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## President's Corner

It's not unusual for mention of our New York Intellectual Property Law Association to be greeted with some remark like "Oh, wow, New York runs the best Judge's dinner. I hope I get invited again this year." To be sure, we are extremely proud of our Dinner in Honor of the Federal Judiciary. While it may not be the oldest (the Chicago Intellectual Property Law Association is holding its 103rd "Dinner in honor of the Judiciary" on November 14, 1997), our Judge's Dinner is recognized by many as the premier dinner in honor of the Judiciary as compared with any jurisdiction and, for that matter, any other practice area in the United States. Notwithstanding our well-founded pride in our Judge's Dinner, the fact is that, in our ongoing Association activities, we do a great deal more to honor the Federal Judiciary as well as the judicial system as a whole. What better way could there be to "honor" our judicial system than by responding to the needs of our young lawyers, by educating our active members on current as well as fundamental legal issues and trends, by filing briefs *amicus curiae* to ensure full and impartial judicial consideration of important legal matters, and by assisting in the selection of competent and able judges. The first two months of our activities for this Association year are typical of the high level of energy and commitment of our active members and exemplify the type of events which honor our Judiciary in a direct and special way.

### Efforts Of The Young Lawyers Committee

Recently, at the Harvard Club, the Young Lawyers Committee organized the first of several panel discussions to present "practical tips" for young lawyers by experienced attorneys and judges -- sort of a "how to" on the subject of what to do and what not to do to establish a solid foundation for a career in intellectual property law. The first of these panel discussions focused on practical tips from the bar. In addition to myself, Marie Driscoll of Robin, Blecker & Driscoll, Alice Brennan of Bristol Myers Squibb, and Michael Glynn of Novartis participated in a focused discussion which, I believe, was quite well-received. On behalf of the Board, a special word of thanks to Marie, Mike and Board member Alice for their participation in this worthwhile program. We all realize that their busy schedules permit participation in this type of activity only with some sacrifice on their part, which is deeply appreciated.

The young lawyer's program itself was interesting for several reasons. Over 100 young lawyers attended (not including the young at heart, such as Al Robin): the keen interest of the attendees in knowing how each of the individual panel members came to develop their respective specialties, to achieve their current portions, and what each finds important in hiring a "young" lawyer; the networking among the young lawyers themselves during the pre-program cocktail hour; and the enthusiasm of our Young Lawyers Committee, personified by Chair, Mary Lee Jenkins, which I find energizing and infectious.

One aspect of the Young Lawyers Committee evening stands out in my mind and merits comment here. During the course of her remarks, Marie Driscoll advised the young lawyers present to seek to develop a specialty or perhaps a sub-specialty, in some area of intellectual property law, both for private practice as well as corporate attorneys, such that clients will in time come to associate the lawyer with specific knowledge and skills. A little bit later in the evening, Mike Glynn made the point that young lawyers should attempt to acquaint themselves with all aspects of intellectual property practice to develop as broad a knowledge base as possible. Were Marie and Mike saying different things? I think not. The need to develop a specialty in a given area so that an individual lawyer has a special expertise to offer in a given circumstance is certainly not inconsistent with being able to understand the broad envelope of issues that often arises in dealing with an intellectual property law matter. The former defines our individual expertise, whereas the latter enables one to grasp a better overview of the legal problem or problems at issue.

### **Efforts Of The Meetings And Forums Committee**

Also in the past two months, the Meetings and Forum Committee under Chair Susan McHale held two very successful luncheon meetings. In the first, Federal Circuit Judge Pauline Newman addressed a large group at the Cornell Club on the state of the Federal Circuit after its first fifteen years. More recently (on "Halloween"), the Honorable Phillip G. Hampton, Assistant Commissioner for Trademarks, addressed another packed house on the (hopefully not so scary) proposed changes in the trademark rules of practice. What is notable about these meetings is not only the large number of people who have attended, but the receptiveness of all present to the opportunity that the Association has provided for our members to listen to and question those persons most knowledgeable about current issues affecting our practice in significant ways. The next luncheon meeting is on November 20th when a "mystery speaker" will address the subject of "Litigation Advocacy", again at the Cornell Club. You are encouraged to sign up early.

### **Amicus Brief Filed**

While other Committee activities were proceeding at a steady pace (more next issue), Amicus Brief Committee Chair Charles P. Baker, ably assisted by Bruce M. Wexler, both of Fitzpatrick, Cello, Harper & Scinto, were putting the final touches on the Association's Amicus Brief in the *In re Zurko* case. As approved by the Board, the Association's Brief advocates that the Federal Circuit should continue to review fact finding by the Patent and Trademark Office under the "clear error" standard. The Amicus Brief in the *Zurko* case followed on the heels of the submission and resubmission of an amicus brief in the *College Savings Bank v. Florida Prepaid Post-Secondary Education Expense Board* case, which is based upon the Board's adoption of an Association position which advocates that the state entity should not be immune from suit under the patent statute.

So it is clear that as an Association we are not only quite active in a variety of different ways, but in particular, in ways which give "honor" to the judiciary and our judicial system on an ongoing basis.

On behalf of the Board, I again thank all those very active committee chairs and committee members who keep the organization running, as well as those members who support the programs that the committees and the board conduct.

I continue to encourage all members to keep an eye out for others in various aspects of intellectual property life who would benefit from membership in our Association. The application process is easily

carried out through Admissions Committee Chair Ed Blocker at North American Phillips Corporation (914-332-0222).

A happy and joyous holiday season to all.

-- Edward V. Filardi

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## Calendar of Events

### December 19, 1997

NYIPLA Luncheon Meeting, "Omnibus Patent Reform Bill" Cornell Club, New York City

### January 17-21, 1998

ABA-IPL Section, ABA-IPL 1998 Midwinter Meeting, Ritz Carlton Laguna Niguel, Dana Point, California

### January 21-24, 1998

American Intellectual Property Law Association, Mid-winter Meeting, La Quinta Hotel Golf & Tennis Resort, La Quinta, California

### January 23, 1998

NYIPLA Luncheon Meeting, "Trademark Issues Relating to the Internet" Cornell Club, New York City

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## News From the Board of Directors

by John F. Sweeney

The Board of Directors met at The University Club in New York City on October 14, 1997. President Edward Filardi presided. In addition, at the request of the Board, several committee chairpersons were in attendance, including: Charles P. Baker -- Chairperson of the Legislative Oversight and Amicus Briefs Committee; Bruce Wexler, who assisted Mr. Baker with his report; Thomas A. O'Rourke -- Chairperson of the Publications Committee; Susan McHale -- Chairperson of the Meetings and Forums Committee; Edward Blocker -- Chairperson of the Membership Committee; and Dolores Moro-Grossman -- who substituted for Thomas Beck, Chairperson of the Litigation Practice and Procedures Committee.

