



THE NEW YORK INTELLECTUAL PROPERTY
LAW ASSOCIATION

BULLETIN

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Number 3

PRESIDENT'S CORNER

A lot is going on in the Association. Here are some of the highlights.

Judges Dinner. Our Annual Dinner in Honor of the Federal Judiciary is set for Friday, March 25th. We are delighted to have Chief Judge Nies return as our speaker.

ADR. The Judges Dinner will be immediately preceded by a symposium we are co-hosting at Fordham University School of Law on March 25th. The program, entitled "Alternative Dispute Resolution of Intellectual Property Matters — Here and Now," has been put together by our ADR Committee.

In addition to planning what looks like a great program (thanks, primarily, to the energy of its Chair, Charlie Baker), the ADR Committee has also submitted extensive comments to WIPO on their draft arbitration and mediation rules.

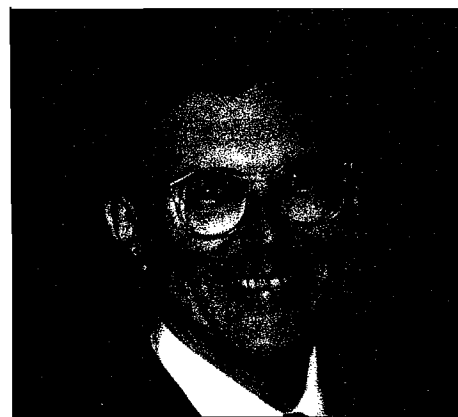
PTO Comments. As noted in the last issue of our *Bulletin*, our Harmonization Committee drafted, and we have submitted, detailed comments to Commissioner Lehman on patent law harmonization. I believe that the PTO found these helpful. So I have now asked our Copyright and Patent Law Committees to draft comments on software-related inventions — comments we plan to submit on March 30th.

NYIPLA Annual. Greg Battersby, the dedicated Chair of our Publications Committee, has done it again. Because of his leadership, and the noteworthy contributions of a host of authors, next month we will be introducing what I hope will be the first of a long series of yearly publications, our *Intellectual Property Annual*.

Madrid Protocol. Our Foreign Trade-Mark Committee will be co-sponsoring a lively program on the Madrid Protocol at

Fordham University School of Law on Friday, April 8th. This will be part of a two-day (April 7-8) program Fordham is hosting on foreign intellectual property issues. In addition to distinguished speakers on the international experience and the PTO view, Al Robin and Virginia Richard will debate the pros and cons of the Protocol for U.S. applicants.

Luncheon Speakers. Our very successful series of luncheon speakers is continuing at full speed. Thanks to Marilyn Matthes Brogan, the able Chair of our Committee on Meetings and Forums, we have already had four such luncheons and plan to have four more. The next is scheduled for February 18th, where we will hear from Mr. Quinn, a senior member of the PTO Trademark Trial and Appeal Board.



I hope that you are all surviving the cold weather — and I look forward to seeing you at one of these outstanding programs.

—William J. Gilbreth

CALENDAR OF EVENTS

March 18, 1994	NYIPLA Luncheon Meeting, Cornell Club, New York City
March 25, 1994	CLE Program "Alternative Dispute Resolution of Intellectual Property Matters — Here and Now" co-sponsored by the NYIPLA and Fordham University School of Law, Fordham Law School, New York City
March 25, 1994	NYIPLA Annual Dinner in Honor of the Federal Judiciary, Waldorf-Astoria Hotel, New York City
April 7-8, 1994	ABA-PTC Section, Spring CLE Program, Stouffers Concourse Hotel, Arlington, Virginia
April 8, 1994	NYIPLA Foreign Trademark Law and Practice Committee Program on the Madrid Protocol, Fordham Law School, New York City

NYIPLA AND FORDHAM CO-SPONSOR CLE PROGRAM ON ADR

The New York Intellectual Property Law Association and Fordham University School of Law will co-sponsor a Continuing Legal Education program entitled "Alternative Dispute Resolution of Intellectual Property Matters — Here and Now" in the splendid McNally Amphitheater of Fordham Law School. The program will take place on March 25, 1994 and will feature Judge Marvin E. Frankel, former United States District Court Judge of the Southern District of New York, as well as an outstanding group of experienced attorneys and legal scholars.

