

NYIPLA[®]

Bulletin

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Just How Bliss Is Ignorance? The Supreme Court Grants Certiorari to Determine the Standard of Intent Required for Induced Infringement

by Dorothy R. Auth, Jason M. Rockman and Jack Shaw

1) Introduction

International business is increasingly reliant on out-sourcing parts of products--or even entire products--to overseas manufacturers in order to remain competitive. "Made in China, designed by company ABC" is found on elite consumer and commercial products and has become an accepted hallmark of quality, reliability and competitive pricing.

Recently, the United States Supreme Court accepted review of a basic patent enforcement principle which has become an increasingly common business practice that companies which market these products in the U.S. must be acutely aware of in order to not find themselves in a federal court accused of induced infringement. Succinctly put, if your contractor creates or helps create a copy of a component or a product protected by a U.S. patent, here or overseas, that contractor may be held liable for inducing infringement even though he does not directly infringe or even have knowledge of the patent.

In the case on certiorari, the U.S. Supreme Court will review the Federal Circuit's holding that one whose conduct demonstrates "deliberate indifference" of an obvious risk of infringing

a United States patent may have the requisite intent to be held liable for inducing infringement under 35 U.S.C. §271(b). In *SEB S.A. v. Montgomery Ward & Co., Inc.*, 594 F.3d 1360 (Fed. Cir. 2010) ("*SEB*"), the defendant was found liable for inducing infringement of an asserted patent despite the fact that no proof was provided that the defendant knew of the subject patent.

The question presented for review by the Supreme Court is whether the legal standard for the state of mind element of a claim for actively inducing infringement under §271(b) includes one of "deliberate indifference of a known risk" that an infringement may occur, as the Federal Circuit held, or whether the standard requires "purposeful, culpable expression and conduct" to encourage an infringement, as the U.S. Supreme Court held in a copyright case, *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 937, 125 S. Ct. 2764, 2780, 162 L. Ed. 2d 781, 801 (2005)[("*Grokster*")]. *Global-Tech Appliances, Inc. v. SEB S.A., cert. granted*, 79 U.S.L.W. 3220, 3226 (U.S. Oct. 12, 2010) (No. 10-6).

This article will explore the development of inducement law, the issues that may have piqued the Supreme Court's interest to review the induce-

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November 2010

Dear Fellow Members,

I am pleased to report that this year's Fall CLE program at the Princeton Club was a big success. The fine program of panel discussions before a packed house was organized by CLE Co-Chairs Anna Erenburg and Rich Parke working in close concert with their active committee members under the watchful eye of Board Liaison Dorothy Auth.

A special hat tip goes to our Past President Marylee Jenkins for inviting Don Martens, and to Jessica Copeland for inviting Chief Judge Paul Luckern of the International Trade Commission as speakers for this event. Both Chief Judge Luckern and Don easily pass muster under the "10,000 hours" of experience requirement that best selling author Malcolm Gladwell suggests in his new book "Outliers - The Story of Success" is needed to be an "outlier" (read "luminary") in any field of endeavor. Their vast experience was aptly reflected in their fine presentations.

A special thank you is owed to Paul Slater for his all-day trip from Chicago through inclement weather to grace us with an excellent patent anti-trust presentation.

Also a big success was our October 15th CLE luncheon program at the Harvard club organized by Meetings & Forums Committee Co-Chairs Jay Anderson and Rich Martinelli working closely with Board Liaison Ira Levy. The program, which included a good mix of prosecution and litigation topics, is summarized elsewhere in this issue of the Bulletin.

Needless to say, our committee activities for the year are in full swing. If you haven't already done so, now is a good time to reach out to a committee chair or co-chair as a first step to becoming active. All of the Association's committees and their chairs are listed in this Bulletin and on the *nyipla.org* web site. While active committee par-

ticipation is its own reward, it also benefits our employers by enabling us to develop networking connections and helping us grow in the field. It also contributes to that 10,000 hours of experience that Mr. Gladwell and others believe is important for taking on future leadership roles in both our Association and beyond.

Our next CLE gathering will be at the Harvard Club on December 13th featuring a lecture by Chief Judge Randall Rader of the Federal Circuit. Please consider attending. It will help you stay informed and stay connected to the Association.

Even though there's no snow on the ground yet, our 89th Waldorf dinner in honor of the federal judiciary is "just around the corner" on March 25, 2011. The NYIPLA's Outstanding Public Service award will be presented to the Hon. Arthur Gajarsa of the Federal Circuit. Judge Gajarsa has an extensive background in the patent and international law arenas, and has strong ties to our Association's geographical region.

At the Waldorf dinner we will also present a lifetime achievement award posthumously in honor of the diamond anniversary of the Hon. Giles S. Rich's term as President of our Association in 1950-51.

The keynote speaker at the dinner will be the Hon. John Gleeson. Judge Gleeson sits on the bench of the Eastern District of New York. His

speech will be presented after dinner, marking a return to the historical format used prior to Mayor Rudy Giuliani's appearance at the podium in 1996.

All-in-all, the March 25th gathering promises to be most enjoyable one - one that hopefully will evoke echoes of its origin in 1922, namely a dinner that is for judges and about judges. That is, of course, why we call it our "judges dinner". Hoping to see you then, if not sooner.

With kind regards,
Dale Carlson



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ment question in *SEB*, and practical considerations in light of potential outcomes from the Supreme Court’s review.

2) Facts and Background to *SEB*

The Supreme Court granted review of the inducement standard as it was applied by the Federal Circuit in *SEB*, a case involving technology related to consumer deep-fryers. In *SEB*, the plaintiff-patentee sued various defendants, including Pentalpha Enterprises, Ltd. (“Pentalpha”), for, *inter alia*, inducing infringement of SEB’s U.S. Pat. No. 4,995,312 (“‘312 patent”). See *SEB*, 594 F.3d at 1365. Pentalpha developed an accused deep-fryer after purchasing the patentee’s commercial product and copying its patented features. *Id.* at 1366. Pentalpha then sold the accused deep fryers to parties in Hong Kong or China, who subsequently sold the products in the US. *Id.*

Before selling its accused deep-fryers, Pentalpha obtained a right-to-use opinion from a patent attorney located in Binghamton, NY, who analyzed 26 patents and concluded that none of the claims in those patents read on the accused deep fryers. *Id.* The patent attorney did not identify or analyze the SEB patents at issue. Moreover, Pentalpha never told the attorney that it had copied the SEB deep fryer. *Id.*

At trial, Pentalpha asserted that it could not have induced infringement because of “the lack of evidence that anyone at Pentalpha ‘had any knowledge whatsoever with respect to the existence of the ‘312 patent.’” *Id.* at 1367. The Federal Circuit affirmed the finding of inducement against Pentalpha, holding that the “knowledge of the patent” requirement for finding inducement¹ can be satisfied by showing a “deliberate indifference of a known risk” of the existence of a patent. *SEB*, 594 F.3d at 1377.

Pentalpha argued in its Petition for Certiorari that the deliberate indifference standard applied by the Federal Circuit conflicts with the Supreme Court’s standard in *MGM Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005), which requires that the state of mind element for actively inducing patent infringement requires “affirmative intent that the product be used to infringe.” Brief for the Petitioners at 7, *Global-Tech Appliances, Inc. v. SEB S.A.*, No. 10-6 (U.S. June 23, 2010). Pentalpha asserts that the standard expressed by the Federal Circuit in *SEB* does not require affirmative intent and is contrary to *Grokster*’s admonition that “mere knowledge of infringing potential” is not sufficient to subject one to liability. *Id.* at 8-9 (citing *Grokster*, 545 U.S. at 937). Under the Federal Circuit’s new deliberate indifference standard, according to Pentalpha, a trier of fact could find that an alleged inducer “deliberately disregarded a known risk,” and induced infringement in “virtually any situation.” *Id.* at 12.

