



May/June 1999

- [President's Corner](#)
 - [News from the Board of Directors](#)
 - [CLE Update](#)
 - [NYIPLA Survey](#)
 - [Recent Decisions of Interest](#)
 - [Jefferson Medal Dinner](#)
-

President's Corner

By Howard B. Barnaby

In my first President's Corner written last fall, I made the pronouncement that this is truly a great Association. Now, as I write my final column as my term ends, I am pleased to be able to echo my initial sentiments.

On March 26, 1999, I had the privilege of presiding over the NYIPLA's 77th Annual Dinner in Honor of the Federal Judiciary. The dinner once again enjoyed record attendance levels and stands as a fitting tribute to the many judges present as guests of the Association. I was personally honored to have the Honorable Joseph M. McLaughlin as our keynote speaker. Judge McLaughlin offered a wry view of some of the foibles of trial and appellate practice. As I said in my concluding remarks that night, Judge McLaughlin has spoken at this Dinner during the past three decades, once in 1976, again in 1981 and now he has managed to close out this decade. I hope that one of my successors will invite the Judge back during the coming decade.

Each year, the Judge's Dinner continues to be a monumental undertaking that falls on the shoulders of the First Vice President. This year, I owe a debt of appreciation to John Sweeney for making the dinner a memorable experience for me and my family.

The successes during the past year would not have been possible without the assistance of many. First and foremost, I wish to thank the officers of the Association. Mel Garner has done a great job in his first year as Secretary. His job is detail-intensive and he and his staff deserve a tremendous vote of thanks. I always felt a bit guilty conducting business during our monthly board meetings because I knew that this would require Mel to take minutes in lieu of his meal.

John Murnane has continued to maintain the Association books in his second term as Treasurer. John has improved our dues payments to such an extent that we had only three delinquent members last year. In addition, John has developed an extensive reporting system that provides the Board with detailed, monthly statements as to our current financial situation. The Association coffers are truly in good hands.

Robert Neuner, as Second Vice President, has been responsible for the Annual Meeting and Dinner to be held on May 12. Bob has coordinated the Annual Meeting, the first Board of Directors meeting of the 1999-2000 Association year and the Annual Dinner with its award presentation and speakers. I appreciate all of Bob's efforts since they set the stage for the assumption of this office by our President-Elect, Herbert Schwartz. It was my experience that my time on the Board provided the opportunity to gain a sense of the Association's customs and traditions and to develop a direction for my term as President. In working with Herb during these years, I have seen the same force at work in him. I am confident that he will provide strong and valuable leadership during the coming year. I offer him my heartfelt best wishes and full support.

Our Board of Directors also deserves a strong vote of thanks and recognition. The Board meets each month to set policies and vote on Association activities. In addition, each Board member serves as a liaison to a committee as a means of communicating Association policies to the committees and bringing to the Board's attention significant committee contributions. I want to thank all of the Board members who served with me last year, and particularly retiring members, Richard DeLucia, Teresa Gillis and Ed Vassallo.

Last, but by no means least, I owe a special debt of thanks to our committee chairs. The committee structure is truly the lifeblood of this Association. Last year was a particularly active one for our committees. I would like to extend special thanks for some projects that went "above and beyond" the call. Fred Dorchak and his Committee on Patent Law, both times on short notice, was able to review and prepare reports to the Patent and Trademark Office on significant rule and policy changes. Bruce Wexler and his Legislative Oversight and Amicus Brief Committee authored two Supreme Court amicus briefs that were submitted in the *Zurko* and *CSB* decisions recently argued before the Court. Tom O'Rourke and the Publications Committee continues to provide our avenues of communication in the form of the **Greenbook**, the *NYIPLA Bulletin* and the **NYIPLA Annual**.

Mark Abate and his Committee on Education and Information continues to administer the Conner Writing Competition and the Annual Inventor of the Year Award. Paul Garrity and his Committee continue to provide our ever-popular program of monthly luncheon speakers, which program will hopefully begin to carry CLE credit. Leon Bechet and his Young Lawyer's Committee planned a ceremonial admission to the Bar of the U.S. Supreme Court that was held on May 3, 1999. Finally, Anthony Giaccio and the CLE Committee have undertaken a formidable task in helping the Association to conform with the new mandatory CLE rules in New York State. Besides gaining qualification of the Association as a CLE provider, Anthony and his committee are preparing a number of CLE programs for the coming year, including a CLE Weekend scheduled for September 24-26, 1999. In addition, the committee is exploring the possibility of creating a video library of past programs to assist our members in gaining CLE credits. My hat is off to each and every committee chair and member. Thank you for your efforts.

