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ESI (ELECTRONICALLY STORED INFORMATION) DISCOVERY GUIDELINES

*By James Gould, Richard Brown, Richard Mandaro**

The costs associated with electronically stored information (“ESI”) in a large patent case can run into the millions of dollars. ESI discovery can also create serious problems for the unwary practitioner. We have developed discovery guidelines (“Guidelines”) to address both of these problems in a practical way. The Guidelines also aim to assist parties, counsel and the courts in promoting the just, speedy, and inexpensive determination of civil actions.¹

The Federal Rules provide for discovery of information “relevant to a party’s claim or defense.”² “Relevance” for this purpose includes admissible evidence as well as information that is “reasonably calculated” to lead to the discovery of admissible evidence.³ Although the Federal Rules provide for liberal discovery, a party need not provide discovery of ESI from sources that are not reasonably accessible because of burden or cost.⁴ Typically, a producing party is responsible for the cost of producing discovery, including ESI. However, in appropriate circumstances, a court may order the requesting party to bear some or all of the cost in producing such information.⁵

Against this backdrop and the need to manage the expense and bur-

den of ESI discovery, several courts have prescribed model orders or default guidelines for ESI discovery within their respective districts.⁶ The Guidelines set forth below are intended to supplement any such district court orders or guidelines, as well as all other discovery rules and court orders concerning discovery. We suggest that counsel consider these Guidelines in connection with the initial discovery conference under Fed. R. Civ. P. 26(f) and in creating a plan and proposed order for the conduct of discovery. These Guidelines should also be useful in all complex commercial litigation, not just patent cases.

Of course, not all of these Guidelines apply to every case, especially small ones. However, the authors believe they have value in cases of all sizes as a checklist to ensure nothing is overlooked. The Guidelines also provide a roadmap for parties to plan ahead for ESI discovery, reach agreement without motion practice (where possible), and avoid “gotcha” litigation based on an excusable oversight or mistake during discovery. The Guidelines should also assist counsel in discussing with their own clients the various issues in collecting, reviewing, and producing ESI discovery. Although parties are ultimately

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January 2013

Even in the midst of a cold winter stretch, NYIPLA members remain heartily engaged on many fronts, including two of our core functions: education on new developments in the law and advocacy on issues of paramount importance in the field.

The AIA legislation continues to spawn new regulations, and our members will continue to benefit from NYIPLA's education programs. Last year, we hosted a breakfast CLE and the USPTO Roadshow. This year, we have two programs which will focus on the post-AIA world. On February 6, the NYIPLA will host a CLE program that will address the first-to-file implications of the AIA legislation. This program is the first in memory hosted on Long Island, and features collaborations with several local institutions. We are grateful to Accelerate Long Island, the Long Island Forum for Technology, and the Long Island Software and Technology Network for collaborating with us on this innovative program. The program will feature nuts-and-bolts updates on AIA regulations, as well as panelist views on the impact of these changes to Long Island companies. We are fortunate that Sue Purvis, the USPTO representative to the Greater New York Region, has agreed to participate in this program. We recognize with appreciation the tremendous efforts of Colman Ragan and Ray Farrell in organizing this program, and thank them and all involved in this important event.

Our annual Judges Dinner is fast-approaching in March, and we will conduct our usual CLE luncheon at the Waldorf=Astoria in the afternoon on March 22. In keeping with tradition, we expect a significant number of judges to attend the

luncheon and are grateful that several judges will participate as panelists. A special thanks to Federal Circuit Judge Kathleen M. O'Malley, who has agreed to participate on the panel to discuss patent litigation under the AIA. We welcome Judge O'Malley, and look forward to this impressive program.

On the advocacy front, the Amicus Briefs Committee continues to follow many cases and recently has filed briefs in two important cases. In *CLS Bank International v. Alice Corp.*, the Committee filed a brief addressing patent eligibility for so-called "computer-implemented inventions." Most recently, the Committee filed a brief in the Supreme Court in *Bowman v. Monsanto Corp.* The *Bowman* brief addresses the important interface between field of use license restrictions, contributory infringement and the doctrine of exhaustion. The briefs are available on the NYIPLA website at <http://www.nyipla.org/nyipla/AmicusBriefsNews.asp>. Special thanks to the Committee members and particularly the chairs Dave Ryan, Charles Macedo and John Hintz for all their work on these briefs, as well as to Board Members Denise Loring and Tony Lo Cicero.

Finally, I would like to applaud the efforts of our Membership Chairs John Moehringer and Bill McCabe, as well as Board Liaison Bruce Haas. The Membership Committee works largely behind-the-scenes, and plays a major role in ensuring the continued vitality and success of NYIPLA. John, Bill and Bruce have been key to our ongoing efforts to keep NYIPLA at the top of our field. We are lucky to have such talented and dedicated volunteers.

Tom Meloro



responsible for complying with their discovery obligations, counsel (including outside counsel) are also charged with ensuring that their clients fulfill those obligations, including that they have conducted a reasonable search for discoverable information.

ESI Discovery Guidelines

1. As part of the meet-and-confer process that takes place in advance of the Rule 26(f) conference, the parties should:

- a. Make good faith efforts to identify the systems where they may have discoverable ESI (*e.g.*, e-mail, voicemail, text messaging, document management databases, spreadsheet applications and other relational databases), the search capabilities of those systems and methods by which such systems should be searched for likely discoverable documents, the date range of records to be searched, and custodians of likely discoverable ESI. The search techniques can include keyword searching, Boolean searching (which allows one to combine keywords with terms such as “and,” “or,” and “not”), and clustering methods, among others. The parties should also discuss whether to agree that searches may be performed by computer software that is used to determine which data is relevant, *i.e.*, using predictive coding technology.
- b. Discuss whether to conduct discovery of certain ESI materials, such as e-mail records, in phases. Discovery can be phased by: the issues in the case (*e.g.*, claim construction discovery may be sequenced first); the type of ESI (*e.g.*, e-mail discovery may be phased after discovery of other ESI); the importance of custodians (e-mail from a selected number of “most important” custodians); or chronologically (with the more relevant time period searched and produced first). Given the often large volume of e-mail, the parties should also discuss whether to exclude e-mail from general ESI production requests under Fed. R. Civ. P. 34 and 45, or compliance with a mandatory disclosure requirement under Fed. R. Civ. P. 26(a) or a district court’s local rules. Obviously, when adverse parties bear similar burdens and costs in producing discoverable ESI, they should have similar incentives to agree to restrict or limit ESI production, and avoid opportunistic use of the discovery rules. Conversely, a party that has little ESI of its own to produce relative to its opponent may have less incentive to agree to limit ESI discovery.
- c. Discuss whether absent a showing of good cause, general ESI production requests under Fed. R. Civ. P. 34 and 45 or compliance with a mandatory disclosure requirement shall not include metadata. In general, metadata is information embedded in an electronic document that identifies characteristics of

the file (*e.g.*, who authored or edited the file and when it was accessed, printed, or saved). This data may be relevant to the issues in the litigation, but producing it increases the expense of document production and review. If the parties agree on a default rule that ESI production should not include metadata, the parties may wish to agree that the production should include fields showing the date and time that the document was sent and received, as well as the complete distribution list, if such fields exist.

