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## President's Corner

As undoubtedly was the feeling of all my predecessors at about this time of year, I assume the duties and responsibilities as President for this 1997-98 Association with a great sense of honor and respect for the Office, as well as of commitment to dedicate myself to the Association's business. It is a sense of commitment not only to maintain the stature of the Association but also to achieve our mutual goal to continue to strengthen our organization's structure for effective response to our rapidly changing and expanding practice. I look upon my role as President as one which requires that I function as a coordinator of the good work of my fellow Officers, our Board members and the committee chairs. Indeed, I understand that the respect and the deference accorded the President derives from a broad-based recognition within the membership that the office of President represents a strong tradition of excellence that has been maintained over a period now in the final leg approaching our centennial.

As long as I have been a member of our Association, I have always believed that the primary goal and purpose of our Association is and should be essentially twofold:

1. to serve as a voice for the intellectual property bar in the New York metropolitan area on critical issues affecting our practice; and
2. to provide a reliable and trustworthy informational and educational source of relevant subject matter and events for all levels and disciplines within our membership.

When I first became a member of our Association in 1970, the national intellectual property associations, namely the American Intellectual Property Law Association (then the American Patent Law Association) and the American Bar Association, Intellectual Property Law Section (then the Section on Patent, Trademarks and Copyright Law), were both well along in development into independently staffed and well-supported organizations with a broad membership base and committee participation. I was, for one,

as was the case for many others, immediately drawn to participate in the AIPLA and eventually the ABA/IP Law Section and continue to enjoy many benefits of participation in those organizations. But while I, as I am sure we all, appreciate the vital role of the AIPLA and the ABA/IP Law Section, there can be no question but that the primary goal of our Association remains necessary and vital and continues to require our commitment and dedication. I am committed to insuring that our great tradition is nurtured and our work accomplished.

To be sure, our Association has other important goals and purposes: we support, cooperate with and provide critical review for the AIPLA and the ABA/Intellectual Property Law Section on significant issues to our practice; we bear the burden of promoting civility among the lawyers in our practice, not far akin from the function of Inns of Court; we have, as an added objective, to serve and honor our judiciary and this we do exceedingly well with our annual "Judges Dinner."

Looking upon the goals and objectives of our Association, I intend to work with the Officers and the Board to focus the Association's activities for the upcoming year on promoting these goals and objectives in a concrete way.

A major highlight of our Association year 1996-1997, under the able leadership of Martin Goldstein, was the rearrangement of the standing committees of the Association. The new committee structure provides a much improved platform for the development of projects responsive to current issues in all aspects of intellectual property practice. By the time you read this column, I would have already made committee chair and member appointments as well as the designation of Board liaisons. These appointments were made based upon responses to the committee preference sheets sent to the membership. Only a small percentage of the membership have, to date, returned these preference sheets. I urge you to consider participation based upon the new committee structure. For convenience, I will state here our standing committees as they are presently constituted with the new committees in bold:

- Membership Committee
- Committee on Alternate Dispute Resolution
- Committee on the Annual Dinner in Honor of the Federal Judiciary
- Committee on the Annual meeting of the Association
- Committee on Antitrust, Inequitable Conduct and Misuse
- **Young Lawyers Committee**
- **Committee on Computers, Entertainment Law and Media**
- Committee on Continuing Legal Education
- Committee on Copyrights
- Committee on Economic Matters Affecting the Profession
- **Patent Law and Practice Committee**
- **Trademark Law and Practice Committee**
- Committee on the Legislative Oversight and the Amicus Briefs
- Committee on the License to Practice Requirements
- Committee on Litigation Practice and Procedures
- Committee on Meetings and Forums
- Nominating Committee
- Committee of Past Presidents
- Committee on Public and Judicial Personnel
- Committee on Public Information, Education and Awards
- Committee on Publications
- Committee on Trade Secret Law and Practice
- **Committee on Design Protection**
- Committee on Harmonization of Patent Laws

