

NYIPLA

January/February 2006

# Bulletin

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Nineteen Hundred and Twenty-two

NYIPLA

## RECENT DEVELOPMENTS IN THE LAW OF SPAM

By Abigail A. Rubinstein and Amy J. Benjamin<sup>1</sup>

### I. INTRODUCTION TO THE CAN SPAM ACT

Everyone knows how unsolicited emails can disrupt email systems and slow down the exchange of information between Internet computer servers. Indeed, numerous news stories have reported how unsolicited emails a/k/a "spam" cost businesses in the United States millions of dollars. Spam is perhaps the equivalent of having your telephone constantly ringing with sales representatives leaving solicitations on your answering machine. For example, after logging into your computer, you discover, not surprisingly, that your mailbox is full. Overnight, you have received hundreds of emails, all of them solicitations. You think - there ought to be a law. In fact as a result of this growing problem, there is now a federal law that regulates bulk commercial email, the "The Controlling the Assault of Non-Solicited Pornography and Marketing Act of 2003." It is also known as the "CAN SPAM Act", because the Act does not make spam unlawful but instructs how commercial emails should be sent. *See* 15 U.S.C. § 7701 *et seq.*

Effective January 1, 2004, the Act establishes specific requirements for companies and individuals that send bulk commercial email. It preempts some state spam laws but allows states to enact laws that prohibit false or decep-

tive messages. The Act does not apply to charitable or political bulk email.

### II. REQUIREMENTS OF THE CAN SPAM ACT

The Act requires those who send bulk commercial email to:

- Include a legitimate return email address and physical postal address.
- Activate a functioning opt-out mechanism to allow consumers to decline to receive further emails from the sender.
- Provide clear notice of the opt-out mechanism.
- Honor all opt-out requests.
- Provide clear notice that the email is an advertisement or solicitation.
- Provide a warning in the subject heading that clearly identifies messages containing sexually oriented material.

The Act also prohibits the following:

- Falsifying or disguising the true source of the email.
- Harvesting email addresses.
- Bait and switch offerings.

Moreover, business are prohibited from benefiting from the distribution of false or misleading emails, such that the liability for sending false or misleading emails is extended to anyone who benefits from the email.

*cont. on page 3*

February 10, 2006

Dear Members:

I am delighted to inform you that Scott Turow will be the keynote speaker at the Dinner in Honor of the Federal Judiciary, on March 24.

Scott is a practicing attorney in Chicago, and of course one of our most successful authors of novels about judges, attorneys, our practice, and more. He is the author of seven best-selling novels. His first, *Presumed Innocent*, was followed by *Burden of Proof* and *Pleading Guilty*. His most recent, *Ordinary Heroes*, was published in November 2005. His books have been translated into more than 25 languages and, in total, have sold approximately 25 million copies worldwide. His books have been made into successful movies, including *Presumed Innocent* starring Harrison Ford.

We look forward to having Scott with us at the dinner.

The Association's Board recently approved proposed Local Patent Rules that will be submitted to the Chief Judge of the Southern District of New York. These proposed rules were drafted by an ad hoc



President Edward E. Vassallo

committee formed by our Committee on Patent Law and Practice, chaired by Rob Scheinfeld. The purpose of these proposed rules is to assist the court in dealing with complex patent litigations. The proposed rules are intended to be flexible so as to accommodate the unique attributes of each suit. We look forward to receiving comments from the SDNY.

I hope you enjoy this issue of our Newsletter.

Cordially,  
Edward E. Vassallo



### NYIPLA Announces Keynote Speaker **Scott Turow** Attorney and Best-selling Legal Novelist

Scott Turow will be the keynote speaker at the NYIPLA 84<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary at the Waldorf=Astoria Hotel on March 24, 2006



Further to President Vassallo's comments above, Mr. Turow is a well accomplished author of the legal profession whose works have included best selling novels. In addition, Mr. Turow has been a partner in the Chicago office of Sonnenschein Nath and Rosenthal, concentrating on white

collar criminal defense, while also devoting a substantial part of his time to pro bono matters. He has served on a number of public bodies, including the Illinois Commission on Capital Punishment appointed by Governor George Ryan in 2000 to recommend reforms to Illinois' death penalty system. He is currently the Chairman of Illinois' Executive Ethics Commission regulating executive branch employees. He is also a past president of the Authors Guild, and is currently a trustee of Amherst College.

### III. EFFECTIVENESS OF THE CAN SPAM ACT

In the legislative history of the Act, Congress documented that the volume of spam email has been rapidly increasing, and as of 2003 spam accounted for more than 46% percent of all global email traffic. The volume of spam email continues to soar. It is a very cost efficient way to advertise and costs roughly \$100-\$500 to send one million emails. Recently, Ironport Systems, an email security company, announced that according to its measurements, the volume of spam has increased ten times in the past twelve months. Indeed, a single bulk emailer typically sends up to 30 million unsolicited commercial emails each day.

Whether these numbers are accurate is unclear. However, the Federal Trade Commission ("FTC") has vigorously pursued violators of the Act and filed numerous complaints resulting in a preliminary injunction against one of the largest spamming companies in the world, Phoenix Avatar. *See FTC v. Phoenix Avatar, LLC*, No. 04C2897, 2004 WL 1746698 (N.D. Ill. July 30, 2004). The FTC has also successfully obtained preliminary injunctions under the Act against Hitech Marketing, Scientific Life Nutrition, Rejuvenation Health Corp. and Gregory Bryant. *See FTC v. Harry*, No. 04C4790, 2004 WL 1749515 (N.D. Ill. July 27, 2004); *FTC v. Bryant*, No. 3:04-CV-897-J-32MMH, 2004 WL 2504357 (M.D. Fla. Oct. 4, 2004).

Additionally, under the Act, Internet Service Providers ("ISP's") may file a cause of action against those in violation. America Online, Earthlink, Microsoft Corp., and Yahoo! Inc. formed an industry anti-spam group and together have filed at least six lawsuits under the Act against hundreds of defendants, including some of the world's most notorious large scale spammers. Microsoft and Neoburst.Net LLC, recently settled a suit resulting in a stipulated permanent injunction against Neoburst.Net. The specific terms of the injunction can be found in *Microsoft Corp. v. Neoburst.Net, LLC*, No. C-03-00718RMW, 2004 WL 2043093 (N.D. Cal. Sept. 3, 2004).

Despite these successes, identifying and locating the source of spam remains the single greatest challenge to anti-spam enforcement. The way the Internet currently operates, there is no mechanism that requires a sender's identity to be authenticated. Therefore, spammers can, and do, conceal their identities with ease. A report by the FTC notes "that as much as 90% of spam is untraceable." FTC, *A CAN-SPAM INFORMANT REWARD SYSTEM – A REPORT TO CONGRESS* (2004). Where possible, tenacious forensic computing that follows the trail of electronic transmissions or monetary transactions to the spammer is the only way to locate the source of illegal spam.

### IV. LOCATING THE SOURCE OF SPAM

There are numerous techniques used by spammers to conceal their identities. An experienced forensic computer investigator is needed to ensure that the electronic or monetary trail is properly followed and documented. Spammers have an arsenal of methods to conceal their identities including :

- **Spoofing:** An email header is disguised to make it appear that it comes from a different email address other than the one from which it actually came. Thus, not only do millions of messages get sent from a falsified email address, messages returned as undeliverable will be sent to the falsified email address resulting in the potential for an innocent user's inbox to become flooded with angry returned emails and shut down due to exceeding size limits.

- **Open Relays:** An unprotected, or "unsecured," email server is configured to accept and transfer email on behalf of any user. For example, a spammer in the United States might send email through an open relay in Russia which would cause the email to appear as though it came from Russia.

- **Open Proxies:** Proxy servers are machines on a network that only directly interact with the Internet. A proxy server may be configured in a way that permits unauthorized users to connect through it to other computers on the Internet. The headers for messages that pass through an open proxy indicate the proxy's Internet Protocol ("IP") address in the "Received from" line, and not the true originating IP address. Spammers sometimes route their messages through a series of open proxies, referred to as a "proxy chain."

