



# THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

# BULLETIN

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Number 3

## PRESIDENT'S CORNER

Over the past Holiday Season the work of the Association has continued without respite!

The Patent and Trademark Office requested our assistance to conduct a seminar in New York on changes in practices before the PTO resulting from the GATT Treaty and the change to a 20-year patent term. Through the efforts of our Meetings Committee Chairperson, Marilyn Brogan, and our CLE Chairman, Ed Vassallo, arrangements were made with Fordham University Law School to conduct the seminar in its auditorium. The event was an outstanding success, with almost 300 attendees. The speaker, Charles Van Horn, provided us with a detailed informational package for our members. If anyone wishes to obtain that material, please send a check for \$25.00 to Erica Rayburn, c/o Fitzpatrick, Cella, Harper & Scinto, 277 Park Avenue, New York, NY 10172. A copy will be made and mailed to you. We also hope to have a videotape of the conference available at a later date.

As you may know, the PTO has also asked for written comments on the proposed publication of patent applications after 18 months pendency. A number of our Committees are working on comments for submission by the Association. If you have any suggestions you would like the Board to consider for submission, please let me know.

Our Admissions Committee is working on a number of proposals for increasing the membership of our Association. In the meantime, I ask that all members make an effort to urge attorneys on their corporate staffs and in their law firms who have not joined the Association to do so. In addition to reduced costs for Association events, membership in the Association offers edu-

cational and networking opportunities, the *Greenbook*, and now the *Annual* (The Blue Book).

For the past several years, the Board has been trying to develop a history of the Association. We are asking former Presidents and Secretaries of the Association for pertinent records they may have which we will review and store in a centralized location. If any other members have records or even stories about the Association which you feel would be useful for our efforts in preparing this history, please send them to me.

Finally, please note on your calendar March 24th as the date for our Annual Dinner In Honor of the Federal Judiciary. Our guest speaker will be Marlin Fitzwater,



former Press Secretary to Presidents Reagan and Bush.

Best Wishes to all for the New Year!

— Pasquale A. Razzano

## CALENDAR OF EVENTS

March 1-2, 1995

INTA Forum "Trademarks Beyond the Lanham Act," Marriott Marquis, New York City

March 24, 1995

NYIPLA Annual Dinner in Honor of the Federal Judiciary, Waldorf-Astoria, New York City

April 6-7, 1995

ABA-IPL Section, Spring CLE Program, Hyatt, Crystal City, Arlington, Virginia

April 14-15, 1995

"Trademarks, Copyrights, and Unfair Competition For the General Practitioner" Sponsored by American Law Institute-American Bar Association, Stouffer Concourse Hotel, Washington, DC

April 18-21, 1995

American Intellectual Property Law Association, Spring Stated Meeting, Seattle Four Seasons, Seattle, Washington

April 20-12, 1995

"International Intellectual Property Law and Policy," sponsored by Fordham University School of Law, McNally Amphitheater, New York City

# THOUGHTS ON PRACTICING BEFORE THE CAFC— AN INTERVIEW WITH JUDGE HELEN W. NIES

by Marylee Jenkins

THE HONORABLE HELEN W. NIES  
CIRCUIT JUDGE, FEDERAL  
CIRCUIT



**Appointed:** 1980

**Born:** August 25, 1925; Birmingham, Alabama

**Education:** University of Michigan, B.A., 1946, Phi Beta Kappa; J.D., 1948 Order of the Coif

**Government Positions:** Attorney, Department of Justice, Washington, D.C., 1948-51; Branch Counsel, Office of Price Stabilization, 1951-52 (Homemaker, 1952-60).

**Private Practice:** Associate, Pattishall, McAuliffe & Hofstetter, Chicago, Washington, D.C., 1960-66, resident partner 1966-78; partner, Howrey & Simon, Washington, D.C., 1978-80.

**Previous Judicial Positions:** United States Court of Customs and Patent Appeals 1980-82; Chief Judge, United States Court of Appeals, Federal Circuit, 1990-94.