A brief review of the history of inducement law is warranted here to understand the roots of the “deliberate

indifference” concept and whether any of Pentalpha’s allegations have merit.

3) The Origin and Development of Inducement Law

Prior to the enactment of the Patent Act of 1952, no legislation defining direct or indirect infringement existed. See 5-17 DONALD S. CHISUM, CHISUM ON PATENTS §17.04 (Sept. 2010); accord *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468-69 (Fed. Cir. 1990) (“*HP*”). During that time, common law patent infringement was divided by the courts into direct infringement, which was the unauthorized making, using or selling of the patented invention, and contributory infringement, which was any other activity where, although not technically making, using or selling, the defendant displayed sufficient culpability to be held liable as an infringer. *HP*, 909 F.2d at 1469.

When the Patent Act of 1952 was enacted, the single concept of common law contributory infringement was divided between section 271(b) for active inducement, and section 271(c) for contributory infringement. Section 271(c) covered the sale or offer for sale of a component that is especially made for use in a patented combination or process, without a substantially non-infringing use. Section 271(b) originally codified the pre-1952 case law on contributory infringement “other than through the sale of a component especially adapted for infringing use.” See 5-17 DONALD S. CHISUM, CHISUM ON PATENTS §17.04 (Sept. 2010); *HP*, 909 F.2d at 1468-69.

Section 271(b), however, which states that “[w]hoever actively induces infringement of a patent shall be liable as an infringer” evolved throughout the years since its enactment. For example, although this section did not expressly contain any language regarding the requisite intent or knowledge to be liable as an inducer, the legislative history and case law uniformly impose such a requirement. See 35 U.S.C.S. §271 (n.39) (2010) (“Inducement of infringement prohibited by 35 USCS § 271(b) has connotations of active steps knowingly taken, knowingly at least in the sense of purposeful, intentional, as distinguished from accidental or inadvertent . . .”); *Water Technologies Corp. v. Calco, Ltd.*, 850 F.2d 660, 668 (Fed. Cir. 1988) (citing 4 D. CHISUM, PATENTS §§ 17.04[2], [3] (1984)); *HP*, 909 F.2d at 1469 (in view of the very definition of “active inducement” in pre-1952 case law and the fact that §271(b) was intended as merely a codification of pre-1952 law, the intent element is required for finding inducement liability).

Water Technologies was one of the first Federal Circuit cases to address the question of the intent required to demonstrate inducement. In *Water Technologies*, the defendant was a material developer who asserted that,

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because there was no proof that he had knowledge that a manufacturer's acts using his formulations were directly infringing, he could not be liable as an infringer. 850 F.2d at 668. The Court, however, found that this assertion was contradicted by evidence that the defendant helped the manufacturer develop the infringing products and consumer use instructions, and exerted control over the manufacturer's infringing acts. *Id.* The Federal Circuit focused the intent inquiry on the knowledge that an alleged inducer has with respect to the infringing nature of another's directly infringing conduct, holding that "a person infringes by actively and knowingly aiding and abetting another's direct infringement." *Id.* (emphasis in original).

Two years later, in *HP*, the Court added that "proof of actual *intent to cause the acts* which constitute the infringement is a necessary prerequisite to finding active inducement," 909 F.2d at 1469 (emphasis added). Here, the Court focused on whether the defendant intended to cause the infringing acts themselves, as opposed to, for example, simply knowing that another's acts constitute infringement. In *HP*, the defendant sold a division of its business that made, among other things, the accused products. *Id.* at 1470. As part of the sales agreement, the defendant included an indemnification clause as to any liability imposed on the buyer for infringement of the patents at issue. *Id.* at 1467. Although the Court acknowledged that indemnification clauses can create an inference of intent, its inclusion here was merely part of the defendant's goal to sell the division at the best price. *Id.* at 1470. As a result, the Court held that the defendant had "no interest in nor control over what [the

buyer] chose to do" with the division after the sale. *Id.* at 1469. Therefore, according to the Federal Circuit, the defendant did not have the requisite intent to be liable as an infringer, because it did not intend to cause the buyer's infringing acts. *Id.* at 1469-70.

A few months later, the Federal Circuit decided *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544 (Fed. Cir. 1990), which relied on the *Water Technologies* and *HP* cases to define the inducement standard. The *Manville* Court held that a defendant must possess *specific intent to encourage another's infringement* and not merely have knowledge of the acts alleged to constitute inducement. *Id.* *Manville* also established that the plaintiff has the burden of showing that the alleged infringer's actions induced infringing acts and that he knew or should have known his actions would induce actual infringements. *Id.*

This "should have known" prong of the *Manville* standard is the first appearance of this lower threshold and may have opened the door to allegations of inducement where a defendant did not have actual knowledge of a patent for which the defendant's actions induced infringement, or, for example, as in *Insituform Techs., Inc. v. CAT Contr. Inc.*, 161 F.3d 688 (Fed. Cir. 1998), where the Court added in *dicta* that constructive knowledge of the patent may be sufficient. *Id.* at 695. Based on the facts, the Federal Circuit in *Manville* held the defendants not liable for inducing infringement because the evidence showed they were not aware of patent-in-suit before the suit was filed, and their subsequent actions were conducted with a "good faith belief" that their product did not infringe based on the advice of counsel. *Manville*,

NYIPLA Calendar

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917 F.2d at 553-54.

In 2005, the Supreme Court took up the issue of intent required for inducement liability in *Grokster*, a copyright case. 545 U.S. 913 (2005). In that case, the Supreme Court held that:

Evidence of "active steps . . . taken to encourage direct infringement," such as advertising an infringing use or instructing how to engage in an infringing use, show an affirmative intent that the product be used to infringe, and a showing that infringement was encouraged overcomes the law's reluctance to find liability when a defendant merely sells a commercial product suitable for some lawful use.

Id. at 936. However, the *Grokster* Court made clear that mere knowledge of infringing potential or of actual infringing uses is not enough to subject a distributor to liability, absent a showing of affirmative intent to induce infringement. *Id.* at 937. The Supreme Court limited induced infringement to "purposeful, culpable expression and conduct," finding on the facts that acts of advertising infringing uses to potential infringing users met this threshold. *Id.*

After *Grokster*, the Federal Circuit again took up the issue of the intent necessary to prove inducement in a patent context in *DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293 (Fed. Cir. 2006), where a plaintiff patent holder argued that, under *HP*, an alleged inducer need only have caused the acts of direct infringement of another to be held liable as an infringer. *Id.* at 1305. The Federal Circuit disagreed, pointing to the Supreme Court's holding in *Grokster*, that "purposeful, culpable expression and conduct" are required. Citing *Manville*, the *DSU Medical* Court required that the defendant's actions induce infringing acts and that he knew or should have known his actions would induce actual infringements. *Id.* at 1304 (quoting *Manville*, 917 F.2d at 553). However, *DSU Medical* emphasized that even under this standard, knowledge of the patent is required. *Id.*

Based on this precedent, the issue of inducement was again presented to the Federal Circuit in *SEB*.

