

# 2006 / 2007 GREENBOOK

## THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.

“THE ASSOCIATION IS ESTABLISHED TO MAINTAIN THE HONOR AND DIGNITY OF THE LAW OF PATENTS, TRADEMARKS AND COPYRIGHTS; TO PROMOTE THE DEVELOPMENT AND ADMINISTRATION THEREOF; TO ADVANCE THE EDUCATION OF THE MEMBERS OF THE BAR AND THE PUBLIC IN THOSE FIELDS OF LAW, AND TO COOPERATE WITH FOREIGN ASSOCIATIONS IN HARMONIZING THE SUBSTANCE AND INTERPRETATION OF INTERNATIONAL CONVENTIONS FOR THE PROTECTION OF INTELLECTUAL PROPERTY.”

- BYLAWS, ARTICLE II

**MEMBER  
NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS**

This GREENBOOK constitutes a review of the official year of the Association which started June 1, 2005 and ended May 31, 2006, and includes rosters of committees and membership applicable to the current official year. The closing date for copy was September 1, 2006.

If any member wishes to update his or her contact information, please e-mail the Association at [ADMIN@NYIPLA.ORG](mailto:ADMIN@NYIPLA.ORG) with the updated information, and designate the subject line as "Contact Information".

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SECRETARY**

Theresa M. Gillis

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The New York Intellectual Property Law Association  
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# **PART I**





# **SECTION 1**

*Officers & Board of Directors*



*Marylee Jenkins*  
***NYIPLA President***  
***2006-2007***

## OFFICERS AND BOARD OF DIRECTORS 2006-2007



*Front row (left to right):* NYIPLA Officers Theresa M. Gillis, Anthony Giaccio, Christopher A. Hughes, Marylee Jenkins, Mark J. Abate, John E. Daniel, Edward E. Vassallo.  
*Back row (left to right):* NYIPLA Board of Directors Ronald A. Clayton, Alexandra B. Urban, Karl Milde, W. Edward Bailey, Dale L. Carlson, Thomas J. Meloro, Philip T. Shannon (not shown are Robert C. Scheinfeld and Vincent N. Palladino).

### OFFICERS 2006-2007

*President, MARYLEE JENKINS*

1675 Broadway, New York, NY 10019  
Tel: (212) 484-3928 Fax: (212) 484-3990

*President Elect, CHRISTOPHER A. HUGHES*

Three World Financial Center, New York, NY 10281-2101  
Tel: (212) 415-8524 Fax: (212) 415-8701

*First Vice-President, ANTHONY GIACCIO*

One Broadway, New York, NY 10004  
Tel: (212) 908-6419 Fax: (212) 425-5288

*Second Vice-President, MARK J. ABATE*

Three World Financial Center, New York, NY 10281-2101  
Tel: (212) 415-8723 Fax: (212) 415-8701

*Treasurer, JOHN E. DANIEL*

1177 Avenue of the Americas, New York, NY 10022  
Tel: (212) 715-9195 Fax: (212) 715-8195

*Secretary, THERESA M. GILLIS*

222 East 41st Street, New York, NY 10017  
Tel: (212) 326-3679 Fax: (212) 755-7306

*Immediate Past President, EDWARD E. VASSALLO*

30 Rockefeller Plaza, New York, NY 10112  
Tel: (212) 218-2100 Fax: (212) 218-2200

## **BOARD OF DIRECTORS 2006-2007**

**ROBERT C. SCHEINFELD (2007)**  
30 Rockefeller Plaza, New York, NY 10012  
Tel: (212) 408-2512 Fax: (212) 408-2501

**DALE L. CARLSON (2007)**  
One Century Tower - PO Box 1832, New Haven, CT 06508-1832  
Tel: (203) 498-4385 Fax: (203) 782-2889

**VINCENT N. PALLADINO (2007)**  
1211 Avenue of the Americas, New York, NY 10020  
Tel: (212) 596-9000 Fax: (212) 596-9090

**KARL MILDE (2008)**  
10 Bank Street, Suite 460, White Plains, NY 10606  
Tel: (914) 949-3100 Fax: (914) 949-3416

**PHILIP T. SHANNON (2008)**  
866 United Nations Plaza, New York, NY 10017  
Tel: (212) 813-5917 Fax: (212) 813-5901

**W. EDWARD BAILEY (2008)**  
1185 Avenue of the Americas, New York, NY 10036-4003  
Tel: (212) 556-2327 Fax: (212) 556-2222

**RONALD A. CLAYTON (2009)**  
30 Rockefeller Plaza, New York, NY 10112  
Tel: (212) 218-2246 Fax: (212) 218-2200

**THOMAS J. MELORO (2009)**  
787 Seventh Avenue, New York, NY 10019  
Tel: (212) 728-8248 Fax: (212) 728-9248

**ALEXANDRA B. URBAN (2009)**  
299 Park Avenue, New York, NY 10171  
Tel: (212) 318-5675 Fax: (212) 318-5035

## **SECTION 2**

*Committees: 2006-2007*

To apprise the membership of the Association as well as committee members of the scope and functions of the various Association committees, the views of the Board of Directors as to the scope of each committee's activities are noted under the committee's name.

## **Committee on Alternative Dispute Resolution**

*Scope of the Committee.* It shall be the duty of this Committee to consider the use of alternative dispute resolution techniques, including arbitration, in resolving intellectual property disputes and to make recommendations with respect thereto to the Board of Directors.

*Chair*

ROBERT T. TOBIN

*Board Liaison*

VINCENT N. PALLADINO

## **Committee on the Annual Dinner in Honor of the Federal Judiciary**

*Scope of the Committee.* It shall be the duty of this Committee to assist the President in connection with the preparation for and the conduct of the Annual Dinner in Honor of the Federal Judges.

*Chair*

ANTHONY GIACCIO

*Board Liaison*

CHRISTOPHER A. HUGHES

## **Committee on the Annual Meeting of the Association**

*Scope of the Committee.* It shall be the duty of this Committee to assist the President and Secretary in connection with the preparation for and the conduct of the Annual Meeting of the Association and related events.

*Chair*

MARK J. ABATE

*Board Liaison*

CHRISTOPHER A. HUGHES

## **Committee on the Antitrust, Inequitable Conduct and Misuse**

*Scope of the Committee.* It shall be the duty of this Committee to consider the antitrust laws, insofar as they relate to intellectual property, and other unfair conduct in connection with intellectual property including inequitable conduct and misuse, and to make recommendations with respect thereto to the Board of Directors.

*Chair*

DAVID F. RYAN

*Board Liaison*

PHILIP T. SHANNON

*Members*

ROBERT ALDERSON  
MITCHELL BITTMAN  
NICHOLAS COCH  
MICHAEL DALLAL  
JOHN E. DANIEL  
SCOTT FAMILANT  
AARON FRANKEL  
DENNIS GREGORY  
ROBERT M. ISACKSON  
ARTHUR L. LIBERMAN  
BRIAN MCQUILLEN  
EDWARD MEILMAN

VERONICA MULLALLY  
DOUGLAS R. NEMEC  
JOHN W. RYAN  
PETER SAXON  
LAWRENCE F. SCINTO  
PHILIP T. SHANNON  
STEPHEN D. SUSMAN  
JAMES K. STRONSKI  
ESTELLE J. TSEVDOS  
DANIELLE TULLY  
DAVID WEILD III  
CATHENNE YOUSSEF



## Committee on Continuing Legal Education

*Scope of the Committee.* It shall be the duty of this Committee to formulate and present continuing legal educational seminars of interest to the broad spectrum of the Association's membership and to make recommendations with respect thereto to the Board of Directors.

### *Chair*

AMY J. BENJAMIN

### *Board Liaison*

THOMAS J. MELORO

### *Members*

HEATHER CHASE	DONNA M. PRAISS
MICHAEL DALLAL	JESSICA L. RANDO
THERESA M. GILLIS	WALTER SCOTT
MEYER A. GROSS	THOMAS E. SPATH
BENJAMIN C. HSING	ESTHER STEINHAUER
ROBERT M. ISACKSON	ALEK P. SZECZY
PATRICE P. JEAN	BARTHOLOMEW VERDIRAME
MARK I. KOFFSKY	CHARLES A. WEISS
BENU MEHRA	JOHN F. WITHERSPOON

## Committee on Copyrights

*Scope of the Committee.* It shall be the duty of this Committee to consider all aspects of United States, foreign and multi-national copyright law and practice and to make recommendations with respect thereto to the Board of Directors. The Committee shall keep fully informed as to all procedures, rules, regulations and decisions, statutes, treaties, agreements and conventions, existing or proposed, relating to copyrights and make recommendations to the Board of Directors regarding any changes therein.

### *Chair*

DAVID A. EINHORN

### *Board Liaison*

RONALD A. CLAYTON

### *Members*

MATTHEW ABBOTT	CAROLE KLINGER
MARSHA AJHAR	ANDREW KOENIG
KAREN BROMBERG	ROBERTA KRAUS
ROBERT CAMERON	KAZUO MAKINO
HEATHER CHASE	AMINA PARA MATLON
LEONARD P. DIANA	VIRGINIA R. RICHARD
NICHOLAS EISENMAN	LONI RUDOLPH
RICHARD B. KLAR	PHILIP T. SHANNON
CLINTON STAUFFER	

## Committee on Design Protection

*Scope of the Committee.* It shall be the duty of this Committee to study the protection of designs and related legislative proposals, and to make recommendations with respect thereto to the Board of Directors.

*Chair*

JONATHAN E. MOSKIN

*Board Liaison*

PHILIP T. SHANNON

*Members*

ANTHONY J. CASELLA  
HENRY J. CITTONI  
JERRY DAINOW  
URSULA B. DAY  
JOHN GALLAGHER  
MELVIN C. GARNER  
STEPHEN KAMPMEIER

JOHN KUNG  
RODNEY C. KYLE  
NICHOLAS PETERSON  
JAMES SIGNOR  
THOMAS SPATH  
CHRISTOPHER WOODS  
DAVID WEILD III

## Committee on International IP Law

*Scope of the Committee.* It shall be the duty of this Committee to coordinate with the Committee on Patent Law and Practice in cooperation with others regarding proposals to harmonize the substance, practice and interpretation of national laws and the international convention for the protection of intellectual property.

### *Chair*

SAMSON HELFGOTT

### *Board Liaison*

KARL F. MILDE, JR.

### *Members*

ROBERT ALDERSON  
MATTHEW D. ASBELL  
DOROTHY R. AUTH  
AMY BECKMAN  
DWAYNE L. BENTLEY  
MITCHELL BITTMAN  
KARA BONITATIBUS  
KATE CASSIDY  
SUJATA CHAUDHRI  
CHARLES COSTELLO  
PAUL F. FEHLNER  
WILLIAM S. FROMMER  
HARRIS GAO  
STEVEN B. GAUTHIER  
GARY J. GERSHIK  
JAMES GIBSON

AARON HALEVA  
JOHN T. JOHNSON  
RODNEY C. KYLE  
AMINA PARA MATLON  
STEVEN MEYER  
MERRI C. MOKEN  
VERONICA MULLALLY  
MICHEL O'HARA  
PHILIP E. ROUX  
SILVIA SALVADORI  
VICTOR SIBER  
THOMAS E. SPATH  
PETER B. SORELL  
PETER TU  
STEVEN D. UNDERWOOD  
DAVID WEILD III

CATHENNE YOUSSEF

## **Committee on Internet Law**

*Scope of the Committee.* It shall be the duty of this Committee to consider the intellectual property aspects of computer, entertainment and media law and practice and to make recommendations with respect thereto to the Board of Directors.

*Chair*

PAUL J. REILLY

*Board Liaison*

ALEXANDRA B. URBAN

*Members*

JAMES GIBSON  
ROBERTA KRAUS  
ABIGAIL RUBINSTEIN

## **Committee on Legislative Oversight and Amicus Briefs**

*Scope of the Committee.* It shall be the duty of this Committee to coordinate the activities of this Association relating to intellectual property legislation, and to make recommendations with respect thereto to the Board of Directors.

*Chair*

ROCHELLE K. SEIDE

*Board Liaison*

MARK J. ABATE

*Members*

ROCHELLE CHODOCK	STEVEN MEYER
ARUN CHANDRA	CHARLES E. MILLER
THOMAS L. CREEL	JONATHAN MOSKIN
NICHOLAS EISENMAN	ROLAND PLOTTEL
RICHARD ERWINE	ROBERT RANDO
DENNIS GREGORY	TODD ROSENFELD
ALISON HANSTEAD	DAVID RYAN
AARON HELEVA	PETER SAXON
EFFREY I.D. LEWIS	HOWARD SHIRE
ARTHUR L. LIBERMAN	VICTOR SIBER
JOSEPH LOY	RAYMOND VAN DYKE
BRENDAN MEE	CHARLES A. WEISS
BRUCE WEXLER	

## **Committee on License to Practice Requirements**

*Scope of the Committee.* It shall be the duty of this Committee to keep fully informed as to requirements and proposed requirements affecting the practice of members of the Association before government agencies, including the Patent and Trademark Office, and the Courts, relating to admission to practice, qualifications for practice, continuing legal education and specialization, and to make recommendations for changes thereto to the Board of Directors.

### *Chair*

ALLAN A. FANUCCI

### *Board Liaison*

DALE L. CARLSON

### *Members*

MARK A. FARLEY  
KAZUO MAKINO

MARY W. RICHARDSON  
TED WEISZ

## Committee on Litigation Practice and Procedure

*Scope of the Committee.* It shall be the duty of this Committee to consider legislation and rules affecting practice and procedural matters in intellectual property litigation outside the Patent and Trademark Office, and other matters relating to practice in such litigation, and to make recommendations with respect thereto to the Board of Directors.

### *Chair*

JEFFERY M. BUTLER

### *Board Liaison*

THOMAS J. MELORO

### *Members*

STEVEN M. AMUNDSON	AMINA PARA MATLON
DOROTHY R. AUTH	BRIAN MCQUILLEN
MARK BAGHDASSARIAN	THOMAS F. MEAGHER
EDMOND R. BANNON	JEREMY MERLING
JAMES BARABAS	RYAN MICALLEF
ROBERT BOURQUE	TED MLYNAR
KATE CASSIDY	LORA MOFFATT
JENNIFER CHUNG	VERONICA MULLALLY
NICHOLAS COCH	DOUGLAS R. NEMEC
BRIAN COGGIO	EMILY RAPALINO
MARCUS COLUCCI	ROBERT RANDO
ARTHUR CUTILLO	DEBRA RESNICK
SCOTT FAMILANT	SASHA RIEDERS
JOSEPH FARCO	JOHN W. RYAN
DANIEL GANTT	BETTY A. RYBERG
MELVIN C. GARNER	MICHAEL SAUER
MICHAEL GROW	RONALD SCHUTZ
STEVEN R. GUSTAVSON	LAWRENCE F. SCINTO
AARON HALEVA	OGNIAN VARBANOV SHENTOV
ANTHONY H. HANDAL	STEPHEN D. SUSMAN
JOHN T. JOHNSON	ESTELLE J. TSEVDOS
DAVID LINDENBAUM	KEITH WALTER

JOHN F. WITHERSPOON

## **Committee on Meetings and Forums**

*Scope of the Committee.* It shall be the duty of this Committee to prepare and conduct a series of educational meetings of the Association other than meetings of the Officers, Committees and Board of Directors, the Annual Meeting of the Association and the Annual Dinner in Honor of the Federal Judiciary.

