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Implications of Post-Seagate Cases Finding Willful Infringement

by Joseph M. Casino and Amit R. Parikh¹

I. Summary

Patent infringement is a strict liability tort that does not delve into the state of mind of the accused infringer. Courts have discretion to treble damages in exceptional cases. As to the accused infringers, the risk of finding a case exceptional arises primarily when they are found to be willful infringers.

This article will examine the development of the law after the standard for finding willful infringement was changed to the higher and less subjective standard of "objective recklessness" by *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (en banc), which overruled previous cases that had placed an affirmative duty of care on the accused infringer. Based on a detailed review of all cases citing to the *Seagate* decision, it is clear that even under the objective recklessness standard, willful infringement remains a risk. The article concludes by analyzing the trends in the application of the objective recklessness standard and providing recommendations.

II. Background

Under 35 U.S.C. § 284, "[w]hen the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed." Thus, enhanced damages are authorized by 35 U.S.C. § 284, are discretionary with the court, and are available up to three times the damage award. While Section 284 does not itself identify the circumstances under which enhanced damages are available, case law establishes that enhanced damages are available in "exceptional cases," such as where the court finds willful infringement.

A finding of willfulness does not require an award of enhanced damages, but merely permits such an award. *See* 35 U.S.C. § 284. Once a defendant is found liable for willful infringement, there are nine factors that courts consider to determine whether to award enhanced damages: (1) whether the infringer deliberately copied the patent; (2) whether the infringer investigated the scope of the patent and formed

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Dear Fellow Members:

Welcome to the 2011-12 Association year! It is an honor and a privilege for me to serve as President of the Association this year. I look forward to a productive year.

The year began with the May Annual Meeting. It was heartening to see the large turnout and the enthusiasm of the membership. It was a particular pleasure to see so many Past Presidents in attendance. It is my hope this year to increase the involvement of these senior statesmen and women in the activities of the Association.

As I indicated at the Annual Meeting, my objective this year is to increase participation in the Association – both in terms of committee activities and membership. I was fortunate to find willing and able co-chairs for all of the committees by June. Since then, each of the committee chairs has been actively engaged with their Board liaisons to develop an agenda for the year. Committees are not only planning their own internal work for the year, but a number of cross-committee activities are being explored. For example, the Meetings and Forums Committee will be co-sponsoring several events. Meetings and Forums will coordinate and administer the event, while another committee will assume responsibility for the content of the event. With these sorts of cross-committee activities, it is hoped that the opportunities for networking within the Association can be increased, while enriching the Association's activities.

On the membership front, the Association held a Young Lawyers' event in July. A panel of practitioners in diverse areas of intellectual property provided a presentation on their practices. The event was attended by about 70 students, summer associates and young lawyers. Its purpose was to give exposure to the Association and to encourage young lawyers to join. It is hoped that additional events focused on other constituencies of the Association will take place later in the year. Suggestions for ways to increase membership in the Association are welcomed.

The Amicus Committee is already actively engaged on a number of issues. The Second Circuit recently rendered a decision in *John Wiley & Sons, Inc. v. Kirtsaeng*, involving the issue of rights to resell in the United States copyrighted works purchased lawfully abroad. The Second Circuit's decision was in line with the position that had been advocated by the Association in its amicus brief. In its June 17, 2011 opinion in *City of Ontario, CA v. Quon* relating to rights of privacy, the Supreme

Court cited the NYIPLA amicus brief. Members interested in the content of the Association's amicus briefs are encouraged to visit the NYIPLA website, where copies are available.

The Association is often an amicus filer in important cases. Members are encouraged to keep in mind the potential role of the Association as an amicus filer when a matter is being appealed. Please contact the Co-chairs of the Amicus Committee if you are aware that an issue of importance is being raised in an appeal. Advance notice to the Amicus Committee of an impending appeal with an important issue affords the Board and the Amicus Committee adequate time to consider the appropriateness of an amicus filing and to prepare an appropriate brief.

The Association's new website is now fully operational. It will be the repository for most historic Association materials and information. The Association is attempting to assemble a complete set of its Bulletins, as well as other historic materials such as Green Books. If anyone is aware of a source of these materials, particularly from the period prior to 1980, please contact the Co-chairs of the Website and Records Committee.

Because it is now possible to have Association historic materials available on the website on a permanent basis, the traditional Green Book was discontinued last year. Going forward, the first Bulletin of each Association year will be an abbreviated Green Book. This change is not only in keeping with the electronic age we are in, but also results in substantial cost savings.

If you have not already done so, please consider not only joining, but becoming an active participant of, one of the NYIPLA committees. The Association's committees offer an opportunity to network and build relationships among colleagues, while helping the Association remain at the forefront of intellectual property policy and legislation. Please also encourage colleagues with whom you work to become members of the Association and to likewise become active committee members.

Again, I look forward to working with and for you this year.



With kind regards,
Terri Gillis

a good faith belief that the patent was invalid or not infringed; (3) the infringer's behavior during litigation; (4) the infringer's size and financial condition; (5) closeness of the case; (6) duration of the infringer's misconduct; (7) remedial action by the infringer; (8) the infringer's motivation for harm; and (9) whether the infringer attempted to conceal the misconduct. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 827 (Fed. Cir. 1992).

III. Pre-Seagate Willful Infringement Jurisprudence

Historically, the Federal Circuit set forth a "duty of care" standard for willful infringement: when "a potential infringer has actual notice of another's patent rights, he has an affirmative duty to exercise due care to determine whether or not he is infringing." *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983).

Accused willful infringers commonly asserted an advice-of-counsel defense to satisfy the "duty of care" standard. *Seagate*, 497 F.3d at 1369. Since an opinion of counsel is protected by the attorney-client privilege, producing the opinion of counsel to meet the "due care" standard resulted in a waiver that applied to "all other communications relating to the same subject matter." *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005). On the other hand, failure to produce an opinion of counsel raised an adverse inference that "would warrant the conclusion that [the defendant] either obtained no opinion of counsel or did so and was advised that its [activities] would be an infringement of valid U.S. patents." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1580 (Fed. Cir. 1986). Therefore, the willful infringement doctrine created a dilemma where if an accused infringer chose not to rely upon its opinion of counsel for strategic reasons, such as a concern about waiving its attorney-client privilege, it risked being found liable for willful infringement, even though it may have in fact obtained and relied upon a competent opinion of counsel. See *Quantum Corp. v. Tandon Corp.*, 940 F.2d 642, 643 (Fed. Cir. 1991).

Recognizing that the adverse inference imposed "inappropriate burdens on the attorney-client relationship," the Federal Circuit overruled earlier precedent and held that failure to produce an opinion of counsel would not give rise to an adverse inference. *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1343 (Fed. Cir. 2004). The Federal Circuit also clarified the scope of the work product waiver when an accused infringer asserts an opinion of counsel defense by holding that "[w]ork-product, which [was] never communicated to the client, is not discoverable," even after the waiver of attorney-client privilege. *In re Echostar Commc'ns Corp.*, 448 F.3d 1294, 1303 (Fed. Cir. 2006). However, after *Echostar*, the issue of whether reliance on advice of opinion counsel waives privilege as to communications with trial counsel caused disagreement among district courts.

IV. The Seagate Decision

A. The Majority Opinion by Judge Mayer

In *Seagate*, the en banc Federal Circuit considered two issues: (1) whether it should alter the "duty of care" standard for willful infringement, and (2) whether relying on an opinion counsel in defending against a willful infringement charge constitutes waiver of privilege for trial counsel.

First, in considering whether to alter the "duty of care" standard for willful infringement, a majority of the Federal Circuit defined "willful" in connection with reckless behavior. See *Seagate*, 497 F.3d at 1370-71. After noting that the "duty of care" standard announced in *Underwater Devices* set a lower threshold for willful infringement more "akin to negligence," *id.* at 1371, the majority overruled the "duty of care" standard and held that "willful infringement permitting enhanced damages requires at least a showing of **objective recklessness**." *Id.* (emphasis added).

