



THE NEW YORK PATENT, TRADEMARK AND  
COPYRIGHT LAW ASSOCIATION

# NYPTC BULLETIN

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## PRESIDENT'S CORNER

### DESIGN PROTECTION

A new mode of protection for designs of useful articles seems possible within the next two years. Current proposals would provide a ten-year term of protection for original designs, with required registration and marking.

Existing laws do not provide adequate protection for innovative designs of such products as lamps, furniture and kitchenware. The *unobviousness* standard and cost are obstacles to practical protection by design patents. The requirement of separability of the protected ornamental aspects of a design from its functional aspects often makes copyright protection inappropriate. Questions of functionality and the development of secondary meaning limit the effectiveness of protection under trademark principles.

There appears to have been general agreement for many years favoring a copyright-like form of design protection without the patent law's *unobviousness* requirement. Why then has no such law been enacted? Because when everyone tries to get onto the boat, it sinks. Until shortly before enactment as the Copyright Revision Act of 1976, Title II of the bill provided for design protection. An attempt to include typeface protection sunk that effort.

During the past two years, broad support for design protection legislation has again developed. What's holding it up? The auto industry wants to include "crash parts," those pieces of sheet metal which crumple so easily and cost so much. The insurance industry, cloaked in the role of consumer protection, opposes inclusion of crash parts. Others have jumped aboard, seeking to protect various operating parts which allegedly have a distinctive shape,

including such things as internal parts of engines. Why hasn't this issue been bifurcated, leaving the auto parts issue for separate attention? Because there would be little hope of gaining Congressional votes for a law which would increase the cost of auto repairs.

Representative Moorhead (R-CA) has reintroduced a version of his bill from the last Congress under H.R. 902. (37 PTCJ 359, Feb. 16, 1989) In July, Representative Gephardt (D-MO) and others introduced H.R. 3071 (38 PTCJ 348, Aug. 3, 1989), a further refinement of H.R. 902 which addresses both the typeface and

crash-parts protection issues, providing limited, defined protection in both fields.

If you have not yet considered how a design protection law will affect your clients, now is the time to look into the subject. The pending bills are mercifully short. Pay special attention to the definitions of protected and unprotected subject matter. Then contact Lloyd McAuley, chairman of our Committee on Design Protection and give him your views. Act now. The ship is about to sail.

John B. Pegram, President

## CALENDAR OF EVENTS

- |                      |   |
|----------------------|---|
| October 2-3, 1989    | B.N.A.: Preventing Piracy of Your Intellectual Property<br>(Washington, D.C.)   |
| October 3-6, 1989    | Pacific Industrial Property Association Meeting<br>(Tucson, Arizona)  |
| October 19, 1989     | NYPTCLA Luncheon Meeting, John B. Pegram of Davis, Hoxie, Faithful & Hapgood on Summary Judgement<br>(Williams Club, N.Y.C.)              |
| October 18-20, 1989  | A.I.P.L.A.: Annual Meeting (Arlington, Virginia)  |
| November 9, 1989     | Alternative Dispute Resolution of Technology Disputes,<br>(New York City)   |
| November 10-12, 1989 | NYPTCLA C.L.E. Weekend Seminar at Mohonk Mountain House<br>(New Paltz, New York)  |
| November 16, 1989    | NYPTCLA Luncheon Meeting (Tentative)  |
| November 16, 1989    | Federal Circuit Bar Association Annual Reception, Hon. Anthony M. Kennedy, Assoc. Justice, U.S. Supreme Court, Speaker (Washington, D.C.) |
| November 19-20, 1989 | Fed. Circuit Bar Association Mini-Judicial Conference<br>(Baltimore, Maryland)  |

## CLE WEEKEND AT MOHONK PLANNED

by Gregory J. Battersby

The annual Association Continuing Legal Education weekend will be held again this year at the Mohonk Mountain House in New Paltz, New York from Friday evening, November 10, 1989 through Sunday morning, November 12, 1989. The program is being co-sponsored by the NYPTC, the New Jersey Patent Law Association and the Connecticut Patent Law Association. The program will kick off at 4:00 P.M. on Friday, November 10, 1989 with a talk by Robert T. Orner, "Is the Patent System Working?" A welcoming reception and dinner will follow.

Saturday morning will start with breakfast and welcoming remarks by the presidents of the sponsoring associations. The Saturday morning program will include panel discussions on Inequitable Conduct—Proposed Patent Office Rule 57 moderated by John Sweeney; Intent to Use: The Practitioner's View moderated by Frank Colucci; and EEC and 1992—Trademark Harmonization also moderated by Frank Colucci. The afternoon will be free. A reception is planned from 7:00 - 8:00 P.M. followed by a Dinner-Dance.

The Sunday program will include an Appellate Workshop featuring Chief Judge Markey of the CAFC, at least one other Federal Circuit Judge, Joseph Fitzpatrick and Paul Heller. This will be followed by two debates between Edward Filardi and David W. Plant on "Should a Plaintiff-Patentee be Permitted to Offer Evidence in its Case in Chief as to the Merits of the Invention" and "Should Separate Trials for Infringement and Validity be the Norm?"

The program concludes with a commentary by the Hon. Jeffrey Samuels on "The New Trademark Law and Patent Office Update" followed by brunch.

The Mohonk Mountain House accommodations are available at the weekend package price of \$625 double occupancy, \$445 single occupancy and includes the following: registration fee; room for Friday and Saturday evening, and all meals Friday evening through Sunday brunch; two cock-

tail receptions and Saturday evening Dinner-Dance, complete educational program, continuous coffee breaks and all gratuities, taxes and service charges.

SPACE IS LIMITED so early registration is strongly recommended. For further information, contact John Sweeney, Morgan & Finnegan, 345 Park Avenue, New York, NY 10154 (212) 758-4800. ■

## NEWS FROM THE BOARD OF DIRECTORS

by Howard B. Barnaby

At its April 18, 1989 meeting, the Board heard a report from Frank Scheck on the success of the Annual Judges' Dinner. New attendance records reached the full capacity of the Waldorf Astoria Hotel. This may necessitate use of an allotment system next year once full capacity was reached. Other alternatives were discussed for limitations on attendees.

John Kidd reported on the Inventor of the Year Committee and its election of John Anderson of Union Carbide as the recipient of the 1989 Inventor of the Year Award.