Registration and a continental breakfast will start at 8:30 a.m. The morning program will then commence at 9:00 a.m. and will run until approximately 12:30 p.m. A luncheon in the Law School's attractive interior atrium will follow. The afternoon session will run until 3:30 p.m. to permit attendance at the Association's Annual Judges' Dinner that evening. Guests and members from out of town will be able to combine this CLE program and the Judges' Dinner on a single trip to the City.

The morning session will begin with "An Overview of Arbitration — The Case History of a Complicated Patent/Antitrust Multi-Party Dispute" by people who were actually involved in an arbitration proceeding. Charles E. Koob of Simpson, Thacher & Bartlett, who represented one of the parties in the arbitration, will discuss the agreement to arbitrate. Stephen D. Houck, now a Vice President of the Center for Public Resources and then counsel to another party, will follow with a discussion of the selection of arbitrators. One of the arbitrators, Judge Marvin E. Frankel of Kramer, Levin, Naftalis, Nessen, Kamin & Frankel, will continue with a presentation about the arbitration hearing itself. Professor Jacqueline M. Nolan-Haley of the Fordham Law School will conclude the overview with a discussion of other ADR processes that might have been used.

The next segment of the morning session, in a point and counterpoint format, will compare administered versus non-administered arbitration. The participants will be Michael F. Hoellering, Vice President and General Counsel of the American Arbitration Association, and Peter H. Kaskell, a Vice President of the Center for Public Resources.

The final segment of the morning session will be a panel discussion of intellectual property arbitration experiences and how to avoid pitfalls therein. Moderated by Steven P. Berman of Johnson & Johnson, the panel members will be Norman L. Balmer of Union Carbide, Russell C. Deyo of Johnson & Johnson, and Philip S. Johnson of Woodcock, Washburn, Kurtz, Mackiewicz & Norris.

The afternoon program will consist of two presentations. Tom Arnold of Arnold, White and Durkee will discuss mediation, and Edward E. Vassallo of Fitzpatrick, Cella, Harper & Scinto will conclude the day with a talk on special considerations in international ADR procedures.

An announcement and reservation form for the program is included with this *Bulletin*. The very reasonable fee includes the continental breakfast and luncheon, as well as the hand out materials. ■

NYIPLA TO SPONSOR PROGRAM ON THE MADRID PROTOCOL

The Committee on Foreign Trademark Law and Practice, chaired by John Olsen, has prepared a program on the Madrid Protocol. The program will be presented on Friday morning, April 8, 1994 as part of a two-day intellectual property forum at Fordham Law School. Full details on the forum and registration information are contained in the insert in this issue of the *Bulletin*. ■

NEWS FROM THE BOARD OF DIRECTORS

by William H. Dippert

The Board of Directors met October 21, 1993. William Gilbreth presided.

Mr. Dippert provided the Treasurer's Report prepared by Howard Barnaby. Upon motion the Treasurer's Report was accepted.

Mr. Gilbreth asked whether any progress had been made with regard to scheduling a golf tournament. Mr. Razzano reported that Gregory Battersby is looking into it.

There was discussion concerning the selection of a speaker for the 1994 Judges Dinner. Mr. Goldstein suggested that we should concentrate on non-judicial speakers, which have proven to be of more interest to the audiences. Mr. Creel suggested that since it is a dinner in honor of the judiciary, we should still think of a judicial speaker. Mr. Murnane suggested that in addition to having a speaker, the Association should also consider presenting an award, for example, a "President's Medal," each year. This was followed by further discussion of the possibility of presenting an award for intellectual property jurisprudence.

Mr. Creel reported on the ADR program being considered in conjunction with the Judges Dinner, for which program the ADR Committee has put together a proposed outline. There was discussion of the date, that is, March 24 or 25, the program content, suggested speakers as well as co-sponsorship with Fordham Law School. The Board recommended that the program be planned for March 24 or 25, 1994, preferably March 25, with Fordham Law School as a co-sponsor.

Mr. Gilbreth reported for Mr. Barnaby regarding the Madrid Protocol. The Foreign Trademark Committee has proposed a two-day program devoted to discussion of the Madrid Protocol. Mr. Barnaby contacted Fordham Law School, which is having a foreign intellectual property program in April, 1994. Fordham Law School offered the Foreign Trademark Committee afternoon for a presentation concerning the Madrid Protocol.

