



THE NEW YORK PATENT, TRADEMARK AND  
COPYRIGHT LAW ASSOCIATION

# NYPTC BULLETIN

Volume 33

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Number 1

## PRESIDENT'S CORNER

Since the committee year is just about to begin, I do not have a lot to discuss in this President's Corner. I did, however, receive the following letter which I thought highlighted the need for organizations like ours to reach out and educate the public on what intellectual property law is and what we can and cannot do to protect it. I am referring this letter to the Committee on Legal Aid but if anyone has a specific interest in this type of pro-bono legal work, please contact me or Jeffrey Lewis, the chair of that committee for further action:

Dear Ms. Ryan:

I spoke with your organization regarding starting an educational/self-help non-profit organization targeting persons with panic disorder and depression who are home-bound. I want to reach these people via multi-line electronic bulletin board (BBS). You returned my call during your trip to Europe and requested more details, asking that I reference your call as a reminder.

My ultimate goal is to help people who are home-bound due to a panic disorder or depression and provide them with the means to help themselves by communicating interactively with each other, forming self-help groups, obtaining lists of mental health professionals in their area specializing in their particular disorder and having access to educational material. I don't wish to compete with or act as a substitute for the professional treatment that these people may need; however, many of these people have limited financial means or are uninsured, so access to such an organization could be very beneficial to this targeted group.

Since speaking with you, I have contacted many law firms requesting pro-bono assistance in setting up my organization. I have also contacted many local and na-

tional self-help groups, attorneys, associations and mental health professionals to determine if such a program already exists. My continuing research has indicated that no other such program exists—at least not in this country.

According to Alcoholics Anonymous, there are literally hundreds of daily on-going self-help groups in the Washington, DC area alone which are available for alcoholics in the course of their recovery. By comparison, there are just three self-help groups for people with panic disorders. Most of these groups dissolve in less than a year because they change locations, lose vital group leaders due to burn-out, or are inaccessible to the home-bound, so getting to these meetings is difficult for people with these disorders.

My reason for contacting your organization was because data files which are uploaded and downloaded via a BBS need to be in the public domain. Established self-help groups have protected material, under copyright law, which would be most valuable to the users I plan to target. What steps do I take to get permission to use such material?

Such information may include:

- 12 Step and other programs
- Published articles by medical professionals, associations, journals, pharmaceutical companies, mental health professionals, etc.

My hope is to be able to provide educational material freely, so that I can help this large but much hidden group.

I may not be asking the right questions

or providing you with enough information. I was attracted to your organization simply because your name suggests that you deal in such manners of intellectual property, public domain, and liability issues concerning them.

I would be most appreciative of any guidance your organization could offer. Are there issues I've overlooked? Should I contact a particular person or organization? Would you be willing to send me a letter of endorsement—anything, that might help lend credibility and support for my proposed self-help organization as I continue to seek pro-bono legal support, and community acceptance?

I spent many years as an agoraphobic. It was by chance that I was lead to a treatment center, but only after many years of living in fear of leaving my home. Since being correctly diagnosed and treated, I plan to spend the rest of my life continuing with my own recovery, and pursuing my self-help organization, so others won't have to spend the best years of their lives living in ignorance, fear or needless shame.

Thank you for inviting me to write to you with more details. I appreciate your phoning me all the way from Europe! That was very thoughtful of you. Whatever you decide you can do, I want you to know that I have appreciated your time.

Sincerely,  
(Name Witheld)

— Andrea Ryan

## CALENDAR OF EVENTS

October 25-November 1, 1992

Licensing Executive Society, LES USA/  
Canada Annual Meeting, Boca Raton, FL

January 23-26, 1993

ABA-PTC Section, Mid-Winter Meeting,  
Registry Resort, Naples, FL

# 1992-93 NYPTC COMMITTEE ASSIGNMENTS

## 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 Bylaws and the Rules on Admissions of the Association and to make recommendations with respect thereto to the Board of Directors.

*Chair* Michael J. Kelly  
*Board Liaison* William H. Dippert

Edward M. Blocker  
Alice C. Brennan  
Eric B. Janofsky  
Edward H. Loveman  
Rory J. Radding  
Gidon Don Stern

and the Officers and Directors

## 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.

*Chair* Charles P. Baker  
*Board Liaison* Thomas L. Creel

Steven P. Berman  
Andrea L. Colby  
Bernard F. Crowe  
Edward Halle  
James M. Heilman  
J. Russel Juten  
Claire Ann Koegler  
Ernest F. Marmorek  
Russell G. Pelton  
Earl L. Scott  
Jeffrey A. Schwab  
Edward Weigram

## 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.

*Chair* Pasquale A. Razzano  
*Board Liaison* William J. Gilbreth

John Cotter  
Mary Ann Dickey

## 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 events.

*Chair & Board Liaison*  
Thomas L. Creel

Jeffrey Lewis  
Ronald Bleeker

## Committee on Antitrust, Inequitable Conduct and Misuse

*Scope of the Committee.* It shall be the duty of this Committee to consider the antitrust 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.

*Chair* John E. Daniel  
*Board Liaison* John Francis Sweeney

Mitchell Bittman  
Martin E. Goldstein  
Arthur D. Gray  
Robert Hess  
C. Bruce Hamburg  
Richard T. Laughlin  
Frank E. Morris  
Stuart P. Sender

## 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.

*Chair* Edward E. Vassallo  
*Board Liaison* Edward V. Filardi

Mark Abate  
Charles W. Almer  
Alfred Ewert  
Martin Goldstein  
George Kaplan  
John Kidd  
Stanley Liebenstein  
John A. O'Brien  
David W. Plant  
Scott K. Reed  
Evelyn M. Sommer

## Committee on Copyrights

*Scope of the Committee.* It shall be the duty of this Committee to consider all aspects of United States, foreign and international 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.

*Chair* Marilyn Smith  
*Board Liaison* John Francis Sweeney

Allen J. Baden  
Ronald A. Clayton  
Terese Cohen  
Eliot Gerber  
Thomas A. Smart  
Marilyn D. Smith  
Roger Thompson  
Raymond Van Dyke

## Committee on Design Protection

*Scope of the Committee.* It shall be the duty of this Committee to study the protec-

tion of designs and related legislative proposals, and to make recommendations with respect thereto to the Board of Directors.

*Chair* Lloyd McAulay  
*Board Liaison* Virginia Richard

Anthony J. Casella  
Albert C. Johnston  
Charles E. McKenney  
W. Brown Morton, Jr.

#### **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.

*Chair* Brian M. Poissant  
*Board Liaison* Howard B. Barnaby

Victor N. Balancia  
Stevan J. Bosses  
David A. Einhorn  
Meyer A. Gross  
Randy Lipsitz  
Richard A. Meilman  
Norman H. Zivin

#### **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.

*Chair* Richard L. De Lucia  
*Board Liaison* David J. Mugford

A.L. Collard  
Charles W. Grimes  
Shahan Islam  
John James McGlew  
William R. Robinson  
Edward A. Steen

#### **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.

*Chair* Michael N. Meller  
*Board Liaison* Robert L. Baechtold

Christopher E. Chalsen  
Jay L. Chaskin  
Murray J. Ellman  
Francis C. Hand  
Richard B. Klar  
Bernard Lieberman  
John S. Piscitello  
G. Woltrust

#### **Committee on Foreign Trademark Law and Practice**

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

*Chair* John R. Olsen  
*Board Liaison* Virginia R. Richard

George E. Badenoch  
James L. Bikoff  
Richard Brown  
George W. Cooper  
Michael I. Davis  
Eileen E. Kennedy  
Joseph Nicholson  
James N. Palik  
Irving N. Stein

#### **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 U.S. Patent Law and Practice in cooperation with others regarding proposals to harmonize the substance, practice and interpreta-

tion of national laws and the international convention for the protection of intellectual property.

*Chair* William J. Brunet  
*Board Liaison* Peter Saxon

Ronald A. Bleeker  
Leonard Diane  
Thomas M. Gibson  
Samson Helfgott  
George W. Johnston  
Peter Ludwig  
Charles A. Muserlian  
Robert I. Pearlman  
David Weild

#### **Host Committee**

*Scope of the Committee.* It shall be the duty of this Committee to prepare for and conduct any activities for the benefit of other professional associations and their members which may be authorized or requested by the Board of Directors.