William Brunet next reported on the Special Committee on Harmonization and a proposed resolution prepared by the Committee. Following discussion and certain amendments, the Board approved a resolution for use by NYPTCLA representatives at the upcoming WIPO meeting. The resolution included the following provisions:

- (1) the need for a broad unity of invention provision;
- (2) the need for protection between publication of pending applications under the WIPO treaty and the grant of a patent;
- (3) a requirement, where national law does not require substantive examination, that the patent be granted promptly, such as within eighteen months after the priority date;
- (4) favor a short period, such as five years, to phase out current pre-grant oppositions (as opposed to the ten-year phase-out provision in the current treaty draft);
- (5) favor permitting changes in patents after issue, including enlargement of

the scope of the claims, within a limited time while preserving the U.S. law requirement that the error arose without deceptive intention and with the revised patent being subject to intervening rights;

(6) recognize that any contracting state must consider as prior art anything put into commercial use prior to the grace period by the inventor, or his assignee, or anything derived by the inventor from anyone not under an obligation to assign to the inventor, or to the inventor's assignee.

Martin Goldstein then gave a report on the Admissions Committee and offered certain suggestions for promoting increased membership. It was agreed that these suggestions would be considered by the next Administration.

Stanley Silverberg presented a report on the Trademark Trial and Appeal Board Rules package and certain amendments to eliminate possible favoritism to foreign applicants.

The Board met again on May 16, 1989. Peter Saxon reported on the upcoming Annual Dinner featuring Judge Eugene Nickerson as the guest speaker.

The Board considered a resolution and report by the Foreign Patent Law and Practice Committee identifying particular "priority countries" for the U.S. trade representative to identify in trade negotiations as countries which are lax in matters of intellectual property law. The Board decided not to adopt a proposed resolution and returned the report to the Committee for further consideration.

The Board next heard a report from Robert Baechtold concerning the PTO proposals for Rule 57. After giving a general overview of the PTO position, Larry Alaburda reported for the Court Procedure and Practice Subcommittee. The subcommittee opposed the new Rule 57 because it disagreed with the "but for" test and with the silence of the rule on the question of intent. Terry Gillis reported that the Patent Office Affairs Subcommittee preferred that the proposals of Rule 57 should be accomplished legislatively and not by rulemaking. Upon further discussion, the Board unanimously adopted the following resolution:

In view of the inability of the Patent and Trademark Office to change a legal standard established by the Court of Ap-

peals for the Federal Circuit, this Association's position with regard to the proposed Rule 57 is that the Rule not be adopted.

At the next Board meeting on May 18, 1989, Stanley Silverberg presented a report of the U.S. Trademark Committee concerning the Trademark Revision Act. The Board unanimously adopted the following resolution proposed by the Committee:

WHEREAS, the Trademark Revision Act of 1988 requires domestic applicants filing "intent to use" applications to commence use of the mark in U.S. commerce prior to being granted a registration therefor;

WHEREAS, the Trademark Revision Act of 1988 permits foreign applicants filing under the Paris Convention based on a foreign registration to be granted a U.S. registration based on an "intent to use" application without any use of the mark anywhere;

WHEREAS, the presently proposed fee structure will invariably require domestic "intent to use" applicants to incur increased fees over those required of foreign convention "intent to use" applicants during prosecution of their respective applications; and

WHEREAS, the foregoing constitutes discrimination against domestic applicants;

BE IT THEREFORE RESOLVED, that the New York Patent, Trademark, Copyright Law Association in principle favors requiring bona fide use of a mark in the ordinary course of trade somewhere before issuance of a U.S. registration and that the Association in principle favors adoption of rules which would equalize the intent to use fees incurred by foreign and domestic applicants.

Mr. Silverberg then discussed the Committee's comments with respect to the proposed Trademark Trial and Appeal Board Rules changes. He suggested that the Association send a letter to Janet Rice stating that it had no additional comments beyond those already submitted by the USTA. The Board unanimously agreed to this proposal. ■

## PENDING LEGISLATION

*By David J. Lee and Edward P. Kelly*

Congress has been busy over the last few months. Bills have been introduced that would significantly affect the patent, trademark and copyright fields. In addition, proposed antitrust legislation would open new vistas for research and development by joint ventures.

### PATENTS

#### International Trade Commission

Last August, the President signed into law the Omnibus Trade and Competitiveness Act of 1988 (H.R. 4848). The Act made a variety of significant changes in laws relating to intellectual property, particularly in the context of foreign trade. One of the laws modified by the Act was Section 337 of The Tariff Act of 1930.

Section 337 allows a patent owner to petition the International Trade Commission ("ITC") for an order barring importation of a product that infringes his patent or is made abroad by a process that would infringe a process patent if practiced in this country. The party charged with infringement has available the usual defenses available in patent litigation in the United States Courts, and others as well. If the ITC decides that an exclusion order is appropriate, the ITC must refer its decision to the President for approval.

The 1988 amendments to Section 337 made it easier for a patent owner to obtain an exclusion order from the ITC by removing the burden previously on the patent owner of proving that importation of a foreign-made product would cause substantial injury to a United States industry. The 1988 amendments left unchanged other prerequisites to obtaining relief under Section 337. As things now stand, the ITC must consider the effect of exclusion on the public health and welfare, as well as on competitive conditions in the United States. In August, Senator John Rockefeller (D-W.Va) introduced legislation that would substantially amend Section 337 in favor of domestic patent owners where infringing imports emanate from a country that fails to protect inventions of domestic companies.

The Rockefeller bill is entitled "The Intellectual Property Protection Act of 1989" (S. 1529). The Senator's avowed purpose in introducing the bill was to induce foreign nations — Japan in particular — to make their patent laws fairer to domestic industry:

"I am concerned that American and other foreign companies, especially those in high tech industries, do not receive adequate patent protection in Japan. My Foreign Commerce and Tourism Subcommittee has held two hearings in the past year on this problem and has identified many of the constraints faced by American industry. One of the most significant problems is the very long time it takes to obtain a patent in Japan: an average of over 5 years there versus only 19 months in the United States. This lengthy delay is an open invitation to copying and abuse. A second major problem is the very narrow interpretation of patent claims in Japan. This permits others to make minor changes in a patented invention. The result is that Japanese companies can, and do appropriate the technology in the original invention at no cost and without the permission of the inventor". (Cong. Rec. August 4, 1989, P. S10268)

The bill would require the Commissioner of Patents and Trademarks to identify and list foreign countries that do not adequately protect domestic intellectual property. In an ITC action involving products emanating from a country on that list, the ITC would be required to issue an exclusion order without considering the usual economic defenses of the infringer. Furthermore, the patent defenses open to the infringer would be limited to those set forth in Section 282(1) ("non-infringement, absence of liability for infringement, or unenforceability"). Finally, there would be no Presidential review of any decision by the ITC to issue an exclusion order.