- **Zombie Drones and Bot Networks:** Without the knowledge of the computer owner, software may be downloaded onto a computer which causes the computer to spew out spam or to serve as a relay or proxy for spam. A "bot network" consists of a large number of zombie drones controlled by the same entity. Some observers report bot networks with as many as 400,000 drones.

- **Untraceable Internet Connections:** There are several ways for people to access the Internet through a network address that cannot be connected to an individual or a physical location. Users who connect to the Internet through public Internet cafes, through free (or stolen) Wireless Fidelity ("WiFi") connections, or through certain universities' on-campus networks need not identify themselves and can therefore send messages anonymously on the Internet. Spammers may also purchase ISP roaming access using false names and untraceable payment methods.

*See* FTC, *A CAN-SPAM INFORMANT REWARD SYSTEM – A REPORT TO CONGRESS* (2004).



## V. WHAT LEGAL ACTION CAN BE TAKEN BY THOSE WHO ARE VICTIMS OF OVERWHELMING BULK EMAIL SOLICITATIONS

Although the CAN SPAM Act does not necessarily provide a cause of action for those who are not classified as "Internet service providers," there are steps that a victim of overwhelming spam can take when the spammer is identified and located.

### A. State Law

While the CAN SPAM Act does preempt state spam statutes imposing an opt-in regime, whether or not most state anti-spam laws are preempted remains unclear. Courts have not yet addressed the scope of preemption of prior state statutes that specifically address fraud and deception in Internet email. Indeed, in *Kramer v. Cash Link Systems*, the Federal Court, applying Iowa law, awarded \$1 billion in what may be the largest judgment against spammers. Robert Kramer brought a complaint under Section 714E.1 of the Iowa Code, which prohibits the sending of misleading or false unsolicited email messages. IOWA CODE ANN. § 714E (West 2004). The court did not discuss preemption, but awarded the large sum in a default judgment. See *Kramer v. Cash Link Systems*, No. 3-03-CV-80109-CRW-TJS (S.D. Iowa December 17, 2004).

Some states have amended their anti-spam laws to avoid preemption by the CAN SPAM Act. For example, on September 17, 2004, California Governor Schwarzenegger signed new legislation amending California's unsolicited commercial email law. The amended law imposes liability for sending commercial email that (1) contains a third-party domain name without the permission of the third party, (2) includes falsified, misrepresented, or forged header information, or (3) has a subject line that a person knows would likely mislead a recipient. Whether the amendment succeeds in avoiding preemption has not yet been determined.

### B. Traditional Claims

Traditional claims, such as trespass to chattels, have also been applied to spamming cases. Trespass to chattels generally occurs when one party intentionally uses or interferes with another's personal property without authorization. However, not all jurisdictions apply trespass to chattels to spamming cases. Virginia is one such jurisdiction where courts allow trespass to chattel remedies. See *America Online, Inc. v. IMS*, 24 F. Supp. 2d 548, 549 (E.D. Va. 1998). In *IMS*, the court held that the defendant bulk emailer committed trespass to chattels when it sent 60 million unsolicited emails to America Online subscribers. *Id.* at 551. The Second Circuit has also allowed trespass to chattel remedies. In *Register.com v. Verio, Inc.*, the Second Circuit affirmed the grant of a preliminary injunction, finding that the plaintiff would likely prevail on its claims

of trespass to chattels as a result of using Internet robots<sup>2</sup> to harvest WHOIS registrant data. See *Register.com v. Verio, Inc.*, 356 F.3d 393, 404-5 (2d Cir. 2004). However, California courts have rejected trespass to chattels claims in spamming cases. See *Intel v. Hamidi*, 71 P.3d 296 (Cal. 2003); *Ferguson v. Friendfinders, Inc.*, 115 Cal. Rptr. 2d 258 (Cal. Ct. App. 2002).

Additionally, depending on the factual circumstances of the case, federal and state trademark infringement, unfair competition, false designation of origin, and dilution laws may be applicable.

### C. Computer Fraud and Abuse Act

The Computer Fraud and Abuse Act prohibits a person or entity from:

a. Knowingly causing the transmission of a program, information, code, or command, and as a result of such conduct, intentionally causing damage without authorization to a protected computer;

b. Intentionally accessing a protected computer without authorization, and as a result of such conduct, recklessly causing damage; or

c. Intentionally accessing a protected computer without authorization, and as a result of such conduct causing damage.

d. Obtaining information from a protected computer by intentionally accessing a computer without authorization or exceeding authorization through conduct that involves any interstate or foreign communication. 18 U.S.C. § 1030(a)(5), 1030(a)(2)(C).

Courts have also found that bulk emailers violate the Computer Fraud and Abuse Act by using their email accounts to send unsolicited mass emails to other accounts at the same ISP. As a result of this conduct, the bulk emailers recklessly caused damage and intentionally accessed protected computers. This conduct placed the bulk emailers outside the authorization of their terms of service agreement. See *America Online, Inc. v. National Health Care Discount, Inc.*, 174 F. Supp. 2d 890, 899 (N.D. Iowa 2001) (holding advertiser violated the Computer Fraud and Abuse Act when bulk emailers acting as its agents sent unsolicited emails to AOL customer accounts); *America Online, Inc. v. LCGM, Inc.*, 46 F. Supp. 2d 444, 450-51 (E.D. Va. 1998) (holding that massive e-mail transmissions, or "spam," violated Computer Fraud and Abuse Act section prohibiting impairment of computer facilities).

### D. Unsolicited Fax Laws

There is a great deal of overlap of technology today. Faxes can be sent via email, and emails sent via fax. Therefore, depending on the technology being used, the Telephone Consumer Protection Act ("TCPA"), 47 U.S.C. § 227, which makes it illegal for a person to use any telephone, facsimile machine, computer, or other device to send an unsolicited advertisement to a tele-

phone facsimile machine, may be applicable to sending unsolicited bulk commercial emails.

Recently, this statute was amended. The Junk Fax Prevention Act of 2005 (JFPA), which went into effect on July 9, 2005, permits businesses to send unsolicited faxes to anyone with whom they have an established business relationship, provided there is the appropriate opt out notice. An established business relationship is defined as "a prior or existing relationship formed by a voluntary two-way communication between a person or entity and a residential subscriber with or without an exchange of consideration, on the basis of an inquiry, application, purchase or transaction by the residential subscriber regarding products or services offered by such person or entity, which relationship has not been previously terminated by either party." The JFPA does not supercede any existing State laws and such laws may also be an effective tool for stopping spam.

## VI. CONCLUSION

There is no panacea for spam, nor is there any immediate relief that will insulate businesses and consumers from the havoc spam causes. There are however steps that can be taken to encrypt information that is passed via the Internet, such as anti-spam software and firewalls.

In addition, marketing firms and departments now have some clear guidance from Congress on how to effectively engage in a legitimate email advertising campaign without becoming exposed to claims of trespass and the like. While there is a proper way for businesses to send commercial email, solicit sales, update computer records etc. via the Internet, businesses and individuals must remain on guard because the anonymity of the Internet remains an active breeding ground for cyber pirates to take advantage of those who are not vigilant and careful with their information over the Internet.



<sup>1</sup> Abigail A. Rubinstein is an associate and Amy J. Benjamin is a principal at Darby & Darby. The article was submitted as part of a Paper prepared by the NYIPLA Internal Law Committee, chaired by Paul Reilly, entitled "Recent Case Law, Developments and Trends Concerning Trademarks, Copyrights, Patents and the Internet."

<sup>2</sup> An Internet robot is a software program interacts with other network services intended for people as if it were a real person to gather information.

The NYIPLA Bulletin welcomes articles on intellectual property law and practice.  
E-mail to: Ashe P. Puri, Bulletin Editor, at [asheesh.puri@ropesgray.com](mailto:asheesh.puri@ropesgray.com)

## Honorable Joseph M. McLaughlin

### Recipient of the 2006 NYIPLA Outstanding Public Service Award

Joseph M. McLaughlin, United States Circuit Judge for the United States Court of Appeals for the Second Circuit.