Most of all, thank you for giving me the opportunity to serve as President of the Association during the past year. I have truly enjoyed meeting and working with many of you. I have always sensed a great amount of cooperation and support from everyone. As I begin my fourteenth and final year on the Board of Directors as immediate past president, I look forward to working with Herb Schwartz and the other officers in any meaningful way.

News from the Board of Directors

By Melvin C. Garner

The Board of Directors met at the Yale Club on March 16, 1999. William Dippert of the Public and Judicial Personnel Committee, Marc J. Abate of the Public Information Education and Awards Committee, and John M. Delahanty of the Computers, Entertainment Law and Media Committee were in attendance at the request of the Board. Howard Barnaby presided.

The minutes of the Board Meeting of February 16, 1999 were presented by Melvin Garner. There being no proposed changes, the minutes were approved.

John Murnane distributed the March 15, 1999 Treasurer's Report. This report shows the income and expenses of the Association from a historical perspective. The Report included a balance sheet for the Association. As of the Report, the Association had a balance of \$472,000. Last month this balance was only \$122,000, the increase being due to payments for the Judge's Dinner. On an annualized basis, the Association had \$8,000 more at the same time in 1998. On motion and second, the Treasurer's Report was approved.

Mr. Barnaby reported that William Eberle had applied for Life Membership. Mr. Murnane, as a former partner of Mr. Eberle, made a motion to grant Life Membership. Mr. Garner seconded the motion. It was unanimously approved.

In the absence of John Sweeney, Mr. Barnaby reported on the status of the Judge's Dinner. As of that time, there were 2,868 reservations and 176 Honored Guests. There were five Federal Circuit judges and four Judges from the Second Circuit expected at the Dinner. In honor of the Speaker, Judge McLaughlin, \$1,000.00 will be contributed to the Fordham Law School and \$1,000.00 to St. Johns Law School. Mr. Barnaby stated that in order to expedite the introductions during the Judge's Dinner, the entire dais will be introduced prior to the meal. During dessert and coffee, he will introduce the Judges in groups according to the Court to which they belong.

A question was raised as to whether United States Patent and Trademark Office personnel, other than the Commissioner and high ranking officials invited in the past, should be invited to attend the Judge's Dinner. It was decided that no further invitations should be extended.

Mr. Barnaby reported that John Reilly was interested in forming a foundation to sponsor patent law. John Daniels questioned what such a foundation would do given the local nature of the Association. It was the decision of the Board that a written proposal should be obtained from Mr. Reilly.

Mr. Barnaby indicated that the Annual Meeting will be held on May 12th, and that Judge Mukasey of the Southern District of New York was expected to be the speaker.

Mr. Dippert reported that his committee was active in trying to have an intellectual property attorney appointed to the Federal Bench in the Southern District of New York or the Eastern District of New York. They have been looking at the process involved in accomplishing this goal. In the past, they have had discussions with the Judicial Selection Committee of Senator D'Amato. John Delahanty reported that he had been in contact with Senator Schumer's Office and that they are receptive to the idea. In addition, members of this Committee have contacted Judge Griesa, who is enthusiastic about the possibility of a further intellectual property attorney being appointed to the bench. Currently, there are two vacancies in the Southern District of New York, one being for a judge in Westchester County. However, there may already be candidates in line for these two positions. The Committee intends to identify candidates with qualifications, with a particular emphasis on those that represent a racial and sexual diversity. Such a candidate should be between 50 and 55 years of age and be a patent litigator, if possible. A discussion was held about the financial compensation for federal judges. It was decided that the Committee should put together a report on the financial compensation of federal judges.

