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The America Invents Act – Provisions of Interest to Litigators

By Ognian V. Shentov and James Barabas¹

The recently-enacted America Invents Act (AIA) of 2011² makes a number of changes to U.S. patent law, many of which are of particular interest to litigators. These provisions include a section on joinder, a false patent marking lawsuit limitation, a change to the venue requirement for lawsuits against the U.S. Patent and Trademark Office (USPTO), elimination of the best mode defense in litigation, clarification of previous case law regarding the use of opinion of counsel to prove willful infringement and induced infringement, and a revised defense to infringement based on prior commercial use. These provisions are addressed in detail below.

Joinder – Delaware Rising

The joinder provisions under 35 U.S.C. § 299, which went into effect with passage of the AIA (Sept. 16, 2011), had an immediate impact. Prior to the passage of these provisions, non-practicing entities commonly sued multiple defendants based on claims of infringement of the same patent or patents, where the only thing in common among the various defendants was their alleged infringement. Going forward, it will be much more difficult to succeed with this strategy. With the passage of the AIA, a party

can sue multiple defendants in a single complaint only if:³

- (1) any right to relief is asserted against the parties jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences relating to the making, using, importing into the United States, offering for sale, or selling of the same accused product or process; and
- (2) questions of fact common to all defendants or counterclaim defendants will arise in the action.

Any hope that plaintiffs may have had of arguing that infringement of a patent alone would be sufficient to establish a common question of fact was dashed by the explicit language of the statute itself. In particular, “accused infringers may not be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, based solely on allegations that they each have infringed the patent or patents in suit.”⁴ In short, when suing multiple parties, plaintiffs have the burden to show in the complaint why joinder is appropriate based on specific facts, not including an allegation of infringement. However, an accused infringer may waive the joinder requirement and opt to stay in the original case.⁵ In combina-

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March 2012

In the context of my work with the committee drafting local patent rules for the Eastern and Southern Districts of New York, questions have periodically arisen whether patent litigation really needs special rules. Undoubtedly the perception that patent litigation is “special” is fostered by the existence of a specialized appellate court – the Federal Circuit, by the recently launched Patent Pilot Project, and by the enactment of special local patent rules by a number of district courts. In recent discussions, I have noted a growing tendency to question whether patent litigation is really so special – or is it just another form of complex litigation like any other our federal courts so ably handle. This leads to the follow-on question: Do we do ourselves a disservice by asking for special treatment rather than drawing on the wealth of experience developed by litigators dealing with other kinds of complex cases?

At a recent NYIPLA CLE, Judge Gleeson addressed the Patent Pilot Project. He pointedly questioned the wisdom in limiting patent litigation to a portion of the federal bench. Plainly the entire federal judiciary is equally capable of mastering patent legal principles. The difficulty in patent cases is mastery of (or at least comfort with) the technological issues that underlie the legal analyses in a patent case. Yet the judges participating in the Pilot Project need not have any particular technological expertise. Moreover, the judiciary has to – and does – deal with technology in other contexts – mass torts, product liability, etc. And even the judges of the Federal Circuit have ably served without any particular technological expertise prior to their appointment. Given that the ultimate fact finder to be persuaded in a patent case is often a lay juror, I wonder whether the focus should not be more on training patent lawyers to speak in plain English (as Judge Posner admonished in the context of a recent *Markman* ruling) rather than treating patent cases as a special exception to normal litigation procedures.

I also wonder the extent to which special local patent rules are warranted. Patent cases, like any other cases, come in all shapes and sizes. Fitting all patent cases into a uniform timetable or set of procedures makes

no sense. Is justice served by failing to invalidate an improperly issued patent because the defendant was locked into a rigid straightjacket of the prior art known early in litigation when “final” contentions were due and the plainly invalidating prior art was discovered later



in the discovery process? If the case can be resolved summarily after a term is construed, why delay resolution until after months or years of expensive discovery practice? On the other hand, does it make sense to lock down claim construction months and months before trial? After all, claim construction is part of the jury instructions – which normally can be corrected or amended until the jury retires to deliberate. Would the public and the patent system be better served if, rather than cumbersome procedural rules that are often far more rigid than in other types of litigation, procedures in patent cases were managed flexibly with an objective of overall fairness and efficiency in the context of the specific suit? Again, doing so would require patent litigators to explain in plain English the circumstances of the particular case.

We disserve the public and the patent system if, for the sake of procedural conformity among patent cases, we lose sight of the more fundamental objectives of enforcing patents that are valid against infringers and invalidating patents that should not have issued. The current version of the proposed local patent rules is brief and addresses only contentions, *Markman* claim construction procedures, and waiver of privilege when advice of counsel is at issue. The proposed rules set very few deadlines and expressly provide that their few provisions should be modified to accommodate the specific circumstances of a case. To the extent these rules are adopted by the Eastern and Southern Districts of New York, it is my hope that litigators and judges alike implement them with an eye to fairness and efficiency in the specific case.

With kind regards,
 Terri Gillis

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tion, the joinder provisions make it more difficult to sue groups of unrelated defendants, yet allow those defendants the flexibility to join forces if they wish.⁶

The joinder provisions already are having a significant effect on U.S. patent litigation. In particular, the number of parties involved in patent litigation has dropped since the enactment of the AIA. Thus, in the 45 days before the AIA, from August 2, 2011 to September 15, 2011, 265 complaints were filed in the top six district courts in the country (courts with the greatest number of patent cases filed), involving 2,272 parties. In those same courts during the 45-day period following the AIA, from September 16, 2011 to October 31, 2011, 248 complaints were filed, but those complaints involved only 848 parties.⁷ One possible explanation is that the increased cost of litigation and the need to file and keep track of separate lawsuits has made it less attractive for plaintiffs to sue parties for which the potential damages award may be insignificant. Before the AIA, filing lawsuits against such parties added little incremental cost for a plaintiff, and in the context of multi-party litigation was frequently used to justify the selection of a venue that is similarly convenient (or inconvenient, as the case may be) to all defendants.⁸ With the new joinder provisions, it can be expected that in the long run fewer parties will be named in patent infringement suits, because there would be less of an incentive for plaintiffs to sue parties for which the expected damages are low.

The new joinder provisions have caused other practical changes as well. For example, the popularity of the District of Delaware has increased in both relative and absolute terms. Between the same 45-day periods discussed above, the number of patent cases filed in Delaware increased from 76 to 101. Since the AIA was enacted until February 6, 2012, Delaware has seen the largest number of patent cases filed in any district at 262. By contrast, the number of cases filed in the Eastern District of Texas decreased significantly between the same 45-day periods, dropping from 91 to 36 patent cases, although that district remains popular with plaintiffs and ranks second overall with 202 patent cases filed since the AIA was enacted. The Federal Circuit's jurisprudence on venue transfer,⁹ along with recent district court decisions, seem to suggest that further realignment of the most popular patent litigation venues may occur.¹⁰ In particular, one can expect that defendants will seek more often to transfer venue, especially where their manufacturing and sales operations are local in nature and are far removed from the forum chosen by the plaintiff. Last, but not least, at this point it remains unclear whether, under Section

299 of the AIA, compliance with a particular industrial or technical standard (for example signal compression standards, such as JPEG or MPEG) will be deemed to create "questions of fact common to all defendants," sufficient to justify joinder of multiple unrelated parties.¹¹

False Patent Marking – The Beginning of the End

Over the past several years a cottage industry had developed in which private parties would find products that had allegedly been falsely marked with a patent number, such as those products marked with numbers of expired patents, and would proceed to file *qui tam* actions in which, under 35 U.S.C. § 292(b), they were entitled to collect one half of the recovered penalties. These suits had been criticized by the patent bar and various district courts on constitutional and other grounds, including the lack of actual damage to the *qui tam* plaintiff, while causing the parties defending against these suits to incur significant litigation expenses.¹² The AIA addresses this problem by eliminating the standing most private parties have to file such suits – the Act makes clear that "[o]nly the United States may sue" for the statutory penalty under Section 292 of up to \$500 for every such offense.¹³ Newly added subsection 292(c) further limits the grounds for this type of litigation by providing that marking a product "with matter relating to a patent that covered that product but has expired is not a violation of this section."¹⁴ Finally, it is very significant that the amendments to Section 292 "shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of enactment of this Act."¹⁵

An important exception still allows private parties to allege false marking. The AIA provides that "[a] person who has suffered a competitive injury as a result of a violation of this section may file a civil action in a district court of the United States for recovery of damages adequate to compensate for the injury."¹⁶ There are significant hurdles to such lawsuits. First, the Federal Circuit has held that the requirement to plead with particularity allegations of fraud applies to false marking claims, and that a complaint that makes only conclusory allegations is insufficient to let a false marking claim proceed.¹⁷ Based on the history of recent litigations, few private parties will be able to clear this hurdle. Furthermore, it is likely that establishing a competitive injury based on false marking, and justifying a dollar number that quantifies the associated damages a competitor has suffered, will not be a trivial task.

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Venue Change – The Eastern District Of Virginia And The USPTO

Lawsuits against the USPTO must now be filed in the Eastern District of Virginia District Court, rather than in the District of Columbia District Court.¹⁸ The legislative history of the AIA suggests that the venue change was made in order to correct an oversight in the 1999 American Inventors Protection Act, in which Congress established that as a general matter the venue of the USPTO is the district in which it resides (i.e., the Eastern District of Virginia).¹⁹

Best Mode – What Remains Of This Requirement

Failure to satisfy the best mode requirement has been eliminated as a defense in patent litigation, effective immediately upon enactment of the AIA.²⁰ In particular, defendants can challenge the validity or enforceability of a patent based on any requirement of 35 U.S.C. § 112, “except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable.”²¹ This change seems unlikely to have much effect on patent litigation, because the failure to disclose a best mode was never a particularly popular or successful defense. But it is unclear why the drafters of the AIA chose to retain the best mode requirement in Section 112 (with which patent applicants still must comply), while taking away the primary enforcement mechanism penalizing the applicants for a failure to comply with the requirement.²²

With respect to the changes concerning best mode, the USPTO has advised its examiners in part as follows: “As this change is applicable only in patent validity or infringement proceedings, it does not alter current patent examining practices set forth in MPEP 2165 for evaluation of an application for compliance with the best mode requirement of 35 U.S.C. § 112.”²³ However, in the context of determining whether a later application is entitled to an earlier filing date, “Examiners should consult with their supervisors if it appears that an earlier-filed application does not disclose the best mode for carrying out a claimed invention and the filing date of the earlier-filed application is actually necessary.”²⁴ It remains to be seen how seriously applicants for a U.S. patent will continue to take the best mode requirement, and whether the USPTO will be in a position to ensure compliance with the requirement.

