

**United States Court of Appeals
FOR THE FEDERAL CIRCUIT**

PRINCO CORPORATION and PRINCO AMERICA CORPORATION,
Appellants,

v.

INTERNATIONAL TRADE COMMISSION,
Appellee,

and

U.S. PHILIPS CORPORATION,
Intervenor.

On Appeal from the United States International Trade Commission in
Investigation No. 337-TA-474

**NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION'S
MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* IN SUPPORT
OF PHILIPS' MOTION FOR REHEARING *EN BANC* AND IN
OPPOSITION TO PRINCO'S MOTION FOR REHEARING *EN BANC*,
AND MOTION FOR LEAVE TO FILE OVERLENGTH BRIEF**

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JULY 2, 2009

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I. PROCEDURAL BACKGROUND FACTS

The New York Intellectual Property Law Association (“NYIPLA” or “the Association”), pursuant to Fed. Cir. R. 29(a) and 35(g), and Fed. R. App. P. 29(a) and (b), respectfully moves for leave to file *instanter* its brief *amicus curiae* (i) in opposition to the petition for rehearing by appellants (collectively “Princo”), and (ii) in support of the petition for rehearing by intervenor (“Philips”). The Association also seeks leave to file a brief longer than the 10 pages specified by Fed. Cir. R. 35(g).

A. The Petitions and the Panel Decision

The petitions of Philips and Princo address two separate portions of the panel decision:

1. Princo seeks rehearing of the panel’s affirmance of the ITC’s rejection of the defense of patent misuse predicated on the allegation that the Philips patents asserted against Princo were bundled with Sony’s U.S. Patent 4,942,565 (the “Lagadec patent,” which expired in September 2007) in an unlawful mandatory package license, which both Princo and the panel decision refer to as “tying.” On this issue, Judge Gajarsa joined in the opinion of Judge Dyk and Judge Bryson concurred, writing “that the majority’s ground for decision is also correct and offers a satisfactory alternative rationale for affirming the Commission’s

determination on that issue.” *Princo Corp. v. Int’l Trade Comm’n*, 563 F.3d 1301, 1321 (Fed. Cir. 2009) (Bryson, J., concurring in the result in part and dissenting in part) (“*Princo I*”).

2. Philips seeks rehearing of the panel’s decision that the action must be remanded to the ITC for three separate determinations in respect of Princo’s defense of “patent misuse by horizontal price fixing:” (i) whether the record supports the existence of some horizontal agreement between Sony and Philips “to prevent Langadec from being licensed as a competing technology” (*id.* at 1313, 1319-21); (ii) where on the “continuum” of potential commercial viability the standard for the putative misuse of suppression of alternative technology should be placed (*id.* at 1319); and (iii) whether the record establishes that this standard was met with respect to those claims of Lagadec other than claim 6, which presumably do not apply to Orange Book-compliant discs (*id.* at 1319 n.14). The panel decision refers to the rule of reason (*id.* at 1314 n.11); never defines the product market within which the alleged horizontal restraint is said to operate; suggests that the nature of the restraint is such that anticompetitive effects within that undefined market may be presumed (*id.* at 1315-16); and concludes that “[s]uch agreements are not within the rights granted to a patent holder.” (*Id.* at 1316). On this issue, Judge Bryson dissented, writing that the ITC’s “findings of fact and legal conclusions provide a sufficient ground for upholding the Commission’s ruling

that Princo has failed to satisfy its burden of showing patent misuse through a horizontal price-fixing agreement.” (*Id.* at 1323).

B. Prior Proceedings

This is the second time that this almost seven-year-old Section 337 action has been before the Court on appeal from a final determination of the ITC. In the first ITC decision of March 2004, the Commission affirmed the ALJ’s October 24, 2003 Initial Determination (“ID”) and found 29 claims of Philips’ patents infringed by Princo and not invalid. Relief was nevertheless withheld by the Commission on the theory that the “essential” Philips patents asserted against Princo were unenforceable for misuse because Philips had packaged them in licenses with several “nonessential” patents.¹ *In re Certain Recordable Compact Discs and Rewriteable Compact Discs Comm’n Opinion*, No. 337-TA-474 (U.S.I.T.C. Mar. 11, 2004), *available at* www.usitc.gov.