Upon motion by Robert Neuner, seconded by Brian Poissant, the Minutes of the September 16, 1997 Board meeting were unanimously approved. The Treasurer's report, dated September 30, 1997, was circulated. Upon motion by John Sweeney, seconded by Mr. Neuner, the Treasurer's report was unanimously approved.

Greg Battersby reported that the Association presently has no contract with Horizon Conference Center, the Association's consultants in the planning and organization of the Annual Dinner In Honor Of The Federal Judiciary. A new contract will be negotiated. In the meantime, Herbert Schwartz, Chairperson of the Annual Dinner Committee, was authorized by the Board to pay Horizon \$7,500 as a down payment as has been done in the past.

Charles Baker reported on the draft amicus brief that has been prepared in the *In Re Zurko* case. The proposed Association brief takes the position that Section 559 of the Administrative Procedure Act

preserves the clearly erroneous standard of review with respect to fact findings by the United States Court of Appeals for the Federal Circuit of Patent and Trademark Office patentability decisions. The Board unanimously supported the position advanced in the proposed Association brief. All present were invited to propose specific suggestions for inclusion in the brief to be reviewed by Mr. Baker. The final brief will be submitted for approval to Mr. Filardi and filed on or before the due date of November 3, 1997.

Mr. Filardi reported that Daniel DeVito, Chairperson of the Association's Committee on Antitrust, Inequitable Conduct and Misuse, has advised that the Committee is active. In particular, the Committee will be taking up the issue of an accused infringer's reliance (or lack thereof) on opinions of counsel. The Committee has identified at least one instance where the accused infringer may have a valid reason not to rely on an opinion. The Committee also intends to examine the state of the law regarding the true scope of the waiver of the attorney-client privilege that applies when an opinion of counsel is relied upon as a defense against a charge of willful infringement. The Committee will also report on the duty of a patent owner who, in the course of litigation, becomes aware of information that may render the patent invalid and/or not infringed. Also, the Committee will report on the Justice Department's Antitrust Division's rules on the licensing of intellectual property, as well as the treatment by the courts of inequitable conduct cases since the new Rules 1.56 and 1.57 took effect.

The report by Tom Creel on the activities of the Past Presidents' Committee was deferred. However, Mr. Filardi noted that Mr. Creel will be sending letters to the Past Association Presidents to inquire as to which committees each of them will advise.

Edward Blocker reported on the Membership Committee's drive for new members. Mr. Blocker proposed that when a new member is accepted, a letter should be sent by the Association welcoming the member. Mr. Blocker will prepare a proposed letter for approval by the Board, and John Murnane will be asked to provide the Membership Committee with an exact list of the current membership. Also, Mr. Blocker will make application forms available for distribution by members within their respective law firms.

Substituting for Thomas Beck, Chairperson of the Litigation Practice and Procedures Committee, Dolores Moro-Grossman reported on the possibility of establishing an Inn Of Court. The purpose would be to raise the standards of practice and improve civility. After the possibility of an Inn Of Court was discussed among the Board, the Litigation Practice and Procedures Committee was directed to make a specific recommendation concerning the establishment of an Inn Of Court.

Susan McHale reported on the recent activities of the Meetings and Forums Committee. Specifically, Ms. McHale reported that the September 1997 luncheon, at which the Honorable Pauline Newman of the United States Court of Appeals for the Federal Circuit was the guest speaker, was sold out and a great success. The Committee plans to continue with the program of luncheons with high-quality speakers, including possibly Senator Orin Hatch and other prominent speakers. Mr. Filardi commended Ms. McHale and her Committee on doing an outstanding job.

Thomas A. O'Rourke, Chairperson of the Publications Committee, reported that there is a full slate of legal authors for this year's Association Annual Intellectual Property Law Review. Mr. O'Rourke further reported that the *Greenbook* for the 1997-1998 Association year will be published in the next several weeks.

The report of the CLE Committee was deferred until the next Board meeting.

Upon motion by Martin Goldstein, seconded by Howard Barnaby, the meeting was adjourned.

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## Report on the Commissioner's Ad Hoc Committee Meeting

by Frederick J. Dorchak

The Commissioner's Ad Hoc Committee on Patent Policy and Projects met on September 11, 1997 at the Patent and Trademark Office. Summarized below are the highlights of that meeting.

### **Reasons For Radical Changes In Afternoon Portion Of The 1997 Patent Bar Examination**

The afternoon portion of the 1997 patent bar examination was changed from a claim drafting test to an all objective questions format. In the past, prior to the claim drafting format, the PTO had used a part objective question/part claim drafting format to test an applicant's knowledge of claim drafting principles. Then when the PTO moved away from this approach and made the afternoon portion claim drafting questions only, the time to review the exam increased. As the number of applicants for the exam increased (close to 4,000 people took the exam in August 1997) the PTO had to limit the offering of the exam to once per year.

In order to decrease the time to review the exam and in the hope of moving back toward offering the exam more often, the PTO held hearings on changing the exam format and went to an all objective question format.

Concern was expressed at the meeting that an all objective question format was not going to test an applicant's ability to draft claims. The concern was that an objective question format emphasized book learning over practice, that a beneficial part of the claim drafting portion was that applicants actually had to show proficiency in the actual drafting of claims, and that an objective question format was not as effective. In addition, some applicants who had taken the all objective question format in August reported that the test had tricky questions that did not so much test claim drafting principles as it did attention to detail. Nevertheless, the PTO indicated at the meeting that the objective questions did test an applicant's knowledge of claim drafting principles, that an objective question format actually would permit better testing of an applicant's knowledge of claim drafting principles, and that the entire change had gone through the review process before the change had been implemented.

According to PTO, complaints have been received over both formats and the PTO was certainly not trying to trap anyone with tricky questions on the new format. The PTO reiterated its view that the prior claim-drafting portion did not necessarily demonstrate an applicant's ability to draft claims and was too easy to pass by someone who did not have a broad knowledge of claim drafting principles but did certain minimum things on the exam. In addition, the PTO is looking into the use of a course for applicants to pass to better prepare them for actual practice in general and claim drafting skills in particular.

The PTO also indicated that no determination has been made regarding the recycling of questions for the exam.

### **Average Time For Issuing Patent After Fee Is Paid**

The PTO's goal is that after the issue fee is paid, no more than 100 days should pass before the patent issues. Currently, the PTO is averaging 150 days. This backlog is consistent across the various disciplines in the PTO.