The award is being presented to Judge McLaughlin in recognition of a lifetime dedicated to the pursuit and administration of justice. Joseph McLaughlin was appointed to the United States Court of Appeals for the Second Circuit in 1990. Previously he had served as a United States District Judge for the Eastern District of New York since 1981.

Judge McLaughlin was a Captain in the U. S. Corp of Engineers, where he served in Korea from 1955-1957. From 1959 to 1961, he was in private practice with the New York law firm Cahill Gordon & Reindel. He joined the faculty of the Fordham University Law School from 1961 to 1981, where

he served as Dean and Professor of Law.

Judge McLaughlin is the co-author of Peterfreund & McLaughlin, *Cases on New York Practice*. He is the author of *McKinney's Practice Commentaries to CPLR*; *New York and Federal Law of Evidence*; and *Federal Evidence Practice Guide*. He is also the editor-in-chief of *Weinstein's Evidence* (Matthew Bender & Co.).

His many roles in public service include serving as Chair of the New York State Law Revision Commission from 1975 to 1982. He is a member of the Federal Bar Council, the New York State Bar Association, and the Association of the Bar of the City of New York. He is married to the former Frances Lynch and has four children, Mary Jo, Joseph, Matthew, and Andrew. He is also the proud grandfather of eight grandchildren.



## As Time Goes By - Imagine This!

by Dale Carlson

Imagine this: you are sitting in on a luncheon keynote presentation by Federal Circuit Judge Pauline Newman while looking out a window of the massive conference room. You see another court, this one a tennis court, circumscribed by a golf course.

Judge Newman is giving a compelling presentation on the history of her Court. She focuses on the Court's first two years of existence. Realizing that she's talking about two YEARS, rather than DECADES, you awake from your daydream to the possibility that you are slipping through a Rip-van-Winkleian, multi-decade time warp. Where's the DeLorean when you need it?

On the Orwellian calendar, what time is more fitting than 1984, specifically Veterans' day weekend 1984. The place is Arrowood Conference Center in Westchester County. After lunch, you will join family and friends, and colleagues in the profession, for a game of tennis on the court that you overlook. Tennis will be followed by dinner, drinks and dancing in Arrowood's Grand Ballroom.

Too good to be true, you say? Just a dream... might be a dream, must be only make-believe. Perhaps, but consider this: long before it was fashionable, much less mandatory, our Association played an instrumental and vital role in the continuing education of its members. A key focal point for this education was, and continues to be, the Fall CLE seminars. Although today the Fall seminars typically take place during the course of a single day in one of Manhattan's university clubs, things weren't always so.

Prior to the New York bar's mandating CLE, the organizers of our Fall seminar had to stretch their imaginations to find ways to entice the members to attend. A popular enticement was location, location, location. Various "hot-spots" included the Poconos

(e.g., "Skytop Lodge"), the Catskills (e.g., "Neville Grande" and "Mohonk Mountain House"), Connecticut (e.g., "Heritage Village Conference Center"), and Westchester (e.g., "Tarrytown House" and, as we dreamed, "Arrowood").

One particularly imaginative former President of our Association, Karl Jorda had visions of an event in Bermuda, or in the Caribbean Islands. Cost was invariably the show-stopper for the islands - typically running twice that of a local event reachable by car or train.

The echoes of the Veterans' weekend gatherings left an indelible imprint on the brains and psyches of those in attendance. The seminars invariably provided a primer on the law in a stimulating environment away from the madding crowds. The opportunity to meet, greet, and get to know fellow members of our Association, and their spouses or significant others, as well as the tag-along tots and teens, was uniquely memorable.

Locations like the rec room at Skytop provided a perfect vehicle for getting to know one-another over a game of billiards or ping pong. Hiking up the trails at Mohonk past the "humpty dumpty" rock formations, and the signage urging "slowly and quietly please" that echoed the resort's Quaker origins, allowed time for reflection on the strengths of our Association and the substance of its people. "Tea time" brought everyone together, with the common bond being stomachs aching for "home-made" cookies.

The academic content of the Fall seminars was, and continues to be, detail-oriented, with plenty of time allotted for discussion and lively debate among the attendees. Spouses and significant others in attendance were encouraged to "drop in" to see what was going on in the IP field.

The depth of the Fall seminars stands to this day in sharp contrast to the "broad strokes" picture painted by our Association's Spring joint patent practice seminar. When Past Presidents Ed Filardi and David Kane dreamed up the idea of the Spring seminar, the by-words "short and sweet" must have been foremost on their minds. In the first Spring seminar, the speakers were allotted only five minutes each to present their talk. Now, ten minutes is the norm for the Spring event. In contrast, the speakers for the



*Dale A. Carlson, a partner at Wiggin & Dana, is the Chair of the Committee on License to Practice Requirements.*



Fall event typically have three or four times that amount in which to explore the full range of their topic. Time enough to really talk, and think, things through!

Meanwhile, it's still 1984 and we're back at Arrowood. Besides hearing Judge Newman, we can look forward to presentations from Rene Tegtmeyer of the Patent Office, Mary Beth Peters of the Copyright Office, Ian Calvert of the Patent Office Board of Interferences, and Judge Kevin Duffy of the Southern District of New York. Additionally, Past President Doug Wyatt will speak on the impact of the Federal Circuit's decisions on patent law, and Past President Jerome Lee will present the view of outside counsel with regard to sincerity and integrity in trial presentations. Association members Neil O'Brien and John Bergin will speak on the art of negotiation, and the practice of anticounterfeiting, respectively. All-in-all, it promises to be a great learning event.

After the weekend is over, we'll say good-bye to our fellow one-hundred-and-twenty attendees. We'll look forward to seeing them again at the next Fall seminar, and the next one, and the next one, albeit in a different time, and in a different place. ■

## ARTICLES

The Association welcomes  
articles of interest to the IP bar.

Please direct any submissions  
by e-mail to:

Ashe P. Puri, Bulletin Editor, at  
[asheesh.puri@ropesgray.com](mailto:asheesh.puri@ropesgray.com)

### *Announcing* **HONORABLE WILLIAM C. CONNER** **INTELLECTUAL PROPERTY LAW WRITING COMPETITION FOR 2006** *sponsored by*

**THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION (NYIPLA)**

*Awards to be presented on May 24, 2006, in New York City at the  
NYIPLA Annual Meeting and Dinner*

For enrollment and submission requirements on this competition, please visit [www.nyipla.org](http://www.nyipla.org)

## NYIPLA CALENDAR

FOR MORE DETAILS ON THESE PROGRAMS SEE PAGE 8

### **Date: Friday, February 24, 2006**

#### **Event: CLE Luncheon & Program**

Keynote Speaker: Hon. Michael R. Fleming, Chief Administrative Judge  
Board of Appeals and Interferences (USPTO)

Topic: Interim Guidelines for Examination of Patent Applications  
for Patent Subject Matter Eligibility

Place: Princeton/Columbia Club

### **Date: Friday, March 24, 2006**

**Event: The 84th Annual Dinner in Honor of the  
Federal Judiciary and the CLE Day of Dinner Program**

Place: Waldorf-Astoria, New York

### **Date: Wednesday, May 3, 2006** - Save the Date

#### **Event: 22nd Annual Joint Patent Practice Seminar**

Keynote Speaker: Hon. Alan D. Lourie, Circuit Judge,  
United States Court of Appeals, Federal Circuit

A full-day program comprised of five panels featuring the most up-to-date  
information in the following areas: Litigation, Biotechnology/Pharmaceu-  
ticals, Foreign Patent Practice, Information Technology/Licensing/Trade  
Secrets and USPTO Practices

### **Date: Wednesday, May 24, 2006** - Save the Date

#### **Event: NYIPLA Annual Meeting & Awards Dinner**

Co-Sponsored by:

The New York Intellectual Property Law Association  
Committee on Meetings and Forums,  
Committee on Continuing Legal Education &  
The Joint Patent Practice Continuing Legal Education, Inc.

