THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

BULLETIN

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PRESIDENT'S CORNER

In my first President's Corner, I noted that the upcoming Dinner in Honor of the Federal Judiciary would be the Diamond Jubilee dinner, and also noted that, while this dinner was our "jewel in the crown," it was not our only activity.

While it is not our only activity, as we more closely approach the dinner, it assumes a position of increasing importance, and this year is certainly no exception. A major portion of the planning is to select an appropriate speaker.

AN UPDATE ON THE 75TH ANNUAL JUDGES' DINNER

This year, in honor of the Diamond Jubilee, we are honored to have as our speaker, Judge William C. Conner, and we will also be privileged to receive remarks from Judge Giles Sutherland Rich. So far as is known, these are the only past officers of our Association who have been appointed to the Federal bench; each of these Judges is a past President of our Association.

It is significant that the first Vice President at the time of the 25th anniversary dinner was Judge Rich, and the first Vice President at the time of the 50th anniversary dinner was Judge Conner. It is most fitting that they grace our dais at the 75th anniversary dinner.

One can always debate which came first, "the chicken or the egg"? Has our Association reached this milestone and achieved the eminence which it has because of leaders such as these, or is it the existence of the Association and the interplay of its many members which allowed the development of such leaders? Like the chicken and egg, there probably is no answer; here, no doubt, there is a symbiosis.

In addition to these special speakers, because of the significance of this dinner, we will have some "extras" to recognize it. That is in keeping with what the Association did at both the 25th and 50th Anniversary Dinners.

I am certain that our many attendees will appreciate this celebration of our Federal Judiciary and our own milestone.

– Martin E. Goldstein

CALENDAR OF EVENTS

February 21, 1997	NYIPLA Luncheon Meeting, "Report from the WIPO Conference: Copyright Issues" Speaker: Mort Goldberg, Cornell Club, New York City
February 25-26, 1997	"The Art & Skill of Direct and Cross Examination" sponsored by the CitiBar Center for Continuing Legal Education, call (212) 382-6612 for further information.
March 13-15, 1997	Licensing Executive Society, LES (USA and Canada) Winter Meeting, Charleston, South Carolina
March 21, 1997	NYIPLA 75th Annual Dinner in Honor of the Federal Judiciary, Waldorf-Astoria Hotel, New York City
March 28, 1997	NYIPLA Luncheon Meeting, Speaker: Hon. Janet Rice, TTAB, Cornell Club, New York City
April 2-3, 1997	ABA-IPL Section, Twelfth Annual Spring CLE Program, "Patent, Trademark & Copyright Law: Litigation & Corporate Practice" Crystal Gateway Marriott Hotel, Arlington, VA

NEWS FROM THE BOARD OF DIRECTORS

by John F. Sweeney

NOVEMBER MEETING

The Board of Directors met at The Yale Club, 50 Vanderbilt Avenue, New York, New York on Tuesday, November 19, 1996. Martin Goldstein presided.

Howard Barnaby presented the Treasurer's report. Upon motion by Mr. Schwartz, seconded by Mr. Sweeney, the Treasurer's report was approved.

Thomas Beck reported on the New York State Audio-Visual Study Committee concerning audio-visual coverage of court proceedings. The members of the Board discussed whether or not the Association should take a position in support of the continuation of New York State's program for the use of audio-visual coverage of court proceedings. In general, the Board supported the program, but a caution was expressed concerning audio-visual coverage of cases in which trade secret information is discussed. Upon motion by Edward Vassallo, seconded by Howard Barnaby, the Board decided to support the continuation of the status quo with respect to the New York State audio-visual program for the coverage of court proceedings. Mr. Beck will communicate the Association's support to the New York State Audio-Visual Study Committee but will note the Board's concern with respect to coverage of trade secret cases.

Mr. Goldstein reported on the letter of October 15, 1996 from Judge Kaye, Chief Judge of the State of New York, requesting that members of the legal profession begin working with the public high schools and grammar schools to increase the general level of understanding of the legal system. Thomas Spath suggested the possibility of the Association developing videotapes concerning the operation of the legal system, which could be provided to local schools. Edward Filardi, the Board liaison to the Public Information And Education Committee, was asked to request that this committee study the issue and make a recommendation to the Board.