Mr. Goldstein led discussion concerning the Annual Dinner. He commented that although the dean of a local law school was asked last year, he questioned whether the speaker must be limited to the deans of local law schools. Mr. Creel stated that he had initiated the idea of "rotating" the deans of local law schools last year but that this concept was not fixed.

Mr. Gilbreth suggested that we consider inviting intellectual property law professors from local law schools and some of their students. He recommended that Mr. Goldstein submit a proposal to the Board at a future meeting.

There was extensive discussion concerning Harmonization and whether the

Association should, or can, take a position on Harmonization. Mr. Gilbreth commented that comments in a recent *BNA Patent, Trademark and Copyright Journal* reflect the lack of a consensus among the patent bar. He suggested that the Commissioner is trying to find the aspects of Harmonization for which there is support.

There was also extensive discussion concerning a letter prepared by David Weild and his Committee on Harmonization, which letter is to be submitted to the Commissioner. Mr. Gilbreth commented that he liked the letter in general but felt that the Association should not take a specific position. In response, Mr. Weild explained that he had reviewed past Association materials

to determine prior positions taken by the Association and that the letter essentially repeated those prior positions. Mr. Brunet questioned how long positions should last and suggested that the Association be polled on Harmonization.

There was additional discussion concerning first-to-invent versus first-to-file. At the end of the discussion, Mr. Gilbreth appointed a committee consisting of Mr. Brunet, Mr. Goldstein, Mr. Razzano, Mr. Weild, and other interested parties to review the proposed letter and to suggest changes prior to submission to the Commissioner. ■

Announcing the

**WILLIAM C. CONNOR INTELLECTUAL PROPERTY
WRITING COMPETITION FOR 1994**

sponsored by

THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

Awards to be presented in May 1994 at the Grand Hyatt Hotel,
New York New York
at the NYIPLA Annual Meeting/Dinner

The Winner will receive a cash award of \$1,000.

The Runner-up will receive a cash award of \$500.

The competition is open to students currently enrolled in a full time (day or night) J.D. program. The subject matter must be directed to one of the traditional subject areas of intellectual property, i.e., patents, trademarks, copyrights, trade secrets, unfair trade, and antitrust. Entries must be submitted by April 3, 1994 to the address given below.

For a copy of the rules of the competition, call or write to:

Thomas H. Beck, Esq.
Fitzpatrick, Cella, Harper & Scinto
277 Park Avenue
New York, New York 10172
(212) 758-2400

REMINDER: 1994 INVENTOR OF THE YEAR AWARD

Nominations for the 1994 NYIPLA Inventor of the Year Award are due no later than **March 18, 1994**. The Committee on Public Information and Education encourages all members to nominate for the Award one or more inventors who have received patents on inventions that have benefited the patent system and society. If you need nomination forms or additional information, please contact Thomas H. Beck, Esq., Fitzpatrick, Cella, Harper & Scinto, 277 Park Avenue, New York, New York 10172, (212) 758-2400. ■

PENDING LEGISLATION

by Edward P. Kelly

NAFTA AMENDMENTS

The President recently signed into law a bill that amends certain U.S. intellectual property laws to comply with the recently signed North American Free Trade Agreement (NAFTA). The provisions of the bill affect patent, trademark and copyright law.

Under prior patent law (Section 104), an inventor could not establish a date of invention by reference to knowledge or use of the invention in a foreign country except as provided in Section 119 of the patent law. Section 119 of the patent law provides for establishing a filing date based upon a previous application filed in a Paris Convention country. Section 104 has now been amended so that an inventor can establish a date of invention by reference to knowledge or use not only in the United States but also in a NAFTA country.

The trademark law previously denied registration to a mark that was primarily

geographically descriptive or misdescriptive. The applicant, however, could attempt to demonstrate that the mark had become distinctive of the applicant's goods. Section 1052(d) has now been amended to reflect the fact that after the effective date of NAFTA, such proof will no longer be accepted with respect to such geographic marks. Such marks, however, would be registrable upon the supplemental register.

The new law also provides for the restoration of copyright protection in certain motion pictures authored by Mexican and Canadian authors which previously entered the public domain due to publication without the requisite copyright notice.

GOVERNMENT-SPONSORED RESEARCH

We previously reported bills pending in the House and Senate which would encourage inventions made with government funds to be transferred to private industry for commercialization. (See NYIPLA Vol. 34, No. 2) A bill previously introduced by Senator Jay Rockefeller (S.1537) would direct federal laboratories to transfer, for reasonable consideration, ownership in intellectual property to a private research partner. The government would retain "march in" rights in the event that the assignee did not commercialize the technology.