#### LUNCHEON & CLE PROGRAM

HON. MICHAEL R. FLEMING, CHIEF ADMINISTRATIVE JUDGE  
BOARD OF APPEALS AND INTERFERENCES (USPTO)

on the topic of

**"Interim Guidelines for Examination of Patent Applications  
for Patent Subject Matter Eligibility"**

**Friday, February 24, 2006**

The Princeton/Columbia Club • 15 West 43<sup>rd</sup> Street • New York, New York

12:00-12:30 Reception • 12:30-1:00 Lunch • 1:00-2:00 Program

For further information about this program and to obtain registration  
information, please visit [www.nyipla.org](http://www.nyipla.org).

JPPCLE

#### 22<sup>nd</sup> Annual Joint Patent Practice Seminar

A One-Day Program Featuring Five Panels of Experts discussing recent  
developments in the law which all patent practitioners will need to know.

*Our panels of experts will discuss recent developments in ...*

- Litigation • Biotechnology/Pharmaceuticals • Foreign Patent Practice
- Information Technology/Licensing/Trade Secrets • USPTO Practice

**Wednesday, May 3, 2006**

at our new location

The Marriott Marquis • Westside Ballroom • Sixth Floor

1535 Broadway (between W45<sup>th</sup> & W46<sup>th</sup>), New York, NY

8:55 A.M. to 5:00 P.M.

Keynote Speaker



Hon. Alan D. Lourie  
Circuit Judge, U.S. Court of Appeals, Federal Circuit

New York State attorneys earn 8.0 CLE Credits  
Pennsylvania attorneys earn 6.5 CLE Credits

for further information

please visit [www.jppcle.org](http://www.jppcle.org)

This program is sponsored by the

Joint Patent Practice Continuing Legal Education, Inc. and co-sponsored by:  
Connecticut Intellectual Property Law Association  
New Jersey Intellectual Property Law Association  
New York Intellectual Property Law Association  
Philadelphia Intellectual Property Law Association

**WWW.JPPCLE.ORG**

#### CLE Day of Dinner Program and Luncheon

The New York Intellectual Property Law Association

is pleased to present the

**CLE Day of Dinner Program in conjunction with the  
84th Annual Dinner in Honor of the Federal Judiciary on  
Friday, March 24, 2006**

The program will be held at:

**The Starlight Roof at The Waldorf-Astoria**

301 Park Avenue • New York, New York

11:30-12:00 Welcome Reception

12:00-12:20 PM Lunch

2:20-2:00 PM Program

**Topic: "Due Deference? Claim Construction,  
The District Courts and The Federal Circuit"**

Speakers:

Hon. Arthur J. Gajarsa, Circuit Judge, U.S. Court of Appeals, Federal Circuit  
Hon. Donetta W. Ambrose, Chief Judge, U.S. District Court, Western District of PA  
Robert C. Morgan, Ropes & Gray LLP  
John M. Desmarais, Kirkland & Ellis LLP  
Ira J. Levy, Goodwin Procter LLP: Moderator  
Edward E. Vassallo, Fitzpatrick, Cella, Harper & Scinto: Welcoming Remarks

#### Every Lawyer in America Should Own One

The United States Mint marks the 250th anniversary of the birth of Chief  
Justice John Marshall by issuing a commemorative silver dollar in his honor.

Chief Justice John Marshall is one of the most revered figures in American legal  
history. His reputation is due not only to his 34-year term in office, the longest  
for a Chief Justice in history, but also to his masterful leadership of that body.

The coin is the first in the Mint's history to acknowledge the Great Chief  
Justice or to recognize the Supreme Court of the United States. \$10 from the sale  
of each coin benefit the Supreme Court Historical Society. The coin is available  
as a proof coin (\$39) and as an uncirculated coin (\$35). You can help the Society  
serve the Court and the nation by purchasing a John Marshall commemorative  
silver dollar. **Special offer for NYIPLA Members:** Order 5 or more proof coins

for \$36 each! For information about the

coins and ordering, visit the Society at

[www.supremecourthistory.org](http://www.supremecourthistory.org)

or call the Society toll-free at

1-888-539-4438



## A CALL FOR NOMINATIONS FOR THE 2006 NYIPLA INVENTOR OF THE YEAR AWARD

Each year, the New York Intellectual Property Law  
Association (NYIPLA) presents the *"Inventor of the  
Year Award"* in order to pay tribute to an individual or  
group of individuals who, through their inventive talents,  
have made worthwhile contributions to society by  
promoting "the progress of Science and useful Arts."

*We encourage you to nominate one or more  
candidates no later than April 3, 2006.*

The Inventor of the Year Award enables the Association  
to extend recognition to deserving innovators and  
inventors, and promote the practice of intellectual  
property law.

The Award will be presented this year at the Association's  
Annual Meeting and Dinner to be held on **May 24,  
2006**, in New York City.

For eligibility requirements and nominations forms,  
please visit [www.nyipla.org](http://www.nyipla.org)



*The Fall One Day CLE Program featured the Honorable Paul R. Michel, Chief Judge, U.S. Court of Appeals for the Federal Circuit, as the keynote speaker. The program included over 170 attendees. The program was comprised of five panels and included the following speakers and topics:*

### Panel I

#### Patent Law Reform

*Moderator - Walter Scott*

The Patent Law Reform (Analysis of HR 2795) presentations addressed patent prosecution under the proposed HR 2795 legislation. The topics and subject matter included in the presentations were the following:

(1) "Inequitable Conduct" - presented by Madeline Baer of Brown Raysman Millstein Felder & Steiner LLP. The presentation addressed changes in, and the consequences of not fulfilling, the duty of candor imposed upon a patent applicant by filing a patent application under the proposed legislation.

(2) "Changes to Patent Applications and the Application Process" - presented by John E. Tsavaris, II, Ph.D of Kenyon & Kenyon. The presentation addressed changes to the standards of patentability in the proposed legislation. In particular, the presentation focused on the proposed new definition of prior art and the elimination of the best mode requirement of 35 U.S.C. § 112, ¶ 1.

(3) "Post-Grant Opposition Proceedings" - presented by Steven R. Ludwig, Ph.D., of Sterne, Kessler, Goldstein & Fox P.L.L.C.. The presentation addressed the rationale identified by the House of Representatives subcommittee for having post-grant opposition proceedings in the United States. Additionally, the presentation identified logistical and procedural implications of the proposed legislation.

### Panel II

#### Patent Litigation Update

*Moderator - Keith Zullo*

The Patent Litigation Update (Panel II) presentations addressed current patent litigation topics. The topics and subject matter included in the presentations were the following:

(1) "Mediation At The Federal Circuit" - presented by Kevin R. Casey of Stradley, Ronen, Stevens & Young, LLP. The presentation addressed the Federal Circuit's new voluntary appellate mediation program, and the advantages and disadvantages of such mediation. The presentation included information and statistics regarding appellate mediation in other circuits, and detailed information regarding the procedures for mediation at the Federal Circuit.

(2) "Prosecution Laches As A Litigation Defense" - presented by Mark I. Koffsky of Goodwin Procter LLP. The presentation addressed *Lemelson* decision, and other decisions, as they relate to the defense of prosecution laches. The presentation also analyzed the elements of prosecution laches as a defense, and addressed how such a defense might be used in the future.

(3) "Polymorphs And Unintentional Infringement: Where Are We Now?" - presented by Errol B. Taylor of Milbank, Tweed, Hadley & McCloy LLP. The presentation addressed a historical overview of the de minimis infringement defense. The presentation considered this defense as it arose in *Smithkline Beecham Corp. et al. v. Apotex Corp., et al.*, 403 F.3d 1331 (Fed. Cir. 2005), where plaintiff asserted that defendant's product infringed even if it included only "trace amounts" of the claimed compound, and even if such trace amounts were present in the accused product despite defendant's best efforts at keeping them out. The presentation also considered how the de minimis infringement defense might be used in the future.

(4) "Sensible Legal Writing: Changing The Federal Rules Of Civil Procedure" - presented by Charles A. Weiss of Kenyon & Kenyon. The presentation addressed the proposed plain-lan-



Judge Paul R. Michel and Mark Abate

*cont. on page 10*



John E. Tsavaris II, Madeline Baer, Walter Scott, and Steven R. Ludwig

guage revisions to the Federal Rules of Civil Procedure, the proposed changes that appear to make the rules more clear, and the proposed changes that appear to have the opposite effect.