*Chair* Edward V. Filardi  
*Board Liaison* Peter Saxon

David Goldberg  
Gerald W. Griffin  
Paul H. Heller  
David H.T. Kane  
Jerome G. Lee  
Joseph J. Previto  
Albert Robin  
Peter Saxon  
Frank F. Scheck  
Arthur Tenser  
John O. Tramontine  
Douglas W. Wyatt

#### **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.

*Chair* Thomas E. Spath  
*Board Liaison* Gregory J. Battersby

Peter DeLuca  
Alfred P. Ewert  
Howard R. Jaeger  
Wayne M. Kennard  
Mark P. Kesslen

### 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.

*Chair* Jeffrey I.D. Lewis  
*Board Liaison* Virginia R. Richard

Milton L. Honig  
Richard Komson  
Walter T. Zielinski

### 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.

*Chair & Board Liaison*  
Thomas J. Creel

James W. Badie  
Stephan J. Harbulak  
Leonard B. Mackey  
Arthur M. Peslak  
William J. Sapone  
Rochelle Seide

### 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.

*Chair* Dale L. Carlson  
*Board Liaison* Roger S. Smith

Martin E. Goldstein  
John V. Swinson

### Committee on Litigation Practice and Procedure

*Scope of the Committee.* It shall be the duty of this Committee to consider legislation 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.

*Chair* Robert Neuner  
*Board Liaison* Berj A. Terzian

Stevan J. Bosses  
Robert L. Goldman  
Robert W. Fiddler  
John Flock  
Constance S. Huttner  
Albert L. Jacobs, Jr.  
John Kurucz  
David H. Pfeffer  
Peter Phillips  
Lawrence F. Scinto  
Mark H. Sparrow  
Robert C. Sullivan  
Todd A. Wagner

### Committee on Meetings and Forums

*Scope of the Committee.* It shall be the duty of this Committee to prepare and conduct 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.

*Chair* William F. Lawrence  
*Board Liaison* William H. Dippert

Charles E. Baxley  
Marilyn Matthes Brogan  
John Donofrio  
Myron Greenspan  
William F. Lawrence  
Amanda Laura Nye  
Philip T. Shannon  
David H. Vickrey

### 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.

*Chair & Board Liaison*  
Peter Saxon

Ronald A. Bleeker  
Martin E. Goldstein  
William F. Lawrence  
Frank F. Scheck

### 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.

*Chair* Frank F. Scheck  
*Board Liaison* Peter Saxon

Lorimer P. Brooks  
Hugh A. Chapin  
Bert A. Collison  
William C. Conner  
John C. Cooper  
William F. Eberle  
Paul M. Enlow  
Frank W. Ford, Jr.  
Alfred L. Haffner, Jr.  
Edward Halle  
Cyrus S. Hapgood  
Paul H. Heller  
Albert C. Johnston  
Karl F. Jorda  
David H.T. Kane  
John T. Kelton  
W. Houston Kenyon, Jr.  
Stanton T. Lawrence, Jr.  
Jerome G. Lee  
John B. Pegram  
Joseph J. Previto  
Harry R. Pugh, Jr.  
John A. Reilly  
Morris Nelson  
Giles S. Rich

Albert Robin  
John O. Tramontine  
Douglas W. Wyatt

### **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 Bylaws 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.

*Chair* Albert Robin  
*Board Liaison* Pasquale M. Razzano

Herbert Blecker  
Dale L. Carlson  
Peter Saxon  
Arthur 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.

*Chair* Herbert F. Schwartz  
*Board Liaison* William Gilbreth

Mark J. Abate  
Herbert Blecker  
F.T. Carr  
Kenneth E. Madsen  
Thomas F. Meagher  
John W. Ryan  
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.

*Chair* Wayne M. Kennard  
*Board Liaison* Howard B. Barnaby

Mark Abate  
Thomas H. Beck  
Philip Furgang  
Ira J. Levy  
Peter C. Schechter  
Rochelle K. Seide

### **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.

*Chair & Board Liaison*  
Gregory J. Battersby

Arlana S. Cohen  
Kenneth J. Dow  
Karen J. Kramer  
Serle Ian Mosoff  
Thomas A. O'Rourke  
Charles J. Zeller

### **Committee on Trade Secret Law and Practice**

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

*Chair* Melvin C. Garner  
*Board Liaison* David Mugford

Donald J. Curry  
William R. Evans  
Stewart J. Fried  
Joseph B. Taphorn  
Scott A. Wisser

### **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 technol-

ogy law and practice and to make recommendations with respect thereto to the Board of Directors.

*Chair* Theresa M. Gillis  
*Board Liaison* John D. Murnane

E. Jane Berry  
Paul H. Blaustein  
Michael I. Chakansky  
Frederick J. Dorchak  
James A. Finder  
Stephen H. Frishauf  
William S. Frommer  
Thomas Langer  
Hope Liebke  
George W. MacDonald, Jr.  
Jay H. Maioli  
John M. McGillycuddy  
Gabriel P. Katona  
Roland Plottel  
Donna M. Praiss  
Stanley J. Silverberg  
Tiberiu Weisz

### **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.

*Chair* Edward J. Handler, III  
*Board Liaison* Edward Filardi

Marsha G. Ajhar  
Martin J. Beran  
Peggy Day  
Paul Fields  
Julius Fisher  
Laurence Hefter  
Martin A. Levitin  
George F. Long  
Eric D. Offwer  
Alan Ruderman  
Fritz Schweitzer, Jr.  
Howard J. Shire  
Stanley Silverberg

### **Representatives:**

**National Council of Intellectual  
Property Law Associations**  
Peter Saxon

**U.S. Inter-Bar EPO Liaison  
Representative  
Samson Helfgott**

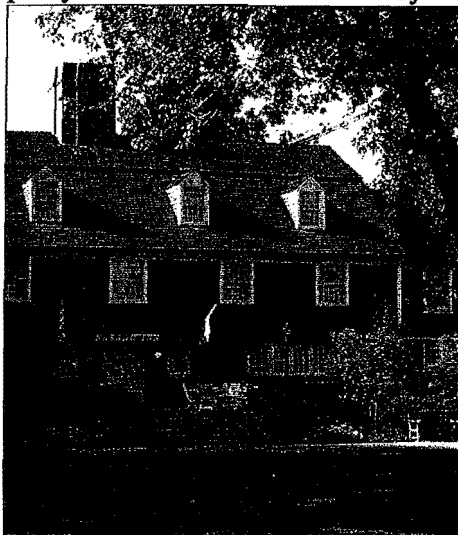
**U.S. Bar/Japan Patent Office Liaison  
John B. Pegram**

## CLE WEEKEND HIGHLIGHTS

Ed Vassallo, CLE Chairperson, and the CLE Committee hosted the CLE Weekend at the Nassau Inn in Princeton, New Jersey, on September 11-13. Al Robin and Claire Koegler won the golf tournament held Friday at Princeton Meadows Country Club, and were presented their awards at Friday's Dinner Reception by Past President Peter Saxon. Everyone in attendance agreed the sessions were both entertaining and informative.

### EX PARTE AKAMATSU

Former Commissioner of the Patent and Trademark Office, Harry F. Manbeck, Jr. and John F. Witherspoon, a former member of the Board of Appeals and Interferences (1971-1978), debated the question: Should the Commissioner of the PTO use the Board of Patent Appeals and Interferences as an instrument to establish legal policy? The debate was moderated by the



*The Nassau Inn, Princeton, NJ*

Honorable Alfred M. Wolin, United States District Judge for the District of New Jersey.

In *Ex parte Akamatsu*, 22 USPQ 2d 1915 (Bd. App. and Int. 1992), a panel of the Board composed of three examiners-in-chief heard an appeal from a rejection of certain claims under 35 U.S.C. §101 as drawn to nonstatutory subject matter, a mathematical algorithm. The claims were to a method and apparatus used for graphics interpolation. The apparatus claims were in means plus function form and essentially recited means for performing each step of the method. The panel decided the appeal, wrote and signed an opinion reversing the examiner's decision, but had not mailed it when Commissioner Manbeck, convinced that the panel had erred, designated a new panel consisting of himself, the Deputy Commissioner, the Assistant Commissioner for Trademarks and the Chairman and Vice Chairman of the Board to replace the original panel. The new panel affirmed the Examiner's decision.