### *Chair*

PETER G. THURLOW

### *Board Liaison*

ALEXANDRA B. URBAN

### *Members*

CHERYL H. AGRIS	ANGIE M. HANKINS
MARSHA AJHAR	BENJAMIN C. HSING
ANNE BARSHALL	ROBERT M. ISACKSON
AMY J. BENJAMIN	ELEANOR N. JOHNSON
MONICA BHATTACHRAYYA	STEVEN LIPMAN
AVITAL BLANCHARD	JONATHAN MUENKEL
ARUN CHANDRA	ISRAEL NISSENBAUM
ANNE CHEN	ROLAND PLOTTEL
ROCHELLE CHODOCK	RORY RADDING
CHRISTOPHER A. COLVIN	JESSICA L. RANDO
VITO DEBARI	DEBRA RESNICK
RICHARD W. ERWINE	DONALD L. RHODAS
PAUL F. FEHLNER	MICHAEL SAUER
THOMAS E. SPATH	

## **Committee on Membership**

*Scope of the Committee.* It shall be the duty of this Committee to promote membership in the Association, to process applications for membership in accordance with Article III of the Bylaws and the Rules on Admissions of the Association and to make recommendations with respect thereto to the Board of Directors.

### *Chair*

MARILYN MATTHES BROGAN

### *Board Liaison*

RONALD A. CLAYTON

### *Members*

VICTORIA J.B. DOYLE	LESLIE K. MITCHELL
ERIN HENNESSY	DEENA L. WEINHOUSE



## Committee of Past Presidents

*Scope of the Committee.* It shall be the duty of this Committee to propose to the Board of Directors ways in which the Association and its objectives and public image may be improved and to study and report to the Board on any matter which may be referred to the Committee by the Board.

### *Chair*

JOHN D. MURNANE

### *Board Liaison*

EDWARD E. VASSALLO

### *Members*

HOWARD B. BARNABY	KARL F. JORDA
LORIMER P. BROOKS	DAVID H.T. KANE
HUGH A. CHAPIN	STANTON T. LAWRENCE, JR.
BERT A. COLLISON	JEROME G. LEE
HON. WILLIAM C. CONNER	ROBERT NEUNER
JOHN C. COOPER	JOHN B. PEGRAM
THOMAS L. CREEL	JOSEPH J. PREVITO
RICHARD L. DELUCIA	PASQUALE A. RAZZANO
WILLIAM F. EBERLE	JOHN A. REILLY
PAUL M. ENLOW	ALBERT ROBIN
EDWARD V. FILARDI	M. ANDREA RYAN
FRANK W. FORD, JR.	PETER SAXON
MELVIN C. GARNER	FRANK F. SCHECK
WILLIAM J. GILBRETH	HERBERT F. SCHWARTZ
EDWARD HALLE	JOHN F. SWEENEY
CYRUS S. HAPGOOD	JOHN O. TRAMONTINE
DOUGLAS W. WYATT	

## **Committee on Patent Law and Practice**

*Scope of the Committee.* It shall be the duty of this Committee to consider all aspects of foreign and multinational patent laws and practice which affect the rights of United States entities in technology in foreign countries and to make recommendations with respect thereto to the Board of Directors.

*Chair*

WILLIAM H. DIPPERT

*Board Liaison*

ROBERT C. SCHEINFELD

*Members*

ROBERT BOURQUE	LESLIE NGUYEN
RONALD BROWN	NICHOLAS PETERSON
ARUN CHANDRA	DONNA PRAISS
MICHAEL DALLEL	THOMAS PRESSON
JERRY DAINOW	EMILY RAPALINO
SAM DESAI	SASHA RIEDERS
ALOZIE ETUFUGH	SILVIA SALVADORI
WILLIAM FROMMER	PETER SAXON
DANIEL GANTT	RONALD SCHUTZ
MELVIN GARNER	ALEK SZECZY
EDWARD MEILMAN	WILLIAM TABLER
JEREMY MERLING	EDWARD TEMPESTA
CHARLES MILLER	DANIELLE TULLY

JOHN P. WHITE

## **Committee on Professional Ethics and Grievances**

*Scope of the Committee.* It shall be the duty of this Committee to increase education and interaction among NYIPLA members concerning the rules of professional responsibility issues particularly germane to intellectual property practitioners. The Committee's mission was changed this year to expand its focus from its historical role which had been limited to considering grievances against NYIPLA members.

*Chair*

HUNTER C. CARTER

*Board Liaison*

ROBERT C. SCHEINFELD

*Members*

STEVEN A. AMUNDSON	RORY RADDING
JENNIFER CHUNG	JAMES K. STRONSKI
MICHEL O'HARA	CHARLES A. WEISS
TED WEISZ	

## **Committee on Public and Judicial Personnel and International Relations**

*Scope of the Committee.* It shall be the duty of this Committee to consider and propose candidates for public and judicial offices which involve patent, trademark and copyright matters, and to make recommendations to the Board of Directors with respect to such candidates.

*Chair*

SUSAN E. MCGAHAN

*Board Liaison*

W. EDWARD BAILEY

*Members*

THOMAS L. CREEL

THOMAS F. MEAGHER

JOHN T. JOHNSON

MICHEL O'HARA

JOSEPH LOY

MICHELLE SHENDER

JOHN P. WHITE

## **Committee on Public Information, Education and Awards**

*Scope of the Committee.* It shall be the duty of this Committee to publicize the activities of the Association, to publicize the patent, trademark and copyright systems, to educate the public with respect to such systems and to make recommendations to the Board of Directors with respect thereto.

*Chair*

RICHARD W. ERWINE

*Board Liaison*

W. EDWARD BAILEY

*Members*

AL CHEN

ROB NUPP

RICH MARTINELLI

JESSICA RANDO

JOHN MOEHRINGER

BRAD SCHELLER

RAYMOND VAN DYKE

## **Committee on Publications**

*Scope of the Committee.* It shall be the duty of this Committee to prepare, edit, publish and disseminate such publications as may be requested by the Board of Directors and to make recommendations to the Board with respect thereto.

*Chair*

ASHE P. PURI

*Board Liaison*

MARYLEE JENKINS

*Greenbook Subcommittee Chair*

STEPHEN J. QUIGLEY

*Members*

KATE CASSIDY

ROCHELLE CHODOCK

ARUN CHANDRA

SUJATA CHAUDHRI

ARTHUR CUTILLO

WILLIAM DIPPERT

CATHERINE GRATTON

BENJAMIN C. HSING

JOSEPH LOY

MARY W. RICHARDSON

CHARLES RYAN

RAYMOND VAN DYKE

## **Committee on Trade Secret Law and Practice**

*Scope of the Committee.* It shall be the duty of this Committee to consider all aspects of United States trade secret law and practice and to make recommendations with respect thereto to the Board of Directors.

*Chair*

HOWARD C. MISKIN

*Board Liaison*

KARL F. MILDE JR.

*Members*

AMY BECKMAN	JOHN GALLAGHER
MITCHELL BITTMAN	ARTHUR L. LIBERMAN
CHRISTOPHER A. COLVIN	JOSEPH LOY
LEONARD DIANA	EDWARD MEILMAN
RONALD SCHUTZ	

## **Committee on Trademark Law and Practice**

*Scope of the Committee.* It shall be the duty of this Committee to consider all aspects of trademark law and practice and to make recommendations with respect thereto to the Board of Directors.

*Chair*

KATHLEEN E. MCCARTHY

*Board Liaison*

VINCENT N. PALLADINO

*Members*

BRUCE BABER	URSULA B. DAY
JOHN BERGIN	STEPHEN FEINGOLD
ROBERT CAMERON	MICHELLE GRAHAM
SUJATA CHAUDHRI	WILLIAM GUILD

## Young Lawyers Committee

*Scope of the Committee.* It shall be the duty of this Committee to address the concerns and needs of minorities, women and newly-admitted lawyers.

### *Chair*

ALOZIE N. ETUFUGH

### *Board Liaison*

DALE L. CARLSON

### *Members*

MATTHEW ABBOTT

BRIDGETTE AHN

AMY BECKMAN

KARA BONITATIBUS

BRIAN BUCK

HEATHER CHASE

JENNIFER CHUNG

SAM DESAI

JOSEPH FARCO

HARRIS GAO

STEVEN B. GAUTHIER

CATHERINE GRATTON

ALISON HANSTEAD

ERIC HENSHAW

DUANE JOHNSON

GLORIA JUNG

DAVID LINDENBAUM

BENU MEHRA

RYAN MICALLEF

LESLIE NGUYEN

JESSICA L. RANDO

EMILY RAPALINO

SASHA RIEDERS

BRAD SCHELLER

MICHELLE SHENDER

JAMES SIGNOR

GREGORY SPEKTOR

ADAM R. STEINERT

EDWARD TEMPESTA

JENNIFER H. WU

**American Intellectual Property Law Education Foundation Liaison**

DANIEL A. DEVITO

**Joint Patent Practice Continuing Legal Education Liaison**

AMY J. BENJAMIN

**U.S. Inter-Bar European Patent Office Liaison Council Representatives**

SAMSON HELFGOTT  
THOMAS E. SPATH

**U.S. Bar/Japan Patent Office Liaison Council Representatives**

JOHN B. PEGRAM  
MARYLEE JENKINS





## **SECTION 3**

*Treasurer's Report 2005-2006*

## **ANNUAL REPORT OF THE TREASURER 2005-2006**

As described in detail in the report of the Association's Certified Public Accountant, the statement of income and expenses for the fiscal year 2005-2006 shows a net loss of \$1,474.

The Association's net worth is \$985,911 and its financial condition continues to be sound. The Association continues to be in favorable condition as it begins the fiscal year 2006-2007.

**THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.  
STATEMENT OF ASSETS AND LIABILITIES  
FOR THE YEAR ENDING APRIL 30, 2006  
EXHIBIT A**

### **CURRENT ASSETS**

Cash – Checking Account – Citibank	\$741,436.00
Money Market Account	24,380.00
Certificate of Deposit – Due 5/5/06	78,104.00
Certificate of Deposit – Due 10/13/06	31,379.00
Certificate of Deposit – Due 5/5/06	78,053.00
Certificate of Deposit – Due 2/28/07	32,559.00

**TOTAL ASSETS** **\$985,911.00**

### **NET WORTH**

Balance – May 1, 2005	\$987,385.00
Less: Net Loss for the Period Ended, April 30, 2006	\$ (1,474.00)

**TOTAL NET WORTH** **\$985,911.00**

**THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.**  
**STATEMENT OF INCOME AND EXPENSES**  
**FOR THE YEAR ENDING APRIL 30, 2006**  
**EXHIBIT B**

**INCOME**

Annual Dues Income	\$142,154
CLE Program Income	111,890
Judges Dinner Income	846,615
Annual Meeting Income	10,855
Interest Income	7,984
	<hr/>
<b>TOTAL INCOME</b>	<b>\$1,119,498</b>

**EXPENSES**

CLE Program Expense	\$94,264
Judges Dinner Expense	600,057
Annual Meeting Expense	16,342
Board of Director Meeting Expense	8,429
Consulting Expense	251,802
Printing Expense	58,030
Mailing Expense	20,178
Accounting Expense	1,250
Insurance Expense	12,221
Scholarship Expense	10,000
Joint Patent Seminar Expense	5,950
Committee Meeting Expense	11,300
Supplies Expense	6,977
Website Expenses	3,600
Donations	2,500
Young Lawyers Expense	4,365
Past Presidents Dinner Expense	5,204
Bank Service Charges	508
Miscellaneous Expense	7,995
	<hr/>
<b>TOTAL EXPENSES</b>	<b>\$1,120,972</b>

**NET LOSS – EXHIBIT B** **\$ (1,474)**



## **SECTION 4**

*Former Officers & Directors*



## PRESIDENTS

Wm. Houston Kenyon	1922-1925	John N. Cooper	1965-1966
John P. Bartlett	1925-1926	Albert C. Johnston	1966-1967
Hubert Howson	1926-1927	John T. Kelton	1967-1968
Edwin J. Prindle	1927-1928	Hugh A. Chapin	1968-1969
Thomas Ewing	1928-1929	Edward Halle	1969-1970
William A. Redding	1929-1930	Alfred L. Haffner, Jr.	1970-1971
Rickard Eyre	1930-1931	Frank W. Ford, Jr.	1971-1972
Charles Neave	1931-1932	William C. Conner	1972-1973
William H. Davis	1932-1933	Joseph J. Previto	1973-1974
Oscar W. Jeffrey	1933-1934	Stanton T. Lawrence, Jr.	1974-1975
Fritz V. Briesen	1934-1935	Lorimer P. Brooks	1975-1976
George Ramsey	1935-1936	Morris Relson	1976-1977
William B. Greeley	1936-1937	Bert A. Collison	1977-1978
Merrell E. Clark	1937-1938	John A. Reilly	1978-1979
Albert G. Davis	1938-1939	William F. Eberle	1979-1980
Clifton V. Edwards	1939-1940	Jerome G. Lee	1980-1981
Theodore S. Kenyon	1940-1941	Albert Robin	1981-1982
Dean S. Edmonds	1941-1942	Paul M. Enlow	1982-1983
Newton A. Burgess	1942-1943	Douglas W. Wyatt	1983-1984
Stephen H. Philbin	1943-1944	Lee C. Robinson, Jr.	1984-1985
Robert W. Byerly	1944-1945	John O. Tramontine	1985-1986
Lawrence Bristol	1945-1946	Karl F. Jorda	1986-1987
Clair W. Fairbank	1946-1946	Paul H. Heller	1987-1988
R. Morton Adams	1946-1947	David H.T. Kane	1988-1989
Charles H. Walker	1947-1948	John B. Pegram	1989-1990
Alan N. Mann	1948-1949	Frank F. Scheck	1990-1991
Worthington Campbell	1949-1950	Peter Saxon	1991-1992
Giles S. Rich	1950-1951	M. Andrea Ryan	1992-1993
Alexander C. Neave	1951-1952	William J. Gilbreth	1993-1994
Frank E. Barrows	1952-1953	Pasquale A. Razzano	1994-1995
Granville M. Brumbaugh	1953-1954	Thomas L. Creel	1995-1996
Norman N. Holland	1954-1955	Martin E. Goldstein	1996-1997
Floyd H. Crews	1955-1956	Edward V. Filardi	1997-1998
W. Houston Kenyon, Jr.	1956-1957	Howard B. Barnaby	1998-1999
Henry R. Ashton	1957-1958	Herbert F. Schwartz	1999-2000
David S. Kane	1958-1959	John F. Sweeney	2000-2001
James B.L. Orme	1959-1960	Robert Neuner	2001-2002
Wallace H. Martin	1960-1961	Richard L. DeLucia	2002-2003
Mark N. Donohue	1961-1962	Melvin C. Garner	2003-2004
Cyrus S. Hapgood	1962-1963	John D. Murnane	2004-2005
Ralph L. Chappell	1963-1964	Edward E. Vassallo	2005-2006
Harry R. Pugh, Jr.	1964-1965		

## SECRETARIES

Conrad A. Dietrich	1922-1925	Paul H. Heller	1977-1981
Charles E. McTiernan	1958-1961	William J. Barnes	1952-1955
Crichton Clarke	1925-1931	John B. Pegram	1981-1984
Frank W. Ford, Jr.	1961-1964	Stewart L. Whitman	1955-1956
R. R. Adams	1931-1934	Peter Saxon	1984-1987
Alfred L. Haffner, Jr.	1964-1968	Malvin R. Mandelbaum	1956-1958
Charles H. Keel	1934-1944	Pasquale A. Razzano	1987-1990
Bert A. Collison	1968-1970	William H. Dippert	1991-1996
David A. Woodcock	1944-1946	John F. Sweeney	1996-1998
Caspar C. Schneider, Jr.	1970-1973	Melvin C. Garner	1998-2000
Elmer R. Helferich	1946-1949	Edward E. Vassallo	2000-2002
Kenneth E. Madsen	1973-1977	Mark J. Abate	2002-2006
Leland L. Chapman	1949-1952		