- d. Discuss whether ESI documents will be produced in native format, near-native format (*e.g.*, e-mails converted to a text format), image format (such as TIFF or PDF), or on paper. Often included in this discussion is whether the ESI documents are text searchable and whether metadata will be produced as well (*see* 1(c), above).
 - e. Discuss whether there is a good faith reason to restore any existing form of media where backup data is maintained, and whether there is a good faith reason to preserve, collect, and/or produce the ESI in the categories identified in Schedule A below. There may be reasons why a party believes there is discoverable information in such categories, whether it be the date or nature of the underlying conduct at issue or some other rationale. Self-evidently, restoration of back-up media or preservation and collection of categories of documents in Schedule A add to the expense and burden of discovery.
2. If the parties believe that search terms (which may be names, words, short phrases, numbers or Boolean Logic search commands) should be used to search for likely discoverable ESI, they should meet and confer (as part of the pre-Rule 26(f) conference or thereafter) on a schedule for:
- a. Exchanging lists of proposed search terms. Such terms should be tailored to specific issues. A request for a company or product name without further modifiers is likely overbroad.
 - b. Finalizing lists of search terms applicable to each respective producing party.
3. Preliminary Scoping Search when using search terms:
- a. A producing party may run a preliminary “scoping” search using the search terms identified by the parties for the relevant time frame to determine the approximate volume of responsive documents.
 - b. If the preliminary scoping search shows that using such terms will result in the retrieval of a large number or percentage of non-responsive documents, the parties shall meet and confer in a good faith effort to narrow the search.

cont. from page 3

- c. If the receiving party still insists on the original search terms, the Court in its discretion may order the receiving party to pay an appropriate portion of the additional cost over using narrower search terms proposed by the producing party.
4. E-Mail records. The parties should discuss whether to require specific discovery requests in order to obtain e-mail records and other forms of electronic correspondence, and whether to limit the number of e-mail custodians and/or the number of search terms used in collecting potentially responsive e-mail discovery.
5. If a producing party follows the guidelines outlined above and conducts a final search based on the agreed upon (or ordered) search terms, then the producing party shall be presumed to have conducted a reasonable search in good faith for discoverable ESI.
6. After a producing party has completed a search based upon the agreed upon (or ordered) search terms, a requesting party may seek follow-up searches upon a showing of good cause.
7. Pursuant to Federal Rule of Evidence 502(d), the inadvertent production of privileged or work-product-protected ESI material is not a waiver in the pending case or in any other proceeding.

SCHEDULE A

1. Deleted, slack, fragmented, or other data only accessible by forensics.
2. Random access memory (RAM), temporary files, or other ephemeral data that are difficult to preserve without disabling the operating system.
3. On-line access data such as temporary internet files, history, cache, cookies, and the like.
4. Data in metadata fields that are frequently updated automatically, such as last opened dates.
5. Back-up data that are substantially duplicative of data that are more accessible elsewhere.
6. Voice messages.
7. Instant messages that are not ordinarily printed or maintained in a server dedicated to instant messaging.
8. Electronic mail or PIN-to-PIN messages (which bypass e-mail data servers) sent to or from mobile devices (*e.g.*, iPhone and Blackberry devices), provided that a copy of such mail is routinely saved elsewhere.
9. Other electronic data stored on a mobile device, such as calendar or contact data or notes, provided that a copy of such information is routinely saved elsewhere.
10. Logs of calls made from mobile devices.
11. Server, system or network logs.
12. Electronic data temporarily stored by laboratory equipment or attached electronic equipment, provided that such data is not ordinarily preserved as part of a laboratory report.
13. Data remaining from systems no longer in use that is unintelligible on the systems in use.

APPENDIX A

Northern District of California: <http://www.cand.uscourts.gov/eDiscoveryGuidelines>

District of Delaware: <http://www.ded.uscourts.gov/sites/default/files/Chambers/SLR/Misc/EDiscov.pdf>

Middle District of Florida: http://www.flmd.uscourts.gov/Forms/Civil/Discovery_Practice_Manual.pdf
(Section VII, "Technology")

Southern District of Florida:
<http://www.flsd.uscourts.gov/wp-content/uploads/2011/12/FINALDecember2011LocalRules.pdf>

District of Kansas: <http://www.ksd.uscourts.gov/guidelines-for-esi/>

District of Maryland: <http://www.mdd.uscourts.gov/news/news/ESIProtocol.pdf>

District of New Jersey: <http://www.njd.uscourts.gov/rules/completeRules.pdf> (*see* 26.1(d))

Southern District of New York: http://www.nysd.uscourts.gov/rules/Complex_Civil_Rules_Pilot.pdf
(Standing Order for certain cases; see Exhibit B thereto)

Northern District of Ohio: http://www.ohnd.uscourts.gov/assets/Rules_and_Orders/Local_Civil_Rules/Appendices/Appendix_K.pdf

Northern District of Oklahoma: http://www.oknd.uscourts.gov/docs/34dc340b-bff2-4318-9dee-cb0a76bcf054/Guidelines_for_Discovery_of_Electronically_Stored_Information.pdf (Based on the District of Kansas)

Western District of Oklahoma: <http://www.okwd.uscourts.gov/files/genorders/genord09-5.pdf>

Western District of Pennsylvania:
<http://www.pawd.uscourts.gov/Documents/Forms/lrmanual.pdf> (see LR 26.2)

Middle District of Tennessee: http://www.tnmd.uscourts.gov/files/AO_174_E-Discovery.pdf

Western District of Tennessee: <http://www.tnwd.uscourts.gov/pdf/content/LocalRules.pdf> (see LR 26.1)

Eastern District of Texas:
http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=22218&download=true



***James Gould** has retired, after nearly four decades of patent litigation, to pursue non-legal writing. Google James Gould and click on his Amazon author page to see his publications to date. Current projects include a screenplay and a collection of short stories.



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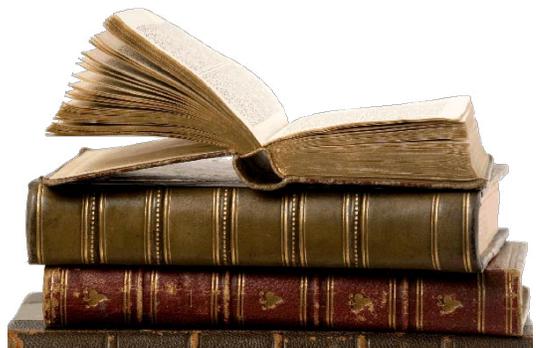


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(Endnotes)

- ¹ See Fed. R. Civ. P. 1.
- ² Fed. R. Civ. P. 26(b).
- ³ *Id.*
- ⁴ Fed. R. Civ. P. 26(b)(2)(B).
- ⁵ See Fed. R. Civ. P. 26, 2006 Advisory Committee Notes.
- ⁶ See Appendix A for a list of federal district courts with guidelines or model orders for ESI discovery.

ATTENTION: 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.

Notable Trademark Trial and Appeal Board Decisions

By Stephen J. Quigley, Of Counsel, Ostrolenk Faber LLP

Member of the NYIPLA Trademark Law and Practice Committee

(All decisions are precedential.)

Scandalous Refusal Upheld by the CAFC

The Federal Circuit Court of Appeals affirmed the TTAB's ruling that the mark could not be registered for "chocolate suckers in the shape of a rooster" because

Cock Sucker



this term is scandalous under Section 2(a). The applicant had argued that the mark is a double entendre and therefore the Trademark Office was required to prove that the most relevant meaning to the public is vulgar. The Court disagreed, holding

that the Trademark Office had to find only that a meaning of the mark is vulgar. The Court distinguished the BLACK TAIL case, *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994), in which the issue was the mark's ambiguity – not whether it was a double entendre. The fact that COCK SUCKER as presented in this manner is humorous does not mean that it can't also be scandalous. *In re Fox*, 702 F.3d 633 (Fed. Cir. 2012).