A new bill recently introduced by Paul Kanjorski (D.PA) would set up a corporation to facilitate the transfer of patents and technologies to the private industry. (H.R. 3350) The corporation would have authority to make loans to private industry to commercialize federal technology. The bill contains provisions similar to the Rockefeller bill in that it would retain rights in the federal agencies in the event that the technology was not commercialized.

H.R. 3350 has been referred to the Committee on Banking, Finance and Urban Affairs.

COPYRIGHTS

Elimination of Copyright Registration Requirement

We previously reported a bill (H.R. 897) that would eliminate the registration requirement for copyrighted works as a condition to commencing a lawsuit and

obtaining certain remedies. (See NYIPLA Vol. 34 No. 2.) The bills would repeal Section 412 of the Copyright Act which requires registration to recover statutory damages and attorneys' fees. The bill has now received full approval by the House. Its counterpart bill (S. 373) is still pending in the Senate. At one time the House bill contained provisions that would reverse case law holding that security interests in copyright are perfected only by filing in the Copyright Office rather than filing in particular states pursuant to that state's UCC law. (See *National Peregrine Inc. v. Capitol Federal Savings and Loan*, 116 BR 194 (Cal. 1990). Those provisions are no longer contained in H.R. 897.

Elimination of Copyright Royalty Tribunal

The President recently signed into law a bill that eliminated the Copyright Royalty Tribunal. This Tribunal previously sat to administer the compulsory licensing provisions of the Copyright Act. The work of the tribunal will now be handled by copyright arbitration panels selected by the Librarian of Congress. These arbitrators will set royalty rates pursuant to the compulsory license provisions of the Copyright Act. ■

LENTEN DISPENSATION FOR JUDGES DINNER

The following is the text from a letter to Thomas L. Creel, Chairman of the Judges Dinner Committee, from Reverend Leslie J. Ivers, Vice Chancellor, Chancery Office, Archdiocese of New York, regarding the NYIPLA Judges Dinner on March 25:

Dear Mr. Creel:

We are happy to grant a dispensation from the Lenten regulation of Friday abstinence from meat for those Catholics attending the New York Intellectual Property

AN OPEN LETTER TO ASSOCIATION MEMBERS

1994 INVENTOR OF THE YEAR

The presentation of the Inventor of the Year Award affords the Association an excellent opportunity to extend recognition to an individual who, because of his or her inventive talents, has made worthwhile contributions to society. The person selected should have received patents for his or her invention(s), and by such invention(s), benefited the patent system and society.

This year, the award will be presented at the Association's annual meeting and dinner to be held in May 1994 in New York City.

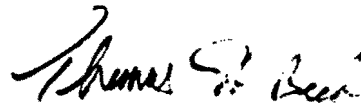
I encourage each practitioner, each firm, and each corporate counsel to nominate one or more candidates for consideration. This program cannot be successful without the participation of the Association members in solo, firm, and corporate practice.

The Inventor of the Year Award enables our Association to extend recognition to a deserving individual and provides good publicity for the Association, the patent system generally, and the practice of intellectual property law.

A nomination form for submitting recommended candidates is attached. Additional copies may be obtained by contacting the undersigned. Please forward your nominations no later than March 18, 1994.

Thank you.

Cordially,



Thomas H. Beck
Chairman, Committee on Public
Information and Education
(212) 758-2400

NOMINATION FORM FOR INVENTOR OF THE YEAR - 1994

Instructions: You may nominate as many individuals as you wish. Please provide one form for each nominee (joint nominations are acceptable). Please submit three (3) copies of all papers, including this form, that you wish to be considered by the Awards Panel. An acceptable nominee must: have one or more issued patents; have no restrictions that will prevent him or her from being able to attend the awards presentation at the NYIPLA annual meeting and dinner in May 1994; must be favorably disposed to the patent system; and must be respected by his or her professional peers. The award is made in recognition of an inventor's lifetime contributions.

1. Nominee: _____
Address: _____
Tel. No.: _____
 2. Identify invention(s) forming the basis of the Nomination:

 3. List, by number and inventor, the United States Patent(s) with respect to the above invention(s): _____

 4. Set forth any known litigation, interference, or other proceeding that involves or has involved the foregoing inventions or patents, and the result: _____

 5. Nominator: _____
Address: _____
Tel. No.: _____
- Signature: _____ Date: _____

Please set forth on an attached separate sheet, a typed, single spaced statement, suitable for reproduction, that embodies the significance of the nominee's contributions which form the basis of this Nomination.