**MLJ:** *What suggestions or comments do you have concerning appellate practice, practically briefs and oral argument?*

**Judge Nies:** Keep in mind that the court is looking for your help. A judge may not be experienced in one or more of these fields

of law over which we have jurisdiction. It is a help to the court to have a lawyer who is an expert in the field to answer questions, so that the judge has a better understanding of the ramifications of a decision.

First with respect to briefs, the Appellant's brief typically begins with a statement of facts in the most favorable light for their side of the case, like a post trial brief. I call it their "wish list." It's what they wish they had proved. The statement of facts at the appellate level is what the court below said were the facts. If an appellant focuses on what the judge said, rather than trying to retry the case at the appellate level, that would be much more effective. When you present as a fact something that the judge found to the contrary, it appears that you are trying to mislead the court and nothing is less effective. If you believed it should have been found as the fact, present it as an issue. You need to focus on what the trial judge did. Your opponent is the trial judge. The trial judge has spent a great deal of time on the case, usually longer than I will, although not necessarily. I begin with respect for his or her effort.

It is almost always true that some mistake has been made in the trial. The trial judge is on the spot and has to make rulings quickly. It's simply not enough to point to an error that was made by the judge. You have to show that the error likely affected the outcome of the case. A harmless error under the Federal Rules must be ignored. Nitpicking to find errors won't do the job on appeal.

With respect to oral argument, oral argument goes well if you engage in a dialogue with the judges. The judges have certain questions they need to have resolved. It may be in your favor or against you — you really can't tell from the question itself. The judges' questions show where they have problems and give you an opportunity to answer them. You should welcome the judges' questions.

**MLJ:** *Did you notice a difference between a patent attorney arguing an appeal and a general practitioner?*

**Judge Nies:** There are very few appeals that are not argued by experienced patent attorneys. I would say 99% are argued by experienced patent attorneys. I can remember just one instance where a general

litigator, very well known, argued the appeal in a patent case. And he was obviously well prepared and had done his homework except it was quite obvious that his general knowledge of patent law was limited. I can remember asking a question which drew an absolute blank. It was a question extending and relating the theory to another facet of patent law that he was totally unfamiliar with.

I see no advantage in having a general litigator argue to the court of appeals. If you need a background in tax, you're better off with a tax lawyer in a tax appeal. If it has to do with personnel matters, it's much better to have someone who's very familiar with government personnel law. A contracts case dealing with some of the arcane principles of government contract law is likely to be better presented by someone who is experienced in the field.

**MLJ:** *What would you say is the biggest difference in arguing before the appellate court now and when you were first appointed to the Court?*

**Judge Nies:** I would say the biggest difference in arguing before the appellate court that has developed over the last fifteen years or so is that the judges are so well prepared. That surprises some attorneys. It used to be that the judges came into court not knowing anything about the case and studied the case after the oral argument. That is not true anymore and particularly on this bench. The judges are extremely well prepared both on the facts and the law before the argument. We have to be prepared because the time for argument is so short. The reason we have been able to cut the time to such a short period is that we are prepared so that the lawyers can get directly to the issues. That's all we want to hear about. We don't need a detailed recitation of the litigation procedures and of facts not in dispute.

**MLJ:** *How do you feel technology has changed the appellate court?*

**Judge Nies:** Technology has improved the preparation of opinions, if only because it's easier to write and rewrite. If we still had to make twelve carbons and corrections on twelve carbons we would not indulge in that luxury of refinement. I feel free to go

through draft after draft after draft because it is easier for the support staff to make the changes.

**MLJ:** *Do you feel that technology has delayed the court process at all?*

**Judge Nies:** There is no question that much of trial practice has increased because of the word processor and the ability to quickly turn out standard interrogatories and motions with the necessary legal memoranda. I'm sure that has greatly increased the burdens of the trial court.