Web Page Not an Acceptable Specimen

A screen shot of the applicant's YouTube web page was not an acceptable specimen of the mark because it failed to show the mark in direct connection with the goods in the application (audio recordings featuring music). The Board acknowledged "the advent and certainly the trend of music being offered in downloadable formats or the equivalent thereof in lieu of the traditional trade channels for tangible sound recordings, e.g., CDs being sold via retail or online stores." The screen, however, did not include a "download" or similar link indicating that the recordings are available for downloading or acquisition by some other means. *In re Rogowski*, 104 U.S.P.Q.2d 2012 (TTAB 2012).

Stylization Does Not Create a Separate Distinctive Impression

The word SADORU is equivalent to "saddle" in English and, as such, is descriptive of motorcycle seats. The question was whether the mark in the application was sufficiently stylized to create a separate and distinctive

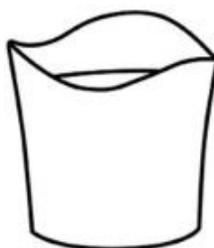
commercial impression apart from the word itself.

SADORU

The Board, finding that the letters were only "slightly stylized" and the "dip" in the lettering "so minimal as to be insignificant," ruled that the stylization was not sufficient and upheld the refusal to register. *In re Sadoru Group, Ltd.*, 2012 TTAB LEXIS 325 (TTAB Aug. 14, 2012).

Bottle and Cap Designs Are Inherently Distinctive

This mouthwash bottle and its cap are inherently distinctive and capable of registration. Reversing the examining attorney's determination that these designs



constituted merely ornamental, non-distinctive product packaging with no proof of acquired distinctiveness, the Board found that product packaging, and specifically

bottle designs, at least with regard to mouthwash, can function as source indicators. The appropriate question is whether the design is so unique or unusual that one can assume that consumers will automatically perceive it as an indicator of source. *In re The Procter & Gamble Company*, 2012 TTAB LEXIS 447 (TTAB Nov. 16, 2012).

Registration Bars Dilution Claim

Section 43(c)(6)(B) of the Trademark Dilution Revision Act (2006) provides a complete bar to a dilution claim brought against a federally registered trademark. Despite concern that the statutory language resulted from a "clerical error" at the time the law was passed, the Board stated that it "must apply and enforce the statute as written, rather than picking and choosing a preferred interpretation." If the complete bar against dilution enjoyed by a registered mark is not what the drafters intended, Congress can amend the statute. The Board granted the registrant's motion to dismiss the dilution claim in the petition for cancellation. *Academy of Motion Picture Arts and Sciences v. Alliance of Professionals & Consultants, Inc.*, 104 U.S.P.Q.2d 1234 (TTAB 2012).

Update on the Proposed Foreign Counterfeit Merchandise Prevention Act

By James L. Bikoff and Judd Lauter, Silverberg, Goldman & Bikoff, LLP

In the past year, the U.S. Congress has evinced an increasing eagerness to enact legislation amending the Trade Secrets Act (18 U.S.C. § 1905) to facilitate communication between U.S. Customs and Border Protection (“CBP”) and intellectual property rights holders. The desire for new legislation has its genesis in a shift in CBP policy in the year 2000, in the form of a Customs Directive,¹ that upset the cooperative framework in which the CBP and private parties shared information. The agency became concerned that sharing certain information regarding imported goods would violate the Trade Secrets Act and subject CBP personnel to lawsuits.

Under the Directive, CBP officers are required to “remove or obliterate any information indicating the name and/or address of the manufacturer, exporter, and/or importer, including all bar codes or other identifying marks,” prior to the release of any sample to a trademark or copyright holder. This change in policy has led to an alarming decline in information sharing between the CBP and rights holders.

On March 20, 2012, House Rep. Ted Poe (R-TX) introduced the Foreign Counterfeit Prevention Act (H.R. 4216), which would amend the Trade Secrets Act by adding a subsection that expressly allows the CBP to provide the owner of a registered trademark or copyright unredacted information relating to suspected counterfeit and pirated goods. A markup on the bill was scheduled for December 13, 2012, but was canceled due to the introduction of a replacement bill, the Foreign Counterfeit Merchandise Prevention Act (H.R. 6654), by Congressman Poe. That bill has been subsequently reintroduced by the 113th Congress under the same name, as H.R. 22.

H.R. 22 shares the same sponsors and substantive provisions as H.R. 4216, amending the Tariff Act of 1930 to allow the CBP to share unredacted information relating to suspected counterfeit and pirated goods with rights holders. That language has been modified somewhat from H.R. 4216, but the modifications are merely aesthetic. In addition, the new bill contains a section amending Section 42 of the Lanham Act (15 U.S.C. §1124), which bars the entry of counterfeit goods into the U.S. and vests the Department of the Treasury with the authority to maintain a database of trademark registrations to help enforce the prohibition.

The bill’s proposed amendment to Section 42 of the Lanham Act would do two things. First, it would replace the language about the “Secretary of the Treasury” and “Department of the Treasury” with the “Secretary of Homeland Security” and the “Department of Homeland Security.” As a consequence, the Department of Homeland Security, not the Department of the Treasury, would be responsible for the administration of the CBP’s trademark database. Since the CBP falls within the Department of Homeland Security, this places the administration of the database where it belongs.

Second, the proposed amendment would add a provision in Section 42 of the Lanham Act pertaining to “critical merchandise.” “Critical merchandise” is defined by an enumerated list of potentially dangerous and hazardous goods (*e.g.* aircraft engines, children’s sleepwear, cosmetics, drugs, food, etc.). The bill’s focus on critical merchandise dovetails with recent efforts by Congress, the CBP, and other federal agencies to protect American and foreign consumers from increasingly sophisticated and dangerous counterfeit products, such as pharmaceuticals and military hardware. With respect to critical merchandise, the amended section would allow the CBP to immediately share information with brand owners regarding suspected counterfeit critical goods rather than having to wait seven days under current regulations. Additionally, unlike the part of H.R. 6654 allowing the CBP to share information with rights holders, this provision appears to affirmatively require the CBP to do so.

Also of note, a nearly identical provision to H.R. 4216 was included in the Customs Trade and Facilitation Act of 2012 (H.R. 6642) – a bill introduced into the House of Representatives by Rep. Kevin Brady (R-TX) on December 7, 2012, that proposed a much larger, more comprehensive reform of customs practices. All legislation that was not passed during the 112th Congress must be reintroduced by the 113th Congress in order to be considered. Currently, H.R. 6642 has yet to be reintroduced.

(Endnotes)

¹ Customs Directive No. 2310_008A (April 7, 2000), available at <http://www.cbp.gov/linkhandler/cgov/trade/legal/directives/2310-008a.ctt/2310-008a.pdf>.

December 2012 IP Media Links

Edited by Ted Wills, Member of NYIPLA Publications Committee

“IP Media Links” is a new feature in which The Bulletin takes a look at how non-legal media outlets are covering intellectual property.

December is a time to reflect on the past year and look forward to the next. This month, *Bloomberg Businessweek* reflects on the consequences for the U.S. patent system of the *Patent Law Treaties Implementation Act of 2012*, the recently enacted law that increases the term and scope of design patents. It is intended to harmonize the United States’ design patent laws with those of the rest of the world. But some are concerned that the law will result in the US Patent and Trademark Office (PTO) being flooded with more patent applications than it can handle. Also there are concerns that the law will provide superfluous patent protection that will ultimately give more ammunition to patent trolls. (<http://www.businessweek.com/articles/2012-12-28/from-ipads-to-crocs-new-patent-law-protects-design>).