The majority went on to fashion a two-prong test for the new willful infringement standard. The first, objective prong requires a patentee to show "by clear and convincing evidence that the infring-

er acted despite an objectively high likelihood that its actions constituted infringement of a valid patent.” *Id.* The majority noted that the state of mind of an accused infringer is not relevant under the objective inquiry. *Id.* The second, subjective prong requires the patentee to “demonstrate that this objectively-defined risk . . . was either known or so obvious that it should have been known to the accused infringer.” *Id.*

The majority left it to future cases to develop the contours of how this new willful infringement standard would be applied. *Id.* However, in a footnote, the majority mentioned that the “standards of commerce would be among the factors a court might consider.” *Id.* at 1371 n.5. The use of “standards of commerce” was suggested by Judge Newman’s concurrence, as discussed below. The majority does not state whether “standards of commerce” apply to the objective or subjective prongs or both.

Second, the majority held that due to the significantly different functions of trial counsel and opinion counsel, waiver of the attorney-client privilege, resulting from asserting the advice of counsel defense to willful infringement, does not extend to trial counsel’s communications with his or her clients. *See id.* at 1373. Finding additional support for this holding, the majority noted that communications with trial counsel have little, if any, relevance for the willfulness inquiry. *See id.* at 1374. The majority explained that a willfulness claim depends on an alleged infringer’s pre-litigation conduct because when a patentee files a complaint, he must have good faith for alleging willful infringement. *See id.* Therefore, since opinion counsel focuses on providing an objective assessment for making informed business decisions and trial counsel focuses on litigation strategy, trial counsel’s communications have little relevance to pre-litigation conduct and the willfulness inquiry. *See id.*

As to willful infringement after a lawsuit has commenced, the majority recognized that if an alleged infringer’s post-filing conduct is reckless, the patentee may move for a preliminary injunction. *Id.*

However, a patentee who does not attempt to stop an accused infringer’s post-filing conduct through a preliminary injunction should not be able to accrue enhanced damages based on post-filing conduct. *Id.* Even though an accused infringer may avoid a preliminary injunction by only raising a substantial question of invalidity as opposed to the higher clear and convincing standard for succeeding on the merits, the majority found that when a patentee attempts to secure injunctive relief but fails due to a substantial question relating to non-infringement or invalidity, “it is likely the infringement did not rise to the level of recklessness.” *Id.* Accordingly, the majority noted, “[a] substantial question about invalidity or infringement is likely sufficient not only to avoid a preliminary injunction, but also a charge of willfulness based on post-filing conduct.” *Id.*

Lastly, the majority held that asserting an advice of counsel defense to refute a charge of willful infringement does not waive trial counsel’s work product. *Id.* at 1375. Although the same rationale for limiting waiver of attorney-client privilege applies to the work product doctrine, the majority noted that due to the nature of the work product doctrine, limiting waiver of trial counsel’s work product “applies with even greater force” because it “strengthens the adversary process . . . and may ultimately and ideally further the search for the truth.” *Id.*

B. Concurrence by Judge Gajarsa

Judge Gajarsa (joined by Judge Newman) wrote separately to express his belief that the court ought to take the opportunity to eliminate the “grafting of willfulness onto section 284.” *Id.* at 1376-77. Specifically, Judge Gajarsa believed that enhanced damages should not be limited to findings of willfulness and that district courts ought to have the discretion to enhance damages irrespective of the state of mind of the accused infringer. *See id.* For example, Judge Gajarsa points to situations where a substantial portion of the accused infringer’s sales data is lost prior to discovery or where monetary enhanced damages are more appropriate than a permanent injunction. *See id.* at 1378-79.

Judge Gajarsa found that to establish willful infringement, a patentee “must show, by clear and convincing evidence, (1) that [the accused infringer’s] theory of noninfringement/invalidity was not only incorrect, but was objectively unreasonable, and (2) that [the accused infringer] ran a risk of infringing [the patentee’s] patents substantially greater than the risk associated with a theory of noninfringement/invalidity that was merely careless.” *Id.* at 1384. Judge Gajarsa explained that subjective beliefs become relevant only if the patentee successfully shows objective unreasonableness. *Id.* Since the patentee did not satisfy the objective unreasonableness prong, Judge Gajarsa chose not to confront the issues of waiver of attorney-client and work-product privileges. *Id.*

It is not clear from Judge Gajarsa’s subtle re-statement of the majority’s test whether he intended to add (or stress) some further nuance. However, in our review of subsequent cases, Judge Gajarsa’s test has not played a role.

C. Concurrence by Judge Newman

Judge Newman joined the majority’s holding that a “voluntary waiver of the attorney-client privilege and work product protection as to patent opinion counsel is not a waiver of any privilege or protection as to litigation counsel.” *Id.* at 1384. Judge Newman also agreed with Judge Gajarsa that district courts ought to have discretion to enhance damages without finding willful infringement. *See id.* at 1385. In addition, Judge Newman agreed that *Underwater Devices* ought to be overruled, but only because that case “has been misapplied . . . to mean that ‘due care’ requires more than the reasonable care that a responsible enterprise gives to the property of others.” *Id.* Specifically, Judge Newman’s issue with *Underwater Devices* is that it required “that every possibly related patent must be exhaustively studied by expensive legal talent” or else an adverse inference to willful infringement will apply. *See id.*

Under the new willful infringement standard set by the majority, Judge Newman explained that the

standard of behavior by which a possible infringer evaluates adverse patents “should be the standards of fair commerce, including reasonableness of the actions taken in the particular circumstances.” *Id.* Judge Newman reasoned that it “cannot be the court’s intention to tolerate the intentional disregard or destruction of the value of the property of another . . . yet the standard of ‘recklessness’ appears to ratify intentional disregard, and to reject objective standards requiring a reasonable respect for property rights.” *Id.* In conclusion, Judge Newman found that willful infringement turns on “the reasonableness, or in turn the culpability, of commercial behavior that violates legally protected property rights.” *Id.*

Judge Newman’s concurring opinion suggests that the “standards of commerce” should be considered as part of the objective prong of the willfulness inquiry: “Although new uncertainties are introduced by the court’s evocation of ‘objective standards’ for such inherently subjective criteria as ‘recklessness’ and ‘reasonableness,’ I trust that judicial wisdom will come to show the way, in the common-law tradition. The standards of behavior by which a possible infringer evaluates adverse patents should be the standards of fair commerce, including reasonableness of the actions taken in the particular circumstances.” *Id.*

V. Review of Post-Seagate Willfulness Law

This Article considers what conduct has been deemed to be willful infringement such that it warrants enhanced damages under *Seagate*’s new heightened standard. To understand the circumstances under which willfulness claims have been accepted and the circumstances under which willfulness claims have been rejected, we have reviewed every reported decision that cites *Seagate*. We have prepared a chart as an Appendix to this article (available at: www.arelaw.com/downloads/Seagate-Chart.xls) that contains a record of all the relevant cases that were reviewed, their citations, whether the court found willfulness and enhanced the damage award, and a brief summary of the

cont. on page 6

court's rationale. We have used "Y" to indicate a willfulness finding even if damages were not enhanced, "N" to indicate a finding of no willfulness by the court and "M" to indicate a decision of interest but not deciding the ultimate question of willfulness (e.g., denial of summary judgment or information on the pleading standards). We have given particular attention to facts in cases where willfulness was found (by the court or a jury) and to cases where no willfulness was found by the court on summary judgment or judgment as a matter of law (JMOL).

We note that in many cases tried to a jury it is impossible to know what factors the jury found persuasive in finding willfulness or how it applied the new Federal Circuit test from *Seagate*. In some cases, the court discusses the facts that support or counsel against upholding the jury verdict. Further, many of the reported decisions include a discussion by the court of the *Read* factors used to determine whether the court will enhance damages. We assume these factors may have influenced the jury's determinations and have included them in our chart.

While we have put forward our thoughts on the cases applying *Seagate* below, we invite the readers of this article to review and analyze the chart independently to consider trends and key facts.

VI. Analysis of Post-*Seagate* Willfulness Law

We summarize below the main areas where our study has revealed trends and practice points.

A. Key Factors in Willfulness Determinations

1. Closeness of the Case

The merits of defenses presented by the accused infringer have become significant factors in determining willfulness. In particular, all of the Federal Circuit cases that find no willful infringement rely heavily on whether the defenses raised by the accused infringer were reasonable.