### **Present Status Of PTO Services - Goals And Actual Dates As Compared To Status On June 29, 1993**

In Fiscal Year 1993, the PTO goal was 22 days from filing of a patent application for the issuance of a Filing Receipt. The 1993 monthly average was 38 days. Currently, the PTO is averaging 115 days for the mailing of the Filing Receipt.

In Fiscal Year 1993, the PTO goal and monthly average was 4 weeks prior to the Issue Date for the mailing of an Issue Fee Receipt. Currently, the PTO is also averaging 4 weeks.

An Analysis of Service Goals comparing May 1993 and August 1997 was handed out. This analysis showed that some goals had been enhanced, that in some cases, performance had improved, and that in

many cases the PTO had met its performance goals. For example, the analysis showed that the August 1997 monthly average of calendar days for recording and returning patent and trademark assignments was lower than the monthly average for May 1993. The analysis also showed that the PTO annual workload for processing requests for certified copies, assignments and trademark search library services had increased by significant percentages whereas staffing had increased only modestly (10% or less) in these areas. This analysis is planned to be published in the Official Gazette.

The PTO acknowledged that it was "behind several 8-balls" with respect to the tremendous backlog in PTO services which applicants are experiencing and hopes to improve.. The current delays were attributed to the complete changing of the PTO computerized system, including the start of a new financial and data entering system in the past 4-5 months and the training of personnel having "very extended" learning curves.

### **Operating Hours Of Attorney's Windows**

Currently, the PTO is still considering and developing plans to close at 8:00 p.m. the PTO window for the filing of papers in the PTO. According to the PTO, it is costly to maintain the window past 8:00 p.m. and the level of use is low. The window has been receiving only 2-3 customers per hour after 8:00 p.m. In lieu of keeping the window open past 8:00 p.m., the PTO is looking into a lock-box drop-off for filing of papers.

### **Errors On Official Filing Receipts Necessitating Filing Requests Of Correction**

Concern was expressed at the meeting that the problem of incorrect filing receipts was getting out of hand, that four out of five filing receipts being received were inaccurate, and that in response to requests for corrections, many times the corrections are not made and new errors are introduced. The PTO acknowledged the concern, said it was not pleased with the level the PTO is performing at and is still working on the problem, and promised that those types of errors should not happen as frequently in the future.

Currently, all filing receipts are coming out of the Applications Branch. In the future, corrected filing receipts may be coming out of the Group Art Units. The PTO is also taking a serious look at reinstating the OG notice as to the status of cases.

### **Delays In Receiving Official Filing Receipts For Provisional Applications**

The PTO acknowledged that it was well behind in the obvious goal to issue filing receipts promptly for all cases, not just provisional applications, noted that extreme cases existed where filing receipts are exceptionally delayed, and attributed the delays to lost cases and software problems.

### **Change In Procedure Regarding Issuance Of Filing Receipts**

Concern was expressed at the meeting that the practice announced in the June 10, 1997 Official Gazette did away with the long-standing practice that the issuance of a filing receipt was both (1) a reliable indicator that the initial processing of an application was complete and (2) evidence of completion of filing formalities. The PTO is now sending out the official filing receipt as soon as certain minimum requirements are met, rather than later when all filing formalities are completed.

The PTO explained that this change was designed to accelerate the time for issuing filing receipts in order to get filing receipts out as quickly as possible so as not to delay, for example, the issuance of foreign filing licenses.

### **Delay In Return Of Postcard Receipts Attached To New Patent Applications**

Concern was expressed at the meeting that postcards attached to newly filed cases are arriving with

unprecedented delays, that 12 weeks delay was considered routine by the PTO Mail Room, and that receipt of postcards within 6 weeks was considered unusually fortunate.

The PTO advised that it had just moved resources into the "front-end" of the filing process and applicants should start seeing improvements. In July, postcard returns were taking up to 3 months; now it takes less than 3 weeks, and the time should be 1-2 weeks by the end of September as a direct benefit of additional resources at the front end. According to the PTO, 6 week delays should not happen.

### **Delay In Forwarding To Examining Groups Responses To Final Rejections Addressed To Box AF**

Concern was expressed at the meeting that the forwarding of responses to final rejections has been slowing down.

The PTO advised that there should not be a delay and that the PTO opens envelopes addressed to Box AF and sends them to the Examiners within 2-3 days of receipt. The PTO cautioned that the envelope must indicate Box AF to get this expedited treatment. Also, if other papers are included with papers marked Box AF, processing of these papers will be delayed.

### **Problems In Public Search Room**

The PTO acknowledged that problems existed in the public search room and stated that the PTO needed to take some action. For example, certain members of the public, such as Rapid Patent employees, have been reportedly cutting certification ribbons from certified applications in the files to hasten the copying process. Cutting the ribbons defeats the purpose of the ribbon to maintain the integrity of the file.

In response, the PTO is publishing a rules reminder which will be published soon. They have written Rapid Patent (now Derwent) in its Arlington office asking that their employees obey the rules. The PTO also will take action with respect to any specific episode reported to it. The PTO has tremendous concern over the treatment of file wrappers and believes that previous resources did not permit taking adequate safeguards.

As a quick step to combat the problem, the PTO is consolidating the photocopiers near the location where the files are kept. The PTO also envisions placing more controls over the number of file wrappers checked out at a time by a person and issuing new user passes, perhaps with photo ID. In implementing these controls and clamping down on past practices, the PTO would appreciate any support the bar associations and patent organizations can give them.

In addition, the PTO is looking at other media imaging systems (e.g. CDs) to maintain the integrity of the file wrapper.

Concern was also expressed over the delay in making the latest OG available at the PTO. OGs are delivered Tuesday mornings and are supposed to be made available by 12:00 noon, but are often not available until after 4:00 or even the next day.

The PTO stated that it makes every effort to get the OGs out on time, and the situation is being monitored. Prompt availability of the OGs depends on the Government Printing Office. If the GPO is behind, the PTO is behind.

Concern was also expressed that certain users of the public search room are receiving favorable treatment. The PTO advised that this perception was a misconception. In general, the PTO does not let members of the public behind the counter to retrieve files. However, when the file is large, the PTO puts it in the back and allows the requesting member of the public to retrieve it.

Concern was also expressed over the contractor the PTO is using; however, this contractor is the same one the PTO has been using for 9 years, has extensive experience, and has increased his staff. In addition, the

PTO Patent Management Team is taking steps to identify old files to be destroyed in order to help resolve the space problems.

The PTO also acknowledged that a large problem currently exists with the retrieval of files due to the new PALM system still being worked on and a lack of space causing PCT and provisional applications to be stored in the warehouse. The PTO has received permission to get more space and is planning a Fall 1997 occupancy in a new storage location.