SF Weekly’s The Snitch blog reflects on what has been dubbed by some “the year of the patent troll” and laments two emerging troll strategies: threatening suits against companies for *using* technologies (as opposed to selling patented technologies) and targeting smaller companies because they are more likely to settle. (http://blogs.sfweekly.com/thesnitch/2013/01/bottom-feeding_patent_trolls_t.php).

Brian J. Love in *Wired Magazine* looks forward this month and proposes using patent fees to stop trolls and to cut down on the number of gratuitous software patents in existence. Love’s research has revealed that patent holders that actually produce products tend to bring infringement claims near the beginning of a patent term while trolls tend to bring claims in the final years of a patent term. Altering patent terms through the legislative process would prove difficult. But, thanks to recent patent reform, the USPTO now has power to set its own fee structure. Thus, Love proposes the adoption of a fee schedule requiring annual renewal payments in the latter half of the term with increases in the fees as the patent ages. This, Love argues, would result in the expiration of many unproductive patents

and a smaller pool of available patents for trolls to exploit. (<http://www.wired.com/opinion/2012/12/how-to-stop-patent-trolls-lets-use-fees/>).

New York IP attorneys Alexandre Montagu and Thomas Walsh make some IP predictions in their *Forbes* article, “Copyright, Patents, Trademarks: The Outlook for 2013.” The authors highlight several pending copyright cases including a case pending in New York Federal Court that will determine whether the First Sale Doctrine allows the service Redigi.com to enable users to resell digital music files. For trademarks and domain names, the authors discuss how, in 2013, brand owners will be watching closely developments in ICANN’s expansion of top-level domain extensions. And, of course, in the world of patents, 2013 will continue to be about patent trolls and mobile phone and tablet wars. (<http://www.forbes.com/sites/ciocentral/2012/12/28/copyright-patents-trademarks-the-outlook-for-2013/>).

December is a time of the year for football, indoor arena concerts, and the holidays. *The Washington Post’s DC Sports Bog* takes a look at some of the phrases for which Redskins rookie quarterback Robert Griffin III has submitted trademark applications. As expected, he has applied for RG3 and RGIII. But he has also applied for a whole slew of other marks including GO CATCH YOUR DREAM, NO PRESSURE NO DIAMONDS, and UNBELIEVABLY BELIEVABLE. (<http://www.washingtonpost.com/blogs/dc-sports-bog/wp/2012/12/19/things-rgiii-has-trademarked/>).

Billboard asks whether the rapper, Drake, can trademark his motto “YOLO.” (<http://www.billboard.biz/bbbiz/industry/legal-and-management/can-drake-trademark-the-term-yolo-1008061902.story>).

If you have small children in your life, you know that Disney dominates holiday gift giving. *Bloomberg* reports how that dominance was extended to the courtroom in a Winnie-the-Pooh

trademark litigation victory. In 2009, Stephen Slesinger Inc. attempted to cancel Disney's Pooh trademarks, claiming it had greater rights in the marks than Disney. The USPTO rejected Slesinger's claims and the Federal Circuit Court of Appeals upheld the USPTO's determination. (<http://www.bloomberg.com/news/2012-12-21/disney-wins-u-s-appeals-court-ruling-over-pooh-trademark.html>).

Finally, this month two media figures who were both inspired by a collection of copyright reform essays, titled *Copyright Unbalanced: From Incentive to Excess*, ask in separate articles whether it is time to push back against the tide of ever-increasing copyright protections:

- In *The Washington Examiner*, Timothy P. Carney scolds the GOP for being too cozy with the entertainment industry on copyright issues. Carney argues that Republicans' commitment to free markets should put them on the side of reformers who wish to curtail copyright

protections. (<http://washingtonexaminer.com/gop-sides-with-mickey-mouse-on-copyright-reform/article/2515183#.UOYVP6U8YTww>).

- In *Forbes*, Timothy B. Lee writes about an essay he contributed to *Copyright Unbalanced* where he voices his concerns about the government's aggressive seizure of technology companies' assets in civil copyright cases. He points to the case of Megaupload, whose servers and assets were seized by the Federal Government. As a result, Megaupload could not even mount a defense because its assets were unavailable to pay lawyers. Lee argues that the threat of asset seizure is having a chilling effect on media startups and it has alarming due process concerns as asset seizures will often doom companies even if the companies are ultimately able to successfully defend themselves. (<http://www.forbes.com/sites/timothylee/2012/12/06/how-copyright-criminalization-threatens-online-innovation/>).

Moving UP ▲ & Moving ON >>>

► Peter Thurlow, the current co-chairperson of the NYIPLA Patent Law and Practice Committee as well as co-liaison for the SIPO of China/US Bar Liaison Council, and an Intellectual Property partner at Jones Day in New York, was appointed to serve a three-year term on the U.S. Patent and Trademark Office's Patent Public Advisory Committee ("PPAC") starting in November 2012. PPAC is a nine-member advisory committee that includes senior advisors from business, academia, and private law practice and advises the Director of the USPTO on matters relating to the policies, goals, performance, budget, and user fees of the USPTO relating to patents. In addition to his NYIPLA Committee duties, Mr. Thurlow also has been active in the implementation of the America Invents Act (AIA), testifying in February 2012 on behalf of the NYIPLA at the USPTO with respect to the USPTO's proposed AIA fee schedule, representing the NYIPLA in September 2012 at the USPTO's first-inventor-to-file roundtable, and helping to coordinate the AIA road show at the New York Public Library in September 2012.

The Bulletin's Moving Up and Moving On feature is 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: Mary Richardson (mary.e.w.richardson@gmail.com) or Robert Greenfeld (rgreenfeld@mayerbrown.com).

Making Your Case: Effectively Using Experts in Patent Litigation

➤ Thursday, February 28, 2013 ◀

“Day of Dinner” Luncheon CLE Program: The Interplay Between Patent Litigation In The District Courts And Proceedings Before The Patent And Trademark Office

➤ Friday, March 22, 2013 ◀

EARN 2.0 NYS/NJS CLE PROFESSIONAL CREDITS

Waldorf=Astoria Hotel, 301 Park Avenue, New York

The
91st
Annual Dinner
IN HONOR OF THE
Federal
Judiciary

➤ Friday, March 22, 2013 ◀

Waldorf=Astoria Hotel, 301 Park Avenue, New York

The NYIPLA Judges Dinner is the largest black-tie gathering of federal judges, government officials, corporate counsel, legal professionals, and representatives from other intellectual property associations, with an attendance exceeding 2,800 members and guests.

Dinner Speaker

Michael Strahan

Former NFL player for the New York Giants, and the new co-host on “Live! With Kelly and Michael”



Outstanding Public Service Award

Honorable Barbara S. Jones

United States District Court for the Southern District of New York

29th Annual JPPCLE

➤ Tuesday, April 16, 2013 ◀

EARN 8.0 NYS CLE PROFESSIONAL CREDITS

New York Marriott Marquis, 1535 Broadway, New York

NYIPLA Annual Meeting & Awards Dinner Preceded by CLE Workshops

➤ Tuesday, May 21, 2013 ◀

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

As Time Goes By – Entertainment at the Judges Dinner

Those who have had the opportunity to attend a number of Judges Dinners probably have their favorite, although it is likely that we found each to have been enjoyable. Entertainment, of one form or another, has invariably played a role in contributing to this enjoyment over the years.

Long before any of us can remember, Judges Dinners featured live entertainment for the audience gathered at the Waldorf. Back in the 1920s and 1930s, the entertainment of choice was a play having some connection to patents. The originator of several of these plays was a patent lawyer-turned-playwright named Lawrence Langner.