Most of the district courts granting summary judgment or JMOL of no willfulness did so solely based on the merits of the defenses raised. This makes sense, since when viewing a case objec-

tively, the reasonableness of defenses is the most objective evidence that the accused infringer acted reasonably in light of a known risk.

2. Knowledge of the Patent-in-Suit

Both the timing and type of knowledge of the patent-in-suit has been found to be highly relevant. Pre-suit knowledge of the patent-in-suit from direct communication between the patentee and accused infringer is, of course, the best evidence. However, attempts have been made to show pre-suit knowledge of the patent-in-suit from other sources such as patent prosecution activities or inference of knowledge due to copying of a patented product.

Without pre-suit notice, proving willfulness is extremely difficult, normally requiring the patentee to seek a preliminary injunction.

3. Standards of Commerce

In *Seagate*, the Federal Circuit explicitly left the task of applying the new willful infringement standard to future cases. One question that arises is whether the first prong of the *Seagate* test ("clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent") should be determined by (1) consideration of only the merits of the case (i.e., how close the case was); or (2) consideration of the merits plus other factors, such as whether the steps taken by the infringer after knowledge of the patent were reasonable in the circumstances of the case.

We raise this question because *Seagate* itself is vague as to how standards of commerce come into play in the analysis. Rationally, it would seem that "standards of commerce" should be considered only for the second, subjective prong, but Judge Newman's concurrence suggests a broader use of the standards of commerce. In other words, does the first prong require consideration of whether the defenses to the patent are objectively reasonable, or can the analysis include whether the acts by the infringer were objectively reasonable (or both)?

Our analysis reveals that there is not yet a clear answer as to whether and how "standards of com-

merce” fit into the first prong. In one subsequent Federal Circuit case, *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1336 (Fed. Cir. 2009) (decided by a panel that included Judge Newman), the court held that “evidence of copying in a case of direct infringement is relevant only to *Seagate*’s second prong.” Further, the court found that “designing around” was not relevant to *Seagate*’s first prong. *Id.* at 1337. We believe a majority of cases follow this approach and do not consider acts by the infringer in considering the first prong of the *Seagate* test. Many cases grant summary judgment or JMOL to the accused infringer after determining that the issues were close or that reasonable defenses were presented.

However, in *i4i Ltd. P’ship v. Microsoft Corp.*, 598 F.3d 831, 860 (Fed. Cir. 2010), *aff’d*, 131 S. Ct. 2238 (2011), a different Federal Circuit panel considered the actions taken by Microsoft in concluding the jury verdict of willfulness was supported:

Despite th[e] highly similar functionality, there is no evidence Microsoft took any remedial action, even though Microsoft knew of the ‘449 patent as early as April 2001, before any work had begun on [Microsoft’s product]. For example, Microsoft . . . started marketing, selling, and instructing others in the use of [Microsoft’s product] in 2002. *Cf. DePuy Spine, Inc. v. Medtronic Sofamor Danek*, 567 F.3d 1314, 1336-37 (Fed. Cir. 2009). Similarly, there is no evidence Microsoft ever made a good faith effort to avoid infringement; internal emails show Microsoft intended to render i4i’s product “obsolete” and assure “there won’t be a need for [i4i’s] product.” Based on this and other evidence presented at trial, it would have been reasonable for the jury to infer that Microsoft went ahead with producing, marketing, and promoting its [product] despite an objectively high likelihood the [product] infringed the ‘449 patent. ***This***

same evidence supports the jury’s finding as to the subjective prong of Seagate.

Id. (emphasis added). Here, the Federal Circuit relies on the acts of Microsoft, including the lack of remedial actions, in considering the first prong of the *Seagate* analysis, contrary to the suggestion of its prior decision in *DePuy*. As seen in our chart, there are several district court cases that also consider the reasonableness of actions of the infringer in considering whether the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent (i.e., *Seagate*’s first prong).

As a practical matter, if the court does not resolve the willfulness issue before trial, the actions of the accused infringer will be before the jury, since they are relevant to at least the second prong of the *Seagate* test. Thus, both sides will want to develop their evidence on the actions taken by the accused infringer after notice of infringement.

The accused infringer should consider seeking a jury instruction as to the type of evidence that can be used to satisfy the first prong of the *Seagate* test. Alternatively, an accused infringer can seek a directed verdict from the court and JMOL of no willful infringement if reasonable defenses were presented.

4. Opinions of Counsel

No case has found willfulness where the accused infringer obtained an opinion of counsel, except where the opinion counsel was not informed of key facts.

Internal analysis of a patent by the accused infringer was found to be a factor supporting non-willfulness in several cases. However, consideration has been given to the qualifications of the person giving the opinion. In several cases, the patentee highlighted the lack of qualification and/or training in U.S. patent law of the person giving the opinion.

An opinion of counsel would appear to be relevant to both prongs of the *Seagate* analysis. An opinion can demonstrate that there were reasonable defenses to infringement and that the accused infringer took objectively reasonable steps to make sure its actions did not create a great risk of in-

fringement. Further, an opinion can go to the state of mind of the accused infringer under the subjective prong of the *Seagate* test.²

Of course, lack of an opinion no longer gives rise to an adverse inference that an accused infringer willfully infringed. However, several cases have allowed arguments that lack of an opinion can be considered in determining whether the actions of the accused infringer were objectively reasonable.

5. Testimony from Employees

Testimony from employees that they believe there is no infringement has been relevant in finding no willfulness. However, courts have made it clear that it is the jury's province whether to accept or reject the credibility of such testimony.

6. Relationship of Parties

It appears from our review that findings of willfulness are more likely in cases involving competitors. This makes sense since at least under the subjective prong of the *Seagate* test, there will more likely be evidence of concern regarding a competitor's patents and knowledge of its patented products.

It is not clear that the relationship of a party as a competitor should make any difference under the objective prong of the *Seagate* test. As noted above, however, in considering the objective prong of the *Seagate* test, at least some courts look at the reasonableness of one's actions.

It would appear to be a good and reasonable practice to study and take steps to avoid the patents of known competitors since there is a higher risk that they will have patents that could be infringed.

7. Copying and Designing Around

While the Federal Circuit's *DePuy* decision suggests that evidence of copying or designing around should only come into play if the second, subjective prong of the *Seagate* test is reached, it appears this evidence comes into play in many of the reported decisions, often without specifying to which prong such evidence relates.

Where there is evidence of copying, willful-

ness is more likely to be found and, conversely, if there is evidence of attempts to design around, willfulness is unlikely to be found. Perhaps these results would be changed if district courts were to become diligent in instructing juries to consider such evidence only if they first determine the objective prong of the *Seagate* test is satisfied.

B. Additional Practice Points

1. The Risk of Willful Infringement Still Exists After *Seagate*

While willful infringement has become more difficult to prove, many jury verdicts of willful infringement have occurred after the *Seagate*. Courts on occasion have reversed jury findings of willfulness. There are over thirty cases post-*Seagate* that have found willful infringement and in which damages were enhanced. Therefore, any ring of the death knell for willful infringement is premature.

As discussed above, cases in which the accused infringer copied the patentee's product, cases in which the accused infringer does not react to early notice of a patent, and cases involving competitor's patents appear to be the riskiest situations. Further, opinions of counsel and early evaluation of patents still are the best course to have the strongest evidence of no willful infringement.

2. Early Resolution of Willfulness

An accused infringer should consider making a motion for summary judgment of no willfulness. Courts have granted such motions, particularly in circumstances in which the court knows the merits of the defenses or there is no clear actual notice of the patents pre-suit. For example, if the court has already considered other defenses on summary judgment, this may help a motion for summary judgment of no willfulness. Further, if a preliminary injunction has been sought and denied, this should support summary judgment of no willful infringement.

Early resolution of willful infringement could keep from a jury certain potentially prejudicial evidence of subjective intent (e.g., copying, lack of opinions, internal e-mails, etc.).

VII. Conclusion

After *Seagate*, proving willful infringement has become more difficult. However, quite a few jury verdicts of willfulness have been upheld by district courts and the Federal Circuit.