Mr. Filardi reported on the new Patent and Trademark Office proposal for continuing legal education requirements. The PTO is proposing a computer-administered test followed by a course in patent claim and specification drafting. The members of the Board supported such a procedure, but it was noted that if there was going to be a course, there should also be an exam given to assure that applicants registered to practice before the PTO have satisfactorily mastered the course work. The view was also expressed that there should be no PTO CLE requirement for those already admitted to practice before the PTO. Mr. Filardi was asked to prepare a draft letter expressing the Association's views to the PTO for circulation. The letter will set forth a proposed NYIPLA position with respect to each of the questions posed by the PTO in the notice published on September 30, 1996 at 61 Fed. Reg. 51072.

Mr. Barnaby reported on preparations for the Annual Judges' Dinner. Mr. Barnaby informed the Board of Horizon's request that Horizon be able to use a general database consultant company in connection with the preparations for the dinner. The cost is estimated to be about $5,000 to $7,500 for the first year. After some discussion, a consensus was reached that Horizon should make a written proposal concerning the use of a separate database company.

The form of the program for the 1997 Annual Judges' Dinner was also discussed. Specifically, alternatives for a special tribute to Judge Nies were discussed, along with how the 75th anniversary of the Association should be reflected in the program. A committee, headed by Martin Goldstein and including Edward Filardi, Howard Barnaby and Tom Creel, was appointed to study the options and make recommendations.

Mr. Goldstein informed members of the Board that the WIPO Arbitration Seminar will be held in New York beginning March 20, 1997 and concluding March 21, 1997, the date of the Annual Judges' Dinner. The Board discussed whether or not the attendees at the WIPO Arbitration Seminar should be invited to attend the Annual Judges' Dinner.

It was agreed that the WIPO attendees would be invited and that a separate satellite room in the Waldorf could be made available to accommodate them.

Mr. Barnaby reported that Professor Hanson will not be going to the December 1996 WIPO conference on behalf of the Association because he was not invited. It was suggested that WIPO be contacted to see if a future invitation could be arranged for Professor Hanson.

Mr. Goldstein briefly reported on the Chicago Intellectual Property Law Association Dinner which he attended as President of the New York Intellectual Property Law Association. Mr. Goldstein also gave a brief report on the meeting of the Patent and Trademark Institute of Canada. He noted that many of the cases discussed were U.S. decisions.

Herbert Schwartz reported on the study he has made on the committee structure of the Association. He expressed the general view that the procedure for getting on committees be formalized and that a fixed term should be established. Mr. Schwartz also expressed the view that there may be no need for certain committees such as the Employment Committee. Mr. Goldstein thanked Mr. Schwartz for his attention to the matter, as well as Mr. Schwartz's general suggestions, and he asked Mr. Schwartz to go forward with the study so as to be able to make specific proposals concerning changes to the committee structure.

DECEMBER MEETING

The Board of Directors met at The Yale Club, 50 Vanderbilt Avenue, New York, New York on Tuesday, December 17, 1996. Martin Goldstein presided.

Howard Barnaby presented the Treasurer's report. Upon motion by Alice Brennan, seconded by John Sweeney, the Treasurer's report was approved.

Mark Abate, Chairperson of the Committee on Public Information and Education, reported on ways to implement the suggestions made by Judge Kaye, Chief Judge of the State of New York, in her letter dated October 15, 1996, for members of the bar to provide "citizen education" concerning the legal system in the state school systems, particularly high schools. Mr. Abate reported that Judge Richard Lee Price of the Supreme Court in the Bronx has a database of schools who have indicated an interest in participating in the legal sys-

tem education program and attorneys who have also expressed an interest in participating. The Bronx Supreme Court program operates under the sponsorship of the New York County Lawyers Association. Mr. Abate suggested that members of the Association could participate through the Bronx Supreme Court program. He recommended that an announcement be put in the Association's newsletter providing information on how members can join the ongoing Bronx Supreme Court program. Mr. Abate was authorized by the Board to write a letter to Judge Kaye for Martin Goldstein's signature indicating the willingness of the Association to participate in the legal system education program.