I urge you all to become more involved. Now that a solid activity platform has been put into place, we must now endeavor to revitalize the work of our committees. While our Association has always

experienced the circumstance where a major portion of the work is accomplished by a small cadre of members, this group has become in my view too small and overburdened. There can be little doubt that, as I experienced myself, the lure and work of the AIPLA and the ABA/IP Law Section have diluted our group of active members. Surely, any attitude which allows thinking of the nature "let the AIPLA let the ABA/IP Law Section do it" or "the AIPLA and the ABA/IP Law Section have more extensive organizations to do it better" is troubling. Our organization must continue to speak and act on behalf of our members and, in turn, the members must believe in and be committed to the unique goals and objectives of our Association.

My immediate intention is to call upon the more senior lawyers of our firms and corporations to encourage them to become more active in the Association committee work in a "supervisory" leadership role. It is crucial for the senior lawyers within our membership structure to impress upon the young lawyers the obligations to themselves and to our profession to become more involved. Understandably, young lawyers are often "suffering" under the weight of the heavy burden of their workload coupled with insufficient experience to balance "extra curriculum" activities. We must impress upon all the pressing need for the commitment of these young lawyers.

Once the commitment is recognized, the task then becomes one of communication about how to become involved. My suggestions in this regard are as follows:

1. Based upon the new committee structure and the purposes for each committee, identify the committee in which you wish to become involved. Selection can be based upon your current work interests or simply your desire to become more informed about other areas. There is no need for expertise to become involved.
2. Communicate with the chair of the committee that provokes your interest. You can obtain the name of the chair either through the *Greenbook* or through any Officer of the Association. Feel free to call other chairs to find out about the work of their committees. I encourage you to do this.
3. Request from the committee chair some specific project you can work on.
4. Suggest projects to the committee chair (perhaps from current legal research work on issues you have investigated in the past) which should be considered by the committee.

I believe that we need a more formal procedure for committee work to be monitored and reported to the Association membership, sort of a "gentle" format for deadlines to complete tasks. I think we all respond better under the yoke of a "due date." With regard to committee workings, I will ask the Board to adopt the following working and report structure:

1. By September 15, 1997, the committee chair should submit an agenda of committee projects for the upcoming year to be presented at a "kickoff" luncheon for the Association year.
2. By February 1, 1998, an initial draft report for the committee following a set format should be submitted to the Secretary, John F. Sweeney, for discussion at the February Board meeting.
3. By May 15, 1998, a final report in written form for presentation with oral commentary by the committee chair at the annual meeting, i.e., during the third week in May 1998.

With regard to the committees and chair appointments, the Board has approved that we will appoint committee chairs for a period of three years and that each rotation of all the subcommittees will be set so that any sitting President need appoint only about one-third of the committee chairpersons. Where appropriate, and I expect that this would apply to most committees, a vice-chair and sub-committee chairs will be asked to serve in order to identify and groom new chair persons.

The Board has authorized a dinner for the past presidents which will have a dual function of providing an opportunity to honor the past presidents on an annual basis and to solicit from them each year concrete suggestions for committee projects and the Association's work for the upcoming year. The dinner will be organized by our 1995-96 President, Tom Creel, and will be scheduled for sometime mid-September, hopefully before the committee chairs' "kickoff" luncheon.

With regard to the CLE function of organization, we will continue to support and focus upon our luncheon meetings, (which have been received exceedingly well), our joint CLE seminar meeting with the Philadelphia, Connecticut and New Jersey Associations and our various one-day seminars and topics of current interest. I hope that we can also schedule other CLE activities of a "how-to" nature adapted to provide inexpensive, educational forums for our senior lawyers to share their experience with our membership in general, and in particular with our young lawyers.

With regard to our support for AIPLA and ABA/IP Law Section positions and critical review of those position, I can only urge that each of you identify issues well in advance so that we can position ourselves to either initiate action by a national organization or take action ourselves.