Summary judgment of no willful infringement has become a successful strategy for many accused infringers. Courts have also been active in reversing jury findings of willfulness, particularly if reasonable defenses have been presented.

The *Seagate* test for willfulness is still evolving. It is not clear that presenting only reasonable defenses to a patent in litigation will shield an accused infringer from a finding of willful infringement by a jury.

Patentees would be well served by giving early notice of infringement when possible. Of course, patentees have to be careful regarding notice of infringement if they are not ready for litigation because an accused infringer can initiate a pre-emptive declaratory judgment action. However, early notice has been a crucial factor in many willfulness determinations after *Seagate*.

If a company receives pre-suit notice of a patent, serious consideration should be given to obtaining formal opinions and taking other steps to evaluate the risks under the patent. Careful attention should be given to the risk of willful infringement with regard to the patents of competitors. If the product or patent of a competitor is copied, or

if competitors in a field have known patent portfolios, the importance of an independent study and opinion that such behavior steers clear of valid patent claims is even more important. After notice of a patent, one should ask what evidence exists that reasonable steps were taken to determine whether there is a real risk of infringement.

¹ Joseph Casino is a partner at the firm of Amster, Rothstein & Ebenstein LLP. Amit Parikh is a student at Fordham



University School of Law who plans to join Amster, Rothstein & Ebenstein LLP upon graduation in 2012. The authors would like to thank David Goldberg, David Boag and Michael Kasdan of Amster, Rothstein & Ebenstein LLP and the NYIPLA for their assistance in finalizing this article. The views expressed by the authors are their personal views.

² Opinions may also be helpful when inducement issues are involved in a case to show lack of specific intent to induce infringement. *See, e.g., DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304 (Fed. Cir. 2006) (*en banc*). ■

Moving UP ▲ & Moving ON >>>

Elizabeth M. Barnhard, formerly of Wyeth, and
Dr. Susie S. Cheng, formerly of Jones Day, have joined the
Pharma/Biotech Practice Group of Leason Ellis.

The Bulletin has introduced a new feature for the Association's members. If you have changed your firm or company, made partner, received professional recognition, or have some other significant event to share with the Association, please send it to the Bulletin editors: Wanli Wu (wwu@wiggin.com) or Robert Greenfeld (RGreenfeld@mayerbrown.com).

SUPREME COURT 2010 - 2011 IP CASE REVIEW

by Mayer Brown LLP's Supreme Court & Appellate Practice

Global-Tech Appliances, Inc. v. SEB S.A., No. 10-6

(May 31, 2011)

Issue: Patent Act – Required State of Mind for a Claim of Inducement

Under Chapter 28 of the United States Patent Act, 35 U.S.C. § 271(b), “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” In *Global-Tech Appliances, Inc. v. SEB S.A., No. 10-6*, the Supreme Court held that to be held liable under Section 271(b) the defendant must know that the induced acts constitute patent infringement and that willful blindness, but not mere deliberate indifference, satisfies Section 271(b)’s knowledge requirement.

In *Global-Tech Appliances*, petitioners, the defendants below, bought one of respondent’s home-cooking devices from Hong Kong, copied many features from respondent’s appliance, and developed a similar device for sale in the United States. Because the exemplar that petitioners purchased and copied was bought abroad and not intended for the U.S. market, it lacked respondent’s U.S. patent markings. Petitioners did not inform their attorney that they had copied respondent’s device, and the attorney, having failed to locate respondent’s patent, issued an opinion letter stating that petitioners’ device did not infringe any patent that he had found. Petitioners then sold their device to others, who in turn resold the device to consumers. Respondent filed suit claiming, as relevant here, that petitioners were guilty of induced infringement under Section 271(b).

A jury found in respondent’s favor, and on appeal, the Court of Appeals for the Federal Circuit affirmed. Although there was no direct evidence that petitioners actually knew of respondent’s patent before respondent filed suit, the Federal Circuit found that petitioners “‘deliberately disregarded a known risk’” and that “[s]uch disregard” was “‘a form of actual knowledge’” sufficient to establish liability under Section 271(b). Slip op. at 3.

In an opinion by Justice Alito, the Supreme Court affirmed but on different grounds. Accord-

ing to the Court, Section 271(b) “requires knowledge that the induced acts constitute patent infringement.” Slip op. at 10. The Court held that the knowledge requirement is not satisfied by proof of deliberate indifference because a deliberate indifference standard “permits a finding of knowledge when there is merely a ‘known risk’ that the induced acts are infringing” and “does not require active efforts by an inducer to avoid knowing about the infringing nature of the activities.” *Id.* at 14. Rather, absent proof of actual knowledge, Section 271(b) demands proof of willful blindness, which, the Court explained, requires proof of the defendant’s subjective belief that there is “a high probability” of infringement and evidence that the defendant took “deliberate actions to avoid learning of that fact.” Slip op. at 13. Although the lower court had applied the deliberate indifference standard rather than the stricter willful blindness standard, the Court affirmed judgment for the respondent, finding that the record evidence established the petitioners’ willful blindness.

In a dissenting opinion, Justice Kennedy took the position that Section 271(b) requires actual knowledge, and that proof of willful blindness is therefore insufficient to establish liability.

Disclaimer: Mayer Brown LLP filed an amicus brief in support of petitioners on behalf of the Business Software Alliance.

Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems, Inc., No. 09-1159

(June 6, 2011)

Issue: Bayh-Dole Act – Agreements to Assign Patent Rights

In a decision that could affect the numerous recipients of federal funding for research, the Supreme Court addressed the proper interpretation of the Bayh-Dole Act, 35 U.S.C. §§ 200 *et seq.*, which allocates rights in inventions developed with federal funds. The Act allows recipients of federal research funding to retain title to inventions developed with that funding, provided certain con-

ditions are met. The question presented in *Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems, Inc.* was whether the Bayh-Dole Act automatically vested the recipient of federal funding with the rights to an invention developed by one of its employees using that funding. In a 7-2 decision, the Court held that the Act does not automatically vest title to such inventions with the recipient of federal funding and that title instead remains with the original inventor.

The case stemmed from a dispute between Stanford University and Roche Molecular Systems over the patent for an HIV testing kit. The technology behind the kit was developed by a team including Dr. Holodniy, a Stanford researcher. As part of his research, Dr. Holodniy visited Cetus to learn about a technique Cetus developed known as “PCR.” PCR became an integral part of the HIV testing kit Dr. Holodniy developed. As a condition of his visit, Dr. Holodniy assigned to Cetus his rights to any inventions developed from knowledge he gained at Cetus. Cetus subsequently sold those rights to Roche. After Stanford secured three patents relating to the HIV testing kit, Stanford sued Roche for violation of the patents. Roche argued that, as a result of Dr. Holodniy’s assignment, it had a right to develop and market the HIV testing kits.

Chief Justice Roberts, writing for the majority, rejected Stanford’s argument that the Bayh-Dole Act trumped Dr. Holodniy’s assignment of rights to Cetus. The Court focused on the statute’s use of the word “retain,” see 35 U.S.C. § 202(a) (providing that a contractor may “elect to retain title” to an invention), and found such usage incompatible with an implicit vesting of rights. The Court noted that the statutory text also referred to an “invention of the contractor,” see *id.* (emphasis added), a qualifier which would be surplusage in the presence of an automatic vesting of title. Rejecting Stanford’s arguments, the Court held that the Bayh-Dole Act assumed (as is the common practice) that the federal funding recipient would include in its employment contracts an assignment of rights in inventions to the employer. But, where such an assignment is lacking, long-established background principles of patent law require that the patent rights revert to the individual inventor. Although Stanford had attempted to include such an assignment in its employment contract with Dr. Holodniy, the Federal

Circuit previously held that this assignment was ineffective.

In dissent, Justice Breyer, joined by Justice Ginsberg, argued that the Court should have remanded the case to the Federal Circuit for additional development. Justice Breyer outlined two arguments which he felt warranted further briefing in the lower court, before the Supreme Court should pass on the case. First, Justice Breyer strongly criticized the Federal Circuit’s rule which invalidated Stanford’s attempted assignment agreement with Dr. Holodniy. Second, Justice Breyer argued that equitable principles and the goals of the Bayh-Dole Act required a rule that Dr. Holodniy was legally obligated to assign to Stanford his rights in the invention, independent of other agreements with third parties.