Marylee Jenkins, Chairperson of the Committee on Consonance and Harmonization, reported on plans for a young lawyers seminar and mentor program concerning intellectual property law. Ms. Jenkins recommended that a questionnaire be developed to send to members of the Association to determine interest in participating in intellectual property law seminars and mentoring programs for young lawyers. Plans of the Committee on Consonance and Harmonization for a seminar and reception for young lawyers, including women and minority lawyers, were approved. It was estimated that the cost would be $40 per person and that approximately 50 persons would attend.

Mr. Barnaby reported that plans to develop new software for planning the Judges' Dinner will be deferred until next year. Mr. Barnaby recommended that for the upcoming Judges' Dinner in March 1997, the existing software be used. This plan was approved by the Board.

Mr. Goldstein reported that the members of the WIPO Conference will be receiving invitations to the Judges' Dinner and will be informed that its attendees could have their own seating area. However, WIPO declined this offer.

After some discussion, it was agreed that the cost per person of the Judges' Dinner will be raised by $10 per person to $135 for members and $185 for non-members.

Mr. Barnaby reported that a banner will be displayed at the upcoming Judges' Dinner in honor of the Association's 75th anniversary. After some discussion, it was decided not to have centerpieces or commemorative pins. There will be a separate booklet to commemorate the Association's 75th anniversary. ■

IN MEMORIAM — MICHAEL T. FRIMER

We are deeply saddened to learn of the death of Michael T. Frimer on December 29, 1996. Mr. Frimer was former Head of the Intellectual Property Department of J.P. Stevens & Co., Inc. Prior to joining Stevens, he was the Manager of the Patent Department of Atlantic Richfield. He received a B.S. in Chemistry from City College and graduated at the top of his class from Seton Hall University of Law.

He is survived by his wife, Fay, two children, Richard and Joyce, a daughter-in-law, Judy, his sister, Lillie Latzen and two grandchildren, Danielle and Kayla Frimer. He will be sorely missed by his many friends and colleagues. ■

FORDHAM'S FIFTH ANNUAL CONFERENCE ON INTERNATIONAL IP LAW AND POLICY

Fordham University School of Law is pleased to announce its Fifth Annual Conference on International Intellectual Property Law and Policy, which offers lawyers and others an opportunity to meet new colleagues and to learn about and discuss important developments in this very important area of practice.

This two-day conference will analyze international developments in copyright, patent and trademark law with regard to the European Union, Asia, the United States, the World Intellectual Property Organization ("WIPO"), WTO and the Information Superhighway. The faculty is comprised of speakers from the judiciary, WIPO, the Commission of the European Communities, the U.S. government, academia and U.S. and international bars.

For information on specific topics and speakers, as well as registration, please refer to the brochure enclosed with this issue of the *Bulletin.* ■

PENDING LEGISLATION

by Edward P. Kelly

Several significant bills relating to intellectual property reached the President's desk for signature prior to the adjournment of the 104th Congress — and several others did not. Among those bills that were enacted into law in 1996 were the following.

BILLS PASSED INTO LAW IN 1996

Trademark Dilution

Congress finally added an anti-dilution remedy to the Federal Lanham Act for trademark infringement which constitutes the dilution or tarnishment of a well-known mark by another's use of a similar or identical mark on different goods. The dilution remedies previously available were limited to applicable state law which might not be enforced outside the territorial boundaries of that single state. The Lanham Act legislation applies only to the dilution of "famous marks."

Theft of Trade Secrets

Another new law makes economic espionage or theft of trade secrets a federal crime under Title 18 of the U.S. Code.

Attorney Fees Against the U.S. Government

The United States government is now responsible for attorneys' fees in patent infringement cases, but only in those instances in which the plaintiff is an independent inventor, non-profit organization or a company with less than 500 employees.

Limitations of Remedies for Infringement of Medical Procedure Patents

Another patent bill enacted into law severely curtails the infringement remedies that are available for infringement of patented medical and surgical procedures. The PTO apparently has not stopped issuing patents on medical and surgical procedures, but the law enacted by Congress significantly limits remedies for infringement. The law is not intended to extend into the biotech area to eliminate remedies for infringement of patents with claims on gene therapy or in vitro diagnostics.