On the first appeal to this Court, Princo and the ITC argued that the ruling should be affirmed because the Philips package licenses were (i) *per se* unlawful by analogy with the product tying cases and the block-booking cases; and (ii) were unlawful under the rule of reason. Those arguments were squarely rejected in *U.S. Philips Corp. v. Int’l Trade Comm’n*, 424 F.3d 1179 (Fed. Cir. 2005) (“*Philips I*”).

¹ The ALJ had determined that a total of twelve patents included in one or more of the Philips Orange Book licenses were “nonessential,” but the 2004 Commission Decision considered only four of those twelve patents.

The action was remanded to resolve any additional outstanding alleged misuse defenses.² On remand, Princo focused its arguments on putative misuse defenses allegedly arising from inclusion of the Lagadec patent in the Orange Book licenses, and the Commission rejected those arguments in the 2007 Commission Ruling.

II. TECHNICAL BACKGROUND FACTS

A. The Orange Book Standards and the Philips Licenses

This action involves the two very successful licensing programs of Philips under the “Orange Book” industry standards for recordable (CD-R) and re-writeable (CD-RW) compact discs. The technology for those standards was developed jointly by Philips and Sony, and the Orange Book standards were jointly authored to reflect the product of the joint venture to which both made technological contributions. Patents were contributed for use under the licensing program by Philips, Sony, and two other firms.

A CD-R compact disc is a recordable compact disc upon which information can be written once in a CD-R recorder or computer drive, and read or played back on a CD-player or CD-ROM drive. CD-R compact discs can be used for both

² “Because the Commission did not address all of the issues presented by the administrative law judge’s decision under both the per se and rule of reason analysis, further proceedings before the Commission may be necessary with respect to whether Philips’s patents are enforceable and, if so, whether Philips is entitled to any relief from the Commission.” *Philips I*, 424 F.3d at 1198.

audio and data recording. All blank CD-R compact discs conform to Orange Book Part II (CD-R) specifications and should work in all recorders and computer drives manufactured under the Orange Book CD-R or CD-RW standards.

A CD-RW compact disc is a recordable compact disc upon which information may be written, erased, overwritten and read. CD-RW compact discs can be used for both audio and data recording. A CD-RW compact disc, once recorded, must be read or played back on either a CD-RW drive or a player designed to read lower reflectivity compact discs. All blank CD-RW compact discs conform to Orange Book Part III (CD-RW) specifications and should be compatible with all recorders and computer drives manufactured under the Orange Book CD-RW standard.

The six Philips patents at issue in this action are broadly licensed to the industry by Philips on a nonexclusive basis for the manufacture and sale of such CD-R and CD-RW compact discs that comply with the Recordable CD-R and Rewritable CD-RW Orange Book standards.

B. Analog ATIP and the Raaymakers and Lagadec Patents

Two of the six Philips patents at issue in this action, the Raaymakers patents, relate to an analog method by which a CD-R or CD-RW recorder or computer drive can determine where its laser is positioned along the spiral pre-groove track

of the compact disc.³ The Philips method, known as the “Absolute Time in Pre-groove” or “ATIP” method, built upon the preexisting wobble signal technology already used to supply velocity control. *See Princo I*, 563 F.3d at 1305-06.

Sony’s Lagadec patent claimed a digital method for accomplishing the same objective. As the panel wrote, “there is no dispute that a disc made using one technological approach would not work in an [sic] CD recorder designed to read position data using the other.” *Id.* at 1306. It also found, however, that claim 6 of the Lagadec patent was sufficiently broad to read on CD-R and CD-RW compact discs using the Raaymakers technology that complied with the Orange Book standards. *Id.* at 1311-12.

