become the subject of litigation is relatively unlikely to constitute spoliation.”²⁶

The Sanctions Determination

In reviewing the *Micron* district court’s award of dispositive sanctions, the Federal Circuit stated that although “[t]he district court’s opinion alludes to several key items” that could support a determination of bad faith, “the district court did not make clear the basis on which it reached that conclusion.”²⁷ The Federal Circuit also noted that the district court

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did not apply the correct standard, disavowing a “knew or should have known” standard and identifying the proper inquiry as “whether Rambus [as the spoliating party] ‘intended to impair the ability of the potential defendant to defend itself.’”²⁸ The Federal Circuit remanded for a determination under the correct standard and, because the burden of proving prejudice shifts to the destroying party when there has been a showing of bad faith, remanded on the issue of prejudice as well.²⁹

The Federal Circuit also instructed the *Micron* district court on remand to “explain the reasons for the propriety of the sanction chosen (if any) based on the degree of bad faith and prejudice and the efficacy of other lesser sanctions.”³⁰ Importantly, the Federal Circuit also held that dispositive sanctions should be available only when “there is clear and convincing evidence of both bad-faith spoliation and prejudice to the opposing party.”³¹

The Federal Circuit went on to note that prejudice “requires a showing that the spoliation ‘materially affect[s] the substantial rights of the adverse party and is prejudicial to the presentation of his case.’”³² Where bad faith is shown, the spoliator bears the burden to show lack of prejudice.³³ Otherwise, the opposing party has the burden on the issue of prejudice.³⁴ The court also noted that “bad faith and prejudice, without more, do not justify the imposition of dispositive sanctions.”³⁵ In imposing sanctions, a district court should consider factors including (i) the degree of fault of the spoliating party, (ii) the degree of prejudice to the opposing party and (iii) whether a lesser sanction is appropriate that will avoid unfairness to the opposing party and deter spoliating conduct by others in the future.³⁶

The *Hynix* Decision

In the *Hynix* case, the district court found that the litigation was not reasonably foreseeable when the documents at issue were destroyed because of a number of intervening contingencies on which the litigation depended.³⁷ The Federal Circuit held that this analysis narrowed the reasonably foreseeable standard and observed that it was reasonably foreseeable that each of these contingencies would occur.³⁸ The court therefore vacated the district court’s judgment and remanded for proceedings consistent with the framework set forth in the *Micron* decision.³⁹

Judge Gajarsa’s Opinions

Concurring-in-part and dissenting-in-part in both the *Micron* and *Hynix* decisions, Circuit Judge Gajarsa criticized the majority for substituting its views for those of the district courts in both cases.⁴⁰ He also noted that neither the Supreme Court, the Ninth Circuit, nor the Third Circuit had yet defined a standard for when litigation is reasonably foreseeable.⁴¹

Conclusion

So far, few district court decisions have cited the Federal Circuit’s opinion. In one recent decision, however, a court in the Southern District of California agreed with the Federal Circuit that “[t]he fundamental element of bad faith spoliation is advantage-seeking behavior” relative to the litigation.⁴² Applying this definition, the district court found there was no bad faith where the spoliating Hitachi employee deleted company files from his home computer to cover up his copying of company files in violation of company policy. According to the district court, this was not bad faith because his motivation was “truly personal,” as opposed to “advantage-seeking.”⁴³ The court also considered Hitachi’s efforts to remediate any possible prejudice, including undertaking a forensic analysis of the deleted files on its employee’s personal computer that demonstrated the files had been produced in other forms.⁴⁴ Based on the lack of bad faith and the production of the deleted files, the court declined to impose sanctions for the admitted spoliation.⁴⁵

Although the full impact of the *Rambus* decisions remains to be seen, the opinions help to clarify the standards of what is reasonably foreseeable litigation and the standards for the imposition of sanctions in the event that spoliation is found. In doing so, the Federal Circuit opinion cites to case law from various circuit and district courts in this developing area of the law, and may have an influential effect on both Federal Circuit and regional circuit case law.



Endnotes

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Nineteen Hundred and Twenty-two

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- (c) how parties may change the way they conduct patent litigation in view of those provisions.



◆ ◆ ◆ *Schedule* ◆ ◆ ◆

Registration & Reception	10:30 a.m. – 11:30 a.m.
Lunch	11:30 a.m. – 12:20 p.m.
Presentation	12:20 p.m. – 2:15 p.m.

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² *Micron Technology, Inc. v. Rambus Inc.*, 645 F.3d 1311 (Fed. Cir. 2011), and *Hynix Semiconductor Inc. v. Rambus Inc.*, 645 F.3d 1336 (Fed. Cir. 2011).

³ *Micron*, 645 F.3d at 1320; *Hynix*, 645 F.3d at 1345.

⁴ *Micron*, 645 F.3d at 1319.

⁵ *Hynix*, 645 F.3d at 1345.

⁶ *Id.* at 1340.

⁷ *Micron*, 645 F.3d at 1332; *Hynix*, 645 F.3d at 1355.

⁸ *Micron*, 645 F.3d at 1332.

⁹ *Id.* at 1317.

¹⁰ *Id.* at 1318.

¹¹ *Id.*

¹² *Id.*

¹³ *Micron*, 645 F.3d at 1320.