Amendments to the Stephenson Wydler Act

Amendments to the Stephenson Wydler Act, 15 U.S.C. 3710, were enacted which are intended to give private industry more incentive to enter cooperative research and development agreements (CRADAS). Now, when a private company and a federal laboratory jointly develop a technology, the private sector party has the option of taking an exclusive license for a field of use for the technology jointly developed. The government receives a paid-up, revocable license under the jointly developed technology, as well as march-in rights if the private sector does not commercialize the jointly developed technology or the licensee is not manufacturing in the United States. Even the government-employed inventor can benefit. He or she can receive the first $2,000 of income if the invention is commercialized and also a 15% annual royalty.

Trademark Counterfeiting

Tougher anti-counterfeiting provisions were enacted into law. Under the new law, trademark counterfeiting may also constitute a Rico offense, thereby subjecting counterfeit goods and all property associated with the counterfeiting to seizure.

LEGISLATION TO BE REVISITED

Among the legislation which did not reach the President's desk but may be revisited in the next Congress, are the following.

Madrid Protocol

The United States has acceded to, but not ratified the Madrid Protocol for trademarks, despite the fact that a bill has been pending for some time now (H.R. 1270). The Madrid Protocol affords its member the opportunity to file a single international application and receive trademark protection in all member states.

Omnibus Patent Bill

In the patent area, an ominous bill, which had been pending for much of the 104th Congress, never made it to the President. The bill included reforms with respect to reexamination proceedings in the Patent Office, creation of a prior use defense and publication of U.S. patent applications 18 months after filing. The bill (H.R. 1732) would amend the Reexamination Statute to give a third-party a greater role and influ-

Announcing the

WILLIAM C. CONNER INTELLECTUAL PROPERTY WRITING COMPETITION FOR 1997

sponsored by

THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

Awards to be presented on May 21, 1997 in New York City at the NYIPLA Annual Meeting and 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 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 March 15, 1997 to the address given below.

For a copy of the rules of the competition, call or write:
Mark J. Abate, Esq.
Morgan & Finnegan, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 758-4800

AN OPEN LETTER TO ASSOCIATION MEMBERS

1997 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 on May 21, 1997 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 me. Please forward your nominations to me no later than March 15, 1997.

Thank you.

Cordially,

Mark J. Abate
Chairman Committee on Public
Information and Education
(212) 758-4800

NOMINATION FORM FOR INVENTOR OF THE YEAR — 1997

Instructions: You may nominate as many individuals as you wish. Please provide one form for each nominee (joint nominations are acceptable). Please submit twelve (12) copies of all papers, including this form, that you wish to be considered by the Awards Panel. A nominee must: have one or more issued patents (the patent(s) relied on should not be the subject of pending litigation); be favorably disposed to the patent system; and be respected by his or her professional peers. The award is made in recognition of an inventor's lifetime contributions. The nominee should be prepared to attend the NYIPLA annual meeting to be held on May 21, 1997 in New York City.

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 provide a summary of the nominee's contributions which form the basis of this Nomination, and of any recognition of the nominee's contributions accorded by his or her peers.

Please add any additional information you believe the Awards Panel will find helpful. Material submitted will not be returned. Please forward the Nomination by March 15, 1997 to Mark J. Abate, Morgan & Finnegan, 345 Park Avenue, New York, N.Y. 10154. Telephone number (212) 758-4800.

ence in the outcome of a reexamination proceeding. For instance, the bill would allow the third-party requester to not only comment on the patent owner's response to reexamination, but also readdress the issues raised in the Patent Office during the reexamination procedure.

The prior use bill would amend Section 273 of the Patent Statute to provide a defense to patent infringement if the accused infringer had, acting in good faith, commercially used the subject matter in the U.S. before the effective filing date of the patent. "Commercially used" would mean "use in the U.S. in commerce, whether or not the subject matter at issue is accessible or otherwise known to the public." There is also a special exception for a subject matter that cannot be commercialized without significant investment of time and money. In that case, a person would be deemed to have commercially used a subject matter if he effectively reduced the subject matter to practice in the U.S. before the effective filing date of the patent and then after the effective filing date of the patent diligently completed the remainder of the activities and investments necessary to commercially use the subject matter. However, there is a one-year limitation in the bill that provides that the defense is only available if the reduction to practice occurred more than one year prior to the effective filing date of the patent.