Regarding concern over inadequate results from Official Searches, the PTO advised that it is tracking this problem and is trying to come up with a systems approach whereby the first person to request a file will receive it first. According to the PTO, Official Searches currently locate approximately 30% of the missing files requested.

An inventory of all PTO files is approximately 60% completed. The misfile rate is in the 0.5-1% range. When the inventory is completed, the PTO hopes to have a big improvement in locating files.

### **Automation Questions**

The question was raised as to the reasons for, the status of, and the financing sources of Project Nos. 20 (electronic filing), and 20.1 (trilateral computerization of application texts).

These two projects deal with an Internet-based system for the electronic filing of applications and a document exchange program whereby priority documents could be exchanged with WIPO.

Currently these projects are dealing with technical security issues concerning the use of encryption and digital signal technology. The Government Information Technical Services ("GITS"), an inter-agency Task Force which brings together the various expertise throughout governmental agencies, will suggest what products to use for encryption. Currently, an advisory group is developing prototypes that hopefully will be incorporated into a PTO system.

The PTO advised that the Treasury has provided \$350,000 in funding for each project. The study of these projects is providing the PTO with a lot of information on security systems in transmitting documents. A report is due in December 1997.

### **New Roster For Patent Management Line-Up Due To New Selections And Director Transfers**

The PTO advised that a new roster exists for PTO Directors and appears in the Official Gazette. Currently, the OG does not include Deputy Directors on the roster, but will in the future.

### **Status Of Re-Engineering At PTO For Creating Six Sectors**

One of the five patent goals in the Strategic Plan is to move the various PTO disciplines into "fully integrated industry sectors." The PTO hopes to begin implementing this change in Fall 1997 and probably will complete it in close to 6 months.

The PTO plans to provide a notice in each pending case of the new applicable Sector assigned to that particular case in place of the former Group designation. In some cases, as many as four Groups will form one Sector. According to the PTO, the change will not "necessarily" delay First Office Actions and should help make things better despite some "paper-matching" problems from Group to Sector. The timing of a First Office Action varies from technology to technology, and the PTO does not see the reorganization into Sectors to cause more of a problem.

### **Problems With File Information Units Presorting Mail To "Boxes"**

Concern was expressed at the meeting that the PTO "Box" designations according to which communicants

with the PTO are expected to presort the mail, are an illogical, counterintuitive, and difficult-to-remember jumble. Merely numbered boxes are mixed with boxes with a title entirely in words.

Again, the PTO emphasized that only material designated for a particular box should be sent to that box; the material should not be mixed with other filings in the PTO.

### **Problems With File Information Unit**

Concern was expressed that the personnel in the record room are belligerent, rude, and lazy. The PTO advised that it may consider using public survey cards on the rudeness of officials. The PTO has mid-year and annual appraisals and will correct any problems with a particular individual.

Concern was also expressed regarding many apparent computer problems in ordering files from the warehouse. For example, it was reported that ordered files are dropped from the system and never obtained or are spontaneously sent back. The PTO advised that it has no control over the warehouse and retrieval takes time. Searching for files may take months, years. The PTO, however, is continually looking for files.

Concern was also expressed that interference files which are terminated are impossible to retrieve; however, the PTO advised that the interference files are in better order than the PTO's other files. The PTO attributed delays in retrieval of files to space concerns and computer problems.

According to the PTO, up until about a year ago, the PTO's PALM system said that interference files were located at the Board, but in fact these files were really in the warehouse. The Board has requested that all public copies of interferences should be ordered from the Certification Branch. The PTO is working to tighten up procedures for logging interference files in and out of the PALM system. Currently, if an interference is pending, the file is in the control of the Office of Public Records. If an interference is terminated, the file is in the control of the File Information Unit. Very often files are with the Judge and difficult to obtain. The average time of retrieving a file from the Board is 38 days.

### **Missing Patent Files**

Last year, the Certification Branch reported that over 500 requests for reconstruction of files had been ordered. This year, the Certification Branch has about 90 requests of which 20 are for pending cases. (The PTO does not count in the number of requests "informal" reconstructions).

When a file is reconstructed, the file receives a new file jacket and a new bar code. In attempting to reconstruct a file, the PTO asks the attorney of record or pro se applicant to provide copies. Letters are sent to the address of record. If the letter is returned by the Post Office, the PTO closes out the case. The PTO does not keep requests for reconstruction open indefinitely. Once the process is completed, the PTO "activates" the file, and the public can determine what steps were taken and the results.

### **Assignments Of Nonprovisional Applications**

The PTO advised that where an applicant assigns both the invention and the provisional application itself, a new assignment is not necessary when a nonprovisional application based on the provisional application is filed.

### **Inappropriate Form Paragraphs Used By Examiners**

Concern was expressed over the following "standard" paragraph issued by an examiner in an office action:

"Claims . . . are rejected because it claims a species within a genus. It is not clear if or how the narrow specie limits the broader genus. Applicant utilizes the phrase 'and/or' in defining the unsaturated fatty acid used in the reaction. The alternate expression 'or', is distinguished because there is no question of limiting

the broader genus, it is the use of 'and' that renders the claim indefinite."

To add to the confusion, there apparently appeared no "or" or "and/or" in any claim.

The PTO advised that this paragraph was not an Official Form paragraph, and Examiners are discouraged from making up their own standard paragraphs. Any problems in an Examiner's Office Action should be indicated in the response to the Office Action.

### **Status Of Patent Rule Changes Re: Implication Of Patent Procedures**

The PTO advised that the Final Rule Package has been forwarded to Congress and to the OMB for approval. The approval has not yet been received but should come by September 22, 1997. The Final Rules will then be published by the end of September in the Federal Register and the third week of October in the OG. It is possible that the rule package will be effective in the third week of November.

The PTO has developed a full package of training materials on the new rule package for the Examining Corps and the support staff. The support staff will be trained before the effective date of the rule package and the Examining Corps will be trained at approximately the same time, perhaps after the effective date.

The PTO has received a number of suggestions from the various Bar Groups and has not adopted many of the controversial items into the Final Rule, as follows:

(1) The proposed change to §1.91 which was to strictly prohibit models and exhibits (unless required by the Office) is not being adopted. Instead, a model or exhibit (not required by the Office) will be admitted into the record if: (1) the model or exhibit meets the paper size/standard requirements for application papers (§§1.52 and 1.84); or (2) a petition to admit the model or exhibit into the record is granted.

(2) The proposed elimination of §§1.104, 1.105, 1.181(a), (c), and (g), 1.325 and 1.351 is not being adopted.

(3) The proposed changes to §§1.113 and 1.116 to streamline the after final practice, and not permit first action finals in continuing applications, are not being adopted.