Failure To Obtain An Opinion Of Counsel May Not Be Used To Prove Willful Infringement Or An Intention To Induce Infringement Of A Patent

The AIA added new Section 298 regarding the advice of counsel:

The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of an infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.²⁵

In part, the new provision merely codifies existing case law. The Federal Circuit had already held that there was no affirmative obligation to obtain an opinion of counsel to combat an allegation of willful infringement. *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007). However, the AIA rejected a portion of another Federal Circuit opinion concerning the impact of a failure to obtain an opinion of counsel with respect to inducement of infringement. *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683 (Fed. Cir. 2008). In *Broadcom*, the Federal Circuit held that “[b]ecause opinion-of-counsel evidence, along with other factors, may reflect whether the accused infringer ‘knew or should have known’ that its actions would cause another to directly infringe, . . . such evidence remains relevant to the second prong of the intent analysis,” i.e., “that the accused infringer knowingly induced infringement and possessed specific intent to encourage another’s infringement” (citations omitted), and that “the failure to procure such an opinion may be probative of intent in this context.”²⁶

The AIA does not adopt the above holding in *Broadcom*. In explaining the reason for this change, the legislative history of 35 U.S.C. § 298 provides as follows:

The Act includes a new provision that bars courts and juries from drawing an adverse inference from an accused infringer’s failure to obtain opinion of counsel as to infringement or his failure to waive privilege and disclose such an opinion. Section 298 of title 35 is designed to protect attorney-client privilege and to reduce pressure on accused infringers to obtain opinions of counsel for litigation purposes. It reflects a policy choice that the probative value of this type of evidence is outweighed by the harm that coercing a waiver of attorney-client privilege inflicts on the attorney-client relationship. Section 298 applies to findings of both willfulness and intent to induce infringement—and thus legislatively abrogates the Federal Circuit’s decision in *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (Fed. Cir. 2008).

H.R. Rep. No. 112-98, pt. 1, at 53 (2011) (“H.R. 1249 Report”). The new AIA provision further de-emphasizes the role of an opinion of counsel in litigation, and is not expected to have much of an effect on the conduct of parties in litigation.

Prior User Rights Defense Revised to Protect U.S. Business Interests in the First-to-File World

A “prior user rights defense” generally refers to a defense to patent infringement afforded to a party that was commercially using, or engaged in substantial preparations for commercial use of, an invention that was later patented by another party.²⁷ Previously limited in the United States to business methods, under amended 35 U.S.C. § 273 the prior commercial use defense against a claim of patent infringement may now be asserted for any technology covered by a patent issued after September 16, 2011.²⁸ The prior commercial use must have occurred in the United States, at least one year before the earlier of the effective filing date of the claimed invention or the date on which the claimed invention was disclosed to the public.²⁹ To invoke the defense, an alleged infringer must have commercially used the claimed invention in good faith in connection with an internal commercial use or an actual arm’s length sale or transfer.³⁰ The burden of proof is on the party asserting the defense, and must be established by clear and convincing evidence.³¹

In addition to making the defense applicable to all technologies, amended Section 273 expands the number of parties who may claim a prior user rights defense to include a parent, subsidiary or affiliate under common control.³² But Section 273 also imposes important limitations, exceptions and penalties associated with the defense. Thus, the prior use defense is personal, and may not be licensed, assigned, or transferred, except in connection with an assignment or transfer of the entire business related to the defense.³³ Furthermore, the defense is geographically limited to cover only those sites where the invention was used before the critical date.³⁴ The defense does not apply to infringing activities after the date of abandonment of commercial use.³⁵ Section 273 also provides an exception to the prior user rights defense for inventions that, when they were “made,” were subject to ownership or obligation of assignment to universities or their technology transfer organizations.³⁶ Failure to demonstrate a reasonable basis for asserting the defense carries potentially stiff penalties, as the statute provides that the court “shall find the case exceptional” for the purpose of awarding attorney fees.³⁷

Prior user rights defenses have long been considered a necessary part of a transition to the first-to-file system used by most countries in the world.³⁸ But details in the practical implementation of such defenses vary from country to country, especially with regard to the level of activity required by a party to assert prior user rights. This level ranges from pure use in Brazil and Canada, to a pure possession of the invention in France, and various hybrid schemes used by

other countries.³⁹ In its January 2012 report on the prior use defense, the USPTO has taken the position that amended Section 273, which requires an internal commercial use or an actual arm’s length sale or transfer and affirmatively sets forth several scenarios in which subject matter is considered to be “commercially used,” strikes the right balance between protecting the interests of patent holders and those of business entities that choose to protect their intellectual property as a trade secret.⁴⁰

The effect of the amended prior user rights defense on U.S. patent litigation remains to be seen. Despite being used for a long time in many countries, this defense has not generated significant case law, and is essentially untested in the context of U.S.-style litigation. Should the defense be tested, some of the new law provisions seem likely to prove problematic. For example, despite the transition to a first-to-file system, the wording of the university exception in amended Section 273 opens the door to disputes concerning conception and reduction to practice in the context of when the invention was “made.” Still, public comments from interested parties thus far suggest that the prior use defense provided in amended Section 273 is likely to work as intended, and will not generate significant legal disputes or added litigation costs.⁴¹ An implementation report on the prior user rights defense by the USPTO is due in 2015.⁴²

Conclusion

In sum, changes in U.S. patent law following the enactment of the AIA in September 2011 have had a significant impact on patent litigation and will continue to have an impact in the future. In particular, the joinder provisions have already led to shifts in patent litigation complaint filing strategies. The changes to the false marking statute have allowed many district courts to clear an entire line of cases from their dockets. The change to the venue provision should make the District Court for the Eastern District of Virginia, already an important court and a well known “rocket docket” for patent cases, even more important in patent law. The change to the best mode provision raises questions, including whether the best mode requirement in Section 112 will have any practical impact on patent prosecution practice. The AIA codified existing case law concerning willful infringement and effectively removed questions about the effect that a failure to obtain the advice of counsel with respect to patent infringement, or to present such advice to a judge or jury, may have had. The prior use defense has not played a significant role in patent litigation so far, and this will likely remain so even though important questions are still unresolved. On balance, the AIA seems to have addressed several concerns expressed in recent years about the joinder,⁴³ false marking, and willful in-

fringement provisions, and harmonizes the U.S. patent law with the rest of the countries that have first-to-file systems. Potentially expensive litigation scenarios are now somewhat less likely to occur. Time will show if the goals of the AIA – “moderniz[ing] US patent law to improve the operations of the US Patent and Trademark Office, inhibit[ing] frivolous patent lawsuits, protect[ing] the rights of all inventors, and spur[ring] innovation as a means to create American jobs and raise standards of living” – have been effectively promoted.⁴⁴

(Endnotes)

¹ Ognian Shentov is a partner at Jones Day and is a member of the New York Intellectual Property Law Association’s Patent Litigation Committee. His practice focuses on intellectual property litigation, portfolio management, and counseling for companies in the United States and abroad. He can be contacted at ovshentov@jonesday.com. Jim Barabas is an associate with Allen & Overy LLP’s New York office and is also a member of the New York Intellectual Property Law Association’s Patent Litigation Committee. His practice focuses on intellectual property litigation and counseling for companies in the United States and abroad. He can be contacted at james.barabas@allenoverly.com. Any opinions expressed in this article are solely those of the authors and do not necessarily reflect the opinions or views of any of their clients or respective law firms.



² Pub. L. 112-29, 125 Stat. 284 (2011).

³ 35 U.S.C. § 299(a) (2011).

⁴ 35 U.S.C. § 299(b) (2011).

⁵ 35 U.S.C. § 299(c) (2011).

⁶ A recent district court case, *Preservation Techs. LLC v. Google*, No. 8-11-cv-1860 (C.D. Cal., filed Dec. 2, 2011), illustrates some aspects in the practical application of new joinder Section 299. Following the enactment of the AIA, in December 2011, plaintiff Preservation Technologies filed several patent infringement suits on the same patents against various parties. Upon consulting with the parties, the district court judge issued a consolidation order, pointing to the allegation that the defendants in each case have infringed the same patents (which on the face of the new law is insufficient to justify joinder), and stating that the cases are to be consolidated, “[b]ecause there will be a significant amount of overlap between these cases.” While there can be little doubt that multiple parallel cases involving the same patents would involve a significant amount of overlap, it should also be apparent that the defendants, including entities such as Google, YouTube, Netflix, Amazon, Sony, Hulu, and Dish Network, waived their right to challenge joinder, as they are permitted under Section 299(c). One can only speculate whether the same defendants would have acted differently had they been sued elsewhere.

⁷ What Effects Are Patent Reform Measures Having On The Number Of Patents And Patent Cases Being Filed? (Nov. 15, 2011), <http://docketreport.blogspot.com/2011/11/what-effects-are-patent-reform-measures.html>.

⁸ To test the hypothesis that the new joinder provisions caused a drop in the number of parties sued for patent infringement, we also looked at the 45 days exactly a year prior to enactment of the AIA (September 16, 2010 to October 31, 2010), as determined in the docketreport.blogspot cited above. The number of parties sued for patent infringement in this time period in the top six patent district courts was 940, or roughly 11% higher than the number of parties sued in 2011 over the same time period.