**MLJ:** *Commentators have remarked that when Judge Markey was Chief Judge, the Federal Circuit was more pro-patent and that while you were Chief Judge, the Circuit was more centered in its views. What kind of role do you feel the Chief Judge plays in shaping the court, if any?*

**Judge Nies:** I don't see that the Chief Judge has a special influence on the court other than by the force of one's own opinions. The Chief Judge has one vote on any case. Any change in the court that people can perceive during my tenure is more likely due to the change in the membership of the court, not the Chief Judge. Except for Judge Rich and myself, the court has had a complete turnover from the original bench of 1982. ■

## 10TH MEETING OF THE U.S. BAR/EPO LIAISON COUNCIL

*by Samson Helfgott*

The 10th meeting of the U.S. Bar/EPO Liaison Council was held in Arlington, Virginia on October 26, 1994. The Liaison Council includes representatives from all of the major U.S. Bar Associations and meets annually with representatives of the European Patent Office to discuss matters of concern to a U.S. applicant filing in the EPO. The U.S. is the major country filing in the EPO with approximately 27% of the

applications filed in EPO originating from the United States.

At the meeting, the EPO was represented by its President, Dr. Paul Braendli, and other members of the EPO staff. The Council was chaired by Samson Helfgott, Chairman of the Council.

One of the major topics of discussion was the costs in utilizing the European Patent System. Various surveys had been conducted, both in Europe and the United States, on the cost of using the European Patent System. Because of the many individual nations involved, the European System requires many translations and the use of many separate patent attorneys which account for a substantial part of the costs. The European Patent Office is presently giving some consideration to this matter and will try to seek ways to reduce such costs of using the European System.

Dr. Braendli reported on the developments in the European Patent System over the last twenty years, indicating that more than 650,000 patent applications have been filed and more than 250,000 patents have thus far been granted by the EPO. A new feature this year is the extension or designation system where the effect of the EPO is extended to other countries. From March 1994, the effect of the EPO patent has been extendable to Slovenia upon the payment of a relatively low extension fee. Previously, the extension system covered Lithuania. It is expected that Latvia and Romania will soon become available for EPO patent extensions and other countries appear to be interested. One advantage of the extension is that for the first three countries mentioned above, translation of only the claims is required.

In 1993, approximately 40% of the 71,000 patent applications filed in the EPO originated from the PCT. Use of the PCT is increasing and in 1994 it represented 44% of applications filed. The total findings in the EPO in 1994 are 4% higher than in 1993 of which 3.8% is due to increased filings from the United States. There is little or no backlog for EPO searches at the moment. However, examination does have somewhat of a backlog. The goal for examination is to have a report within at least seven months from receipt of the request for examination.

Although it had been initially anticipated that each year the EPO fees would be

increased in order to keep up with inflation, the EPO announced that for the second straight year they have determined that there would be no fee increases.

Numerous topics were discussed with respect to prosecution of applications before the European Patent Office. Recent Board decisions with respect to correcting errors in the European patent applications were reviewed as well as the current situation with respect to the last stage for amending applications and the last stage for filing divisional applications. The EPO again reminded the Council members that it is possible to apply for expedited examination by providing a simple request for such expediting without even providing for any reasons. There were also discussions on the question of broadening claims during prosecution and the procedures for making changes to EPC rules and regulations.

At the conclusion of the meeting, plans were made for the next meeting to be held in 1995. The new Chairman for the Council for the next two years will be Michael Meller. ■

## INTA FORUM TO PROBE OUTER LIMITS OF LANHAM ACT

How far practitioners have gone beyond traditional boundaries of trademark law in the United States in expanding protection for infringement of trademarks will be the subject of a forum sponsored by The International Trademark Association (INTA). The INTA Forum, "Trademarks Beyond the Lanham Act," will be held March 1-2 at the Marriott Marquis in New York.