Commissioner Manbeck explained that his action was motivated by the need to maintain certainty in the law. In addition, Mr. Manbeck argued that the Board must follow the Commissioner's "legal policy" directives to ensure that the PTO will always "speak with one voice," that the PTO should not issue invalid patents and that the real issue here is one of "pay and status" of members of the Board.

Mr. Witherspoon believed the underlying fundamental issue in the debate to be: Is it in the best interest of the United States patent system (i.e. the public interest) to afford inventors an opportunity to obtain a review of an examiner's refusal to allow their applications for patents within the PTO itself, in lieu of having to seek relief directly in the federal courts?

Mr. Witherspoon said he also favored certainty in the law and the PTO not knowingly issuing invalid patents. However, he argued that use of the Board to implement a Commissioner's policy, as was allegedly done in *Akamatsu*, is "illogical, impractical, and probably illegal," as well as demoralizing to members of the Board. He reads sections 7, 131, 132, and 134 of Title 35 as collectively setting forth a statutory arrangement whereby examiners (on behalf of the Commissioner) review applications at one level and whereby applicants are then accorded a right of appeal to an-

other level within the PTO. According to Mr. Witherspoon, the "required by law" provision of section 6, which sets forth the Commissioner's duties, must be interpreted in a way so as not to undercut the other statutes, and that for the Commissioner to mandate the outcome of an appeal, either directly or by indirection through use of his authority to designate panels of the Board, clearly undermines the statutory scheme. Further, he argued that the motion that the PTO must "speak with one voice" simply cannot be reconciled with the very nature of an appellate review. Mr. Witherspoon argued that there is only *one* legal policy which should be followed in the PTO — to apply on a case-by-case basis the applicable law as set forth in the statute and in the Supreme Court and Federal Circuit precedent — and that this has been the approach historically followed by the Board, even in cases involving conflicts between case law precedent and a Commissioner's Notice. *Ex parte Osmond*, 191 USPQ 334 (1976) was cited as an example.

In Mr. Witherspoon's view, the Board is a single entity and a panel functions as an arm of the Board. He contended that no panel, therefore, should decide a case knowing or strongly suspecting that its decision may be contrary to the majority view of the whole Board.

Mr. Witherspoon also believes that less, not greater, certainty results when an individual Commissioner's personal views effectively count for more than one vote on the Board. He pointed out that history shows that Commissioners are hardly of one mind regarding interpretations of the law, and that since 1961, their average term of office is less than three years. In sharp contrast, he said, examiners-in-chief work with important legal issues on a daily basis in groups wherein consensus judgments are reached and often remain on the Board for many years. Mr. Witherspoon contends that these decisions are more likely to result in a stable uniform body of precedent if not disturbed by outside "policy" dictates from time to time. He pointed out that there is nothing to prevent a Commissioner, as well as the Solicitor of the PTO, from presenting their arguments on the record for full consideration by the Board during the appeal process, for example, by assisting an examiner in writing the Examiner's Answer, by participating in oral argument, and by re-



questing reconsideration of a Board decision once made. Mr. Witherspoon explained that in 1927, Congress deliberately abolished the then statutory right of an appeal from the Board to the Commissioner in person, who could overrule the Board, and that the 1927 statute eliminating that procedure is basically still the law today.

Finally, Mr. Witherspoon rejects any suggestion that a Board member would allow administrative matters, such as "pay and status" issues, to influence his decision on the merits of a case.

In a spirited discussion fueled by tough questions from Judge Wolin, neither Mr. Manbeck nor Mr. Witherspoon wavered from their positions. They continued to disagree over whether 35 U.S.C. § 7 (b) provides for an independent second-tier review within the PTO, and whether the proper role of the Board is to implement the personal policy views of the Commissioner. Finally, however, Mr. Manbeck did state that upon reflection, he would include the original board members on a reconvened board, if faced with the same problem today. Nevertheless, he remained firm in his conviction that where the Commissioner is personally convinced that an invalid patent would result because of an "erroneous" decision of the Board, it is his duty to take steps to correct that decision.

### **TWO PESOS v. TACO CABANA**

Peter Cobrin, Esq., of Cobrin, Gittes & Samuel, and Marie Driscoll, Esq., of Robin, Blecker, Daley & Driscoll, discussed the impact of *Two Pesos v. Taco Cabana* \_\_U.S.\_\_ 23 USPQ 2d 1081 (1992) on trade dress law. In *Two Pesos* the Supreme Court affirmed a jury finding that the overall appearance of Taco Cabana's restaurants was a protectable trade dress which had been infringed by Two Pesos. In doing so, the Supreme Court resolved a conflict among the circuits by determining that a trade dress can be protected if it is inherently distinctive even without a showing of secondary meaning. Peter Cobrin noted that trade dress defendants now must try to establish defenses based on functionality and lack of distinctiveness of the trade dress, and the absence of a likelihood of confusion. He recommended that potential infringers prominently feature their own names on their trade dress, a practice which served as an effective defense in the recent *Bristol-*

*Myers Squibb Co. v. McNeil-P.P.C., Inc.*, Nos. 92-7212, 92-7260, 1992 U.S. App. LEXIS 19622 (2d Cir. 1992) case. The potential infringer should also be sure that it does not copy the trade dress exactly.

Marie Driscoll agreed that functionality is a more important defense after *Two Pesos*, and cited *Abbott Laboratories v. Mead Johnson & Co.*, F.2d \_\_, 23 USPQ 2d 1663 (7th Cir. 1992) as a recent case discussing an essentially economic analysis for functionality. In *Abbott Labs*, the Seventh Circuit held that the accused infringer asserting the functionality defense must show that the cost of marketing the infringing product in a different packaging will raise the cost of producing and marketing the product, and thereby drive its price above that of the trade dress owner. She also pointed to *Storck U.S.A. v. Farle Candy Co.*, 785 F. Supp. 730, 22 USPQ 2d 1204 (N.D. Ill. 1992) as a good discussion of what is distinctive versus non-distinctive trade dress, and *Ohio Art Co. v. Lewis Galloob Toys, Inc.*, No. 92 C 947, 1992 U.S. Dist. LEXIS 11879 (N.D. Ill. 1992), where the court, in denying a preliminary injunction, focused on functionality and the plaintiff's failure to show that it had claimed the product configuration as a trademark until its patent rights had nearly expired. Finally, Driscoll commented that the Second Circuit in *Bristol-Myers Squibb v. McNeil* seemed to give trade dress less significance than trademarks.

### **COPYRIGHT MISUSE—THE LASERCOMB CASE**

Professor Hugh C. Hansen of Fordham University spoke on the emerging doctrine of copyright misuse. He examined the facts in *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970 (4th Cir. 1990). He criticized the court's conclusions that the licensor's non-competition clause in its software license was copyright misuse when there had been no antitrust violation or finding of unclean hands. Professor Hansen criticized the court's conclusion that the doctrine could be successfully invoked by a defendant who had not been subject to the alleged misuse and who had committed fraud and had blatantly infringed the plaintiff's copyright.

Professor Hansen found no basis for the court's approach to copyright misuse in the copyright and patent clause of the Constitution, the Federalist Papers, the Copyright

Act or the common law. Moreover, he viewed the court's reasoning as analytically unsound. For instance, the court never gave a reason why a licensor's use of market power to obtain non-price licensing restrictions which are "reasonable" under the antitrust laws should be a *per se* violation of public policy. The reason given in some patent misuse cases, that such licensees "extend" the patent monopoly, is economically unsound. Market power, however obtained, cannot be extended. It can be exploited through the price charged for a product or a price combined with marketing restrictions in licenses. When a licensor chooses to add such restrictions which have costs to licensees, it must reduce its price. Whatever merit there is to a broad patent misuse doctrine, it should not be imported wholesale into copyright law where there is only a right to prevent copying, not a right to make, use and sell.

Professor Hansen also concluded that on the facts before the court there was no economic basis for prohibiting Lasercomb's requirement that licensees not produce competing programs. In fact, this restriction in a market which had seven software competitors would normally benefit consumers. Lasercomb's licensees were not producing software. Its restriction would thus not remove any existing competitors from the market. It would, however, enable Lasercomb to more cheaply police and prevent its non-software producing licensees from copying and selling Lasercomb's software. This reduction in cost could be passed on to the licensees especially since they would ordinarily demand some reduction in price to forego the possibility of future entry into the software market. The licensee's savings could then be passed on to the consumers, and in a competitive market, would be. Even if the provision would always have a noncompetitive effect, the court ignored the fact that only one of Lasercomb's 40 licensees was subject to the restriction.