Please add any additional information you believe the Award's Panel will find helpful (three copies each). Material submitted will not be returned. Please forward the Nomination by March 18, 1994, to Thomas H. Beck, Fitzpatrick, Cella, Harper & Scinto, 277 Park Avenue, New York, New York 10172. Telephone number (212) 758-2400.

Law Association's dinner on March 25th.

If you feel it necessary to mention something in any program you might be printing for the occasion, I suggest the following:

"There is a serious obligation for Catholics to observe the Lenten practice of abstinence from meat on Friday in a substantial way. Individual conscience should decide proper cause to excuse oneself from this obligation."

With every good wish, I am

Sincerely,

Reverend Leslie J. Ivers
Vice Chancellor

THE TENTH ANNUAL JOINT SEMINAR PROGRAM

The Tenth Annual Joint Seminar Program of the Connecticut Patent Law Association, Philadelphia Patent Law Association, New Jersey Intellectual Property Law Association (Host Association) and New York Intellectual Property Law Association will take place at the Grand Hyatt Hotel in New York City on Tuesday, April 26, 1994. A copy of the announcement for this program is included on page 7 of this *Bulletin*.

The Joint Seminar Program has proven to be an extremely popular program over the years. The topics discussed are carefully selected to include the most current developments in, as well as practical suggestions for, the practice of intellectual property law.

The format of the Joint Seminar is unique. There are approximately 30 renowned speakers during the all-day program. Each speaker will give a ten minute oral presentation, so that a wide range of topics can be covered. Written materials,

however, provide further detail to the oral presentations.

The Joint Seminar Program is divided into five main topics — (1) Foreign and International Law, (2) U.S. Patent and Trademark Office Practice, (3) Biotechnology and Pharmaceuticals, (4) Litigation and (5) Licensing and Unfair Competition.

Last year's Joint Seminar Program was held at the Grand Hyatt and proved to be a huge success. Approximately 200 persons were in attendance.

Seating is limited and, therefore, those who wish to attend should complete the registration form promptly.

RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

PATENTS

The Court of Appeals for the Federal Circuit has held that a patentee may recover damages for infringement from the time of constructive notice by shipping properly marked products, even if the patentee does not mark his product immediately after the patent issues. *American Medical Systems, Inc. v. Medical Engineering Corp.*, (Fed. Cir. Nos. 92-1538 and 92-1555 Oct. 4, 1993).

In 1987, American Medical Systems (AMS) sued Medical Engineering Corp. (MEC) for willful infringement of U.S. Patent No. 4,957,765 on an apparatus and method for packaging a fluid containing penile prosthesis in a pre-filled, sterile state. The district court found that the '765 patent was not invalid and found MEC's infringement to be willful. However, the district court determined that AMS was only entitled to damages from the date it gave MEC actual notice of infringement by filing the lawsuit. AMS appealed the decision to limit recoverable damages.

The Federal Circuit, however, held that AMS was entitled to damages from the date it began shipping marked products and was not limited to the date the lawsuit was filed. The Federal Circuit interpreted 35 U.S.C. §287(a) as not setting forth any time limit by which the patentee must mark. The Federal Circuit explained:

The plain language of section 287(a) does not provide any time limit by which marking must begin, nor does the legislative history indicate any such limitation. Congress structured the statute so as to tie failure to mark with disability to collect damages, not failure to mark at the time of issuance with disability to collect damages. Further, allowing recovery of damages from the point of full compliance with the marking statute furthers the policy of encouraging marking to provide notice to the public *** To prevent recovery of damages for failure to immediately mark, however, provides no incentive for a patentee who inadvertently or unavoidably fails to mark initially to mark in the future.

In light of the permissive wording of the present statute, and the policy of encouraging notice by marking, we construe section 287(a) to preclude recovery of damages only for infringement for any time prior to compliance with the marking or actual notice requirements of the statute. Therefore, a delay between issuance of the patent and compliance with the marking provisions of section 287(a) will not prevent recovery of damages after the date that marking has begun. We caution, however, that once marking has begun, it must be substantially consistent and continuous in order for the party to avail itself of the constructive notice provisions of the statute.