### JOINT PRODUCTION AGREEMENTS

Joint research and development agreements allow companies to pool their resources for projects too expensive or too inefficient to be undertaken by an individual company. Prior to 1984, an agreement for joint R&D was subject to challenge under the antitrust laws. Although there were few antitrust challenges to joint R&D programs prior to 1984, critics of the antitrust laws believed that those laws, with their potential for treble damage liability,

provided a significant deterrent to joint R&D undertakings. See Cong. Rec. May 11, 1984, H3184 (Rem. of Rodino). These same critics viewed joint R&D programs as a means of stimulating innovation by United States companies. In 1984, with the overwhelming support of the House and Senate, President Reagan signed the National Cooperative Research Act.

This Act restricted the antitrust laws in the R&D context. It provided that any joint R&D venture challenged as an antitrust violation should be judged under the rule of reason rather than by a *per se* analysis. The Act specifically prohibited a Court from finding a joint R&D agreement to be a *per se* violation of the antitrust laws. The Act also limited the potential liability of R&D joint venturers to actual damages plus attorneys' fees, provided that the joint venturers had disclosed their program to the Federal Government at its inception.

Several bills recently introduced in the House and Senate would extend the reach of the 1984 Act to cover joint production agreements. Representative Fish (R-N.Y.) recently introduced a bill (H.R. 2264) that would amend the 1984 Act to include agreements by companies jointly to operate manufacturing and production facilities. This proposal would not apply to agreements for joint distribution or marketing.

The Fish bill is similar to a bill introduced in the House earlier this year by Representative Edwards (D-Cal.) (H.R. 1025), except that the Edwards bill would extend the 1984 Act to exempt joint distribution and marketing agreements as well as joint production agreements. With the same underlying policies in mind, Representative Boucher (D-Va.) recently introduced yet another bill in the House. This bill would not amend the 1984 Act, but rather would allow the Antitrust Division of the Justice Department and the Federal Trade Commission, in consultation with the Department of Commerce, to review proposed joint production ventures by the standards utilized to judge the legality of mergers. Under this bill (H.R. 1024), companies would be free of liability upon governmental approval.

A fourth bill introduced by Rep. Wyden (D-Ore.) follows somewhat the same approach (H.R. 423). The House Subcommittee on Economic and Commercial Law recently held hearings on the four

House bills. Michael Boudin, representing the Justice Department, testified to the Department's experience that cooperative production ventures increase competition. The Department favors either an extension of the 1984 law to joint production agreements or a requirement of prior approval of these agreements. Professor Edward B. Rock of the University of Pennsylvania Law School testified against any revision of the 1984 Act that would ease existing restraints on joint distribution and marketing. Professor Rock believes that these activities promote or encourage price fixing.

In the Senate, Senator Leahy (D-Vt.) recently introduced a bill that is similar to the bills introduced by Mr. Edwards in the House (S.1006). In introducing his bill, Senator Leahy stressed the importance of permitting domestic firms to pool their resources: The need for firms to pool their resources and enter into joint manufacturing ventures is essential if American business is to remain competitive in the world marketplace. The high-definition television [HDTV] industry is just one example of yet another technology that may be lost to foreign competitors if American companies are unable to pool their manufacturing capabilities. The immense cost required to develop the HDTV technology and catch up with Japanese and European HDTV industries makes it very difficult for any one American firm to undertake the initiative.

The cost of not pursuing the HDTV technology is enormous, however, HDTV technology potentially could create such a large demand for related components, such as semiconductor chips, that the failure to develop the technology could place U.S. high-technology companies at a severe competitive disadvantage. In addition, high definition display screens will become essential for more detailed and more accurate information in everything from the medical to the defense industries. This legislation will enable American companies to compete effectively and will help curb the erosion of the United States' industrial base. (Cong. Rec. May 16, 1989 at S5395).

Under Senator Leahy's bill, the rule of reason would govern joint distribution and marketing agreements. In his remarks, Senator Leahy noted that the 1984

Act had encouraged nearly 100 joint research ventures in the past five years.

## TRADEMARKS Distribution Agreements

In recent years, legislation has been proposed that would encourage the licensing of patent rights by limiting the application of the antitrust laws to patent licenses. A law recently introduced in the Senate, for example, would eliminate the presumption of market power in antitrust cases involving patents (S. 270). Proposed legislation that would limit the application of the antitrust laws to trademark licenses has not been as well received.

In a typical trademark licensing transaction, the trademark owner attempts to secure an agreement from a wholesale distributor that the distributor will sell the trademarked product only in a particular geographic area. Similarly, the distributor often seeks a clause that would grant him the sole and exclusive right to distribute the trademarked product in a particular geographic area.

Trademark license agreements establishing exclusive territories for wholesale distributors may be attacked as antitrust violations. Representative Jack Brooks (D-Tex.) recently introduced a bill — The Interbrand Competition Act of 1989 (H.R. 3151) — that would immunize these types of trademark licenses from attack under the antitrust laws where the trademarked product is in "substantial and effective competition with other products within the relevant market or markets."

## COPYRIGHT Computer Software Rental

The "first sale" doctrine permits the purchaser of a copyrighted work to sell or dispose of a copy he purchased without compensation to the copyright owner. Congress granted an exception to this doctrine for rental phono records in 1984 on the ground that these rentals were a pretext for copying that deprived copyright owners of substantial revenue. The 1984 Record Rental Amendments created copyright liability for unauthorized rental of phonorecords. See 17 U.S.C. §109.

Due to widespread copying of rented computer software, the software industry

has been seeking its own exception from the first sale doctrine. Numerous bills directed to that end have been introduced in Congress over the last several years (See NYPTCLA March/April 1989 at pp. 2 & 3). None of these bills were enacted into law.