## TREASURERS

Philip Farnsworth	1922-1924	Alexander J. McKillop	1982-1984
Albert F. Nathan	1924-1931	Mary-Ellen M. Timbers	1984-1989
Frank E. Barrows	1931-1945	Howard B. Barnaby	1989-1995
John C. Blair	1945-1948	Gregory J. Battersby	1995-1997
Albert C. Nolte	1948-1969	John D. Murnane	1997-2001
Henry C. Dearborn	1969-1973	Marylee Jenkins	2001-2003
Edward H. Valance	1973-1978	Susan E. McGahan	2003-2005
Arthur S. Tenser	1978-1982		

## PRESIDENT ELECT†

Jerome G. Lee	1979-1980	William J. Gilbreth	1992-1993
Albert Robin	1980-1981	Pasquale A. Razzano	1993-1994
Paul M. Enlow	1981-1982	Thomas L. Creel	1994-1995
Douglas W. Wyatt	1982-1983	Martin E. Goldstein	1995-1996
Lee C. Robinson, Jr.	1983-1984	Edward V. Filardi	1996-1997
John O. Tramontine	1984-1985	Howard B. Barnaby	1997-1998
Karl F. Jorda	1985-1986	Herbert F. Schwartz	1998-1999
Paul H. Heller	1986-1987	John F. Sweeney	1999-2000
David H.T. Kane	1987-1988	Robert Neuner	2000-2001
John B. Pegram	1988-1989	Richard L. DeLucia	2001-2002
Frank F. Scheck	1989-1990	Melvin C. Garner	2002-2003
Peter Saxon	1990-1991	John D. Murnane	2003-2004
M. Andrea Ryan	1991-1992	Edward E. Vassallo	2004-2005
		Marylee Jenkins	2005-2006

## 1<sup>ST</sup> VICE PRESIDENTS

Thomas Ewing	1922-1925	John N. Cooper	1964-1965
James Q. Rice	1925-1928	Albert C. Johnston	1965-1966
Oscar W. Jeffery	1928-1931	John T. Kelton	1966-1967
Alan N. Mann	1931-1934	Hugh A. Chapin	1967-1968
George Ramsey	1934-1935	Edward Halle	1968-1969
Dean S. Edmonds	1935-1937	William R. Woodward	1969-1970
Theodore S. Kenyon	1937-1940	Frank W. Ford, Jr.	1970-1971
Newton A. Burgess	1940-1942	William C. Conner	1971-1972
Maxwell Barus	1942-1943	Joseph J. Previto	1972-1973
Robert W. Byerly	1943-1944	Stanton T. Lawrence	1973-1974
Clair W. Fairbank	1944-1945	Lorimer P. Brooks	1974-1975
R. Morton Adams	1945-1946	Morris Relson	1975-1976
Charles H. Walker	1946-1947	Bert A. Collison	1976-1977
Giles S. Rich	1947-1949	John A. Reilly	1977-1978
Alexander C. Neave	1949-1951	William F. Eberle	1978-1979
John Hoxie	1951-1952	Jerome G. Lee	1979-1980
Granville M. Brumbaugh	1952-1953	Albert Robin	1980-1981
Norman N. Holland	1953-1954	Paul M. Enlow	1981-1982
Floyd H. Crews	1954-1955	Douglas W. Wyatt	1982-1983
W. Houston Kenyon, Jr.	1955-1956	Lee C. Robinson, Jr.	1983-1984
Henry R. Ashton	1956-1957	John O. Tramontine	1984-1985
David S. Kane	1957-1958	Paul H. Heller	1985-1986
James B.L. Orme	1958-1959	David H.T. Kane	1986-1987
Wallace H. Martin	1959-1960	John B. Pegram	1987-1988
Mark N. Donohue	1960-1961	Frank F. Scheck	1988-1989
Paul S. Bolger	1961-1961	Peter Saxon	1989-1990
Cyrus S. Hapgood	1962-1962	M. Andrea Ryan	1990-1991
Ralph L. Chappell	1962-1963	William J. Gilbreth	1991-1992
Harry R. Pugh, Jr.	1962-1964	Pasquale A. Razzano	1992-1993

†Amended May 24, 1979



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**1<sup>ST</sup> VICE PRESIDENTS**

Thomas L. Creel	1993-1994	Richard L. DeLucia	2000-2001
Martin E. Goldstein	1994-1995	Melvin C. Garner	2001-2002
Edward V. Filardi	1995-1996	John D. Murnane	2002-2003
Howard B. Barnaby	1996-1997	Edward E. Vassallo	2003-2004
Herbert F. Schwartz	1997-1998	Marylee Jenkins	2004-2005
John F. Sweeney	1998-1999	Christopher A. Hughes	2005-2006
Robert Neuner	1999-2000		

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**2<sup>ND</sup> VICE PRESIDENTS**

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William H. Davis	1922-1923	John A. Reilly	1976-1977
Hubert Howson	1923-1926	Jerome G. Lee	1977-1979
Thomas Ewing	1926-1927	Paul M. Enlow	1979-1981
Dean S. Edmonds	1927-1930	Lee C. Robinson, Jr.	1981-1983
John C. Kerr	1930-1931	Karl F. Jorda	1983-1985
S. Mortimer Ward, Jr.	1931-1933	David H. T. Kane	1985-1986
Newton A. Burgess	1933-1936	John B. Pegram	1986-1987
Lawrence Bristol	1936-1939	Frank F. Scheck	1987-1988
Stephen H. Philbin	1939-1942	Peter Saxon	1988-1989
Worthington Campbell	1942-1945	M. Andrea Ryan	1989-1990
Giles S. Rich	1945-1947	William J. Gilbreth	1990-1991
David A. Woodcock	1947-1949	Pasquale A. Razzano	1991-1992
Thomas J. Byrne	1949-1951	Thomas L. Creel	1992-1993
Victor D. Borst	1951-1953	Martin E. Goldstein	1993-1994
Howard W. Dix	1953-1955	Edward V. Filardi	1994-1995
Virgil C. Kline	1955-1957	Howard B. Barnaby	1995-1996
George S. Hastings	1957-1959	Herbert F. Schwartz	1996-1997
Lawrence B. Dodds	1959-1961	Gregory J. Battersby	1997-1998
Cyrus S. Hapgood	1961-1962	Robert Neuner	1998-1999
John N. Cooper	1962-1964	Richard L. DeLucia	1999-2000
Albert C. Johnston	1964-1965	Melvin C. Garner	2000-2001
Hugh A. Chapin	1965-1967	John D. Murnane	2001-2002
William R. Woodward	1967-1969	Edward E. Vassallo	2002-2003
William C. Conner	1969-1971	Marylee Jenkins	2003-2004
Stanton T. Lawrence, Jr.	1971-1973	Christopher A. Hughes	2004-2005
Morris Relson	1973-1975	Anthony Giaccio	2005-2006
Bert A. Collison	1975-1976		

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**3<sup>RD</sup> VICE PRESIDENTS**

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Richard Eyre	1922-1926	Ferdinand Kump, Jr.	1959-1961
A. Parker-Smith	1926-1929	John N. Cooper	1961-1962
Wallace White	1929-1932	Albert C. Johnston	1962-1964
Worthington Campbell	1933-1935	Edward Halle	1964-1966
Alexander C. Neave	1935-1938	William C. Conner	1966-1969
R. Morton Adams	1938-1941	Joseph J. Previto	1969-1970
Granville M. Brumbaugh	1941-1943	Bert A. Collison	1970-1972
George F. Des Marais	1943-1945	Gerald W. Griffin	1972-1974
Sidney G. Berry	1945-1947	Anthony J. Casella	1974-1976
Curt Von Boetticher	1947-1949	William F. Eberle	1976-1978
James B.L. Orme	1949-1951	Albert Robin	1978-1980
Ralph L. Chappell	1951-1953	Douglas W. Wyatt	1980-1982
John C. Blair	1953-1954	John O. Tramontine	1982-1984
W. Houston Kenyon, Jr.	1954-1955	Paul H. Heller	1984-1985
David S. Kane	1955-1957	David H.T. Kane	1985-1986
William R. Woodward	1957-1959	John B. Pegram	1986-1987

## BOARD OF DIRECTORS

J. Edgar Bull	1922-1923	Henry D. Williams	1937-1938
John P. Bartlett	1922-1924	Dean S. Edmonds	1937-1940
	1928-1943		1951-1954
Arthur C. Fraser	1922-1924	Otto S. Schairer	1937-1940
Harry E. Knight	1922-1924	H. Monroe Humason	1938-1939
Hubert Howson	1922-1925	Howard W. Dix	1938-1941
James Q. Rice	1922-1925	Kenneth S. Neal	1938-1941
Samuel O. Edmonds	1922-1926	Louis P. Whitaker	1938-1941
John R. Nolan	1922-1926	Samuel E. Darby, Jr.	1939-1942
Archibald Cox	1922-1929	Clair W. Fairbank	1939-1942
Livingston Gifford	1923-1925	Clarence D. Kerr	1940-1943
Clifton V. Edwards	1924-1927	George F. Scull	1940-1943
John C. Kerr	1924-1927	John B. Hayward	1941-1944
Arba B. Marvin	1924-1927	F. Bascom Smith	1941-1944
C.C. Billings	1925-1928	Thomas J. Byrne	1942-1945
William G. McKnight	1925-1928		1946-1949
Edwin J. Prindle	1925-1928	William T. Kniesner	1943-1946
Richard Eyre	1926-1929	R. Morton Adams	1943-1945
S. Mortimer Ward, Jr.	1926-1929		1947-1950
	1939-1942	Harry G. Kimball	1943-1945
Carl P. Goepel	1927-1930	Charles H. Walker	1943-1946
Alfred W. Kiddle	1927-1930		1948-1951
John F. Neary	1927-1930	Victor S. Beam	1944-1947
Merrel E. Clark	1928-1931	George T. Bean	1944-1947
Wallace White	1928-1929	Walter E. F. Bradley	1944-1945
	1929-1931		1945-1946
Alan N. Mann	1934-1936	William Bohleber	1945-1948
	1946-1948	Harry G. Grover	1945-1948
Lawrence Bristol	1929-1932	Granville M. Brumbaugh	1946-1949
George E. Folk	1929-1932	Worthington Campbell	1947-1949
Edmond Q. Moses	1929-1932		1950-1951
	1941-1944	Wallace H. Martin	1947-1950
James J. Cosgrove	1930-1933		1961-1962
Herbert H. Dyke	1930-1933	Norman N. Holland	1948-1951
E. Clarkson Seward	1930-1933		1955-1956
Theodore S. Kenyon	1931-1934	Charles H. Keel	1948-1950
Lawrence Langner	1931-1934	Elmer R. Helferich	1949-1950
	1942-1945	W. Houston Kenyon, Jr.	1949-1952
Robert Starr Allyn	1932-1935		1957-1958
	1948-1949	Edmund H. O'Brien	1949-1952
Fritz V. Briesen	1932-1934	Giles S. Rich	1949-1950
A. Parker-Smith	1932-1935		1951-1954
George Ramsey	1933-1934	John Hoxie	1950-1951
Leonard A. Watson	1933-1936		1958-1961
	1942-1945	Floyd H. Crews	1950-1953
Manvel Whitmore	1933-1936		1956-1957
John Parry	1934-1937	Virgil C. Kline	1950-1952
Frederick S. Duncan	1934-1937		1956-1957
Victor D. Borst	1934-1938	Leslie D. Taggart	1950-1953
Robert W. Byerly	1935-1938		1965-1968
	1945-1948	James B.L. Orme	1958-1959
Albert G. Davis	1935-1938		1960-1961
Ramsey Hoguet	1936-1937	Morris Kirschstein	1951-1954
Stephen J. Cox	1936-1939		
R.J. Dearborn	1936-1939		

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**BOARD OF DIRECTORS**

Joe D. Daniels	1952-1955	Daniel H. Kane	1969-1972
Laurence B. Dodds	1952-1955	Morris Relson	1969-1972
George E. Middleton	1952-1955	Ronald F. Ball	1970-1973
Henry R. Ashton	1953-1956	Robert J. Sanders, Jr.	1970-1973
	1958-1959	Samuel L. Welt	1970-1973
Victor D. Broman	1953-1956	Daniel H. Brown	1971-1974
Harry R. Mayers	1953-1956	Jerome G. Lee	1971-1974
Stewart L. Whitman	1954-1955		1981-1982
Walter H. Free	1954-1957	George W. Price	1971-1974
Cyrus S. Hapgood	1954-1957	Morton D. Goldberg	1972-1975
A. Robert Noll	1955-1958	Kenneth E. Madsen	1972-1973
Leonard J. Robbins	1955-1958		1977-1980
Clinton B. Townsend	1955-1958	Edward H. Valance	1972-1973
George S. Hastings	1956-1957		1978-1980
Paul R. Ames	1956-1959	Evans Kahn	1973-1976
W. Brown Morton, Jr.	1956-1959	Richard T. Laughlin	1973-1975
John Schulman	1957-1960	Eric D. Offner	1973-1976
	1965-1968	Caspar C. Schneider, Jr.	1973-1976
Walter J. Halliday	1957-1960	George W. Whitney	1973-1976
Paul S. Bolger	1957-1960	Anthony R. DeSimone	1974-1977
Donald L. Dickerson	1958-1961	Martin Kalikow	1974-1977
Trenton Meredith	1958-1961	Albert Robin	1974-1977
Mark D. Donohue	1959-1960		1982-1983
	1962-1965	William F. Kilgannon	1975-1978
David S. Kane	1959-1962	Michael J. Quillinan	1975-1978
Harry R. Pugh, Jr.	1959-1962	John A. Reilly	1975-1978
Albert C. Johnston	1960-1962		1979-1980
John A. Reilly	1960-1963	J. Phillip Anderegg	1976-1978
Harry R. Sage	1960-1963	David H. T. Kane	1976-1979
Russell G. Pelton	1961-1964		1989-1990
Gordon A. Wilkins	1961-1964	John C. Vassil	1976-1979
Lorimer P. Brooks	1961-1964	Douglas W. Wyatt	1976-1979
Sylvester J. Liddy	1961-1963		1984-1985
Henry W. Koster	1962-1965	Paul M. Enlow	1977-1979
Robert E. Isner	1962-1965		1983-1984
Phillip T. Dalsimer	1963-1966	William F. Dudine, Jr.	1977-1980
Stanton T. Lawrence, Jr.	1963-1966	Lee C. Robinson, Jr.	1978-1981
Charles E. McTiernan	1963-1966		1985-1986
Robert Osann	1964-1967	Bert A. Collision	1978-1979
Henry E. Sharpe	1964-1967	John P. Sinnott	1978-1981
William R. Woodward	1964-1967	Edgar W. Adams, Jr.	1979-1982
John W. Brumbaugh	1965-1968	Stanley H. Lieberstein	1979-1982
W. Phillip Churchill	1966-1969	Lawrence F. Scinto	1979-1982
William E. Dampier	1966-1969	John O. Tramontine	1979-1980
John R. Shipman	1966-1969		1986-1987
Horace B. Fay	1967-1970	John M. Calimafde	1980-1983
Joseph J. Previto	1967-1970	William F. Eberle	1980-1981
Arthur S. Tenser	1967-1970	Karl F. Jorda	1980-1983
Frederick C. Carver	1968-1971		1987-1988
Robert S. Dunham	1968-1971	Alexander J. McKillop	1980-1983
Alfred L. Haffner, Jr.	1968-1971	Paul H. Heller	1981-1984
Alan Latman	1968-1971		1988-1989
Pauline Newman	1968-1972	Siegrun D. Kane	1981-1984
Hugh A. Chapin	1969-1972	Ewan C. MacQueen	1981-1984