With regard to the subject of promoting civility within our bar, the judges' dinner, as well as our CLE luncheons and joint seminars tend to foster this goal. We had, for some time, a "weekend outing" for Association members including a golf and tennis tournament, but the attendance from the Association members was poor for many years. We need to think upon how we can promote useful interaction within our bar in a more definite way. We were recently approached by the Boston IP Law Association to conduct some activities with them. In addition to our strong New Jersey, Philadelphia and Connecticut affiliation, we should promote more activity with IP law groups in nearby cities, particularly in Boston and Philadelphia.

I look forward to a very exciting Association year and I am indeed honored to serve the Association this year as President.

-- Edward V. Filardi

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## Calendar Of Events

September 8-9, 1997	Intellectual Property Owners, IPO Annual Meeting, Renaissance Hotel, Washington, DC
September 10, 1997	International Intellectual Property Association, IIPA Annual Meeting, Renaissance Hotel, Washington, DC
October 16-18, 1997	American Intellectual Property Law Association, Annual Meeting, Crystal Gateway Marriott Hotel, Arlington, VA

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## Committee Assignments 97-98

### Committee on Admissions

Chair: Edward M. Blocker (1998)

Board Liaison: Alice C. Brennan

Members:  
David H.T. Kane  
John W. Olivo  
Vincent Palladino  
Rory J. Radding  
Edward Steen  
Gidon D. Stern  
Officers and Directors

**Committee on Alternative Dispute Resolution**

Chair: Jeffrey Schwab (1999)  
Board Liaison: Theresa M. Gillis

Members  
Harold Einhorn  
Gerald Flintoft  
Murray Franck  
Thomas Gibson  
Aaron B. Karas  
John E. Kidd  
Richard Klar  
Bruce Lilling  
Robert Pearlman  
Russell Pelton  
Edward Weingram  
Walt Zielinski

**Committee on the Annual Dinner in Honor of the Federal Judiciary**

Chair: Herbert F. Schwartz (1998)  
Board Liaison: Howard B. Barnaby

**Committee on the Annual Meeting of the Association**

Chair: Gregory J. Battersby (1998)  
Board Liaison: Herbert F. Schwartz

**Committee on Antitrust, Inequitable Conduct and Misuse**

Chair: Daniel A. DeVito (2000)  
Board Liaison: Robert Neuner

Members  
Mitchell D. Bittman  
Nicholas Coch  
Richard G. Gervase, Jr.  
Mark Kesslen  
Basam E. Nabulsi  
Julie Blackburn  
Anthony C. Coles  
Harold Einhorn  
Robert Isackson  
Eric Lobenfield

**Committee on Consance and Harmonization in the Profession**  
(Young Lawyers Committee)

Chair: Marylee Jenkins (1998)  
Board Liaison: Alice C. Brennan

Members  
Dale Carlson  
Chrystal LeRoy  
Nate Levin  
Richard Newman  
Pamela Salkfeld  
Matthew Simon  
Robert Hess  
Benjamin Levi  
Dolores Moro-Gorman  
Beth Oliak  
Michael Shih

**Committee on Computers, Entertainment Law and Media**

Chair: John M. Delehanty  
Board Liaison: Melvin C. Garner

Paul Barton  
Steven Betensky  
George Cooper  
Robert Hess  
Kathleen McCarthy  
Virginia Richards  
Amy Benjamin  
Charles Brumlick  
William Guild  
Benjamin Lee  
Charles McKenney

**Committee on Continuing Legal Education**

Chair: Ira J. Levy (1999)  
Board Liaison: Edward E. Vassallo

Members  
Anthony Giaccio  
Susan McHale  
Henry Renk  
Charles Ryan  
Irving Stein  
Cecilia O'Brien Lofters  
Frank Morris  
Susan Robertson  
Evelyn Sommer