¹⁴ *Id.*

¹⁵ *Id.* at 1320, 1322.

¹⁶ *Id.* at 1322.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Micron*, 645 F.3d at 1323.

²⁰ *Id.*

²¹ *See id.* (“[Rambus] actively broadened its claims to cover JEDEC standard-compliant products . . .”).

²² *Id.*

²³ *Id.* at 1325.

²⁴ *Id.*

²⁵ *Micron*, 645 F.3d at 1322.

²⁶ *Id.* at 1325.

²⁷ *Id.* at 1327.

²⁸ *Id.* (quoting *Schmid v. Milwaukee Elec. Tool Corp.*, 13 F.3d 76, 81 (3d Cir. 1994)).

²⁹ *Id.* at 1327-28.

³⁰ *Id.* at 1328.

³¹ *Micron*, 645 F.3d at 1328-29 (citing *Shepherd v. ABC*, 62 F.3d 1469, 1472, 1477 (D.C. Cir. 1995)).

³² *Id.* at 1328 (quoting *Wilson v. Volkswagen of Am., Inc.*, 561 F.2d 494, 504 (4th Cir. 1977)).

³³ *See id.* (“If it is shown that the spoliator acted in bad faith, the spoliator bears the ‘heavy burden’ to show the lack of prejudice to the opposing party . . .”) (citing *Anderson v. Cryovac, Inc.*, 862 F.2d 910, 925 (1st Cir. 1988)).

³⁴ *See id.* (stating that the question of prejudice “turns largely” on whose is the burden of proof and thus on the determination of bad faith).

³⁵ *Id.* at 1329.

³⁶ *Id.* (citing *Schmid*, 13 F.3d at 79).

³⁷ *Hynix*, 645 F.3d at 1345.

³⁸ *See id.* at 1346 (“Contingencies whose resolutions are reasonably foreseeable do not foreclose a conclusion that litigation is reasonably foreseeable” and “[t]he narrow standard applied by the district court vitiates the reasonable foreseeability test . . .”).

³⁹ *Id.* at 1347.

⁴⁰ *See Micron*, 645 F.3d at 1332 (“[T]he majority does not review the district court’s sanction award for an abuse

of discretion, instead it reviews the facts and weighs the evidence before it substitutes its judgment for that of the district court . . .”) (Gajarsa, J., dissenting); *Hynix*, 645 F.3d at 1355 (dissenting from the decision regarding spoliation “for the same reasons noted in my dissent in *Micron* . . .”) (Gajarsa, J., dissenting).

⁴¹ *Hynix*, 645 F.3d at 1355.

⁴² *In re Hitachi Television Optical Block Cases*, No. 08-cv-1746 DMS (NLS), 2011 U.S. Dist. LEXIS 90882, at *41 (S.D. Cal. Aug. 12, 2011) (quoting *Micron Technology, Inc. v. Rambus Inc.*, 645 F.3d 1311, 1326 (Fed. Cir. 2011)).

⁴³ *Id.* at *46 (“[The Hitachi employee’s] reason for deleting files was truly personal, that is, to cover up a prior misrepresentation to Hitachi that he had no work files at home.”).

⁴⁴ *See id.* at *47 n.20 (“Hitachi candidly admitted the deletion and attempted to alleviate all prejudice from the deletion.”), *id.* at *52 (noting Hitachi “contacted Plaintiffs with remedial offers attempting to lessen the damage voluntarily and swiftly,” including “voluntarily pa[ying] for the forensic recovery” of deleted files and “the costs to produce a new 30(b)(6) witness in the United States”).

⁴⁵ *Id.* at *53, 56 (declining to impose fee shifting under either the court’s inherent power or under Rule 37 of the Federal Rules of Civil Procedure).

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As Time Goes By – The NCIPLA in its Heyday

by Dale Carlson

My last column briefly touched upon the role that the National Council of IP Law Associations (“NCIPLA” and its predecessor “NCPLA,” also referred to as “the Council”) played in shaping IP reform legislation, notably the Patent Act of 1952.

Formed in 1934, just twelve years after our Association was born, the NCIPLA was envisioned from the start as a forum for information, discussion and debate about IP legislative initiatives of the day. Evidence that the NYIPLA was a proud member can be discerned from the notation at the bottom of the first page of each of our Association’s Greenbooks in prior decades: “MEMBER NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS.”

Up until 1967, the delegates to the Council came from the ranks of “principal executive officers” of the member associations.¹ By virtue of this rather amorphous designation, several officers from a single IP law association presumably could simultaneously be counted as delegates, e.g., the association’s president, vice-president, treasurer etc. Also, depending upon the length of the term of office within their association, the delegate’s tenure might have been as short as one year.²

During 1967, our Association Past President John T. Kelton [1967-68] headed an NCIPLA committee charged with providing a vehicle for having each member association designate one Councilman who need not be a principal executive officer of the member association. Thus, each member association would have a single designee who might serve a term of several years, providing an enhanced sense of continuity and permanence to their role on the Council.

At an NCIPLA meeting in Boston on May 12, 1967, the Kelton committee presented its report



regarding changes to the by-laws. “After considerable animated debate,”³ the

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NCIPLA adopted new by-laws which stood the test of time. Decades later, in the 1990s, I had the honor of serving as the NCIPLA delegate from the Connecticut IP Law Association.