*(Continued)*

**BOARD OF DIRECTORS** *(Continued)*

Richard G. Berkley	1982-1985	John F. Sweeney	1992-1995
Barry Evans	1982-1985		2000-2001
Frank F. Scheck	1982-1985	Berj A. Terzian	1992-1995
	1991-1992	Ronald A. Bleeker	1995-1996
James W. Badie	1983-1986	William J. Brunet	1993-1996
Maria C.H. Lin	1983-1986	William F. Lawrence	1993-1996
Michael N. Meller	1983-1986	Herbert F. Schwartz	1993-1996
John B. Pegram	1983-1986		1999-2000
	1990-1991	Michael J. Kelly	1994-1997
Walter J. Baum	1984-1987	Thomas E. Spath	1994-1997
Herbert Blecker	1984-1987	Marilyn M. Brogan	1995-1998
William F. Lawrence	1984-1987	Richard DeLucia	1995-1998
Philip Furgang	1985-1988	Robert Neuner	1995-1998
Elsie M. Quinlan	1985-1988		2001-2002
Pasquale A. Razzano	1985-1988	Theresa M. Gillis	1996-1999
	1994-1995	Richard DeLucia	1996-1999
Howard B. Barnaby	1986-1989	Edward E. Vassallo	1996-1999
	1998-1999	Alice Brennan	1997-2000
Samson Helfgott	1986-1989	John Daniel	1997-2000
M. Andrea Ryan	1986-1989	Thomas A. O'Rourke	1997-2000
	1993-1994	Charles P. Baker	1998-2001
Alfred P. Ewert	1987-1990	Edward M. Blocker	1998-2001
Leonard B. Mackey	1987-1990	Susan McHale	1998-2001
William J. Gilbreth	1987-1990	Marylee Jenkins	1998-2001
	1993-1994	Mark J. Abate	1999-2002
Dale L. Carlson	1988-1991	Ira J. Levy	1999-2002
John E. Kidd	1988-1991	Dawn Buonocore	2000-2003
Evelyn M. Sommer	1988-1991	Cecilia O'Brien Lofters	2000-2003
Thomas L. Creel	1989-1992	Rory J. Radding	2000-2003
	1995-1996	Thomas H. Beck	2001-2002
Martin E. Goldstein	1989-1992	Christopher A. Hughes	2001-2004
	1996-1997	Robert C. Morgan	2001-2004
Stanley J. Silverberg	1989-1992	Anthony M. Santini	2001-2004
Robert L. Baechtold	1990-1993	William H. Dippert	2002-2005
David J. Mugford	1990-1993	Charles R. Hoffmann	2002-2005
Gregory J. Battersby	1991-1994	Jack D. Slobod	2002-2005
Edward V. Filardi	1991-1994	Anthony Giaccio	2003-2005
	1997-1998	Laura A. Coruzzi	2003-2006
Roger S. Smith	1991-1994	Daniel A. DeVito	2003-2006
John D. Murnane	1992-1995	Susan E. McGahan	2005-2006

## **SECTION 5**

*Bylaws*



## **ARTICLE I**

### **Name**

The corporation shall be called “THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.,” hereinafter called the “Association.”

## **ARTICLE II**

### **Object**

The Association is established to maintain the honor and dignity of the law of patents, trademarks and copyrights; to promote the development and administration thereof; to advance the education of the members of the bar and the public in those fields of law; and to cooperate with foreign associations in harmonizing the substance and interpretation of international conventions for the protection of intellectual property.

## **ARTICLE III**

### **Members**

SECTION 1. *Membership.* There shall be six classes of membership in the Association: Honorary, Life, Retired, Active, Associate and Student.

SECTION 2. *Honorary Members.* All judges of the United States Federal Courts in the Second Judicial Circuit, the circuit and district judges in the District of New Jersey and the judges of the United States Court of Appeals for the Federal Circuit, the Secretary of Commerce, the Commissioner of Patents and Trademarks and all other Presidential appointees to the United States Patent and Trademark Office, and the Register of Copyrights, shall be ex officio Honorary Members of the Association. The Board of Directors shall have the power from time to time to elect other persons as Honorary Members. All Honorary Members shall be entitled to all privileges, except that of voting, and shall be exempt from payment of dues.

SECTION 3. *Life Members.* Any member or former member of this Association of long standing who has achieved distinction by reason of either professional service or service to the Association and who has retired from the active practice of the law or as a patent attorney or patent agent, may by the vote of the Board of Directors be elected a Life Member. All Life Members shall be entitled to all privileges and shall be exempt from payment of dues.

SECTION 4. *Retired Members.* Any member of this Association who retires from active practice of the law or as a patent attorney or agent and who has been an Active or Associate Member in good standing for the five (5) years preceding such retirement, may transfer to “Retired Members” status by making written request for such transfer to the then Secretary or Treasurer of the Association. Retired Members shall have all of the privileges of the Association except those of voting and holding office.

SECTION 5. *Active Members.* Any lawyer admitted to practice in any state or territory of the United States, or in the District of Columbia, interested in patent, trademark or copyright law, of good character and in good standing, and having his residence or a regular and established office in the Second Judicial Circuit or in the District of New Jersey, as now fixed by law, shall be eligible for election to active membership. Active Members of this Association in good standing shall have all the privileges of the Association.

SECTION 6. *Associate Members.* Any lawyer interested in patent, trademark or copyright law, of good character and in good standing, and not having his residence or a regular and established office in the Second Judicial Circuit or in the District of New Jersey, as now fixed by law, or who shall be admitted to practice, but not in a state or territory of the United States, or in the District of Columbia, shall be eligible for election to associate membership. Associate Members shall have all the privileges of the Association except those of voting and holding office.

SECTION 7. *Student Members.* (a) Persons who are not lawyers, but are regularly enrolled as candidates for a professional law degree in a law school approved by the Association of American Law Schools



and would be otherwise qualified for membership, if a member of the Bar, or (b) persons, who are not lawyers, but have graduated with a professional law degree from a law school approved by the Association of American Law Schools within two years of graduation and would be otherwise qualified for membership, if a member of the Bar, shall be eligible for election to student membership. Student Members shall have all the privileges of the Association except those of voting and holding office. A student member may request transfer to active or associate membership upon admission to the Bar.

SECTION 8. *Admission of Members.* No person shall be admitted to active or associate membership of the Association unless he has been recommended by the Committee on Admissions and elected by the Board of Directors and has qualified by payment of dues, all in such manner as shall be provided by the Bylaws.

SECTION 9. *Transfer of Members.* Whenever any Associate Member shall change his office, lodging or dwelling in such a way as to make him eligible for Active Membership, he shall, upon his own written application, provided he be otherwise eligible for Active Membership, be transferred by the Treasurer to the Active Membership list and shall, within such time as the Treasurer may prescribe, pay the difference between the then required admission fee for Active Membership and any admission fee he may theretofore have paid to the Association. Any Active Member who shall change his office, lodging or dwelling in such a way as to make him ineligible for Active Membership shall be transferred by the Treasurer to the Associate Membership list. Any Active or Associate Member who has become eligible to be a Retired Member or has been voted by the Board of Directors to be a Life Member shall be transferred by the Treasurer to the Retired Membership list or Life Membership list as the case may be.

SECTION 10. *Election of Members.* Candidates for membership shall send to the Chairman of the Committee on Admissions their name together with their business address, and also such statements as shall be necessary to show their qualifications for membership.

It shall be the duty of the Committee to review the character and standing of the candidate, to receive and consider all communications

from members of the Association respecting the candidate, and no candidate against whom there shall be two negative votes in the Committee shall be recommended for admission. The proceedings and records of the Committee on Admissions shall be secret and confidential.

The Committee on Admissions shall report to the Board of Directors the names of those whom it recommends for membership in the Association. The Board shall vote upon the admission of such candidate, and no candidate against whom there shall be three negative votes in the Board of Directors shall be admitted. The proceedings and records of the Board of Directors in this regard shall be secret and confidential.

SECTION 11. *Dues.* The admission fees and annual dues of Active, Retired, Associate and Student Members shall be fixed from time to time by the Board of Directors at its discretion. The dues of Active, Associate, Retired and Student Members shall be payable annually at the beginning of the Association's fiscal year. In the event that dues have not been timely received by the Association for that fiscal year, the members will receive notice informing them of outstanding dues and a final deadline for payment prior to the cancellation of membership.

## **ARTICLE IV**

### **Officers**

SECTION 1. *Officers of the Association.* The officers of this Association shall be a President, a President-Elect, a First Vice President, a Second Vice President, a Secretary and a Treasurer.

SECTION 2. *Terms of Office.* The President-Elect, First Vice President, Second Vice President, Secretary and Treasurer shall each be elected to serve for a term of one year. At the expiration of the President's term of office or upon vacancy in the office of the President, the President-Elect shall automatically become and assume the duties of the President and thereupon shall vacate the office of President-Elect, except that, if that person shall have been appointed to the office of President-Elect by the Board of Directors

pursuant to Article VIII, Section 2, that person shall not automatically become and assume the office of President upon expiration of the term of President.

SECTION 3. *Duties of the President.* The President shall be the chief executive officer of the Association and shall preside at all meetings of the Association and of the Board of Directors. Subject to the control of the Board of Directors, the President shall have general supervision over the affairs of the Association and shall have such other powers and duties as chief executive officers usually have or as the Board of Directors assigns to him.

SECTION 4. *Duties of the President-Elect.* The President-Elect shall have the status of the Vice President senior in rank, shall act in the absence of the President and shall have such additional powers and duties as the Board of Directors assigns.

SECTION 5. *Duties of the First Vice President.* The First Vice President shall act in the absence of the President-Elect and shall have such additional powers and duties as the Board of Directors assigns.

SECTION 6. *Duties of the Second Vice President.* The Second Vice President shall have such powers and duties as the Board of Directors assigns.

SECTION 7. *Duties of the Secretary.* The Secretary shall keep a record of the proceedings of the meetings of the Association and of the Board of Directors and a record of all other matters of which a record shall be ordered by the Board of Directors. The Secretary shall conduct the correspondence of the Association under the direction of the President. The Secretary shall notify the officers, directors and all members of committees of their election or appointment, shall issue notices of meetings, and, in the case of stated meetings, shall add a brief note of the object of the meeting.

SECTION 8. *Duties of the Treasurer.* The Treasurer shall keep at all times a complete roll of the members, shall notify new members of their election, and shall effect transfer of members from one class of

membership to another class of membership as provided under Article III of the Bylaws. The Treasurer shall collect and, under the direction of the Board of Directors, shall disburse all funds of the Association. The Treasurer shall keep regular accounts in books belonging to the Association which shall be open to the inspection of any member of the Board of Directors and of the Auditor at all times. The Treasurer shall at the annual meeting report in writing the balance of money on hand and any existing appropriations, and shall make a full report of the receipts and disbursements of the past year, suitably classified, and of all outstanding obligations of the Association, with an estimate of the resources and probable expenses of the coming year, and the Treasurer may make any suggestion pertinent thereto that he or she may deem proper.

The Treasurer's accounts shall be audited by a Certified Public Accountant selected by the President whose report shall be filed with the Secretary prior to the annual meeting and shall be available for inspection at that time.

## **ARTICLE V**

### **Directors**

SECTION 1. *Board of Directors.* The Board of Directors shall manage the affairs of the Association subject to the Certificate of Incorporation and the Bylaws.

SECTION 2. *Composition of the Board.* The Board of Directors shall consist of all current officers of the Association, the immediate past president of the Association and nine additional directors from among the active members of the Association.

SECTION 3. *Powers of the Board.* Six members shall constitute a quorum. The Board shall have power to make such regulations and take such action, not inconsistent with the Certificate of Incorporation and Bylaws as, in its judgment, may be necessary for the welfare or to promote the objectives of the Association. All appropriations of funds of the Association must be made by this Board. It shall keep

a record of its proceedings, which shall be presented at the ensuing meeting of the Association; and at each meeting of the Association it shall report any business which in its judgment shall require the action of the Association.

SECTION 4. *Board Action Without a Meeting.* Any action required or permitted to be taken by the Board of Directors may be taken without a meeting if all of the members of the Board of Directors consent in writing to the adoption of a resolution authorizing the action.

SECTION 5. *Participation in Meeting by Telephone.* Any one or more members of the Board of Directors may participate in a meeting of the Board of Directors by means of conference telephone or similar communications equipment allowing all persons participating in the meeting to hear each other, and such participation shall constitute presence in person at the meeting.

## **ARTICLE VI**

### **Committees**

SECTION 1. *Committees of the Association.* The Committees of the Association shall include: a Committee on Patent Law and Practice, a Committee on Trademark Law and Practice, a Committee on Membership, a Committee on Meetings and Forums, a Committee on Professional Ethics and Grievances, a Nominating Committee, a Committee on Copyrights, a Committee on Publications, and a Committee on Public and Judicial Personnel. Subject to the approval of the Board, the President may distribute the duties of any Standing Committee amongst several committees to be named by him and may include duties other than those identified by the name of the Committee within the duties of a Committee.

SECTION 2. *Appointment of Committees.* Each of the Committees named, except the Nominating Committee, shall be appointed annually by the President, subject to approval of the Board of Directors, and shall consist, in addition to the Chairman, of at least four members. The term of office of each Committee Chairman shall be

set by the Board of Directors for from one to three years, subject to the provisions of Section 5 of this Article VI.

SECTION 3. *Other Committees.* The President shall have the power to appoint, from time to time, such other Committees as he shall deem appropriate.

SECTION 4. *Nominating Committee.* The Nominating Committee shall consist of five active members of the Association, at least two of whom shall be former Presidents or Vice Presidents, and shall be elected at each annual meeting to hold office until the next annual meeting, or until their successors are elected. The President shall fill any vacancies in the Nominating Committee, subject to approval of the Board of Directors. It shall be the duty of the Nominating Committee to make nominations for officers and members of the Board of Directors whose terms of office expire at the next annual meeting, and for a Nominating Committee of five for the ensuing year. Nominations shall be made from among any of the active members of the Association not then serving on the Nominating Committee. The Nominating Committee shall notify the Secretary at least 40 days before such annual meeting of the nominations it has made. The Secretary shall print and mail to all members of the Association entitled to vote, at least 30 days before such meeting, a list of the nominations made by the Nominating Committee. Any nominations other than those made by the Nominating Committee must be made by at least 5 members of the Association and submitted to the Secretary in writing not less than 10 days prior to the annual meeting, and the Secretary shall mail such to all members entitled to vote at least 5 days before the meeting. In case of any vacancy in the nominations, the Nominating Committee may fill the vacancy by a later nomination to be notified to the Secretary at least 6 days before the meeting, and notice thereof to be mailed by the Secretary to all members entitled to vote at least 3 days before the meeting.

SECTION 5. *Committee on Professional Ethics and Grievances.* The Committee on Professional Ethics and Grievances shall consist of 7 members including a chairman, all of whom shall be former members of the Board of Directors. Promptly after the annual meeting in each year the President shall appoint a chairman for a one-year term

and two members for three-year terms, said terms to expire at the annual meetings, and at any time he may fill any vacancy occurring in the Committee, subject to approval of the Board of Directors. The President shall be an ex officio but non-voting member of the Committee and may, at the invitation of the chairman of the Committee, attend its meetings and be privy to its deliberations. The duties and functions of, and the procedures to be followed by, the Committee on Professional Ethics and Grievances shall be set forth in the following subsections of this Bylaw:

(a) The Committee shall receive all inquiries relating to the professional ethics of activities proposed or conducted by a member, may answer such inquiries and may publish such inquiries and answers in such general terms as the Committee, in its absolute discretion, may consider to be in the interest of the membership.