(4) The proposed change to §1.121, concerning the manner of making amendments in reissue and in reexamination proceedings are being adopted; but not the changes concerning the manner of making amendments in non-reissue applications.

(5) The adoption of a final change to §§1.176 and 1.177 is being held in obedience pending further consideration of the recent decision in *In re Graff*, 111 F.3d 874, 42 U.S.P.Q. 2d 1471 (Fed. Cir. 1997). *Graff* involved two issues: (1) whether it is permissible to have a continuation of a reissue application when the reissue application has issued as a reissue patent, and (2) whether broadened claims can be presented more than two years after the original patent date in a reissue application which was filed within two years but included no broadened claims.

(6) The proposed change to §1.193 to require a substitute appeal brief rather than simply a reply brief is not being adopted.

The PTO hopes to publish an article in the October-November JPOS discussing the Final Rules.

In addition, the PTO has come up with several ways to disseminate information concerning PTO rules and procedures. The PTO has a Web Site containing information in Question and Answer format, summaries, and PTO forms. The PTO also offers some information (e.g. forms) for sale either in notebook form (price: approx. \$25 - \$35) or in CD form. A notice in the OG will provide information concerning

availability of these materials.

The PTO also has planned for October 1997 presentations on the new rules. For example, at an October 17, 1997 AIPLA meeting. Magdalen Greenlief of the PTO will speak for about an hour on the new rules.

The PTO forms have been revised to make them user friendly. Use of the forms continues to be voluntary.

In addition, the PTO will take a liberal view with regard to continuing prosecution application procedure. The PTO will continue to accept filings under Rule 60 and Rule 62 even under the new rules.

### **Format Of Certified Copy For Priority Claim**

35 U.S.C. 119(b) requires the submission of a certified copy of the original foreign application. The PTO will accept certifications made by the Patent Office in which the foreign application was filed, but will not accept a foreign priority document from WIPO. The PTO does not consider that the WIPO makes any certification.

### **Proposed Format For Next Ad Hoc Committee Meeting**

The suggestion was made that the PTO consider devoting either one of the regular Ad Hoc Committee meetings, or a special meeting in addition to the twice-a-year meeting custom to a single topic, namely patent examining practices (e.g. examiner behavior, attitudes, customs, practices, training, continuing education, and supervision).

The PTO advised that this proposal could not be implemented under law without compliance with the Federal Advisory Committee Act ("FACA"). Currently, the Ad Hoc Committee is "FACA-exempt." If the Ad Hoc Committee were to have an input in the decision-making and policy development process, the FACA procedures for selecting Committee Members involving competition for participation and other procedures would have to be followed.

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## **Pending Legislation**

by Edward P. Kelly

### **PATENTS**

An Omnibus Bill addressing several patent issues has been pending in Congress for over a year. The issues addressed in the bill include greater third-party participation in re-examination proceedings, a prior use defense, publication of patent applications 18 months after filing and a change in the business organization of the U.S. Patent Office. These proposed amendments to the patent law were initially driven by the mutual understanding agreement signed between Japan and the U.S. Patent Office in 1994. That agreement called for the U.S. to make certain revisions to U.S. patent law in exchange for Japan's agreement to allow foreign nationals to file patent applications in English.

Five former PTO Commissioners have now voiced support for a new Omnibus Bill (S. 507) introduced in the Senate by Senator Orin Hatch (R-Utah). The Senate Omnibus Bill contains provisions substantially similar to the provisions of last year's House Omnibus Bill.

### **Re-examination Proceedings**

The patent statute currently provides that a third party may request re-examination of a patent. However, the third-party's participation currently does not go beyond the initial request for re-examination and a reply to the patent owner's statement in response to the request for re-examination. For instance, amendments made to the claims during re-examination may not be addressed by the third party which

requested re-examination.

The Senate Omnibus Bill would make certain amendments to the re-examination statute and give a third-party a greater role in influencing the outcome of the re-examination. The final version of the House bill debated last Spring deleted the provisions regarding re-examination.

The Senate bill would allow the third-party requester to not only comment on the patent owner's response to re-examination, but also to address the issues raised in the Patent Office during the re-examination procedure. The basis for re-examination would also be expanded to include compliance with Section 112 of the patent statute. A third-party requester would also be able to file an appeal of the examiner's final decision with the Board of Patent Appeals and Interferences. Supporters of the Bill argue that expanded re-examination proceedings could replace expensive litigation.

## **Prior Use Defense**

As a general rule, a company that protects its technology by keeping it a trade secret does so at its peril because it could be liable for patent infringement if someone obtains a patent on that technology. The Omnibus Bill would change that result by amending the patent statute to provide for a limited defense to patent infringement where the alleged infringer made prior use of the patented invention. Many of the U.S. trading parties now afford a prior user defense to patent infringement.

The Bill would amend § 273 of the patent statute to assert a defense to patent infringement if the person had, acting in good faith, commercially used the subject matter in the U.S. before the effective filing date of the patent. "Commercially used" means use in the U.S. in commerce whether or not the subject matter at issue is accessible to or otherwise known to the public. "Use in commerce" means any actual sale or commercial transfer.

There is also a special exception for subject matter that cannot be commercialized without significant investment of time and money. In that case, a person shall be deemed to have commercially used the subject matter if:

(A) before the effective filing date of the patent, the person reduced the subject matter to practice in the U.S., completed a significant portion of the total investment necessary to commercially use the subject matter and made a commercial transaction in the United States in connection with the preparation to use the subject matter and (B) after the effective filing date of the patent, diligently completed the remainder of the activities and investments necessary to commercially use the subject matter and promptly began commercial use of the subject matter.

While a literal reading of the bill indicates that the use or reduction to practice must occur before the effective filing date of the patent, the bill is not that broad.

A later section of the bill entitled "one year limitation" provides that the defense provided by the bill is only available if the use or reduction to practice occurred more than one year prior to the effective filing date of the patent.

The bill would specifically add a section stating that the defense does not constitute a general license but only applies to subject matter claimed in the patent that the person asserting the defense had commercially used before the effective filing date.

## **Publication of U.S. Patent Applications After 18 Months from Filing Date**

The United States converted to a patent term which expires 20 years from the filing date as part of its accession to the GATT treaty. Many of the countries that are signatories to the GATT treaty publish patent applications 18 months after they are filed. The U.S., however, currently does not publish patent

applications prior to issue of the patent. The Senate Omnibus Bill would bring the U.S. into conformity with those countries that do provide for publication 18 months after filing. The published application would be considered prior art under § 102(e) of the patent statute.

The publication provisions were the most disputed of the Omnibus Bill when the House held hearings last Spring. Opponents of early publications argued that publication in the U.S. prior to issuance of the patent hurts small businesses because it provides large corporations an opportunity to steal and use inventions prior to the time a patent issues.