**Committee on Copyrights**

Chair: Marc D. Schechter (1999)  
Board Liaison: Marilyn Brogan

Members  
Gerald Bilotto  
Eric Doffner  
Eliot Gerber

Robert Hess  
Richard Klar  
Richard Laughlin  
Maura Leeds  
Vincent Palladino  
Susan Robertson  
Matthew Simon  
Roger Thompson

**Committee on Economic Matters Affecting the Profession**

Chair: Meyer A. Gross (1999)  
Board Liaison: Brian M. Poissant

Members  
C. Bruce Hamburg  
Milton Honig  
Edward Meilman  
Roland Plottel  
Bruno Polito

**Committee on Patent Law and Practice**

Chair: Frederick J. Dorchak (1998)  
Board Liaison: Melvin C. Garner

Members  
Julie May Blackburn  
Alan Bornstein  
Jay Chaskin  
William Frommer  
James Heilman  
Samson Helfgott  
Al Johnston  
Gabriel Katona  
Kelley Talcott  
Thomas Langer  
Bernard Lieberman  
Maria Lin  
Lloyd McAulay  
Alan Roberts  
Don Rhoads  
Thomas Smith  
Joseph Taphorn  
Berj Terzian  
Todd Wagner  
Tiberiu Weisz  
Michael Wolfson

**Committee on Trademark Law and Practice**

Chair: Eric Prager (1999)  
Board Liaison: John Daniel

Members  
Marsha Adhar  
James Bollinger

Arlana Cohen  
George Cooper  
Eric Doffner  
Stephen Feingold  
Stephen Guigley  
R. Hollwel  
Lisa Jakob  
Timothy Kelley  
Chrystal LeRoy  
Gregor Neft  
Jennifer Reda  
Susan Robertson  
Charles Ruggiero  
Ilene Tanner  
Roger Thompson  
Drew Wintringham  
Karen Wuertz

**Committee on Legislative Oversight and Amicus Briefs**

Chair: Charles P. Baker (1998)

Board Liaison: Robert Neuner

**Members**

Leora Ben-Ami  
Richard Danyko  
Alana Firester  
Lisa Jakob  
Stan Lieberstein  
Matthew Liegel  
Carmella O'Gorman  
Thomas O'Rourke  
Peter Saxon

**Committee on License to Practice Requirements**

Chair: Stuart D. Sender (1999)

Board Liaison: John F. Sweeney

**Members**

Jay Chaskin  
David Einhorn  
Eugene Rzucidlo

**Committee on Litigation Practice and Procedures**

Chair: Thomas H. Beck (1998)

Board Liaison: Theresa M. Gillis

**Members**

Sandra Bresnick  
Sidney Bresnick  
Daniel Brown  
Donald Cameron  
David Dobbins  
Tony Handal  
Constance Huttner



Eugene Ledonne  
Jeffrey Lewis  
Cecilia O'Brien Lofters  
Paul Mahler  
Bernard Malina  
Kathleen McCarthy  
Todd Noah  
Peter Phillips  
Ronald Santucci  
Alan Tenebaum  
Juan Villar  
Robert M. Wasnofski, Jr.  
Kenneth Weitzman  
Norman Zivin

**Committee on Meetings and Forums**

Chair: Susan E. McHale (1998)

Board Liaison: Marilyn Brogan

Members  
W.R. Evans  
Lana Fleishman  
Anthony Giaccio  
George P. Hoare, Jr.  
Stan Lieberstein  
James Markariau  
Leslie Mitchell  
Beth Oliak  
Allen Rubenstein  
Peter Saxon  
Barry White  
Karl Zielaznicki

**Nominating Committee**

Chair and Board Liaison: Martin Goldstein (1998)

Members  
William M. Borchard  
Albert E. Fey  
Gerald Flintoft  
Richard G. Berkley  
Edward Handler  
Siegrun D. Kane  
Thomas E. Spath

**Committee of Past Presidents**

Chair: Thomas L. Creel (1998)