C. Interchangeability and Installed Capacity Considerations

Once Philips and Sony agreed to employ the Raaymakers approach rather than that of Lagadec for the two Orange Book standards, every recorder or computer drive unit that was manufactured and sold under those standards could be considered a part of an installed base that would not be available as part of the potential market for compact discs manufactured and sold under some hypothetical

³ United States Patent 4,999,825 (the “Raaymakers ’825 patent”) expired on November 1, 2008. United States Patent 5,023,856 (the “Raaymakers ’856 patent”) expired on June 11, 2008.

competing compact disc standard that would employ Lagadec rather than Raaymakers technology.

Unless any new type of recordable or re-writeable compact disc is backwards-compatible with recorder and computer drive units already installed in the marketplace, it would not be expected to compete effectively for incremental market share unless the new generation of recorders and computer drives represented a generational paradigm shift—such as the change from vinyl to the CD-DA standard of the Red Book.⁴

III. STATEMENTS REQUIRED UNDER THE RULES

A. Amicus Curiae NYIPLA

The NYIPLA is a bar association of more than 1,600 attorneys whose professional interests and practices lie principally in the areas of patents, copyrights, trademarks, trade secrets and other forms of intellectual property. Since its founding in 1922, the NYIPLA has committed itself to maintaining the integrity of the United States patent law and to the proper application of that law and the related bodies of contract and trade regulation law to commercial transactions involving patents.

⁴ The more common setting for such an improved second generation standard is typified by the Blu-Ray DVD players which are capable of playing first generation DVDs in addition to the new high definition Blu-Ray discs.

As can be seen from the Association's website, over the past decade, the NYIPLA has filed a number of briefs *amicus curiae* with this Court and the Supreme Court in actions involving the interface between the law of patents and the antitrust laws and misuse doctrine.⁵ Beginning with the brief *amicus curiae* filed by the Association in the *Xerox (ISO)* litigation,⁶ we have consistently opposed unwarranted expansion of antitrust theories and the defense of misuse as putative bars to the enforcement of patents found valid and infringed. The Association believes that the theories adopted by the majority in the panel decision here represent an unwarranted expansion of existing law.

B. Representations of the *Amicus Curiae* NYIPLA

The NYIPLA and its undersigned counsel represent that they have authored the brief *amicus curiae* submitted herewith, that no party or counsel for a party in this proceeding authored any part of that brief, and that no person other than the NYIPLA, its members or its counsel, including any party or counsel for a party, made any monetary contribution intended to fund the preparation or submission of

⁵ A separate listing of briefs *amicus curiae* filed by the Association is maintained on the website (www.nyipla.org).

⁶ *In re Indep. Serv. Orgs. Antitrust Litig.*, 203 F.3d 1322 (Fed. Cir. 2000) ("*Xerox(ISO)*"), a case considered by the ALJ at page 160 of the Commission's Initial Determination. *See In re Certain Recordable Compact Discs and Rewriteable Compact Discs Initial Determination*, No. 337-TA-474 (U.S.I.T.C. Oct. 24, 2003), available at www.usitc.gov as part of Pub. 3686.

that brief. The arguments set forth in the brief *amicus curiae* submitted herewith were approved on or about June 30, 2009 by an absolute majority of the total number of officers and members of the Board of Directors of the NYIPLA (including such officers and Board members who did not vote for any reason including recusal), but may not necessarily reflect the views of a majority of the members of the NYIPLA or of the organizations with which those members are affiliated. After reasonable investigation, the NYIPLA believes that no officer, or member of its Board or Amicus Committee who voted in favor of that brief, or any attorney in the law firm or corporation of such officer, Board or Committee member, or attorney who aided in the preparation of that brief represents a party in this litigation. Some officers, Board or Committee members or other attorneys in their respective law firms or corporations may represent entities, including other *amici curiae*, which have an interest in other matters that may be affected by the outcome of this proceeding.

C. Required Notices

Counsel for all parties were informed via e-mail letter on June 19, 2009, of the Association's intent to file this motion. Philips consented. The ITC responded that it "will take no position with respect to NYIPLA's motion." Princo responded that it

does not object to NYIPLA’s motion for leave to file an amicus brief insofar as *that brief supports Philips’ petition* for rehearing en banc with regard to the issue of patent misuse by horizontal price fixing.