4) *SEB* Creates a New Type of Intent For Inducement

Although the *SEB* Court acknowledged that a party must possess specific intent to encourage a third party's direct infringement, the Court then looked outside of the patent law context to determine how specific intent should be defined. *SEB*, 594 F.3d at 1376 (quoting *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (Fed. Cir. 2008) (quoting *DSU Medical*, 471 F.3d at 1306)) ("specific intent in the civil context is not so narrow as to allow an accused wrongdoer to actively disregard a

known risk that an element of the offense exists."'). The Court borrowed the notion of deliberate indifference from two federal civil appellate cases, *Crawford-El v. Britton*, 951 F.2d 1314 (D.C. Cir. 1991) and *Boim v. Holy Land Found. for Relief & Dev.*, 549 F.3d 685 (7th Cir. 2008). In *Crawford*, the Court equated specific intent and deliberate indifference with respect to whether a corrections officer violated a prisoner's constitutional rights by diverting the prisoner's legal documents, purposefully or with "deliberate indifference," to interfere with his litigation. Here, "deliberate indifference" was defined as an example of an "intent to interfere." 951 F.2d at 1318. In *Boim*, a case involving funding for terrorist organizations, the Seventh Circuit stated that one who knowingly donates to terrorist organizations, or donates with "deliberate indifference" as to whether a group is a terrorist organization, is guilty of intentional misconduct. In this context, "deliberate indifference" was defined as knowledge of a substantial probability of the occurrence of a fact without caring about whether it indeed occurs or not. 549 F.3d at 693.

Applying these cases to its new standard, the *SEB* Court distinguished "deliberate indifference" from the "knew or should have known" test of *DSU Medical* by explaining that "should have known" implies a solely objective test, while "deliberate indifference" may require a subjective determination that the defendant knew of and disregarded the overt risk that an element of the offense existed. *SEB*, 594 F.3d at 1376 (citing *Farmer v. Brennan*, 511 U.S. 825, 840 (1994)); see generally, BLACK'S LAW DICTIONARY (9th ed. 2009) ("objective standard" is based on conduct and perceptions "external" to a particular person, and "subjective standard" is a legal standard that is "peculiar" to a particular person and based on the person's individual views and experiences)). In this context, an accused inducer may thus overcome a showing of deliberate indifference by demonstrating that it was genuinely "unaware even of an obvious risk" of patent infringement. *SEB*, 594 F.3d at 1376-77 (citing *Farmer*, 511 U.S. at 844).

The *SEB* Court further elaborated that "deliberate indifference of a known risk is not different from actual knowledge, but is a form of actual knowledge." *SEB*, 594 F.3d at 1377. In reaching this conclusion, the Federal Circuit again explored outside the realm of the patent law jurisprudence, finding support in two cases from regional appeals courts. The first case, a criminal case, *United States v. Carani*, 492 F.3d 867 (7th Cir. 2007), held that "[d]eliberate avoidance is not a standard less than knowledge; it is simply another way that knowledge may be proved." *Id.* at 873. The other, *Woodman v. WWOR-TV, Inc.*, 411 F.3d 69 (2d Cir. 2005), held in a civil case that "a party's knowledge of a disputed fact

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may also be proved through evidence that he consciously avoided knowledge of what would otherwise have been obvious [to] him.” *Id.* at 84 n.14.

5) Why Now? And How Will the Standard of Inducement Be Changed?

SEB’s “deliberate indifference” standard will now be reviewed by the Supreme Court, where the question presented squarely pits “deliberate indifference” against *Grokster*’s “purposeful, culpable expressions and conduct” level of intent. Certainly, the Supreme Court recognizes that, generally, inducement has become an important pleading for patent holders in a world where infringement allegations increasingly implicate many actors, within or outside of the United States, where factors such as outsourcing practices, multi-component complex technologies, and the global transfer of information technology play key roles in business practices.

Under the broad umbrella of these holdings, the Court will likely consider the apparent contradictions between *Grokster* and *SEB*; for example, whether *Grokster*’s holding that a “mere knowledge of infringing potential or of actual infringing uses” is insufficient to show inducement can be reconciled with *SEB*’s holding that deliberate disregard of potentially infringing activities may itself be sufficient to show induced infringement. *Grokster*, 545 U.S. at 937; *SEB*, 594 F.3d at 1376. In addition, under *SEB*, actual knowledge of a patent does not seem to be required; and constructive knowledge of a patent or avoidance of a known risk of a patent’s existence may be deemed a form of actual knowledge; whereas, in *Grokster*, actual knowledge of a patent’s existence is a prerequisite to liability under the “purposeful, culpable expressions and conduct” standard. These discrepancies will likely be addressed by the Supreme Court.

One *amicus* brief by 26 law, economics, and business professors filed with the Petition for Certiorari argues that the *SEB* standard reduces §271(b) to a negligence standard and makes §271(c) superfluous. The professors explain that cases of alleged infringement that would otherwise fit within §271(c), but would not result in secondary liability for failing to meet the requirement for substantial non-infringing uses under that section, now become infringing conduct under §271(b). Brief Amici Curiae of 26 Law, Economics, and Business Professors in Support of Petitioners at 5, *Global-Tech Appliances, Inc. v. SEB S.A.*, 79 U.S.L.W. 3220, 3226 (July 29, 2010) (No. 10-6) (“Brief Amici Curiae”). This, the professors argue, cannot be right.

Perhaps, on the other hand, the Supreme Court wishes to reprise *Grokster* in the patent context. Although *Grokster* is accepted as controlling law, that decision involved copyright infringement. This current Supreme Court case will review inducement in a modern-day patent infringement context. In that respect, the facts of *SEB* accommodate a review because they present a typical case of inducement to infringe a United States patent via

the design, manufacture and/or sale of infringing products overseas, and subsequent sale of infringing products in the U.S. The facts of *SEB* also invite review because the defendant, Pentalpha, was not shown to have actual knowledge of the patent, and *Grokster* by definition did not address this situation. See *SEB*, 594 F.3d at 1373. Therefore, the facts in *SEB* may provide the Supreme Court a chance to clarify the requisite level of knowledge of the patent needed to prove inducement.

Regardless of how the Supreme Court rules, it is likely that one party will benefit. For example, should the Supreme Court favor a more rigorous *Grokster*-type standard, defendants will stand to benefit in that a requirement of “purposeful, culpable conduct and expression” and actual knowledge of the patent raises the evidentiary burden of the patentee. Under the *Grokster* standard, the defendant who chooses to remain ignorant of potential patent rights may avoid inducement. In contrast, patentees are likely keen to see a less rigorous standard in place; *i.e.*, a *SEB*-type standard in which an alleged inducer’s conduct will be examined subjectively to determine whether ignorance was actively chosen. Under this standard, inducing infringement may, in some circumstances, be found even where no evidence exists that the alleged infringer had actual knowledge of the patent or intent to induce the acts of infringement. See *SEB*, 594 F.3d at 1377.

Conclusion

Patent practitioners are well advised to watch for the Supreme Court’s decision in the *SEB* case. The various differences between the “deliberate indifference” and “purposeful, culpable expressions and conduct” standards announced in the question presented implicate a host of issues. The answers to the question presented are sure to impact patent infringement lawsuits under modern global circumstances.

(Footnotes)

¹ As set forth in the case of *DSU Medical Corp. v. JMS Co.*, 471 F.3d 1293, 1304 (Fed. Cir. 2006) (discussed *infra*).



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“As Time Goes By - ‘What Happened to the Boutiques?’”

by John B. Pegram

Boutique, n., a small fashionable shop or a small shop within a large department store, hence, a small business that offers highly specialized services or products.

I was surprised to find in the Association’s 1972-73 Yearbook that about 30% of our 900+ active members at that time worked for corporations and the majority of them were located in New York City. At that time, many American companies had their headquarters and patent departments in this city. The involvement of so many in-house attorneys probably attracted the many “name partners” and other leading lights in their firms who have been our Association’s leaders, and enhanced their client relationships.