Through the years, the NCIPLA served as a vehicle for the local and regional IP law associations to have their voices heard in the halls of Congress. For example, back in 1971 the Senate Subcommittee on Patents, Trademarks and Copyrights held hearings on certain amendments (“the Scott Amendments”) to a Patent Law Revision Bill pending in Congress.

Past NCIPLA Council Chair Howard I. Forman succinctly summed up the NCIPLA’s role at the hearings as follows: “Also testifying . . . was the NCPLA Chairman, Bill Pravel. He spoke, with the prior express authorization of 19 of the NCPLA member associations, regarding positions taken individually by each of them relative to the Scott Amendments.”⁴

Mr. Forman went on to note: “Obviously, in a crowded schedule of witnesses at the three days of the Hearings, many if not most of those 19 associations would not have been heard if they had sought to be represented individually. But through the vehicle of the NCPLA organization, each was able to be ‘heard’ and its testimony recorded so that interested members of the Congress will be able to observe the views of the Scott Amendments held by their constituents represented by those 19 associations.”⁵

With the past as prologue for the future, perhaps the NCIPLA will be reborn or reconstituted to ensure that the local and regional IP law associations have a voice in Congress, as they did before. Perhaps you will help make this possibility become a reality for the betterment of our Association and our profession.

With kind regards,
 Dale Carlson

(Endnotes)

¹ See Forman, Howard I., “An Up-Dated History of National Council of Patent Law Associations,” 53 J. Pat. Off. Soc’y 439, 441 (July 1971).

² *Id.* at 445.

³ *Id.* at 447.

⁴ *Id.* at 462.

⁵ *Id.*

On Thursday, November 3, 2011, the NYIPLA hosted a Fall One-Day Patent CLE Program at the Princeton Club. The program included four panels. Panel I addressed “Ethical Considerations in Prosecution and Litigation.” Panel II addressed “The Supreme Court’s Increased Interest in Patent Law.” Panel III addressed “Litigation Trends and Issues.” Panel IV addressed “Changes in the Bar to Challenging Patents.”

Panel I – Ethical Considerations in Prosecution and Litigation

The members of Panel I, which was moderated by William Thomashower of Schwartz & Thomashower LLP, were Philip Hirschhorn from Buchanan, Ingersoll & Rooney PC; Scott Stimpson from Sills Cummins & Gross PC; Paul Ackerman from Dorsey & Whitney LLP; and Richard Raysman from Holland & Knight LLP.

Mr. Hirschhorn spoke on inequitable conduct. He discussed the historical background of the inequitable conduct defense, including the evolving standards for the defense, the reasons for the popularity of asserting the defense, and concerns raised by courts that the defense has been overused. He then discussed the Federal Circuit’s *en banc* decision in *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276 (Fed. Cir. 2011), and how it changed the standards for the inequitable conduct defense. Finally, he discussed the PTO’s proposed rule-making in connection with the materiality standard for disclosure to the PTO in light of the *Therasense* decision.

Mr. Stimpson spoke on spoliation. He discussed when the duty to preserve and to issue a litigation hold arises for patent owners and for potentially accused infringers, what must be done to comply with the duty to preserve documents and electronic files when that duty arises, and recent precedents addressing the bad faith and materiality requirements.

Mr. Ackerman spoke on vexatious litigation. He discussed the legal framework for assessing sanctions in patent litigation arising from bad faith litigation and litiga-

tion misconduct, including Rule 11 and the “exceptional case” standard under 35 U.S.C. § 285. He then discussed the application of this legal framework in the Federal Circuit’s decision in *Eon-Net LP v. Flagstar Bancorp*, 653 F.3d 1314 (Fed. Cir. 2011), in which a sanctions award of more than \$600,000 was affirmed.

Mr. Raysman spoke on injunctions and sanctions. He discussed the requirements for granting permanent injunctions, including the requirements for the scope and content of injunctions, and the test for determining whether sanctions are appropriate when an adjudicated infringer is accused of violating an injunction. He then discussed how the Federal Circuit’s *en banc* decision in *TiVo Inc. v. EchoStar Corp.*, 646 F.3d 869 (Fed. Cir. 2011), changed the test for determining whether contempt proceedings are appropriate, and surveyed recent district court decisions that applied the *TiVo* decision.

Panel II – The Supreme Court’s Increased Interest in Patent Law

The members of Panel II, which was moderated by David Bomzer from Day Pitney LLP, were Dorothy Auth from Cadwalader, Wickersham & Taft LLP; Robert Fisher from Fitzpatrick, Cella, Harper & Scinto; James Rhodes, Jr. from Sivin & Tobin Associates; and Professor Michael Burstein from Cardozo Law School.

Ms. Auth spoke on induced infringement. She reviewed the Supreme Court’s decision in *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011), which held that “willful blindness” can be sufficient to satisfy the knowledge requirement of a claim for inducement of infringement under 35 U.S.C. § 271(b). She discussed the background of inducement of infringement and the development of the knowledge requirement for inducement prior to *SEB*, and reviewed subsequent cases that cite *SEB*.