Princo also “does not oppose NYIPLA’s motion for leave to file an amicus” brief that “would *oppose Princo’s petition* for rehearing with respect to tying,” but “reserves the right, and asks that the Court consider allowing Princo to reply to NYIPLA’s amicus brief if appropriate.”⁷

IV. GROUNDS FOR THE MOTIONS

A. The Importance of the Issues

Today the rational and considered application of the patent law at its interface with the antitrust laws and the patent misuse doctrine is critically important to the economy of the United States—perhaps most importantly and specifically in the burgeoning area of industry pooling and standard setting organizations (“SSOs”), and the agreements under which the pooled patents applicable to those industry standards are licensed.

Moreover, as was recently reaffirmed in a slightly different context,⁸ this Court recognizes a long-standing policy favoring settlements of patent litigation.

⁷ Because Princo requested that the full text of its response be made available to the Court, the pertinent email exchanges are attached as Exhibits 1 and 2 to this motion.

⁸ *In re Ciprofloxacin Hydrochloride Antitrust Litig.*, 544 F.3d 1323 (Fed. Cir. 2008) (“*Cipro*”).

A necessary corollary of that policy is that mechanisms designed to obviate patent disputes entirely before they arise should likewise be favored. SSOs and patent pools that license broadly and non-exclusively on reasonable and non-discriminatory (“RAND”) terms represent important examples of such mechanisms.⁹

It is likewise important for this critically important sector of the economy that the Court remain vigilant lest application of the defense of unenforceability for misuse should be expanded without warrant. In *Windsurfing Int’l, Inc. v. AMF, Inc.*, 782 F.2d 995 (Fed. Cir. 1986), the Court held that:

To sustain a misuse defense involving a licensing arrangement not held to have been per se anticompetitive by the Supreme Court, a factual determination must reveal that the overall effect of the license tends to restrain competition unlawfully in an appropriately defined relevant market. (Footnote omitted).

Id. at 1001-02.

⁹ At this critical economic juncture, when the potential for the economic reward granted to the patentee is under attack from all sides, the pitfalls of the misuse defense should not be further expanded to provide even less incentive for the disclosures which the framers determined would “promote the progress of science and useful arts.”

The *Windsurfing* rule has been followed consistently by the Court.¹⁰ Just as with the *Clorox* rule of the Second Circuit recently endorsed in *Cipro*,¹¹ speculation, hypothesis or conjecture should never be permitted to substitute for the factual showings required under the principles of *Windsurfing*.

B. Prior History of the Association's Involvement in this Action

On August 27, 2004, the NYIPLA submitted a brief *amicus curiae* on the merits in *Philips I*, supporting Philips and addressing the arguments raised by Princo and the Commission ("NYIPLA *Philips I* Brief").¹² As the NYIPLA *Philips I* Brief indicated (at 11), every effort was made to avoid duplicating

¹⁰ See, e.g., *Monsanto Co. v. McFarling*, 363 F.3d 1336 (Fed. Cir. 2004); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340 (Fed. Cir. 1998); *Virginia Panel Corp. v. MAC Panel Co.*, 133 F.3d 860 (Fed. Cir. 1997).

¹¹ *Clorox Co. v. Sterling Winthrop, Inc.*, 117 F.3d 50, 56 (2d Cir. 1997), outlined the three-step rule of reason process as follows:

First, the plaintiff bears the initial burden of showing that the challenged action has had an actual adverse effect on competition as a whole in the relevant market. Then, if the plaintiff succeeds, the burden shifts to the defendant to establish the pro-competitive redeeming virtues of the action. Should the defendant carry this burden, the plaintiff must then show that the same pro-competitive effect could be achieved through an alternative means that is less restrictive of competition.

(citations omitted).

¹² The Association also moved on November 18, 2004 for permission to file a reply brief, but that motion was denied in the Court's Order of January 5, 2005. Both briefs are available on the NYIPLA's website (www.nyipla.org).

arguments previously articulated by Philips. The same effort will be made in this action.