The first Langner play was entitled “Patent Applied For.” It was a comedy about a tall blonde Australian lady who was the inventor of a new corset. The corset was intended to adjust the contours of the female anatomy to comply with then-current fashion trends. The play was considered to be a great success, and this led to other Langner plays at later Judges Dinners.¹

Mr. Langner went on to achieve great success in the theater world at large. He was a co-founder of the Theater Guild along with his wife, Armina Marshall, a Theater Guild co-administrator, Mr. Langner participated in the Guild’s 1943 production of *Oklahoma*, which became perhaps the most celebrated of the Rodgers and Hammerstein musicals. It is perchance somewhat ironic that Ms. Marshall, who was partly a Native American Indian, was born on the Cherokee Strip in what was then called the “Oklahoma Territory.”²

Of course, plays weren’t the only form of live entertainment at Judges Dinners in years past. Music was a mainstay. The Waldorf’s Basildon Room became the setting for musicians



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

to provide sounds from the big band era for easy listening, and dancing to the foxtrot, cha-cha, waltz, rhumba, and jitterbug.

Spanning more than half a century, a saxophonist and band-leader named Ray “Dutch” Wolff performed at every Judges Dinner from 1960 through 2012. As you may recall, in 1960 Dwight D. Eisenhower was President of the United States, and top hats for men and fur shawls for women were still the order of the day. Back then, our Association’s Bulletin was only a dream in the mind of the newly-constituted “Bulletin Committee,” a dream that didn’t become a reality until the first issue of the Bulletin appeared in October 1961. It goes without saying that Dutch’s tenure of performing musical entertainment at the Judges Dinner is a record that is likely to stand the test of time.

The 2013 Judges Dinner ushers in a new band called the *Silver Streaks*, headed by Rudy Gisolfi. The new band promises to offer a wide range of musical renditions, ranging from rock to ballads to swing numbers. Who knows, maybe they’ll include one of those early pieces, such as *Birth of the Blues*, that harkens back to an earlier era of Judges Dinners.

Happily, we can look forward to a continuation of the Association’s long history of providing live entertainment at the Judges Dinner, mindful that it will help contribute to the evening’s enjoyment. See you at this year’s Judges Dinner!

With kind regards,

Dale Carlson

(Footnotes)

¹ Ladas & Parry, Firm History, available online at www.ladas.com/LADASINFO/history.html

² Armina Marshall’s Obituary (with Correction Appended), The New York Times, July 22, 1991, available online at www.nytimes.com.

October 24, 2012

“The Good, the Bad and the Truly Ugly: Visual Communication with the Jury”

by Jennifer BianRosa

On October 24, 2012, NYIPLA hosted the CLE “The Good, the Bad and the Truly Ugly: Visual Communication with the Jury” at Dickstein Shapiro. Nancy Geenen of Suann Ingle Communications, a trial consulting firm, shared her 24 years of law firm experience as a trial attorney in commercial and intellectual property cases with the attendees. Nancy discussed the basics of design for effective graphics for intellectual property cases. Nancy shared sample graphics and animations from patent, design patent and trademark cases that she has used in jury trials. She

discussed the difference between exhibits and demonstratives, opening statements, techniques for expert witness examination, and closing arguments. Nancy works with trial teams on mock exercises, trial themes and strategies, and trial presentation and discussed her tips for effective courtroom communication at trial as well as strategies for preparation in the 100 days before trial. Nancy also provides training to law firms on how to communicate effectively and persuasively in all settings. Attendees were treated to a copy of Nancy’s book “Women Who Mean Business.”



December 6, 2012 CLE

“Litigating Patent Cases in 2013: Patent Pilot Program, AIA, and e-Discovery”

by Debra Resnick

On December 6, 2012, the NYIPLA Meetings and Forums Committee hosted a Continuing Legal Education (CLE) program at the Union Club of New York. Judge Faith Hochberg from the United States District Court for the District of New Jersey led a lively discussion primarily focused on issues surrounding the America Invents Act and electronic discovery. Judge Hochberg discussed how presiding over patent cases has evolved since implementation of the AIA

and since she became a Patent Pilot Program judge. She also discussed the efforts that she and other Patent Pilot Program judges were taking to share information and keep abreast of developments in other districts. Judge Hochberg also discussed instituting limitations on electronic discovery such as those proposed by Chief Judge Rader of the Court of Appeals for the Federal Circuit and standing orders in the Eastern District of Texas.

January 17, 2013 Fall One-Day Patent CLE Seminar

CLE Co-Chairs Mark Bloomberg and Robert Rando

On Thursday, January 17, 2013, the NYIPLA Continuing Legal Education Committee hosted the Fall One-Day Patent CLE Seminar at the Princeton Club, which had been rescheduled from November 1, 2012 because of Hurricane Sandy. The program included four panels and a Luncheon Keynote Speaker. Panel I addressed “Implementation and Effects of the America Invents Act.” Panel II addressed “Validity and Infringement of Method Claims.” Panel III addressed “Ethical Considerations in Patent Prosecution and Litigation.” Panel IV addressed “Issues Arising in Licensing Patents.” The Luncheon Keynote Speaker was the Honorable Mitchell S. Goldberg, United States District Court Judge for the Eastern District of Pennsylvania.

Panel I – “Implementation and Effects of the America Invents Act”

The members of Panel I included Moderator William Thomashower from Schwartz & Thomashower LLP and Speakers William LaMarca, USPTO Associate Solicitor, Sean Grygiel from Fish & Richardson, P.C., Charles Miller from Dickstein Shapiro LLP, and Stacey Cohen from Skadden, Arps, Slate, Meagher & Flom LLP.



Associate Solicitor LaMarca’s presentation addressed the new rules for implementation of the AIA First-Inventor-to-File system. He provided an incisive discussion on the rules-making process and the “nuts and bolts” aspects of practicing in the new system environment. His guidance on the transitional “straddling” cases was particularly useful and his overall presentation provided

clarity concerning many nuanced issues for the new filing system.

Mr. Grygiel’s presentation focused on strategies for post-grant proceedings under the AIA. He provided a comprehensive discussion on the distinctions in post-grant proceedings. He delineated the differences between Supplemental Examination, Ex Parte Reexamination, Inter Partes Review and Post-Grant Review. Specifically, for each post-grant proceeding, he highlighted the bases, applicable legal standards, how initiated, how and whether estoppel attaches, and the timing for engaging in the proceeding.

Mr. Miller’s presentation detailed the various aspects of ADR, Judicial Recourse and Estoppel in post-grant review. Mr. Miller provided insights regarding the various AIA provisions that enable/affect the post-grant review proceedings. He addressed specific concerns arising from venue limitations and estoppel provisions. His materials also included a comprehensive analysis of the relevant AIA sections.

Ms. Cohen’s topic, “Joinder Under the AIA,” allowed her to discuss actual experience with the new law because the effective date for the legislation had already occurred. Ms. Cohen described the background of the joinder issue leading up to the new legislation and identified cases that have addressed the issue post enactment. She pointed out that the well-intentioned legislation (avoiding joinder of alleged infringers based solely on infringing the same patent, irrespective of the relationship between the alleged infringers or their respective industries and products) has not deterred the filing of lawsuits in the same venue against apparently disparate alleged infringers. Rather, it has resulted in the simultaneous filing of numerous individual cases that are consolidated, at least for pre-trial proceedings, and may have the unintended consequence of additional administrative work for the courts.

Panel II – “Validity and Infringement of Method Claims”

The members of Panel II included Moderator Adda Gogoris from Merchant & Gould and Speakers Charles Macedo from Amster, Rothstein

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& Ebenstein LLP, Matthew McFarlane from Robins, Kaplan, Miller & Ciresi L.L.P., and Paul Ackerman from Dorsey & Whitney.