Most of our members in 1972 worked in “patent firms,” many of which also did trademark work. The structure and operation of those firms—like other law firms of the time—varied widely. In some firms, the partners shared profits by negotiation at year-end or a formula, while in other firms they only shared overhead.

Changes in New York patent practice probably started with the exodus of corporate headquarters from the city. The considerable number of our in-house attorney members in Westchester County and nearby New Jersey in 1972 indicates that exodus had already begun. Over time, attorneys in our patent firms probably had less frequent contacts with in-house patent attorneys.

Another major factor was the entry of general practice firms into the patent field. The definitive event for me was in the early 1970s, when IBM hired Cravath, Swaine & Moore to represent it in patent litigation. Also, the Federal Rules were revised in 1970 to remove the requirements of showing good cause and the approval of a judge for documentary discovery. At around the same

time, IBM and Xerox companies’ ever improving copiers enabled a major expansion of

John B. Pegram is a Past President and Interim Historian of NYIPLA, and a Senior Principal of Fish & Richardson, P.C.



the documents to be discovered and reviewed. As a result, large firms with many associates claimed they had a greater capability to handle patent litigation.

Several other factors helped bring general litigators to the patent field. The 1988 broadening of the statute governing corporate residence for venue purposes, which inadvertently expanded corporate venue in patent cases, contributed to an increase in patent litigation filings away from the defendant’s home. The recognition that jury trials are available in many patent cases also contributed. Although only about 2% of patent cases led to a jury trial, that small chance became a selling point as did familiarity with local courts and juries. Finally, in recent years, companies have increasingly recognized the value of their IP rights and general law firms began to recognize the value of IP work.

Three factors contributing to the demise of several of the larger patent firms were their retirement plans, real estate leases, and increased competition. Before the availability of 401(k) retirement plans, many firms had an agreement requiring payments to retired partners by the remaining active partners. While this worked reasonably well when the firms were expanding and there were few retired partners, there came a time when the arrangement no longer looked attractive to the younger partners. A lease renewal, which might tie the partner to the firm for another ten years, or one of the increasing number of lateral offers precipitated an exodus of partners from several firms. As one attorney told me, “I don’t want to be the last man standing, because I would be responsible for retirement payments.” Cherry picking of experienced attorneys from the traditional patent firms and increased headhunter activity may also have contributed to the demise of some independent patent firms. Overall, that was not such a bad situation for patent lawyers, as it drove up compensation levels and at least some larger firms offered greater employment stability.

Today, however, many or most of us still practice in a “boutique” environment, some within legal “department stores” and others in new, small firms specializing in patent prosecution and opinions.

APPLICATION OF THE COMMON INTEREST DOCTRINE IN PATENT CASES

By Paul Ragusa and Chris Patrick

I. Introduction

The so called “common interest doctrine” often allows different parties who share a common legal interest, but not necessarily the same counsel or the same adversaries, to share privileged information without waiving the attorney-client privilege or the attorney work product immunity. Unfortunately, the doctrine, which is sometimes called the “joint defense” or “community of interest privilege,” is not uniformly applied in the courts and is sometimes not recognized at all. This article addresses the background of the doctrine, provides a synopsis of recent developments in the relevant law, and concludes with practical strategies for increasing the likelihood of a court finding common interest communications privileged.

II. Background

The attorney-client privilege protects from disclosure confidential communications between a client and an attorney representing the client. The underlying justification for the privilege is to incentivize candid communications between a client and its counsel in order to facilitate informed legal advice. If a client is concerned that communications with an attorney could be revealed, information necessary for proper representation may be withheld.¹ An often cited definition of the privilege is in Proposed Federal Rule of Evidence 503(b):

A client has a privilege to refuse to disclose and to prevent any other person from disclosing confidential communications made for the purpose of facilitating the rendition of professional legal services to the client, (1) between himself or his representative and his lawyer or his lawyer’s representative, or (2) between his lawyer and the lawyer’s representative, or (3) by him or his lawyer to a lawyer representing another in a matter of common interest, or (4) between representatives of the client or between the client and a representative of the client, or (5) between lawyers representing the client.²

Implicit in the rule is that the privilege should extend beyond just attorney and client. There are a number of justifications for such an extension – one is to encourage parties working under a common legal interest to benefit from advice of all counsel.³ Another is to facilitate business transactions.⁴ Stated differently, if the privilege is waived by disclosing information to a third party during negotiations, the parties would likely be less forthcoming with relevant information and business could stagnate.

The work product doctrine protects from discovery documents developed in anticipation of litigation or

for trial by an attorney or on the attorney’s behalf.⁵ Its rationale focuses on encouraging competent and diligent preparation by the attorney and encompasses not only communications made from the client to the attorney, but other sources as well.⁶ The early U.S. Supreme Court case of *Hickman v. Taylor* noted a distinction between what is commonly referred to as “ordinary” work product and “opinion” work product, the latter commanding the greatest protection.

If otherwise protected information is disclosed to a third party then, absent an exception, the privilege or immunity can be waived.⁷ An important issue concerns who may waive either the attorney-client privilege or work product protection. This is particularly pertinent in the patent law context where employee-inventors often testify at an infringement trial but typically are not in the management or control group of the company that owns the patent. At least one court has expressly held that the voluntary disclosure of a privileged communication by a non-control group employee can waive the privilege despite the fact that the corporation never approved the disclosure.⁸

Fortunately, courts have recognized exceptions to waiver in various circumstances. The “joint defense” privilege developed within the context of criminal litigation and gradually became commonplace in the civil context.⁹ Eventually, courts recognized a privilege among cooperating plaintiffs. In *In re Grand Jury Subpoena, 89-3 and 89-4*, the Fourth Circuit determined that there was no basis upon which to distinguish co-defendants and co-plaintiffs: “the rationale for the joint defense rule remains unchanged: persons who share a common interest in litigation should be able to communicate with their respective attorneys and with each other to more effectively prosecute or defend their claims.”¹⁰

The common interest doctrine expands the joint litigant privilege to parties who share a common legal interest but may not be involved in the litigation. The leading case is *Duplan Corp. v. Deering Milliken*.¹¹ According to the Court:

A community of interest exists among different persons or separate corporations where they have an identical legal interest with respect to the subject matter of a communication between an attorney and a client concerning legal advice. The third parties receiving copies of the communication and claiming a community of interest may be distinct legal entities from the client receiving the legal advice and may be a non-party to any anticipated or pending litigation. The key consideration is that the nature of the interest be identical, not similar, and be legal,

cont. on page 10

not solely commercial. The fact that there may be an overlap of a commercial and a legal interest for a third party does not negate the effect of the legal interest in establishing a community of interest.¹²

Courts have offered policy rationales for expanding the attorney-client privilege via the common interest doctrine. One court has stated that the purpose of the doctrine is to encourage parties working under a common legal interest “to benefit from the guidance of counsel, and thus avoid the pitfalls that otherwise might impair their progress toward their shared objective.”¹³ Others have been concerned with stifling business: “Unless it serves some significant interest, courts should not create procedural doctrine that restricts communication between buyers and sellers, erects barriers to business deals, and increases the risk that prospective buyers will not have access to important information that could play key roles in assessing the value of the business or product that are considering buying.”¹⁴

In the patent law context there have been a number of cases dealing with the boundaries of the common interest doctrine, but “[t]he legal boundaries which define the scope of the ‘common interest’ rule are by no means well defined.”¹⁵ In *Hewlett-Packard v. Bausch & Lomb*, the Northern District of California held that by disclosing an opinion letter by patent counsel to a third party for the purpose of a potential business transaction, the defendant did not waive the privilege to that opinion letter.¹⁶ In *Johnson Electric v. Mabuchi*, the Southern District of New York held that the attorney-client privilege was not waived when defendant’s attorney disclosed information to one of defendant’s distributors.¹⁷ In *Tenneco Packaging v. C. Johnson & Son*, the Northern District of Illinois held that disclosure of an infringement opinion during an asset purchase negotiation did not defeat the privilege, relying heavily on the fact that the disclosure was subject to a confidentiality agreement.¹⁸ On the other hand, in *Libbey Glass v. Oneida*, the Northern District of Ohio required that in order to maintain the privilege, the parties must demonstrate that the disclosure was for the purpose of “formulating a common legal strategy.”¹⁹

III. Recent Developments

Within the past few years, there have been a number of important changes in the law of willful infringement and induced infringement with regard to opinion of counsel evidence. These changes, coupled with changes in the common interest doctrine, raise a new set of concerns for patent practitioners.