Mr. Fisher spoke on patent eligibility and the standard for invalidity. He reviewed the Supreme Court’s decision in *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, (2011), which held that all issued patents are presumed valid under 35 U.S.C. § 282 and

that the clear and convincing evidence standard applies, even for prior art that was not considered by the PTO during the prosecution of the patent. He also reviewed the Supreme Court and Federal Circuit decisions in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010), and *Prometheus Labs., Inc. v. Mayo Collaborative Servs.*, 628 F.3d 1347 (Fed. Cir. 2010), *cert. granted*, 131 S. Ct. 3027 (2011) (argued Dec. 7, 2011), which addressed the issue of patentable subject matter under 35 U.S.C. § 101.

Mr. Rhodes spoke on assignment of patent rights. He reviewed the Supreme Court's decision in *Bd. of Trustees of Leland Stanford Junior University v. Roche Molecular Sys., Inc.*, 131 S. Ct. 2188 (2011), which held that ownership of an invention flows from an inventor's actual assignment of that invention, not from an inventor's mere agreement to assign the invention. Mr. Rhodes further discussed how that decision is likely to affect assignment practice, including how employers should structure agreements to ensure they retain rights to patents.

Professor Burstein spoke on the changing role of the Supreme Court in reviewing federal circuit decisions. He discussed the history of the Federal Circuit and its role in deciding patent cases, as well as the history of the Supreme Court's review of Federal Circuit decisions, which had been rare but has increased substantially in recent years. Professor Burstein analyzed the Supreme Court's increasing role in reviewing Federal Circuit decisions and provided his views about the nature of the Supreme Court's current approach to patent law.

Panel III – Litigation Trends And Issues

The members of Panel III, which was moderated by Robert Rando from the Rando Law Firm, were Rory Radding from Edwards Wildman Palmer LLP; Robert Isackson from Orrick Herrington & Sutcliffe LLP; and Renee Sekino Wolfe from Milbank, Tweed, Hadley & McCloy LLP.

Mr. Radding spoke on strategic use of reexamination. He discussed the background of the patent reexamination process, including *ex parte* and *inter partes* proceedings prior to the America Invents Act ("AIA"). He described the differences in the standard of review between the courts and the PTO, and discussed the strategic use of reexamination *vis-a-vis* litigation, including the advantages

and disadvantages of reexamination. He concluded that the strategic use of reexamination will continue post-AIA and described the additional procedures provided by the AIA.

Mr. Isackson spoke on compulsory licensing after a finding of infringement. He discussed the background of the Supreme Court's decision in *eBay Inc. v. MercExchange LLC*, 547 U.S. 388 (2006), which held that there was no special rule for awarding injunctions in patent cases, increasing the likelihood that adjudicated infringers could continue to infringe. He reviewed the issues left open by that decision, the guidance from the Federal Circuit on the issue, and the approaches taken by the district courts regarding procedures for determining compulsory licensing rates. Those approaches include court-ordered negotiation, bypassing negotiation where the parties' respective positions would render negotiation fruitless, determining the considerations applicable to assessing an ongoing royalty, awarding fully paid-up lump sum damages, and awarding lost profits combined with an ongoing royalty.

Ms. Wolfe spoke on current challenges of electronic discovery and outsourcing. She discussed the background of the Federal Rules of Civil Procedure relating to electronic discovery and discussed trends in the case law from leading cases regarding e-discovery issues. Those issues include parties' obligations with respect to identifying search terms and best practices for avoiding sanctions. She then discussed outsourcing trends, including the circumstances in which outsourcing may be the better option to follow based on the potential benefits of outsourcing as compared to in-sourcing. Finally, she provided some tips for avoiding potential pitfalls.

Panel IV – Changes In The Bar To Challenging Patents

The members of Panel IV, which was moderated by Alicia Russo from Fitzpatrick, Cella, Harper and Scinto, were James Gould from Locke Lord Bissell & Liddell LLP; Jay Lessler from Blank Rome LLP; and Reza Green from Novo Nordisk.

Mr. Gould spoke on the PTO alternatives to full litigation under the new patent law. He discussed the four ways under the AIA to challenge a patent

cont. on page 10

cont. from page 9

in the PTO, including *ex parte* submissions at any time, post-grant review within nine months of patent issue, transitional post-grant review of business method patents, and *inter partes* review after nine months from issue. He described the pros and cons of each of these compared to district court litigation, with a special focus on *inter partes* review and its speed, limited discovery, decisions by specialized administrative law judges, preponderance of the evidence standard and direct appeal to the Federal Circuit. He also discussed the use of *inter partes* review by generic drug companies to initiate a challenge to patent validity during the period of FDA exclusivity for a new chemical entity before an ANDA can be filed.

Mr. Lessler spoke on challenging the validity of patents. He discussed how the Federal Circuit has applied the test for obviousness following the Supreme Court's decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), which rejected the "teaching-suggestion-motivation" test as determinative of obviousness, but allowed that it provided

a helpful insight. He focused his review on how the Federal Circuit has been analyzing obviousness for inventions involving chemical compounds.