Justice Sotomayor wrote a separate concurring opinion, noting her agreement with Justice Breyer’s criticism of the Federal Circuit’s invalidation of Stanford’s assignment agreement. However, she wrote that, because the issue had not been appealed by Stanford, she joined the majority’s affirmance of the Federal Circuit’s decision.

[*Microsoft Corp. v. i4i Limited Partnership*, No. 10-290](#)

(June 9, 2011)

Issue: Patent Act – Standard of Proof

In a decision that largely maintains the status quo but is nevertheless of considerable interest to patent holders and patent users, the Supreme Court held that to establish a patent-invalidity defense an alleged infringer must prove the patent’s invalidity by “clear and convincing” evidence. The decision in *Microsoft Corp. v. i4i Limited Partnership*, No. 10-290, affirms the Federal Circuit’s long-standing interpretation of Section 282 of the Patent Act, 35 U.S.C. § 282, which states that “[a] patent shall be presumed valid” and that “[t]he burden of establishing invalidity . . . shall rest on the party asserting” the invalidity.

The case arose from a patent held by respondent i4i for a method of storing and editing computer code. i4i sued Microsoft, alleging that the popular Microsoft Word program infringed the patent. Microsoft defended on the ground that the patent was invalid because an implementation of the pat-

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ent had been sold in a program manufactured by i4i more than a year before the patent application was filed. At trial, the jury was instructed over Microsoft's objection that the invalidity defense must be proved by clear and convincing evidence. The jury found for i4i. The \$290 million verdict was upheld by the Federal Circuit, making it the largest patent verdict ever sustained by a circuit court.

The Supreme Court affirmed, rejecting Microsoft's argument that patent invalidity need be proven only by a preponderance of the evidence. The Court found that "presumed valid" was a term of art under existing case law when Congress incorporated the phrase in Section 282, and that the phrase had been interpreted to encompass the clear-and-convincing evidentiary standard. Because Congress is presumed to have known of that interpretation when it enacted Section 282, the Court concluded that Section 282 requires clear and convincing evidence to overcome the presumption of validity.

The Court rejected Microsoft's alternative argument that a patent invalidity defense need be proven only by a preponderance of the evidence if, as Microsoft contended was the case here, the defense rests on prior art that had not been considered by the Patent and Trademark Office (PTO) in granting the challenged patent. Notwithstanding Microsoft's contention that dicta in *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), suggested that outcome, the Court found no indication that pre-Section 282 case law distinguished between prior-art evidence considered by the PTO and prior-art evidence not considered by the PTO, and held that Section 282 makes no such distinction.

The Court did indicate that juries could be instructed to give greater weight to prior-art evidence that had not been considered by the PTO in granting a patent when assessing whether the defendant has proven the patent invalid by clear and convincing evidence. But the validity of such an instruction was not at issue here because Microsoft did not request such an instruction.

Justice Breyer, joined by Justices Scalia and Alito, joined the opinion in full but wrote separately to emphasize that the clear-and-convincing standard applies only to questions of fact, not law. Justice Breyer believed this distinction particularly important in the technical area of patent disputes.

Justice Thomas concurred in the judgment. Although he was not convinced that Congress had codified a standard of proof when it adopted Section 282, he believed that the clear-and-convincing standard of proof for patent invalidity was correct as a matter of common law.

Chief Justice Roberts did not participate in the case.

Disclaimer: Mayer Brown LLP filed an amicus brief in support of the petitioner on behalf of the Business Software Alliance. ■

Save the
Date!

The
90th
Annual Dinner
IN HONOR OF THE
Federal
Judiciary

Friday,
March 23, 2012

*The Waldorf=Astoria Hotel
New York City*

"As Time Goes By – NYIPLA, By Any Other Name..."

by Dale Carlson

The history of the NYIPLA is replete with tongue-twisting acronyms. Back in 1981, the Association's Bulletin was called the "The New York Patent Law Association Bulletin." The September 1981 issue was identified as Volume 21, Number 1 - suggesting that the Bulletin of the Association was entering its 21st year of publication then.

In 1983, the Association's name was changed to The New York Patent, Trademark and Copyright Law Association. Although that name aptly reflected the important role that trademark and copyright lawyers brought, and continue to bring, to the table as members of our Association, the name was a bit cumbersome. Accordingly, the Board of Directors searched for an acronym, settling on "NYPTC" since that was considered "easier to say" than "NYPTCLA." To see if you agree, try saying "NYPTC" three times fast!

In any event, the December 1983 Bulletin was published as "The New York Patent, Trademark and Copyright Law Association NYPTC Bulletin." That rather substantial, if not redundant, moniker stuck for a number of years.

Later, when "intellectual property" became a popular catch-all phrase, our Association changed its name again, and the Bulletin became the "NYIPLA Bulletin" as we know it today.

Perusing the last three decades of Bulletins offers more than just a glimpse at Association name changes. It also offers a

glimpse at people changes within the Association: to wit, members becoming

Dale Carlson, a partner at Wiggin and Dana, is NYIPLA Historian and its Immediate Past President.



committee chairs, committee chairs becoming directors, directors becoming officers.

These people changes flow from the various tasks that the committees set out to accomplish, and the accomplishments themselves: amicus brief submissions, commentaries on pending IP legislation, CLE meeting synopses, case law digests, articles of interest, and so forth. The over-arching theme for our Association is education about the significance of intellectual property to our society. This IP education speaks to a myriad of audiences: members educating members, members educating the general public, members educating Congress, members educating the Supreme Court.

If you are interested in getting ahead in your chosen profession, be it in the area of patents, trademarks, copyrights, privacy law, trade secrets, or a related field, in my opinion there's no better way to do so than by becoming active in the NYIPLA. Measured against any other IP law organization I can think of, the NYIPLA stands out as being most worthwhile.

If you're already engaged in NYIPLA committee work, that's great. If you're not, then please feel free to reach out to the Association's Executive Administrator, Feikje Van Rein, to express an interest in becoming active.

If you do become actively involved in the Association now, that activity will become its own reward since it will make you a better IP lawyer. It will also lead to friendships and business contacts that will last a lifetime. Of course, the full measure of the benefits you will gain will only be apparent when you peruse the Association's Bulletins, by whatever name they may then be called, thirty years from now. In the meantime, enjoy!

With kind regards,
Dale Carlson

Hot Topics in Trademark Law – CLE Program

On June 14, 2011, the NYIPLA hosted Hot Topics in Trademark Law, a half-day trademark CLE program and luncheon at The Princeton Club. Speakers included Judge Frances S. Wolfson of the TTAB; Clark Lackert of Dickstein Shapiro; Qiang Ma of Unitalen; Martin B. Schwimmer of Leason Ellis, LLP; Siegrun D. Kane of Locke Lord Bissell & Liddell LLP; Susan Progoff of Ropes & Gray; Sara Blotner & Sofia Rahman of Citigroup; and Kurt Anderson of Giordano, Halleran & Ciesla, P.C. The program was moderated by Jessica L. Copeland of Hodgson Russ LLP and member of the NYIPLA's Continuing Legal Education Committee.

TTAB Policy and Procedure

The Honorable Frances S. Wolfson, Administrative Trademark Judge for the Trademark Trial and Appeal Board of the United States Patent and Trademark Office ("USPTO"), delivered the keynote address, which included an analysis of the USPTO's Strategic Plan for the next 5 years.

The Strategic Plan included three Trademark Objectives and one TTAB objective. The three Trademark Objectives include: (1) maintaining trademark first action pendency on average to be between 2.5-3.5 months with 13 months final pendency; (2) continuous monitoring and improvement of trademark quality; and (3) ensuring accuracy of identifications of goods and services in trademark applications and registrations. And the one TTAB objective is to enhance operations of the Trademark Trial and Appeal Board.