The Senate bill now gives the applicant -- not filing abroad -- the right to choose whether the application will be published 18 months after filing. Those applicants which choose publication would be able to receive a reasonable royalty from infringers calculated from the date of publication.

### **PTO As Government Corporation**

Another issue addressed in the Omnibus Bill relates to the status of the U.S. Patent and Trademark Office. The bill would convert the PTO into a government corporation. The Senate bill would create the PTO as a government corporation run by a Director appointed by the President. However, the Senate Omnibus Bill does not address the issue of whether Congress should be able to divert patent user fees to reduce the general budget deficit -- as Congress is now doing.

## **COPYRIGHTS**

Under the 1909 Copyright Act, a publication of a work without copyright notice automatically placed the work into the public domain. In most instances, music published on sound recordings did not contain copyright notice, partially because the prevailing opinion was that distribution of sound recordings was not a publication of the music contained on recordings. In *La Cienega Music Co. v. Z Z Top*, 53 F.3d 959 Cir. 1995, cert. denied, 116 S.Ct. 331 (1995), the Ninth Circuit held that the distribution of sound recordings to the public was a "publication" of the music recorded on the sound recordings. Therefore, the Ninth Circuit's decision eliminated copyright protection for music contained on sound recordings that did not contain a copyright notice for the music.

A bill (H.R. 2265) would change the result in *La Cienega* by expressly amending the Copyright Statute to provide that the pre-1978 sale of sound recordings shall not constitute a publication of the work it embodies.

### **Criminal Copyright Sanctions**

H.R. 2265 and another copyright bill were recently approved by the House Judiciary Committee. The other bill (H.R. 1967) would add new criminal sanctions for illegally reproducing copyrighted works by electronic means. This bill would close the loophole in the existing law that required proof of financial gain be submitted to prosecute a person who assisted others in downloading copyrighted programs.

### **Copyright Term Extension**

A bill introduced by Rep. Coble would extend the copyright term to the life of the author plus 70 years.

### **Protection for Boat Hull Designs**

Bills have been introduced in Congress over many years which would grant protection to the industrial designs that did not qualify for patent or copyright protection. In the many years in which they have been introduced, however, none have been passed. The manufacturers of after-market auto parts were often cited as the most serious opponents of protection for industrial designs, presumably because the original equipment manufacturers would be able to exclude them if protection were available.

A new bill is pending that is limited only to the design of boat hulls. The bill was introduced by Rep. Howard Coble (R.- NC) (H.R. 2696) and would amend Title 17 to create ten years for protection of the design of boat hulls. The bill would effectively overrule those cases holding that the patent law preempts a state from passing a law granting patent-like protection. See *Bonita Boats, Inc. v. Thundercraft, Inc.*, 49 U.S. 141 (1989). The protection would be provided to original designs of vessel hulls which are attractive and distinct in appearance. The bill is not intended to cover any design which is purely functional. Anyone infringing a protected design without knowledge that was protected would not be liable. The application for protection would have to be filed with the Copyright Office within a year that the design was first made public. Upon introduction of the bill, the Registrar of Copyrights made several comments in the nature of clarifying language that should be added to the bill. In particular, the Registrar of Copyrights noted that the Copyright Office would not be conducting prior art searches to determine if a design is original and that protection could not be afforded to a design if that design was the subject of a copyright registration.

### **Markey Bill**

A bill (H.R. 824) is pending in the House that would name the Washington headquarters of the Federal Circuit after Judge Howard T. Markey. A bill (H.R. 824) is pending in the House that would name the Washington headquarters of the Federal Circuit after Judge Howard T. Markey. A bill (H.R. 824) is pending in the House that would name the Washington headquarters of the Federal Circuit after Judge Howard T. Markey, the Court's first Chief Judge.

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## **Invitation for Discussion Regarding the Patent System**

by Gabriel Katona

We learned from our elders that the great and enduring success of the 1952 Patent Act was above all due to the fact that it was patiently developed through the widest possible consultation within the patent profession. This is of particular relevance today, when finding ourselves suddenly confronted with new, fundamental patent legislation, imposed and still being imposed in an undue and unseemly haste, in an express and peremptory manner without the proven deliberate and deliberative manner in which the 1952 Patent Act was drafted and promulgated. Today American patent applicants appear to be in the same condition in which Charles Dickens found British inventors over a century ago as commemorated in his *Poor Man's Tale of a Patent*:

"Thereby I say nothing of my being tired of my life, while I was Patenting my invention. But I put this: Is it reasonable to make a man feel as if, in inventing an ingenious improvement meant to do good, he had done something wrong? How else can a man feel, when he is met by such difficulties at every turn? All inventors taking out a patent MUST feel so. And look at the expense. How hard on me ... , to put me to all that expense before I can move a finger!"

The purpose of this invitation is to provoke a thorough and comprehensive discussion and review by all patent professionals and other interested parties regardless of any membership in a professional association, to provide their thoughts and opinions and suggestions about where we are, and where we should be looking to go to provide a better U.S. patent system for all of its users in the future. This broad based approach is sought to replace the kind of legislative initiatives by which the present Administration, more than any other before it, appears driven by controversial instant "reforms" which in the opinions of many could reduce the real value especially of U.S. patents. This effort does not aim for reaching any consensus, because the only and unambitious "ground rules" of the project are to recognize that widely discussed solutions based on consensus and an occasional inevitable compromise, are better than legislation imposed by narrowly unconsultative fiat, and also that more than one solution may coexist for a diversity of objectives.

It is felt that the requested input should be directed to the objective of improving the patenting process for applicants for United States patents and for applicants primarily from the United States, and that the input to this discussion should not be constrained by considerations of any international patent law "harmonization" objectives, or any international cost reduction objectives that are not germane to the present effort. The reason for this suggestion is that substantive patent law harmonization (in contrast to cost saving and simplifying procedural simplification by harmonization), should be at this time primarily of interest to continental organizations composed of individual smaller country entities, especially if they aspire to some form of confederated existence, such as the European countries. Increased continental harmonization, including a uniform patent regime, has been tried with not much success so far by many European states for over 25 years, and they all envy the kind of institutional uniformity, including our uniform patent system, throughout our confederation of the 50 states. Substantive patent law harmonization within North America or within the NAFTA countries, could be a logical next step for us in the more remote future. However, today and in the foreseeable future of the 21st Century, the United States should be concerned with what its domestic applicants consider to be the best for American applicants and for the U.S. public, regardless of the laws of any other countries. Any international substantive patent law "harmonization" in the United States could be of interest only to foreigners, and possibly to a few U.S. multinationals to whom a U.S. patent portfolio is not of primary importance, because they are more concerned with obtaining foreign patents. Therefore, patent legislation should not be shaped by the trivial pursuit of "deals" such as complying with the desire of a foreign country to increase their high technology imports into the United States sooner by shortening the term of the most important U.S. blocking patents, in "exchange" for securing the possibility of late filing by 2 months a translation of patent application into the native language.