(b) The Committee on its own initiative, or on any complaint it may receive, may investigate the professional conduct of any member other than misconduct in his relations to the Association, and of any non-member who may be conducting from or in the Southern or Eastern Federal Judicial Districts of New York any business or practice affecting patent, trademark, copyright or related matters. The Committee may determine that the investigation shall be discontinued and the complaint, if any, dismissed, or it may determine that the matter shall be further investigated and a hearing held by the Committee or by a Subcommittee of at least 3 members of the Committee or, excepting in matters which relate solely to patent practice before the United States Patent and Trademark Office, it may find with or without a hearing that the matter should be referred to an appropriate disciplinary committee of the general bar. Any such hearing shall be conducted in such manner that the person complained of, as respondent, shall be given reasonable notice of the hearing and the contents of the complaint, and shall have full opportunity to plead, present evidence and be represented by counsel at the hearing. If the hearing is conducted by a Subcommittee, the Subcommittee shall report its findings to the Committee.

(c) If a majority of the Committee shall find that the respondent has been guilty of professional misconduct, a copy of the findings shall be sent to the respondent, and the Committee shall determine whether to refer its findings, with the approval of the President, to an appropriate disciplinary committee of the general bar, or to the Commissioner of Patents and Trademarks, or both, and in the event that the Committee's findings are referred to the Commissioner of Patents and Trademarks, the Committee, or a Subcommittee thereof, shall prepare and prosecute with the further approval of the President a complaint against the respondent to the Commissioner of Patents and Trademarks for disbarment or other disciplinary action by the United States Patent and Trademark Office. If the respondent is a member, the Committee may institute proceedings for expulsion or suspension of the member under Article IX of these Bylaws.

(d) Members of the Association summoned by the Committee or Subcommittee to testify at any hearing held under the provisions of Subsection (b) shall be bound to appear and testify. In the event that any member refuses to appear or testify at any such hearing and presents no reason therefor which, in the judgment of the Board of Directors, is satisfactory, such member shall be subject to suspension or expulsion by the Board of Directors under Article IX of these Bylaws, but proceedings under this Subsection (d) except final action taken by the Board shall be secret.

(e)(1) All proceedings under Subsections (b) and (c) of Section 5 (except proceedings referred to in paragraph (2) hereof) shall be secret, except that a matter which has been referred to or discussed with a disciplinary committee of the general bar shall be released from secrecy when said disciplinary committee has itself been released from secrecy with respect thereto either by operation of law, by court order, or in any other way.

(e)(2) Unless otherwise ordered by the Board of Directors, all proceedings under Subsections (b) and (c) of this Section 5, to the extent that they relate solely to practice in patent matters before the United States Patent and Trademark Office, shall be secret until a final order imposing discipline has been entered by the Commissioner of



Patents and Trademarks, except that the Committee on Professional Ethics and Grievances may, if it deems such action desirable to the proper coordination of action by the bar, exchange information with corresponding committees of other bar associations as to the general nature and status of proceedings now or formerly before it involving the same complainant, the same respondent, or the same or similar subject matter, when such corresponding committees represent that they operate under a like or equivalent rule of secrecy.

SECTION 6. *Committee Duties.* All Committees shall report from time to time to the Board of Directors, or to the Association whenever requested to do so by the Board or by the Association. The Board shall have the duty of taking such steps as may be appropriate to make effective the final action of the Association on the subject matter of the Committee reports. A Committee shall not take any action on behalf of the Association and shall not release its report to the public or advise the public of its recommendation without first obtaining favorable Board action thereon, but subject to the provisions of Section 5 of this Article VI, the report and recommendation of a Committee shall be available to any member of the Association. Final action, for and on behalf of the Association, may be taken by the Board on any Committee report. The chairman of any Committee, other than the Chairman of the Nominating Committee and the Chairman of the Ethics and Grievances Committee, may designate a task group comprising himself and not less than three other members of his Committee to act for the full Committee on any matter and may report the work of the group so designated to the Board of Directors as the report of the Committee without review of such report by all the members of the Committee. A copy of any task group report shall be provided to all members of the Committee upon the preparation thereof.

## **ARTICLE VII**

### **Meetings of the Association**

SECTION 1. *Stated and Annual Meeting.* All business requiring a vote of the Association's membership shall be conducted only at a stated meeting of the Association. The annual meeting of the Association shall be a stated meeting held at such place in New York, New York as the Board of Directors may select on the fourth

Thursday of May each year or on such other date within one month thereof as the Board of Directors may establish and give notice of to the membership as provided in Section 2 of this Article VII. Other stated meetings of the Association may be held from time to time on the call of the President or Secretary or of any three members of the Board of Directors or of any fifteen Members of the Association entitled to vote.

SECTION 2. *Notice.* Written notice of each stated meeting of the Association shall be given by first class mail not less than 30 days nor more than 50 days before the date of each meeting and shall state place, date, and hour of the meeting and, if for a special meeting, shall also state the purpose or purposes for which the meeting is called.

SECTION 3. *Time of Meeting.* Meetings of the Board of Directors shall be held (1) immediately after the annual meeting of the Association and (2) thereafter upon the call of the President or the Secretary or any three members of the Board.

SECTION 4. *Voting.* Except as otherwise provided by law and in Article VIII, Section 1, the transaction of business at any stated meeting of the Association shall be authorized by a majority of the votes cast by members of the Association entitled to vote, present in person or by proxy. In the case of a tie, the presiding officer shall cast the deciding vote.

SECTION 5. *Proxies.* At least 30 days before each stated meeting of the Association the Secretary shall mail a blank form of proxy to each member entitled to vote. Proxies shall be recognized only if held by a member entitled to vote or by the President or Secretary of the Association.

SECTION 6. *Quorum.* At any stated meeting of the Association, the presence in person or by proxy of members entitled to cast the lesser of 100 votes or one-tenth of the total number of votes entitled to be cast at the meeting shall constitute a quorum for the transaction of any business which may lawfully come before the meeting unless a greater quorum is required by law.

SECTION 7. *Presiding Officer.* At all stated meetings of the Association the President shall preside, or in his absence the ranking officer, in the order listed in Article IV, Section 1, or any member of the Board of Directors in the absence of all officers, or, in the absence of all members of the Board of Directors, any member selected by the meeting.

SECTION 8. *Order of Business.* At each annual meeting of the Association the order of business shall be as follows:

1. Reading of Minutes of preceding meeting.
2. Report of Board of Directors.
3. Report of Treasurer.
4. Report of Auditor.
5. Report of the Committees.
6. Unfinished business.
7. Elections.
8. Installation of newly elected officers and directors.

## **ARTICLE VIII**

### **Elections**

SECTION 1. *Elections of Officers and Directors.* At each annual meeting of the Association, a President-Elect, First Vice President, Second Vice President, Secretary and Treasurer shall be elected for a term of one year and three directors shall be elected for terms of three years. Additional directors shall be elected as necessary to fill the remainder of any vacated terms. All elections shall be by a plurality of ballots cast. The officers and directors elected shall enter

upon their duties immediately upon their election, and, immediately following their election, the President-Elect elected at the preceding annual meeting shall become and assume the duties of the President. The officers and directors of the Association shall hold their respective offices from the date of their election until their successors are elected and have qualified.

SECTION 2. *Vacancies.* In case of a vacancy in any office other than President, President-Elect, or on the Board of Directors, such vacancy shall be filled for the term until the next annual meeting by a vote of a majority of the directors then in office. A vacancy in the office of President shall be filled pursuant to Section 2 of Article IV. A vacancy in the office of President-Elect shall be filled by the Association at a meeting called for that purpose by the Board of Directors promptly after the vacancy occurs.

## **ARTICLE IX**

### **Suspensions and Expulsions**

SECTION 1. *Suspension and Expulsion of Members.* Any member of the Association may be suspended or expelled for misconduct in his relation to this Association or in this profession, on conviction thereof pursuant to the procedures described herein.

Any officer may be suspended and any director may be removed from office by a vote of two-thirds of all members of the Board of Directors for failure or refusal to perform his duties properly or for conduct tending to bring the Association into disrepute. Absence of a Director from three consecutive meetings may be deemed by the Board of Directors the failure to perform his duties properly.

SECTION 2. *Complaint.* Complaint against a member of the Association for misconduct in his relations to the Association may be made by any member to the Board of Directors. Every such complaint shall be in writing subscribed by the complaining party and shall state plainly the matter complained of. If the Board of Directors shall deem such complaint of sufficient importance, it shall cause a copy thereof,

together with a notice of the time and place where the Board of Directors or a Subcommittee of not less than three members appointed by it, will meet for the consideration thereof, to be served upon the member complained against and to be mailed to the complainant at least five days before the meeting. At the time and place appointed, the Board of Directors or the Subcommittee shall proceed to the hearing of the case under such regulations as the Board of Directors may approve. The Board of Directors by the affirmative vote of at least ten of its members, all of whom must have heard the case, or by adopting the unanimous vote of its Subcommittee as aforesaid, may find the accused member to be guilty of the charge against him and may adjudge that he be expelled or suspended. But the expulsion or suspension by the Board of Directors shall not become effective until thirty days after such action shall have been taken and may be set aside by the Association at a stated meeting or a special meeting duly called for such purpose.

SECTION 3. *Disbarment or Suspension from Practice.* Any member of the Association who shall be disbarred or suspended from practice, or who shall be convicted of a felony, may be suspended or expelled from the Association by the affirmative vote of a majority of the Board of Directors. The disbarment, conviction and suspension from practice herein referred to shall include disbarment, suspension or conviction, by any court, State or Federal, or by the Patent and Trademark Office.

## **ARTICLE X**

### **Property**

All interest in the Association of persons resigning or otherwise ceasing to be members shall vest in the Association.

## **ARTICLE XI**

### **Amendments**

The Bylaws may be amended, but only by a two-thirds vote of the members entitled to vote present in person or by proxy at an annual meeting of the Association, or at a stated meeting called in

accordance with the provisions of these Bylaws after notice mailed ten days before the meeting to each Active Member of the Association, such notice to contain a copy of the proposed amendment with a precise statement of the purpose thereof. The Association shall not pay the expenses of any such notice unless the proposed amendment has been approved by the Board of Directors.

Upon the consideration of any proposed amendment, amendments thereof germane thereto may be offered and voted upon at this meeting.

## **SECTION 6**

*Rules on Admission*





In furtherance of the provision of the Bylaws of this Association, and resolutions of the Board of Directors adopted May 26, 1977, the Committee on Admissions has adopted the following rules:

**RULE 1.** Meetings of the Committee on Admission shall be held at the call of the Chairman.

**RULE 2.** Applications for membership must be made on an application provided by the Association and must be signed by the candidate.

**RULE 3.** (a) The Chairman shall promptly inform the Secretary of the Association of the name and address of the applicant, so that the applicant may be placed on the Association's mailing list without delay.

(b) The Chairman shall promptly notify the Committee of the name and address of the applicant, along with notice that objections to the election of the applicant may be sent to the Chairman within ten (10) days next following the mailing of said notification.

(c) If no objection is received by the Chairman within fourteen (14) days next following the mailing of said notification, the applicant shall be deemed recommended by the Committee for membership in the Association.

(d) If any such objection is received, the Chairman shall promptly call a meeting of the Committee to consider the application of the applicant to which objection has been made in accordance with Section 10 of the Bylaws.

(e) In the absence of objection or, in the event of objection, following a favorable vote of the Committee in accordance with Section 10 of the Bylaws, the Chairman shall promptly report to the Board of Directors the names of the applicants recommended by the Committee for membership in the Association.

## **Guidelines for Life Membership.\***

Any former officer of this Association who has retired from the active practice of law shall be elected a life member upon his application or upon the duly seconded motion of any member of the Board of Directors. A former member of the Board of Directors or a former chairman of any Committee of the Association who has retired from active practice shall be elected a life member upon his application if a majority of the Board of Directors shall deem that he has devoted an exceptional amount of time to the affairs of the Association.

An application for life membership should include all the qualifications of the proposed member.

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\* Adopted October 16, 1973.

# **SECTION 7**

*Members*



# Honorary Members

All judges of the United States Federal Courts in the Second Judicial Circuit, the circuit and district judges in the District of New Jersey and the judges of the U.S. Court of Appeals for the Federal Circuit, the Secretary of Commerce, the Commissioner of Patents and Trademarks, the Register of Copyrights, and other persons so elected (By-laws, Article III, Section 2).

## Second Circuit-Court of Appeals

Jacobs, Dennis G., Chief Judge	New York, NY
Cabranes, José A.	New Haven, CT
Calabresi, Guido	New Haven, CT
Hall, Peter W.	Rutland, VT
Katzmann, Robert A.	New York, NY
Parker, Barrington D., Jr.	New York, NY
Pooler, Rosemary S.	Syracuse, NY
Raggi, Reena	Brooklyn, NY
Sack, Robert D.	New York, NY
Sotomayor, Sonia	New York, NY
Straub, Chester J.	New York, NY
Wesley, Richard C.	Geneseo, NY

## Senior Circuit Judges

Cardamone, Richard J.	Utica, NY
Feinberg, Wilfred	New York, NY
Kearse, Amalya Lyle	New York, NY
Leval, Pierre N.	New York, NY
McLaughlin, Joseph M.	New York, NY
Meskill, Thomas J.	New Britain, CT
Miner, Roger J.	Albany, NY
Newman, Jon O.	Hartford, CT
Oakes, James L.	Brattleboro, VT
Walker, John M., Jr.	New Haven, CT
Winter, Ralph K., Jr.	New Haven, CT

## District Court, Connecticut

Chatigny, Robert N., Chief Judge	Hartford, CT
Arterton, Janet Bond	New Haven, CT
Droney, Christopher F.	Hartford, CT
Hall, Janet C.	Bridgeport, CT
Kravitz, Mark R.	New Haven, CT
Squatrito, Dominick J.	Hartford, CT
Thompson, Alvin W.	Hartford, CT
Underhill, Stefan R.	Bridgeport, CT

————— **District Court, New York (Northern)** —————

Mordue, Norman A., Chief Judge	Syracuse, NY
Hurd, David N.	Utica, NY
Kahn, Lawrence E.	Albany, NY
Sharpe, Gary L.	Syracuse, NY

————— **District Court, New York (Eastern)** —————

Korman, Edward R., Chief Judge	Brooklyn, NY
Amon, Carol Bagley	Brooklyn, NY
Bianco, Joseph	Brooklyn, NY
Cogan, Brian M..	Brooklyn, NY
Dearie, Raymond J.	Brooklyn, NY
Feuerstein, Sandra J.	Brooklyn, NY
Garaufis, Nicholas G.	Brooklyn, NY
Gershon, Nina	Brooklyn, NY
Gleeson, John	Brooklyn, NY
Irizarry, Dora L.	Brooklyn, NY
Ross, Allyne R.	Brooklyn, NY
Seybert, Joanna	Central Islip, NY
Townes Sandra L.	Brooklyn, NY
Vitaliano, Eric	Brooklyn, NY

————— **District Court, New York (Southern)** —————

Wood, Kimba M., Chief Judge	New York, NY
Batts, Debroah A.	New York, NY
Berman, Richard M.	New York, NY
Briant, Charles L., Jr.	White Plains, NY
Buchwald, Naomi Rice	New York, NY
Casey, Richard Conway	New York, NY
Castel, P. Kevin	New York, NY
Chin, Denny	New York, NY
Cote, Denise L.	New York, NY
Crotty, Paul	New York, NY
Daniels, George B.	New York, NY
Hellerstein, Alvin K.	New York, NY
Holwell, Richard J.	New York, NY
Jones, Barbara S.	New York, NY
Kaplan, Lewis A.	New York, NY
Karas, Kenneth M.	New York, NY
Koeltl, John G.	New York, NY
Lynch, Gerard E.	New York, NY
Marrero, Victor	New York, NY
McMahon, Colleen	White Plains, NY

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**District Court, New York (Southern)**