⁹ See, e.g., *In re Genentech, Inc.*, 566 F.3d 1338 (Fed. Cir. 2009); *In re Hoffmann-La Roche Inc.*, 587 F.3d 1333 (Fed. Cir. 2009); *In re Nintendo Co.*, 589 F.3d 1194 (Fed. Cir. 2009); *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008).

¹⁰ Of note here are two cases. In the first, Klausner Technologies sued over 25 defendants in the Eastern District of Texas shortly after the AIA was enacted, asserting that because all defendants used similar visual voicemail capabilities as those of other defendants, there are common questions of fact and hence joinder was appropriate. *Klausner Techs., Inc. v. Oracle Corp.*, No. 6-11-cv-00556 (E.D. Tex., filed Oct. 25, 2011). This direct challenge to the joinder provision of the AIA failed, as merely days later, on November 1, 2011, Klausner filed a notice of voluntary dismissal against all but one party in the original case, and filed individual suits against the dismissed defendants. In another significant ruling, the Federal Circuit granted a writ of mandamus, transferring a case out of Delaware, where the defendant Link_A_Media Devices Corp. (LAMD) was incorporated, to the Northern District of California where LAMD had its principal place of business. *In Re Link_A_Media Devices Corp.*, 662 F.3d 1221 (Fed. Cir. 2011). This case appears to be part of an increased concern by the Federal Circuit that patent infringement cases should be heard in a forum that has a logical connection with the merits of the dispute and that “forum shopping” not be enabled by rigid rules effectively barring transfer. This ruling has particular significance because many companies are incorporated in Delaware, and it now will likely be more difficult to maintain suits in that state against such companies that operate elsewhere.

¹¹ A recent district court order sheds some light on how the question of using a common standard may be applied in the future for purposes of the joinder provision. *Medsquire LLC v. Spring Med. Sys.*, No. 2:11-cv-4504 (C.D. Cal. (Dkt. 139) Dec. 1, 2011). In this order, the district court judge granted defendants’ joint motion to dismiss all but one of the defendants for misjoinder under Fed. R. Civ. P. 20. (The common “transaction or occurrence” requirement for permissive joinder under Fed. R. Civ. P. 20 is substantially similar to the corresponding requirement in new Section 299(a), but Rule 20(a)(2)(B) further permits joinder in case of a common question of either fact or law, whereas Section 299 of the AIA only permits joinder under a question of *fact* common to all defendants.) In opposition, plaintiff argued that each defendant makes and sells software that complies with a federal standard for the certification of software in medical devices, and that compliance with the standard necessarily entails infringement of the asserted patent. Slip op. at 4. Because the original complaint in the case was filed before the enactment of AIA, the order did not rely on the joinder provisions in AIA. Instead, relying on *Fujitsu Ltd. v. Netgear, Inc.*, 620 F.3d 1321, 1327-28 (Fed. Cir. 2010), the court found misjoinder because “only in situations where a properly construed patent covers every possible implementation of a standard will it be enough to prove infringement by showing standard compliance,” and determined

that plaintiff had not established in this case that the asserted patent covers every possible implementation of the standard. *Id.* The standard for joinder in *Medsquire* appears to be rather strict, and is likely to be modified in future decisions.

¹² Regarding the rationale for the change to false marking law, the legislative history of the AIA provides as follows:

The Federal Circuit's recent decision in *Forest Group, Inc. v. Bon Tool Co.*, 590 F.3d 1295 (Fed. Cir. 2009), which held that section 292's \$500 fine is assessed for each product that is falsely marked, has created a surge in false-marking *qui tam* litigation. Though one might assume that section 292 actions are targeted at parties that assert fictitious patents in order to deter competitors, such a scenario is almost wholly unknown to false-marking litigation. False marking suits are almost always based on allegations that a valid patent that did cover the product has expired, but the manufacturer continued to sell products stamped with the patent; or that an existing patent used to mark products is invalid or unenforceable; or that an existing and valid patent's claims should not be construed to cover the product in question.

Indeed, a recent survey of such suits found that a large majority involved valid patents that covered the products in question but had simply expired. For many products, it is difficult and expensive to change a mold or other means by which a product is marked as patented, and marked products continue to circulate in commerce for some period after the patent expires. It is doubtful that the Congress that originally enacted this section anticipated that it would force manufacturers to immediately remove marked products from commerce once the patent expired, given that the expense to manufacturers of doing so will generally greatly outweigh any conceivable harm of allowing such products to continue to circulate in commerce.

To address the recent surge in litigation, the bill replaces the *qui tam* remedy for false marking with a new action that allows a party that has suffered a competitive injury as a result of such marking to seek compensatory damages. The United States would be allowed to seek the \$500-per-article fine, and competitors may recover in relation to actual injuries that they have suffered as a result of false marking, but the bill would eliminate litigation brought by unrelated, private third parties.

H.R. Rep. No. 112-98, pt. 1, at 53 (2011) ("H.R. 1249 Report").

¹³ 35 U.S.C. § 292(a) (2011).

¹⁴ 35 U.S.C. § 292(c) (2011).

¹⁵ 35 U.S.C. § 292 (2011).

¹⁶ 35 U.S.C. § 292(b) (2011).

¹⁷ *In re BP Lubricants USA Inc.*, 637 F.3d 1307, 1309 (Fed. Cir. 2011).

¹⁸ 35 U.S.C. §§ 32, 145, 146, 154(b)(4)(A), and 293 (2011).

¹⁹ The Legislative history on this point states:

In 1999, as part of the American Inventors Protection Act (AIPA), Congress established that as a general matter the venue of the USPTO is the district where it resides. [citing 35 U.S.C. § 1(b)]. The USPTO currently resides in the Eastern District of Virginia. However, Congress inadvertently failed to make this change uniformly throughout the entire patent statute. As a result, certain sections of the patent statute (and one section of the trademark statute) continue to allow challenges to USPTO decisions to be brought in the District of Columbia, a place where the USPTO has not resided in decades.

Because the USPTO no longer resides in the District of Columbia, the sections that authorize venue for litigation against the USPTO are consistently changed to reflect the venue where the USPTO currently resides.

H.R. 1249 Report at 49.

²⁰ 35 U.S.C. § 282 (2011).

²¹ *Id.*

²² Regarding the reason for this change to the best mode requirement, the legislative history of the AIA provides in relevant part as follows:

Under current law, the defense of patent invalidity is available for failure to comply with any requirement of § 112 (specification) or § 251 (reissued patents). Further, a defendant in patent litigation may also allege an intentional nondisclosure of the best mode, with intent to deceive the Office, as a basis for an unenforceability defense. Many have argued in recent years that the best mode requirement, which is unique to American patent law, is counterproductive. They argue that challenges to patents based on best mode are inherently subjective and not relevant by the time the patent is in litigation, because the best mode contemplated at the time of the invention may not be the best mode for practicing or using the invention years later.

In response to these concerns, the Act includes a provision that eliminates best mode as a basis for both invalidity and unenforceability defenses under § 282; other defenses are unaffected.

H.R. 1249 Report at 52.

²³ Robert Bahr, Memorandum re Requirement for a Disclosure of the Best Mode, dated September 20, 2011 (http://www.uspto.gov/aia_implementation/best-mode-memo.pdf).

²⁴ *Id.*

²⁵ 35 U.S.C. § 298 (2011).

²⁶ *Broadcom*, 543 F.3d at 699.

²⁷ See generally Keith Kupferschmid, *Prior User Rights: The Inventor's Lottery Ticket*, 21 AIPLA Q.J. 213, 216 (1993).

²⁸ 35 U.S.C. § 273(a) (2011) ("A person shall be entitled to a defense . . . with respect to subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process.")

²⁹ 35 U.S.C. § 273(a)(1), (a)(2) (2011).

³⁰ 35 U.S.C. § 273(a)(1) (2011).

³¹ 35 U.S.C. § 273(b) (2011).

³² 35 U.S.C. § 273(e) (2011).

³³ *Id.*

³⁴ *Id.*

³⁵ 35 U.S.C. § 273(e)(4) (2011).

³⁶ 35 U.S.C. § 273(e)(5) (2011).

³⁷ 35 U.S.C. § 273(f) (2011).

³⁸ Gary L. Griswold & F. Andrew Ubel, *Prior User Rights—A Necessary Part of a First-to-File System*, 26 J. MARSHALL L. REV. 567, 572 (1993).

³⁹ *Report On The Prior User Rights Defense*, by the U.S. Patent and Trademark Office, pp. 13-15, January 2012, http://www.uspto.gov/aia_implementation/20120113-pur_report.pdf.

⁴⁰ *Id.* at 2-4.

⁴¹ *Id.*

⁴² *Id.* at 4.

⁴³ With respect to joinder, the legislative history of the AIA provides that "[t]he Act also addresses problems occasioned by the joinder of defendants (sometimes numbering in the dozens) who have tenuous connections to the underlying disputes in patent infringement suits." H.R. 1249 Report at 54.

⁴⁴ H.R. 1249 Report at 73.

Accrual and Damages Considerations for Systematic Copyright Infringements

By James M. Gibson, Jason H. Kasner & David A. Jones, Jr.¹

In the realm of copyright infringement litigation, the proper choice of venue can be a decision with significant financial consequences, especially for cases involving systematic, ongoing copyright infringement of multiple works. Suppose Company X licenses upgradable software or publishes and distributes a daily periodical to Company Y and, over the course of many years, Company Y copies and distributes the versions of the software or issues of the publication to unauthorized recipients within its company. This is clearly a violation of copyright law, but, because the entire unauthorized reproduction and distribution occurs internally, Company X is entirely unaware that its rights have been violated. In the tenth year of infringement, a whistle-blower alerts Company X of its subscriber's practice and Company X promptly files suit. In this, or another like scenario, may Company X be compensated for damages incurred over the entire ten-year period of infringement? The answer likely depends on where the suit is brought.