1. Developments in Substantive Patent Law:

Willful and Induced Infringement

In *In re Seagate*, the Court of Appeals for the Federal Circuit set a new standard which no longer requires an opinion of counsel to defeat a charge of willful infringement. Instead, such an opinion is considered a factor in the willful infringement analysis.²⁰ The *Seagate* court

also touched upon issues of waiver, noting that “as a general proposition, relying on opinion counsel’s work product does not waive work product immunity with respect to trial counsel.”²¹

In re EchoStar Communications also addressed the issue of waiver when an opinion of counsel is relied on as a defense to willful infringement.²² The court concluded that once a party relies on advice of counsel as a defense to willful infringement, the attorney-client privilege is waived. Additionally, “the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter.”²³

Broadcom v. Qualcomm addressed opinion of counsel evidence in the context of induced infringement holding that the failure to obtain a non-infringement opinion from qualified independent counsel may be circumstantial evidence of intent to induce others to commit patent infringement.²⁴ A recent district court case went even further and held that failure to obtain an opinion of counsel is “strong circumstantial evidence” that the defendant had the requisite intent to induce infringement.²⁵

2. Developments in the Common Interest Doctrine

The court in *MedioStream v. Microsoft* recently held that a third party intervenor waived the privilege regarding a memo written by the intervenor’s counsel that was forwarded from an employee of the intervenor to one of defendant’s employees.²⁶ The court rested its decision on the fact that the memo was transferred between two non-lawyer employees. “Even assuming the [common interest] doctrine is broader in patent cases, the [intervenor counsel’s] memo was transferred between two non-lawyer employees; the memo was not disclosed in the context of [the intervenor] and [defendant] jointly seeking legal advice. Therefore, the court finds that the common interest doctrine does not apply.”²⁷ The court also found that the employee of the intervenor had authority to waive the attorney-client privilege.²⁸

This decision highlights the reluctance of some courts to expand the common interest doctrine to encompass disclosures to non-attorneys. In the *MedioStream* decision, the court stated “Fifth Circuit cases analyzing the question of common legal interest suggest that the doctrine applies only when co-defendants jointly seek legal advice from counsel.”²⁹ Interestingly, the court applied Fifth Circuit, rather than Federal Circuit, law.

IV. Practical Strategies for Protecting Privilege

Certain practical considerations can increase the likelihood that privileged communications disclosed during an investigation or transaction will stay privileged. The first task is to ascertain the applicable jurisdiction and understand the applicable law which varies among the U.S. circuit courts.³⁰ A company susceptible to suit in certain jurisdictions may want to seek alternatives to disclosure of its most sensitive communications.

When disclosure of privileged communications is warranted or necessary, the parties should execute a

written common interest or joint defense agreement as evidence of their intent to keep certain communications privileged. The parties should articulate in the agreement the common legal interest that provides the basis for one party to seek the advice of the other party's counsel.³¹ The agreement should outline reasonable steps that both parties will adhere to in limiting access to common interest communications. Privileged documents should be labeled as privileged and confidential. Ideally, the documents should remain in the possession of the disclosing party; an online data room with password-protected access and restrictions on copying can be used to share the information.

If possible, the agreement should also recite that both parties reasonably anticipate being sued and are sharing privileged information as part of a joint defense strategy – although a specific threat of litigation is not usually required.³² The timing of the disclosure is important in this regard. For example, where disclosure of privileged communications is made at an early stage of a deal, where the parties are still far apart, a court may be less inclined to find a sufficient common interest. In contrast, where there is an agreement in principle and a deal is imminent, a court is more likely to find that subsequent disclosure of privileged communications does not amount to a waiver.³³

V. Conclusion

The impact of the recent developments in both the common interest doctrine and in the substantive law of willful and induced infringement create a difficult landscape for patent practitioners to navigate. The Federal Circuit decisions in *Seagate*, *EchoStar*, and *Broadcom* make clear that opinion of counsel evidence plays an important role in patent litigation. The uncertainty surrounding the common interest doctrine, however, injects the risk of waiver into situations where a party may wish to use an opinion of counsel for a purpose other than as a defense to willful or induced infringement.



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(Footnotes)

¹ *Fisher v. United States*, 425 U.S. 391, 403 (1976) (“As a practical matter, if the client knows that damaging information could more readily be obtained from the attorney following disclosure than from himself in the absence of disclosure, the client would be reluctant to confide in his lawyer and it would be difficult to obtain fully informed legal advice.”).

² *Rules of Evidence for United States Courts and Magistrates*, 56 F.R.D. 183 (1972).

³ *Libbey Glass v. Oneida, Ltd.*, 197 F.R.D. 342, 347-48 (N.D. Ohio 1999).

⁴ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 115 F.R.D. 308, 311 (N.D. Cal. 1987).

⁵ See e.g., FED. R. CIV. P. 26(b)(3).

⁶ See generally *Hickman v. Taylor*, 329 U.S. 495 (1947).

⁷ See, e.g., *Hodges, Grant & Kaufmann v. United States*, 768 F.2d 719, 721 (5th Cir. 1985).

⁸ *Jonathan Corp. v. Prime Computer, Inc.*, 114 F.R.D. 693 (E.D. Va. 1987).

⁹ See *In re Grand Jury Subpoenas*, 89-3 and 89-4, 902 F.2d 244, 249 (4th Cir. 1990).

¹⁰ *Id.*

¹¹ 397 F.Supp. 1146 (D.S.C. 1974).

¹² *Id.* at 1172

¹³ *Libbey Glass v. Oneida, Ltd.*, 197 F.R.D. 342, 347-48 (N.D. Ohio 1999)

¹⁴ *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 115 F.R.D. 308, 311 (N.D. Cal. 1987).

¹⁵ *GTE Directories Serv. Corp. v. Pacific Bell Directory*, 135 F.R.D. 182, 191 (N.D. Cal. 1991).

¹⁶ *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 115 F.R.D. 308, 309 (N.D. Cal. 1987)

¹⁷ *Johnson Electric North America Inc. v. Mabuchi North America Corp.*, 1995 U.S. Dist. LEXIS 5227, at *8 (S.D.N.Y. Apr. 18, 1996).

¹⁸ *Tenneco Packaging Specialty and Consumer Prods. Inc. v. S.C. Johnson & Son, Inc.*, 1999 U.S. Dist. LEXIS 15433, at *1, *7-8 (N.D. Ill. Sept. 9, 1999).

¹⁹ *Libbey Glass v. Oneida, Ltd.*, 197 F.R.D. 342, 347-48 (N.D. Ohio 1999).

²⁰ *In re Seagate Tech.*, 497 F.3d 1360, 1371-72 (Fed. Cir. 2007); *Energy Transp. Group, Inc. v. William Demant Holding*, 2008 WL 114861, at *1 (D. Del. Jan. 7, 2008) (“[N]othing in Seagate forbids a jury to consider whether a defendant obtained advice of counsel as part of the totality of circumstances in determining willfulness.”).