It was further reported that Judge Griesa of the Southern District of New York may be interested in seminars on intellectual property. Mr. Delahanty stated that he would investigate this and see if the Association can help. Herbert Schwartz noted that the Federal Judicial Center has patent courses. Mr. Barnaby stated that the Public Information, Education and Awards Committee had been thinking about putting together books to help judges with patent cases. It was the consensus of the Board that the Association should do whatever it can to help educate judges with respect to the trial of patent cases.

Charles Baker asked for comments on the draft brief prepared by the Amicus Committee in the *Florida Prepaid v. College Savings Bank* case. Mr. Garner indicated that at page 6 of the brief, there should be more explanation of the implication of the 14th Amendment. Mr. Barnaby noted at the same page that there should be more explanation of the waiver of immunity. John Daniel suggested more policy considerations at the beginning of the brief. Mr. Barnaby thanked Mr. Baker and the Amicus Committee for doing a great job in preparing the brief.

A flyer concerning a program being put on by the Association of the Bar of the City of New York was distributed by Thomas O'Rourke. The Association is not a sponsor of this program. However, the City Bar Program Committee requested that a copy of this flyer be placed in the *Bulletin* when it is mailed to the Association Membership. Mr. Schwartz stated that he was opposed to this because the Association would receive requests from similar organizations and programs for inclusion in the *Bulletin*. After a discussion, it was decided that a notice of the meeting could be put in the *Bulletin*, but that the Association would not distribute the flyer.

Mark Abate led a discussion concerning the nominations for the Inventor of the Year. Three people were previously nominated and at the meeting he distributed a package nominating a fourth person, Dr. Roth, who is employed by Warner Lambert Company of New Jersey. Dr. Roth was a previous nominee. After consideration of all the nominees, the Board provisionally selected Dr. Roth as the Inventor of the Year. Susan McHale reported on the CLE Luncheon and some of the difficulties of signing in and out of the luncheon in order to get CLE credit.

As new business, Mr. Schwartz indicated that the Association should publicize its CLE programs as soon as possible, because firms are making their plans now. A suggestion was made that there be an article in the *Bulletin* about the various CLE programs the Association is about to put on. In particular, it should emphasize that the Association is a unique provider of CLE credits, providing between 1 and 24 hours on IP topics.

There being no further business, the meeting was adjourned.

CLE Update

by Anthony Giaccio

The advent of mandatory CLE in New York State has provided this Association with the opportunity to expand our influence in an area in which we have tremendous expertise, i.e., providing the intellectual property law bar with the highest quality CLE programs. As Chair of the Committee on Continuing Legal Education, I would like to give our membership a brief update concerning NYS MCLE.

First, the NYIPLA has applied to the NYS CLE Board for "Accredited Provider" status, which status will allow us to offer NYS accredited programs without the need for filing program-specific accreditation applications. While this main application is pending, the NYIPLA has filed program-specific applications for our educational programs that have been modified to satisfy the NYS MCLE requirements. All applications are pending. If you have attended any of our programs that have been modified to satisfy the NYS MCLE requirements, starting with the 1998 Fall Weekend Program at the Nevele, you will receive a Certificate of Completion for the program with an identification of the number of NYS CLE credits earned. Further, if you were a speaker at any of these programs, your Certificate will acknowledge your participation as a speaker with an identification of the number of NYS CLE credits earned for speaking. These letters are waiting to be mailed out until we receive word from the NYS CLE Board that either the Association is accredited or any of the specific programs are accredited.

Second, we will be expanding the number and variety of CLE programs and program formats offered

throughout the year in order to capitalize on the wealth of substantive law expertise possessed by our diverse Committees.

Third, a formal policy has been proposed to the newly formed Board concerning the projected pricing of our CLE programs so that a uniform pricing policy is implemented for all NYIPLA CLE programs. Be assured that the Association's registration fees will not only be reasonably priced, but will be priced at or below comparable CLE programs sponsored by other CLE providers.

Lastly, please be advised that new rules have been adopted and new guidelines have been issued concerning NYS MCLE, which are all available at <http://ucs.ljx.com>.

I look forward to working with all of you in providing an aggressive and comprehensive CLE effort on the part of the NYIPLA in order to meet and exceed the needs of the intellectual property law bar.