The Copyright Act makes clear that a claim for copyright infringement cannot be maintained “unless it is commenced within three years after the claim accrued.” 17 U.S.C. § 507(b). What the Copyright Act does not make clear is just when it is that a claim for copyright infringement accrues. There is a split amongst federal district courts regarding the determination for accrual of a copyright claim. There are two primary schools of thought when it comes to determining the date of accrual for copyright infringement claims – the “discovery rule” and the “injury rule.” The majority view among Courts of Appeals that have addressed the issue is the discovery rule. In addition, in circuits in which the Court of Appeals has not ruled directly on the issue, district courts have sometimes held the discovery rule to govern the accrual of copyright infringement claims. When the Supreme Court refused to grant *certiorari* in *William A. Graham Co. v. Haughey*, 646 F.3d 138 (3d Cir.), *cert. denied*, 132 S. Ct. 456 (2011), it missed an opportunity to clear up an ongoing debate amongst the circuit courts regarding this critical question, and to provide clarity to copyright litigants going forward.

The “discovery rule” theory holds that a claim for copyright infringement accrues when a plaintiff knows or has sufficient reason to know of the facts upon which the

claim is based. Since its introduction, hybrid variations of the “discovery rule” have emerged, as courts grapple with the competing interests of copyright plaintiffs and defendants. These alternate permutations, which will be discussed below, further the confusing landscape of the law on copyright infringement accrual.

In the discovery rule's purest form, as articulated by the Ninth Circuit Court of Appeals in *Polar Bear Productions, Inc. v. Timex Corp.*, 384 F.3d 700, 706 (9th Cir. 2004), the three-year Statute of Limitations in Section 507 of the Copyright Act begins to run only when the plaintiff discovers, or should have reasonably discovered, that it has been injured. The pure discovery rule applies the Section 507 limitation period solely to the plaintiff's claim and does not address the potential damages available – an important distinction which is explored below in the context of the Fifth Circuit's hybrid rule. To wit, if a plaintiff discovers (or should have reasonably discovered) an ongoing series of infringements in 2011 which stretch back to 1990 – assuming the plaintiff files its complaint within three years of that discovery, it will have the opportunity to recover damages dating back to the first infringement in 1990. This rule strongly favors plaintiffs, because claims under the Copyright Act do not accrue until discovery, and there are no statutory limitations as to how far back a plaintiff can seek damages.

On the other hand, a minority of courts, including courts in the Second Circuit, apply the “injury rule,” as thoroughly reasoned and explained in *Auscape Int'l v. Nat'l Geographic Society*, 409 F. Supp. 2d 235, 247 (S.D.N.Y. 2004). In *Auscape*, Judge Kaplan of the Southern District of New York provided a rather lengthy and comprehensive examination of the statutory text and legislative history of the Copyright Act along with relevant case law, most importantly the Supreme Court's decision regarding claim accrual under the Fair Credit Reporting Act in *TRW Inc. v. Andrews*, 534 U.S. 19 (2001). Judge Kaplan concluded that Congress' overriding goal in establishing the three-year statute of limitations was to achieve certainty. Calculating the running of the statute of limitations from the date of discovery, Judge Kaplan went on to state, would undermine that goal.

In contrast to the discovery rule, the injury rule maintains that a claim accrues at the time the copyright in-

fringement occurs, regardless of whether the aggrieved party is actually aware of the harm. The reasoning of *Auscape* and the injury rule in general rests on principles of foreseeability and judicial economy, but offers little flexibility for plaintiffs who could not have uncovered infringing activities even despite good faith, diligent investigation. An aggrieved plaintiff may seek refuge under an equitable tolling remedy, which would ostensibly allow the plaintiff to toll the statute of limitations and bring claims timely even after the statute of limitations period has run; however, the standard for such relief is high, often requiring an overt and fraudulent act by the defendant to conceal the infringing activity. In many cases involving corporate copyright infringement, copies are made and sent exclusively internally, using intranet and similar private systems, making such discovery nearly impossible. Operating securely within a private corporate system is the normal course of business for most major corporations, and may not provide a successful basis for equitable tolling. Therefore, potential plaintiffs with no means of reasonably discovering ongoing internal infringements may be barred from recovering damages for any infringing activity that is ultimately discovered after the three-year limitations period.

The reasoning behind the injury rule relies on the principle that copyright infringement is an inherently public enterprise. See 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 12.05 (2007). In most common copyright infringement cases, such as in the reproduction and distribution of pirated music or movies, this is more likely to be true since the infringer primarily benefits from sale of the infringing copies to the public. However, in the case of software and industry trade publications, copyright infringers stand to benefit from making and distributing copies internally to their own employees through secure networks. In this scenario, the infringing activity is neither public nor capable of being reasonably discovered, even through diligent policing. Is it fair to charge a copyright holder with notice of infringements which, by their very nature, are not known to any other party but the infringer?

The Third Circuit squarely addressed the *Auscape* opinion and declined to follow it in *Haughey*, 646 F.3d 138. *Haughey* disagreed with *Auscape* at almost every turn. Among other reasons, *Haughey* highlighted *Auscape*'s concession that the text of the Copyright Act actually offered little insight into Congress' intent regarding the accrual of copyright infringement claims, and found instead that whatever insight was provided more likely favored implementation of the discovery rule.

The continued validity of the discovery rule's application to copyright infringement cases is beginning to come into question in certain circles. See *Warren Freedendfeld Assocs., Inc. v. McTigue*, 531 F.3d 38, 46 n.3 (1st Cir. 2008) (citing *Auscape*). Some scholars and commentators also strongly favor the injury rule, and are urging courts to examine *Auscape*'s analysis and adopt the injury rule. See *Nimmer on Copyright* § 12.05[B][2][b], at 12-150.4 to 150.8 (calling *Auscape* "the best articulation to date of how to compute the Copyright Act's statute of limitations").

Under the Fifth Circuit's hybrid discovery rule, articulated in *Makedwde Publishing Co. v. Johnson*, 37 F.3d 180 (5th Cir. 1994), a copyright infringement claim still accrues when the plaintiff knew or should have known of the infringing activity, and the plaintiff still has the three-year statute of limitations period in which to bring its claim. This is consistent with the pure discovery rule. However, a plaintiff then may only claim damages for infringements occurring within three years of *the date of filing the complaint*. The Fifth Circuit applies the Section 507 statute of limitations to the time for a plaintiff to bring its claim and, retroactively, to the applicable damages period. This method attempts to straddle the fence between the two rules, providing plaintiffs more time to file their claims, but protecting defendants by limiting the potential damages for potentially stale claims.

This hybrid rule, however, effectively nullifies the benefit to plaintiffs of the discovery rule and does not take into account redressing ongoing, systematic infringing activity. If the infringing activity has been ongoing for many years without the plaintiff's knowledge, the plaintiff may be in a position where he is permitted to bring a claim but not permitted to recover damages, if successful. This hybrid rule is more favorable for a copyright plaintiff than the injury rule, but does not go as far as the discovery rule in permitting recovery for past infringements.

To be fair, in jurisdictions employing the injury, discovery and/or hybrid rule, equitable tolling remedies are also available which would allow for recovery of past infringements. However, difficulties inherent in obtaining this "protection," as discussed above, are great and often the burden of obtaining equitable tolling relief is too high to be a realistic option.

The rule that emerged from the *Haughey* case in the Third Circuit is a nuanced alternative which addresses copyright claim accrual as well as the availability of damages (and of pre-judgment interest). According to the Third Circuit, a copyright infringement claim accrues, "at the moment at which each of its component

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elements has come into being as a matter of objective reality, such that an attorney with knowledge of all the facts could get it past a motion to dismiss for failure to state a claim.” 646 F.3d at 150. This definition of accrual is consistent with the injury rule, and is also a departure from the traditional discovery rule. The traditional discovery rule is characterized as “one of those legal precepts that operate to toll the running of the statute of limitations period after a cause of action has accrued.” *Id.* Under the Third Circuit’s discovery rule, however, the claim still accrues when the infringing act occurs, but the Section 507 statute of limitations is tolled until a plaintiff knew or should have known of the existence of a cause of action, at which time the plaintiff will have three years to bring suit. Since the claim accrued and was then tolled, a plaintiff may properly claim damages back to the accrual date without disturbing the Section 507 limitations period.

The Third Circuit’s nuanced opinion is, in principle, logically appealing. Although courts differ on the interpretation of Congress’ intent on whether the injury or discovery rule should apply to accrual of copyright claims, the Third Circuit’s approach seeks to reconcile these differences by eliminating confusing and contradictory terms and streamlining the rule. By characterizing the discovery rule as an equitable measure rather than an accrual-altering rule, the Third Circuit has wisely sidestepped the entire debate. Under *Haughey*, there is no question of when a copyright claim actually accrues – once all elements of the claim are satisfied – regardless of the plaintiff’s knowledge. The Third Circuit’s discovery rule would seemingly be applied discretionally, as an equitable measure, where a plaintiff could not have reasonably known of the infringement, tolling both the time to bring the claim and to recover damages. The *Haughey* method also takes into account the growing number of internal infringements by eliminating the extremely daunting burden most plaintiffs face under current equitable tolling rules.

Courts may be better served inquiring, as a threshold matter, whether the infringing activity was of a nature that the plaintiff, through reasonable and diligent investigation, would have been able to discover, rather than a draconian application of a three-year statute of limitations to the allowable damages period. If the infringement was something that the plaintiff could have discovered, the injury rule rationale seems fair and proper. However, if the infringing activity is internal and, essentially,

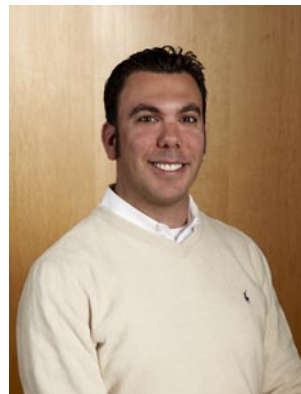
undiscoverable by its very nature, courts may consider applying the Third Circuit’s “discovery rule” in order to afford plaintiffs the chance to recover the full spectrum of damages for copyright infringement.