Judge Wolfson focused her discussion on this TTAB objective, which includes five initiatives: (a) workload and pendency; (b) Accelerated Case Resolution ("ACR") and streamlining; (c) settlement; (d) quality; and (e) issuance of precedents. While discussing the first initiative within this objective, Judge Wolfson explained that such effort requires trademark owners and members of the bar to discuss performance goals relating to the pendency of matters. Additionally, the Judge analyzed the current timeline of filed cases and ultimate decisions. While the goal for fiscal year 2011 is 12-14 weeks between "Ready for Decision" to

"Issuance of Final Decision," as of the second quarter of 2011, the pendency of cases was hovering around 18.1 weeks. The Judge explained the efforts being made to curtail this lengthy process.

Another initiative discussed was the development of additional ACR options for *Inter Partes* cases. The Judge explained that the "Classic" ACR is the summary judgment model, where parties filed cross-motions for summary judgment and requested that they be treated as ACR briefs. The parties then stipulate that the Board can resolve any lingering factual disputes. This, in addition to the "Stipulated Record and Trial Briefs" model -- after discovery closes the parties stipulate to forego trial and proceed directly to briefing the case on the merits -- will allow for a more streamlined and time efficient process.

Judge Wolfson continued to discuss the aforementioned five initiatives by explaining the TTAB's goal of improving its involvement with settlement negotiations, recognizing that 66% of *inter partes* cases are resolved by an answer. For the remaining 33%, the TTAB actually opened an inquiry to practitioners to determine the best way it could assist in settlement discussions. As for initiative (d), the



TTAB is implementing Administrative Trademark Judge peer reviews, quarterly reviews by practitioners and a pilot program to review paralegal orders.

Finally, Judge Wolfson explained that initiative (e) involves the development of law through the issuance of precedential decisions, and in order to do that the TTAB finalized its Manual of Procedure (TBMP). The Judge described the revisions in the 3rd edition of the TBMP, which included New Rules, ACR, ESTTA (Electronic System for Trademark Trials and Appeals), Notes instead of Footnotes and it is now searchable using Adobe Acrobat. Judge Wolfson concluded her address by inviting any comments or suggestions for improving the TBMP to be emailed to TBMPcomments@uspto.gov.

Trademark Enforcement in China: U.S. and Chinese Perspectives

Clark Lackert analyzed and explained the global trademark trends and compared them to China, while Qiang Ma reviewed trademark litigation in China. First Mr. Lackert presented his analysis of China's Trademark Enforcement trends. This analysis included a review of the Enforcement options in China, which include Trademark Oppositions under Articles 33 and 34, Administrative Actions, Customs (imports and exports), Judicial Actions (civil and criminal cases), and Procedures for removing online content (auction listings, retailers operating on third party websites, rogue websites). Mr. Lackert explained the various intricacies of Trademark enforcement in the People's Republic of China. Mr. Lackert also explained how prevalent counterfeiting is in China. A recent administrative action resulted in the seizure of counterfeit HONDA parts on January 28, 2011. One hundred seventeen car parts were seized, which included brakes and oil filters that featured the HONDA trademark. China's efforts to police this counterfeiting includes Public Security Bureaus that provide a criminal review of these cases. However, only counterfeiting of registered trademarks carries criminal liability.

Mr. Lackert's discussion of customs was particularly interesting, as he explained the two procedures Customs uses for trademark enforcement. The two Customs procedures are: (1) detention of suspected infringing goods upon request from trademark holders; and (2) detention by Customs "Ex Officio," which is most common with internationally well-known marks. China's effort to enforce trademarks also includes policing of online sales of counterfeit goods. In light of this, the government has established take-down procedures by auction websites, for example Alibaba.

Mr. Lackert concluded that today, China has made significant harmonization efforts, particularly in the enforcement arena. He also explained that there is a growing awareness of the importance of trademarks and IP generally, particularly in the health and safety areas. Finally, he concluded that there are many challenges from a rapidly expanding economy, huge internal population, and a changing legal landscape.

Dr. Ma discussed recent civil actions of well-known marks, including *BMW v. Shenzhen Century BMW Apparel Co.*, which involved litigation over the BMW mark owned by the German automobile manufacturer BMW. The Court held the following: (1) injunction of the use of the infringing mark; (2) statutory compensation of 50,000 RMB; (3) open apology in newspaper; and (4) name change of the infringing company.

Dr. Ma concluded with strategy suggestions for successful litigation, including choosing the right court, *i.e.*, Beijing, Shanghai, Shenzhen; exploiting the Supreme Court retrial proceeding; utilizing litigation for leveraging settlement; investigating financial abilities of infringer and pushing forward the enforcement of this successful ruling.

Notice and Takedown for Trademarks

Martin Schwimmer discussed recent cases analyzing secondary liability in trademark infringement. Secondary liability is applied where a party continues to supply a product or directly controls and monitors an instrumentality used to infringe plaintiff's mark by a third party who it knows or has reason to know is infringing. Mr. Schwimmer analyzed three cases in which defendants lost: *LV v. Akanoc*, 591 F. Supp. 2d 1098 (N.D. Cal. 2008); *Roger Cleveland Golf v. Prince*, No. 09-02119 (D.S.C. 2011); and *Gucci v. Frontline*, 721 F. Supp. 2d 228 (S.D.N.Y. 2010). Mr. Schwimmer also described best practices for VerO and Notice and Takedown. Finally, Mr. Schwimmer explained the frustration in defending against common law claims, *ex parte* relief and anti-fraud measures.

Parody

Siegrun Kane provided an enlightening discussion about Parody and how the First Amendment becomes a perfect storm. Ms. Kane's presentation included a historic look at many examples of parody that were clearly not likely to confuse, including the 1969 S.D.N.Y. decision regarding the "Be Prepared" advertisement, the 1972 E.D.N.Y. decision regarding "Coca-cola" v. "Cocaine" where the same script was used. Ms. Kane's discussion continued with the Ninth Circuit's 2003 decision stating "[w]hen marks such as Barbie 'transcend their identifying purpose' and 'enter public discourse and become an integral part of our vocabulary' they assume a role outside the bounds of

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trademark law.” *Mattel Inc. v. Walking Mountain Productions*, 353 F.3d 792, 807 (9th Cir. 2003). In 2007, the Second Circuit held that there was no dilution by tarnishment, because harm to Starbucks reputation was not proven. *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2007).

Ms. Kane continued her discussion explaining that the First Amendment does not “always blow plaintiff away” and in some instances the defendant loses. For example in *Pfizer Inc. v. Sachs*, 652 F. Supp. 2d 512 (S.D.N.Y. 2009), the Southern District held that the use of Viagra on missiles ridden by models as ads for adult entertainment, placed in front of Viagra’s headquarters, was not a protectable statement about erectile dysfunction. Finally, however, Ms. Kane concluded with the prediction that many plaintiffs will be “blown away by the power of the First Amendment.”

Recent Developments in Anti-Counterfeiting Enforcement

Susan Progoff explained recent developments in anti-counterfeiting enforcement. Ms. Progoff’s discussion included analysis of personal jurisdiction over corporate principals and credit card processors, as was discussed in *Chloe v. Queen Bee of Beverly Hills, LLC*, 616 F.3d 158 (2d Cir. 2010), and *Gucci America Inc. v. Frontline Processing Corp.*, 721 F. Supp. 2d 228 (S.D.N.Y. 2010). Ms. Progoff also explained the various remedies available against service providers and offshore websites. For example, in *The North Face Apparel Corp. v. Fujian Sharing Import & Export Ltd. Co.*, 10-civ-1630 (AKH) (S.D.N.Y. Sept. 13, 2010), the Court awarded \$78 million in statutory damages, a permanent injunction, transfer of funds currently held by payment processors and discovered in the future to the plaintiff, disabling and transferring of domain names to plaintiff, disabling and discontinuance of all service to defendants’ websites, denial of access by ISPs hosting defendants’ websites, and deletion of defendants’ accounts by e-commerce auction websites.

Ms. Progoff also explained the significant criminal penalties for counterfeiting and the increase of seized goods by ICE (Immigration and Customs Enforcement) and CBP (Customs and Border Protection) in recent years, *i.e.*, 19,959 seizures in 2010 with a retail value of \$1.4 billion. Finally, Ms. Progoff concluded with an analysis of statutory enactments and legislation that will continue to curtail the counterfeiting in the U.S. including the Protect IP Act of 2011 (s. 968), Combating Military Counterfeits Act of 2010 (s. 3941) and New York state and city legislation.