²¹ *Id.* at 1376.

²² 448 F.3d 1294 (Fed. Cir. 2006).

²³ *Id.*

²⁴ *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 697-99 (Fed. Cir. 2008); see also *World Wide Stationary Mfg. Co. v. U.S. Ring Binder, L.P.*, 2009 WL 4730342, at *2 (E.D. Mo. Dec. 4, 2009) (interpreting *Broadcom* and noting that while failure to obtain opinion of counsel is relevant in the inducement context, it is not in the willfulness context).

²⁵ *Abraxis Bioscience, Inc. v. Navinta, LLC*, 2009 WL 2382251, at *36 (D. N.J. Aug. 3, 2009).

²⁶ Order at 2, *MedioStream Inc. v. Microsoft Corp.*, No. 2:08-cv-00369-CE (E.D. Tex., June 1, 2010).

²⁷ *Id.*

²⁸ Order at 2-3, *MedioStream Inc. v. Microsoft Corp.*, No. 2:08-cv-00369-CE (E.D. Tex., June 1, 2010)

²⁹ *Id.* (citing *In re Santa Fe Int'l Corp.*, 272 F.3d 705, 710 (5th Cir. 2001); *In re Auclair*, 961 F.2d 65, 70 (5th Cir. 1992)).

³⁰ Although the Federal Circuit has provided guidance as to matters particular to patent law, such as whether a draft patent application may be privileged, see, e.g., *Rohm and Haas Co. v. Brotech, Corp.* 19 F.3d 41 (Fed. Cir. 1994), most privilege issues are particular to the geographical jurisdiction in which the suit is brought.

³¹ *Verigy US, Inc. v. Mayder*, No. C07-04330, 2008 WL 5063873, at *3 (N.D. Cal. Nov. 21, 2008).

³² See *Louisiana Mun. Police Employees Retirement Sys. v. Sealed Air Corp.*, 253 F.R.D. 300, 310 (D.N.J. 2008).

³³ See *Katz v. AT&T Corp.*, 191 F.R.D. 433, 438 (E.D. Pa. 2000).

US Bar/EPO Liaison Council Meets In Munich

By Samson Helfgott

The 26th Annual Meeting of the US Bar/EPO Liaison Council took place in Munich on October 11, 2010. Attending the meeting was the recently elected president of the European Patent Office, Benoit Battistelli. Along with him, and representing the EPO, were the vice presidents of the Legal Division, the Board of Appeals, and major principal directors and directors of various organizations within the EPO.

The US Bar/EPO Liaison Council consists of delegates from various national and regional patent bar associations in the United States and meets annually with the heads of the EPO, alternating between the US and Europe to discuss matters of interest for US applicants filing in the EPO. Applicants from the United States are the largest group from a single country and constitute approximately 25% of the work for the EPO.

Representing the NYIPLA at this Council meeting were its representatives, Thomas Spath from Abelman, Frayne & Schwab and Samson Helfgott from Katten Muchin Rosenman LLP.

As part of the EPO's annual report, the President indicated that in 2009, the EPO received 212,000 applications which was a drop of 8% from comparable figures during 2008. However, for the first nine months of 2010 there has been an increase of approximately 4% in filings. This compares with the average increase of patent filings in the rest of the world of only 2.5%. Of the applications received by the EPO in 2009, 56,000 were EURO direct cases, while 156,000 were PCT cases filed in Europe.

During 2009, 52,000 patents were granted. The grant rate in the EPO is currently 42%. The pendency for a first European search report with an accompanying written opinion is six months where the EPO is the Office of First Filing (OFF). Where the EPO is the Office of Second

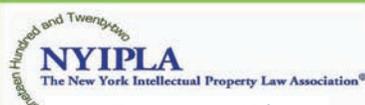
Filing (OSF), the first search report and written opinion is received by 27 months.

The EPO has in the past provided its services to countries within Europe on an Extension basis. These Extension countries are typically those that ultimately hope to become part of the EPO. Apparently, other countries are now interested in making use of the EPO services, but the EPO is hesitant to expand its borders beyond the European continent. It has, therefore, extended its services under a Validation Agreement with Morocco. In this regard, the EPO grant will be accepted by Morocco, but Morocco will not have the ability to become a Member State. It is expected that other countries such as Tunisia, and perhaps others, will also want to become part of the Validation Agreement Program.

The European Patent Office wants to maintain its strength and, at the same time, keep its high quality of search and examination. The series of rule changes generally referred to as "raising the bar" which have been introduced in the past year have increased the quality and timeliness of examination within the EPO. These measures require that an applicant reduce the number of independent claims in the same category prior to beginning the search, rather than during the examination period as was previously done. The changes also include the examiner refusing to conduct a search where the claims have insufficient disclosure or lack clarity. It also requires a response to the Written Opinion conducted along with the search even before an examination is requested, and in the case of a PCT application, providing such a response to any Written Opinion from any Searching Authority before entry into the EPO. It also restricts voluntary amendments to only a single one, thereafter requiring consent of the examiner for further voluntary amendments. Additionally, it also requires that when filing amendments, identification of support within the specification for such amendments must be provided.

The EPO restrictions on divisionals resulted in filing more than 10,000 divisionals during the last month before the restriction on such filings went into effect. The EPO, however, has recognized that there are continuous complaints regarding this restriction on divisionals and has indicated that it will be monitoring the situation as it goes forward.

Beginning on January 1, 2011, the EPO will introduce the Utilization Project as a result of an amendment to EPC (European Patent Convention) Rule 141 and a new Rule 70(b) EPC. The purpose



December 13th
CLE Luncheon Program
EARN 1.0 NYS/JNS CLE CREDIT
FOR BOTH NEWLY ADMITTED & EXPERIENCED ATTORNEYS

Schedule
Registration
11:30am – 12noon
Lunch
12noon – 12:45pm
Program
12:45pm – 2:00pm

Keynote Speaker:
Honorable Randall R. Rader
US Court of Appeals for the Federal Circuit

The Harvard Club
35 West 44th Street, New York City

Details: www.nyipla.org

of this Project is to permit work that is carried out during the priority year by an OFF to be further utilized by the EPO when prosecuting the subsequent European patent application in the EPO as an OSF.

Under the amended rules, an applicant claiming priority of a previous application must file with the EPO a copy of the results of any novelty search carried out by the OFF. This information must be filed together with the European patent application, or in the case of a EURO-PCT application, on entry into the European phase.

Where the search results are not yet available, a copy of the search results must be filed without delay after they have been made available to the applicant.

The search results, in whatever form or format they are established by the OFF, must be submitted together with a copy of the official document issued by the OFF. No copies of the documents actually cited are required nor is a translation required where the search results established by the OFF is in a language other than one of the EPO official languages.

Where at the time the application enters the EPO examination stage, a copy of the search results from an OFF has not been submitted, the EPO will invite the applicant to file within a non-extendable period of two months such copies, or a statement of non-availability of these search results.

If the applicant fails to reply within this two month period, the European patent application will be deemed to be withdrawn. Accordingly, where no search has been done by an OFF, the EPO examination will proceed in any event. However, it will be necessary to file such a statement with the EPO advising them that no search results have been received to avoid abandonment of the application.

While at present no electronic interoffice system for exchange of search results has been set up, it is hoped that the EPO will begin discussions with other patent offices to make the exchange of search results electronically available to the EPO.

There continues to be ongoing interest to implement a European Union (EU) patent along with the introduction of a Community Patent Court. This Court has been renamed the European Patent and European Union Patent Court (EEUPC).