Pauley III, William H.	New York, NY
Preska, Loretta A.	New York, NY
Rakoff, Jed S.	New York, NY
Robinson, Stephen C.	White Plains, NY
Scheidlin, Shira A.	New York, NY
Stein, Sidney H.	New York, NY
Swain, Laura Taylor	New York, NY

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**District Court, New York (Western)**

Arcara, Richard J., Chief Judge	Buffalo, NY
Larimer, David G.	Rochester, NY
Siragusa, Charles J.	Rochester, NY
Skretny, William M.	Buffalo, NY

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**District Court, Vermont**

Sessions III, William K., Chief Judge	Burlington, VT
Murtha, J. Garvan,	Brattleboro, VT

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**Senior District Judges**

Baer, Harold, Jr.	New York, NY
Block, Frederic	Brooklyn, NY
Burns, Ellen Bree	New Haven, CT
Carter, Robert L.	New York, NY
Cedarbaum, Miriam Goldman	New York, NY
Conner, William C.	White Plains, NY
Covello, Alfred V.	Hartford, CT
Curtin, John T.	Buffalo, NY
Dorsey, Peter C.	New Haven, CT
Duffy, Kevin Thomas	New York, NY
Eginton, Warren W.	Bridgeport, CT
Elfvin, John T.	Buffalo, NY
Glasser, Israel Leo	Brooklyn, NY
Griasa, Thomas P.	New York, NY
Haight, Charles S., Jr.	New York, NY
Hurley, Denis R.	Central Islip, NY
Johnson, Sterling, Jr.	Brooklyn, NY
Keenan, John F.	New York, NY
Kram, Shirley Wohl	New York, NY

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Leisure, Peter K.	New York, NY
McAvoy, Thomas J.	Binghamton, NY
McCurn, Neal P.	Syracuse, NY
McKenna, Lawrence M.	New York, NY
Munson, Howard G.	Syracuse, NY
Nevas, Alan H.	Bridgeport, CT
Owen, Richard	New York, NY
Patterson, Robert P., Jr.	New York, NY
Platt, Thomas C., Jr.	Central Islip, NY
Scullin, Frederick J., Jr.,	Syracuse, NY
Sand, Leonard B.	New York, NY
Sifton, Charles P.	Brooklyn, NY
Spatt, Arthur D.	Central Islip, NY
Sprizzo, John E.	New York, NY
Stanton, Louis L.	New York, NY
Sweet, Robert W.	New York, NY
Telesca, Michael A.	Rochester, NY
Trager, David G.	Brooklyn, NY
Weinstein, Jack B.	Brooklyn, NY
Wexler, Leonard D.	Central Islip, NY

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### Third Circuit-Court of Appeals

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Scirica, Anthony J., Chief Judge	Philadelphia, PA
Ambro, Thomas L.	Wilmington, DE
Barry, Maryanne Trump	Newark, NJ
Chagares, Michael	Newark, NJ
Fisher, D. Michael	Pittsburgh, PA
Fuentes, Julio M.	Newark, NJ
Jordan, Kent A.	Wilmington, DE
McKee, Theodore Alexander	Philadelphia, PA
Rendell, Marjorie O.	Philadelphia, PA
Sloviter, Dolores Korman	Philadelphia, PA
Smith, David Brooks	Pittsburgh, PA

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### Senior Circuit Judges

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Aldisert, Ruggero J.	Santa Barbara, CA
Cowen, Robert E.	Trenton, NJ
Garth, Leonard I.	Newark, NJ
Greenberg, Morton I.	Trenton, NJ
Nygaard, Richard Lowell	Erie, PA
Roth, Jane R.	Wilmington, DE
Stapleton, Walter K.	Wilmington, DE
Van Antwerpen, Franklin S.	Philadelphia, PA
Weis, Joseph F., Jr.	Pittsburgh, PA



————— **District Court, New Jersey** —————

Brown, Garrett E., Chief Judge	Trenton, NJ
Bumb, Renee Marie	Camden, NJ
Cavanaugh, Dennis M.	Newark, NJ
Chesler, Stanley R.	Trenton, NJ
Cooper, Mary Little	Trenton, NJ
Greenaway, Joseph A., Jr.	Newark, NJ
Hayden, Katharine S.	Newark, NJ
Hillman, Noel L.	Camden, NJ
Hochberg, Faith S.	Newark, NJ
Kugler, Robert B	Camden, NJ
Linares, Jose L.	Newark, NJ
Martini, William J.	Newark, NJ
Pisano, Joel A.	Camden, NJ
Sheridan, Peter	Newark, NJ
Simandle, Jerome B.	Camden, NJ
Wigenton, Susan	Newark, NJ
Wolfson, Freda L.	Camden, NJ

————— **Senior District Judges** —————

Ackerman, Harold A.	Newark, NJ
Brotman, Stanley S.	Camden, NJ
Debevoise, Dickinson R.	Newark, NJ
Irenas, Joseph E.	Camden, NJ
Lifland, John C.	Newark, NJ
Rodriguez, Joseph H.	Camden, NJ
Thompson, Anne E.	Trenton, NJ
Walls, William H.	Newark, NJ

————— **Federal Circuit-Court of Appeals** —————

Michel, Paul R., Chief Judge	Washington, DC
Bryson, William C.	Washington, DC
Dyk, Timothy B.	Washington, DC
Gajarsa, Arthur J.	Washington, DC
Linn, Richard	Washington, DC
Lourie, Alan D.	Washington, DC
Mayer, H. Robert	Washington, DC
Moore, Kimberly	Washington, DC
Newman, Pauline	Washington, DC
Prost, Sharon	Washington, DC
Rader, Randall R.	Washington, DC
Schall, Alvin A.	Washington, DC

————— **Senior Circuit Judges** —————

Archer, Glen L., Jr.	Washington, DC
Clevenger III, Raymond C.	Washington, DC
Friedman, Daniel M.	Washington, DC
Plager, S. Jay	Washington, DC

————— **Secretary of Commerce** —————

Carlos M. Gutierrez	Washington, DC
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————— **Under Secretary of Commerce  
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# **PART II**

## **THE ASSOCIATION PAPERS**



# **NYIPLA**

**Proposed Local Patent Rules**

**for the**

**U.S. District Court**

**for the**

**Southern District of New York**

Nineteen  
Hundred and Twenty-two

**NYIPLA**

The New York Intellectual Property Law Association

Starting August 8th, 2006, the U.S. District Court for the Southern District of New York began considering a set of specialized rules proposed by the NYIPLA for use in patent cases which are brought in that Court (“Proposed Rules”). Then Chief Judge Mukasey sent the following email to all the Judges of the Court: “As mentioned at our last Board of Judges meeting, I am circulating for your use a set of rules for patent cases proposed by the New York Intellectual Property Law Association. They are optional and can be adapted in whatever fashion you think is useful.”

These Proposed Rules were developed over time by a task force initially assembled two years ago by the Board of Directors. The Proposed Rules take into consideration (but vary from) other local patent rules adopted by other district courts, including the District Courts for the Northern District of California, the Northern District of Georgia and the Western District of Pennsylvania. After several months, many meetings, and many revisions, and much input from many members of this association, the NYIPLA Board proposed Rules which it believes provide an ideal framework for litigating patent cases as both a patentee and accused infringer.

For instance, the Proposed Rules provide procedures for exchanging, along with the automatic initial disclosures required by Fed. R. Civ. P. 26(a)(1), documents particularly relevant to patent cases, such as those relating to on sale, the patents-in-suit, their file histories, the accused devices and prior art. The Proposed Rules further require a patentee to disclose automatically its infringement contentions, along with supporting documentation, as well as an accused party to disclose automatically its invalidity contentions and supporting documentation.

In addition, the Proposed Rules contain procedures for effectively managing the “Markman Hearing” process by, for instance, providing a schedule for the exchange of proposed claim constructions, for the preparation of a joint claim terms chart, and for the filing of claim construction briefs. Other issues peculiar to patent cases, such as willfulness and waiver, and the exchange of expert reports, are also addressed.

In short, the NYIPLA’s Proposed Rules will make patent cases much more manageable for the Court and more predictable for the litigants, ultimately streamlining patent cases, and reducing costs for all parties involved. We hope the Judges of the Southern District, and parties before the Court, use our Proposed Rules and achieve these results.



**UNITED STATES DISTRICT COURT FOR  
THE SOUTHERN DISTRICT OF NEW YORK**

**PROPOSED LOCAL PATENT RULES**

**1. SCOPE OF RULES**

**LPR 1.1. Title.**

These are the Proposed Local Rules of Practice for Patent Cases before the United States District Court for the Southern District of New York. They should be cited as “LPR \_\_\_.”

**LPR 1.2. Objective.**

These proposed rules are intended to facilitate the speedy, fair and efficient resolution of patent disputes. The Local Civil Rules of this Court shall also apply to these actions, except to the extent that they are inconsistent with these Proposed Local Patent Rules. The Court may accelerate, extend, eliminate, or modify the obligations or deadlines set forth in these Proposed Local Patent Rules based on the circumstances of any particular case, including, without limitation, the complexity of the case or the number of patents, claims, products, or parties involved. If a party believes the Proposed Local Patent Rules require modification, or should not be followed, the party must file a written motion with the Court specifically identifying the Local Patent Rule, the proposed modification and the reason for said modification.

**LPR 1.3. Effective Date.**

These Proposed Local Patent Rules shall take effect on July 1, 2006. Relevant provisions of these Rules may be applied to any pending case by the Court, on its own motion or on motion by any party after a meet and confer.

**LPR 1.4. Privilege and Work Product.**

These Proposed Local Patent Rules are not intended to supersede a party’s right to assert the attorney-client privilege or work product immunity, and required production hereunder shall be subject to a party’s right to claim such privilege or work product immunity.

**2. GENERAL PROVISIONS**

**LPR 2.1. Governing Procedure.**

**Initial Scheduling Conference (“ISC”).** When the parties confer with each other pursuant to Fed. R. Civ. P. 26(f), in addition to the matters covered by Fed. R. Civ. P. 26, the parties must discuss and address in the statement filed pursuant to Fed. R. Civ. P. 26(f), the following topics:

- (a) Proposed modification of the deadlines provided for in these Proposed Local Patent Rules and/or set forth in the Court’s Scheduling Order (see Model

Scheduling Order at Appendix “A” for types of deadlines that might be included) and the effect of any such modification on the date and time of the Claim Construction Hearing, if any;

(b) The need for and any specific procedures or limits on discovery relating to claim construction, including depositions of witnesses, including expert witnesses;

(c) A brief description of the technology at issue, and whether the Court should consider the use of a Special Master for technical assistance;

(d) The prospects for settlement; and

(e) The need for a protective order and the submission of a proposed joint protective order, specifically identifying any issues upon which the parties cannot agree, and which the Court should address at the ISC. The parties shall not be relieved of their obligations to produce documents or other information under these Proposed Local Patent Rules or the Federal Rules of Civil Procedure pending resolution of any disputes regarding, or entry by the Court of, an appropriate protective order. In such instances, all documents and information so produced before the entry of an appropriate protective order shall be limited to review by outside counsel of record only if so designated by the producing party, until such time as the protective order is entered.

**LPR 2.2. Certification of Initial Disclosures.**

All statements, disclosures, or charts filed or served in accordance with these Proposed Local Patent Rules must be dated and signed by counsel of record (or by the party if unrepresented by counsel) pursuant to Rules 11 and 26(g) of the Federal Rules of Civil Procedure.

**LPR 2.3. Admissibility of Disclosures.**

Except as hereinafter provided, statements, disclosures, or charts governed by these Proposed Local Patent Rules are admissible to the extent permitted by the Federal Rules of Evidence or Procedure. However, the statements or disclosures provided for in LPR 4.1 and 4.2 are not admissible for any purpose other than in connection with motions seeking an extension or modification of the time periods within which actions contemplated by these Proposed Local Patent Rules must be taken.

**LPR 2.4. Relationship to Federal Rules of Civil Procedure.**

Except as provided in this paragraph, other rules of this Court, or as otherwise ordered, it shall not be a legitimate ground for objecting to an opposing party’s discovery request (e.g., interrogatory, document request, deposition question) or request for admission, or declining to provide information otherwise required to be disclosed pursuant to Fed. R. Civ. P. 26(a)(1), that the discovery request, request for admission or disclosure requirement is premature in light of or otherwise conflicts with, these Proposed Local Patent Rules. A party may object, however, to

the following categories of discovery requests or requests to admit (or decline to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) on the ground that they are premature in light of the timetable provided in the Proposed Local Patent Rules:

- (a) Requests seeking to elicit a party's claim construction position;
- (b) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, device, process, method, act, or other instrumentality; and
- (c) Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art.

Where a party properly objects to a discovery request (or declines to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) as set forth above, that party shall provide the requested information on the date on which it is required to provide the requested information to an opposing party under these Proposed Local Patent Rules, unless there exists another legitimate ground for objection.

The parties are reminded that the obligations under Fed. R. Civ. P. 26(e) to supplement disclosure and discovery responses shall apply to all disclosures required under these Proposed Local Patent Rules.

### **LPR 2.5. Modification of Scheduling Order.**

At any time prior to the end of expert discovery, the parties may jointly seek modification of the scheduling order and, if the parties cannot agree, the Court may amend the schedule on motion upon a showing of good cause.

## **3. PATENT INITIAL DISCLOSURES**

### **LPR 3.1. Initial Disclosures.**

Along with the initial disclosures required by Fed. R. Civ. P. 26(a)(1) ("Initial Disclosures"),

- (a) The party asserting a claim of patent infringement shall produce or make available for inspection and copying, among other items:

- (1) All documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreement, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell or other manner of transfer, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102;

(2) All documents constituting communications to and from the U.S. Patent Office for each patent in suit and for each patent or application on which a claim for priority is based; and

(3) Documents evidencing the accused aspects or elements of each accused apparatus, product, device, process, method, act or other instrumentality (“Accused Instrumentality”) which form the basis for the allegations of infringement.

The producing party shall, within thirty (30) calendar days of production, separately identify by production number which documents correspond to each above category.

(b) With the Initial Disclosures of the party opposing a claim of patent infringement, such party shall produce or make available for inspection and copying:

(1) Publicly accessible documentation sufficient to show the operation of any accused aspects or elements of each accused apparatus, product, device, process, method or other instrumentality identified explicitly (by name, product number, or other specific designation) in the pleading of the party asserting patent infringement. In instances, however, where the pleading contains only a general allegation of infringement by product or class of products and fails to contain a detailed allegation of the specific aspects or elements of each Accused Instrumentality, then this subpart (b)(1) shall not apply; and

(2) A copy of each item of prior art, of which the opposing party is aware, that allegedly anticipates or renders obvious each asserted patent claim.

### **LPR 3.2. Disclosure of Asserted Claims and Infringement Contentions.**

Not later than thirty (30) calendar days after the Initial Scheduling Conference, a party claiming patent infringement must serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.” Separately for each opposing party, the “Disclosure of Asserted Claims and Infringement Contentions” shall contain the following information:

(a) Identification of each claim of each patent in suit that is allegedly infringed by each opposing party;

(b) Separately for each asserted claim identified in part (a) above, identification of each Accused Instrumentality of each opposing party of which the party claiming infringement is aware. This identification shall specify and shall include at least identification of the Accused Instrumentality and all accused aspects or elements thereof;

(c) A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(6), a description of the claimed function of that

element and the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality, and if present under the doctrine of equivalents, the asserting party shall also explain why it contends that any differences are not substantial;

(e) Separately for each asserted claim identified in part (a) above, identify the earliest invention date to which each such asserted claim allegedly is entitled, the basis therefor, and identify all documents evidencing the conception and reduction to practice of each claimed invention, which were created on or before the date of application for the patent in suit or a priority date otherwise identified for the patent in suit, whichever is earlier; and

(f) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality.