Navigating the Social Media Maze

Sara Blotner and Sofia Rahman discussed the difficulties faced by corporations in the dawn of the social media craze. For example, Ms. Blotner and Ms. Rahman explained the necessity of maintaining blogs and social media pages such as Facebook and Twitter accounts. However, policing these pages and blogs is not only an expensive undertaking, it is not a fool-proof endeavor. Ms. Blotner and Ms. Rahman continued to describe the importance of a social media policy, and provided specific drafting considerations to be made before finalizing the policy. For example, there are several regulatory requirements to consider, including that employees’ use of social media may be restricted and/or subject to content restrictions, pre-use filing and/or approval requirements, supervisory review and record retention.

Additionally, Ms. Blotner and Ms. Rahman explained that developing a social media policy includes training, monitoring and enforcement. And specifically addressed advertising in Social Media requires contemplation of commercial speech related issues. Finally, Ms. Blotner and Ms. Rahman discussed the IP issues associated with Content Development.

Rosetta Stone v. Google

Kurt Anderson provided a thorough and enlightening analysis of the *Rosetta Stone* case, including the background of the initial controversy, the procedural history, and the status of the pending appeal. Mr. Anderson explained that the District Court for the Eastern District of Virginia held that Google’s keywords “have an essential indexing function because they enable Google to readily identify in its databases relevant information in response to a web user’s query.” 730 F. Supp. 2d 531 (2010), and that therefore the functionality doctrine prevents a finding of infringement. Additionally, the district court held that “[i]nsofar as Google does not sell language learning software, it cannot be held liable for trademark dilution.” *Id.* at 550.

Mr. Anderson discussed the numerous amicus briefs filed, including INTA’s response on functionality. Specifically, INTA stated that the “functionality doctrine provides a defense to infringement where the defendant has used a functional (and therefore unprotectable) element of plaintiff’s trade dress.” INTA’s brief went on to argue “as a matter of law, the use of a mark for counterfeit or other unlawful purposes cannot constitute a ‘fair use.’”

Finally, Mr. Anderson concluded that the *Rosetta Stone* appeal is currently pending, and is being closely watched by trademark lawyers.

“IP Law from Every Angle”

On July 13, 2011, NYIPLA hosted the panel, “IP Law from Every Angle” at the Princeton Club. The panel introduced young lawyers, summer associates, and law students to the practice of IP law from the perspective of government, in-house counsel, and law firms, as well as to NYIPLA. The panelists were Marty Nagel of the New York City Mayor’s Office of Special Enforcement, Tulloss Delk of IBM, Matt Golden of Merck, and Joe Sherinsky of Orrick, Herrington & Sutcliffe LLP. Dan Reagan of Goodwin Procter LLP was the moderator. The panelists began by describing their pathways to the practice of IP law. After a brief introduction of the primary IP rights, the panelists then delved into two hypotheticals that brought to life the practice of IP law from the perspective of government attorneys, in-house counsel, and firm attorneys. The hypotheticals addressed issues including IP litigation, licensing, client-counseling, and anti-piracy enforcement actions. The panelists closed by discussing how law students can make themselves more attractive to IP law employers and various pathways for law students into the practice of IP law. Throughout the panel and in the reception that followed, audience members posed thoughtful and relevant questions.

Anne Hassett of Goodwin Procter LLP briefly introduced the panel and NYIPLA to the audience, Terri Gillis of Mayer Brown LLP, NYIPLA President, and Michael Bullerman of Kaye Scholer LLP, Young Lawyers Committee Co-Chair, were in attendance. The event was well-attended by young lawyers, summer associates, and law students. NYIPLA received over 110 RSVPs. Information on NYIPLA and membership applications were distributed to all in attendance. A lively reception followed the panel.



Annual Awards Dinner 2011



The Annual Awards Dinner of the NYIPLA was held on Tuesday, May 24, 2011 at the Harvard Club. Incoming Association President Terri Gillis welcomed the members and guests.



Inventor of the Year

The inventor of the Year award recognizes an individual or group who, through inventive

talents, has made worthwhile contributions to society by promoting “the progress of Science and useful Arts.”



Kevin Ecker and John Moehringer presented this year’s Inventor of the Year award to Dr. Rajiv Laroia for his pioneering work at Qualcomm Flarion in the area of Orthogonal Frequency Division Multiplexing which is the foundation for future generation telecommunication technologies such as LTE, 4G and Wi-Fi.

The Association also recognized a group of students for their invention relating to a curb climbing wheelchair made during high school. Jessica Copeland and John Moehringer presented an NYIPLA Young



Innovators award to David B. Ponterio, Dr. Ahron Rosenfeld, Benjamin Barber, Richard Bordoni, Julia Brady, Max Brivic, Michael Cornell, James Doerhoff, Jonathan Goldszmidt, Jeffrey Rovenpor, and Sahib Singh, in recognition of their receiving a patent for their invention.



Conner Writing Competition Winners

This award, named in honor and memory of The Honorable William C. Conner, former judge for the Southern District of New York and past president of the NYIPLA, recognizes excellence in writing by law students in the field of intellectual property law.

The Honorable Barbara S. Jones, United States District Court, Southern District of New York, presented the awards. This year's first place winner was Anthony Cheng from Columbia Law School. His paper is entitled, "Lex Luthor Wins: How the Termination Right Threatens to Tear the Man of Steel in Two." The second place winners were Jason Kreps and Tom Lemmo from New York Law School. Their paper is entitled, "Patents in the New Idea Economy: An Overview of Monetization, Non-practicing Entities, and Recent Federal Jurisprudence."



Hon. Giles S. Rich Diversity Scholarship Award

This scholarship, named in honor and memory of The Honorable Giles S. Rich, former judge for the United States Court of Appeals for the Federal Circuit and past president of the NYIPLA, recognizes a student in a local law school with an interest in intellectual property law who is from a background traditionally under-represented in the legal profession. Each year, the NYIPLA selects a law school and leaves it to the discretion of the law school to select a recipient.

The 2010-11 diversity scholarship recipient was Susan Shin of Fordham Law School. Ms. Shin attended this year's awards dinner.

The 2011-12 diversity scholarship program grant was awarded to the Benjamin N. Cardozo School of Law. John Delehanty presented a check for the scholarship to Cardozo's Professor Justin Hughes.



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**Keynote Speaker:
Honorable Raymond J. Dearie**

The Association was pleased to have the Honorable Raymond J. Dearie, Judge of the U.S. District Court, Eastern District of New York, and formerly its Chief Judge, as the evening's Keynote Speaker. Judge Dearie spoke about renewing our dedication to the legal profession. He urged the attendees to do whatever they can to help improve the administration of justice that is the hallmark of our nation's legal system.





BOARD MINUTES

MINUTES OF MAY 24, 2011 MEETING OF THE BOARD OF DIRECTORS OF THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The meeting of the Board of Directors was called to order at The Harvard Club, 35 West 44th Street, New York, New York at 5:00 P.M. by President Terri Gillis.

In attendance from the Board:

Theresa Gillis	Sue Progoff
Thomas Meloro	Walter Hanley
Charles Hoffmann	Kevin Ecker
Anthony LoCicero	Bruce C. Haas
Dorothy Auth	Alexandra Urban
Jeffrey Butler	Dale Carlson
John Moehringer	

Also in attendance were:

Mark Abate	David Kane
John Delehanty	John Murnane
Edward Filardi	Andrea Ryan
Melvin Garner	John Sweeney
Christopher A. Hughes	

Excused from the Board: Ira Levy, Annemarie Hassett and Leora Ben-Ami.

Robin Rolfe and Feikje Van Rein were in attendance from the association's executive office.

Terri Gillis welcomed the new board members and reviewed the plans and activities for the coming year.

The Board approved the Minutes from the April 24th, May 4th and May 10th telephonic Board meetings. The Board also approved the Minutes from the April 12th, 2011 regular Board meeting.

Terri Gillis announced that the emphasis for the year will be inclusion and participation.

As relates to the financial situation, Terri announced that the NYIPLA is on solid footing in part due to the work done during Mark Abate's presidency.