Dr. Green spoke on Patentable Subject Matter: *Myriad* and Patentability of DNA Molecules. She discussed the reasoning for the district court's decision in *Ass'n for Molecular Pathology v. U.S. Patent and Trademark Office and Myriad Genetics, Inc.*, 702 F. Supp. 2d 181 (S.D.N.Y. 2010), which created a standard that DNA is not patentable as a "physical embodiment of laws of nature" and that diagnostic claims applying no transformative step and method claims for screening cancer therapeutics are not patentable. She then reviewed the divided decision of the Federal Circuit, 653 F.3d 1329 (Fed. Cir. 2011), that overruled the district court's decision, holding that isolated DNA and cDNA are patentable, as are the method claims for screening cancer therapeutics. Dr. Green also addressed the impact that the Federal Circuit may have on biologic and business model patents in the future and the likelihood of a rehearing *en banc*.

Judge Rader's Remarks at the December 15 CLE Luncheon

by Caroline Thufason¹

The Honorable Randall R. Rader, Chief Judge of the U.S. Court of Appeals for the Federal Circuit, spoke at the NYIPLA's CLE Luncheon Program on Thursday, December 15, 2011 at the Union League Club.

Judge Rader offered the audience a choice of topics, and they chose to have him discuss the Supreme Court's handling of IP cases, including the relationship between the Federal Circuit and the Supreme Court. While he acknowledged the audience's choice, Judge Rader also spent a few minutes on other topics as well:

1. State of the Federal Circuit - The Federal Circuit has welcomed new judges, and the court is ready to handle an interesting docket. Judge Rader mentioned his excitement about the Patent Pilot Program to develop expertise in the district courts, and he appreciates the chance to more evenly distribute patent cases with the participating courts.

2. e-discovery Model Order - Most of the audience knew that the Federal Circuit Advisory Council had drafted and adopted a Model Order governing e-discovery. Some attendees had also attended Judge Rader's speech at the Eastern District of Texas

where the Model Order was introduced. Judge Rader briefly explained the elements of the Model Order and discussed its goal to aid trial courts in crafting orders tailored to the facts and circumstances of each case by limiting the number of custodians and search terms.

3. Bright Line and Balancing Tests - Most of the speech offered thoughtful insights on the interplay between the Supreme Court and the Federal Circuit on IP cases. The most interesting comment was Judge Rader's comparison of the Supreme Court as focusing on its "constitutional sandbox" while the Federal Circuit is more like Legoland.

Judge Rader noted the different goals of the Supreme Court and Federal Circuit. The Supreme Court often strikes a balance between two equally important judicial doctrines, for example having to weigh free innovation against effective competition. The main task of the Federal Circuit is to achieve certainty for its users by making bright line rules that are applicable in the marketplace. Judge Rader stated that this is the message that comes across whenever he speaks to the users of the Federal Circuit, *e.g.*, CEOs from both the plaintiff and defendant sides and

CLE PROGRAMS

other people in the marketplace who are dependent on making decisions based on the rules created by the courts. Those users often reiterate their need for predictability and claim they do not really care what the rule is, because they are able to adapt to it. For example, those companies do not care if DNA is patentable or not, Judge Rader said, so long as the same goes for their competitors. Judge Rader emphasized that is why there is virtue in a bright line. In defending this view, he acknowledged that sometimes the Federal Circuit will make bright line rules that are not quite right. But then again, if the Supreme Court finds that the rule is not quite right, the Justices *will* be sure to let the Federal Circuit know.

Judge Rader made no secret of his displeasure with the *Bilski* decision, but merely said that was a topic for a whole new discussion.

4. Japan and China – The Federal Circuit recently traveled to Japan for a joint judicial conference with the Japan IP High Court. Judge Rader reported on the positive reactions from everybody involved. The main topics discussed with panelists and audience members were intellectual property issues of mutual interest. The joint meeting was the first of its kind, witnessed by more than 800 judges, lawyers, and

corporate counsels from the U.S. and Japan. Judge Rader stated that he hopes to duplicate the success of the Japan conference in China, where judges are chosen from among government employees and are bound by government policy. Judge Rader hopes to help China appreciate the benefits of an unfettered judiciary and to persuade Chinese judges to improve the treatment of foreign litigants.

5. *En banc* reviews and *Amicus* Briefs – Judge Rader said that under his guidance the Federal Circuit has increased the number of *en banc* reviews from 2-3 a year to 4-6 a year. He joked that all losing parties are seeking *en banc* review these days, so Judge Rader urged the stakeholders to write *amicus* briefs that are helpful in pointing out which cases really need the *en banc* review. Judge Rader prefers when powerful groups of the patent community, for example the NYIPLA, join forces and write *amicus* briefs that will assist in making sure that the important cases are spotted.

(Footnotes)

¹ Caroline Thufason is a Danish IP litigator, who holds an LL.M. with a law and technology certificate from UC Berkeley. She is currently a legal intern in the New York office of Fish & Richardson P.C.

Judge Gleeson's Remarks at the January 26 CLE Luncheon

by Brian Rothery

On January 26, 2012, the NYIPLA Committee on Meetings and Forums hosted a Continuing Legal Education (CLE) luncheon at the Union League Club. The program was entitled “The Patent Pilot Program and Litigating in the Eastern District of New York.” The program was co-sponsored by the NYIPLA Patent Law and Practice Committee. Brian Rothery of Stroock & Stroock & Lavan LLP served as moderator.