Board Liaison: Martin Goldstein

Members:  
Lorimer P. Brooks  
Hugh A. Chapin  
Bert A. Collison  
Hon. William C. Conner

John Cooper  
Paul M. Enlow  
Frank F. Ford, Jr.  
William Gilbreth  
Alfred L. Haffner, Jr.  
Edward Halle  
Cyrus s. Hapgood  
Paul H. Heller  
Albert C. Johnston  
Karl F. Jorda  
David H.T. Kane  
Stanton T. Lawrence, Jr.  
Jerome G. Lee  
John B. Pegram  
Joseph J. Previto  
Harry R. Pugh, Jr.  
Pasquale A. Razzano  
John A. Reilly  
Hon. Giles S. Rich  
Albert Robin  
Andrea M. Ryan  
Peter Saxon  
Frank F. Scheck  
John O. Tramontine  
Douglas W. Wyatt

**Committee on Public and Judicial Personnel**

Chair: William H. Dippert (1999)

Board Liaison: Robert Neuner

Members:

Herbert Blecker  
Stevan Bosses  
John Cotter  
Michael Meller  
David Pfeffer  
Robert Rando  
John White

**Committee on Public Information, Education and Awards**

Chair: Mark J. Abate (1999)

Board Liaison: Edward Vassallo

Members

Nate Levin  
Carmella O'Gorman  
Bruno Polito  
Alek Szecsy  
Irving Stein  
Raymond Van Dyke  
Edward Weingram

**Committee on Publications**

Chair: Thomas O'Rourke (2000)

Board Liaison: Gregory J. Battersby

Members

Robert Becker

John Cotter

George Hoare

Marylee Jenkins

Matthew Liegel

Leslie Mitchell

**Committee on Trade Secret Law and Practice**

Chair: Robert Scheinfeld (2000)

Board Liaison: Richard L. DeLucia

Members

Edna Janet Berry

Gerald Bilotto

Anthony Coles

Donald Curry

Eric Doffner

Stephen Feingold

Stewart Fried

Richard Laughlin

Stan Lieberstein

Martin Levitin

Bernard Molldrem

Robert Sullivan

Edward Weingram

**Committee on Design Protection**

Chair: John W. Olivo, Jr. (2000)

Board Liaison: Richard L. DeLucia

Members

Peter Cannelias

Ursula Day

Robert Isackson

Maura Leeds

Jacqueline Lesser

Martin Levitan

Richard Meyer

Bernard Moldrem

Jonathan Moskin

Thomas Parker

William Sapone

**Committee on Harmonization of Patent Laws**

Chair: Anthony Zupcic (1998)

Board Liason: John Daniel

Members

William Brunet

Anthony Casella

John Dauer, Jr.

Murray Ellman  
Francis Hand  
Samson Helfgott  
George Kaplan  
Michael Meller  
Charles Ruggiero  
Pamela Salkfeld  
John Sinnott  
Morey Wildes

**NYIPLA Representative US Bar/JPO Liaison**

William Brunet  
John Pegram  
Christopher E. Chalsen

**NYIPLA Representative Inter-Bar EPO Liaison**

Samson Helfgott  
Thomas Spath

**NYIPLA Representative National Counsel of Intellectual Property Law Associations**

Martin Goldstein

**NYIPLA Representative U.S. PTO Public Advisory Committee for Trademark Issues**

Eric Prager  
Siegrun D. Kane

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## News from the Board of Directors

*by John F. Sweeney*

The Annual Meeting of The New York Intellectual Property Law Association, Inc. was held on May 21, 1997 at the Yale Club in New York City. Martin Goldstein presided. John Sweeney reported that a quorum of members, in person or by proxy (186 proxies having been received and over 100 persons attending) was present pursuant to Article VII, Section 6, of the By-Laws. It was unanimously agreed to waive the reading of the minutes of the 1996 Annual Meeting and to accept them as written.