Terri announced the dates for the NYIPLA's major events for the coming year as follows: the upcoming Trademark event will be held on June 14th, the all day Fall CLE event will be held on November 3rd, and the Judges' Dinner is scheduled for March 23, 2012.

The listing of the new committee chairs was circulated.

Terri Gillis announced the launch of the new NYIPLA website.

Charles Hoffmann reported that the Amicus Committee recommends preparation of an amicus brief in the en banc rehearing of the *Akamai v. Limelight* case. The Board approved preparation of that brief.

The next Board Meeting is scheduled for June 7, 2011 to be held at Mayer Brown LLP.

The present meeting was then adjourned by Terri Gillis at 5:20 P.M.

MINUTES OF JUNE 7, 2011 MEETING OF THE BOARD OF DIRECTORS OF THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The meeting of the Board of Directors was called to order at the offices of Mayer Brown, 1675 Broadway, New York, New York at 12:00 P.M. by President Terri Gillis.

In attendance from the Board:

Theresa Gillis	Sue Progoff
Thomas Meloro	Walter Hanley
Charles Hoffmann	Bruce C. Haas
(joined at 1pm)	Dale Carlson
Anthony LoCicero	Ira Levy
Dorothy Auth	Kevin Ecker
Jeffrey Butler	(by telephone)
John Moehringer	Alexandra Urban
	(by telephone)

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Absent and excused from the Board: Annemarie Hassett and Leora Ben-Ami. Robin Rolfe and Feikje Van Rein were in attendance from the Association's executive office.

Terri Gillis called the meeting to order.

The Minutes of the May Board meeting were approved.

As relates to the financial situation, Jeffrey Butler reported that the NYIPLA now has a new relationship officer in charge of the Association's accounts. Jeffrey also reported that the Association is on solid footing. Terri reviewed the financial sheets over the last 4 years and commented that the Association must take heed to remain cost effective for its members. In addition, Terri noted that we must continue to strive to improve attendance at NYIPLA CLE events.

As relates to the committees, the Board discussed the structure and rotation of chairs of committees. The number of co-chairs was discussed and it was decided that each committee should have one chair and one co-chair, each of whom is appointed on a staggered and rotating basis. Once the staggered style is established, the terms will each be for two years. Terri also pointed out that the role of the Board Liaisons is to participate in the committee meetings and report back to the Board on the committee's activities.

The Board discussed: the pros and cons of having a Privacy Law committee. Sue Progoff suggested that the Privacy Law committee dovetails with computer law, at which point Anthony LoCicero suggested it be renamed the "Internet & Privacy Law committee." Jeffrey Butler emphasized the importance of the privacy law practice and proposed that this committee could facilitate expansion of our membership to areas beyond traditional IP law. Terri agreed but cautioned that more participation on the committee will be needed to maintain it. Sue Progoff agreed to be the Board Liaison for the Privacy Law committee.

Terri requested that each of the Board Liaisons organize a luncheon with their committee chairs to discuss the committee's agenda and goals for 2011-12. Further, Terri requested that the CLE committee and the Meetings & Forums committee liaisons and chairs meet to coordinate the NYIPLA events. In particular, Terri recommended that each of the Meetings & Forums events be organized

with one of the other NYIPLA committees (such as Trademark, Copyright, Women in IP, etc.).

Terri discussed the upcoming membership-wide outreach for committee selection, intended to generate new committee members from within the Association. Terri also announced that all of the committee chairs will be invited to attend the September Board meeting and will be asked to present their committee's agenda for 2011-12.

Dorothy Auth reminded the Board about the upcoming Trademark law CLE event and requested that each Board member consider participating in the event.

Terri announced that a July date has been reserved for a Meetings & Forums luncheon event and proposed that the event be co-sponsored by the Young Lawyers committee so as to expose young lawyers and Summer associates to IP law. Alexander Urban proposed a panel of speakers from different areas of IP law. Ira Levy will spearhead this event.

Terri remarked that membership among young lawyers has declined recently and considered how to remedy the trend. Kevin Ecker suggested reduced pricing for the first 5 years, then regular pricing. Alexandra Urban suggested reduced pricing for corporate attorneys. John Moehringer and Kevin Ecker suggested group pricing for a term (e.g., yearly). Terri requested that Alexandra and Kevin ask the Corporate committee to prepare and submit a proposed price structure for corporate members. In addition, Terri is seeking proposals to recapture "lost souls," i.e., former members who have gone to general practice firms that have not historically been active in the NYIPLA.

Jeffrey Butler, as Treasurer, read the names of the NYIPLA new members. These new members were approved by the Board.

Charles Hoffmann reported that the Amicus Committee will be gearing up to draft the amicus brief for the *Akamai* case and that volunteer writers will be needed.

Terri reported that the Past Presidents dinner is scheduled for October 11, 2011 at The Modern, a restaurant next to the MOMA.

The present meeting was then adjourned by Terri Gillis at 1:52 pm.

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2011 - 2012 Closed Committees

Annual Meeting, May

Anthony F. Lo Cicero

Amster, Rothstein & Ebenstein LLP

Judges Dinner

Charles R. Hoffmann

Hoffmann & Baron LLP

Nominating

Mark J. Abate

Goodwin Procter LLP

Past Presidents

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Wiggin and Dana LLP

Historian

Dale L. Carlson

Wiggin and Dana LLP

Public and Judicial Services

Theresa M. Gillis

Mayer Brown LLP

Professional Ethics and Grievance

Charles R. Hoffmann

Hoffmann & Baron LLP

2011 Fall One-Day Patent CLE Program

Thursday, November 3, 2011

The Princeton Club, 15 West 43rd Street, New York, New York 10036

❖ ❖ ❖

Keynote Speaker: Honorable Joanna Seybert, U.S.D.J.,

United States District Court for the Eastern District of New York

Panel 1 ❖ Ethical Considerations In Prosecution And Litigation

- ❖ Inequitable Conduct
- ❖ Spoliation
- ❖ Vexatious Litigation
- ❖ Injunctions and Sanctions

Panel 2 ❖ The Supreme Court's Increased Interest In Patent Law

- ❖ Induced Infringement
- ❖ Patent Eligibility and the Standard for Invalidity
- ❖ Assignment of Patent Rights
- ❖ The Changing Role of the Supreme Court in Reviewing Federal Circuit Decisions

Panel 3 ❖ Litigation Trends And Issues

- ❖ Strategic Use of Reexamination
- ❖ Compulsory Licensing After Finding of Infringement
- ❖ Current Challenges of Electronic Discovery and Outsourcing

Panel 4 ❖ Changes In The Bar To Challenging Patents

- ❖ America Invents Act
- ❖ Challenging the Validity of Patents
- ❖ Patentable Subject Matter: *Myriad* and Patentability of DNA Molecules

CLE Credits 2 Ethics and 5 Professional

FOR BOTH NEWLY ADMITTED & EXPERIENCED ATTORNEYS

October CLE Luncheon

➤ Thursday, October 20, 2011 ◀

EARN 1.0 NYS/NJS CLE PROFESSIONAL CREDIT

Topic: Recent Developments in U.S. Trademark and Unfair Competition Law

The Union League Club • 38 East 37th Street, New York, NY

2011 Fall One-Day Patent CLE Program

➤ Thursday, November 3, 2011 ◀

EARN NYS/NJS CLE CREDITS 2 ETHICS AND 5 PROFESSIONAL

Keynote Speaker: Honorable Joanna Seybert

United States District Court for the Eastern District of New York

The Princeton Club • 15 West 43rd Street, New York, NY

December CLE Luncheon

➤ Thursday, December 15, 2011 ◀

EARN 1.0 NYS/NJS CLE PROFESSIONAL CREDIT

Speaker: Honorable Randall R. Rader,

Chief Judge, United States Court of Appeals for the Federal Circuit

The Union League Club • 38 East 37th Street, New York, NY

Day of Dinner CLE Program

➤ Friday, March 23, 2012 ◀

The Waldorf=Astoria Hotel • 301 Park Avenue, New York, NY

90th Annual Dinner in Honor of the Federal Judiciary

➤ Friday, March 23, 2012 ◀

The Waldorf=Astoria Hotel • 301 Park Avenue, New York, NY

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