The EPO indicated that at present, no increase in user fees is contemplated.

With respect to the EU patent, a draft Regulation would place the EPO in charge of the search, substantive examination, opposition, and appeal procedures relating to EU patents. There are ongoing discussions on how this integration of the EU patent within the EPO system will take place. One suggestion is to give the EU the ability to proceed with accession to the EPO Treaty. However,

this would require revision of the European Patent Convention which is a very challenging task. It may also be possible to have the EU use the EPO system as an Extension State or perhaps under a separate Contractual Agreement where the EPO provides services to the EU in connection with its EU patent. These issues are still under discussion.

The issue of translation of the EU patent into various languages is also still under discussion. The EPO has indicated that it would be willing to establish a machine translation system within four years to provide machine translation into all of the approximately 26 European languages. However, the basic languages of examination are still under discussion. The proposal has been for EU patents to be examined and granted by the EPO in one of the EPO official languages: English, French or German. However, there are still proposals under consideration from the Spanish delegation and others to provide that the application filed in any language would have to be translated into English in any event. The English language application would form the authentic text. However, after grant, the applicant would have to translate the EU patent into another language of his choice and, if the translation were to be narrower, it would be the translation that would limit the scope of protection on the entire EU territory.

In connection with a common European Court System, the proposal is to provide an agreement which would be open for accession to all EPC Contracting States. Participation of the European Union and 27 Member States is compulsory, while participation for the 11 other EPC Contracting States would be optional.

In June 2009, the EU Council asked the Court of Justice of the EU for an opinion on the compatibility of the latest draft agreement on a Common Court System of Europe and the future of the EU patent with existing EU law. While the Court of Justice had a hearing in May 2010, the EU is still awaiting the opinion of the Court to determine whether the agreement would have to be revised in order to enter into force.

Samson Helfgott is a partner at Katten Muchin Rosenman LLP where he focuses on domestic and international patents, trademarks and copyrights. Along with Thomas E. Spath of Abelman, Frayne & Schwab, Mr. Helfgott is the NYIPLA's US Inter-Bar/EPO Liaison. He can be contacted at samson.helfgott@kattenlaw.com.



Developments in International Prosecution and Enforcement

On 15 October 2010, the Committee on Meetings and Forums hosted a Continuing Legal Education (CLE) luncheon at the Harvard Club. The program was entitled “Important New Developments in International Prosecution and Enforcement.”

Brian Daley, a partner at Ogilvy Renault in Montreal, made a presentation that asked, “Are the Patented Medicines (Notice of Compliance) Regulations making it harder to get and enforce patents in Canada?” He explained how these regulations have “turbocharged” changes in Canadian patent jurisprudence, and have at the same time created new pitfalls for applicants and patentees. Mr. Daley also discussed the importance of a “sound prediction of utility” in Canadian pharmaceutical patent applications. He noted recent cases suggesting a changing relationship between the requirements of unobviousness and sound prediction of utility.

Tony Pezzano, a partner at Cadwalader, Wickersham & Taft, spoke on “Evaluating where to litigate international IP disputes” pointing out the differences between International Trade Commission (ITC) and district court cases. Mr. Pezzano described the organization and jurisdiction of the ITC, and the procedure followed in an action under 19 U.S.C. § 1337 (“Section 337”) in the ITC. He also discussed the pilot mediation program for Section 337 investigations at the ITC. In addition, Mr. Pezzano described the advantages of using the

WIPO Arbitration and Mediation Center as an alternative to multi-national patent litigation, and outlined the procedure in a WIPO arbitration case.

Sam Helfgott, a partner at Katten Muchin Rosenman, presented on “Patent Prosecution Highway (PPH) programs and practice tips.” Mr. Helfgott discussed strategies for using the PPH to obtain accelerated prosecution of patent applications in different countries in the PPH network. He presented statistics showing significant reduction in pendency of applications when PPH procedures are used. He pointed out how a favorable International Search Report in a PCT application may be used to fast-track a copending application in the USPTO. Mr. Helfgott also discussed quality, cost and timeliness factors in choosing an International Searching Authority for a PCT application. His discussion of new developments in EPO practice appears elsewhere in this issue of the Bulletin.

The next CLE luncheon meeting will be at the Harvard Club on December 13, 2010. The featured speaker will be Hon. Randall R. Rader, Chief Judge of the Court of Appeals for the Federal Circuit.

The Meetings & Forums Committee is co-chaired by Richard Martinnelli of Orrick Herrington & Sutcliffe LLP and Jay Anderson of Wiggin and Dana LLP.



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Federal Circuit Rules in *Hyatt v. Kappos* NYIPLA Filed Amicus Brief

by Charles E. Miller

The NYIPLA filed an amicus brief authored by Charles E. Miller of Dickstein Shapiro in support of neither party for the Federal Circuit's *en banc* rehearing of *Hyatt v. Kappos* (No. 2007-1066). A copy of the brief is available at www.nyipla.org under "Association Amicus Briefs".

The Association's brief argued for the long-needed, modern-day articulation of the proper role of district court *de novo* review-jurisdiction over PTO Board of Patent Appeals and Interferences (BPAI) decisions under 35 U.S.C. §145 as a meaningful alternative to the highly deferential court/agency standard of review of agency fact-findings available in the Federal Circuit under §§141-144.

On November 8, 2010 the Federal Circuit in a divided (7-2) opinion, ruled that a patent applicant in a civil action against the Patent and Trademark Office under 35 U.S.C. §145 has an essentially unfettered right to introduce new, non-cumulative evidence relevant to the BPAI's fact-findings and that the entirety of such fact-findings must then be reviewed *de novo*:

[W]e hold that the only limitations on the admissibility of evidence applicable to a §145 proceeding are the limitations imposed by the Federal Rules of Evidence and Federal Rules of Civil Procedure. Therefore, we hold that the district court . . . abused its discretion when it excluded Mr. Hyatt's declaration [submitted for the first time at the district court stage] . . .

The particular significance of a §145 civil action is that it affords an applicant the opportunity to introduce new evidence after the close of the administrative proceedings—and once an applicant introduces new evidence on an issue, the district court reviews that issue *de novo*.

The opinion also confirmed the existing principles (1) that an applicant may be barred from presenting new "issues" in the civil action, and (2) that, when no new evidence is presented, BPAI fact-findings should be given deference under the "substantial evidence" standard of review pursuant to the Administrative Procedure Act (APA).

Gilbert Hyatt had sued the PTO in the U.S. District Court for the District of Columbia after the Board had sustained the examiner's written description and enablement rejections of many of the claims in Hyatt's patent application. In addition to the complaint, Hyatt proffered a declaration offering new evidence of enablement and written description. The district court, in granting the PTO's motion for summary judgment, excluded the declaration evidence because of Hyatt's "negligence" in fail-

ing to previously submit it to the PTO. Hyatt appealed, and in a 3-judge panel decision, the Federal Circuit held that the district court properly excluded the evidence because Hyatt had "willfully" withheld it (not negligently as the district court had found) from the PTO.

Judge Kimberly Moore wrote the *en banc* decision which was joined by Chief Judge Rader and Judges Lourie, Bryson, Linn, and Prost. Judge Dyk dissented and was joined by Judge Gajarsa. Judge Newman concurred-in-part — arguing that the district court in a civil action should give no deference to PTO fact-findings even when no new evidence is presented.

A key to the majority decision is the notion that a Section 145 civil action is not an appeal, but rather an actual lawsuit to enjoin the PTO to act. The majority's analysis emphasized the 150-year history of Section 145 civil actions in which the admission of new evidence has always been a part of such proceedings. *Gandy v. Marble*, 122 U.S. 432 (1887) (explaining that the [predecessor] §4915 suit in equity was "not a technical appeal from the Patent Office, nor confined to the case as made in the record of that office"). The Court then reviewed the text of the current statute, the role of the APA, and various policy arguments before reaching its conclusions.