Professor Hansen finally objected to the *Lasercomb* doctrine because it would provide copyright defendants with a vehicle to greatly expand discovery into plaintiff's licensing practices. Without limitations on who can assert it or specific guidelines on what constitutes misuse, the doctrine could increase the costs and delay preliminary relief in all copyright infringement actions. ■

# ON THE MERITS OF AKAMATSU (AND ALAPPAT): WHEN ARE CLAIMS THAT INCLUDE MATHEMATICAL ALGORITHMS STATUTORY SUBJECT MATTER UNDER 35 U.S.C. § 101?

by William J. Gilbreth and  
David C. Radulescu\*

## I. INTRODUCTION

### A. Section 101

35 U.S.C. § 101 defines "patentable inventions" in the following terms:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.<sup>1</sup>

If a claimed invention does not fall within one of the four enumerated categories under § 101, the invention—no matter what it is for, and no matter how useful, novel or non-obvious it might be—is "non-statutory" and non patentable.<sup>2</sup>

Interpretation of Section 101 in the context of mathematical algorithms has proven difficult and controversial. As Judge Rich stated in 1980, for example:<sup>3</sup>

The determination of statutory subject matter under § 101 in the field here involved [i.e., mathematical algorithms] has proved to be one of the most difficult and controversial issues in patent law. [ . . . ] The problems revolve about the role of mathematics in the claimed invention.

But the issue is not novel, in the sense that closely related issues lead to earlier "judicial exceptions" concerning patentability.

In *O'Reilly v. Morse*,<sup>4</sup> the Supreme Court held that Morse had properly been granted a patent for a process of using electromagnetism to produce distinguishable signs for telegraphy.<sup>5</sup> But the Court disallowed a claim directed to the use of "electromagnetism, however developed for making or printing intelligible characters, signs, or letters, at

any distances."<sup>6</sup>

In substance, this early rule is that the general use of such natural phenomena as electromagnetism can not be patented, *per se*—even though particular uses of such phenomena, or apparatus which make use of such phenomena, are potentially patentable.

### B. Computer Programs

In the mid-1960's, President Johnson appointed a task force to consider changes to the patent laws to take into account emerging technologies.<sup>7</sup> An issue to which the committee gave considerable consideration was the patentability of inventions that were part of, or implemented by, computer programming. The committee was concerned about the far reaching, and perhaps unknown, effects of patenting computer program-related inventions. Its recommendation was decidedly in the negative:

A series of instructions which control or condition the operation of a data processing machine, generally referred to as a 'program,' shall not be considered patentable regardless of whether the program is claimed as: (a) an article, (b) a process described in terms of operations pursuant to a program; or (c) one or more machine configurations established by a program.<sup>8</sup>

Several bills were introduced in the Senate to incorporate a provision into the patent statute like that recommended by President Johnson's committee. None were successful.

## II. THREE SUPREME COURT DECISIONS

### A. *Gottschalk v. Benson*<sup>9</sup>

In 1972, the Supreme Court held that a method of converting numerical information from binary-coded decimal numbers into "pure" binary numbers, for use in programming general purpose computers did not constitute patentable subject matter. The *Benson* Rule is that a "mathematical algorithm" cannot be the subject of a patent. It is important to note, however, that *Benson* did not deal broadly with "algorithms." A "mathematical algorithm" was defined as a "procedure to solve a given mathematical problem."<sup>10</sup>

### B. *Parker v. Flook*<sup>11</sup>

In 1978, the Supreme Court held that a method for updating alarm limits during catalytic conversion processes, in which the "only novel feature"<sup>12</sup> is a mathematical formula, did not constitute patentable subject matter.

### C. *Diamond v. Diehr*<sup>13</sup>

In 1981, the Supreme Court held that a process for molding raw rubber into cured products was patentable—notwithstanding that the process employed a mathematical equation. In reaching this result the Court emphasized that:

[A]n application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.<sup>14</sup>

\*\*\*

In determining the eligibility of respondents claimed process for patent protection under § 101, their claims must be considered as a whole.<sup>15</sup>

### D. The CCPA's "Two-Step" Test

In the years following *Benson*, the CCPA formulated a "two-step test" which has sometimes been used to implement the judicial exception articulated in *Benson*.<sup>16</sup>

STEP 1: Does the claim directly or indirectly recite a mathematical algorithm?

STEP 2: If a mathematical algorithm is found, the claim as a whole is further analyzed to determine whether the algorithm is "applied in any manner to physical elements or process steps," and, if it is, it passes muster under § 101.

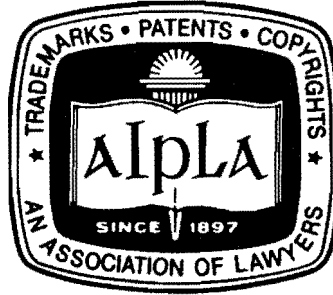
## III. THREE FEDERAL CIRCUIT DECISIONS

### A. *In re Grams*<sup>17</sup>

The Federal Circuit (Archer, J.) held non-patentable a claim to a computerized method for diagnosing an abnormal condition in an individual, involving obtaining data from tests, and analyzing the data according to a mathematical procedure to identify an abnormality and its causes.

The Court first dissected the claim to identify a sole "physical" step after the "mathematical algorithm" was removed, and then held that "[t]he presence of a physical step in

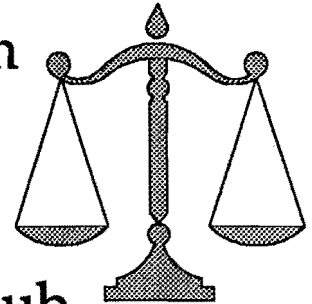




## 1993 Mid-Winter Institute



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the claim to derive data for the algorithm will not render the claim statutory."<sup>18</sup> The Court appeared unable to "reconcile"<sup>19</sup> its interpretation of *Benson* with *Diehr* and another Supreme Court decision concerning § 101, *Diamond v. Chakrabarty*.<sup>20</sup>

### B. *In re Iwahashi*<sup>21</sup>

Four days later another panel of the Federal Circuit (Rich, J.) held patentable a claim directed to a circuit for calculating so-called "auto-correlation" coefficients for a speech recognition device.

The Court did not first extract the "mathematical algorithm" that was "recited" in the claim. Instead the Court analyzed the claim "as a whole":

The claim as a whole certainly defines apparatus in the form of a combination of *interrelated* means and we cannot discern any logical reason why it should not be deemed statutory subject matter as either a machine or a manufacture as specified in § 101.<sup>22</sup>

The Court did not "convert" the apparatus claim into a "corresponding" method claim. [All but one element was written in "means-plus-function" format.] In rejecting one of the Solicitor's arguments, however, the Court used § 112 ¶ 6 to limit the scope of means-plus-function claims.

### C. *Arrhythmia Research Technology Inc. v. Corazonix Corp.*<sup>23</sup>

Last March the Federal Circuit (Newman, J.; Rader, J., concurring separately) held patentable both method and apparatus claims for analyzing electrocardiograph signals in order to determine certain characteristics of the heart function especially after a heart attack.

The Court analyzed the method claims separate from the apparatus claims, and did not convert the apparatus claims into "corresponding" method claims. The Court did not dissect the claims into a "mathematical algorithm" component and "non-mathematical algorithm" component, but analyzed the claim as a whole. The apparatus claims were set forth in "means-plus-function" format and were analyzed with particular reference to the specification in light of § 112 § 6. (*Iwahashi* was endorsed on this point.)

In a concurring opinion, J. Rader emphasized:

Relying on the language of the patent statute, the Supreme Court in [*Diehr*], turned away from the *Benson* algorithm rule. Thus, I too conclude that the '459 patent claims patentable subject matter—not on the basis of a two-step post-*Benson* test, but on the basis of the patentable subject matter standards in title 35.<sup>24</sup>

\*\*\*

First, even if mathematical algorithms are barred from patentability, [cite omitted] the '459 patent as a whole does not present a mathematical algorithm. The '459 patent is a method for detecting the risk of a heart attack, not the presentation and proposed solution of a mathematical problem. In *Diehr*, the Supreme Court viewed the claims as 'an industrial process for molding of rubber products,' not a mathematical algorithm. [cite omitted] The '459 patent's claims as a whole disclose a patentable process.

Second, the '459 patent does not claim a natural law, abstract idea, or natural phenomenon. *Diehr* limited the *Benson* rule to these three categories, none of which encompass the '459 patent.