The INTA Forum will present how copyright and patent laws are being used in addition to the Lanham Act to protect the design and appearance and packaging of products. Strategies for safe use of a competitor's product in comparative advertising will be discussed, as well as how

government regulations affect the right to use and enforce trademarks and brand names.

### EXAMINING TRADEMARK ISSUES ON THE INTERNET

INTA is examining trademark and trade name issues arising out of increased use of the global electronic information network, or Internet. Among the Internet issues to be raised at the INTA Forum are: if downloading of computer programs or information bearing trademarks is infringement by the system operator of the bulletin board; what regulations governing telecommunications affect trademarks; if an Internet address that is confusingly similar to a famous trademark is actually infringement; and if graphic user interfaces can be protected under trademark laws.

### FOCUS ON SPECIFIC INDUSTRIES

The INTA Forum will also address the particular problems in protecting trademarks in the food, drug, tobacco and alcoholic beverage industries. Discussions will include an examination of various geographical designations of historic or actual significance under U.S. and other countries' laws that have application to wines and related food products, and their interplay with the Lanham Act.

### COUNTERFEITING, GRAY MARKET GOODS, DILUTION

The proliferation of counterfeit goods and services in the U.S. and in other countries has led to special laws and enforcement methods to stop their sale and distribution. The INTA Forum will take a look at how the use of temporary restraining and seizure orders, asset freezes and extraterritorial enforcement efforts has led to remedies against the sales and distribution of counterfeit goods.

### REGISTRATION INFORMATION

Those interested in attending "Trademarks Beyond the Lanham Act" should pay by credit card or send a check for \$425.00 to INTA, 1133 Avenue of the Americas, New York, NY 10036.

## NEWS FROM THE BOARD OF DIRECTORS

*by William H. Dippert*

The Board of Directors met on December 13, 1994. Pasquale Razzano presided. Howard Barnaby gave the Treasurer's Report. He commented that the Association's bank account was healthy even though he had recently paid The Sagamore the balance due for the CLE meeting in October.

Mr. Razzano led a brief discussion of the CLE Weekend. He reported that the Association suffered slightly over a \$6000 loss for the program. He also reported that the attendees had positive comments about the program; however, despite such comments, Mr. Razzano recommended foregoing such a CLE program for at least a year.

Bill Gilbreth reported that PLI has asked him to chair an intellectual property program, preferably with a co-sponsor, and he asked whether the Association would like to be such a co-sponsor. After discussion of various aspects of such program, including the benefits and disadvantages to the Association and its members, Mr. Razzano asked Mr. Gilbreth to report back at the next meeting.

Mr. Razzano reported that he had received a call from the President of the New Jersey Patent Law Association, who indicated interest from Judge Archer or Commissioner Lehman in speaking at a meeting of the NJPLA or a joint meeting with another association. After brief discussion of the history of prior joint meetings with the NJPLA, Mr. Razzano indicated that he will pursue the possibility of a joint meeting for April.

There was extensive discussion of pricing and speaker selection for the 1995 Judges Dinner. The discussion concerning pricing included a review of past increases as well as budgetary concerns for the year 1995. Upon motion it was agreed to increase the prices for 1995 Judges Dinner by \$10 apiece. In a subsequent motion, the Board voted 8 to 2 to approve an additional \$5 charge for non-members if there is a paid speaker.

With regard to document storage, Mr. Razzano reported that he has received a

proposal of \$50 a month. Upon motion it was agreed that Mr. Razzano should enter into a relationship for storage of the Association's files.

Mr. Razzano read the names of four candidates for membership. A motion for approval of the candidates passed unanimously.

With regard to new business, Mr. Filardi asked whether we could have Edward Blocker, the Chair of the Committee on Admissions, attend a Board meeting to discuss ways to increase membership. This met with approval.

Mr. Barnaby reported that the Association's voice mail had received some requests for referrals. Mr. Gilbreth suggested that such requests be directed to the referral service of the City Bar Association. Mr. Filardi suggested also directing such requests to Martindale-Hubbell.