Please show your support for the NYIPLA by participating in the following programs:

Upcoming Events

October 24, 1999 NYIPLA Golf Tournament, Tarrytown Convention Center

October 25-26, 1999 NYIPLA 1999 Fall CLE Weekend, Tarrytown Convention Center.

NYIPLA Survey

TO: NYIPLA Members

Re: NYIPLA Survey

We want to collect information concerning how the SDNY is meeting the special needs of patent litigation, and whether there are any suggestions for improvement that should be provided to the Court. This survey is in response to the Court's invitation to discuss any such issues.

Please return the completed survey to Thomas Beck, Fitzpatrick, Cella, Harper & Scinto, 30 Rockefeller Plaza, New York, NY 10112; (fax)212-218-2200.

- 1. Are you involved in decision-making about where to initiate patent litigation? ___ Yes ___ No**
- 2. Are you aware of the basis for decisions on where to initiate patent litigation? ___ Yes ___ No**
- 3. In deciding where to initiate patent litigation what factors were important? (check if applicable)**

- ___ location of plaintiff**
- ___ location of defendant**
- ___ client preference**
- ___ speed of Court decisions**
- ___ speed to trial**
- ___ skill or experience of judges**
- ___ skill or experience of magistrates**
- ___ managing of discovery**
- ___ other (please explain briefly)**

4. Are there any particular jurisdictions favored? Which and why?

5. Are there any particular jurisdictions avoided? Which and why?

6. Do you prefer or avoid the SDNY? Why?

- prefer**
- avoid**
- other**

7. Please rank the following as to patent litigation in the SDNY (from 1 to 5, 1 is good, 5 is bad)

- speed of Court decisions**
- speed to trial**
- well-reasoned decisions from the Court**
- skill or experience of judges as to patent litigation**
- skill or experience of magistrates as to patent litigation**
- skill or experience of court clerks and deputies**
- the Court's management of discovery**
- fairness and convenience of Court procedures**
- treatment of lawyers by Court**
- treatment of parties by Court**
- availability of informal or flexible procedures**

8. What if any changes in the SDNY would you consider desirable or beneficial? Please describe briefly.

Recent Decisions of Interest

By Thomas A. O'Rourke

Copyright

Infringement

In *DSC Communications Corp. v. Pulse Communications, Inc.*, 98-1024 (Fed. Cir. March 11, 1999) (Bryson, C. J.), DSC appealed the grant of JMOL to Pulsecom dismissing all DSC's claims of copyright infringement, misappropriation of trade secrets, and tortious interference with DSC's business expectancy. In a cross-appeal, Pulsecom appealed the grant of summary judgment of noninfringement of Pulsecom's patent to DSC.

DSC manufactures a DLC (the Litespan), a POTS (i.e., plain old telephone service) interface card to work with it (the RUVG), software to operate its interface card (the POTS-DI software), and software to operate the Litespan (the Litespan System software). DSC entered into a series of agreements which all contain provisions that license, under a variety of restrictions, the Litespan System software and POTS-DI software to its customers. Pulsecom developed a Litespan-compatible POTS card to compete with DSC's POTS card which is designed to use the same DSC's POTS-DI software.

The district court found no direct copyright infringement holding that the customers, through a single payment amounting to a sale, acquired ownership of the copies of the software with an unlimited right of possession, according to 17 U.S.C. § 117. As owners, making copies was an "essential step in the utilization" of the software and the customers made no other infringing use of the software. Absent their direct infringement, there could be no Pulsecom contributory infringement. The Federal Circuit reversed and concluded:

Because the DSC-RBOCs agreements substantially limit the rights of the RBOCs compared to the rights they would enjoy as "owners of copies" of the POTS-DI software under the Copyright Act [17 U.S.C. § 117], the contents of the agreements support the characterization of the RBOCs as non-owners of the

copies of the POTS-DI software. The fact that the right of possession is perpetual, or that the possessor's rights were obtained through a single payment, is certainly relevant to whether the possessor is an owner, but those factors are not necessarily dispositive if the possessor's right to use the software is heavily encumbered by other restrictions that are inconsistent with the status of owner.