Finally, and most important, *Diehr* refocused the patentability inquiry on the terms of the Patent Act rather than on non-statutory, vague classifications. Under the terms of the Act, a 'process' deserves patent protection if it satisfies the Act's requirements. The '459 patent claims a 'process' within the broad meaning of section 101. Therefore, this court must reverse and remand.<sup>25</sup>

## IV. *EX PARTE* AKAMATSU<sup>26</sup>

### A. Claims

1. Claim 5. A method for graphics interpolation . . . , said method comprising the steps of: *calculating* a first 4-bit-shifted difference of said first point data from said third point data; *calculating* a second 4-bit-shifted difference . . . ; *calculating* a one-bit-shifted summation . . . ; *generating* said interstitial point data . . . by . . . *adding* . . . ; and *displaying* the interstitial graphic point on the display device according to the interstitial point data generated during said generation step.

2. Claim 6. An apparatus for graphics interpolation . . . , said apparatus comprising: [Similar to claim 5 except that the phrase "a means for" has been added before each calculating and generating step and it also omits the displaying step].

3. Claim 7. A method for graphics interpolation . . . , said method comprising the steps of: *calculating* a first 4-bit-shifted difference of said first point data from said third point data *using a first 4-bit-shifted wired-logic*; . . . [Similar to claim 5 except the shifted difference steps are calculated using "bit-shifted wired-logic," as shown in

the first element above.]

4. Claim 8. An apparatus for graphics interpolation . . . , said apparatus comprising: *a first-means for calculating* a first 4-bit-shifted difference of said first point data from said second point data, *said first means including a first 4-bit-shifted wired-logic*; . . . [Similar to claim 6 except "first means," "second means," and "third means" for calculating are used instead of the anonymous "means" of claim 6, and also recites that the first, second and third means include "bit-shifted wired logic."]

### B. Board of Appeals Decision (Commissioner, et al.):

#### 1. Method Claim 5, non-patentable:

When claim 5 is viewed without the steps of the mathematical algorithm, the only step left is the final step of 'displaying the interstitial graphic point on the display,' that is, displaying the result of the calculation in a broadly stated way . . . the display step represents insignificant or non-essential post-solution activity which does not convert the claimed subject matter into a statutory process.<sup>27</sup>

#### 2. Method Claim 7, non-patentable:

We agree with the examiner's conclusion and cases cited in support thereof [that the] apparatus limitations are not entitled to patentable weight in a method claim.<sup>28</sup>

[Claim rejected for same reasons as claim 5.]

#### 3. Apparatus Claim 6, non-patentable:

a) Claims truly directed to apparatus as a 'machine' or 'manufacture' under § 101 do not fall within the judicially determined mathematical algorithm exception since the calculation method remains free for use by anyone not employing the specific apparatus.<sup>29</sup>

b) Claim converted to a corresponding method claim:

The interposition of the phrase 'a means for' before each method step does not alter the character of claim 6 to limit the claim to specific structure for performing the functions and does not define any interconnection among the 'means.'<sup>30</sup>

c) Claim 6, when viewed without the mathematical algorithm, contains no steps which could be considered to be a statutory process. Unlike claim 5, no step of display is recited. For this reason and for the reasons stated with respect to claim 5, we affirm [the rejection].<sup>31</sup>

d) The Board explicitly refused to refer

to the specification in order to construe the "means" limitations:

Until the Federal Circuit further addresses the issue, our policy is to continue to follow the practice set forth in the CCPA cases [where 'means for' apparatus claims are treated as method claims].<sup>32</sup>

#### 4. Apparatus Claim 8, *patentable*:

[D]ispositive here, the 'wired-logic' limitations are interpreted in accordance with appellant's arguments . . . to be specific hardware limitations not in means-plus-function format, which are analogous to the ROM limitation in *Iwahashi*. Furthermore, we interpret the 'wired-logic' limitations, especially the '4-bit-shifted wired-logic,' to preclude reading claim 8 on a general purpose digital computer, because computers implement shift operations one shift at a time in a register.<sup>33</sup>

### C. Commentary

1. The Board does not cite or follow *Arrhythmia*.

2. The claims should have been analyzed "as a whole." (*Diehr*<sup>34</sup>)

3. *Cessante ratione legis, cessat et ipsa lex*. [Where the reason for the existence of a law ceases, the law itself should also cease.] (See *Benson* discussion of *O'Reilly v. Morse*,<sup>35</sup> and *Diehr* discussion of *Mackay Radio*.<sup>36</sup>

4. The Federal Circuit has "further addresse[d]" the § 112 issue. *Arrhythmia* is in accord with *Iwahashi* on this point.

5. None of the four claims at issue should have been rejected on the basis of Section 101. See, in particular, *Diehr* and Judge Rader's concurring opinion in *Arrhythmia*.

### V. EX PARTE ALAPPAT<sup>37</sup>

#### A. The Stated Issues On Appeal

1. Whether claim 15, which is written in "means plus function" format, can be treated as a method claim for the purpose of the statutory subject matter analysis under 35 U.S.C. § 101.

2. And, if so, whether claim 15 defines statutory subject matter under 35 U.S.C. § 101.

#### B. Claim 15

A rasterizer for converting vectors in a data list representing sample magnitudes of an input waveform into antialiased pixel

illumination intensity data to be displayed on a display means comprising:

(a) means for determining a vertical distance between the endpoints of each of the vectors in the data list;

(b) means for determining an elevation of a row of pixels that is spanned by the vector;

(c) means for normalizing the vertical distance and elevation; and

(d) means for outputting illumination intensity data as a predetermined function of the normalized vertical distance and elevation.

### C. Majority (Commissioner, et al.) (Claim 15 not patentable):

#### 1. *Iwahashi* is limited to its facts.

[T]he usual rules of claim interpretation apply, i.e., claims are given their *broadest reasonable interpretation* and limitations from the specification will not be imputed to the claims.<sup>38</sup>

We conclude that appellants have not carried their burden of showing that claim 15 is directed to specific apparatus and, therefore, that it is proper to treat claim 15 as a method claim.<sup>39</sup>

2. "Each step in claim 15 defines a mathematical operation . . ."<sup>40</sup>; "The present case differs from *Arrhythmia* in that no statutory process remains when claim 15 is viewed without the mathematical algorithm."<sup>41</sup>

### D. Dissent (The Three Original Examiners-in-Chief) (Claim 15 patentable):

1. The facts presented in this appeal before us clearly indicate that we *do not have* functionally-defined disclosed means and their equivalents which are so broad that they encompass any and every means for performing the recited functions in claim 15 on appeal.<sup>42</sup>

2. [T]he new decision majority opinion is internally inconsistent in first acknowledging that 'means for' claims ought to be construed in accordance with the sixth paragraph of [§ 112] for [§ 101] statutory subject matter purposes and then proceeding to apply the prior art broadest reasonable interpretation test to claim 15. We know of no case holding that the broadest reasonable interpretation test for applying prior art should be used for determining statutory subject matter under [§ 101], and the new decision majority has cited none.<sup>43</sup>

3. [The appellants have] clearly satisfied their burden of demonstrating that the 'means for' features are drawn to specific and distinct apparatus . . . [R]asterizer claim 15 reads on the disclosed structure and the equivalents for purposes of determining whether statutory subject matter under 35 U.S.C. 101 is being

claimed; it is not so broad as to encompass any and every means for performing the recited functions. Thus, we do not see any 'form versus substance' issue.<sup>44</sup>

### E. Commentary

The claim should not have been rejected on the basis of Section 101, for essentially the same reasons as set forth above with respect to *Akamatsu*.

### ENDNOTES

\* This paper was presented at the 1992 NYPTC CLE Weekend at Princeton, NJ on September 12, 1992.

1. 35 U.S.C. § 101.

2. *Diamond v. Chakrabarty*, 447 U.S. 303 (1980).

3. *In re Walter*, 618 F.2d 758, 764 (CCPA 1980) (Judge Rich).

4. 56 U.S. (15 How.) 62 (1852).

5. *Id.*, at 111.

6. *Id.*, at 112.

7. "To Promote the progress of . . . Useful Arts," Report of the President's Commission on the Patent System (1966).

8. *Id.*, at 13.

9. 409 U.S. 63 (1972).

10. *Id.*, at 65.

11. 437 U.S. 584 (1978).