Mr. Macedo distilled the patentability issues regarding abstract ideas considered by the Supreme Court and Federal Circuit. He provided a review of the historical and current line of authority and crystallized the cases based upon the statutory language governing patent-eligible subject matter. He also presented a detailed analysis of the Federal Circuit's approach to the issue in light of *Bilski* and *Mayo* and articulated helpful guidelines for practitioners.

Mr. McFarlane's presentation focused on the patentability question arising in laws of nature and natural products cases. He reviewed the historical perspective of the Supreme Court and provided a comprehensive discussion of the current cases. Specifically, he detailed the *Mayo* opinion and provided useful analysis of the decision in light of historical precedent. He also detailed the Federal Circuit's *Myriad* opinion and proposed open questions facing the Supreme Court in *Myriad*.

Mr. Ackerman's presentation addressed the induced infringement issues articulated by the Federal Circuit in the *Akamai* case. He discussed the evolution of the inducement analysis pre-*Akamai*. He also provided a useful practitioner guide for satisfying the inducement requirements in light of the Supreme Court's decision in *Global Tech* and the Federal Circuit's opinion in *Akamai*.

Keynote Speech



The Keynote Speaker, Judge Mitchell S. Goldberg, provided an outstanding presentation on the intersecting antitrust/patent law issues arising from "re-

verse payment" settlements in the pharmaceutical industry. Judge Goldberg's speech was both intellectually engaging and informative. His experience handling reverse settlement lawsuits provided the foundation for his articulation of the conflicting issues that must be considered and resolved in these cases.

Panel III – "Ethical Considerations in Patent Prosecution and Litigation"

The members of Panel III included Moderator Jenny Lee from King & Spalding, LLP, and Speakers Jonathan Ball from Greenberg Traurig, LLP, Robert Katz from Eaton & Van Winkle LLP, Pablo Hendler from Ropes & Gray LLP, and Jon Gordon from Frommer Lawrence & Haug LLP.



Mr. Ball spoke on "Supplemental Examination." He discussed the background of supplemental examination and its intended role in reducing allegations of inequitable conduct. He outlined the circumstances under which the issue of examination is, and is not, available and the information required to make a request for supplemental examination. He concluded with a discussion of the circumstances under which the issue of which material fraud may arise during supplemental examination and the potential ramifications if it does.

Mr. Katz spoke on "PTO's New Regulations on Rule 1.56." He discussed the historical background of Rule 56, compared changes between the new and old rule, and described the significance of those changes in patent prosecution practice. He also reviewed changes in the definitions of prior art and obviousness under the AIA, and how those changes impacted Rule 56. Finally, he outlined various situations in which violations of Rule 56 resulted in a finding of inequitable conduct, and he proposed best practices in prosecution for avoiding

circumstances that could potentially give rise to claims for inequitable conduct under new Rule 56.

Mr. Hendler gave an “Update on Inequitable Conduct Decisions Since *Therasense*.” He discussed the state of the law of inequitable conduct prior to *Therasense*. He then reviewed the facts in *Therasense* and the Federal Circuit’s standards for materiality and intent in its *en banc* decision. He also reviewed Federal Circuit and District Court decisions since *Therasense* and discussed the general reduction in cases where courts find inequitable conduct. Finally, he identified the circumstances, under the *Therasense* standards, that have resulted in findings of inequitable conduct.

Mr. Gordon spoke on the “Effect of *Hyatt* on Prosecution Strategy.” He described the *Hyatt* decision and the potential opportunity for a patent applicant to seek relief in the District Court in a Section 145 action. He then explained the potential advantages and disadvantages of pursuing Section 145 relief and the strategic reasons why it is unlikely that the *Hyatt* decision will result in a significant increase in the filing of Section 145 actions. Specifically, he concluded that it is generally more advantageous for patent applicants to present their arguments and evidence during prosecution before the Patent and Trademark Office.

Panel IV – “Issues Arising in Licensing Patents”

The members of Panel IV included Moderator Andy Berks from Nostrum Pharmaceuticals LLC, and Speakers Steven Hoffberg from Ostrolenk Faber LLP, Richard Brown from Day Pitney LLP, and Andy Berks (Moderator and Panel Speaker).



Mr. Berks spoke on the “Allocation of IP Rights in Research Agreements.” He discussed the various issues that arise with ownership of IP

rights when one organization funds research and another performs the research in connection with development and collaboration agreements. He outlined the competing interests of the parties to such agreements and the typical starting point for negotiations between the parties. He described the issues that must be considered in connection with assignments and licenses under such agreements and the potential dangers of misidentifying inventorship for jointly developed intellectual property rights.

Mr. Hoffberg spoke on “Licensing with Government Agencies and Academic Institutions.” He discussed how the interests of government agencies and academic institutions often differ from the typical interests of corporations and the effect those differences have on license negotiations. He explained how key licensing terms are different and how enforcement strategies differ for those entities (*e.g.*, issues relating to selection of counsel and the obligation to pay for acquisition and enforcement of patent rights). Finally, he outlined Export Administration Regulations compliance issues that are confronted in a university setting when confidential research is conducted by foreign nationals.

Mr. Brown spoke on the “Admissibility of Settlement Agreements.” He discussed the framework for admissibility of settlement agreements under Rules 403 and 408 of the Federal Rules of Evidence and how application of those rules relates to the potential admissibility of settlement agreements to prove the amount of a reasonable royalty. He then reviewed recent Federal Circuit cases and discussed circumstances that may enhance the probative value of a settlement agreement (increasing the likelihood of admissibility) and circumstances that may diminish the probative value of a settlement agreement (decreasing the likelihood of admissibility). He also discussed the likelihood that settlement agreements will be discoverable, even if they are not admissible.

By all measures the Seminar was a huge success, adhering to the high quality and standards of NYIPLA CLE programs and exceeding expectations both in style and substance. The presenters provided clear guidance on a variety of topical issues and the feedback from attendees was very positive. ■

MINUTES OF OCTOBER 25, 2012
Meeting of The Board of Directors of
THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

BOARD MINUTES

The Board meeting was called to order at the offices of Willkie Farr and Gallagher LLP, 787 Seventh Avenue, New York, NY 10019 at 4:10 p.m. In attendance at the Board meeting were:

Tom Meloro	Leora Ben-Ami
Anthony Lo Cicero	Dorothy Auth
Walter Hanley	Ira Levy
Charles Hoffmann	Annemarie Hassett
Bruce Haas	Theresa Gillis

Attending by telephone were Richard Parke, Wanli Wu, Kevin Ecker and Jeffrey Butler. Absent and excused from the meeting were Alexandra Frisbie and Denise Loring. Feikje van Rein and Lisa Lu attended from the Association’s executive office.

Tom Meloro called the meeting to order and the Board approved the minutes of the prior Board meeting.

The Board next discussed the report of the Amicus Briefs Committee. The Board reached no conclusions and indicated that it would consider further information at the next meeting.

Charles Hoffmann then reported on a discussion he had with Russell Levine regarding the request of Licensing Executives Society (“LES”) to cross-promote its Spring 2014 meeting with the Judges Dinner. Charles reported that LES wished to have its meeting in New York City during the week of the Judges Dinner. The Board considered whether the LES meeting would benefit or harm attendance at the Judges Dinner, and decided that Charles and Dorothy Auth should have further discussions with Mr. Levine.