Mr. Razzano reported that Mike Kirk of the PTO had called to advise that the Patent Office has a "road show" concerning GATT. The Board responded favorably to that, and Mr. Razzano suggested that such a program could perhaps be presented by the Association in concert with Fordham.

## RECENT DECISIONS OF INTEREST

*by Thomas A. O'Rourke*

### GENENTECH v. WELLCOME

In *Genentech, Inc. v. Wellcome Foundation, Ltd.*, 29 F.3d 1555 (Fed. Cir. 1994), the CAFC reversed a decision, entered after a jury trial, of infringement under the doctrine of equivalents of three patents directed to a protein made through recombinant DNA technology. The CAFC's decision contained important rulings regarding claim construction.

The patents at issue in *Genentech* covered a natural method of producing protein

tissue plasminogen activator (t-PA), a compound which aids in preventing blood clotting in the human body. The plaintiffs had obtained three patents relating to t-PA: (1) U.S. Patent No. 4,752,603, to a human plasminogen activator, (2) U.S. Patent No. 4,766,075, a DNA sequence encoding human tissue plasminogen activator, and (3) U.S. Patent No. 4,853,330, a process for obtaining a DNA sequence encoding human tissue plasminogen activator. The '075 and '330 patents issued from divisionals of a common parent application. *See id.* at 1557-58.

The plaintiffs filed suit against several defendants including the drug manufacturer, Burroughs Wellcome, on the day that the '603 patent issued, and subsequently amended the suit to add the '075 and '330 patents at the time each issued. At the time of filing suit, Burroughs Wellcome was contracting a facility in the United States for the manufacture of t-PA. *See id.* at 1559.

After a jury returned a special verdict in favor of the plaintiffs, finding infringement under the doctrine of equivalents, the defendants filed a motion for judgment as a matter of law (JMOL). The JMOL motion was denied, and the defendants appealed.

The parties filed cross-motions for summary judgment on the '603 and '075 patents. The court granted defendants' motion in part, holding that neither the '603 nor '075 patents are literally infringed by the defendants. The court held that the "human tissue plasminogen activator" limitation recited in the claims of the '603 and '075 patents meant "the full length amino acid sequence of human t-PA plus any 'naturally-occurring allelic variant' thereof." *Id.* at 1560. The Court also focused on the specific activity limitation of "about 500,000 IU/Mg." contained in claim 1 of the '603 patent. The Court held that this limitation was implicit in the '075 claims. *See id.* at 1559-60. Subsequently, a jury trial was held on the plaintiffs' doctrine of equivalents claims. The jury held for the plaintiffs on all three patents. *See id.* at 1560. Defendants then moved for judgment as a matter of law ("JMOL"), and their motion was denied. Defendants appealed to the CAFC.

On appeal, the CAFC considered the specific activity limitation of the '603 patent. The plaintiffs argued that the defendants should not be permitted to argue that the identical specific activity limitation of the

'603 patent was also found in the '075 patent. The plaintiffs argued that the court's holding had become the "law of the case." The CAFC rejected this argument. The CAFC commented that the only evidence presented in support of this finding was the specification and prosecution history of the '603 patent, and that consequently this could not be read into the claims of either the '603 or '075 patents. *See id.* at 1561-62.

The Court then considered the meaning of the claim limitation of 500,000 IU/Mg. specific activity. Referring to the prosecution history, the Court held that the specific activity was measured using bovine film plate assay, the same assay used in the prior art which the specific activity limitation was intended to distinguish. *See id.* at 1562-63. The Court then considered the definition of "human tissue plasminogen activator," noting that there were four different definitions in the specification. The CAFC commented that "[t]hese diverse definitions reflect either inartful drafting, a conscious attempt to create ambiguity about the scope of the claims, or a desire to claim a wide variety of materials not described or enabled in the specification." *Id.* at 1564.