The Federal Circuit acknowledged that 35 U.S.C. §287 does not apply to method claims because of the non-existence of anything to mark claims. They also agreed with the district court following *Devices for Medicine, Inc. v. Boehl*, 822 F.2d 1062 (Fed. Cir. 1987) which requires marking to recover damages if both product and method claims are asserted to be infringed. The court stated:

Where the patent contains both apparatus and method claims, however, to the extent that there is a tangible item to mark by which notice of the asserted method claims can be given, a party is obliged to do so if it intends to avail itself of the constructive notice provisions of section 287(a).

In this case, both apparatus and method claims of the '765 patent were asserted and there was a physical device produced by the claimed method that was capable of being marked. Therefore, we conclude that AMS was required to mark its product pursuant to section 287(a) in order to recover damages under its

method claims prior to actual or constructive notice being given to MEC.

PATENTS

"On Sale" Bar

The U.S. District Court for the Eastern District of Michigan in *TRW Financial Systems, Inc. v. Unisys Corp.*, DC EMich. No. 90-CV-71252-DT, October 19, 1993, held that a reduction to practice of an invention is not an absolute requirement to activate the 35 U.S.C. §102(b) "on-sale" bar, however, a mere "concept" existing at the time of the sale or offer of sale will not trigger the "on-sale" bar.

Teknekron, Inc., the predecessor-in-interest of plaintiff TRW Financial Systems, was hired as a consultant by Crocker National Bank. On August 1, 1974 Teknekron recommended that Crocker retain Teknekron to design and install an automated video-enhanced system to update the bank's system for handling customer payments mailed to a central location. The contract was signed on December 19, 1974 and the system was delivered on May 20, 1976. However, in April 1975 Teknekron approached other banks inquiring about the purchase of the same system and on January 19, 1976 made a firm offer for sale of the system. The patent for the analog portion of the system was filed on March 21, 1977 and a continuation-in-part covering both the analog and digital systems was filed on July 3, 1978. TRW subsequently filed a suit alleging infringement by Unisys. Unisys claimed the patent was invalid under 35 U.S.C. §102(b) since the invention was on-sale more than one year prior to filing of the patent application.

The District Court applied the decision in *UMC Electronics Co. v. U.S.*, 816 F.2d 647 (Fed. Cir. 1987) where the Federal Circuit held that reduction to practice of an invention was not an absolute requirement to activate the on-sale bar, however, a mere "concept" in existence at the time of the sale or offer would not trigger the bar.

Applying the *UMC Electronics* rationale, the district court determined that Teknekron did not have a sufficiently developed product as of December 1974 to trigger the on-sale bar, even though the August 1974 proposal contained all of the major component parts with technical drawings showing the feasibility of the system. This

offer was considered a mere "concept" and not an actual development of the final system. However, the January 19, 1976 offer involved more than a mere "concept," it involved a system that was sufficiently developed to take the invention out of the "concept" sphere and place it within the "tangible developed product" sphere. Since the patent application was filed on March 21, 1977, more than fourteen months after the January 19, 1976 offer, the patent was held invalid under the 35 U.S.C. §102(b) bar.

Foreign Patent Claims

The Court of Appeals for the Federal Circuit in *In re Kathawala* Fed. Cir. No. 93-1129, November 9, 1993 has held that an invention patented in a foreign country includes all disclosed aspects of the invention for 35 U.S.C. §102(d) purposes, regardless of whether or not the foreign patent claims less than all of the aspects of the invention.

On November 22, 1982, Kathawala filed a U.S. patent application relating to a group of compounds that inhibit a key enzyme in the biosynthesis of cholesterol. Subsequently, Kathawala filed counterpart applications in Greece and Spain on November 21, 1983; however, claims were also added for certain ester derivatives of the originally claimed compounds. The Greek patent issued on October 2, 1984 and the Spanish patent issued on January 21, 1985.

On April 11, 1985, Kathawala filed a continuation-in-part application in the U.S., this application added claims directed to the esters. The U.S. application was rejected under 35 U.S.C. §102(d) since the U.S. application was filed more than one year after the filing dates of the Greek and Spanish applications, both of which issued prior to the U.S. filing date.

The Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences rejecting the U.S. application. The Federal Circuit based their decision on an interpretation of 35 U.S.C. §102(d) which prevents the issuance of a patent when: "the invention was first patented *** by the applicant *** in a foreign country prior to the date of the application for patent in this country on an application for patent *** filed more than 12 months before the filing of the application in the United States."