### **Panel III**

#### **Opposition Proceedings Outside the U.S.**

*Moderator - Thomas E. Spath*

The "Opposition Proceedings Outside the U.S." presentations addressed proceedings in Europe and Japan, and in particular, procedural and evidentiary issues in both nations. The topics and subject matter included in the presentations were the following:

(1) "Perspectives From Europe" - presented by Thomas Friede, a European patent attorney with the Life Sciences Group of the Bardehe Pagenberg Dost Altenburg Geissler firm in Munich. The presentation addressed the timing for filing, including late entry into an existing opposition by an accused infringer, use of a "straw man" or unidentified real party, costs and the time table. Also discussed were defenses, such as lack of novelty, obviousness and lack of supporting disclosure, and those issues that are relevant during examination, such as unity of invention, fraud and inventorship. The presentation concluded with a review of strategic reasons concerning whether to file an opposition against a patent that is affecting the opposition party's business or to seek a negotiated settlement with the patentee that would leave the patent as an obstacle to third parties. It was noted that about 10% of all European patent grants are opposed, resulting in revocations in one-third of the cases, entry of amendments to limit claims in another third, with the balance of the oppositions rejected.

(2) "Opposition Proceedings In Japan" - presented by Dale Carlson of Wiggin and Dana LLP in New Haven, CT. In addition to describing the "Trial for Invalidity" system effective, Japan from January 1, 2004, the presentation also discussed the history of the former pre-grant opposi-

tion system, replaced in 1996 by the relative short-lived post-grant opposition proceeding. The invalidity trial was described with respect to its function as the sole mechanism for challenging a patent, the evidentiary burdens, and the inter partes nature of the proceeding which is conducted by the JPO with appeals to the Tokyo High Court. A statistical analysis was presented indicating a 24% success rate in 2001, and a comparison with the European system is provided. The presentation also included the U.S. reexamination system, and the proposed U.S. post-grant opposition system.

### **Panel IV**

#### **Developments in Foreign Patent Practice**

*Moderator - Theresa M. Gillis*

The Foreign Developments presentations were directed towards recent developments in China, India and the European Patent Office. The topics and subject matter included in the presentations were the following:

(1) "Software Patents in EPC" was presented by Tony E. Piotrowski, Patent Department, Philips NV, Netherlands. The presentation addressed the circumstances under which software and computer related patent applications will be granted in the European Patent Office. The presentation included a discussion of the recent rejection by the European Parliament of proposed sweeping changes.

(2) "Recent Developments in Patent Practice in India" was presented by Ritushka Negi of Remfry & Sagar, India. The presentation included a detailed description of India's evolving participation in international patent treaties and the evolution of India's internal patent law. The presentation included a detailed description of the impact of the 1999, 2002 and 2005 amendments to the Indian patent laws.

(3) "Recent Developments in Patent Practice in the People's Republic of China" was presented by Dr. Xiang Wang, Jones Day, People's Republic of China. The presentation described recent milestones in China's efforts to harmonize its patent laws with those of other countries. The presentation described strategies for dealing with patent enforcement in China.

### **Panel V**

#### **Ethical Issues in Intellectual Property Law**

*Moderator - Alek P. Szczesny*

The "Ethical Issues in Intellectual Property Law" presentations addressed issues concerning ethic concerns prior to and during litigation. The topics and subject matter included in the presentations were the following:

(1) "Ethical Considerations in Ex-Parte Investigations"



Judge Paul R. Michel addressing the audience

- presented by Saul Seinberg, Director, Science and Technology Law Center, Albany Law School. The presentation addressed patent holder rights and ethical responsibilities when undertaking ex-parte investigations (including reverse engineering) of others' potentially infringing activities. The presentation included a detailed hypothetical that was analyzed within the context of various opinions, statutes and rules, including the Sarbanes-Oxley Act.

(2) "Use of Litigation Discovery Materials in the USPTO

and in Foreign Litigations" - presented by Jennifer Reda of Fitzpatrick, Cella, Harper & Scinto. The presentation elaborated upon the nature, availability and modification of protective orders that limit use of litigation discovery materials in proceedings foreign to those within which they were obtained. The presentation also addressed USPTO submission and expungement procedures and requirements for materials subject to a protective order.

(3) "Rule 11 Considerations in Filing Complaints and Counterclaims in Patent Cases" - presented by Gerald Flattmann of Kirkland & Ellis. The presentation addressed pre-filing requirements to avoid Rule 11 sanctions in patent litigations. In particular, the presentation focused on the preparation and use of an effective pre-filing infringement opinion and analysis to avoid sanctions.

(4) "Representing Multiple Parties in Intellectual Property Litigation" - presented by Bartholemew Verdrame of Morgan & Finnegan. The presentation addressed the benefits and limitations of representing multiple parties in IP litigations. The presentation also included client conflicts considerations, and examples and uses of common interest agreements within the context of multiple party representations.

## Jason Koral and Ian Shapiro at December 9, 2005 CLE Luncheon Program

On December 9, 2005, the NYIPLA Committees on Internet Law, Meeting and Forums and Continuing Legal Education co-sponsored a CLE Luncheon Program featuring guest speakers Jason Koral and Ian Shapiro, both associated with the law firm of Kronish Lieb Weiner & Hellman LLP. Mr. Koral and Mr. Shapiro spoke on the topic of "Pop-Up Advertising, Trademarks and the Current State of The Law."

The CLE program addressed the trademark issues in pop-up and other targeted Internet advertising systems, such as keywords. The speakers began their presentation by explaining what online contextual marketing is and how it works.

Mr. Koral then summarized the relevant statutes and caselaw, including the WhenU district court decisions of *U-Haul Int'l v. WhenU.com, Inc.*, 279 F. Supp.2d 723 (E.D. Va. 2003), *Wells Fargo & Co. v. WhenU.com*, 293 F. Supp.2d 734 (E.D. Mich. 2003), and *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp.2d 467 (S.D.N.Y. 2003),

*rev'd* 414 F.3d 400 (2d Cir. 2005), *cert. denied*. The focal point of Mr. Koral's presentation was his elucidation of the various theories of "use" proposed by the brand owner plaintiffs. Mr. Koral ended his segment of the presentation by outlining the Second Circuit's decision in *1-800-Contacts* case and the plaintiff's failed attempt at appeal to the Supreme Court.

Mr. Shapiro spoke about another form of contextual online advertising: keywords. Decisions covered included *Playboy Enterprises, Inc. v. Netscape Comm. Corp.*, 354 F.3d 1020 (9th Cir. 2004), *GEICO v. Google, Inc.*, 330 F. Supp.2d 700 (E.D. V. 2004), and *Google, Inc. v. American Blind & Wallpaper Factory, Inc.*, 2005 WL 832398 (N.D.

Cal. Mar. 30, 2005). After outlining the differences between pop-up v. keyword advertising, Mr. Shapiro discussed what may constitute trademark use in each context.

Finally, the presentation was concluded with suggestions to keyword advertisers as to how online use of others' trademarks can be modified to avoid liability.



Roberta Kraus, Ian Ross Shapiro, Jason M. Koral



## Judge William G. Young at January 13, 2006 CLE Luncheon Program

On January 13, 2006, the NYIPLA Committees on Meetings and Forums, Copyrights, and Continuing Legal Education co-sponsored a CLE Luncheon Program featuring the Honorable William G. Young from the U.S. District Court for the District of Massachusetts. The topic of the CLE Program was the "Ruminations on the Vanishing Trial: The Role of the Federal Circuit and the Fact Law Distinction." Angie M. Hankins, Esq. of Stroock & Stroock & Lavan LLP, hosted the CLE Program.