Judge John Gleeson from the United States District Court for the Eastern District of New York spoke to a packed audience on the Patent Pilot Program. Judge Gleeson volunteered and was designated as one of five (5) judges from the Eastern District who would be participating in the Patent Pilot Program. Judge Gleeson spoke about the origins of the Act that created the Patent Pilot Program, its enactment in January 2011 and the criteria by which a district court was selected to participate in the Pilot Program. Judge Gleeson indicated that to be selected into the pilot program a district court had to be one of fifteen (15) district

courts to have the largest number of patent cases filed, or a district court that had adopted or certified it would adopt local rules specific for patent cases. Judge Gleeson advised that the Eastern and Southern Districts are currently considering draft local rules for patent cases, and that members from the NYIPLA had been active in the process of drafting those rules, including NYIPLA President Terri Gillis.

Fourteen district courts were selected for the patent pilot program including the Eastern District of New York and the Southern District of New York. Judge Gleeson explained how the program would work, namely, a new patent case would be randomly assigned to a district court judge in the first instance like any other case; if the case is assigned to a judge who does not participate in the pilot program, the judge who has been selected to the case may decline the case; and then the case would be randomly assigned to a judge participating in the program. Judge Gleeson offered his opinion that judges who are not participating in the program may not decline patent cases as readily as anticipated.

MINUTES OF NOVEMBER 11, 2011
MEETING OF THE BOARD OF DIRECTORS OF
THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

BOARD MINUTES

The meeting of the Board of Directors was called to order at the offices of Mayer Brown, LLP, 1675 Broadway, New York, New York at 12:00 P.M. by President Terri Gillis.

In attendance from the Board:

Theresa Gillis	Walter Hanley
Charles Hoffmann	Sue Progoff
Anthony Lo Cicero	Thomas Meloro
Dorothy Auth	Ira Levy
Jeffrey Butler	Bruce C. Haas
Annemarie Hassett	

Dale Carlson, Kevin Ecker and John Moehringer participated by telephone. Absent and excused from the Board were Leora Ben-Ami and Alexandra Urban. Feikje Van Rein was in attendance from the Association's executive office. Also in attendance for an initial presentation were the Co-Chairs of the Patent Practice Committee, Peter Thurlow and Brian Rothery.

Terri Gillis called the meeting to order.

Peter Thurlow and Brian Rothery presented an overview of the SIPO – US Bar Liaison Council. The Council is seeking two delegates to act as part of a US delegation to SIPO. The delegates must understand that their representation is self-funded. The Council will initially be prosecution-focused. The requirements of the representatives are as follows: (1) at least one representative must attend each Council meeting (it is proposed to have one meeting per year); and (2) the representative must be a member of a US intellectual property organization. The meetings will be held in the US and in China on an alternating basis. The Board will request that the delegates report back to us after each SIPO meeting. The Council, through its delegates, will help bridge the differences between the US and China patent systems. The Board approved the appointment of two volunteers for this delegation. Peter and Brian were excused after the completion of their presentation.

The Board approved the Minutes of the October Board meeting.

Jeffrey Butler provided the financial report, reporting that dues were up as compared to last year. Jeffrey reported that the Fall Patent Law One-Day event was also a financial success over last year.

Jeffrey presented a summary of two different proposals from accounting firms for auditing services, i.e., Loeb & Troper and O'Connor Davis. The Board approved that Jeffrey, Charlie Hoffmann and Feikje would meet with each accounting firm.

Jeffrey read the new members' list and the Board approved.

Dorothy Auth reported that the Fall One-Day event was well-attended and successful. Terri reminded the Board members that they should make an effort to attend the Association's CLE events, particularly the Fall One-Day event as it is the Association's most significant CLE event of the year.

Ira Levy reported on the Meetings & Forums events. The Trademark CLE Luncheon had 46 attendees. The upcoming December luncheon will feature Chief Judge Rader. Other upcoming CLE luncheons will be co-sponsored by the Patent Law, Internet/Privacy and Copyright Committees. The event co-sponsored by the Copyright Committee will be in honor of Ron Clayton, who was an active member of and Board Liaison to the Copyright Committee.

Tom Meloro reported that the Amicus Committee was quiet, but that they are following several pending cases.

With regard to the preparations for the Judges' Dinner, Charlie Hoffmann reported that he is currently compiling the Honored Guest list and considering nominees for the Public Service Award. In addition, Feikje prepared a postcard

ATTN: NYIPLA Members

If you have any NYIPLA
 historical records, specifically
 Bulletins (1967-1981),
 Greenbooks (prior to 1951) and
 Judges' Dinner booklets (1973 & prior
 to 1971), please contact Bill Dippert at
wdippert@eckertseamans.com
 or 1.914.286.2813.

for marketing purposes. The Board considered the cost and benefits associated with mailing such a postcard, after which the Board approved the mailing.

Kevin Ecker reported on the progress of the Inventor of the Year Competition and outlined the timing for the competition. Notifications for the competition were mailed out in the beginning of October. Three submissions have been received thus far. The submission period is from Nov. 1- Dec. 15, 2011. Kevin asked the Board whether a law firm can pay the winner's costs to attend the Awards Dinner. The Board approved this arrangement.

John Moehringer reported on the progress of the Connor Writing Competition. His Committee is currently updating its law school contact lists and will announce the competition in the coming weeks.