The Federal Circuit disagreed with Kathawala's argument that the invention was not first patented in Greece for §102(d) purposes since claims are invalid under Greek patent law when directed to non-statutory subject matter. The Federal Circuit stated:

Even assuming that Kathawala's compound, composition, and method of use claims are not enforceable in Greece, a matter on which we will not speculate, the controlling fact for purposes of Section 102(d) is that the Greek patent issued containing claims directed to the same invention as that of the U.S. application. When a foreign patent issues with claims directed to the same invention as the U.S. application, the invention is 'patented' within the meaning of Section 102(d); validity of the foreign claims is irrelevant to the Section 102(d) inquiry. This is true irrespective of whether the applicant asserts that the claims in the foreign patent are invalid on grounds of non-statutory subject matter or more conventional patentability reasons such as prior art or inadequate disclosure.

Kathawala does not dispute that the Greek patent issued containing claims directed to the same invention as that of his U.S. application. Kathawala sought and obtained the claims contained in the Greek patent and cannot now avoid the Section 102(d) bar by arguing that that which he chose to patent abroad should not have been allowed by the foreign patent office. Acceptance of such a position, as the Board stated, would place an 'unrealistic burden' on the courts and PTO to resolve 'esoteric legal questions which may arise under the patent laws of numerous foreign countries[.]' *** The PTO should be able to accept at face value the grant of the Greek patent claiming subject matter corresponding to that claimed in a U.S. application, without engaging in an extensive exploration of fine points of foreign law. The claims appear in the Greek patent because the applicant put them there. He cannot claim exemption from the consequences of his own actions. The Board thus correctly concluded that the validity of the Greek claims is irrelevant for purposes of Section 102(d). Accordingly, the Board properly affirmed the examiner's rejection of the Greek patent.

The Federal Circuit also reiterated the point that for 102(d) purposes, the effective date of a foreign patent is the date on which it becomes publicly available and not necessarily on the date it issues. *See In re Monks*, 588 F.2d 308 (CCPA 1978). Thus the Federal Circuit concluded that the invention was patented in Spain prior to the U.S. filing date.

Announcing
THE TENTH ANNUAL JOINT SEMINAR PROGRAM
PATENT PRACTICE UPDATE

Due to the continuing popularity of their Seminars on Updates of Patent Practice, The Connecticut Patent Law Association, The New Jersey Intellectual Property Law Association, The New York Intellectual Property Law Association and The Philadelphia Patent Law Association are pleased again to present a one-day program featuring five panels of experts discussing recent developments in the law which all patent practitioners will need to know. Our panels of experts will discuss recent developments in U.S. Patent Office Practice, Patent Litigation, Pharmaceutical and Biotechnology Developments, Foreign and International Practice, and Licensing and Unfair Competition. A valuable reference text is included in the registration fee.

Sponsored By:

**New Jersey Intellectual Property Law Association
(Host Association)
Connecticut Patent Law Association
New York Intellectual Property Law Association
Philadelphia Patent Law Association**

April 26, 1994

Grand Hyatt Hotel
Grand Central Station
42nd Street and Park Avenue

9:15 a.m. to 5:00 p.m.

\$125 Registration Fee

(This fee includes a Luncheon, Bus Transportation to Penn Station and all Seminar Materials)
(A \$15 late registration fee will be added to the price of admission if you register at the door)

RESERVATION FORM

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Enclosed is a check for \$_____ payable to the NJIPLA for _____ attendees at \$125.00 each.

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Small intellectual property firm, Empire State Building, 350 Fifth Avenue, New York, has one window office for rent (approx. 9 x 13) in new suite facing north and west, federal library, conference room, receptionist. Contact Robert Stoll or Joe Previto, 736-0290.

Nilsson, Wurst & Green, a progressive intellectual property law firm with major U.S. and foreign corporate clientele, invites exceptional patent attorneys to join its growing practice. Successful candidates will have a degree in electrical engineering, physics or a related technical field and substantial experience in patent prosecution and/or litigation. Compensation and benefits will be at the higher competitive levels. Interested candidates should send their resumes and writing samples to Robert A. Green, 707 Wilshire Blvd., 32nd Floor, Los Angeles, CA 90017. All submissions will be kept in the strictest confidence.

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