The CLE Program event was attended by almost 100 guests. Everyone enjoyed and appreciated the candor and openness of Judge Young. Judge Young discussed the role of the Federal Circuit, *Markman* proceedings, and prosecution history estoppel. On the topic of the Federal Circuit, Judge Young stated, "I have seen the future, and it is the Federal Circuit." Judge Young discussed the Federal Circuit's mission and compared and contrasted it with European courts and U.S. state and district courts. Judge Young also discussed his method for handling *Markman* proceedings. Specifically, he discussed the use of experts by the defendant and the Court and timing of



Angie Hankins & Judge William Young

*Markman* proceedings, and emphasized the importance on *Markman* briefs and oral argument. Finally, Judge Young commented on the complex nature of *Festo*. Judge Young discussed the conflict between the equitable nature of doctrine of equivalents and the fact that it rests on many factual determinations.

The CLE Program concluded with a lively question and answer session.



Mark Abate & Rory Radding



Judge William Young



Judge William Young, Angie Hankins & Amy Wilson



W Edward Bailey, Matthew Siegal & Judge William Young



Attendees

## Minutes Of October 19, 2005 Meeting Of The Board Of Directors And Committee Chairs

# NEWS FROM THE BOARD

The meeting of the Board of Directors and Committee Chairs was called to order at the Princeton/Columbia Club at 12:15 p.m. by President Ed Vassallo.

Marylee Jenkins, Anthony Giaccio, Mark J. Abate, Susan E. McGahan, Laura A. Coruzzi, Robert C. Scheinfeld, Dale L. Carlson, Vincent N. Palladino, Karl F. Milde, Jr., Philip T. Shannon, W. Edward Bailey were present. Also present were Committee representatives David Ryan, Thomas E. Spath, Charles P. Baker, Alexandra B. Urban, Allan A. Fanucci, Richard W. Erwine, Alozie N. Etufugh, William Dippert, Thomas Meloro, Meyer Gross, John B. Pegram, Ashe Puri and Stephen Quigley and Michael Isaacs of Star Consulting

Each of the Committee representatives in attendance gave a report about the activities of their Committee.

■ **Committee on Antitrust, Inequitable Conduct and Misuse:** Mr. Ryan reported on the activities of the Committee on Antitrust, Inequitable Conduct and Misuse, including writing an article for the Bulletin regarding patent tying and submitting a brief in the *ITW* case pending before the Supreme Court regarding the presumption of market power in patent cases. Mr. Ryan also discussed the recent success of the Committee's brief in the Supreme Court *Phillips* case. Also, the Committee is following a number of developments, e.g. remand of *Merck v. Integra* regarding the experimental use exception and proposed legislation to reverse the *Holmes* case regarding to Federal Circuit jurisdiction.

■ **Committee on Continuing Legal Education:** Mr. Meloro reported on behalf of the Committee on Continuing Legal Education. The Fall CLE program on November 18, 2005 has been planned and is currently being publicized. Chief Judge Michel of the Federal Circuit is the luncheon speaker and there are panel discussions relating to the patent reform legislation pending in Congress, foreign patent practice, ethics and litigation. The NYIPLA recently co-sponsored an FCBA program and made CLE credits available. Three programs are in the planning stages:

- (1) a late February copyright program;
- (2) the Judges Dinner CLE program;
- (3) the JPPLE on May 3, 2006.

■ **Committee on Design Protection:** Mr. Shannon reported on behalf of the Committee on Design Protection. The Committee will submit an article for publication in the March/April issue of the Bulletin concerning design patent enforcement in the ITC. The patent statute regarding recovery of infringers total profits and novelty and obviousness of design patents are also being considered.

■ **US Inter-Bar EPO Liaison Representative:** Mr. Spath reported as the US Inter-Bar EPO Liaison Representative. A meeting was held by the US Inter-Bar EPO in Chicago earlier this year. The Committee members will continue to be involved in a number of activities relating to harmonization of patent laws, including WIPO and U.S. Patent and Trademark Office meetings and following the bills pending before Congress.

■ **Committee on Legislative Oversight and Amicus Briefs:** Charles Baker reported on behalf of the Committee on Legislative Oversight And Amicus Briefs. The Committee will continue to organize the Association's efforts to prepare and file amicus briefs in the Federal Circuit and Supreme Court. Mr. Baker emphasized that the Committee is always looking for Association members willing to volunteer to write amicus briefs on behalf of the Association. Consideration is being given to retaining a consultant to help the Association present its views on pending patent reform legislation to New York Congressional members. Messrs. Abate, Bailey, Scheinfeld and Baker and Ms. Jenkins will consider this initiative further. Consideration is also being given to amicus participation in petitions for rehearing before the Federal Circuit.

■ **Committee on Economic Matters In The Profession:** Mr. Gross reported on the activities of the Committee on Economic Matters In The Profession. The Committee is considering malpractice insurance issues. The Committee prepared a questionnaire for insurance companies interested in writing IP insurance policies. The Committee is also looking at the quality of lawyers to defend against IP malpractice insurance claims and whether those lawyers understand our business.

■ **Committee on License to Practice Requirements:** Dale Carlson reported on behalf of the Committee on License To Practice Requirements.



The Committee is looking into proposals to require recertification of patent attorneys admitted to the Patent Office and to loosen the background requirements of attorneys sitting for the Patent Office bar examination. The Committee is also looking into the role of patent agents in the profession.

■ **Committee on Litigation Practice and Procedure:** Anthony Giaccio reported on the activities of the Committee on Litigation Practice and Procedure. The Committee intends to follow bills in Congress that will have an effect on litigation of intellectual property cases and will prepare a report.

■ **Committee on Meetings and Forums:** Alexandra Urban reported on behalf of the Committee on Meetings And Forums. Ms. Urban spoke about planning for a number of CLE meetings and that speakers for a number of luncheon meetings have already been procured.

■ **Committee on Membership:** Allan Fanucci reported on the activities of the Committee on Membership. The Committee will continue its effort to attract new members by soliciting membership at CLE meetings and at the Young Lawyers Committee activities.

■ **Committee on Public and Judicial Personnel:** Ed Bailey reported on the activities of the Committee on Public and Judicial Personnel. The Committee is interested in promoting members who aspire to judgeships. The Committee is also following threats made in Congress to impeach sitting judges and will provide a report.

■ **Committee on Public Information, Education and Awards:** Rich Erwine reported on the Committee on Public Information, Education and Awards. The Committee will coordinate activities relating to the Inventor of the Year Award and Conner Writing Competition. The Committee plans to reach out to local corporations regarding the Inventor of the Year Award and personally contact law school deans regarding the Conner Writing Competition.

■ **Committee on Publications:** Bill Dippert reported on the activities of the Committee on Publications. Ashe Puri, Chair of the Bulletin Subcommittee and Stephen Quigley, Chair of the Greenbook Subcommittee, reported on the activities of their Subcommittees. The Bulletin is interested in expanding the scope of the articles published and will publish five issues this year. The Committee will also publish the Green Book before the end of this year. Consideration is being given to including a historical record of Association's activities (*e.g.* CLE programs, amicus briefs filed) in the 2006 Greenbook.

■ **Committee on Consonance and Harmonization in the Profession (Young Lawyers Committee):** Alozie Etufugh reported on the activities of the Committee on Consonance And Harmonization In The Profession (Young Lawyers Committee). The Committee plans to

have a reception for Committee members, initiate a law student outreach program and organize networking opportunities for young lawyers.

■ **Committee of Patent Law and Practice/Adhoc Committee on Local Rules in Patent Cases:** Robert Scheinfeld reported on behalf of Committee of Patent Law and Practice and the Adhoc Committee on local rules in patent cases. The Committee has and will continue to monitor pending legislation to amend the patent statute, and has drafted a report on the pending legislation. The Committee is also considering preparing a report for submission to Congress. The Adhoc Committee of Robert Scheinfeld, Mark Abate and Daniel DeVito has prepared and drafted local rules in patent cases for proposal to the Chief Judge of the Southern District of New York. The draft will be circulated to the Board in advance of its next meeting.

■ **Committee on Trade Secret Law and Practice:** Howard Miskin reported on behalf of the Committee on Trade Secret Law and Practice.