The CAFC reasoned that it was appropriate to avoid any definition which the PTO could not reasonably have relied upon in the course of the prosecution of the patent. *See id.* The Court explained that this manner of interpretation prevents an applicant "from obtaining in court a scope of protection which encompasses subject matter that, through the conscious efforts of the applicant, the PTO did not examine." *Id.* The Court concluded that the proper definition was the definition that "is the most consistent with the limited form in which the claims are drafted." *Id.*

The Court held that there was insufficient evidence for the jury to conclude that the defendants' alleged infringing product has a specific activity of about 500,000 IU/mg., as required by claim 1 of the '603 patent. The Court also found that there was insufficient evidence for the jury to conclude that the defendants' alleged infringing product came within the meaning of "human tissue plasminogen activator" of the '075 and '830 patents. *See id.* at 1569. Accordingly, the Court reversed the district court's decision and entered judgment as a matter of law for the defendants.

## TRANSCO PRODUCTS v. PERFORMANCE CONTRACTING

In *Transco Products, Inc. v. Performance Contracting, Inc.*, 32 USPQ2d 1077 (Fed. Cir. 1994), the CAFC reversed a much criticized decision of the U.S. District Court for the Northern District of Illinois regarding an applicant's duty to comply with the "best mode" requirement of 35 U.S.C. § 112.

The *Transco* case concerned U.S. Patent No. 4,009,735, which is directed to thermal insulation for vessels and piping within nuclear power plants. The '735 patent issued from a continuation application. The '735 patent was owned by the defendant, Performance. After Performance asserted that the plaintiff Transco was infringing the '735 patent, Transco brought suit for a declaratory judgment on the validity of the '735 patent.

Both parties moved for summary judgment. *See id.* at 1079. The Court then found that at the time of filing the continuation application which later issued as the '735 patent, the inventor knew of a best mode of practicing the claimed invention that he did not have knowledge of at the time of the filing of the parent application. The court held that the '735 patent was therefore invalid since, according to the district court, "an applicant must update the best mode disclosure upon each filing of a continuing application." *See id.* (citing *Transco Products, Inc. v. Performance Contracting, Inc.*, 813 F. Supp. 613 (N.D. Ill. 1993)).

On appeal, the CAFC reversed. The CAFC first reviewed the history of 35 U.S.C. 120, the statute covering continuing applications. The CAFC noted the language that the continuation application "shall have the same effect, as to each invention, as though filed on the date of the prior application . . ." *See id.* at 1081. Giving effect to this language, the CAFC concluded that "the date for evaluating a best mode disclosure in a continuing application is the date of the earlier application with respect to common subject matter." *Id.* at 1082.

The CAFC commented as follows:

The district court's comments regarding continuing application practice and new matter illustrate a misunderstanding of patent law and patent office practice. The subject matter that the district court believes Pinsky should have disclosed in his continuation application would clearly have constituted "new

matter" pursuant to 35 U.S.C. §132, 37 C.F.R. §1.118, and MPEP §§ 608.04 (a)-(c) and 706.03 (o). It must be understood that the introduction of a new best mode disclosure would constitute the injection of "new matter" into the application and automatically

deprive the applicant of the benefit of the earlier filing date of the parent or original application for any claim whose validity rests on the new best mode disclosure." *Id.* at 1083.

Concluding that there were questions of material fact remaining, the CAFC reversed the district court's order and remanded the case. *See Id.* at 1086.

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For further information, please contact Helen Herman, Director of Office of Academic Programs, at (212) 636-6885

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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, 1995 to the address given below.

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

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Marylee Jenkins; Serle Ian Mosoff; Thomas A. O'Rourke; Lisa Pieroni; Henry Sacco; Charles J. Zeller.

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## A PRIMER ON LICENSING

by Jack Revoyr

The first publication of its kind, **A Primer on Licensing** is a complete, step-by-step guide that covers the fundamentals of establishing and managing a successful trademark licensing program. It is must-reading for licensing professionals who want to maximize profits and avoid common pitfalls.

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