Mr. Goldstein gave a brief report on the previous Association year. His full report will be printed in the 1997-1998 *Greenbook*. Mr. Goldstein thanked the Committee Members, Chairpersons and Board Members completing their terms for their work during the year. He made special note of the work of Howard Barnaby for his efforts in connection with the Judges' Dinner; Herb Swartz for his efforts in connection with the Annual Meeting; Greg Battersby for his efforts regarding the *Greenbook*, the *Bulletin*, and the *Annual*; and Michael Kelly and Thomas Spath for their efforts as Board Members.

Mr. Goldstein then reviewed some of the accomplishments of the Association during the 1996-97 year, including a reorganization and modernization of the Association's committee structure, the establishment of an Association web-site, the well-attended CLE programs, the work of the Public Affairs and Litigation Committees relating to educational programs in the city's public schools, and the 1997 75th Annual Dinner in Honor of the Federal Judiciary (the largest ever) and the high-quality presentations by the guests of honor, Judge Rich and Judge Conner, members of the Association.

Mr. Goldstein called for a moment to remember John N. Cooper, a Past President of the Association, who died in the past year. There was a moment of silence in honor of Mr. and of other former members of the

Association who died in the past year.

Mr. Goldstein read the report of the auditors. Upon motion by Mr. Sweeney, seconded by Mr. Barnaby, the auditor's report was unanimously approved.

Summaries of the following Committee Reports were presented orally: Admissions; Alternative Dispute Resolution; Annual Dinner in Honor of the Federal Judiciary; Antitrust, Inequitable Conduct and Misuse; Consonance and Harmonization in the Profession; Copyrights; Economic Matters; Employment; Foreign Patent Law and Practice; Harmonization of Patent Laws; Legislative Oversight and Amicus Briefs; License To Practice Requirements; Litigation Practice and Procedure; Meetings and Forums; Nominating Committee; Past Presidents; Public and Judicial Personnel; Public Information and Education; Publications; Trade Secret Law and Practice; U.S. Patent Law and Practice; and U.S. Trademark Law and Practice. Written reports which were submitted by the Chairperson of each Committee were submitted to the Association and are being maintained by the Secretary.

Resolutions amending the Association Bylaws were passed by the unanimous vote of all in attendance plus proxy votes of 183 in favor, two against, and one split vote.

The President called for the report of the Nominating Committee, which was given by Tom Creel. John Sweeney reported that no other nominations had been received. There were no nominations from the floor. Marilyn Brogan moved that the Secretary be directed to cast a single ballot for the slate proposed by the Nominating Committee. The motion was seconded by Pat Razzano and passed unanimously. As a result, the slate was declared elected by Mr. Goldstein.

Mr. Goldstein asked that the Past Presidents accompany Edward Filardi to the podium. Mr. Goldstein declared that Mr. Filardi had become President and presented him with a commemorative gavel. Mr. Filardi addressed the meeting briefly and then presented Mr. with a commemorative plaque for his term of office. There being no new business at this time, Mr. Filardi declared the meeting adjourned.

Following the Annual Meeting of the Association, the Board of Directors held its monthly board meeting. Mr. Filardi presided.

It was decided that Committee Preference Sheets for the 1997-1998 Association year will be mailed to the full membership in early June 1997.

A motion was made by Mr. Schwartz, and seconded by Robert Neuner, to hold an annual dinner of the Past Presidents of the Association. The motion was unanimously approved. Mr. Creel, immediate Past President, will be the dinner chairperson. As part of the annual dinner activities, the Past Presidents will be asked to make recommendations to the then-sitting President (this year, Mr. Filardi) as to projects for the upcoming Association year. Upon motion by Mr. Sweeney, seconded by Mr. Schwartz, the meeting was adjourned.