Richard Parke then reported on the November 1 program. While 68 people already had signed up for the program, the Board noted that it hoped for greater attendance. A few Board members noted that emails from the Association are blocked by their firms due to the stringency of the spam filters. Feikje van Rein indicated that she was working with the administrators of the law firms to correct this situation. The Board indicated that this was a continuing problem, but that attendance was likely to increase.

Annemarie Hassett then reported on the Young Lawyers Committee. Annemarie

indicated that the program put on at New York University Law School within the past month had been very well attended and favorably reviewed. The program on the Life of an IP Associate will be repeated at other law schools. Annemarie also complimented the work of the co-chairs on this committee and suggested that the Association have an event for this committee to increase its ranks.

The Board then received a report from the Association’s auditor, Loeb & Troper LLP. Alan Blum and Ana Shaferova made the presentation to the Board. The presentation, which included written materials, explained how the audit was undertaken and the auditors went through the results as outlined in the written materials. The auditors explained that the Association had now moved to an accrual basis, as indicated in the written materials. The auditors also explained that in auditing the Association they had considered the Not-For-Profit Guidelines and IRS Form 990. The auditors indicated that they had found no indication of fraud and that they found the audit to be very typical for a first audit.

The auditors and the Board discussed a draft Management Letter which had some policy suggestions as well as a draft Financial Statement and Auditor’s Report. Conflict of Interest, Whistleblower and Document Retention policies were discussed. The Board and auditors then went through the IRS Form 990. Board members asked questions for clarification and provided additional information for the auditors to consider. The Board determined that it would consider the specific policy suggestions at the next meeting to allow the Board members to consider the policies in light of the discussion with the auditors. The Board thanked the auditors for their hard work and thanked Jeffrey Butler for his efforts on behalf of the Association to coordinate and supervise this process.

New Members were then considered and approved, subject to verification that those who indicated they were at law firms but sought Student membership were still students.

Dorothy Auth then reported on the Association’s meeting with officials from SIPO. Dorothy indicated that the judges of the Shanghai patent court who met with the Association

provided information on the experiences of the court and indicated that the judges would like to collaborate further with the NYIPLA. The Board requested a proposal from the Patent Law Committee on further collaboration efforts.

Theresa Gillis then provided a summary of the status of updating the bylaws of the Association.

Walter Hanley gave a brief update on the Conner Writing Competition. The committee requested to change the page limit to 20. It was suggested to change the limit to a word count instead of a page count.

Dorothy Auth raised the fact that Cornell will

now have a representative of the USPTO permanently assigned to it to assist the new Technology Center. The Board agreed that Dorothy should reach out to the new liaison from the USPTO and see if the NYIPLA could collaborate with the representative.

Terri Gillis reported the NY Eastern and Southern Districts will be adopting the new patent rules.

Peter Thurlow, a co-chair of the NYIPLA Patent Law and Practice Committee, has been appointed to the USPTO Patent Public Advisory Committee (PPAC).

The meeting was adjourned at approximately 6:00 p.m.

MINUTES OF NOVEMBER 14, 2012
Meeting of The Board of Directors of
THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The Board meeting was called to order at the offices of Willkie Farr and Gallagher LLP, 787 Seventh Avenue, New York, NY 10019 at 11 a.m. In attendance at the Board meeting were:

Thomas Meloro	Theresa Gillis
Anthony Lo Cicero	Richard Parke
Walter Hanley	Dorothy Auth
Charles Hoffmann	Leora Ben-Ami

Kevin Ecker and Wanli Wu attended by telephone. Absent and excused from the meeting were Bruce Haas, Alexandra Frisbie, Jeffrey Butler, Ira Levy, Annemarie Hassett and Denise Loring. Feikje van Rein attended from the Association's executive office.

Tom Meloro called the meeting to order. Due to Superstorm Sandy, Leora Ben-Ami was unable to circulate the minutes of the October meeting; those minutes will be circulated and considered in December.

There was no oral financial report but the monthly financial summary was provided to the Board. The Board felt that this was sufficient, given the very detailed review with the auditors in October.

The Board next addressed the policies suggested by the auditors. With regard to the Conflicts of Interest policy, suggestions were made to add a materiality qualifier to certain conditions. Tom Meloro suggested that Article IV be simplified. With regard to Article VI, the Board agreed that the proposed circulation provisions were too broad and that circulation to the Board generally should provide sufficient oversight. There were stylistic questions regarding Article VII as well, particularly concerning designating the association as "charitable" rather than "tax exempt." Feikje agreed to discuss the changes and suggestions with the auditor and Tom indicated he would try to edit the policy.

The Board discussed the Document Retention policy, and sought verification that the time periods suggested were standard. The Board discussed the nature of documents of historical interest and how to craft the policy to preserve such documents. Charlie indicated that he would contact Dale Carlson to discuss language to allow historical preservation of important information. With regard to Article VI, the Board suggested that the first sentence of the second paragraph be changed to: "Document destruction will be suspended immediately in accordance with applicable law." Article VII is to be changed to delete the use of a "Controller" to review procedures periodically.

The Board suggested that the time period in provision 9 of the Whistleblower policy be changed from "within five business days" to "promptly."

The Board approved the list of New Members.

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Not Receiving NYIPLA E-mails?

Contact your IT/ISP and
request them to place
admin@nyipla.org on your Safe List!

Tony Lo Cicero then reported on behalf of the Amicus Briefs Committee.

The *CLS Bank v. Alice Corp.* case was discussed, with Leora Ben-Ami recused. The Board agreed that a draft brief should be done in accordance with the outline provided and that a telephone conference should take place on November 29th to discuss the draft, if needed.

The *Myriad* case was discussed briefly. The *FTC v. Watson* case was raised, but Tom Meloro, Leora Ben-Ami, Richard Parke, Dorothy Auth, Walter Hanley and Terri Gillis recused themselves from discussion. Therefore discussion was tabled. The *Bowman v. Monsanto* case was discussed (Leora Ben-Ami recusing).

Dorothy Auth then reported that she is scheduling a luncheon for November 29 with the officers and Sue Purvis, the USPTO liaison for Cornell. The main discussion points will be joint efforts of programming and the USPTO pro-bono program. The November 1 CLE program was cancelled due to Sandy. The new date is January 17, 2013. The Board also discussed the December 6 CLE breakfast with Judge Hochberg, and agreed to the Union League space.

Regarding the Judges Dinner, Tom Meloro recommended having Michael Strahan as the speaker, which the Board approved. There also was a discussion of altering the musical format to increase attendance for dancing.

Charlie Hoffmann reported on the Licensing Executives Society (“LES”) discussion with Russell Levine regarding its 2014 meeting and coordination with the NYIPLA. LES agreed it would not continue its program on the day of the dinner. LES proposed having its meeting on Tuesday-Thursday before the Judges Dinner and suggested that NYIPLA members could lead a panel discussion at LES. Mr. Levine and Charlie agreed to further discussions, but Charlie and Dorothy indicated that the meeting went well and that coordination seemed likely.

Terri Gillis asked the Board to see what further changes were needed to the Bylaws. There was a discussion about the Nominating Committee and encouraging further participation and diversity. Term limits were discussed as was the ladder system and whether it should be assumed that the Treasurer would go on the ladder following his or her tenure as Treasurer. The Board agreed that there may be individuals well suited to be Treasurer who would not be appropriate to ultimately become the President of the Association and that further consideration to the issue would be useful.

The Board was informed that the Conner writing competition would be announced next week.

Tom Meloro mentioned that he had received a

call from a court seeking pro bono assistance in a trademark case. Willkie Farr will handle this matter and the Board agreed the Association could provide assistance for pro bono matters through its member firms.