### **LPR 3.3. Document Production Accompanying Disclosure.**

With the “Disclosure of Asserted Claims and Infringement Contentions,” the party claiming patent infringement shall supplement its Initial Disclosures, if applicable, and, to the extent not previously produced by any party, shall produce to the other party all documents supporting the asserting party’s Disclosure of Asserted Claims and Infringement Contentions under LPR 3.2(b) above.

### **LPR 3.4. Invalidity Contentions.**

Not later than thirty (30) calendar days after service upon it of the “Disclosure of Asserted Claims and Infringement Contentions,” each party opposing a claim of patent infringement, shall serve upon all parties its “Invalidity Contentions.” Invalidity Contentions shall contain the following information:

(a) The identity of each item of prior art that a party then contends allegedly anticipates or renders obvious each asserted claim. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances

under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

(b) Whether each item of prior art allegedly anticipates each asserted claim or renders it obvious. If a combination of items of prior art allegedly makes a claim obvious, each such combination, and the motivation to combine such items, must be identified;

(c) A chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element that such party contends is governed by 35 U.S.C. § 112(6), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and

(d) Any grounds of invalidity under 35 U.S.C. § 112 of any of the asserted claims.

**LPR 3.5. Document Production Accompanying Invalidity Contentions.**

With the “Invalidity Contentions,” the party opposing a claim of patent infringement shall supplement its Initial Disclosures, if applicable, and shall produce to the asserting party, to the extent not previously produced by any party, all documents supporting the opposing party’s Invalidity Contentions under LPR 3.4(a) above.

**LPR 3.6. Disclosure Requirement in Patent Cases Initiated by Declaratory Judgment.**

(a) **Invalidity Contentions If No Claim of Infringement.** In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable, LPR 3.2 and 3.3 shall not apply unless and until a claim for patent infringement is made by a party. If the defendant does not assert a claim for patent infringement in its answer to the complaint, no later than thirty (30) calendar days after the Initial Scheduling Conference, the party seeking a declaratory judgment must serve upon each opposing party its Invalidity Contentions that conform to LPR 3.4 and produce or make available for inspection and copying the documentation described in LPR 3.5.

(b) **Inapplicability of Rule.** This LPR 3.6 shall not apply to cases in which a claim for a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable is filed in a pleading or counterclaim filed in response to a complaint filed in this Court for infringement of the same patent.

**LPR 3.7. Amendment to Contentions.**

(a) Amendments, supplementations, or modifications of the Infringement Contentions or the Invalidity Contentions are permissible, subject to other applicable rules of

procedure and disclosure requirements, if made in a timely fashion and asserted in good faith and without purpose of delay. The Court's ruling on claim construction may support a timely amendment, supplementation, or modification of the Infringement Contentions or the Invalidity Contentions.

(b) In addition to the permissible amendments, supplementations, or modifications under LPR 3.7(a) above, unless a party's Contentions are Final under LPR 3.7(c), a party must amend, supplement, or modify its Infringement or Invalidity Contentions within sixty (60) days of the occurrence of any of the following events:

- (1) the discovery that such party's contentions are substantially erroneous or deficient;
- (2) a determination that new prior art or evidence supports an invalidity contention; or
- (3) the discovery of a new Accused Instrumentality.

(c) Each party's Infringement and Invalidity Contentions, whether or not amended, supplemented, or modified under this LPR 3.7, shall be deemed that Party's Final Contentions automatically sixty (60) calendar days after the Court's Final ruling on claim construction. No changes shall be made to any Party's Final Contentions without leave of Court and then only for good cause shown.

### **LPR 3.8. Willfulness or Exceptional Case.**

Unless a later date of production is selected by the Court (due to bifurcation of willfulness or any other reason), not later than thirty (30) calendar days after service by the Court of its final ruling on dispositive motions, each party opposing a claim of patent infringement that will rely on an opinion of counsel as part of a defense to a claim of willful infringement or that a case is exceptional shall:

(a) Produce or make available for inspection and copying the opinion(s) and any other documents relating to the opinion(s) as to which that party agrees the attorney-client or work product protection has been waived; and

(b) Serve a privilege log identifying any other documents which the party is withholding on the grounds of attorney-client privilege or work product protection.

A party opposing a claim of patent infringement who does not comply with the requirements provided for in LPR 3.8 shall not be permitted to rely on an opinion of counsel as part of a defense to a claim that infringement was willful or a case was exceptional absent a stipulation of all parties or by order of the Court, which shall be entered only upon a showing of good cause.

#### **4. CLAIM CONSTRUCTION PROCEEDINGS**

##### **LPR 4.1. Exchange of Proposed Constructions for Claim Terms and Phrases.**

Not later than forty-five (45) calendar days after service of the Invalidity Contentions pursuant to LPR 3.4, each party shall simultaneously exchange a list of claim terms and phrases, and proposed constructions for each, which that party contends should be construed by the Court, and identify any claim element which that party contends should be governed by 35 U.S.C. § 112(6).

##### **LPR 4.2. Preparation and Filing of Joint Disputed Claim Terms Chart.**

Not later than seven (7) calendar days after the exchange set forth in LPR 4.1, the parties shall meet and confer to identify claim terms and phrases that are in dispute, and claim terms and phrases that are not in dispute. Not later than ten (10) calendar days after the meet and confer, the parties shall prepare and file a Joint Disputed Claim Terms Chart listing claim terms and phrases, and each party's proposed construction, for each disputed claim term and phrase, asserted by each party.

##### **LPR 4.3. Claim Construction Briefing and Extrinsic Evidence.**

(a) Not later than thirty (30) calendar days after filing of the Joint Disputed Claim Terms Chart pursuant to LPR 4.2, the party asserting infringement, unless otherwise stipulated by the parties, shall serve and file an Opening Claim Construction Brief including a proposed construction of each claim term and phrase which the parties collectively have identified as being in dispute. Such Opening Claim Construction Brief shall also, for each element which the party contends is governed by 35 U.S.C. § 112(6), describe the claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element in the patent specification. Such Opening Claim Construction Brief shall further include a statement of the anticipated length of time necessary for the party to present its case at the claim construction hearing.

(b) At the same time the party serves its Opening Claim Construction Brief, that party shall serve and file an identification of extrinsic evidence, including testimony of lay and expert witnesses the party contends supports its claim construction. The party shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, lay or expert, the party shall also serve and file an affidavit signed by the witness that sets forth the substance of that witness' proposed testimony sufficient for the opposing party to conduct meaningful examination of the witness(es).

(c) Not later than thirty (30) calendar days after service of the Opening Claim Construction Brief, the opposing party shall serve and file a Response to Opening Claim Construction Brief including the party's proposed construction of each claim term and phrase which the parties collectively have identified as being in dispute. Such Response shall also, for each element which the opposing party contends is governed by 35 U.S.C. § 112(6), describe the



claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element. Such Response shall further include a statement of the anticipated length of time necessary for the party to present its case at the Claim Construction Hearing and a concise statement not to exceed five (5) pages as to whether the party objects to the opening party's offer of extrinsic evidence.

(d) At the same time the opposing party serves its Response, that party shall serve and file an identification of extrinsic evidence, including testimony of lay and expert witnesses the party contends supports its claim construction. The party shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, lay or expert, the party shall also serve and file an affidavit signed by the witness that sets forth the substance of that witness' proposed testimony sufficient for the opposing party to conduct meaningful examination of the witness(es).

(e) Not later than seven (7) calendar days after service of the Response, the opening party may serve and file a Reply, not to exceed ten (10) pages, solely rebutting the opposing party's Response. Such Reply shall further include a concise statement not to exceed five (5) pages as to whether the party objects to the opposing party's offer of extrinsic evidence.

(f) Not later than five (5) calendar days after service of the Reply, the opposing party shall have the option of serving and filing a Sur-Reply, not to exceed five (5) pages, solely rebutting the opening party's Reply.

(g) Prior to the Claim Construction Hearing, the Court may issue an order stating whether it will receive extrinsic evidence and, if so, the particular evidence that it will exclude and that it will receive, and any other matter the Court deems appropriate concerning the conduct of the hearing.

#### **LPR 4.4. Claim Construction Hearing.**

Subject to the convenience of the Court's calendar, fifteen (15) calendar days following submission of the Reply specified in LPR 4.3(e), the Court shall conduct a Claim Construction Hearing.

### **5. EXPERT WITNESSES**

#### **LPR 5.1. Disclosure of Experts and Expert Reports.**

(a) For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule.

(b) No later than sixty (60) calendar days after the Court's ruling on claim construction each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which each bears the burden of proof ("First Round Disclosures").

(c) No later than thirty (30) calendar days after service of the First Round Disclosures, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which the opposing party bears the burden of proof (“Second Round Disclosures”).

(d) Unless otherwise ordered by the Court, no later than fifteen (15) calendar days after the Second Round of Disclosures, each party shall make any rebuttal expert witness disclosures permitted by Rule 26 (“Rebuttal Reports”).

**LPR 5.2. Depositions of Experts.**

Depositions of expert witnesses disclosed under this Rule, if any, shall be completed within forty-five (45) calendar days after service of the Rebuttal Reports.

**APPENDIX A**  
IN THE UNITED STATES DISTRICT COURT FOR  
THE SOUTHERN DISTRICT OF NEW YORK  
Plaintiff, v. Defendant.            ))            Civil Action No.

MODEL SCHEDULING ORDER FOR USE IN PATENT CASES

AND NOW, this \_\_\_\_\_ day of \_\_\_\_\_ 20\_\_\_\_\_,

IT IS ORDERED that this action is placed under the Proposed Local Patent Rules of this Court for pretrial proceedings and all provisions of these Rules will be strictly enforced.

IT IS FURTHER ORDERED that counsel shall confer with their clients prior to all scheduling, status, or pretrial conferences to obtain authority to participate in settlement negotiations which may be conducted or ordered by the Court.

IT IS FURTHER ORDERED that compliance with provisions of Local Rule 16 and the Proposed Local Patent Rules shall be completed as follows:

- (1) The parties shall move to amend the pleadings or add new parties by \_\_\_\_\_;
- (2) The party claiming patent infringement must serve on all parties a Disclosure of Asserted Claims and Infringement Contentions, and make any required Document Production by \_\_\_\_\_; *[30 calendar days after the Initial Scheduling Conference; LPR 3.2 and 3.3]*
- (3) The party claiming invalidity must serve on all parties Invalidity Contentions, and make any required Document Production by \_\_\_\_\_; *[30 calendar days after service of Disclosure of Asserted Claims and Infringement Contentions; LPR 3.4 and 3.5]*
- (4) Each party will simultaneously exchange Proposed Claim Terms and Phrases for Construction by \_\_\_\_\_; *[45 calendar days after service of the Invalidity Contention; LPR 4.1]*
- (5) The parties shall meet and confer by \_\_\_\_\_ to identify claim terms and phrases that are in dispute, and claim terms and phrases that are not in dispute; *[Not later than seven (7) calendar days after the exchange of proposed claim terms and phrases; LPR 4.2]*
- (6) Each party shall also file by \_\_\_\_\_ a Joint Disputed Claim Terms Chart listing claim terms and phrases, and each party's proposed constructions, for each disputed claim term and phrase, asserted by each party; *[Not later than ten (10) calendar days after the meet and confer; LPR 4.2]*

(7) Plaintiff shall file and serve an Opening Claim Construction Brief and an identification of extrinsic evidence by \_\_\_\_\_; [30 calendar days after filing of the joint disputed claim terms chart; LPR 4.3 (a) and (b)]

(8) The Opposing Party shall file and serve a response to the Opening Claims Construction Brief, an identification of extrinsic evidence and any objections to extrinsic evidence by \_\_\_\_\_; [30 calendar days after service of the opening claim construction brief; LPR 4.3 (c) and (d)]

(9) The opening party may serve and file a Reply directly rebutting the opposing party's Response, and any objections to extrinsic evidence by \_\_\_\_\_; [7 calendar days after opposing party's response is served; LPR 4.3(e)], and the opposing party may submit a Sur-Reply by \_\_\_\_\_; [5 calendar days after the Reply is served; LPR 4.3(f)]

(10) The Court will conduct a hearing on the issue of Claim Construction on \_\_\_\_\_, [15 calendar days after submission of the reply; LPR 4]

(11) The parties shall complete fact discovery by \_\_\_\_\_ and all interrogatories, depositions, requests for admissions, and requests for production shall be served within sufficient time to allow responses to be completed prior to the close of fact discovery; [recommended 60 days after the court's ruling on claim construction]

(12) Each party shall make its initial expert witness disclosures, as required under Rule 26, on the issues on which each bears the burden of proof by \_\_\_\_\_, [60 days after court's ruling on claim construction; LPR 5.1(b)]

(13) Each party shall make its initial expert witness disclosures, as required under Rule 26, on the issues on which the opposing party bears the burden of proof by \_\_\_\_\_; [30 days after the first round of expert disclosures; LPR 5.1(c)]

(14) Rebuttal expert witness disclosures are to be made by \_\_\_\_\_; [15 calendar days after second round of expert disclosures; LPR 5.1(d)]

(15) Expert depositions, if any, shall be completed by \_\_\_\_\_; [45 days after service of the Rebuttal Reports; LPR 5.2]

(16) Motions for summary judgment with evidentiary material and accompanying brief, if appropriate, shall be filed by \_\_\_\_\_, and responses to such motions shall be filed within \_\_ days thereafter. Reply and surreply briefs shall not be filed unless approved/requested by the Court;

(17) All parties shall file an indication whether or not they are willing to proceed to trial in front of a Magistrate Judge by \_\_\_\_\_;

(18) The parties shall submit a pretrial order by \_\_\_\_\_.

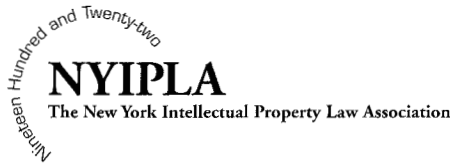
(19) The Court shall conduct a pretrial conference on \_\_\_\_\_, at \_\_\_\_\_ (time) Room \_\_\_\_\_, \_\_\_\_\_, New York, and all trial counsel must attend; and

(20) The trial shall commence on \_\_\_\_\_ 20\_\_, at \_\_\_\_\_ (time), Courtroom No. \_\_\_\_\_.

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United States District Judge

cc: All Counsel of Record.





# NYIPLA Proposed Comments and Recommendations to the USPTO On The USPTO's Proposed Rules Changes Regarding Continuations, Examination of Claims and Applications Containing Patentably Indistinct Claims

*Submitted on May 3, 2006 to the U.S. Patent and Trademark Office  
on behalf of the NYIPLA by President Edward E. Vassallo and  
The Board of Directors*

The U.S. Patent and Trademark Office ("Office") published two proposed rules packages<sup>1</sup> on January 3, 2006 that, if adopted, will dramatically affect how patent applications are prosecuted in the United States. On May 3, 2006, the New York Intellectual Property Law Association (NYIPLA), President Edward E. Vassallo, and The Board of Directors proposed comments for the Office to consider in evaluating whether these proposed rules should be adopted and recommended alternatives for the Office to consider to improve the patent examination process, as follows:

## **INTRODUCTION:**

The New York Intellectual Property Law Association (the "NYIPLA") is a professional association of more than 1,300 attorneys whose interests and practices lie in the area of patent, copyright, trademark, trade secret and other intellectual property law. The Association's members include in-house attorneys working for businesses owning patents or having to deal with the patents of third-parties, as well as attorneys in private practice who represent both patent owners and accused infringers. NYIPLA members represent both plaintiffs and defendants and also regularly participate in proceedings before the Office.