■ **US Inter-Bar Japan Patent Office Liaison:** John Pegram reported on the activities of the US Bar-Japan Patent Office Liaison. This group meets periodically to discuss changes to Japan patent law. A meeting is scheduled for December 6, 2005 in Washington, D.C. with JPO.

After all the Committee Chairs had provided their reports, the Committee Chairs were excused and the meeting of the Board continued.

At the Board meeting, the minutes of the Board of Directors' Meeting held on September 16, 2005 were approved.

Mr. Vassallo provided the Treasurer's Report. The Association's finances are sound.

There was a discussion concerning the "Anti-Dilution Act." Vince Palladino, who was asked to consider the INTA, New York City Bar Association and Trademark Committee proposals, summarized the issues and possible positions the Association could adopt. Because a number of issues created by the New York City Bar Association proposal, the Board has decided not to support and not to oppose that proposal.

Mr. Giaccio discussed planning for the Annual Meeting and Dinner in May. A number of ways to boost attendance at the Dinner were discussed.

Mr. Vassallo reported on the Annual Dinner in Honor of the Federal Judiciary. Messrs. Isaacs, Hughes, Vassallo and Abate will be meeting with the Waldorf regarding the Dinner next week.

The meeting was adjourned at 2:00 p.m.

The next meeting of the Board is scheduled for Wednesday, November 16, 2005 at 12:00 Noon at the Princeton/Columbia Club.



## SOUTHERN DISTRICT CASE REVIEW

by Mark J. Abate and Jennifer BianRosa<sup>1</sup>

### WORLD TRADE CENTER FREEDOM TOWER COPYRIGHT INFRINGEMENT CLAIM SUSTAINED

**Shine v. Childs**

2005 U.S. Dist. Lexis 16525

(S.D.N.Y. August 4, 2005)

(Judge Michael B. Mukasey)

As a student of the Yale School of Architecture, Thomas Shine developed a design for a skyscraper in connection with a required class in the fall of 1999. Shine developed a preliminary model "Shine '99" in October 1999. The model was a tapered tower with "two straight, parallel, roughly triangular sides, connected by two twisting facades, resulting in a tower whose top [is] in the shape of a parallelogram." A later design entitled "Olympic Tower" was "a twisting tower with a symmetrical diagonal column grid, expressed on the exterior of the building, that follows the twisting surface created by the floor plates' geometry" creating an elongated diamond pattern. Both designs were later registered as architectural works with the U.S. Copyright Office. Shine presented designs for Olympic Tower and the Shine '99 model to a panel of experts for critique, of which Defendant Childs was a member. Childs praised Shine's design during the presentation, and individually after the presentation.

Shine alleged that Childs, a design architect and project manager for the Freedom Tower at the World Trade Center (WTC) site, copied Shine's design in his plans for the Freedom Tower. Shine sued for copyright infringement citing substantial similarities to Shine '99, a structural grid identical to Olympic Tower and a strikingly similar façade to Olympic Tower. Childs moved for summary judgment.

The Court noted that both of Shine's designs were worthy of protection under the Architectural Works Copyright Protection Act (AWCPA) which protects the "overall form as well as the arrangement and composition of spaces and elements in the design" of an architectural work.

The Court reasoned that while Shine '99 was

a "rough model, [it] is more than a or an idea; it is a distinctive design for a building" and that "whether a tower could actually be constructed from this model was irrelevant" citing two Second Circuit decisions: *Attia v. Soc'y of the N.Y. Hosp.*, 201 F.3d 50, 57 (2d Cir. 1999) and *Sparaco v. Lawler, Matusky & Skelly Eng'rs LLP*, 303 F.3d 460, 469 (2d Cir. 2002).

The Court also dismissed defendants' arguments that Shine's designs were unoriginal. The Court remarked that while twisting towers, towers with diamond windowed facades, towers with support grids similar to Olympic Tower and towers with setbacks had been built before, there was no evidence that "the particular combinations of design elements present in either Shine '99 or Olympic Tower are unoriginal."

Because defendants conceded that Childs had access to both Shine '99 and Olympic Tower in his role as a panel member of experts at the Yale School of Architecture, only a "probative similarity" between the copyrighted works and the Freedom Tower design was necessary to show actual copying. An issue of material fact remained as to whether Childs actually copied Shine's Olympic Tower, the court used the "total concept and feel" test to determine whether reasonable jurors could find that a substantial similarity exists between Olympic Tower and the Freedom Tower. A more discerning ordinary observer standpoint was used to determine if there was a substantial similarity between only those elements "that provide copyrightability to the allegedly infringed compilation" in conjunction with the total concept and feel test.

The Court pointed out such similarities between Olympic Tower and the Freedom Tower as both towers taper and twist, each tower has an undulating textured diamond patterned façade, and the façade's diamond shapes conclude at the foot of each tower where more than half open to allow for entry as well as differences including the number of sides of each tower that twist, the direction of each tower's twist, and the shape of each tower's ground floor. The Court found that reasonable jurors could disagree as to the substantial similarity between Olympic Tower and the Freedom Tower and denied defendants'

*cont. on page 16*

motion for summary judgment as to Shine's claims regarding Olympic Tower. The Court also noted that Childs's alleged infringing design was later substantially redesigned with "little similarity to either of Shine's copyrighted works" and that the alleged infringing design was unlikely to be constructed.

## PATENT SEARCHES PERFORMED IN THE ORDINARY COURSE OF BUSINESS TO ATTACK THE VALIDITY OF COMPETITOR'S PATENTS NOT PROTECTED AS WORK PRODUCT

**Takeda Chem. Indus., Ltd. v.**

**Alphapharm Pty. Ltd.**

2005 U.S. Dist. LEXIS 14308

(July 19, 2005)

(Judge Denise Cote)

Plaintiff Takeda Chemical Industries, Ltd. ("Takeda") in a patent litigation moved to compel defendant generic drug companies Alphapharm Pty, Ltd ("Alphapharm") and Genpharm, Inc. ("Genpharm") to produce "all documents concerning patent searches performed and scientific positions formulated by non-legal employees of the defendants' sister company, Generics U.K." The Court addressed whether documents concerning patent searches are protected by the work product doctrine under

Rule 26(b)(3) of the Federal Rules of Civil Procedure as documents prepared "in anticipation of litigation".

Generics U.K. conducted the investigation of all patents concerning the pharmaceuticals of interest to Merck Generics, of which Defendants are subsidiaries. Under the instruction of Merck Generics, Generics U.K. investigated the patent status of the drug pioglitazone hydrochloride ("pioglitazone"), marked under the brand name Actos by Takeda. Generics U.K. discovered that Takeda was the assignee of U.S. Patent No. 4,687,777 ("the '777 patent") directed toward the pioglitazone molecule and decided that it could attack the '777 patent's validity based on prior art. Genpharm notified Takeda of Alphapharm's ANDA filing to market a generic version of pioglitazone and Alphapharm's Paragraph IV certification that the '777 patent was invalid or unenforceable. Takeda then sued Alphapharm and Genpharm as the ANDA "constitutes an act of patent infringement as a matter of law" and "the filing of the certification of invalidity invariably leads to litigation".

In conducting its patent searches on pioglitazone, Generics U.K. consulted outside counsel and received specific instructions as to how "Merck Generics should in the first instance proceed with patent searches regarding compounds that Merck Generics intends to market in the United States." The partner later confirmed that the searches for the pioglitazone prior art "'were performed pursuant' to his instructions." Takeda requested an order compelling the production of "all documents concerning patent searches performed by non-legal employees of Generics U.K. and scientific positions formulated by non-legal employees of Generics U.K." which defendants asserted were privileged under Rule 26(b)(3) of the Federal Rules of Civil Procedure as documents prepared "in anticipation of litigation".

The Court cited *United States v. Adlman*, 134 F.3d 1194 (2d Cir. 1998) in identifying that "in anticipation of litigation" is a question of "whether [the particular document] would have been prepared irrespective of the expected litigation" and that in order to win protection for the document a party must prove that it "was created because of anticipated litigation, and would not have been prepared in substantially similar form but for the prospect of that litigation." The court observed that defendants regularly conducted initial patent searches and analyses to determine "the vulnerability of those patents to an attack of invalidity based on prior art" in the ordinary course of business. The court also dismissed defendants' argument that the patent search be protected as performed "on the instructions" of an attorney since outside counsel merely provided advice as to how to conduct a search, but did not order the search performed.