With respect to the copies of the software created by Pulsecom while operating its own Litespan systems purchased in the open market without a restrictions on their use, the Federal Circuit held there was no direct infringement. According to the CAFC, Pulsecom qualified as owner under 17 U.S.C. § 117, and is entitled to make such copies of the POTS-DI software as are necessary to operate the systems. The CAFC rejected Pulsecom's affirmative defense of fair use for reverse engineering, as in *Sega*, 977 F.2d 1510, 1520 (9th Cir. 1992). Pulsecom made copies of the software on its POTS cards as part of their ordinary operation in order to demonstrate the interchangeability of the Pulsecom cards with the DSC cards, not as part of an effort to determine how the Litespan system worked.

On the issue of patent infringement, the district court held that DSC's device (i.e., the RUVG card) did not infringe Pulsecom's patent because the patent's claim is limited to service to normal analog telephones and does not cover service to a PBX system, while DSC's RUVG card is used only with PBX systems.

The district court based its holding of noninfringement on the claim construction that "subscriber telephone instrument" refers to a typical analog telephone. Moreover, "POTS-type telephone service" was limited to normal analog telephones and did not include PBX systems while DSC's RUVG card was used only with PBX Systems.

On appeal before the CAFC, Pulsecom contended that the claim language "telephone instrument" includes PBX equipment since the patent specification, while explaining the difference between the two DC signaling systems, loop start and ground start, in use with the claimed apparatus, expressly mentions that GS is usually used with PBX systems.

The Federal Circuit rejected this view, stating:

this portion of the specification does not support Pulsecom's argument that the term "telephone instrument" is broad enough to include *all* equipment included within a PBX system, such as the PBX interface between RUVG cards and the individual telephones in the PBX system. The key to the proper construction of the claim language "for providing POTS-type telephone service using DC signaling to the subscriber telephone instrument" is the requirement that the subscriber telephone instrument use DC signaling to request service. Accordingly, we construe the claim language to include only those systems in which the telephone instrument requests telephone service using DC signaling. The unresolved factual question is whether -- it is the PBX equipment, the calling PBX telephone, or some other device that requests service using DC signaling.

The case was remanded to the district court for it to resolve the factual issues.

Patents

Prosecution History Estoppel

In *Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc.*, 98-1360 (Fed. Cir. March 18, 1999) (Lourie, C. J.), Upjohn appealed the district court's grant of summary judgment holding that Mylan did not infringe Upjohn's patent under the doctrine of equivalents because of prosecution history estoppel, and alternatively, that Upjohn was collaterally estopped from asserting its infringement claim by a prior judgment of invalidity and unenforceability.

In its suit against Mylan, Upjohn argued infringement of the patent under the doctrine of equivalents claiming "anhydrous lactose" is the equivalent of "spray-dried lactose." Upjohn argued that the prosecution

history viewed as a whole, through the statements of its attorney, the inventor Ni, and its laboratory notebook, all confirm that the terms "non spray-dried lactose" and "hydrous lactose" were always used as synonymous.

The Federal Circuit found this argument unpersuasive and held that a correct interpretation of the prosecution history barred Upjohn's claim of patent infringement under the doctrine of equivalents. The CAFC focused on the attorney's and inventor's statements, and the opinion issued by the Board in reversing the examiner's rejection of the claims under 35 U.S.C. § 103. According to the Court, Upjohn's prosecuting attorney's statement asserting that spray-dried lactose was "a critical feature of the present invention" effected a broad disclaimer of all formulations of micronized glyburide which do not contain spray-dried lactose as excipient, including both hydrous and anhydrous lactose. This disclaimer was followed and confirmed by Inventor's statement which contended that "spray-dried lactose is far superior" to a particular form of non spray-dried lactose (namely, here, hydrous lactose). Thus, the Federal Court affirmed the district court holding that Mylan's formulations containing anhydrous lactose did not infringe the patent under the doctrine of equivalents because of prosecution history estoppel.