12. *Id.*, at 588.

13. 450 U.S. 175 (1981).

14. *Id.*, at 187.

15. *Id.*, at 188.

16. *Patentable Subject Matter*, 1106 Official Gazette 5, 6 (Sept. 5, 1989) (Legal analysis by Associate Solicitor Lee E. Barrett, an attorney in the Office of the Solicitor of the Patent and Trademark Office, on the subject of the patentability of mathematical algorithms and computer programs).

17. 888 F.2d 835 (Fed. Cir. Nov. 3, 1989).

18. *Id.*, at 840.

19. *Id.*, at 837-38.

20. 447 U.S. 303 (1980) (Noting that Congress intended statutory subject matter to include "anything under the sun that is made by man.").

21. 888 F.2d 1370 (Fed. Cir. Nov. 7, 1989).

- 22. *Id.*, at 1375.
- 23. 958 F.2d 1053 (Fed. Cir. March 12, 1992).
- 24. *Id.*, at 1061.
- 25. *Id.*, at 1066.
- 26. 22 USPQ2d 1915 (Bd.Pat.App.Int. May 12, 1992)
- 27. *Id.*, at 1918.
- 28. *Id.*, at 1919.
- 29. *Id.*, at 1919.
- 30. *Id.*, at 1922.
- 31. *Id.*, at 1922.
- 32. *Id.*, at 1922.
- 33. *Id.*, at 1922.
- 34. See note 15, *supra*.
- 35. 409 U.S. at 68.
- 36. 450 U.S. at 188.
- 37. 23 USPQ2d 1340 (Bd.Pat.App.Int. May 12, 1992).
- 38. *Id.*, at 1344.
- 39. *Id.*, at 1344.
- 40. *Id.*, at 1346.
- 41. *Id.*, at 1347.
- 42. *Id.*, at 1349.
- 43. *Id.*, at 1350.
- 44. *Id.*, at 1350.

## THOUGHTS ON HARMONIZATION AFTER THE ABA SAN FRANCISCO MEETING

*by S. Delvalle Goldsmith*

At the ABA Meeting in San Francisco, there were three Business Sessions. All of the first two and part of the third were devoted to international patent harmoniza-

tion. The following are some thoughts to be considered about the patent harmonization Treaty.

1. Is there any "life after harmonization"? International harmonization of any facet of our existence is presumably good, especially if it results in international friendship and goodwill (no guarantee). But aren't there important aspects of U.S. intellectual property law that deserve equal time?

2. Are we looking at the trees of individual harmonization items rather than at the forest of the negotiation necessary to achieve the items we desire? The most important practical aspect of harmonization for us should be successful negotiation to get something beneficial if we change from first-to-invent to first-to-file. Are we giving our negotiators the correct information?

3. While many of us think that first-to-file may be simpler and less expensive, many others (maybe a majority) think first-to-invent is better. Shouldn't we tell our negotiators that it will be difficult to accomplish change from our time-honored and presently-operating first-to-invent system unless we get in return changes in foreign patent systems (such as more extensive subject matter protection, an adequate grace period, and recognition of the doctrine of equivalents) that will benefit U.S. inventors and assignees who apply for patents under those systems?

4. Happily, we acted in San Francisco to ask the ABA to update its position on harmonization from one based on our rescinded 1967 position to one based on our current (1991) position. However, I don't think this goes quite far enough in the direction indicated above.

5. (an unhappy thought) If, by adherence to the proposed Treaty, we give up first-to-invent to secure more extensive subject matter protection, we will get little or nothing in return from the major industrial countries which already provide patent protection for chemical and pharmaceutical

products. On the other hand, we will also get little or nothing in return from the less industrialized countries if they don't sign the Treaty or sign it with reservations. I don't know the answer to this riddle. Perhaps we could ask our industrial country friends (who want the Treaty) to use their efforts to convince the less industrialized countries to sign the Treaty.

6. I think the Section has, in our own Bill Brunet, someone who combines expertise in this emotional area with a calm and non-emotional approach. ■

## NYPTC SPONSORS U.S. SUPREME COURT ADMISSION

*by Howard B. Barnaby*

On June, 15, 1992, over thirty NYPTC members, their friends and families gathered at the U.S. Supreme Court for a ceremonial admission.

The Association arranged for a block of rooms at a nearby hotel which were made available for the entire weekend. After a day of touring our nation's capital, the participants met at Hogate's Restaurant on Sunday evening for a reception and dinner. Also present at the dinner were NYPTC President Andrea Ryan and immediate Past President Peter Saxon. Since the restaurant's air conditioning system happened to fail just prior



to the evening's festivities, a hot time was had by all.

The following morning, the group was whisked off to the Supreme Court by limousines (with air conditioning). All participants were then escorted into the courtroom where Albert Robin, an NYPTC Past President, moved their admission before the full Court. The event proved to be a memorable one for all. While this year's group of admittees won't be able to repeat the weekend, the Association hopes to sponsor another ceremonial admission in five years. ■

## NEWS FROM THE BOARD OF DIRECTORS

*by William H. Dippert*

The Board of Directors met on July 14, 1992. Reading of the minutes of the meeting of May 21, 1992 was waived. Upon motion by Mr. Mugford, seconded by Mr. Creel, the minutes were approved unanimously.

Mr. Barnaby presented the Treasurer's Report. Also, he commented that dues notices will be sent out in August and that letters will be sent to larger firms and corporations concerning "group billing." Approximately nine such firms and corporations have expressed interest thus far. Further, Mr. Barnaby reported on the Supreme Court Admission Program, which was well attended and well received.

Mr. Filardi and Mr. Goldberg reported on the Host Committee's efforts for scheduling activities in conjunction with the ABA Convention set for August, 1993. The activities are as follows:

1. A Spouses' Tour scheduled for the morning of Saturday, August 7;
2. An early evening reception scheduled for Saturday, August 7; and
3. An afternoon function scheduled for Sunday, August 8.

The Host Committee will coordinate with the ABA patent section concerning events (1) and (3). However, the Association will be entirely responsible for event

(2). The Museum of Modern Art, the New York Public Library, and the UN Delegates' Lounge were considered as locations for event (2). After a thorough investigation of each of these facilities, particularly with regard to cost, the Host Committee recommended the UN Delegates' Lounge.

There was discussion concerning solicitation of contributions and a charge for attendees. It was agreed that it would be desirable to seek contributions from law firms and corporations and to establish a nominal charge of \$10 or \$20 per attendee. Mr. Filardi was authorized to contact law firms and corporations for contributions and to establish a nominal charge for the attendees. He will furnish a proposed solicitation letter to the Board at the September Board meeting.

Peter Saxon, reporting for the CLE Weekend Committee, provided a listing of proposed topics and speakers. After discussion of hand-outs and the possibility of making a course book available, it was agreed that hand-outs should be encouraged. Mr. Razzano will be in charge of a golf tournament to be held in conjunction with CLE Weekend. Ms. Ryan will contact Paul Heller to see if he will be available to supervise a tennis tournament.

Ms. Ryan reported that Justice O'Connor will not be available to speak at the 1993 Judges Dinner. She indicated that she will write to Judge Meskill, who had been suggested by Judge Feinberg.

Mr. Razzano reported that Horizon submitted a new contract for the 1993 Judges Dinner. After discussion the Board authorized Mr. Razzano to sign the contract with Horizon unless he believes that the contract is not competitive.

Mr. Meller reported on a proposed program regarding harmonization, which program would be scheduled just prior to the 1993 Judges Dinner. He proposed a debate format with experts from each side.

Roger Smith asked Mr. Meller and Mr. Brunet to get more information concerning comparable programs and to report back in September. Mr. Creel suggested that they should consider other associations for co-sponsors.

Mr. Razzano reported that there was an issue concerning certain costs for the Inventor of the Year program. The Board agreed that the Association should absorb those costs. ■

## PENDING LEGISLATION

*by Edward P. Kelly*

### PATENTS

#### ITC Exclusion Orders

Section 337 of the Tariff Act of 1930 provides the ITC with authority to exclude imports that infringe domestic patents, trademarks and copyrights. Domestic companies favor the use of the ITC procedure because, in most cases, it represents a special remedy that offers faster relief than proceeding in the district court. The ITC must decide a case within one year. Section 337 also allows the ITC, in its discretion, to exclude a good or require the posting of a bond during the pendency of a proceeding. The ITC may do so if it has reason to believe that Section 337 is being violated. When temporary relief is sought, the ITC must make a ruling within ninety (90) days.