While many other countries publish patent applications 18 months after the filing date, the United States does not. The Omnibus Bill would have contained provisions that would bring the U.S. into conformity with the other countries that do provide for publications 18 months after filing. The Omnibus Bill would contain a provision that would allow the patent holder to obtain provisional rights to obtain reasonable royalty from infringers who infringed during the time between publication and the time that the patent issues. ■

RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

PATENTS

Claim Interpretation

In *Novo Nordisk of North America Inc. v. Genentech Inc.*, 37 USPQ2d 1773 (Fed. Cir. 1996), the Court of Appeals for the Federal Circuit vacated an injunction against Novo Nordisk's importation of human growth hormone (hGH) covered by Genentech's U.S. patent. The CAFC held that a portion of the trial court's claim interpretation was improper and that Genentech, under a proper interpretation of the claim, would be unable to prove that Novo's process was within the scope of the asserted claim.

35 U.S.C. §271(g) requires that the patentee prove that the accused infringer imported, offered for sale, sold or used a product made by a process within the scope of the claims of the patentee's U.S. patent. A patentee may request that the alleged infringer be enjoined from importing goods covered by a U.S. process patent. A court's decision granting such an injunction may be overturned on appeal only upon showing of an abuse of discretion by the issuing court. An abuse of discretion may be characterized as a clear error of judgment in weighing relevant factors or the exercise of discretion based upon an error of law or clearly erroneous factual finding. Claim construction, being a question of law, if decided erroneously, may be called an abuse of discretion.

Genentech is the assignee of U.S. Patent 4,601,980 ('980 patent) directed to a recombinant DNA method for producing a 191- or 192-amino acid hGH expression product. Claim 2 of the '980 patent, the only claim asserted in the case reads:

> 2. A method for producing human growth hormone which method comprises culturing bacterial transformants containing recombinant plasmids which will, in a transformants bacterium, express a gene for human growth hormone unaccompanied by the leader sequence of human growth hormone or other extraneous protein bound thereto, and isolating and purifying said expressed human growth hormone.

The dispute centered around whether claim 2 covered only the direct expression of hGH or both the direct expression and cleavable fusion expression of the hormone. The hGH manufactured in Denmark and imported by Nova is produced by a cleavable fusion expression method. Put simply, this method produces the same hGH as the Genentech method, but the hGH does not result from direct expression, but rather from cleavable fusion expression. The hGH produced by cleavable fusion expression is connected to additional amino acids from which it must be cleaved before product hGH contemplated in the '980 patent is realized.

Novo contended that the claims should be limited to direct expression. Genentech maintained that the claims, properly interpreted in light of the specification, include cleavable fusion expression. The CAFC disagreed with Genentech's and the lower court's interpretation, stating:

> It is true, as Genentech states, that the specification refers to both direct expression and cleavable fusion expression of human growth hormone. The specification teaches, for example, that the invention allows the expression of either the intended product absent extraneous conjugated protein [i.e., by direct expression], or intended product conjugated to but specifically cleavable from extraneous protein [i.e., by cleavable fusion expression]. Col. 7, ll. 48-51. The claims, however, not the specification, measure the protected patent right to exclude others.

Also important when interpreting claim 2 of the '980 patent, according to the CAFC, is that it calls specifically for hGH "unaccompanied by . . . extraneous protein bound thereto." The hGH by cleavable fusion expression by extraneous protein is precisely what Novo produces by cleavable fusion expression. This division between direct and cleavable fusion expression is also recognized in the '980 specification.

The CAFC also reviewed important aspects of the prosecution history in its claim construction.

> Furthermore, Genentech distinguished the prior art by arguing that the patentable invention produced[d] [the] desired protein unaccompanied by extraneous conjugated protein, thus for the first time achieving success in producing [the] desired protein in a direct manner. Similar assertions were made throughout the patent's lengthy prosecution.

It is apparent from this history that Genentech considered its invention to be direct expression of hGH rather than via a fusion protein.

The CAFC's thorough review of the claims in light of the specification and file history in this case is an excellent example of how this process is properly undertaken. After properly construing the claims, the Court of Appeals found that the district court erred in finding literal infringement and irreparable harm. Hence, the Federal Circuit vacated the injunction.