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## Pending Legislation

*by Edward P. Kelly*

Bills have been pending in House and Senate since 1994 that would pave the way for the United States accession to the Madrid Protocol. The Madrid Protocol is a trademark treaty among numerous European countries. The Treaty provides for the centralized filing of trademark applications in member countries. For the United States, accession to the Madrid Protocol would mean that U.S. citizens could file one international trademark application and achieve registration in all member countries. As practitioners will attest, membership in the Madrid Protocol would benefit small U.S. businesses most since trademark registration in individual European companies previously meant incurring the fees for an application in

each country and for an agent retained in each country to file and prosecute the application. The recent institution of the Community Trademark System (CTM) in Europe has somewhat alleviated this problem because it also provides for central filing.

Until recently, the legislation that would bring the U.S. into the Madrid Protocol failed in Congress because it was essentially opposed by the Clinton administration. The Clinton Administration is in opposition to entry into Madrid Protocol because the U.S. would be at a disadvantage with respect to European union voting rights. Countries in the European union had voting rights both as to the European union and as separate national governments. The Administration is currently negotiating this point.

It now appears that United State's accession to Madrid Protocol will be accomplished. The House of Committee on Courts of Intellectual Property recently approved HR.567 that would make certain amendments to U.S. law to bring the U.S. into the Madrid Protocol.

Another bill, HR 1661, would make certain changes to U.S. law to make the United States a party to another international treaty call the Trademark Law Treaty. This treaty is aimed at harmonizing trademark registration standards worldwide. This bill was also approved by the House Committee on Courts of Intellectual Property.

There are currently eleven countries which have joined the Trademark Law Treaty. The changes that would have to be made to the U.S. law to bring the United States into conformance with the treaty would involve amending U.S. law to relieve certain restrictive requirements. For instance, in order to accede to the treaty, U.S. law would have to be amended so that an assignment could be accomplished in the U.S. Trademark Office without submitting a copy of the underlying assignment document. Foreign registrations would no longer be required to be submitted in support of an application based on a foreign registration in order to receive a filing date and it would be possible to revive an application abandoned during the examination process. Practitioners who handle foreign assignments and applications for clients filing in Europe would be pleased to learn that the treaty does not allow a country to impose formalities such as notarization and authorization of signatures.

HR 1661 also contains another unrelated provision that would change U.S. trademark law. Under current case law, at least one court has held that an incontestable registration cannot be attacked on the ground of functionality under Section 14 of the Lanham Act. *See Shakespeare Co. v. Solstar Corp. of America, Inc.*, 9 F.3d 1091 (4th Cir. 1993). The Court reasoned that the defenses available against incontestable registrations are listed in Section 33 of the Lanham Act and functionality is not one of them. The new amendment to HR 1661 would amend 15 U.S.C. § 1115 to provide that functionality may be asserted as a defense.

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## Recent Decisions of Interest

by Thomas A. O'Rourke

In the Supreme Court's decision *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, \_\_ US \_\_, 41 USPQ2d 1865 (1997), the Supreme Court held that there is a rebuttable presumption that an amendment made to the claims by the patent applicant during prosecution is related to patentability and therefore creates prosecution history estoppel. The Federal Circuit, to which the case was remanded, recently ruled that a patent owner is entitled to establish the reason for a claim change where the file wrapper is unclear or silent as to the reason for the amendment, 54 PTCJ 155 (Fed. Cir. June 19, 1997). In the decision, the Federal Circuit left it up to the district court in each instance to determine the procedures for determining whether the presumption has been overcome. This could include a hearing or be based on the written record. The Federal Circuit stated:

We hesitate to specify the procedures that the district court can employ to answer the question

posed by the newly created presumption of prosecution history estoppel. The better course is to allow the district court to use its discretion to decide whether hearings are necessary or whether the issue can adequately be determined on a written record. If the district court determines that a reason not related to patentability prompted an amendment, the court must then decide if that reason is sufficient to overcome estoppel. In conducting the inquiry, the Supreme Court has cautioned the courts to consider carefully the importance of public notice and reliance on the prosecution history, as well as the need for fairness to the patentee.