The most recent proponents of a computer software exception are Senator Orrin Hatch (R-Utah) and Representative Mike Synar (D-Okla.). Senator Hatch introduced a bill last January that would create copyright liability for unauthorized rental of computer software (S.198). Representative Synar recently introduced a bill (H.R.2740) that would accomplish the same objective, and also would grant an exemption to non-profit libraries if the library loaned the computer software with a copyright warning. The bill would require the Registrar of Copyrights to provide a report on the effect of the amendment within three years.

### VISUAL ARTISTS' RIGHTS

Last year, the United States became a signatory to the Berne Convention, an international copyright treaty that affords certain reciprocal rights to copyright owners throughout the world. In that connection, Congress amended the copyright laws in numerous respects.

Among the rights afforded under Berne principles are an author's moral rights in his work. A moral right is an inherent right of an author to claim authorship of his work and prevent its destruction or alteration. The United States copyright laws do not specifically provide for moral rights. During the hearings on conforming our copyright laws to comply with the Berne Convention, the House and Senate considered several bills that would have amended the copyright laws to recognize moral rights in authors of works of fine art (S.1619, Sen.Kennedy, D-Mass., H.R. 3221, Rep.Markey, D-Mass; See NYPTCLA January/February 1989 at pp.4 & 5. Ultimately, no moral rights provisions were included in the Berne amendments because Congress (based on expert advice) concluded that existing laws provided all the moral rights necessary for United States compliance with the Berne Convention.

The moral rights bills, with modifications, were recently re-introduced in the House and Senate by their original proponents (S.1198 and H.R. 2680). The bills would create a new Section 106(a) of the

Copyright Act. This Section would provide the author of a work of visual art with the right to claim authorship in the work, as well as prevent the use of his name on a work he did not create or on an altered work. The bills also afford the author a right to prevent distortion or modification of his work that would be prejudicial to his reputation. The Senate bill would further provide that the author's rights could not be waived during his lifetime. The House bill would permit written waiver of the author's rights during his lifetime.

### ELEVENTH AMENDMENT IMMUNITY

The Eleventh Amendment grants a State immunity from suit in Federal Court under the Copyright Act. Several District Courts recently have dismissed copyright infringement suits against States on the authority of the Eleventh Amendment. See NYPTCLA Bulletin May/June 1989 at 8. These decisions were based on the proposition that Congress had not expressed a clear intention to eliminate State immunity in enacting the Copyright Statute.

Bills have been introduced in both the House and Senate (H.R. 1131 and S.497) that would amend the Copyright Act expressly to recite an intention to eliminate State immunity. After these bills were introduced, the United States Supreme Court took a case that questioned the power of Congress to eliminate State immunity. *Pennsylvania v. Union Gas Co.*, No.87-1241. Activity on the bills halted to await the Supreme Court's decision.

On June 15, 1989, the Supreme Court held that Congress does have the power under the Commerce Clause to eliminate the Eleventh Amendment immunity of a State. The House Subcommittee on Courts, Intellectual Property and the Administration recently approved H.R.1131. The bill has been renumbered (H.R. 3045) and will be sent to the full Judiciary Committee for consideration.

### WORK FOR-HIRE AMENDMENT

The Copyright Act invests ownership of a copyright in the author of the work. An exception to this rule is "work made for hire". A work made for hire is either (1) a work prepared by an employee during the course of his employment or (2) a work spe-

cially ordered or commissioned. See 17 U.S.C. §101. In either instance, ownership of the copyright vests in the employer or the party commissioning the work. In the case of a specially ordered or commissioned work, the parties must agree in writing that the work is made for hire.

The framers of the 1976 Copyright Act generally intended that the work for hire exception should be applied only to an employee who had an established and ongoing relationship with an employer. See Cong. Rec. June 22, 1989 at S7341 (Rem. of Cochran). In recent years, however, employers have sought to define "employee" broadly in an attempt to obtain the rights to an author's work.

An employer may, for example, hire a freelance artist to create a work. Even if the work has been specially commissioned, the employer cannot — absent an agreement in writing — invoke the second test of the work for hire exception. Instead, the employer must argue that the artist was his "employee" and that the copyright is the employer's under the first test of the work made for hire exception.

The United States Supreme Court confronted this argument last June in *Community For Creative Non-Violence v. Reid* 57 U.S.L.W. 4607 (June 5, 1989). There, a sculptor made an oral agreement with a non-profit association. The association paid only the sculptor's expenses, and there was no written agreement governing copyright ownership. The sculptor accepted many of the association's suggestions and directions, but there were no elements of a traditional employer/employee relationship. The association argued that their supervision of the project was enough to make the sculptor their employee and his work their property under the first test of work made for hire exception.

The Supreme Court disagreed. The Court held that the sculptor was an independent contractor, not an "employee", and that the work for hire exception did not apply. Noting that the legislative history of the Copyright Act gave no specific guidance as to the meaning of the term "employee", the Court applied common law agency principles. The Court invited Congress to clarify the meaning of the term "employee" rather than have the Courts deal with the uncertainty of applying agency principles in copyright cases.



Senator Cochran recently responded to this invitation by introducing legislation (S.1253) that would amend the Copyright Act to redefine "employee" as a "formal, salaried employee". The bill would state that the "employee" test of the work for hire exception is distinct from the test for specially commissioned work, preventing a party from falling back on the "employee" test where no written agreement has been executed.

In introducing his bill, Senator Cochran explained the need for clarification of "employee" as used in the Copyright Act:

"The absence of a clear articulation in the statute of who an "employee" is under subsection (1) has led to confusion and disagreement in the courts, and has resulted in independent contractors being classified as "employees" in contravention of the intent of the framers of the compromise on work for hire enacted as part of the 1976 Copyright Act".

"As articulated by the Court, [the agency] test requires an evaluation of at least thirteen factors to the circumstances of each case, with no factor having dispositive impact standing alone, 57 U.S.L.W. 4612. See Restatement of Agency (Second - §220(2)). Although the Court's discussion of those factors strongly suggests that most freelancers would not be considered "employees" under them, that determination cannot be made with certainty at the onset of the relationship between a commissioning party and the creator. Particularly given the nonexclusivity of the factors mentioned by the Court in *Reid*, litigation will routinely be required to ascertain whether the party creating the work meets the "employee" standard. Aside from the cost and uncertainty associated with the constant threat of litigation, there remains the possibility that a freelancer could be held to be the employee of a commissioning party based on a court's subjective assessment of the facts and circumstances of each particular case". (Cong. Rec. June 22, 1989.)