In the dissent, Judge Dyk argued that the majority made an improper leap from (1) the correct premise that new evidence should be admissible in the civil action, to (2) the incorrect conclusion that the law imposes no meaningful limits on the introduction of new evidence regardless of what was presented to the BPAI.

The decision should dispel once and for all any concerns the patent community may have had about the need to lard the PTO record in administrative appeals with voluminous evidence -- often mostly unwelcomed by the Board -- for fear of not being able to proffer it later in a Section 145 action since it will henceforth be admitted and considered. Also, the decision buttresses the current opposition to SEC. 6(c)(1) and (2) of the March 10, 2010 Managers Amendment of S.515, the Senate version of the Patent Reform Act which would abolish the long-standing right of patent owners to district court *de novo* review under 35 U.S.C. §306 (incorporating Section 145 by reference) of adverse Board decisions in *ex parte* re-examinations the prosecution stage of which resembles that of patent applications.

Charles E. Miller is Senior Counsel at Dickstein Shapiro LLP where his practice concentrates primarily in the chemical and pharmaceutical industries.

Board of Directors Meetings Reports

Summary of the September 14, 2010 Meeting

The meeting was called to order at the New York offices of Wiggin & Dana at 450 Lexington Avenue, New York by President Dale Carlson. Theresa Gillis, Susan Progoff, Mark Abate, Jeffrey Butler, Allan Fanucci, Walter Hanley, Ira Levy and John Moehringer were present. Alice Brennan participated by telephone. Also present was Feikje van Rein of Robin Rolfe Resources. Absent and excused were Dorothy Auth, Leora Ben-Ami, Doreen Costa, John Delehanty, Charles Hoffmann and Tom Meloro.

The minutes of July 13, 2010 meeting were approved.

Alice Brennan presented the Treasurer's Report. The Association is on better financial footing than a year ago. Overall expenses have decreased due to changes in Association administration as well as increased use of electronic communications.

The draft program of the full day November 4th CLE program was discussed and suggestions for additional speakers were made.

Dale Carlson read the Amicus Brief Committee's September report prepared by the committee's co-chair Dave Ryan. The report included an overview of the cases for which decisions have issued, cases pending in which briefs already have been filed, potential new filings currently under consideration, and recent decisions not to file.

In accordance with the bylaws, the names of new members were read and the Board passed a motion to accept them.

The Board discussed the membership descriptions provided in the bylaws and agreed that the new member sign-up form should be amended to solicit additional information from prospective members.

Dale Carlson reported that the contract with the Waldorf=Astoria for the 2011 Judges' Dinner has been negotiated and signed. Some suggestions for keynote speaker and Outstanding Public Service award were discussed.

Mark Abate presented a proposal for the Past Presidents Dinner to be held on Tuesday, November 9 at the restaurant Oceana. The Board passed a motion to fund the Past Presidents Dinner.

Dale Carlson reported that the August/September 2010 Bulletin was at press and scheduled to be mailed shortly. Brief reports on behalf of the Patent Litigation, Trademark Practice, Patent Practice, Meetings & Forums, and Corporate Committees were provided.

Committee chairs and co-chairs will be invited to the next Board meeting.

The meeting was adjourned at 2:00 pm. The next meeting is scheduled for Tuesday, October 19 at noon at the Union League Club.

Summary of the October 19, 2010 Meeting

The meeting of the Board of Directors was called to order at The Union League Club at 38 East 37th Street, New York by President Dale Carlson. Preceding the Board Meeting, from noon until 1:15 p.m., the Committee Chairs and Co-Chairs reported on their plans for the year.

Board members in attendance were Theresa Gillis, Tom Meloro, Alice Brennan, Charles Hoffmann, Dorothy Auth, Susan Progoff, Allan Fanucci, Mark Abate, John Moehringer, Leora Ben-Ami, Walter Hanley, Doreen Costa, and Ira Levy. Absent and excused were John Delehanty and Jeffrey Butler. Robin Rolfe and Feikje Van Rein were in attendance from the Association's executive office.

Upon motion by Dorothy Auth, the Board approved the Minutes from the September 14, 2010 Board Meeting.

Alice Brennan provided the Treasurer's Report, concluding that the Association continues to be on a sound financial footing.

Ira Levy, as liaison for the Meetings & Forums Committee, gave a report on the October 15th CLE Luncheon event, reporting that attendance was good and the topics covered were timely and relevant to the attendees.

Dorothy Auth, as liaison for the CLE Committee, provided an update regarding the preparation and planning for the Fall One-Day Patent Law event scheduled for November 4, 2010.

Dorothy Auth read the names of the new NYIPLA members and a motion to accept them was approved.

Tom Meloro reported that planning for the 2011 Judges Dinner is moving forward on schedule.

Dale Carlson announced that (1) the Honorable Judge Gajarsa will receive the Outstanding Public Service Award; (2) a lifetime achievement award will be presented posthumously to Judge Giles S. Rich on the diamond anniversary of his term as NYIPLA President [1950-51], and (3) the Honorable Judge Gleeson, from The Eastern District of New York, will be the after-dinner keynote speaker at the event.

Feikje Van Rein reported that she is preparing a marketing announcement for the Judges Dinner. An initial mailing to the members is planned for mid-December. Robin Rolfe is working on the seating plans.

Charles Hoffman reported as liaison for the Amicus Committee regarding the latest cases for consideration for amicus brief submission. The Committee's report requested the Board to make a recommendation as to whether a brief should be prepared in the *Rosetta Stone v. Google* case and the *General Protecht Group v. I.T.C.* case. Following some discussion, the Board agreed to request additional information from the Amicus Committee.

The meeting was adjourned upon motion by Dale Carlson. The next meeting is scheduled for November 16, 2010 at the offices of Mintz, Levin, Cohn, Ferris, Glovksy and Popeo, P.C. in the Chrysler Center at 666 Third Avenue.

IP Litigation: Perspectives on the Practice

On October 25, 2010, the Young Lawyers' Committee hosted the panel, "IP Litigation: Perspectives on the Practice" at Fordham Law School in conjunction with the Fordham IP Institute, with support from Goodwin Procter LLP.

The panelists were Magistrate Judge Patty Shwartz of the U.S. District Court for the District of New Jersey, Kevin C. Ecker of Philips Electronics, Kathleen McCarthy of King & Spalding LLP, Brad Scheller of Mintz Levin LLP, and Jeff Zachmann of IBM. Andrew Stein of Goodwin Procter LLP was the moderator.

The panelists began by describing their day-to-day responsibilities with respect to IP litigations and then discussed IP litigation from the perspective of the client, inside counsel, outside counsel, and the bench. The panelists closed by discussing how law students can make

themselves more attractive to IP litigation employers and the various pathways for law students into the practice of IP law. Throughout the panel, students in attendance posed thoughtful and relevant questions.

NYIPLA President, Dale Carlson of Wiggin & Dana LLP, introduced the panel and the NYIPLA to the audience. Immediate Past NYIPLA President, Mark Abate of Goodwin Procter LLP, and Professor Hugh Hansen of Fordham Law School also attended. The event was

very well attended by law students from at least six area law schools. Information on NYIPLA and membership applications were distributed to all students in attendance. A reception followed the panel.

The Young Lawyers' committee is co-chaired by Sonja Keenan of Cadwalader, Wickersham & Taft LLP and Andrew Stein of Goodwin Procter LLP.



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The NYIPLA's Executive Office has changed.

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