Because the Supreme Court denied *certiorari* in the *Haughey* case, which would have been a perfect opportunity to put to rest confusion between the circuits regarding copyright claim accrual, the debate between the injury rule and the discovery rule remains. The differing accrual philosophies among the circuits should not be overlooked by a copyright plaintiff when deciding where to file suit, to ensure an opportunity to fully recover all possible damages. This is especially true for claims against systematic, ongoing copyright infringement, where infringing activity could have gone undetected

for many years beyond the term of applicable statute of limitations. Until the Supreme Court accepts a case such as *Haughey*, and brings clarity to this area of copyright law, the battle between the injury rule and discovery rule will continue, and plaintiffs prosecuting cases for multiple infringements must be cognizant of the rules for each district or risk losing out on significant potential damages awards.

(Endnotes)

¹ James M. Gibson is a Partner with Powley & Gibson, P.C., and Jason H. Kasner and David A. Jones, Jr. are associates with Powley and Gibson, P.C. specializing in trademark and copyright law. James, Jason and David may be reached at 212-226-5054 and via e-mail at jmgibson@powleygibson.com, jhkasner@powleygibson.com and dajones@powleygibson.com, respectively. The views expressed in this article are solely those of the authors and are not to be attributed to Powley & Gibson, P.C. or any of its clients.



As Time Goes By – An Off-Key Keynote of Note

by Dale Carlson

Imagine this: You are seated in the Grand Ballroom of the Waldorf-Astoria at the Judges' Dinner. After the usual pre-prandial drinks and multi-course meal, you settle in for dessert and what you may have come to expect will be a light-hearted and entertaining speech from the keynote speaker.

On this occasion, however, you are destined to get more than you bargained for.

The speech opens on a sober note, to wit: "I do not have the slightest interest in providing entertainment for dinner parties or for anyone else. . . . My sole reason for coming here is to impress upon you the need for the legal profession to start playing a truly responsible role in our society."

By mid-speech, fighting words are flying through the air: "The patent lawyers here tonight may have been wondering why so far I have not alluded to them. Yet patent lawyers exhibit the same tendencies that pervade other segments of the profession. They too are skilled in the tactics of obfuscation and delay. Moreover, I believe that many patent lawyers do harm to the economy and to the credibility of the patent system. Frequently they represent the narrow economic interests of their clients, to the detriment of the public, by using such tactics as indiscriminate patenting of minor design details."

Although the Judges' Dinner audience generally behaves with decorum that is fitting of the grandeur of the occasion, at the moment things have gone awry. Hurling through the air are insults from the audience directed at the keynote speaker. The speaker and members of the audience engage in heated debate. In short order, pandemonium erupts throughout the Grand Ballroom!

Perhaps this is a dream . . . only a bad dream. However, you wake up from your dream to find that the date is March 30, 1979. You are attending the NYIPLA's 57th Annual Judges' Dinner. The keynote speaker is seventy-nine-year-old

Admiral Hyman G. Rickover, head of the U.S. Navy's nuclear fleet and aptly nicknamed "Father of the



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

Nuclear Navy." His speech is ominously titled "Lawyers Versus Society."

Viewed with the unique balm that only time can offer, the Admiral's speech makes a lot more sense than the audience hearing it at the Waldorf may have realized. He was fed up with the delay tactics and obfuscation associated with the endless litigation that the government was embroiled in over seemingly petty issues. He sensed that lawyers may be the only ones capable of fixing the mess endemic to an overly-litigious society he believed lawyers were responsible for abetting.

His message, albeit one largely lost on the audience at the Judges' Dinner, is that lawyers in their individual capacity have the responsibility and duty to act above self-interest, and narrow client interest, to protect a free society; otherwise, the free society will not remain free.

The Admiral put it thusly: "A free society cannot exist unless the public has confidence that justice through the legal system is available equally to all; that courts can and will deliver justice in a timely manner which people of ordinary means can afford; and that lawyers, as officers of the court, are men of integrity, well trained and dedicated to resolving differences in society fairly. Further, the responsibility must rest with each member of the bar."

Admiral Rickover's speech is reproduced in its entirety in this issue of the Bulletin. If he were alive today, the Admiral would doubtless be pleased that his words, and the facts he alluded to, are being re-visited now, when clearer heads can prevail.

As you re-visit Admiral Rickover's speech, or visit it for the first time, it may be helpful to keep his approach to analyzing facts in mind, to wit: "Sit down before fact with an open mind. Be prepared to give up every preconceived notion. Follow humbly wherever and to whatever abyss Nature leads or you learn nothing. Don't push out figures when facts are going in the opposite direction."¹

In many respects, the Admiral's take was dead-on. However, on the evening of March 30, 1979, he may have been the only person in the Grand Ballroom with that insight. Today, we may look at things a little differently.

With kind regards,

Dale Carlson

(Footnotes)

¹ As quoted in *Business Insider*, December 2010.

This speech reflects the views of the author and does not necessarily reflect the views of the Secretary of the Navy or the Department of the Navy.

For release 8:00 PM (EST)
Friday, March 30, 1979

LAWYERS VERSUS SOCIETY
by
ADMIRAL H. G. RICKOVER, USN
before the
NEW YORK PATENT LAW ASSOCIATION, INC.
NEW YORK, N.Y.
MARCH 30, 1979

Several weeks after I agreed to address this group, officials of your association began expressing interest in the topic of my speech. They urged me to talk about my career, national defense, history, philosophy, my perception of the future – anything but patents, they said federal judges and corporate executives would be present and that the members and guests would want to enjoy themselves.

I do not have the slightest interest in providing entertainment for dinner parties or for anyone else. I have always lived, among other rules, by the one, “Heaven is blest with perfect rest, but the blessing of earth is honest toil.” My sole reason for coming here is to impress upon you the need and importance for the legal profession to start playing a truly responsible role in our society.

In the legal community and elsewhere, the pedestal of professionalism is now shaky. Abuses of power by businessmen, accountants, doctors, and lawyers – make it obvious that something is wrong. Instead of working for the benefit of society, many professionals seem to be working for the benefit of a few or for themselves. Professional organizations appear unable or unwilling to police their members. Public confidence in them has declined, although other professions are also at fault, lawyers are the brunt of the criticism.

It has been my experience that members of the legal profession are contributing substantially to the erosion



of values and institutions on which our society is based. In their quest for money and power many lawyers seem to have forgotten their obligations. By so doing, they alienate their countrymen; breed distrust of our institutions and those who run them; and undermine the traditional values of honor, humility, and honest dealing.

The problem stems largely from the growing obsession with money in our society. Preoccupation with profit creates incentives and pressures on individuals to act in ways they would not otherwise consider.

Lawyers are supposed to be officers of the court; it is to them that society has entrusted the administration of justice. The American people expect our so-called officers of the court to be more than mercenaries. Yet in pursuit of their own interests, many lawyers have lost sight of the public good. Instead of holding back the attack on our institutions and values, many have instead led it.

There has been a breach of faith by lawyers – and the public knows it. A recent national poll found them ranked below garbage collectors in public esteem and that but a small part of the public has confidence in law firms. The Chief Justice of the Supreme Court recently concluded that a majority of lawyers practicing in court are not properly equipped to do so. The President himself has stated publicly that we are “over-lawyered and under-represented.” A foreign official has commented, “You have lawyers like other people have mice.”

It is argued that our adversary system of law demands that attorneys litigate vigorously, regardless of the merits of their client's case. This view has become a rationalization for practicing the law in a way that frequently offends justice and debases the integrity of our judicial system. Too often the finances, patience, and time available to a litigant have become more important to the outcome of a case than its legal merits. Lawyers should instead strive to focus the court's attention on the legal or factual issues in dispute quickly and efficiently. But many of them do the opposite. Law practiced in this manner does not aim to reconcile the parties and resolve the disputes. It strives to benefit those who have the resources to dominate the court by distracting it.

One of the most frustrating and wasteful practices in society today, and one that contributes most to the breakdown in our system of justice, is the deliberate obfuscation of issues by lawyers. Faced with a weak case, many seek to redirect attention to irrelevant matters and technicalities. By so doing they can delay or altogether avoid unfavorable decisions on the legal merits of a case.

Although complaints about delays in the judicial process are widespread and often discussed in legal circles, I wonder how many lawyers even care, or have a realistic appreciation of the detrimental effects frivolous litigation, legal maneuvering, massive discovery campaigns, and delaying tactics have, not only on the judicial process, but on other worthwhile human endeavors. Caught up in the heat of their legal battles, and with an eye towards the rewards, many lawyers seem indifferent to the effect their litigative tactics have on their victims.

I have had first hand experience with these effects and I doubt they are unique. I am responsible for the design, construction, and safe operation of 152 operating nuclear reactors in naval ships and ashore – more than the total of all other operating commercial reactors in the U.S. today. Like many other projects in government and industry, this work requires meticulous attention to detail and long hours by many dedicated people. Every year it becomes harder and harder for them to do a proper job. Their efforts and attention must increasingly be redirected to extraneous matters. In this respect, the legal profession is making a great negative contribution to our defense.

As one minor example, fifteen years ago, the General Accounting Office reported that a large defense contractor had overcharged the government \$500,000

on one of my contracts. Last December the issue finally came to trial. I expect a ruling in about a year. The issue is simple. Yet the lawyers representing the contractor have managed to drag it out. Meantime, their client has use of the money in dispute.

In another case, a large conglomerate refused to honor its contract, contending it was invalid and should be repriced. Four years of massive discovery and legal maneuvering have now elapsed, and validity of the contract has yet to be tried in court. Meanwhile, the time of many key Navy personnel is diverted from their primary duties.

In this case I have been subject to more than 40 hours of detailed interrogation under the guise of discovery by a team of experienced lawyers over a period of several weeks. Had they been interested only in gathering information about the case, they could have completed the questioning in one to two hours. Of course, the longer they take, the more money these high-priced lawyers make. A few days ago, I received word that the lawyers want to resume my deposition.