Senator Cochran's bill also would require that, in the case of a specially commissioned work, any written agreement stating that the work is made for hire must be executed before the work begins. This provision is intended to prevent the commissioning party from conditioning payment upon execution of a written agreement after the work has been completed. Senator Cochran noted that Congress had intended, in creating the work made for hire exception in 1976, that the creator be given an opportunity to make an inde-

pendent, objective decision whether to agree to work for hire at the outset of the commissioned relationship (Cong.Rec. June 22, 1989 S7343). ■

## RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

### PATENTS — PERSONAL JURISDICTION

Personal Jurisdiction in a patent infringement action was obtained against a foreign parent corporation that had committed no infringing acts in the state in *Meyers v. Asics Corp.*, 38 BNA PTCT 105 (C.D. Calif. 1989).

In *Meyers*, the Japanese parent corporation was subject to personal jurisdiction under the California long arm statute because the Court found that the parent's wholly-owned subsidiary was "a mere part of an overall marketing plan which purposefully availed itself of the privilege of doing business in California." The District Court focused on ASIC's statements in its annual report that the purpose of the California subsidiary was to permit the parent to do business in California and the United States.

The Court also focused on the fact that the parent corporation sent the alleged infringing goods to the subsidiary in California to support the Court's conclusion that there was personal jurisdiction over the parent corporation.

### DESIGN PATENTS

In 1954, the Court of Appeals for the Federal Circuit decided in *In re Campbell*, 212 F.2d 606 (CCPA 1954) which held that design patent applications cannot be a divisional of an application for a mechanical patent and thus benefit from the filing date of the mechanical patent. Although the *Campbell* decision was not always followed by the Patent and Trademark Office in practice, the decision was never overruled by the CCPA or the CAFC.

Recently, in *Racing Strollers, Inc. v. Tri Industries*, 38 BNA PTCJ 241 (CAFC June

20, 1989) the CAFC overruled the *Campbell* decision and held that the Section B120 of the Patent Statute does not apply to design patents and accordingly, a design patent under the proper circumstances could be a divisional of a mechanical patent and thereby receive the benefit of the mechanical patent's filing date.

### TRADEMARKS—SECTION 43(A)

The Second Circuit in *H.L. Hayden Co. of New York v. Siemens Medical Systems, Inc.*, 38 BNA PTCJ 248 (2d Cir. 1989), recently held that the unauthorized sale of a trademarked product does not in and of itself constitute a violation of 15 USC §1125(a). *Hayden* was an action to recover for claimed violations of the antitrust laws in which Siemens counterclaimed, *inter alia*, that Hayden's unauthorized sale of defendant's X-ray equipment constituted a violation of Section 43(a).

The District Court dismissed the 43(a) counterclaim and the Second Circuit affirmed. The Second Circuit distinguished its earlier decision *El Greco Leather Products Co. v. Shoe World Inc.*, 806 F.2d 392 (2d Cir. 1986), on the ground that in *El Greco*, plaintiff had no opportunity to inspect the goods bearing its mark. The Second Circuit also distinguished *Original Appalachian Artworks v. Granada Elect. Inc.*, 816 F.2d 68 (2d Cir. 1989), because in the *Original Appalachian* case the Court found the product sold by the defendant was not the same as plaintiff's. In *Hayden*, since the goods were in fact Siemens' there could be no violation of Section 43(a) even though the sale was unauthorized.

### PATENTS—REEXAMINATION

In a reexamination proceeding, the amended claims will be entitled to the original date of the patent if the claims are "identical" to the original patent claims. The Court of Appeals for the Federal Circuit held in *Tennant Co. v. Hako Minuteman, Inc.*, 38 BNA PTCJ 250 (CAF 1989), that the reexamination claim need not be verbatim copies of the original claims so long as they were without "substantial" change. The CAFC concluded that even though the claims reexamination contained the addition of the word "bottom" before "wall," they were still substantially identical to the original claims.

**PATENTS—DAMAGES**

The CAFC awarded lost profits to the patent owner in *Datascope Corp. v. SMEC Inc.*, 38 BNA PTCJ 259 (CAFC 1989), because there was no non-infringing alternative available. Datascope's patent was for a percutaneous intra-aortic balloon catheter.

The patent was previously found valid and infringed by the CAFC. In the damage portion of the action, the District Court awarded Datascope reasonable royalties. On the appeal, Datascope argued that a third party's dual lumen catheter was not an acceptable non-infringing substitute. In accepting this argument, the Court focused on

the fact that there was ongoing litigation between Datascope and the third party over infringement by the dual lumen catheter and the District Court in that action had granted a preliminary injunction in Datascope's favor. Accordingly, there was no non-infringing substitute and the Court awarded plaintiff its lost profits. ■

**COMMITTEES: 1989-1990****COMMITTEE ON ADMISSIONS**

Scope of the Committee. It shall be the duty of this Committee to promote Membership in the Association, to process applications for Membership in accordance with Article III of the By-Laws and the Rules on Admissions of the Association and to make recommendations with respect thereto to the Board of Directors.

*Chairman*

Michael J. Kelley

*Board Liaison*

Martin E. Goldstein

*Members*

Edward M. Blocker

Alice C. Brennan

Margaret Ranft Day

Edward H. Loveman

Thomas A. O'Rourke

Rory J. Radding

Rolf E. Schneider

Gidon Don Stern

Scott E. Thompson

William J. Ungvarsky

and the Officers and Directors

Victor N. Balancia

Jay Begler

Steven P. Berman

Ronald A. Bleeker

Thomas R. Bremer

Michael I. Chakansky

Armand Cifelli

James V. Costigan

Bernard F. Crowe

William S. Feiler

Edward J. Fitzpatrick

Murray I. Franck

James M. Heilman

Robert W. Hollweg

J. Russell Juten

Clark W. Lackert

Kenneth E. Madsen

Ernest F. Marmorek

Roger S. Smith

Tiberiu Weisz

George W. Whitney

Mrs. W. Ming Wolf

**COMMITTEE ON THE ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY**

Scope of the Committee. It shall be the duty of this Committee to assist the President in connection with the preparation for and the conduct of the Annual Dinner Meeting in honor of the Federal Judges.