The suggestion is to start this broad based discussion by considering the most important and most urgent question of how the starting and overall costs of the entire patenting process could be reduced to applicants and the public. Under the current patenting system, most ways of saving unnecessary expenditures downstream can take place only after much or most of the patenting costs have already been incurred by applicants. Therefore, the logical way to accomplish greater cost savings appears to require as much of a reduction as possible, in the nature and magnitude of initial official fees, and some of the initial involvement of patent professionals, thus to back end load the patenting process to the maximum possible extent.

This also takes into account that many more patent applications are prepared and filed than will ultimately become highly useful and therefore valuable. For that reason, many patent applications are abandoned either before they issue, or by failure to maintain the patents.

Solutions should also take into account that many, possibly most, initially commercially successful patents have a shorter commercially viable life than the full available patent term, and also that applications relating to complex and/or technologically advanced subject matter require much longer times to be examined before they issue. It should also be considered that many patents on valuable inventions, such as on many pharmaceuticals, become valuable only later and are not much affected by pendency delays, but they are the most valuable on the day before they expire.

Another important factor to consider is the increasing realization (except by those who are engineering the recent patent legislation) that R&D in the large industrial sector (possibly excepting the research-based pharmaceutical industry) is becoming less "R" and more "D", with an increasing reliance on trade secrets. Japan has led this trend, and it has now also occurred in the United States. This also results in basic patents becoming less significant to large industrial companies and their patents are generally less important and less valuable, with an ever shorter useful life. High technology is becoming the province of small companies and of venture capital, whose interests should receive more attention. Regrettably this trend is being accelerated by the current legislative efforts in this country, which erodes the value of U.S. patents, such as by the elimination of a minimum patent term, and also the introduction of prior user rights which primarily favor the large industrial sector with its decreasing reliance on the patent system as a source of benefits when compared to its costs.

The following two alternatives are suggested only to kick off the discussions, rather than as thought-out recommendations for future implementation. These potential general patenting schemes are envisioned as coexistent alternative choices with the current patenting process, or a cooperatively improved version thereof. These further alternatives are not offered for the reason that they happen to be available in some other countries, but only, because they offer alternative ways of shifting much of the social and ultimately private cost of patenting toward the back end of the patenting process, by which time the commercial viability, and thus the true value of the invention, will permit its owners to make better informed and less costly choices.

The present system, with possible improvements, would seem to be the logical choice for those applicants that file patents for the licensing or sales value of the technology, or are otherwise ready for its immediate exploitation. A choice of two further new alternative options is envisioned here, in which applicants could choose instead of the current patenting procedure, between the following two modes that one which seems to them as most suited for their purposes, by either substantially delaying examination, or by entirely skipping pre-issuance examination.

The first of the two additional herein envisioned patenting choices is a deferred examination option with an earlier publication to take place after a period that appears agreeable to most U.S. applicants. Under this choice, the applicant may elect to defer examination in the manner of a provisional patent application but with a much longer life. A deferred examination system happens to be available today in Canada, Germany and in Japan where the applicant may choose to delay the examination of a patent application by 5 years in Canada\*, and by 7 years elsewhere. Thus, much (if not most) of the patenting costs to applicants can be delayed by them to a later time when they will actually know whether the patent will be really worth the further expenses of its examination. In the meantime, the priority of their invention remains preserved. Third parties may also request examination. Of course, no provisional protection should be available for much or most of the voluntarily delayed period. With this option it could be an improvement to consider the benefits of providing for a minimum patent term after the request for examination or from issue, with an alternative of a fixed number of years from initial filing or from the date of a claimed right to priority.

The last, even more radical option would be proceeding directly to the registration of the patent without any pre-registration examination. This registration would provide a recognition of a prima facie priority cum defensive publication. In that case, as is done in a number of countries which have such systems, the protected scope of a patent would be determined only at a time when a patent is sought to be enforced. The Patent Office (possibly in collaboration with the infringement defendant) would make a provisional determination of the scope of the protectable invention, which would then be fully decided as part of the enforcement action in an inter partes procedure by the court. This alternative might even provide for a rare preliminary injunction, but only after a provisional determination in the Patent Office.

Therefore, please let us have your comments and suggestions to permit us to determine whether to formalize the activity for the planning of a fundamental review of the U.S. patent system. Send your views to Gabriel P. Katona, 230 Park Avenue, Suite 2200, New York NY 10169.

\* The seven year maximum deferral period was reduced in Canada by two years as of October 1, 1996, because when the approximate two-year usual period for the issuance of a first Office action is included, the actual deferral became nine years.

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## Recent Decisions of Interest

by Thomas A. O'Rourke

## PATENTS

### On Sale Bar

Section 102(b) was the basis for a summary judgment of invalidity in *Evans Cooling Systems Inc. v. General Motors Corp.*, 54 BNA PTC 433 (Fed. Cir. 1997). In *Evans*, the Federal Circuit affirmed the invalidity ruling of the district court that GM, the accused infringer, placed the invention on sale prior to the critical date. The Court relied on a June 1991 order for a 1992 Corvette placed with a GM dealer. The dealer transmitted the order to GM after receiving the customer's deposit prior to the critical date. Evans reduced his invention to practice in 1986 but did not file a patent application until July 1992. The 1992 Corvette had an engine with the patented cooling system.

Evans argued that GM's denial of infringement was an admission that the Corvette engine did not anticipate the patent claims. This argument was rejected by the CAFC which concluded that GM's burden of proving the Corvette's engine anticipated the patented invention was met by Evans claim that the engine infringed the patent.

The order by the customer was also challenged as being insufficient to trigger the §102(b) bar. However, the order satisfied the three criteria for a 102(b) bar: "(i) there is a specific and definite offer for sale; (2) of a successfully tested device embodying every limitation of the patented invention; and (3) the sale is for commercial purposes."

The CAFC also rejected Evans' claim that §102 should have an exception so that an offer for sale does not invalidate a patent where the offer stems from a third party secretly stealing an invention while it is a trade secret. The CAFC rejected this argument because the activities that created the bar in the *Evans* case were not instigated by the person who stole the invention. In the *Evans*' case, neither the purchaser, who placed the order nor the dealer who received the order, had any knowledge or participation in the alleged theft. Evans' remedy was thus a state court action for misappropriation of trade secrets not patent infringement.