As to the issue of collateral estoppel, Upjohn contended that collateral estoppel based on the decision in *Upjohn Co. v. MOVA Pharmaceutical Corp.*, 48 USPQ2d 1357 (D.P.R. 1998) should not have been applied because Upjohn did not have a full and fair opportunity to litigate, the *MOVA* judgement is still "uncertain" since the appeal is pending, and the two appeals should be consolidated. The CAFC found Upjohn's contentions to be without merit and concluded that Upjohn had a full and fair opportunity to litigate the validity of the patent in the prior unsuccessful suit. As for Upjohn's concern as to the finality of *MOVA*, the CAFC held: "Finality should attach for claim preclusion purposes at the time of entry of judgment. The pendency of an appeal or post-trial motions for JMOL/new trial has no effect on the finality or binding effect of a trial court's holding."

The Federal Circuit continued:

the district court did not err in applying collateral estoppel based on the judgment in *MOVA*, despite the fact that the motion for JMOL/new trial had not yet been resolved by the *MOVA* court, and despite the possibility of a subsequent appeal of the *MOVA* judgment. We also decline Upjohn's invitation to consolidate this appeal with the appeal in *MOVA*. If another panel later concludes that one or more of the jury verdicts in *MOVA* should be reversed, Upjohn may then move the district court to modify its judgment accordingly.

Means-Plus-Function Claims, Trade Dress and Trademark Infringement

In *Al-Site Corporation v. VSI Int'l, Inc.*, 97-1593 (Fed. Cir. March 30, 1999) (Rader, C. J.), the defendants appealed the denial of their JMOL motions by the district court. The jury verdict determined that VSI literally infringed plaintiff's '532 patent. The jury also held that VSI infringed the remaining patents under the doctrine of equivalents.

In reaching the conclusion that there was literal infringement of the '532 patent the district court determined that the claim term "fastening means" was a means-plus-function element. Before the Federal Circuit, VSI did not challenge this claim construction but argued a lack of substantial evidence to support the jury verdict of infringement. The CAFC noted that although the adhesive used by VSI is not identical to the fastening structure (namely, a rivet or button) described in the '532 patent, the jury, correctly applying §112, ¶ 6, determined that the VSI adhesive literally infringes the '532 patent because it was "structurally equivalent to the fastening structure disclosed in the specification of claim 8 of the '532 patent." Furthermore, expert testimony established that the use of glue instead of a rivet "is an insubstantial change" and that it was known to persons of ordinary skill in the art that they were "equivalent fastening means."

As to the jury's finding of infringement of the remaining patents under the doctrine of equivalents, the Federal Circuit held that the district court erred in

its claim interpretation because the claims did not use the specific language necessary to trigger presumptive application of § 112, ¶ 6 (i.e., "means of" followed by a function). Moreover, even where functional language was found, the claims supplied elaborate sufficient structure to perform the recited function so as to overcome the presumption.

VSI also argued that it would not infringe any of the claims under the doctrine of prosecution history estoppel. VSI argued that because all of Magnivision's patents arose from related applications, the same prosecution history estoppel applies to them as well. The CAFC rejected the argument as unpersuasive stating: "The '345, '726, and '911 patents all have limitations not found in the '532 patent and did not necessarily require the specific limitation added to the claims of the '532 patent to be patentable. The specific limitations added to gain allowance of the '532 patent are not included in and are therefore not relevant to determining the scope of the claims of the later issued patents."

As to trade dress infringement, the plaintiff must show all of the following: (1) inherent distinctiveness or secondary meaning, (2) nonfunctionality, and (3) the likelihood of consumer confusion between its and the defendant's trade dress. Applying the test, the Federal Circuit found no infringement of Magnivision's display card and blister pack trade dress. Testimony of sole use by Magnivision prior to VSI's was not enough without a showing of distinctiveness or secondary meaning which Magnivision failed to provide because the use of the dress was limited in time and not uniform, and advertising was not tied to the products in issue. Also, no evidence of likelihood of confusion was found since the parties' packaging are substantially different.

As for infringement of Magnivision's MAGNIVISION mark by VSI's mark MAGNAoDOT, no likelihood of consumers' confusion was found since the only similarity is the MAGNA/MAGNI prefix which enjoyed wide common use in the industry. The Federal Circuit in holding there was no infringement stated: "The differences in the marks, the absence of actual confusion despite several years of simultaneous use in an identical market, the absence of evidence that VSI intended to copy Magnivision's mark, and the weakness of the descriptive MAGNIVISION mark add up to a finding of noninfringement as a matter of law."