How is the common good served when lawyers obfuscate issues, delay and harass the opposition, and attempt to abrogate contracts? How is justice served by frustrating the legal institutions and procedures that have been established and are available to the public for resolution of disputes? Even when both parties can afford the legal costs, the delay and harassment now typically involved in litigation make it increasingly unattractive to all except the lawyers. Moreover, through delay, one party can effectively deny his adversary's right to a judicial determination.

Last summer, the Secretary of the Navy decided to grant the Navy's three largest shipbuilders extra-contractual relief totaling more than \$500 million under a special law Congress had enacted to cover extraordinary actions determined to be necessary to facilitate the national defense. The Secretary said that not granting such relief would inevitably mean long years of litigation and a disruptive relationship which would unreasonably jeopardize the national defense.

Large contractors and their well-paid law firms have thus made litigation unpalatable and difficult for their adversaries. In such a climate the concept of justice is lost; victory will usually go to those in the strongest negotiating position.

The tactics of delay and obfuscation which serve some lawyers well in court have now permeated the government procurement process. By dragging out

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disputes, law firms make it possible for their clients to defer or perhaps avoid reporting large losses to stockholders. Several large shipbuilders were for many years able to avoid reporting such losses, simply by predicting optimistic recoveries from pending litigation, and the longer a case drags on, the greater the likelihood of government people leaving for other jobs, memories fading, and the case being finally settled independent of the legal merits.

There are now law firms which specialize in omnibus claims against the government. These claims have distinguishing characteristics. They often go from tens to hundreds of millions of dollars. They are grossly inflated, so that settlement at a fraction of the claim will still yield the desired amount. They are based on unsubstantiated allegations that the government is at fault. They do not show a cause and effect relationship between alleged government responsible actions and the amount claimed.

Some draw an analogy with other types of litigation, such as personal injury suits where a lawyer might ask for \$1 million in damages in the hope of recovering \$25,000. In such cases, no one takes the initial amount seriously. The judge or jury arrives at a figure independently, based on the testimony of witnesses.

But contract claims against the government are different. Since public funds are at stake, every element of these claims must be scrutinized for legal entitlement and the cost audited and evaluated. Large claims of this sort tie up many key people for many years who must evaluate the valid and invalid portions of the claim. Those on whom the government must rely for claims analyses are the very ones who are also responsible for other on-going work.

One conglomerate submitted claims totaling about \$1 billion against the Navy. The claims comprised 64 volumes, each two inches thick, and covered many years of performance under various contracts.

Government teams under the direction of a special independent board required a year and a half to evaluate these claims. They were eventually settled for less than one-fourth the amount claimed. To justify even this figure, the government had to include large sums to cover litigative risk and litigative cost – that is the likelihood of unfavorable decisions by a court, and the estimated cost for the government to spend years litigating.

Abuse of the discovery process, harassment, obfuscation, and delay are not practices unique to claims lawyers.

Wide ranging interrogatories and extensive discovery requests have become a standard legal tactic. I understand some law firms have thousands of questions stored in computers, available at the press of a button. Thus, even the limits of an attorney's imagination or time need no longer be a constraint on the mischief he can cause.

Another example of lawyer mischief involves the Freedom of Information Act. The Act was designed to ensure public access to government information.

Now, law firms are using it to conduct, in effect, unilateral discovery proceedings in disputes with the government, and at times when the latter has no comparable right to the corporate data. The law firms are able to use the Act to give their clients an unfair advantage over the government in litigation.

Some law firms try to obtain for their clients, through the Freedom of Information Act, information they could not otherwise get about their commercial competitors, such as labor and overhead rates, estimating practices, and so on – information that is furnished to the government in the procurement process.

In such instances, the government often ends up in the middle. Under the Freedom of Information Act, government employees can be disciplined for improperly withholding such information. Yet under another statute, they can be fined and imprisoned for releasing a company's proprietary data. One company sues the government to disclose data about a competitor; the competitor then sues to forbid its release. This is an example of the chaos produced by the fertile minds of our lawyers. It is also an example of the advantage lawyers are taking of the system to promote the interests of their clients – and themselves. I doubt that those who enacted the Freedom of Information Act envisioned the uses to which it has been put by lawyers.

The patent lawyers here tonight may have been wondering why so far I have not alluded to them. Yet patent lawyers exhibit the same tendencies that pervade other segments of the profession. They too are skilled in the tactics of obfuscation and delay. Moreover, I believe that many patent lawyers do harm to the economy and to the credibility of the patent system. Frequently they represent the narrow economic interests of their clients, to the detriment of the public, by using such tactics as indiscriminate patenting of minor design details.

Members of the Patent Bar, while purporting to be looking out for the public interest, frequently promote

concepts which favor their large clients. The dogma of the patent lawyers is contradictory. On the one hand, they contend that government contractors should get exclusive rights to inventions developed at government expense, yet rarely, if ever, have I heard patent lawyers criticize these contractors for requiring their employees to give up all rights to inventions developed at contractor expense.

The patent lobby speaks eloquently of freedom, the free enterprise system, and competition, in connection with patent issues. In practice, however, they help large companies fence out competition by blanketing fields of technology with patents and patent applications on ideas and items not worthy of a patent. Small firms that cannot afford the delay and cost of infringement litigation do not enter the market.

The patent lobby is actively promoting the concept that the government should provide businessmen greater incentives to invest in technology in order to combat a perceived decline in this country's technological growth. The recommended incentives take the form of increased government spending for research and development and granting contractors exclusive rights to patents developed at government expense.

I am not convinced that there is actually a decline in technology or that the infusion of government funds would be an appropriate solution. In any event, should the government spend more, large companies will probably get the lion's share of the increase – as they always do.

Patent lawyers well know that increased government research and development spending and giving government contractors. Exclusive rights to government financed inventions will promote greater concentration of economic power in large conglomerates, and at public expense. Suppose, with vast sums of government money, a large company makes a major discovery in energy. What would an ordinary taxpayer think if that company could, for 17 years, legally control the dissemination, use, and pricing of this invention? Yet this is what the patent lobby advocates.

Most professions have a group that sets standards of conduct for its members, and is supposed to discipline transgressors – an organization whose charter places professionalism above money considerations. In the legal community, this group is the American Bar Association.

Unfortunately, this organization seems to be further undermining respect for the legal profession. By responding with a counter attack to thoughtful criticism by

our President and our Chief Justice, the ABA showed it is more interested in preserving its customs than in being a professional organization. Perhaps it should be renamed the American Bar Protective Association, or ABPA.

The ABA's disciplinary procedures are widely recognized as a token effort, with disbarment reserved primarily for the rare member who is occasionally convicted of a felony. Even where misconduct is found, punishments are often light. A Pennsylvania attorney, found guilty of embezzling \$10,000 from a client's inheritance, was merely suspended from the ABA. A New York attorney refused to allow his client to be brought to trial until his fee had been paid. He then deducted the fee from the bail money, which he intercepted. The ABA called the incident a mere fee dispute and took no disciplinary action.

The ABA has done nothing to solve the revolving door problem—where lawyers get experience in government, and then join private firms which represent clients against their former government agency. One Washington law firm that specializes in claims against the Navy is headed by a former Navy general counsel. Another such firm was headed by a former member of the defense department's Armed Services Board of Contract Appeals. And only last month the chairman of this very same board resigned to become a partner in this very same firm. There he will join an ex-Navy deputy counsel who was responsible for defending the government against shipbuilding claims.

Several months ago, The Wall Street Journal carried an advertisement by a former Navy attorney who touted his experience with claims while employed by the Navy. He solicited clients who desired to submit claims against the government. Despite years of debating this subject, the legal profession and the ABA have yet to enforce their own rules against lawyers switching sides.

The ABA often operates more like a trade association than a professional society. For example, its public contract law section represents the association in matters relating to government procurement, yet it has become a front for the claims lawyers who dominate its membership and actions.

Last year, the ABA was actively lobbying Congress in favor of a bill governing disputes under government contracts. The views of this organization carry great weight in such arcane subjects.

Buried in their proposed legislation were numerous loopholes, all of which favored claims lawyers and their conglomerate clients. For example, the bill set a double standard which invariably worked against the govern-

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ment. Also, agencies would, for the first time, be given authority to horse-trade claim settlements without regard to their legal merits. But this was not clearly spelled out in their proposal; it would be apparent only to those well versed in the claims business.

I pointed this out in Congressional testimony, and the bill was changed to eliminate these loopholes. In addition, the bill was modified to require certification of claims and to provide stiff penalties for submission of false claims. As you may by now surmise, the ABA did not endorse these modifications.

Later I learned that the ABA lobbyists who worked on this bill were senior partners of prominent, claims oriented law firms. Claims lawyers, like other citizens, are entitled to lobby members of congress in their own behalf. But for them to do so by using the American Bar Association as the umbrella degrades the entire profession. Why does the ABA tolerate such actions taken in its name?

Today, our nation faces important problems of unprecedented difficulty – declining energy reserves, the economy, the environment, foreign affairs, slowing productivity growth. Faced with these problems we cannot afford so many who, in the pursuit of money, exacerbate the difficulties of these problems.

Lawyers occupy key positions and exert great influence in our society. Many other citizens, also seeking success, emulate them. Is the example being set by many in the legal profession of benefit to our society, or is it harmful? What happens to traditional values when signed contracts are broken with no moral stigma attached to those who break them; when people are driven, under threat of litigation, to pay sums they may not owe; when those skilled in thwarting justice are considered successful men?

I do not mean to indict all lawyers. Many dedicated ones serve in government, on the bench, and in private practice. Nevertheless, the practice of law is today replete with problems that demand correction. And lawyers are the ones who must do the job.

I have some specific recommendations:

- Take steps to discourage frivolous litigation. In
1. this regard, the present requirement to certify pleadings in civil litigation needs strengthening – these requirements are full of loopholes, and are no deterrent to those who would bring frivolous charges before the courts. Criminal penalties should be established and strictly enforced for attorneys who certify pleadings they know or have reason to know are false.