In rejecting the tying theories the Commission had applied to the claim that the Orange Book licenses contained unlawful package licensing provisions, the *Philips I* opinion of Judge Bryson incorporated two arguments made only by the NYIPLA:

1. That because a “nonexclusive patent license is simply a promise not to sue for infringement,” the “conveyance of such a license does not obligate the licensee to do anything; it simply provides the licensee with a guarantee that it will not be sued for engaging in conduct that would infringe the patent in question.”

Philips I, 424 F.3d at 1189 (citations omitted);¹³ and

2. That “[t]he effect of a nonexclusive license was different before the Supreme Court, in *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), abolished the doctrine of licensee estoppel,” since

Before *Lear*, a nonexclusive license had a legal effect that made it more than a mere covenant by the licensee not to sue. Acceptance of the license barred the licensee from challenging the validity of the patent. Some of the early decisions regarding patent-to-patent tying arrangements appear to have been based, at least in part, on that feature of pre-*Lear* patent licenses. . . . In the

¹³ This principle was recently reaffirmed in *TransCore, LP v. Elec. Transaction Consultants Corp.*, 563 F.3d 1271, 1275-76 (Fed. Cir. 2009).

post-*Lear* era, the “acceptance” of a license has no such restrictive effect on the licensee’s freedom.

Philips I, 424 F.3d at 1190 n.3 (citations omitted).

Based on its preparation of briefs *amicus curiae* in the *Philips I* phase of this action, the Association is fully familiar with the legal issues considered in the panel decision and the facts contained in the public record. Hopefully, this will permit the NYIPLA to make novel and meaningful contributions to the substantive analysis under which the Court will determine whether rehearing *en banc* should be granted.

C. The Association Respectfully Requests Leave to File an Overlength Brief

Federal Rule of Appellate Procedure 32(a)(7) limits the length of a principal brief to 30 pages or 14,000 words. Federal Circuit Rule 35(g) limits the length of an *amicus curiae* brief to 10 pages, but does not provide a word limit. However, the 10-page limit of Rule 35(g) is one-third the amount of pages allotted under Fed. R. App. P. 32(a)(7). One-third of 14,000 words is approximately 4,666 words. The Association’s brief is less than 4,666 words (it is approximately 3,000 words). The Association respectfully requests leave to file this brief.

Counsel for all parties were informed via e-mail letter on June 30, 2009, of the Association’s intent to file this motion. Philips does not object to the motion.

Princo opposes the motion. As of the time this motion was printed, the ITC had not responded to the Association's request for consent.

V. CONCLUSION

For all the foregoing reasons, the motions for leave to file a brief *amicus curiae* and an overlength brief should be granted, and the Court should consider the brief *amicus curiae* submitted herewith.

Dated: July 2, 2009

Respectfully submitted,

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EXHIBIT 1

From: Dave Ryan [<mailto:dfrhawley@optonline.net>]
Sent: Wednesday, June 24, 2009 5:02 PM
To: 'Halpern, Kenneth'; 'Wesenberg, Eric'; 'douglas.melamed@wilmerhale.com';
'clara.kuehn@usitc.gov'
Cc: 'Weiss, Charles'; 'Rasmussen, Garret'; 'Abate, Mark'; 'beeneyg@sullcrom.com'
Subject: RE: Princo v. ITC

Ken--

Lest there be any misunderstanding, this is how the draft motion currently reads:

Counsel for all parties were informed via e-mail letter on June 19, 2009 of the Association's intent to file this motion. Philips consents to the motion. Counsel for the International Trade Commission ("ITC" or "the Commission") "will take no position with respect to NYIPLA's motion". Princo

"does not object to NYIPLA's motion for leave to file an amicus brief insofar as that brief supports Philips' petition for rehearing en banc with regard to the issue of patent misuse by horizontal price fixing."

Princo also "does not oppose NYIPLA's motion for leave to file an amicus" brief that "would oppose Princo's petition for rehearing with respect to tying", but

"reserves the right, and asks that the Court consider, allowing Princo to reply to NYIPLA's amicus brief if appropriate."