Trademarks

Scandalous Marks

In *Ritchie v. Orenthal James Simpson*, 97-1371 (Fed. Cir. March 15, 1999) (Plager, C. J.), Ritchie appealed the TTAB's dismissal for lack of standing of his oppositions filed with the Board, pursuant to 15 U.S.C. § 1063, asserting non-registrability of Simpson's marks under § 2(a), "immoral or scandalous matter," or, alternatively, § 2(e)(4), "mere surname," of the Lanham Act. Simpson applied for federal registration of the trademarks O.J. SIMPSON, O.J., and THE JUICE for use with a broad range of goods.

Whether a registration is immoral and scandalous is to be ascertained in the context of contemporary attitudes in the viewpoint of a "substantial composite" of the general public. Ritchie alleged that he was such a person. Ritchie also argued that Article III of the U.S. Constitution's "case" and "controversy" restrictions for standing do not apply to matters before administrative agencies and boards, such as the PTO. Therefore, in the case at hand, the applicable standard is to be found in § 13 of the Lanham Act which only requires that the opposer have a belief that he would suffer a damage from the registration of the mark. Two additional judicially-created requirements must be met to have standing. The opposer must have a "real interest" in the proceedings and must have a "reasonable" basis for his belief of damage.

The "real interest" test requires that the opposer have a direct and personal stake in the outcome of the opposition. The Board held that the opposer must have "a personal interest in the proceeding *beyond that of the general public*." The Federal Circuit rejected this interpretation. Ritchie argued that as an individual member of the group of Christian, family men who believe in a loving and nurturing relationship between husband and wife, Ritchie himself would suffer the injury of disparagement if Simpson's marks were

registered. The Federal Circuit held that: Ritchie has a real interest, a personal stake, in the outcome of the proceeding and is more than a mere intermeddler and that the fact that his concerns are shared by a large number of people, perhaps even the vast majority of the American public, is in no sense a disqualification of his right to oppose the registration."

As to the "reasonable" belief of damage test, for standing purposes the reasonableness may be shown by alleging that the opposer possesses a trait or characteristic that is clearly and directly implicated by the proposed trademark. On the other hand, if the marks do not implicate particular traits or characteristics, reasonableness may be shown alleging evidence that others also share the same belief of harm from the proposed trademark, i.e., the belief is not simply the opposer's subjective view. This evidence may come in the form of surveys, petitions, or affidavits from public interest groups representing people who allegedly share the damage caused by the mark. In the case at hand, the Federal Circuit found insufficient evidence of reasonableness from Ritchie's allegation that the marks are offensive to him as a Christian, family man. Instead, the CAFC found evidence of reasonableness in the fact that Ritchie obtained petitions signed by people from all over the U.S. who agree with him on the offensiveness of Simpson marks, making his view an objective one.

On the contention that allowing Ritchie's opposition would endanger Simpson's First Amendment rights, the issue was disposed of by the CAFC by stating that "the denial of federal registration of a mark does not prohibit the use of that mark. [Moreover], [u]ntil such time as the constitutionality of these Lanham Act provisions is challenged and found wanting, our job is to apply the law as it is written."

Jefferson Medal Dinner

The Jefferson Medal will be presented by the New Jersey Intellectual Property Law Association at its annual dinner dance on June 11, 1999 at the Hilton Hotel in Short Hills, New Jersey. The recipient of the Jefferson Medal will be the Honorable Paul R. Michel, Judge for the Court of Appeals for the Federal Circuit. Judge Michel was appointed to the Court in 1988. He has taught, lectured and written on intellectual property rights. Prior to Judge Michel being appointed to the Federal Circuit, he served as Deputy District Attorney in Philadelphia, Assistant Watergate Special Counsel and Assistant Counsel to the Senate Intelligence Committee. Judge Michel has also served in the Department of Justice. Prior to dinner, we anticipate an informative talk by Judge Michel dealing with his government experiences.

Ticket information can be obtained from:

Salvatore P. Pace, Esq.
The BOC Group / Patent, Trademark & Licensing
100 Mountain Avenue
Murray Hill, NJ 07974
Tel. No. 908-771-6242 / FAX No. 908-771-6159

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