In January 1988, however, a dispute settlement panel established by the GATT Council held that certain procedures authorized by Section 337 violated GATT. While GATT recognizes that a country may permit special enforcement procedures necessary to enforce intellectual property rights against infringing imports, it requires that the procedures be no less favorable than those used against domestic products, or if less favorable, be necessary to secure compliance with GATT consistent regulations or procedures. The GATT panel found that Section 337 discriminated against foreign companies. In particular, the panel found that Section 337 caused imported products to be treated less favorably than domestic products in five specific respects:

1. A patent owner may choose either the ITC or a District Court where foreign goods are in issue, but only a District Court where domestic goods are involved.

2. A patent owner may choose both the ITC and a District Court where foreign goods are in issue, but only a District Court where domestic goods are involved.

3. The ITC can issue general exclusion orders as well as exclusion orders directed to specific respondents, but District Court orders can be directed only to defendants.

4. ITC proceedings are subject to statutory time limits, but District Court actions are not.

5. Counterclaims cannot be asserted in ITC proceedings, but can be in District Court actions.

The U.S. Trade Representative agreed to revise Section 337 and made several proposals that would have substantially altered the jurisdiction of the ITC. Those proposals recently gave way to a new plan that would establish a single process for patent disputes in the district court, but allow transfer to the ITC where imported goods are involved.

No proposal to conform Section 337 has yet been adopted—due in part to the ongoing GATT negotiations. Senator Jay Rockefeller (D-W.Va.) does not want to wait until the conclusion of the GATT talks to deal with Section 337. Senator Rockefeller recently introduced a bill that he believes would amend Section 337 to bring it into compliance with GATT. The bill (S.3172) would provide that Section 337 be amended in the following respects:

- A respondent would be permitted to assert counterclaims to an exclusion and cease and desist orders.

- An importer could bring an action for declaratory relief in the ITC.

- A defendant in a district court proceeding who is also a defendant in an ITC proceeding could obtain a stay of the district court proceeding upon request to the ITC.

- Instead of statutory time limits, the ITC would be required to make its determination at the earliest practical time.

- The bonding procedures of Section 337 would be conformed to the bonding procedures in the district court.

In introducing the bill, Senator Rockefeller asserted that these changes would conform Section 337 to GATT. The bill has been referred to the Senate Finance Committee.

### **Sanctions Against the Japanese Patent System**

The Senate has taken testimony in recent years from government and industry witnesses regarding discrimination by the Japanese patent system against foreign inventors. The Senate identified these alleged discriminating practices in 1988. The Senate found that Japan discriminated by imposing inordinate delays in examining and

granting patents, allowing pre-grant oppositions and allowing protracted litigation and appeals.

The Trade Act of 1984 contains provisions (the "Super 301" provisions) that allow the Trade Representative to identify foreign countries that deny adequate protection for intellectual property and fair and equitable access to U.S. persons that rely on intellectual property. These countries can have trade sanctions imposed against them. Senator Rockefeller recently introduced a bill (S.3190) that would amend the Special 301 provisions to include countries, like Japan, that effectively deny adequate and effective patent protection to U.S. nationals because of:

- (a) unreasonable delays in granting or enforcing patents;

- (b) pre-grant opposition to patent applications;

- (c) unnecessarily narrow interpretations of patent claims by the authorities which determine patent validity and

- (d) other policies and practices.

S. 3190 has been referred to the Senate Finance Committee.

### **COPYRIGHTS**

Digital Audio Tape (DAT) recorders are capable of recording the signals encoded in a compact disc. DAT copies made from the disc (or DAT copies of the disc) have the same quality as the original recording, regardless of whether they are the first or the thousandth generation. Some perceive DAT as an unprecedented opportunity for copyright infringement.

While the electronics industry looked forward to the distribution of DAT machines in the U.S., the U.S. recording industry feared and resisted the importation of DAT machines on the ground that unlimited and uncompensated copying would ruin their business. The recording industry's efforts to prevent the importation of DAT machines ultimately failed.

Technology is available, however, that can prevent unlimited digital copying. The technology is known as the Serial Copy Management System (SCMS). It allows first generation digital copies to be made from compact discs, pre-recorded DAT cassettes or digital broadcasts, while preventing further digital to digital copies. Legislation introduced last year in the House (H.R. 4096,

Waxman (D.-Ca.) and Senate (S. 2358, DeConcini (D.-Ariz.)) would have required that all DAT recorders sold in the U.S. be equipped with a SCMS. This would have allowed a home DAT owner to make first generation copies of a compact disc but would have prevented additional copying. The Electronics Industry Association and the Recording Industry Association of America supported that legislation because it prevented serial copying. The Senate never adopted the legislation, in part because certain members of the recording industry, such as the Songwriters Guild of America, would not support a bill that did not provide any type of royalty for the first copy made by a DAT machine.

Two years ago, Senator DeConcini requested that the various interested members of the electronics industry and the music industry work together to find a solution to the problem. The various industry members to this dispute subsequently reached an agreement on the sale of DAT machines in the U.S. The agreement would allow the sale of DAT machines equipped with SCMS, confirm that the private, non-commercial taping of both analog and digital material is permissible under the copyright law and provide a royalty on the sale of DAT machines. The royalty would be distributed among writers, music publishers, record artists and record companies by the Copyright Royalty Tribunal.

Bills have been pending in the House (H.R. 4567) and Senate (S. 1623) for the past year that would codify the agreement. The Senate recently passed The "Home Recording Act of 1991" (S. 1623) that would add a new Chapter 10 to the Copyright Statute. The bill provides for the assessment, collection and distribution of royalties to the recording industry. The bill also provides remedies for violations of the royalty and SCMS requirements. The remedies include statutory damages, actual damages and attorney's fees as well as injunctions and the destruction of violating products.

The bill has generally enjoyed support throughout the music industry. The Senate, however, has continued to fine tune the bill. For instance, the bill provides that a portion of the royalty will be split among writers and music publishers on a 50-50 basis, notwithstanding any conflicting contractual obligations. Senator DeConcini recently explained that the Senate bill has been amended so that



the provision overriding contractual agreements will not apply where such an override would be inconsistent with any subsequent international agreements the U.S. reaches in current trade negotiations. For instance, the U.S. is currently engaged in the Uruguay round of GATT negotiations. One of the objectives of GATT is to obtain binding international commitments to respect foreign contractual relationships in providing access to royalty pools and enforcing copyrights. The Senate bill also has been amended to exclude books and recordings of instructional materials. The exclusion does not apply to rap, gospel or other types of music that rely on spoken phrases.

The House bill is similar to S. 1623. The House bill has been sent to the House Judiciary and Ways and Means Committees.

### Criminal Penalties for Software Piracy

A bill (S.893) recently introduced by Senator Orin Hatch (R-Utah) would subject pirates of computer software to criminal penalties. A person counterfeiting at least 50 copies infringing the copyright in one or more software proposals would be subject to a fine of up to \$250,000 and/or imprisonment of up to 5 years. The distribution of more than 10, but less than 49, copies would provide a fine of up to \$25,000 and imprisonment of up to one year. The full Senate has already approved S. 893. The House recently held hearings on the bill. Video game manufacturers expressed strong support for the bill on the ground that it would be particularly effective against pirates that produce game cartridges containing over 100 infringing games. Representatives of the Computer and Communications Industry Association cautioned that the bill should not be interpreted to cover the activities of those who reverse engineer computer software.

### Tax Consequences of Business Acquisitions

The acquisition of an entire business usually involves the purchase of both tangible (buildings, inventory) and intangible (patents, copyrights, trademarks, goodwill) assets. For the buyer, the IRS currently provides an amortization deduction for acquired intangible assets if they have an identifiable value separate from goodwill and a

determinable useful life. Under current law, goodwill, and in most instances trademarks and tradenames, are not depreciable because they are deemed to have an indeterminable useful life. Trademarks which have no known useful life may be amortized over 10 years for costs up to \$100,000 and over 25 years for costs over \$100,000. Acquired patents and copyrights, however, are depreciable if they are assigned an identifiable value in the course of the transaction. Generally, the value of copyrights and patents cannot be amortized when they are acquired in a bulk transfer of business assets.