Please advise whether anyone on your side of the aisle objects to this formulation -- which quotes directly from Eric's email.

Regards,
Dave

-----Original Message-----

From: Halpern, Kenneth [<mailto:khalpern@orrick.com>]
Sent: Wednesday, June 24, 2009 4:50 PM
To: Dave Ryan; Wesenberg, Eric; douglas.melamed@wilmerhale.com;
clara.kuehn@usitc.gov
Cc: Weiss, Charles; Rasmussen, Garret; Abate, Mark; beeneyg@sullcrom.com
Subject: RE: Princo v. ITC

Dear Mr. Ryan:

Mr. Wesenberg is temporarily unavailable; I write on his behalf for our client.

I appreciate your response. First, I believe your email does confirm that NYILPA has long planned to involve itself in this case. Second, and more importantly, as you know, under Federal Circuit rules, parties do not have an opportunity to respond to requests for rehearings without invitation from the Court. NYILPA's brief potentially will serve as a response to our client's papers that Philips is otherwise not entitled to file. It is that concern that animates our position. Nonetheless we do not object, but noted our position as stated in Mr. Wesenberg's email. If, as you indicated in our phone conversation, you choose not to report our full position to the Federal Circuit, Princo reserves the right to do so as part of a request for leave to file a reply.

Very truly yours,
Ken Halpern

Counsel for Princo

From: Dave Ryan [<mailto:dfrhawley@optonline.net>]
Sent: Wednesday, June 24, 2009 12:44 AM
To: Wesenberg, Eric; douglas.melamed@wilmerhale.com; clara.kuehn@usitc.gov
Cc: 'Weiss, Charles'; Halpern, Kenneth; Rasmussen, Garret; 'Abate, Mark';
beeneyg@sullcrom.com
Subject: RE: Princo v. ITC

Dear Mr. Wesenberg -

Thank you for your response to my inquiry regarding the position Princo will take in response to the proposed NYIPLA motion.

Please let me provide some background regarding the Association's continuing interest in the legal issues raised by this litigation. Hopefully, that background will serve to allay some of your concerns and misperceptions. Having drafted the protocols under which the Board and the Amicus Committee currently make decisions regarding the Association's amicus filings, moreover, I can personally assure you that your fears are totally groundless.

In the first place, please be advised that on August 27, 2004 - almost five years ago and, apparently, before you became involved - the Association filed a brief amicus curiae in support of Philips in the Philips I phase of the litigation. We also prepared and moved for leave to file a reply brief, but that motion was denied.

As the principal author of both briefs, I was extremely pleased with the unanimous panel decision in which Judge

Bryson accepted two important arguments that we had briefed. If you are interested, those briefs are available on the Association's website (www.nyipla.org).

Understandably, I was less pleased with Judge Dyk's April 20, 2009 opinion for the majority which I felt "appears to have the potential to undermine much of what we helped to achieve with our amicus filing in Philips I" - a perception which I reported to all members of the NYIPLA Amicus Committee and Board of Directors two days after the decision on April 22, 2009.

Garrard Beeney is a fine trial lawyer who possesses an outstanding analytical mind and broad experience as counsel to standard setting organizations ("SSOs") such as MPEG. His first contribution to an Association CLE program was, I believe, as a speaker on a Quanta panel that I chaired on July 29, 2008. Based upon a recommendation that I made to our CLE Committee Chair, he also gave a presentation on the implications of Quanta for computer/electrical technologies as part of our fall one-day CLE event on November 7, 2008.

As I advised the Association's Amicus Committee and Board of Directors I planned to do, I consulted Garrard and his colleague Jim Williams in a telephone conversation to discuss the technical and legal impediments to the feasibility of developing a digital replacement for ATIPS using Lagadec as part of a hypothetical standard to compete with the Orange Book. I have never discussed any aspect of the Southern District case with anyone from Sullivan & Cromwell.