## Patents

### Appellate Review of Patent Office Division

In order to facilitate the CAFC's review of decisions by the Board of Patent Appeals and Interferences, the CAFC has ruled that the Board must include in its decisions specific findings of fact and conclusions of law along the lines of Rule 52 (a) of the Federal Rules of Civil Procedure. In *Gechter v. Davidson*, 54 PTCJ 156 (Fed. Cir. June 19, 1997), the CAFC was faced with a Board decision that held that certain claims corresponding to a count were anticipated by the prior art. The Board's decision did not include findings of fact and conclusions of law but merely made a conclusory ruling regarding anticipation.

While the CAFC recognized that the Federal Rules of Civil Procedure were limited to the district courts and were not applicable to PTO Board decisions, it held that the Board must "meet an equivalent standard" to the Federal Rules of Civil Procedure. The CAFC stated:

From a practical, judicial policy standpoint, moreover, patentability (validity) issues such as anticipation, whether decided by the Board or by district courts, should be reviewed similar. If we did not require the Board to adhere to the same level of specificity in explicit fact findings and legal conclusions to support an anticipation finding, appellate review of the very same claim might produce disparate result, depending simply on which tribunal decided the issue.  
\*\*\* Our holding avoids this kind of disparity.

Nor does the standard we apply today exceed that applied to many other administrative tribunals. It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards and that failure to provide such an explanation is grounds for striking down the action.

## Enablement

The burden of proof on whether a prior art reference is enabling is on the person challenging the patent. In *Abbott Laboratories v. Diamedix Corp.*, 54 PTCJ 114 (N.D. Ill. June 5, 1997), Abbott brought a declaratory judgment action alleging that the patents in suit were invalid in view of a published Japanese patent application. Based on the Japanese patent application, Abbott brought a motion for summary judgment. The Court denied the motion on the ground that there were factual issues on whether the Japanese patent application was enabling.

Although there were material issues of fact that precluded summary judgment, the Court went on to address the burden of proof on whether the prior art was enabling. The Court held that since the patents in suit had a presumption of validity, Abbott bore the burden of proving the Japanese application was enabling. The court stated:

Since the burden is always on the challenger to show invalidity by clear and convincing evidence, \*\*\* once Abbott has shown that each and every claim is cited in the Mukojima reference, i.e., identity, Diamedix only has the burden of producing some material evidence which places the enablement of the reference in question. Once it has done so, Abbott must show by clear and convincing evidence that the Mukojima reference was, in fact, enabling.

The question not answered by the decision is the effect on the issue of enablement where the prior art relied on by the accused infringer is a U.S. patent which under 35 U.S.C. §282 is also presumed valid and therefore is presumed to be enabling.

## Trademarks

### Gray Market Goods

Gray market goods were the subject of a recent Fifth Circuit decision, *Diamond & Gem Trading USA Co., v. Martin's Herend Imports Inc.*, 54 PTCJ 106 (5th Cir. June 5, 1997). The product in question was porcelain tableware made in Hungary by Herend. The defendant was the exclusive distributor of Herend tableware in the United States. Plaintiff purchased product at Herend company stores in Hungary. The District Court found the sale in the U.S. of product bought in Hungary was a violation of §43 (a) and enjoined Diamond's sales activities. On appeal, the Fifth Circuit affirmed. According to the Court of Appeals, the tableware products sold by Diamond were gray market goods since they were not offered for sale in the United States by Martin's, the exclusive distributor. The fact that the products were genuine was not the issue. The marketing in the United States depended "not only on the 'quality' of such goods as measured in some objective or scientific sense, but on the ability to impart on the domestic consumer a view that the goods are rare, collectable, elegant, chic or otherwise desirable pieces to own." Thus, even though goods were genuine Herend products, the Court of Appeals upheld the injunction because "the foreign goods are materially different" from the product sold by the U.S. distributor.

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