Means-Plus-Function Claims

In *York Products Inc. v. Central Tractor Farm,* 40 USPQ2d 1619 (Fed. Cir. 1996), the Court of Appeals refused to interpret a claim as a means-plus-function claim and subject to section 112, paragraph 6, even through the claim contained the word "means."

The plaintiff York Products, Inc. (York) owned U.S. Patent No. 4,958,876 (the '876 patent) entitled "Vehicle Cargo Bed Liner." The patent claimed a protective liner for a vehicle cargo body, such as the bed of a pickup truck. The sidewalls of the liner include ridges which are aligned on opposite sides of the liner to create slots into which a user may insert a wooden board to lock a load in place.

York alleged that Central Tractor Farm & Family Center (Central Tractor) infringed the '876 patents with its models of bed liners for use in the cargo body of pickup trucks. Custom Form manufactured the accused products and Custom Form defended Central Tractor.

The U.S. District Court for the Western District of Pennsylvania granted Custom Form's judgment as a matter of law. York appealed the case to the Federal Circuit. The parties' dispute centered on the interpretation of the claim 1 and 32 of the '876 patent. In claim 32, the claim language in dispute was:

> means formed on the upwardly extending liner sidewall portions including a plurality of spaced apart, vertically extending ridge members protruding from the linear sidewall portions and forming load locks in gaps separating adjacent ones of the ridge members, said lead locks having a depth sufficient to anchor a structure positioned and supported in the cargo bed. *Id.* at 1623 (emphasis deleted).

The District Court interpreted claim 32 to mean that the ridge member must extend from near the bottom of the sidewall of the liner to near the top of the sidewall.

The Federal Circuit noted the use of the word "means" in claim 32 and reviewed the claim to see whether the claim was a means-plus-function claim and subject to section 112(b). The Court stated that "the use of the word 'means' triggers a presumption that the invention used the term advisedly to invoke the statutory mandates for means-plus-function clauses." *Id.* at 1623.

However, the Court ultimately found that claim 32 was not a means-plus-function claim, because the claim did not link the word "means" to a function. Instead the word "means" was followed by a "detailed recitation of structure." The Court held: "Without a 'means' sufficiently connected to a recited function the presumption in use of the word 'means' does not operate . . . Thus, this court construes this claim without reference to section 112, ¶ 6." *Id.* at 1624.

The Court then analyzed the claim to determine if claim 32 placed a height limitation on the ridge members. The Court found that the claim language of claim 32 did not provide a height limitation, but merely disclosed that the "'load locks [have] sufficient depth.'"

The Court also reviewed the specification and the prosecution history to determine if the claim language should be interpreted to place a height limitation on the ridge members. The Court found no height limitation and reversed the District Court's holding with respect to claim 32.

In claim 1, the disputed claim language was: "ridge members protruding in a common plan[e] from the liner sidewall portions for at least a substantial part of the entire height thereof." *Id.* at 1622.

The District Court interpreted claim 1 to require that the ridge member must extend from near the bottom to near the top of the liner sidewall.

The Federal Circuit affirmed the District Court's interpretation with respect to claim 1. The Federal Circuit found no "express intent to impart a novel meaning to claim terms" and applied the ordinary meaning to the words in the claim. The Court took the dictionary definition of "substantial part" and found that it modified the term "entire height thereof" which in turn referred back to the term "liner sidewall portions."

In *Cole v. Kimberly-Clark Corp.,* 1996 U.S. App. Lexis 31360 (Fed. Cir. December 6, 1996), the Court of Appeals affirmed the district court's holding that a claim containing the word "means" could not be interpreted as a means-plus-function claim, because the claim describes the structure supporting the function.

The plaintiff, Shelley K. Cole (Cole), owned U.S. Patent No. 4,743,239 ('239 patent) entitled "Disposable Brief having an Area of Relatively Thin Absorbent Material and an Area of Relatively Thick Absorbent Material." The claimed invention consists of a disposable brief for use during toilet training. The briefs are close-fitting, legless underpants with a combination of three separate absorbent layers of varying thickness and sides that can be easily torn open to remove a soiled brief.