*Chairman*

Peter Saxon

*Board Liaison*

Frank F. Scheck

*Members*

Lawrence Alaburda

William H. Dippert

Michael K. O'Neill

Lawrence S. Perry

M. Andrea Ryan

**COMMITTEE ON THE ANNUAL MEETING OF THE ASSOCIATION**

Scope of the Committee. It shall be the duty of this Committee to assist the President and Secretary in connection with the preparation for and conduct of the Annual Meeting of the Association and related event.

*Chairman & Board Liaison*

M. Andrea Ryan

*Members*

William H. Dippert

Julius Fisher

**COMMITTEE ON ANTITRUST, INEQUITABLE CONDUCT AND MISUSE**

Scope of the Committee. It shall be the duty of this Committee to consider the anti-trust laws, insofar as they relate to intellectual property, and other unfair conduct in connection with intellectual property including inequitable conduct and misuse, and to make recommendations with respect thereto to the Board of Directors.

*Chairman*

Nicholas L. Coch

*Board Liaison*

John E. Kidd

*Members*

James W. Badie

Charles E. Baxley

Mitchell Bittman

Michael A. Caputo

John E. Daniel

Frederick J. Dorchak

William S. Feiler

C. Bruce Hamburg

Gunther A. Hauptman

David Kalow

Lawrence G. Kastriner

**COMMITTEE ON ALTERNATIVE DISPUTE RESOLUTION**

Scope of the Committee. It shall be the duty of this Committee to consider the use of alternative dispute resolution techniques, including arbitration, in resolving intellectual property disputes and to make recommendations with respect thereto to the Board of Directors.

*Chairman*

David W. Plant

*Board Liaison*

Thomas L. Creel

*Members*

Charles P. Baker

Donald F. Parsons, Jr.  
 Jeffrey A. Schwab  
 Stuart J. Sinder  
 William Thomashower  
 Michael I. Wolfson  
 Walt Thomas Zielinski

### **COMMITTEE ON THE BICENTENNIAL OF THE PATENT AND COPYRIGHT LAWS, AND OF THE FEDERAL COURTS**

Scope of the Committee. It shall be the duty of this Committee to make recommendations to the Board of Directors concerning celebration of the bicentennial of the patent and copyright laws, and of the federal courts, and to implement the Association's celebration activities.

*Chairman*  
 Douglas W. Wyatt  
*Board Liaison*  
 Frank F. Scheck  
*Members*  
 David H.T. Kane  
 S. Delvalle Goldsmith

### **COMMITTEE ON CONTINUING LEGAL EDUCATION**

Scope of the Committee. It shall be the duty of this Committee to formulate and present continuing legal educational seminars of interest to the broad spectrum of the Association's Membership and to make recommendations with respect thereto to the Board of Directors.

*Chairman*  
 Edward V. Filardi  
*Board Liaison*  
 Alfred P. Ewert  
*Members*  
 Charles E. Baxley  
 Joseph J. Brindisi  
 Murry I. Franck  
 Philip Furgang  
 Richard T. Laughlin  
 Joel E. Lutzker  
 Frank Morris  
 John D. Murname  
 Robert I. Pearlman  
 Henry J. Renk  
 John F. Sweeney  
 Fritz L. Schweitzer

Ilene B. Tannen  
 William J. Thomashower  
 Ed Vassallo

### **COMMITTEE ON COPYRIGHTS**

Scope of the Committee. It shall be the duty of this Committee to consider all aspects of United States, foreign and multi-national copyright law and practice and to make recommendations with respect thereto to the Board of Directors. The Committee shall keep fully informed as to all procedures, rules, regulations and decisions, statutes, treaties, agreements and conventions, existing or proposed, relating to copyrights and make recommendations to the Board of Directors regarding any changes therein.

*Chairman*  
 Daniel M. Rosen  
*Board Liaison*  
 Martin E. Goldstein  
*Members*  
 Peter D. Aufrichtig  
 Vincent F. Bick, Jr.  
 Jordan B. Bierman  
 George W. Cooper  
 G. Roxanne Elings  
 Fred A. Keire  
 George F. Long, III  
 Gerard J. McGowan, Jr.  
 Howard C. Miskin  
 Garo Partoyan  
 Ilene B. Tannen  
 Roger S. Thompson  
 Chuanjie Zhou

### **COMMITTEE ON DESIGN PROTECTION**

Scope of the Committee. It shall be the duty of this Committee to study the protection of designs and related legislative proposals, and to make recommendations with respect thereto to the Board of Directors.

*Chairman*  
 Lloyd McAulay  
*Board Liaison*  
 M. Andrea Ryan  
*Members*  
 Stewart J. Fried  
 Arthur D. Gray  
 Albert C. Johnston  
 Jay H. Maioli

Bernard Malina  
 Charles E. McKenney  
 J. Harold Nissen  
 Angelo Notaro  
 Glenn F. Ostragen

### **COMMITTEE ON ECONOMIC MATTERS AFFECTING THE PROFESSION**

Scope of the Committee. It shall be the duty of this Committee to keep informed as to all matters affecting the economic interests of the Members of the Association including tax problems, retirement plans, pension programs, insurance programs, office management, office equipment, patent costs, trademark and copyright registration costs and employee salaries and to make recommendations to the Board of Directors with respect to such matters.

*Chairman*  
 Meyer Gross  
*Board Liaison*  
 Thomas L. Creel  
*Members*  
 Jay Begler  
 Norbert Ederer  
 Albert Jacobs, Jr.  
 Edward G. Meilman  
 Eric C. Woglom

### **COMMITTEE ON EMPLOYMENT**

Scope of the Committee. It shall be the duty of this Committee to process requests for employment and requests for employees in the patent, trademark and copyright fields and to make recommendations to the Board of Directors with respect to such matters.

*Chairman*  
 Patrick J. Walsh  
*Board Liaison*  
 Thomas L. Creel  
*Members*  
 Bernard E. Crowe  
 Barbara Toop D'Avanzo  
 Anthony H. Handal  
 Gabriel P. Katona  
 Leonard Prusak  
 R. N. Ronning  
 Earl L. Scott  
 Edward A. Steen  
 Howard P. Terry



### COMMITTEE ON FOREIGN PATENT LAW AND PRACTICE

Scope of the Committee. It shall be the duty of this Committee to consider all aspects of foreign and multinational patent laws and practice which affect the rights of United States entities in technology in foreign countries and to make recommendations with respect thereto to the Board of Directors.