The potential approaches of the Association to the anticipated motions for en banc rehearing and our projected amicus filing were discussed in some detail at both the May and June Board meetings. I prepared a memorandum outlining those approaches and circulated it at the June Board meeting at which preliminary approval for our filing was received.

Given the foregoing background, you should not find it surprising that the decision to oppose your motion for rehearing en banc - which seeks to further subvert the continuing vitality of Philips I - could be communicated to you less than one business day after we received it.

Very truly yours,

Dave Ryan

From: Wesenberg, Eric [<mailto:ewesenberg@orrick.com>]
Sent: Tuesday, June 23, 2009 9:43 PM
To: Dave Ryan; douglas.melamed@wilmerhale.com; clara.kuehn@usitc.gov
Cc: Weiss, Charles; Halpern, Kenneth; Rasmussen, Garret
Subject: RE: Princo v. ITC

Re: Princo v. ITC Appeal No. 2007-1386

Princo does not object to NYIPLA's motion for leave to file an amicus brief insofar as that brief supports Philips' petition for rehearing en banc with regard to the issue of patent misuse by horizontal price fixing.

Insofar as NYIPLA's amicus brief would oppose Princo's petition for rehearing with respect to tying, Princo notes that NYIPLA, an organization of over 2,000 members, disclosed its organizational decision to oppose Princo's petition only one business day after receiving that petition. This suggests that NYIPLA had made a decision to oppose prior to seeing the contents of Princo's petition. Princo further notes that Garrard Beeney, Philips' lead counsel in the parallel SDNY action, has been a recent speaker at a NYIPLA continuing legal education event on licensing law.

In light of that, while Princo does not oppose NYIPLA's motion for leave to file an amicus opposing Princo's petition, it reserves the right, and asks that the Court consider allowing Princo to reply to NYIPLA's amicus brief if appropriate.

Eric Wesenberg

Counsel for Princo

From: Dave Ryan [<mailto:dfrhawley@optonline.net>]
Sent: Friday, June 19, 2009 9:35 AM
To: Wesenberg, Eric; douglas.melamed@wilmerhale.com; clara.kuehn@usitc.gov
Cc: 'Weiss, Charles'
Subject: Princo v. ITC

Eric L. Wesenberg, Esq. (ewesenberg@orrick.com)

A. Douglas Melamed, Esq. (douglas.melamed@wilmerhale.com)

Clara Kuehn, Esq. (clara.kuehn@usitc.gov)

Re: Princo v. ITC (Federal Circuit No. 2007-1386)

The New York Intellectual Property Association ("NYIPLA" or "the Association") intends to move in the Federal Circuit for permission to file a brief amicus curiae in support of U.S. Philips Corporation's Petition for Rehearing En Banc ("the Philips Petition") and in opposition to the Petition For Rehearing En Banc of Princo Corporation and Princo America Corporation ("the Princo Petition").

Please advise whether you will (a) consent to the NYIPLA motion; (b) oppose the NYIPLA motion, or (c) take no position in respect of the NYIPLA motion - so that we may advise the Court accordingly.

Thank you for your assistance.

Very

truly yours,

David F. Ryan, Board Liaison To

The

NYIPLA Amicus Committee

"EMF <orrick.com>" made the following annotations.

IRS Circular 230 disclosure:

To ensure compliance with requirements imposed by the IRS, we inform you that any tax advice contained in this communication, unless expressly stated otherwise, was not intended or written to be used, and cannot be used, for the purpose of (i) avoiding tax-related penalties under the Internal Revenue Code or (ii) promoting, marketing or recommending to another party any tax-related matter(s) addressed herein.

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EXHIBIT 2

From: Halpern, Kenneth [<mailto:khalpern@orrick.com>]
Sent: Thursday, June 25, 2009 3:10 PM
To: Dave Ryan
Cc: Wesenberg, Eric; Melamed, Doug; clara.kuehn@usitc.gov
Subject: RE: Princo v. ITC

Dave:

Your email below is completely inappropriate. NYIPLA is not a party and has entered no appearance, and thus quite naturally has never been on our service list. Moreover, your email rests on a host of unfounded and untrue assumptions. My role in preparing our corrected brief ended days before I spoke to you -- by that point, the brief was in the hands of staff in our DC office (I am in NY), who were filing and serving it, using the same service list they had used a few days earlier for the original brief (before we had ever heard of you). It did not cross my mind, nor should it have, to call them, find out if they'd served the brief and instruct them to send it to you. Of course, if you'd asked me, I would have been happy to have a copy emailed to you. (I myself have not yet received a pdf of the as-filed version.)