2. Establish within the legal community a truly professional forum for dealing with the problems of law and justice – a forum that would place professional responsibility above commercial considerations; effectively discipline members; and recommend ways of reducing litigation and streamlining judicial procedures.

Judges and others responsible for the administration of justice should act more firmly than they now do in policing our courts. Some judges seem to equate justice with ensuring that each side takes as much time as it wishes to make its case. Where would we be if the Supreme Court operated on that basis?

A free society cannot exist unless the public has confidence that justice through the legal system is available equally to all; that courts can and will deliver justice in a timely manner which people of ordinary means can afford; and that lawyers, as officers of the court, are men of integrity, well trained, and dedicated to resolving differences in society fairly. Further, the responsibility must rest with each member of the bar.

Responsibility is a unique concept: it can only reside and inhere in a single individual. You may share it with others, but it is still with you. Even if you do not recognize it or admit its presence, you cannot escape it. If responsibility is rightfully ours, no evasion, or ignorance, or passing the blame can shift the burden to someone else.

At all levels of our society, there is today much talk of rights and too little of duties. Here is a great opportunity for lawyers, for men who have benefited greatly from the law and from a benign and bounteous land. Here is the opportunity to contribute something in return.

The freedom and privilege you presently enjoy will not last, nor will it be available to future generations, unless you do so; unless you act as responsible professionals and citizens; unless you treat those who act irresponsibly as they deserve to be treated.

In coming here I feel a bit like Eurystheus of Greek mythology. The Augean stables housed three thousand oxen and had not been cleaned for thirty years, Eurystheus did not have the wherewithal to clean the stables himself, but he did point out the problem to Hercules, who cleaned them by diverting two rivers.

In similar vein, I can only hope that some of you will take on the Herculean task of cleansing the legal profession. This is well worth the effort, even if you have to drown a few oxen in the process.

NYIPLA 2012 Annual Meeting and Awards Dinner



Tuesday, May 22, 2012

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

Keynote Speaker

Honorable Barbara S. Jones

United States District Court for the Southern District of New York

SCHEDULE

Annual Meeting CLE Luncheon Ethical Issues in IP Practice

12:00 – 12:30	Registration
12:30 – 1:15	Luncheon
1:15 – 3:00	CLE Presentation

Annual Meeting & Awards Dinner

3:00 – 4:30	Committee Meetings
4:30 – 5:30	Annual Meeting of Members
5:30 – 6:00	Board Meeting
5:30 – 6:30	Cocktail Reception
6:30 – 9:00	Awards Dinner

Registration www.nyipla.org

Annual Meeting CLE Luncheon only	\$ 140.00 Member	\$ 170.00 Non-member
Annual Meeting & Awards Dinner only	\$ 150.00 Member	\$ 180.00 Non-member
Both CLE Luncheon and Dinner	\$ 190.00 Member	\$ 250.00 Non-member

Moving UP ▲ & Moving ON ►►►

- Frankfurt Kurnit Klein & Selz, PC has promoted to counsel Amelia Brankov, Christopher Chase, Nicole Hyland and Michael Schiffer.
- Perkins Coie LLP has launched its New York intellectual property practice with Associate Manny Caixeiro, formerly with Loeb & Loeb LLP, and Partners John Squires and Dennis Hopkins and Of Counsel Chuck Fish, all most recently with Chadbourne & Parke LLP.

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 (www@wigin.com) or Robert Greenfeld (rgreenfeld@mayerbrown.com).

February 1, 2012 CLE Program “Why Should I Take The Patent Bar Exam?”

Carolyn Blessing

On February 1, 2012, the NYIPLA Young Lawyers Committee hosted a Continuing Legal Education (CLE) panel discussion and networking reception at the Princeton Club. The program was titled Associates CLE Panel and Networking Reception: “Why Should I Take The Patent Bar Exam?” Carolyn Blessing of Locke Lord LLP served as moderator.

The panel of speakers included Jessica Davis, an associate at Goodwin Procter LLP; Brian Rothery, a partner at Stroock & Stroock & Lavan LLP; and Peter Thurlow, a partner at Jones Day.

The speakers discussed the utility of taking the Patent Bar Exam generally, and the added incentive, in light of the recently passed American Invents Act (AIA), to take the Patent Bar before September of this year. Mr. Rothery and Mr. Thurlow discussed how their registration with the USPTO has played a role in their practices, both with regard to prosecution and litigation. They presented a primer on the AIA to the group, giving an overview of the changes that will be implemented through this new legislation. Ms. Davis explained her recent experience studying for and passing the Patent Bar, and presented helpful tips for those wishing to prepare for the exam.

Following the panel discussion, all were invited to join in a cocktail reception for informal discussion and networking.

CLE PROGRAMS



February 16, 2012 CLE Program “On the Cutting Edge of Social Media and Behavioral Advertising”

Jonathan Moskin

On February 16 2012, the NYIPLA Privacy Law Committee and Committee on Meetings and Forums hosted a Continuing Legal Education (CLE) luncheon at the Union League Club. The program was entitled “On the Cutting Edge of Social Media and Behavioral Advertising.” Jonathan Moskin of Foley & Lardner LLP served as moderator. The panel of speakers included Henry Goldstein, Privacy and Innovation Services Counsel for CBS Interactive, and Lesley Rosenthal, General Counsel of Lincoln Center for the Performing Arts. Mr. Goldstein discussed how emerging privacy standards and the FTC’s “Do Not Track” proposal may affect online publishers and the overall system and culture of online advertising. In particular, Mr. Goldstein provided technical background regarding methods of personal data collection. He also provided legal background concerning the FTC’s prior efforts to regulate online advertising – in par-

ticular by establishing a “Do-Not-Track” mechanism for consumers to opt out of personal data collection on-line, and industry efforts to anticipate and comply with expected FTC regulations. The talk was particularly timely, because the FTC, on March 26, subsequently released its final report entitled “Protecting Consumer Privacy in an Era of Rapid Change: Recommendations for Businesses and Policymakers.”

Ms. Rosenthal discussed legal issues that arise when businesses use social media to interact with the public—with a particular focus on unique issues facing non-profits and the importance of coordinating on-line marketing efforts with company staff.

My thanks again to the panelists and the attendees.



MINUTES OF JANUARY 10, 2012
MEETING OF THE BOARD OF DIRECTORS OF
THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

BOARD MINUTES

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

In attendance from the Board:

Terri Gillis	Walter Hanley
Charles Hoffmann	Sue Progoff
Anthony Lo Cicero	Bruce C. Haas
Dorothy Auth	Lenora Ben-Ami
Jeffrey Butler	Kevin Ecker
Annemarie Hassett	Dale Carlson
Thomas Meloro	

John Moehring participated by telephone. Absent and excused from the Board were Ira Levy and Alexandra Urban. Feikje van Rein was in attendance from the Association's executive office.

Terri Gillis called the meeting to order.

The Board approved The Minutes of the December Board meeting.

Jeffrey Butler provided the financial report, reporting that the association is in good standing. The recent CLE events have been profitable.

Jeffrey read the new members' list and the Board approved. Jeffrey will review the by-laws with regard to out-of-state membership.

Jeffrey discussed the Auditor's proposed retainer letter and the Board's edits to the proposed letter. The Board approved the revised retainer letter.

Terri Gillis discussed the International Association of Judges event and the need to collect the pledges from sponsoring firms. In addition, the Board approved an immediate payment of \$15,000 to the International Association of Judges as partial fulfillment of the \$25,000 pledge from the various firms.

Terri discussed the proposed new local patent rules for the SDNY and EDNY. These proposed rules have been reviewed by the full committee and the NYIPLA Board has been asked to review the draft. Because of Terri's experience in developing the patent rules, Terri volunteered to participate in the Day-Of-Dinner CLE luncheon event. Anthony Lo Cicero also volunteered to participate on the panel.

Tom Meloro discussed alternative CLE formats based on his discussions with Ira Levy. Tom favored skills-based programs, but was

concerned about the extensive and prolonged involvement of the faculty. Nevertheless, he recommended the Association try the new format. Terri remarked that a one-on-one format would be impractical and suggested a panel presentation on a skills topic. In this regard, the Board appointed a subcommittee to develop a pilot program in this new format by the end of the Summer. The subcommittee consists of Anthony Lo Cicero, Annemarie Hassett and Sue Progoff.

Tom Meloro reported on the activities of the Amicus Committee. Although the committee is quiet at the moment, they are monitoring several cases. In fact, Charles Miller attended the U.S. Supreme Court argument in *Hyatt v. Kappos* on Jan. 9, 2012.

Dorothy Auth reported on the progress in preparing the Day-Of-Dinner CLE event. Terri volunteered to participate as the biotech practitioner. Anthony Lo Cicero volunteered to participate as the computer technology practitioner. The Board members recommended a number of potential Judges and Magistrate Judges to be contacted as further participants.

Charles Hoffmann reported that the Judges' Dinner preparations are moving forward and there has been an increase in the number of law firms reserving suites for the reception. Terri suggested that for next year's event, the location of the suites be tied to number of tables a firm purchases for the dinner. The Board also discussed the number of tables in the main dining room each firm should be assigned.

Kevin Ecker reported on the progress of the Inventor of the Year Competition. Seven submissions have been received thus far and several more are being carried over from last year.

Walter Hanley reported that the Publications Committee had been solicited to review a treatise, but has declined to participate because the contents were mostly irrelevant to intellectual property law and the treatise was simply too voluminous.

John Moehring reported on the progress of the Connor Writing Competition. His Committee has sent the letters announcing the competition to the various law schools and has already received 4-5 submissions.

Anthony Lo Cicero reported that the Annual Meeting will be on May 22, 2012 at the Princeton Club, and he is working to organize a CLE event. Anthony is considering a *Markman* hearing practical skills event to be held from 12-2 pm, followed by committee meetings from 2-4 pm, then the annual meeting from 4-6 pm and the dinner from 6-9 pm. Terri recommended that the Save-the-Date announcement be circulated soon.