#### *Chairman*

Jay L. Chaskin

#### *Board Liaison*

Dale L. Carlson

#### *Members*

E. W. Adams, Jr.

Mitchell Bittman

Don Cameron

Michael A. Caputo

Murray J. Ellman

Edward J. Fitzpatrick

Samson Helfgott

David Kalow

Ferdinand F.E. Kopecky

Bernard Lieberman

Maria C.H. Lin

Michael J. Meller

John P. Sinnott

Roger S. Smith

### COMMITTEE ON FOREIGN TRADEMARK LAW & PRACTICE

Scope of the Committee. It shall be the duty of this Committee to consider all aspects of foreign and multi-national trademark law and practice and to make recommendations with respect thereto to the Board of Directors.

#### *Chairman*

Virginia R. Richard

#### *Board Liaison*

Stanley J. Silverberg

#### *Members*

George W. Cooper

Michael I. Davis

G. Roxanne Elings

Gezina Holtrust

Clark W. Lackert

Lloyd L. Mahone

John R. Olsen

James N. Palik

Garó Partoyan

Thomas E. Spath

Irene B. Tannen

John P. Sinnott

### COMMITTEE ON HARMONIZATION OF PATENT LAWS

Scope of the Committee. It shall be the duty of this Committee to coordinate the activities of the Committee on Foreign Patent and Practice and the Committee on US Patent Law and Practice in cooperation with others regarding proposals to harmonize the substance, practice and interpretation of national laws and the international convention for the protection of intellectual property.

#### *Chairman*

William J. Brunet

#### *Board Liaison*

Leonard B. Mackey

#### *Members*

Jay L. Chaskin

Theresa M. Gillis

Samson Helfgott

Karl F. Jorda

Michael N. Meller

John P. Sinnott

### COMMITTEE ON INCENTIVES FOR INNOVATION

Scope of the Committee. It shall be the duty of this Committee to undertake studies and make recommendations to the Board of Directors regarding possible changes in law, regulations and governmental policy which are likely to provide incentives for innovation.

#### *Chairman*

Stanley Lieberstein

#### *Board Liaison*

Alfred P. Ewert

#### *Members*

Burton P. Beatty

E. Janet Berry

Rory J. Radding

Deborah A. Somerville

Terry Zisowitz

### COMMITTEE ON LEGAL AID

Scope of the Committee. It shall be the duty of this Committee to assist the Legal Aid Society of New York in rendering services in the patent, trademark or copyright fields to persons designated by the Society as qualifying for the aid of the Society and to report such activities to the Board of Directors.

#### *Chairman*

Steven J. Baron

#### *Board Liaison*

Evelyn M. Sommer

#### *Members*

Ronald E. Brown

Milton L. Honig

C. Douglas Wingate

### COMMITTEE ON LEGISLATIVE OVERSIGHT

Scope of the Committee. It shall be the duty of this Committee to coordinate the activities of this Association relating to intellectual property legislation, and to make recommendations with respect thereto to the Board of Directors.

#### *Chairman & Board Liaison*

Leonard B. Mackey

#### *Members*

Lawrence Alaburda

William J. Gilbreth

Frank J. Colucci

Theresa M. Gillis

Stanley J. Silverberg

Evelyn M. Sommer

### COMMITTEE ON LICENSE TO PRACTICE REQUIREMENTS

Scope of the Committee. It shall be the duty of this Committee to keep fully informed as to requirements and proposed requirements affecting the practice of Members of the Association before government agencies, including the Patent and Trademark Office, and the Courts, relating to admission to practice, qualifications for practice, continuing legal education and specialization, and to make recommendations for changes thereto to the Board of Directors.

#### *Chairman*

Joseph J. Brindisi

#### *Board Liaison*

Alfred P. Ewert

#### *Members*

James M. Heilman

Charles McKenney

### COMMITTEE ON LITIGATION PRACTICE AND PROCEDURE

Scope of the Committee. It shall be the duty of this Committee to consider legisla-

tion and rules affecting practice and procedural matters in intellectual property litigation outside the Patent and Trademark Office, and other matters relating to practice in such litigation, and to make recommendations with respect thereto to the Board of Directors.

*Chairman*

Lawrence Alaburda

*Board Liaison*

William J. Gilbreth

*Members*

James W. Badie

Victor N. Balancia

Stevan J. Bosses

Armand Cifelli

Arlana S. Cohen

William S. Feiler

Arthur D. Gray

Albert L. Jacobs, Jr.

William F. Kilgannon

Richard T. Laughlin

Jeffrey I.D. Lewis

George F. Long, III

Kenneth E. Madsen

Dolores A. Moro

Donald F. Parsons, Jr.

David N. Pfeffer

Henry J. Renk

Leonard J. Santisi

Jeffrey A. Schwab

Evelyn M. Sommer

Drew M. Winttingham

Terry Zisowitz

## COMMITTEE ON MEETINGS AND FORUMS

Scope of the Committee. It shall be the duty of this Committee to prepare and conduct a series of educational meetings of the Association other than meetings of the Officers, Committees and Board of Directors, the Annual Meeting of the Association and the Annual Dinner in Honor of the Federal Judiciary.

*Chairman*

William H. Dippert

*Board Liaison*

Pasquale A. Razzano

*Members*

Arlana S. Cohen

Leonard P. Diana

George Kaplan

Gary L. Kosdan

William F. Lawrence

Raphael A. Monsanto

Seth Natter

Thomas E. Spath

Vincent J. Vasta, Jr.

## NOMINATING COMMITTEE

Scope of the Committee. It shall be the duty of this Committee to consider candidates to the elective offices of the Association and to submit to the Members at the Annual Meeting of the Association, the names of candidates which the Committee nominates for such elective offices according to Article VI, Section 4.

*Chairman & Board Liaison*

David H.T. Kane

*Members*

Steven J. Baron

Samson Helfgott

Paul H. Heller

Margaret Ranft-Day

## COMMITTEE OF PAST PRESIDENTS

Scope of the Committee. It shall be the duty of this Committee to propose to the Board of Directors ways in which the Association and its objectives and public image may be improved and to study and report to the Board on any matter which may be referred to the Committee by the Board.