Jeffrey Butler reported that Mrs. Connor recently passed away.

Bruce Haas reported that new membership was down 48 members as compared to last year (1274 in 2010, 1226 in 2011). However, the membership is significantly up as regards young lawyers. The Board discussed ways to increase the membership numbers. Terri suggested an expansion of the mailing list for events to include non-members. Bruce suggested that the lower membership numbers are a simple reflection of the lower number of Judges' Dinner attendees.

Ira Levy and Dorothy Auth presented suggestions to alter the CLE event rates in an effort to be more attrac-

tive to the membership. Ira discussed possible changes to the structure of luncheon events; for example, he suggested that smaller events could be hosted at sponsor law firms, which could save rental/space fees, whereas larger events could still use rented spaces. Ira also proposed a switch from lunch to evening CLE events which could be held at law firm offices. In addition, Ira suggested the Association consider co-sponsoring events with organizations such as NJIPLA and/or WESFACCA. Dorothy discussed alternative pricing structures such as offering a corporate discount rate for the Association's corporate members.

Tom Meloro and Ira Levy discussed the relationship between the NYIPLA and JPPCLE, in that JPPCLE provides sponsorship money for speakers at NYIPLA events in exchange for their recognition as a co-sponsor on event-associated materials. It was agreed that JPPCLE would be asked to allow the NYIPLA to use the JPPCLE mailing list in exchange for allowing JPPCLE to continue to use the NYIPLA mailing list and name in connection with promotion of the JPPCLE events.

Terri reported that she has received several requests from associations, e.g., from LES, IIPS, Connor Inn and NJIPLA, to create relationships with NYIPLA so that mailing lists can be shared. She asked that the Board consider whether the Association should develop such relationships.

The meeting was adjourned by Terri Gillis at 2:10 pm.

MINUTES OF DECEMBER 13, 2011
MEETING OF THE BOARD OF DIRECTORS OF
THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The meeting of the Board of Directors was called to order at the offices of Mayer Brown, LLP, 1675 Broadway, New York, New York at 12:30 P.M. by President Terri Gillis.

In attendance from the Board:

Theresa Gillis	Walter Hanley
Charles Hoffmann	Sue Progoff
Anthony Lo Cicero	Ira Levy
Dorothy Auth	Bruce C. Haas
Jeffrey Butler	Leora Ben-Ami
Annemarie Hassett	John Moehringer

Dale Carlson and Kevin Ecker participated by telephone. Absent and excused from the Board meeting were Thomas Meloro and Alexandra Urban. Robin Rolfe and Feikje Van Rein were in attendance from the Association's executive office.

Terri Gillis called the meeting to order.

The Board approved The Minutes of the November Board meeting.

Jeffrey Butler provided the financial report, reporting that the association is on a steady course in that the net returns to date are ahead of last year's revenues. Ira Levy asked and Jeffrey confirmed that these advances are largely an issue of timing.

Jeffrey read the new members list and the Board approved.

Ira Levy presented his ideas for alternative Meetings & Forums venues to attract higher attendance and be more convenient for our members. Ira proposed a Meetings & Forums calendar for 2012 that contains a mix of venues such as clubs, firms and schools. Annemarie Hassett reported that the Young Lawyers Committee does not feel that lunchtime is a good time of day for a meeting, particularly when it is outside the office. Instead, the Young Lawyers Committee proposes that meetings be held from 6-8 pm and have a price point of \$35-\$50, with a rate of \$25 for students and \$50 for young lawyers. Terri Gillis agreed that evening meetings are better for her associates.

cont. on page 14

The overall pricing for the Meetings & Forums events was also discussed. Ira Levy pointed out that many firms are no longer sending multiple attorneys to the events due to their expense. In addition, as John Moehringer pointed out, because different organizations are putting on similar or even identical events, e.g., Judge Rader's upcoming day in NY, members are choosing which to attend based on price. Also, John proposed that the Association focus on what makes it unique: (1) our access to Judges and highly trained patent litigators to create and run programs that develop practical skills, such as deposition and trial skills; and (2) our close alignment with top NY IP firms to create and run employment fairs/events. Leora Ben Ami pointed out that the Young Lawyers could particularly benefit from a presentation by a Magistrate Judge discussing how the attorney should appear before the Magistrate, for example. Kevin Ecker suggested the Association present a 3-part course: two parts comprising preparation and the third part being a presentation to a Judge or Magistrate Judge. Terri agreed that this could be an excellent approach. Anthony Lo Cicero agreed and proposed that the course focus on *Markman* hearings and could be tested at the upcoming Annual Meeting.

Ira Levy also proposed the development of a Young Lawyers' curriculum which would consist of a six-month course teaching the trial process from complaint to trial. The course could be presented in monthly installments with a repeat make-up class later in each month. Ira also suggested that these courses be offered in the evenings. Leora pointed out that in order to be successful, such a course must fill a training need for general practice firms that is not otherwise already met. Ira responded that the proposed course could provide IP-specific litigation training which is different from the general litigation courses offered by many firms. Ira also proposed that the course could be priced per session or as a full all-in price. Kevin Ecker suggested that the Association consider streaming the content over the internet in order to attract smaller firm and corporate participants. This added feature could also lower the per person cost. Terri requested that Ira consult with Tom Meloro on the feasibility of preparing such a course program.