Bruce Haas reported that new membership continues to lag last year's membership numbers. Bruce correlated the decrease in members to certain firms who have either changed their policy as it relates to association memberships or have disappeared altogether. Kevin Ecker commented that that we could search USPTO and court registrations to find these lost members.

Charles Hoffmann reported that the Copyright Committee is preparing the April 12 CLE Luncheon event. The Committee has already engaged three speakers and is looking for a moderator for the event.

Sue Progoff reported on the activities of the Privacy Committee. The Committee is preparing for the February CLE Luncheon. They have engaged three speakers for the event.

Jeffrey Butler reported that the Patent Practice Committee has been reviewing the new proposed rules in the AIA.

Anthony Lo Cicero reported that the Patent Litigation Committee is currently reviewing Judge Rader's proposed guidelines for eDiscovery. The Committee is also considering proposed spoliation guidelines.

Sue Progoff reported that the Trademark Committee is working on an agenda and considering speakers for the upcoming Half-Day Trademark event, which will be held on July 18, 2012.

Dale Carlson reported that the Website & Records Committee is reviewing archived materials and considering ways to enhance the Association's website.

Leora Ben-Ami reported that the Women in IP Committee will be hosting an in-person committee meeting at Kaye Scholer on January 31, 2012. She invited the women Board members to attend the meeting.

Annemarie Hassett reported that the Young Lawyers Committee added a third co-chair and is preparing for their Feb. 1st event addressing why young attorneys should take the patent bar exam. In addition, the Young Lawyers Committee is considering yet another CLE meeting where a Judge would share tips-of-the-trade to young lawyer participants.

The meeting was adjourned by Terri Gillis at 2 P.M. The Board then conducted an Executive session.

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Inventor of the Year Award

**Please join us at the NYIPLA Annual Meeting and Awards Dinner on
May 22, 2012 at the Princeton Club, NYC when we will be honoring the
2012 Inventor of the Year Award Winner**

Dr. Radoslav Adzic

Dr. Radoslav Adzic will be recognized for his extensive work as a Senior Chemist at Brookhaven National Laboratory, in the field of nanocatalysts with reduced platinum loading for applications in hydrogen fuel cells. Dr. Adzic's nanocatalysts contain only about one-tenth the platinum of conventional catalysts and have the potential to make fuel cell vehicles practical by addressing critical durability and cost barriers. Additionally, Dr. Adzic's contributions in this field can have far reaching effects in the future of power supply, telecommunications and consumer electronics, including a decrease in oil consumption.

MINUTES OF FEBRUARY 14, 2012
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, LLP, 1675 Broadway, New York, New York at 12 P.M. by President Terri Gillis.

In attendance from the Board:

Terri Gillis	Thomas Meloro
Anthony Lo Cicero	Walter Hanley
Annemarie Hassett	Bruce C. Haas

Jeffrey Butler (until 1:25pm), Dale Carlson, Kevin Ecker, Ira Levy, Susan Proffoff and John Moehringer participated by telephone. Absent and excused from the Board meeting were Dorothy Auth, Leora Ben-Ami, Charles Hoffmann and Alexandra Urban. Feikje van Rein was in attendance from the Association's executive office.

Terri Gillis called the meeting to order.

The Board approved The Minutes of the January Board meeting.

Jeffrey Butler provided the financial report, reporting that the association is in good standing. Jeffrey requested to explore investment options. Board members discussed various options for discounted CLE programs, membership drive investments, young lawyers programs, etc.

Jeffrey read the new members' list and the Board approved.

The Board convened into an Executive Session.

Kevin Ecker reported that the Inventor of the Year committee received seven submissions and he presented the top three choices. Overall the Board agreed with the decision, but would like the committee to further explore the commercialization of the top two contenders and previous years' winners.

Terri Gillis discussed the International Association of Judges event and the status of the committed pledges.

Terri presented a status update for the proposed new local patent rules for the SDNY and EDNY. Annemarie Hassett and Anthony Lo Cicero discussed alternative CLE formats and presented their ideas about "learning by doing" programs. The Board discussed different types of programs and the amount of time of preparation and faculty involvement.

Tom Meloro reported on the activities of the Amicus Committee. There are currently no developments.

Progress in preparing for the Day-Of-Dinner CLE event was discussed. Raymond Chen from the USPTO

and the Hon. Mark Falk have both agreed to speak at the program.

Feikje van Rein, in Charles Hoffmann's absence, reported that the Judges' Dinner preparations are moving forward. She reported that more honored guest tables have been requested and less satellite room tables. The Association has received more RSVPs from Honored Guests than last year.

Anthony Lo Cicero reported that the Annual Meeting will be on May 22, 2012 at the Princeton Club, and he is working to organize a CLE event. Anthony reported that the topic will be on ethics.

Sue Proffoff reported on the activities of the Privacy Committee. The Committee is preparing for the February CLE Luncheon. They have engaged three speakers for the event. She asked the Board to solicit some of their colleagues to attend the program.

Sue Proffoff reported that the Trademark Committee is working on an agenda and considering speakers for the upcoming Half-Day Trademark event, which will be held on July 18, 2012.

Annemarie Hassett reported that the Young Lawyers Committee hosted its Feb. 1st event addressing why young attorneys should take the patent bar exam. The program was not well attended, but the quality of the program was good.

The meeting was adjourned by Terri Gillis at 2 P.M.

ATTN: NYIPLA Members

**If you have any NYIPLA
historical records, specifically
Bulletins (1967-1981),
Greenbooks (prior to 1951) and
Judges' Dinner booklets (1973 & prior
to 1971), please contact Bill Dippert at
wdippert@eckertseamans.com
or 1.914.286.2813.**

APRIL CLE LUNCHEON:

Hot News – Hot New Doctrine or Yesterday’s News?

EARN NYS/NJS 2.0 CLE PROFESSIONAL CREDITS

➤ **Thursday, April 12, 2012** ◀

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

Hosted by the Meetings & Forums Committee and co-sponsored by the Copyrights Committee

CLE LUNCHEON: Ethical Issues in IP Practice

EARN NYS/NJS 2.0 CLE ETHICS CREDITS

FOLLOWED BY

NYIPLA 2012 ANNUAL MEETING AND AWARDS DINNER

➤ **Tuesday, May 22, 2012** ◀

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

JULY HALF-DAY HOT TOPICS IN TRADEMARK CLE PROGRAM

EARN NYS/NJS CLE PROFESSIONAL CREDITS

➤ **Wednesday, July 18, 2012** ◀

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

NOVEMBER FALL ONE-DAY PATENT CLE SEMINAR

EARN NYS/NJS 7.0 CLE PROFESSIONAL CREDITS *INCLUDING 2.0 ETHICS CREDITS*

➤ **Thursday, November 1, 2012** ◀

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

NEW MEMBERS

Last Name	First Name	Firm	E-mail	Office
Balcof	Steven M.	Ropes & Gray LLP	sbalcof@gmail.com	212-596-9549
Beepat	Rookmin	Seton Hall School of Law	rookmin.beepat@gmail.com	908-414-1661
Bergin	Rich	FTI Consulting, Inc.	bergin.r@gmail.com	617-897-1527
Burak	Robert Daniel	Amster, Rothstein & Ebenstein LLP	rburak@arelaw.com	212-336-8000
Duvdevani	Tamar Y.	DLA Piper US LLP	tamar.duvdevani@dlapiper.com	212-335-4799
Ganas	Matthew	DLA Piper US LLP	matt.ganas@dlapiper.com	212-335-4966
Gonzalez	Carlos	Gonzalez Law Associates P.C.	cgonzalezesq@aol.com	212-405-2234
Hoang	Lily N.	Jonathan D. Davis, P.C.	lnh@jddavispc.com	212-687-5464
Jaffe	Joshua	Dickstein Shapiro LLP	jaffej@dicksteinshapiro.com	212-277-6500
Kabir	Taneem	New York Law School	taneem.kabir@law.nyls.edu	718-300-3952
Lerner	Eric	DLA Piper US LLP	eric.lerner@dlapiper.com	212-335-4986
Nanton	Cindy K.	Roger Williams University School of Law	cindynanton@aol.com	646-915-7174
Pacchia	Thomas J.		tpacchia@gmail.com	908-403-8893
Parmigiani	Cara Alexandria	Seton Hall School of Law	cara.parmigiani@student.shu.edu	973-722-7655
Reinckens	Melissa Anne	DLA Piper US LLP	melissa.reinckens@dlapiper.com	212-335-4798
Rodrigues	Airina Lynn	DLA Piper US LLP	airina.rodrigues@dlapiper.com	212-335-4673
Rucando	David	Suffolk University Law School	david.rucando@verizon.net	617-851-5411
Seidman	Joshua	New York Law School	joshua.seidman@law.nyls.edu	617-596-4715
Skelley	Steven Thomas	Dickstein Shapiro LLP	skelleys@dicksteinshapiro.com	330-606-1434
Spence	Nicole Ann-Marie	New York Law School	nspence05@gmail.com	347-249-9560
Tomic	Jaksha	Dilworth & Barrese, LLP	jtomic@dilworthbarrese.com	516-224-1618
Wills	Theodore Charles	New York Law School	theodore.wills@law.nyls.edu	615-406-4322
Wu	Rachel T.	Fordham Law School	rachel.t.h.wu@gmail.com	201-889-7685

THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.

Telephone (201) 461-6603 www.NYIPLA.org

The *Bulletin* is published bi-monthly for the members of The New York Intellectual Property Law Association. Annual Non-Member Subscription is \$25.00. Single copies are \$10.00 each.

Correspondence may be directed to Bulletin Editors,
Robert Greenfeld, Mayer Brown LLP, rgreenfeld@mayerbrown.com and
Wanli Wu, Wiggin and Dana LLP, wwu@wiggin.com

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