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Since the patent searches were conducted in the ordinary course of business and would have been performed irrespective of the litigation the court held that the documents in question were not entitled to work product protection. The Court also noted that the patent searches were performed well before the litigation and before Alphapharm determined whether it would file an ANDA. The Court granted Takeda's motion to compel the production of documents relating to the results of patent and prior art searches performed by Generics U.K. However, the court added that documents created after the defendants determined the possible invalidity of the '777 patent may be protected under Rule 26(b)(3).

## **MOTION FOR SUMMARY JUDGMENT OF PATENT INFRINGEMENT DENIED IN PART AND GRANTED IN PART**

**Applied Interact, LLC v.**

**The Vermont Teddy Bear Co., Inc.**

2005 U.S. Dist. LEXIS 19070

(July 24, 2005)

(Judge Harold Baer, Jr.)

Plaintiff Applied Interact, LLC (AI) filed suit against The Vermont Teddy Bear Co., Inc. ("VTB") for infringement of four patents (U.S. Patent Nos. 5,227,874 ("the '874 patent"), 5,249,044 ("the '044 patent"), 5,508,731 ("the '731 patent"), and 5,713,795 ("the '795 patent") (the "patents in suit")), all of which relate to methods of communication between an "organizer" and audience members in remote locations. In particular, "[t]he patents contemplate that the organizer will broadcast certain stimuli, such as product advertisements or sweepstakes; the audience members will respond to the stimuli from remote locations and be able to generate product coupons at those remote locations; and that the organizer will evaluate the individual responses."

AI alleged that VTB infringed the patents in suit by communicating to its customers through VTB's internet site. The VTB site offered visitors a coupon for a free tour of its factory, allowed visitors to search for product information and invited visitors to sign up for a sweepstakes to win a free teddy bear. AI also claimed that VTB induced customers to perform certain steps of the disputed claims by the offers and design of the VTB web site.

VTB filed the present motion for summary judgment. The court agreed with VTB that there was no genuine issue of material fact with regards to AI's claim of inducement of infringement. As to VTB's summary judgment motion on AI's claims for direct infringement, the Court

noted that while several courts have held a party liable for direct infringement under 35 U.S.C §271(a) when one party performed some steps of a method claim while another entity performed the other steps, "some connection" between the two was necessary. The Court found, in part, that there was "some connection" between VTB and its customers when customers printed coupons for a free tour of the VTB factory, searched for products, or entered in a sweepstakes as the customers did so according to VTB's instructions on the web site.

The claim language of Step 2 of Claim 10 of the '874 patent required "providing said individuals with electronically programmable token dispensers capable". The term "electronically programmable token dispensers" was construed as hardware for printing a hard copy record, or coupon. The parties disputed the definition of the term "providing." The Court consulted the American Heritage Dictionary in construing the term to mean "furnishing, supplying, or making available already-existing [equipment]." Under this construction, the Court held that there was a genuine issue of material fact as to whether "VTB and its customers are directly connected through the Internet, and that customers who accept VTB's offer obtain the free factory tour by following VTB's instructions to print out the coupon and redeem it at VTB's factory." As to the claim language of Step 4, Claim 10, which read, in part, "programming said dispensers by means of electronic instructional signals transmitted from a central location", the Court found that a javascript command on VTB's coupon web page "programmed" the customer's printer and satisfied the claim language.

The claim language at issue of the '044 patent required, in part, "providing a system at a remote location". VTB maintained that it never provided its customers with hardware. The Court disagreed, and found that a genuine issue of material fact remained as to whether "VTB had "some connection" to its customers when they supplied or made available their computer systems to search for products on VTB's web site."

The claim language at issue of Claim 26 of the '795 patent required a "player's wager entry". AI asserted, but the court disagreed, that VTB customers "wagered" their personal information in exchange for a sweepstakes entry. The Court granted VTB's motion for summary judgment of noninfringement of the '795 patent.

The claim language at issue of Claim 62 of the '731 patent required "providing means for communicating response data from the locations of responding members to a central data storage facility". The parties disputed whether the claimed means included software or hardware. The Court declined to resolve whether the means "encompasse[d] just hardware or both software

*cont. on page 18*



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and hardware” because AI raised a triable issue as to whether VTB in combination with its customers “provide a means for communicating response data.” The Court noted that there was “some connection” between VTB’s provision of an Internet connection to customers and VTB’s customers own Internet connections which respond to VTB’s online invitations.

## PRELIMINARY INJUNCTION OF TRADEMARK INFRINGEMENT GRANTED ON REMANUFACTURED WATCHES

**Cartier v. Symbolix, Inc.**

2005 U.S. Dist. LEXIS 10841

(June 1, 2005)

(Judge Richard J. Holwell)

Plaintiff Cartier moved for a preliminary injunction to enjoin defendants from altering genuine stainless steel Cartier watches. Defendants mounted diamonds on pre-owned stainless steel Cartier watches at the request of customers in order to simulate Cartier’s more expensive white gold watches.

Cartier utilized a private investigator to discover that defendants proposed to sell the investigator a Cartier Tank Francaise stainless steel model with diamonds added on the bezel and case for \$ 6,000 or \$5,750; the genuine model cost \$ 14,500 in comparison. Cartier contended that Ahmed Saleh, principal for the defendants, asserted that he “had been doing it for ten years.” In subsequent conversations with the investigator Saleh reassured her that the stainless steel was “polished” to give the appearance of white gold and stated that “They are exactly identical.” Saleh also placed a picture of the Cartier Tank Francaise watch in stainless steel altered with diamonds in a Dallas newspaper advertisement remarked that no one could tell the difference between the two.

After obtaining the altered watch, a Cartier official inspected it and noted the “marked inferiority in the aesthetic appearance as compared to comparable genuine diamond-set Cartier watches.” He also noted that the “the setting of the diamonds was done in a sloppy manner, resulting in a cheap, shoddy looking item.”

In order to prevail on its trademark infringement claims under § 1114 of the Lanham Act, Cartier must show that the defendants “(1) without consent, (2) used in commerce, (3) a reproduction, copy or colorable imitation of plaintiff’s registered mark, as part of the sale or distribution of goods or services, and (4) that such a use is likely to cause confusion” As defendants

did not dispute elements (1) and (3), only the issues of whether defendants’ activities in reselling the altered Cartier watches constituted “the unlawful exploitation of plaintiffs’ trademark “in commerce” and [was] likely to cause confusion” remained.

The defendants argued that because the product was modified at the request of the customer and not offered for sale to the general public, the Lanham Act did not apply. The Court cited *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 130 (1947) in noting that “a second-hand dealer may reap some advantage from an existing trademark as long as the trademark holder is “not identified with the wear and tear or reconditioning by the dealer.” The Court, however, distinguished the case at hand as “the changes defendants made to the watches are not the sort of simple reconditioning or repairs performed in *Champion Spark Plug*, but are unauthorized, substantial modifications resulting in ‘new construction[s].’” The fact the modification was made at the request of a customer was irrelevant as “once a product is injected into commerce there is no bar to confusion, mistake, or deception occurring at some future point in time.” (citing *Rolex Watch USA, Inc. v. Meece*, 2000 U.S. Dist. LEXIS 20583 (N.D. Tex. 2000) and *Rolex Watch USA v. Michel Co.*, 179 F.3d 704 (9th Cir. 1999)).

The Court found that defendants impermissibly used the Cartier trademark “in commerce” as contemplated by the Lanham Act. The Court also found that plaintiffs showed a likelihood of confusion especially noting that “defendants’ products is designed to deceive the public” and that “Cartier faces the palpable loss of goodwill once consumers perceive the “cheapening” and dilution of the brand and granted plaintiffs’ motion and entered a preliminary injunction against the defendants enjoining them from altering and selling Cartier watches.

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