Compounding the inappropriateness of your accusation, Princo was under no obligation to refile as quickly as we did. The Federal Circuit's order gave us a deadline for refiling of July 3. It seemed to us the reasonable and fair course was nonetheless to file the corrected brief as quickly as possible, and so we did. In any case, the corrected brief is not substantively different from the original brief, as you would have seen if you'd looked at it before firing off your email to me. It seems extremely unlikely to me that your proposed amicus will differ as a result of the cuts reflected in the corrected brief.

Finally, I don't know what is meant by your placement of quotation marks around the word "corrected," but this kind of snide (and empty) insinuation has the odor of a party adversary, not a disinterested third-party seeking only to vindicate an interest in the development of the law.

Regarding your inquiry of last evening, Princo asks that its position on your proposed amicus, set forth in Mr. Wesenberg's email of June 23, be reproduced in full. Anything less is objectionable, and Princo reserves the right to inform the Federal Circuit of its full position and your refusal to disclose it, should we decide to seek leave to file a reply.

Very truly yours,
Ken Halpern

From: Dave Ryan [<mailto:dfrehawley@optonline.net>]
Sent: Thursday, June 25, 2009 12:45 PM
To: Halpern, Kenneth
Cc: Wesenberg, Eric; 'Melamed, Doug'; clara.kuehn@usitc.gov

Subject: Princo v. ITC

Ken-

I just received a copy of your "Corrected" Petition from Doug Melamed. I'm a little frosted that, despite our telephone and email correspondence yesterday, and despite knowing that we face a July 2 deadline for our amicus filings, you neither transmitted a courtesy copy to me or even told me it was coming.

The NYIPLA's practice has been that we file notices of appearance along with our briefs and motions. May I nevertheless request that you please favor me with copies of any additional filings you may make?

Thanks,

Dave Ryan

"EMF <orrick.com>" made the following annotations.

=====

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CERTIFICATE OF INTEREST

In accordance with Fed. Cir. R. 29(a) and 47.4, the undersigned counsel of record for amicus curiae New York Intellectual Property Law Association hereby certifies the following:

1. The name of every party or amicus curiae represented by me or by the other below-identified attorneys in connection with this proceeding is: New York Intellectual Property Law Association.

2. The name of the real party in interest (if such party is not named in the caption of this brief) is: New York Intellectual Property Law Association.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are: None.

4. The names of all law firms and partners or associates that appeared for the parties or *amici* now represented by me in the lower tribunal or who are expected to appear in this Court are:

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Chair, Amicus Committee
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to the Amicus Committee
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July 2, 2009

Charles Weiss / with permission

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(914) 271-2225

CERTIFICATE OF SERVICE

I hereby certify that on July 2, 2009, I served the foregoing *New York Intellectual Property Law Association's Motion for Leave to File Brief Amicus Curiae in Support of Philips' Motion for Rehearing En Banc And in Opposition to Princo's Motion for Rehearing En Banc, and Motion for Leave to File Overlength Brief* on all parties by causing two copies thereof to be delivered by overnight courier to counsel for each as follows:

Eric L. Wesenberg, Esq.
Garret G. Rasmussen, Esq.
Kenneth J. Halpern, Esq.
Michael C. Ting, Esq.
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Menlo Park, CA 94025

Attorneys for Appellants Princo Corp. and Princo Am. Corp.

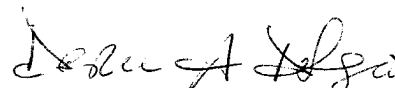
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Attorneys for Intervenor U.S. Philips Corp.

DATED: July 2, 2009



Daria A. DeLizio