The Kimberly-Clark Corp. (K-C) began marketing disposable training briefs with three absorbent layers of varying thickness and sides that can be easily torn open. The side seams in the K-C brief are ultrasonically bonded. Cole filed suit against K-C, alleging literal infringement and infringement under the doctrine of equivalents. The U.S. District Court for the District of Arizona found that K-C's briefs did not infringe Cole's '239 patent.

Claim 1 was the only independent claim. It provided, in pertinent part:

> perforation means extending from the leg band means to the waist band means through the outer imperme-

> able layer means for tearing the outer impermeable layer means removing the training brief in case of an accident by the user. *Id.* at *3.

Cole argued that the clause "perforation means . . . for tearing" was a "means-plus-function" element under 35 U.S.C. §112, ¶6 and must be construed to encompass all embodiments disclosed in the specification and their equivalents.

The Court found that the claim was not a means-plus-function claim. Although the claim contained the word "means," it also contained structural language. The Court stated:

> For example, the "perforation means . . . for tearing" element of Cole's claim fails to satisfy the statute because it describes the structure supporting the tearing function (i.e., perforations). The claim describes not only the structure that supports the tearing function, but also its location (extending from the leg band to the waist band) and extent (extending through the outer impermeable layer). An element with such a detailed recitation of its structure, as opposed to its function, cannot meet the requirements of the statute. Here, the claim drafter's perfunctory addition of the word "means" did nothing to diminish the precise structural character of this element. It definitely did not somehow magically transform this element into a §112, ¶6, "means-plus-functions" element. *Id.* at *19.

The Court then interpreted the claim by using the ordinary meaning for each of the words in the claim. The Court referred to a dictionary to provide the meaning of "perforation means" as: "[A] hole, or one of a number of holes, bored or punched through something, as those between individual postage stamps of a sheet to facilitate separation." *Id.* at *20.

The Court also looked to the prosecution history to interpret the term "perforation means." During the prosecution history, Cole distinguished her invention from other prior art patents. Cole distinguished her patent from the Strohbeen and Repke patents by arguing that the side seams of her invention were substantially different from the side seams of the Strohbeen and Repke patents. Both of those patents provided for ultra-sonic sealing as a preferred embodiment of the invention. The Court found that Cole "surrendered any argument that her 'perforation means' encompasses ultra-sonic bonded seams."

The Court found that there was no literal infringement or infringement under the doctrine of equivalents by K-C and affirmed the decision of the District Court. ■

EXTENSION GRANTED !

ON THE DISABILITY INSURANCE PLAN BEING OFFERED TO NYIPLA MEMBERS

Due to an overwhelming response, Union Central has agreed to continue to enroll members beyond the January 31st deadline. But don't procrastinate! Contact Randy Rasmussen at 203 637-1006 to enroll.

CLASSIFIED ADVERTISEMENTS

Registered patent attorney sought by large Phoenix law firm. Outstanding opportunity to join an expanding intellectual property practice. Candidate should have excellent academic and professional credentials, and 2-4 years experience. Please send cover letter, resume and law school transcript to: Lisa Nealon, Recruitment Coordinator, Fennemore Craig, 2 N. Central, Suite 2200, Phoenix, AZ 85004-2390.

Hamilton, Brook, Smith & Reynolds, P.C. has an immediate opening for a patent attorney with at least three years patent prosecution experience. Strong technical background in electrical/mechanical engineering required. Experience with medical devices would be helpful. Interested candidates may submit resumes and transcripts (undergraduate, graduate and law schools) in confidence to John Medbury, Administrative Director, Hamilton, Brook, Smith & Reynolds, P.C., Two Militia Drive, Lexington, MA 02173.

Hamilton, Brook, Smith & Reynolds, Lexington, Massachusetts, is seeking well-qualified patent attorneys with technical backgrounds in biotechnology and chemistry at all levels of experience. Interested attorneys should send a current resume to John Medbury, Administrative Director, Hamilton, Brook, Smith & Reynolds, Two Militia Drive, Lexington, MA 02173.

Experienced patent attorney (biotehnology/chemical) seeking overflow work. Diverse practice includes prosecution, validity/infringement analysis, agreement drafting and negotiation. References available. C. A. O'Gorman, 370 Elwood Ave., Hawthorne, NY 10532. Tel. (914) 769-5699.

The New York Intellectual Property Law Association, Inc.
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