Terri Gillis reported that the Amicus Committee had a quiet month.

Jeffrey reported on the progress of the audit project for the Association. Jeffrey, Charlie Hoffmann and Feikje met with the two candidate accounting firms and discussed

the various means for auditing the Association's accounts with each of the firms. After some discussion, the group decided to recommend Loeb & Troper for the Association's accounting needs. The Board approved its retainer.

With regard to the preparations for the Judges' Dinner, Charlie Hoffmann reported that the initial postcards and invitations have been mailed. In addition, Judge Lourie has accepted the award honor and Judge McMahon has confirmed that she will be the honored guest speaker.

Kevin Ecker reported on the progress of the Inventor of the Year Competition. Seven submissions have been received thus far. The deadline for submission is Dec. 15, 2011. Kevin is planning to discuss the submissions with the Board at the January or February 2012 Board meeting.

John Moehringer reported on the progress of the Connor Writing Competition. His Committee has completed updating the charts for law schools and the competition announcement is posted on the Association website. The due date for submission is March 11, 2012. John will present the best submissions to the Board at the April 2012 meeting.

Bruce Haas reported that new membership was down 60 members as compared to last year. He has studied the demographics of this decline and has noticed that it can be attributed to the loss of certain firms as members. However, Terri pointed out that young lawyers as a group are increasing in their membership. A number of suggestions were discussed to increase membership in the Association.

Dorothy Auth reported that the CLE Committee has begun its preparation for the Day of the Dinner CLE Luncheon. The theme for this year's event will be the impact of the AIA on Judges and trials.

Anthony Lo Cicero reported that the Annual Meeting will be held at the Princeton Club and he is working to organize a CLE event. Currently Anthony is considering a *Markman* hearing practical skills event.

Sue Progoff reported on the activities of the Privacy Committee.

Terri reported that the donations committed by the Board member firms for the International Association of Judges - Union Internationale des Magistrats (IAJ-UIM) are now due. Feikje will work to collect the firm pledges. As for the event, the Association will obtain a number of seats for the event which will be distributed to those firms donating the most money.

The meeting was adjourned by Terri Gillis at 2 pm. The Board then conducted an Executive session. ■

Moving UP ▲ & Moving ON >>>

Frankfurt Kurnit Klein & Selz, PC has added **Andrew Hurwitz** as a partner, and **Alan Sacks** as counsel, in the firm's Entertainment Group. Prior to joining Frankfurt Kurnit, Mr. Hurwitz was a partner at the Schreck Rose Dapello Adams & Hurwitz, LLP. Mr. Sacks was a senior associate with the firm.

Jones Day has added **Kelsey Nix** as a partner in the firm's Intellectual Property Practice. Prior to joining Jones Day, Mr. Nix was a partner at Willkie Farr & Gallagher LLP.

The Bulletin has introduced a new feature for the Association's members. If you have changed your firm or company, made partner, received professional recognition, or have some other significant event to share with the Association, please send it to the Bulletin editors: Wanli Wu (wu@wiggjin.com) or Robert Greenfeld (RGreenfeld@mayerbrown.com).

Day of the Dinner CLE Luncheon

The Practical Impact of the America Invents Act on Patent Litigation

➤ Friday, March 23, 2012 ◀

The Waldorf=Astoria Hotel, 301 Park Avenue, New York, NY

EARN NYS/NJS 2.0 CLE PROFESSIONAL CREDITS

followed by

90TH ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY

April CLE Luncheon

Hot News – Hot New Doctrine or Yesterday's News?

➤ Thursday, April 12, 2012 ◀

The Union League Club, 38 East 37th Street, New York, NY

EARN NYS/NJS 2.0 CLE PROFESSIONAL CREDITS

Hosted by the Meetings & Forums Committee and co-sponsored by the Copyrights Committee

NYIPLA Annual Meeting

➤ Tuesday, May 22, 2012 ◀

The Princeton Club, 15 West 43rd Street, New York, NY

Annual Meeting CLE Luncheon "Ethical Issues in IP Practice"

11:30 – 12:00 Registration

12:00 – 12:45 Luncheon

12:45 – 2:30 CLE Presentation

Annual Meeting & Awards Dinner

2:45 – 4:15 Committee Meetings

4:30 – 5:30 Annual Meeting of Members

5:30 – 6:00 Board Meeting

5:30 – 6:30 Cocktail Reception

6:30 – 9:00 Awards Dinner

July Half-Day Hot Topics in Trademark CLE Seminar

➤ Wednesday, July 18, 2012 ◀

The Princeton Club, 15 West 43rd Street, New York, NY

Hosted by the Continuing Legal Education Committee

November Fall One-Day Patent CLE Seminar

➤ Thursday, November 1, 2012 ◀

The Princeton Club, 15 West 43rd Street, New York, NY

EARN NYS/NJS 7.0 CLE PROFESSIONAL CREDITS INCLUDING 2.0 ETHICS CREDITS

Hosted by the Continuing Legal Education Committee

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The *Bulletin* is published bi-monthly for the members of The New York Intellectual Property Law Association.
Annual Non-Member Subscription is \$25.00. Single copies are \$10.00 each.

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