*Chairman*

Paul H. Heller

*Board Liaison*

David H.T. Kane

*Members*

Lorimer P. Brooks

W. Houston Kenyon, Jr.

Granville M. Brumbaugh

Stanton T. Lawrence, Jr.

Hugh A. Chapin

Jerome G. Lee

Bert A. Collison

Harry R. Pugh, Jr.

William C. Conner

Joseph J. Previto

John C. Cooper

John A. Reilly

William F. Eberle

Morris Relson

Paul M. Enlow

Giles S. Rich

Frank W. Ford, Jr.

Albert Robin

Alfred L. Haffner, Jr.

Lee C. Robinson, Jr.

Edward Halle

John O. Tarmontine

Cyrus S. Hapgood

Douglas W. Wyatt

Albert C. Johnson

Karl F. Jorda

John T. Kelton

## COMMITTEE ON PROFESSIONAL ETHICS AND GRIEVANCES

Scope of the Committee. It shall be the duty of this Committee to perform the activities set forth in Section 5 of Article VI of the By-Laws of the Association and to keep fully informed as to all Codes of Ethics or Professional Responsibility applicable to Members of the Association and interpretations thereof and as to all proposed changes in such Codes.

*Chairman*

Herbert Blecker

*Board Liaison*

Frank F. Scheck

*Members*

Richard G. Berkley

Karl F. Jorda

William F. Lawrence

Michael N. Meller

John P. Sinnott

Arthur S. Tenser

## COMMITTEE ON PUBLIC AND JUDICIAL PERSONNEL

Scope of the Committee. It shall be the duty of this Committee to consider and propose candidates for public and judicial offices which involve patent, trademark and copyright matters, and to make recommendations to the Board of Directors with respect to such candidates.

*Chairman*

John D. Foley

*Board Liaison*

William J. Gilbreth

*Members*

Harold Einhorn

Robert W. Fiddler

Joseph M. Fitzpatrick

Steven J. Lee

Thomas F. Meagher

David J. Mugford

Lawrence F. Scinto  
Herbert F. Schwartz  
John C. Vassil  
John P. White  
George W. Whitney

#### **COMMITTEE ON PUBLIC INFORMATION AND EDUCATION**

Scope of the Committee. It shall be the duty of this Committee to publicize the activities of the Association, to publicize the patent, trademark and copyright systems, to educate the public with respect to such systems and to make recommendations to the Board of Directors with respect thereto.

##### *Chairman*

Julius Fisher

##### *Board Liaison*

John E. Kidd

##### *Members*

Marilyn Brogan

Wayne M. Kennard

#### **COMMITTEE ON PUBLICATIONS**

Scope of the Committee. It shall be the duty of this Committee to prepare, edit, publish and disseminate such publications as may be requested by the Board of Directors and to make recommendations to the Board with respect thereto.

##### *Chairman*

Gregory J. Battersby

##### *Board Liaison*

Howard B. Barnaby

##### *Members*

George M. Kaplan

David J. Lee  
Jeffrey I. D. Lewis  
Serle Mosoff  
John R. Olsen  
James N. Palik  
Charles N. J. Ruggiero  
Mary Ellen Timbers  
Charles J. Zeller

#### **COMMITTEE ON UNITED STATES PATENT LAW AND PRACTICE**

Scope of the Committee. It shall be the duty of this Committee to consider all aspects of United States patent and technology law and practice and to make recommendations with respect thereto to the Board of Directors.

##### *Chairman*

Theresa M. Gillis

##### *Board Liaison*

Evelyn M. Sommer

##### *Members*

Peter D. Aufrechtig

Jordan B. Bierman

James V. Costigan

Barbara Toop D'Avanzo

Frederick J. Dorchak

Norbert Ederer

Stephen H. Frishauf

William S. Frommer

Francis C. Hand

George Kaplan

Thomas Langer

David J. Lee

Alan H. Levine

Jay H. Maioli

Edward G. Meilman

Charles A. Muserlian

J. Harold Nissen

Roland Plottel  
R.N. Ronning  
Stanley I. Rosen  
Berg A. Terzian  
Mary-Ellen Timbers  
Tiberiu Weisz  
Michael I. Wolfson

#### **COMMITTEE ON U.S. TRADEMARK LAW AND PRACTICE**

Scope of the Committee. It shall be the duty of this Committee to consider all aspects of United States trademark law and practice and to make recommendations with respect thereto to the Board of Directors.

##### *Chairman*

Frank J. Colucci

##### *Board Liaison*

Stanley J. Silverberg

##### *Members*

Charles E. Baxley

Martin J. Beran

Vincent F. Bick

Jordan B. Bierman

James L. Bikoff

Marilyn Brogan

Margaret Ranft Day

Paul Fields

Stewart J. Fried

Bruce E. Lilling

C. Bruce Hamburg

Robert W. Hollweg

Martin A. Levitin

Charles McKenney

Eric D. Offner

Glenn F. Ostrager

Douglas W. Wyatt

## **IN MEMORIUM**

**We deeply regret to announce the death on September 30, 1989  
of Lee C. Robinson, Jr., a former President of the NYPTC.**

## ANNOUNCEMENTS:

### REMINDER

Any firm intending to reserve a suite at the Waldorf-Astoria hotel for the 1990 Judges' Dinner should contact the hotel immediately to assure availability of the suite at a suitable time prior to the dinner.

### ADR SEMINAR NOV. 9

On November 9, the NYPTCLA will be co-sponsoring the ADR for Technology Disputes program in New York City. This seminar will present a stellar group of advocates and neutrals including several sitting and former district court judges who will explain their own experiences with ADR of high technology disputes. For more information, please contact Monic Hargrove, The Association of the Bar of the City of New York Fund, Inc., 422 West 44th Street, New York, N.Y., 10036-6690.

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### Members

Committee on Publications: Board Of Directors Liaison: Howard B. Barnaby; Chairman and Bulletin/Greenbook Editor: Gregory J. Battersby.

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Gregory J. Battersby, Editor; Richard B. Klar, David J. Lee, Jeffery I. D. Lewis, Salvatore C. Mitri, George M. Kaplan, Thomas L. Jarvis, Thomas O'Rourke, Charles N.J. Ruggiero, Charles J. Zeller.

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