Leora Ben-Ami raised the issue of long-term membership and suggested that the Board have a significant portion of a meeting set aside for a discussion on long-term issues.

Tom Meloro and the Board thanked the Executive office for its handling of important matters during the storm. The meeting was adjourned at 1 p.m.

**2013 NYIPLA
HONORABLE
WILLIAM C. CONNER
INTELLECTUAL PROPERTY LAW
WRITING COMPETITION
*Deadline: Friday, March 8, 2013***



The Winner will receive a cash award of \$1,500.00
The Runner-up will receive a cash award of \$1,000.00

Awards to be presented on May 21, 2013 at the
NYIPLA Annual Meeting and Awards Dinner
at the Princeton Club in New York City

The competition is open to students enrolled in a J.D. or LL.M. program (day or evening). The subject matter must be directed to one of the traditional subject areas of intellectual property, *i.e.*, patents, trademarks, copyrights, trade secrets, unfair trade practices and antitrust. Entries must be submitted electronically by March 8, 2013 to the address provided below.

See rules for details on www.nyipla.org.

Pejman F. Sharifi
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Tel 1.212.294.2603 • Fax 1.212.294.4700
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MINUTES OF DECEMBER 11, 2012
Meeting of The Board of Directors of
THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION

The Board meeting was called to order at the offices of Willkie Farr and Gallagher LLP, 787 Seventh Avenue, New York, NY 10019 at 4:10 p.m. In attendance at the Board meeting were:

Thomas Meloro	Anthony Lo Cicero
Charles Hoffmann	Leora Ben-Ami
Richard Parke	Annemarie Hassett
Bruce Haas	

Attending by telephone were Dorothy Auth, Kevin Ecker, and Alexandra Frisbie. Absent and excused from the meeting were Walter Hanley, Wanli Wu, Theresa Gillis, Jeffrey Butler, Ira Levy and Denise Loring. Feikje van Rein and Robin Rolfe attended from the Association's executive office.

Tom Meloro called the meeting to order. The October and November Board minutes were approved.

Feikje van Rein provided a financial report, indicating that the Association continued to be on solid financial footing. She noted that increasing membership continued to be a challenge and indicated that the executive office continued to work on improving outreach. The Board members then discussed how to improve Association membership in the long term, as present membership is acceptable. Board members noted that because law firms have changed policies regarding paying for membership, it will become a challenge to retain and increase membership in the future.

The Board decided that membership would be discussed as an agenda item on January 15, 2013.

The Board then discussed the policies suggested by the Association's auditors. Regarding the Document Retention policy, Charlie Hoffmann reported that he had discussed the retention of historical documents with Dale Carlson and the suggested policy now reflects that input. Feikje van Rein confirmed that the time frames suggested are standard according to the auditors. The Board also agreed that "Treasurer" should replace "Controller" where applicable. Minor changes also were discussed regarding the Conflict of Interest policy, including that the term "charitable" should be removed.

The Board unanimously approved the Document Retention, Whistleblower and Conflict of Interest policies as edited.

New members were then reviewed and the Board approved the proposed new members.

The proposals of the Amicus Briefs Committee were then discussed. With regard to *Bowman v. Monsanto*, Leora Ben-Ami and Richard Parke recused themselves. The Board approved the preparation of a brief supporting Monsanto. With regard to *FTC v. Watson*, Leora Ben-Ami, Tom Meloro and Bruce Haas recused themselves. The Board agreed that the Amicus Briefs Committee should draft a brief on the merits. Regarding the *Myriad* genetics case, Tom Meloro recused himself. The Committee reported that it was still considering whether to file a merits brief.

Dorothy Auth reported on the lunch with the USPTO liaison resident in New York, Sue Purvis. A group of Board members had lunch with Ms. Purvis to discuss ways to assist the PTO with its outreach in New York. Ms. Purvis requested that the NYIPLA assist in a pro bono program run by VLA (Volunteer Lawyers for the Arts). The Board discussed that its function would only be to assist with publicizing this program and would not be running any program or providing any legal services directly or indirectly. This led to a discussion of further ways that the Association may assist promoting pro bono work through publicizing events and opportunities, including considering whether the Association might assist in a mini-fair where various pro bono organizations could educate lawyers regarding pro bono opportunities. The PTO liaison also suggested having a roundtable on software; the Board indicated it would consider advertising assistance. Ms. Purvis also suggested a PTO-in-New York-day event, possibly in the Fall. The Board expressed interest and asked that Dorothy and others continue these discussions.

Tony Lo Cicero provided an update regarding entertainment at the Judges Dinner.

The Association then discussed having further activities in February, including a practical session on expert testimony, which will be considered. It was noted, however, that there might be too many activities in February scheduled.

The meeting was then adjourned.

NEW MEMBERS

Last Name	First Name	Firm/School	Tel. No.	E-mail Address
Abramson	Bruce	Rimon	646-688-4157	bdabramson@gmail.com
Adamo	Kenneth	Kirkland & Ellis LLP	312-862-2671	kadamo@kirkland.com
Boies	Alexander	New York University School of Law		amb1024@nyu.edu
Bromberg	Karen H.	Cohen & Gresser LLP	212-957-7600	kbromberg@cohengresser.com
Coulson	Christopher J.	Kenyon & Kenyon LLP	212-908-6409	ccoulson@kenyon.com
Crandall, Jr.	Richard			wellscrandall@gmail.com
Daniels	Adam P.	Edwards Wildman Palmer LLP	203-353-6850	adaniels@edwardswildman.com
Elings	Roxanne	Davis Wright Tremaine, LLP	212-603-6416	roxanneelings@dwt.com
Fink	Sarah	Kenyon & Kenyon LLP	212-908-6248	sfink@kenyon.com
Frank	William	Amster, Rothstein & Ebenstein LLP	212-336-8188	scifantasy@gmail.com
Gummow	Brian M.	Ropes & Gray LLP	212-596-9000	brian.gummow@ropesgray.com
Hoffmann	Charles D.	Patterson Belknap Webb & Tyler LLP	212-336-7635	choffmann@pbwt.com
Hogan	Caitlin Patricia	Fitzpatrick, Cella, Harper & Scinto	212-218-2270	chogan@fchs.com
Johnson	Marti	Skadden, Arps, Slate, Meagher & Flom LLP	212-735-3000	marti.johnson@skadden.com
Kang	James	Rutgers School of Law		jjkang13@gmail.com
Katikala	Chaitanya Shaq	New York Law School	813-766-4397	shaq.katikala@gmail.com
Kheyfits	Dimitry	Kheyfits PLLC	212-203-5399	dkheyfits@kheyfits.com
Kunen	Stephen Michael Ian	Wilson Sonsini Goodrich & Rosati	212-497-7771	skunen@wsgr.com
Larsen	Andrew	Merchant & Gould, P.C.	212-223-6658	alarsen@merchantgould.com
Lugo	Karlo Raul	Benjamin N. Cardozo School of Law		karlorlm@aol.com
Lynch	Heather Victoria	Bernstein Liebhard LLP	212-779-1414	lynch@bernlieb.com
Matuschak	Mark G.	Wilmer Cutler Pickering Hale and Dorr LLP	212-937-7226	mark.matuschak@wilmerhale.com
Mckenzie	Elizabeth	Brooklyn Law School		elizabeth.mckenzie@brooklaw.edu
Netto	Derek			dereketto@gmail.com
Rubinstein	Jacob	Brooklyn Law School	516-967-2622	jacob.rubinstein@brooklaw.edu
Saint Vitus	Tushara	Hofstra University School of Law		tsaint3@pride.hofstra.edu
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