## **Claim Interpretation**

A jury verdict of infringement was reversed by the CAFC in *Strattec Security Corp. v. General Automotive Specialty Co.*, 54 BNA PTCJ 439 (Fed. Cir. 1997). The Federal Circuit held that the district court erred in its claim interpretation because the terms "conductive sheet material" and "conductive sheet-like material" were clearly limitations as used in the specification. The district court also erred in not properly interpreting the term "sheet" as being no different from "round wire which had been thinned." Since the use of a sheet material was the distinction over the prior art, this distinction could not be eliminated by the district court in construing the claims. Thus, the Federal Circuit concluded: "We owe no deference, however, to a jury verdict reached upon an improper claim construction when, as is the case here, the correct construction of the claims is dispositive of the issue of infringement."

## **Expert Testimony**

Although experts in patent infringement cases may give their opinion on the ultimate issue in the case without providing the basis for the opinion, the district court is under no obligation to accept that opinion. In *Rohm & Haas v. Brotech Corp.*, 54 BNA PTCJ 607 (Fed. Cir. 1997) the plaintiff contended that its expert's opinion on literal infringement established a prima facie case and that Brotech had the burden of rebutting that prima facie case. The Federal Circuit rejected this argument and concluded that while the expert's testimony may be conclusory, there is nothing that requires the district court to accept these unsupported assertions by the expert.

## **ANTITRUST**

### **Refusal to License**

The Ninth Circuit recently addressed the issue of antitrust liability for a company's refusal to license patent rights or copyrights in *Image Technical Services, Inc. v. Eastman Kodak*, 44 USPQ 2d 1065 (9th Cir.

1997). In the ITS case, Kodak refused to license photocopying and micrographics equipment which had thousands of parts. Only 65 of the parts were patented.

Without discussing the importance or lack of importance of the 65 patented parts, the Ninth Circuit distinguished the Kodak refusal to license from the cases where the refusal to license was only for the patented product. See *United States v. Westinghouse Electric Corp.*, 648 F.2d 642 (9th Cir. 1981) and *Zenith Radio Corp. v. Hazeltine Research, Inc.* 395 U.S. 100 (1969). In *Westinghouse*, the Ninth Circuit held that: "[t]he right to license [a] patent, exclusively or otherwise, or to refuse to license at all, is the 'untrammeled right' of the patentee."

The Kodak court affirmed the jury's verdict of an antitrust violation in part, because Kodak's refusal to license extended to unpatented parts.

## **COPYRIGHTS**

### **Derivative Works**

The issue of whether ceramic tiles bearing artwork were derivative works was recently before the Seventh Circuit in *Lee v. A.R.T.*, 44 USPQ 1153 (7th Cir. 1997). The plaintiff created artwork for notecards and small lithographs. These works were sold to defendant by plaintiff's firm. Defendant A.R.T. mounted the works on ceramic tiles and covered the tiles with an epoxy resin. A.R.T. then resold the tiles.

Plaintiff contended that the tiles were derivative works which cannot be made without the owner of the copyright's consent under 17 USC §106(2). The statute defines a derivative work as follows:

A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'

Analyzing the statute, the Seventh Circuit concluded that the tile was not an art reproduction or any of the other specific examples in the statute. Then the Seventh Circuit turned to the residual phrase of the statute: "any other form in which a work may be recast, transformed, or adapted."

### **The Court of Appeals stated:**

None of these words fits what A.R.T. did. Lee's works were not 'recast' or 'adapted'. 'Transformed, comes closer and gives the ninth circuit some purchase for its view that the permanence of the bond between art and base matters. Yet the copyrighted note cards and lithographs were not 'transformed' in the slightest. The art was bonded to a slab of ceramic, but it was not changed in the process. It still depicts exactly what it depicted when it left Lee's studio.

Thus, there was no infringement of Lee's copyright.

The Seventh Circuit's conclusion is at odds with two earlier cases. See *Munoz v. Albuquerque A.R.T. Co.*, 829 F.Supp. 309 (D. Alaska 1993), *aff'd*, 38 F.3d 1218 (9th Cir. 1994) and *Mirage Editions Inc. v. Albuquerque A.R.T. Co.*, 856 F.3d 1341 (9th Cir. 1988).

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## **Classifieds and Announcements**

**Park Avenue Near Grand Central Station Intellectual Property Attorneys** have attractive offices available including receptionist if desired and secretarial stations. (212) 681-0800.

**Schwab Goldberg Price & Dannay will combine with Cowan Liebowitz & Latman**, effective January 1. The merger is significant in the practice of intellectual property law, as both firms feature an unusual depth of expertise and a range of high profile clients, including top names in the publishing, media, computer and entertainment industries.

The combined firm, which will use the Cowan, Liebowitz name, includes 50 lawyers. The two firms, each four decades old, are known for their expertise in copyright and trademark law, particularly traditional publishing. They have litigated cases at all levels, including the U.S. Supreme Court, defending such properties as the *Jurassic Park* novel and motion picture and representing the *Stalag 17* play against the *Hogan's Heroes* television show. Client matters handled in recent years include defamation issues, privacy and publicity rights and contract rights. Increasingly, the two firms have been helping clients cope with the legal ramifications of both the Gutenberg domain and the Internet domain. They have expanded their patent and technology transactions practices to address the changing issues generated by the new communications media. Both firms also offer established corporate, commercial, trusts and estates and real estate practices as well. Deals, including international work, have run the gamut from the sale of dozens of book publishing companies to helping clients purchase and operate golf courses.

Schwab Goldberg lawyers will practice in the Cowan, Liebowitz offices at 1133 Avenue of the Americas in New York City.

**Technology Transfer Executives.** Competitive Technologies, Inc., (CTI) seeks a patent and licensing attorney for its Fairfield, CT headquarters. Responsibilities will include patent prosecution, business assessment of patents and licensing.

*Qualifications:* Admission to the Patent Bar with 1-3 years experience in patent prosecution and licensing . The ability to work independently in handling a broad variety of technologies is required. Excellent interpersonal skills, verbal and written communications skills.

*Compensation:* Competitive salary and benefits package which includes stock options and performance bonus.

*Company:* CTI is a publicly-traded company that has been in the technology transfer, licensing, and new venture business for more than 25 years. Our clients include major Fortune 50 corporations, research universities and laboratories. CTI has offices in Fairfield, CT; Cleveland, OH; Bethlehem, PA; Osaka and London. For additional information on CTI, visit our web site at [www.cti.lehigh.edu](http://www.cti.lehigh.edu).

Submit resume and salary history to: Personnel Director, Competitive Technologies, Inc., 1960 Bronson Road, P.O. Box 340, Fairfield, CT 06430.

**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.

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