The buyer's primary incentive is to maximize the amount of the purchase price allocated to allowable depreciable intangible assets, thereby resulting in more depreciation deductions to reduce taxable income over the life of the assets. The nature of this tax treatment has led to disputes with the IRS over the type of intangible assets acquired as well as disputes over the amount of the purchase price attributable to particular intangible assets.

The House recently passed a bill (H.R. 11) that would alleviate these controversies by simplifying the amortization rules when a business is acquired. The bill would allow amortization of acquired intangible assets such as goodwill, trademarks and patents and copyrights acquired in a bulk transfer over a single 14-year period. The provisions of H.R. 11 had previously been contained in an overall tax package that President Bush vetoed. The Administration, however, currently supports H.R. 11.

## RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

### PATENTS—PROSECUTION HISTORY ESTOPPEL

In *Read Corp. v. Portec Inc.*, 23 USPQ 2d 1426 (Fed. Cir. 1992), the Court of Appeals for the Federal Circuit, in affirming the denial of a JNOV motion for infringement of

a utility patent, held that prosecution history estoppel does not limit the doctrine of equivalents where a limitation added was not the basis for allowance. However, the court reversed the denial of such a motion for a design patent.

Read Corp. owns a utility patent (4,197,194) and a design patent (263,836) for a portable screening apparatus for separating fine material from coarse material. Among the '194 limitations is a limitation regarding a set of wheels which are "movable relative to said frame" from "an operative position" to "an inoperative position for resting said frame flush on the sound." Read Corp. added the movable wheels limitation in order to overcome Patent Office rejection.

Portec Inc. became interested in producing a competing device and inquired about circumventing the '194 claims to avoid infringement. Eventually, Portec produced its own device. Read Corp. filed suit against Portec, claiming infringement of both the '194 and '836 patents.

A jury held that the patents were valid and Portec's device infringed both patents. The district court denied Portec's JNOV motion, awarding almost \$4 million in damages and more than \$51.2 million in attorney's fees. Portec appealed.

The Federal Circuit was persuaded that Portec's device, because it had fixed wheels and a footpad attached to each side instead of the retractable wheels, was sufficiently distinguished and as such did not literally infringe the '197 patent. However, the Federal Circuit did find literal infringement of a different limitation regarding the "short end" height of the apparatus.

The Federal Circuit also addressed and rejected Portec's assertion that Read Corp. was estopped from claiming infringement because Read had pointed out during '197's prosecution that some references did not have the movable wheels feature. The Federal Circuit held that:

Every statement made by a patentee during prosecution to distinguish a prior art reference does not create a *separate* estoppel. Arguments must be viewed in context. . . . In context, Read distinguished, for example the Deister reference because of a wealth of differences. [A]ny estoppel created by Portec's argument encompasses *all* of these *combined* distinctions of Deister and not an estoppel respecting *each* of the *individual* differences, e.g., that any device with none movable wheels cannot infringe. That feature in itself was not the basis for patentability over Deister.

*Id.* at 1433

Accordingly, the Federal Circuit affirmed the denial of the JNOV motion since all but one of the limitations of the asserted claims are met literally, and that one is met equivalently.

The Federal Circuit also reversed the JNOV motion with regards to the '836 design patent. The court stated that:

Infringement of the '836 patent, thus, depends upon:

(1) the similarity of the ornamental features of the Portec device and the patented design and (2) the likelihood that an ordinary person would be confused because of such ornamental similarity... Because Read failed to submit any evidence directed to either element of infringement, no substantial evidence supports the jury's finding that Portec infringed the '836 design patent.

*Id.* at 1434

Additionally, the Federal Circuit severed a finding of willful infringement and vacated the attorney's fee award. The case was remanded for modification of the injunction and reconsideration of the attorney's fees.

#### PATENTS—PRESUMPTION OF VALIDITY

In *New England Braiding Co., Inc. v. A.W. Chesterton Co.*, CAFC, No. 91-1080, (July 28, 1992), the Court of Appeals for the Federal Circuit, in affirming the district court's denial of preliminary relief, held that the presumption of validity under 35 U.S.C. §282 does not relieve a patentee who moves for a preliminary injunction from rebutting evidence of invalidity. The Court stressed that while a patentee does not have to prove validity, the patentee must show the alleged infringer's defense lacks substantial merit.

A.W. Chesterton Co. had been experimenting for several years with different types of compression packing. In 1989, they announced that it was producing braided packaging which would deform into a trapezoidal shape when laid flat.

However, a former Chesterton employee had secured two patents (U.S. Patent Nos. 4,550,639 and 4,729,227) related to braided packaging in a trapezoidal shape. The patents were assigned to Seal Company of New England, Inc., which granted an exclusive license to New England Braiding Co., Inc. (NEBCO). These companies jointly brought an infringement suit against Chesterton, and

also moved for a preliminary injunction.

The Trial Court denied the injunction motion, holding that NEBCO would likely not succeed on the merits of the case because the evidence indicated that a different Chesterton engineer had actually invented the braid claimed in the '639 and '227 patents. NEBCO appealed.

NEBCO argued that the district court failed to consider the statutory presumption of validity provided by 35 U.S.C. §282. The Federal Circuit rejected this argument, stating:

the presumption does not relieve a patentee who moves for a preliminary injunction from carrying the normal burden of demonstrating that it will likely succeed on all disputed liability issues at trial, even when the issue concerns the patent's validity. The district court cannot be held to have erred in deciding that the patentee failed to make a sufficient showing of likelihood of success required to support a preliminary injunction where the evidence presented in support of validity raises a substantial question...

While it is not the patentee's burden to prove validity, the patentee must show that the alleged infringers' defense lacks substantial merit.

The Federal Circuit agreed with the district court's conclusion that NEBCO was not likely to prevail over Chesterton's allegation that '639 and '227 were invalid under 35 U.S.C. §102(f). The Federal Circuit agreed with the trial court's credibility determination that it was unlikely that the former Chesterton employee was the actual inventor of the braided packaging, and therefore upheld the denial of the motion for preliminary injunction.

#### WILLFUL COPYRIGHT INFRINGEMENT

In *N.A.S. Import Corp. v. Chenson Enterprises Inc.*, 23 USPQ 2d 1387 (2d Cir. 1992) the Court of Appeals for the Second Circuit found that a reckless disregard of a copyright justified enhanced statutory damages for willful infringement under 17 U.S.C. §504(c)(2). The Court also pointed out that actual knowledge of infringement is unnecessary to prove willfulness.

Chenson Enterprises Inc. sold women's handbags with a buckle design identical to Alentino's copyrighted buckle design except for the embossing of the company names. The two parties were in close proximity to

each other. An infringement suit was filed after the use of cease and desist letters had failed and after Chenson acted contrary to the letter from his attorney to Alentino that his client would "not import or sell any more of the items."

On remand, the district court enjoined Chenson from using the handbag buckle and subsequently awarded damages without finding willful infringement. The Second Circuit reversed the non-willful infringement finding and vacated the statutory damages award.

The court noted that an infringement is willful, for enhanced statutory damages purposes, if the defendant had actual or constructive knowledge that its actions constituted infringement. *Id.* at 1388. However, the Second Circuit stated that "reckless disregard of the copyright holder's rights (rather than actual knowledge of infringement) suffices to warrant award of the enhanced damages." *Id.* at 1389.

Based on the facts that the buckles were identical, the stores were in close proximity to each other and the prevalence of knock-offs in the market, the court concluded that Chenson knowingly appropriated Alentino's buckle design or at least was aware of the infringement. In addition, the letter by Chenson's attorney to Alentino permits an inference that Chenson had constructive knowledge that its actions constituted copyright infringement.

The Second Circuit noted that it remains within the district court's discretion, in light of the willfulness finding, to decide whether to enhance damages. The fee award was vacated for recalculation based upon reconsideration of the damage award. ■

## ANNOUNCEMENTS

Anderson Kill Olick & Oshinsky, P.C. is pleased to announce the acquisition by its Intellectual Property and Technology Law group of David Toren and the law firm of Toren, McGeady & Associates. Anderson Kill will continue to provide legal services concerning all aspects of intellectual property and technology law, including patents, trademarks, copyrights, mask works, trade secrets, trade dress, unfair competition and product counterfeiting. David Toren, Klaus Stoffel and Friedrich Kueffner will be joining currently existing members of Anderson Kill's Intellectual Property Group including David A. Einhorn, Shahan Islam and Raj Mehra. Offices are located at 666 Third Avenue, New York, New York 10017. Telephone (212) 850-0700.

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