The Board appreciates that the Office is trying to manage the record number of patent applications being filed each year in the Office<sup>2</sup> and the reported backlog, and supports the Office's review of its current practices and procedures to determine ways that the Office can continue to make the patent examination process more effective and efficient. The Board notes, however, that the challenges faced by the Office relate to *procedural* issues that should be addressed by administrative remedies. However, the Office's proposed rules changes have drastic consequences that will adversely affect an Applicant's *substantive* patent rights as described below. The continuation practice, for example, is embedded in the U.S. patent system and *procedural* steps to limit the number of continuations that an Applicant is permitted to file without sufficient explanation would have a dramatic negative effect on an Applicant's *substantive* patent rights.

## **A. Changes to Continuation Practice:**

The proposed rule would require that second or subsequent continued examination filings, whether a continuation application, a continuation-in-part application, or a request for continued examination, be supported by a "showing" as to why the amendment,

argument, or evidence presented could not have been previously submitted.

If the “showing” requirement is not satisfied when a continuation application is filed under 37 C.F.R. § 1.53(b), the Office will refuse to enter, or will delete if present, any specific reference to a prior-filed application.

Comment A1:

**The Office lacks the statutory authority under 35 U.S.C. § 120 to limit the number of copending continuation applications originating from an original application.**

Section 120 provides, in part, that:

“[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor ... named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application ....”

There are no provisions in Section 120 as shown above that grant the Office the statutory authority to limit the number of continuations that can be filed. The comments provided by the Office in the notice of proposed rule making state that the Office is not setting a *per se* limit on the number of continuing applications. Rather, the notice goes on to state that the Office just wants the Applicant to show that the third and following applications in the chain of applications are necessary

to advance prosecution.<sup>3</sup> However, contrary to the Office’s assertions in the notice of proposed rule making, the effect of this proposed rule is to impermissibly limit the number of copending continuation applications originating from an original application. The Office’s ability to refuse to enter, or to delete if present, a priority claim to an earlier-filed application that an Applicant previously filed a correct claim to priority means that an earlier-filed application in a chain of continuations can be used against a later-filed application as a 35 U.S.C. § 102(b)<sup>4</sup> absolute bar.

For example, assume that an Applicant files his first application on November 10, 2000, and the application issues as the ‘123 patent on December 12, 2003. Before the ‘123 patent issues, the Applicant files a continuation application on December 11, 2003, and continues to file copending continuation applications thereafter until a third continuation application is filed on September 15, 2006. Assuming the proposed rule has been adopted, and the third continuation application has been denied due to Applicant’s failure to satisfy the “showing” requirement, the Office could deny the Applicant’s claim to priority in the third continuation application to the ‘123 patent, and the ‘123 patent could be used by the Office as a Section 102(b) bar to the third continuation application.<sup>5</sup>

Comment A2:

**The proposed rule runs afoul of the court’s holding in *In re Henriksen*<sup>6</sup>**

The court held in *In re Henriksen* that under 35 U.S.C. § 120 there is



no statutory basis for fixing an arbitrary limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of copending applications, provided Applicant meets all the other conditions of Section 120. The Office stated in the notice of proposed rule making that “[t]he Office is aware of case law (e.g., *In re Henriksen*) which suggests that the Office has no authority to place an absolute limit on the number of copending continuing applications originating from an original application.”<sup>7</sup> Again, the Office asserts that it is not limiting the number of continuation applications that can be filed, i.e., it is just requesting that an adequate “showing” be made. However, as described above, if an adequate “showing” is not made then the effect will be to limit an Applicant’s right to have a copending continuation application.

Comment A3:

**The Office should obtain authority from Congress under 35 U.S.C. § 120 to limit the number of copending continuation applications originating from an original application.**

The Patent Reform Act of 2005 (H.R. 2795<sup>8</sup>, “the Proposed Act”) sought to dramatically amend the patent laws in the United States. The Proposed Act was introduced June 8, 2005 in the House of Representatives by Congressman Smith and included a provision<sup>9</sup> to amend 35 U.S.C. § 120 to give the Office the authority to limit the number of continuation applications that an Applicant could file.

An Amendment in the Nature of a Substitute to H.R. 2795 was offered by Representative Smith on July 26, 2005 (“Amendment”). Unlike the Proposed Act, the Amendment did not include a provision to give the Office the authority to limit the number of continuation applications that an Applicant could file.

Moreover, recently, on April 5, 2006, Representatives Berman and Boucher introduced a bill “the Patents Depend on Quality Act of 2006,” (“the Proposed PDQ Act”) that sought to amend 35 United States Code. The Proposed PDQ Act, like the Amendment discussed above, did not include a provision to limit the number of continuation applications that an Applicant could file.

Congress’ decision to include a continuation-limiting provision in the Proposed Act, but not in the subsequent Amendment or the Proposed PDQ Act is an indication that Congress is still trying to determine whether such a law would be beneficial to our patent system. If the Office believes that such a law would be beneficial, then the Office should ask Congress to pass a law that gives the Office the clear statutory mandate to limit the number of continuations that an Applicant could file.

Comment A4:

**The Office’s decision to adopt this rule without a clear mandate from Congress could wreak havoc on the patent system if the courts subsequently hold that the Office did not have statutory authority under 35 U.S.C. § 120 to limit the number of continuation applications that an Applicant could file.**

What happens one or two years after

the adoption of this rule if the Court of Appeals for the Federal Circuit or the U.S. Supreme Court holds that the Office did not have the statutory authority under Section 120 to limit the number of continuations that an Applicant could file? Is the Office going to implement procedures to allow Applicants that were previously denied a continuation based on their inability to satisfy the “showing” requirement to revive their patent applications? Is the Office prepared to deal with this and other related situations?

Comment A5:

**If the Office adopts this proposed rule, the Office should change the standard to satisfy the “showing” requirement from “why the amendment, argument, or evidence presented could not have been previously submitted” to --reasonable under the circumstances--.**

As mentioned above, the Board does not believe the Office has the statutory authority under 35 U.S.C. § 120 to impermissibly limit the number of continuation applications that an Applicant could file. In addition, the *In re Henriksen* decision supports the Board’s position that there is *no* statutory basis for fixing an arbitrary limit on the number of continuations that an Applicant could file.

However, to the extent the Office decides to adopt this rule, the Board notes that in its present form, the standard of “why the amendment, argument, or evidence presented could not have been previously submitted” to satisfy the “showing” requirement is too stringent. An Examiner could always make the argument that the

evidence could have been submitted earlier. The “reasonable under the circumstances” standard would give an Examiner more flexibility in determining whether the “showing” standard has been satisfied.

For example, the BioTech/Pharmaceutical group has been one of the biggest critics of the proposed changes to continuation practice because they argue that it takes 6-8 years, if not longer, to commercialize a product as compared to 2-3 years to commercialize a mechanical or electrical product. Thus, continuation applications allow a biotech/pharmaceutical application to stay copending while commercial embodiments of their products are being developed. If an Examiner uses the proposed strict standard, an Examiner could simply assert that the amendment, argument, or evidence *could have* been previously submitted. If, however, the Examiner uses a “reasonable under the circumstances” standard then the Examiner would be able to take into consideration the unpredictability of chemical/pharmaceutical arts as compared to the predictability of the mechanical and electrical arts<sup>10</sup>, take all the related factors into consideration and be given more discretion in making his or her determination regarding whether the “showing” requirement has been satisfied.

Comment A6:

**If the Office adopts this proposed rule, the Office should use interim rules to ease the transition from an “unlimited continuation practice” to “limited continuation practice.”**

For a pending application that already includes at least one continuation application in its file history, the

proposed rule change to continuation practice would not allow an Applicant to obtain “one more” continuation application after the effective date of the rule unless the Applicant could satisfy the “showing” requirement.<sup>11</sup> For example, if an Applicant files a continuation application under 37 C.F.R. § 1.53(b) on June 10, 2005 and the proposed rule is adopted and takes effect on June 10, 2006, then the Applicant must include in the next continuation application information directed to why the amendment, argument, or evidence could not have been previously submitted to satisfy the “showing” requirement. Although the Board understands the Office’s desire not to have a pre-GATT rush to file patent applications<sup>12</sup>, equity and such a drastic shift in policy dictates that this rule should be phased-in gradually, especially shortly after the rule becomes effective. An interim rule would allow the Commissioner to apply a more lenient standard at least to the 400,000-500,000 pending applications after the effective date, for possibly a year from the adoption of the proposed rule. Such an interim rule would ease the transition into the “limited continuation practice” era.

### **B. Changes to Examination of Claims Practice:**

The changes to the examination of claims practice propose to have an Examiner initially examine only 10 claims designated by an Applicant for review. For example, if a patent application includes 20 claims, of which 3 are in independent form and 17 are in dependent form, the Office will require the Applicant to choose the 3 independent claims and designate 7 ad-

ditional dependent claims for review. The remaining 10 dependent claims will only be reviewed if there is an indication of allowable subject matter in the initial 10 claims.

If, however, the Applicant wants all 20 claims examined initially then the Office is proposing that the Applicant “share the burden” by submitting to the Office an Examination Support Document (ESD). The ESD includes requirements similar to those required by Section 708.02 of the MPEP for a Petition to Make Special to, e.g., expedite the examination of an application. For example, the ESD must include a statement that a preexamination search was conducted, submit an Information Disclosure Statement citing the relevant art, and include a detailed explanation of how the claims are patentable over the references cited in accordance with 37 C.F.R. § 1.111(b) and (c).

Comment B1:

#### **Piecemeal examination by the Office would increase the pendency of some patent applications.**

An example will illustrate this point more clearly. Assume an application includes 20 claims, three of which are in independent form. Under the existing rules, an Examiner will initially review *all* 20 claims. Quite often, the Examiner rejects the independent claims as not patentable over the cited prior art but includes an “Indication of Allowable Subject Matter” for the subject matter in one of the dependent claims, and states that the application would be allowable if the dependent claims that include the allowable subject matter are rewritten in independent form. An Applicant may decide to either traverse the Examiner’s

rejections or amend the claims to place them in a form for allowance. Under the proposed rule, however, the allowable subject matter may be in one of the non-designated dependent claims. Thus, the Examiner would not review the subject matter of those claims, the Applicant would not be made aware of the indication of allowable subject matter in such claims and the pendency of the application would increase. A first full examination of all claims would be the most efficient practice.

Comment B2:

**If the Office adopts this rule, the requirement in the Examination Support Document that Applicant characterize the prior art should be eliminated.**

The ESD requires that an Applicant provide a concise statement of the utility of the invention as defined by the independent claims, a Section 112 showing of where the limitations in the claims find support in the application and any parents, and identify all the limitations of the claims that are disclosed by the references cited. The first two requirements relating to the concise statement of utility and the Section 112 showing are reasonable since they both relate to an Applicant's application. The third requirement is not reasonable because it requires that an Applicant characterize in writing the relevant prior art. This role is more appropriate for the Examiner in light of 37 C.F.R. § 1.104<sup>13</sup> since it is the Examiner's role to review and analyze the prior art for patentability purposes. In other words, the first two requirements relating to the concise statement of utility and the Section 112 showing "share the burden" of examining all

the claims in the application by providing the Examiner with additional information about the application. However, the third requirement relating to an Applicant reviewing and characterizing the prior art makes the Applicant *both* the Applicant and Examiner, and the latter role of examining and characterizing the prior art is best left to the Examiner. Shifting responsibility for examination of patent applications from Examiners to Applicants represents a fundamental and inappropriate shift in our patent system from our current examination system to a registration system.

**C. Changes to Practice re Applications Containing Patentably Indistinct Claims:**

The proposed rule requires that when an Applicant files multiple applications with the same filing date (or within two months of such date), and the applications include common inventors and overlapping disclosures, the Office will *presume* that the applications contain patentably indistinct claims.

An Applicant can rebut the presumption by explaining why the claims in the applications are distinct or submit a terminal disclaimer and explain to the satisfaction of the Office why two or more pending applications should be maintained. If the Office is not satisfied, then the Office may require elimination of the patentably indistinct claims from all but one of the applications.

Comment C1:

**The Office should assign one group of Examiners or one Examiner to review applications that have overlapping disclosures.**

In order to improve efficiency, the Office should assign one Examiner or one group of Examiners to review applications with overlapping disclosures. This approach will increase efficiencies at the Office because the Examiner will be familiar with the disclosure in the specifications of the related cases and can easily review the specifications and the scope of the claims. In other words, having one Examiner review 8 applications with overlapping disclosures is more efficient than 8 Examiners reviewing 8 applications with overlapping disclosures.

#### **D. Alternatives to consider instead of proposed rule changes:**

The Board makes the following recommendations to make the patent examination process procedurally more effective and efficient without negatively impacting substantive patent rights:

i) Establish a system of notification of Applicants before First Office Actions are issued so that an Applicant can schedule an interview prior to the First Office Action and at least encourage Examiners to interview Applicants before a First Office Action;

ii) Allow and encourage interviews after a final office action;

iii) Ease after final practice (Section 1.116<sup>14</sup> is too restrictive. It only allows amendments under very limited circumstances.);

iv) Provide incentives to E-file submissions to the Office;

v) Consider adopting additional rules that defer examination of applications for those Applicants that are willing to sacrifice patent term to delay examination; and

vi) Require that the issuance of the second final Office Action, which will trigger the “showing” requirement if a continuation is filed thereafter, be reviewed by at least the Supervisory Patent Examiner for the Group Art Unit. Another approach may include having three Examiners, instead of only the SPE, review the second final Office Action.

<sup>1</sup> See 71 Fed Reg 48, Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims, and 71 Fed Reg 61, Changes to Practice of the Examination of Claims in Patent Applications.

<sup>2</sup> In FY 2005, the Office received 384,228 Utility, Plant, and Reissue (UPR) patent applications, 25,304 Design applications, as well as 46,926 PCT applications. (Source: PTO’s Performance and Accountability Report for Fiscal Year 2005).

<sup>3</sup> See 71 Fed Reg 50, right-hand column, second full paragraph.

<sup>4</sup> 35 U.S.C. 102 Conditions for patentability; novelty, provides that “[a] person shall be entitled to a patent unless ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more

than one year prior to the date of the application for patent in the United States.”

<sup>5</sup> The printed publication of the first application could also be used under Section 102(b) as an absolute bar to the third continuation application.

<sup>6</sup> See *In re Henriksen*, 399 F.2d 253, 158 USPQ 224 (CCPA 1968).

<sup>7</sup> See 71 Fed Reg 50, right hand column, third full paragraph.

<sup>8</sup> The Patent Reform Act of 2005 (H.R. 2795) was introduced June 8, 2005 in the House of Representatives by Congressman Lamar Smith (R-TX). H.R. 2795 is a bill to amend Title 35, United States Code.

<sup>9</sup> SEC 8, Continuation Applications, subsection 123, Limitations on continuation applications, provides that “[t]he Director may by regulation limit the circumstances under which an application for patent, ... may be entitled to the benefit under section 120 of the filing date of a prior-filed application....”

<sup>10</sup> See Section 2164.03 of the M.P.E.P., Relationship of Predictability of the Art and the Enablement Requirement - 2100 Patentability, which states that mechanical and electrical arts are predictable, and the chemical arts are unpredictable.

<sup>11</sup> See 71 Fed Reg 56, left-hand column, first full paragraph.

<sup>12</sup> See *Ending Abuse of Patent Continuations* (Lemley, Moore) 84 B.U. L. Rev. 63, 2004, footnote 86, which notes the spike in patent filings before June 8, 1995.

<sup>13</sup> § 1.104 Nature of examination. (a) Examiner’s action. (1) On taking up an application for examination ... the *examiner* (emphasis added) shall make a thorough study thereof and shall make a thorough investigation of the available

prior art relating to the subject matter of the claimed invention.

<sup>14</sup> 37 C.F.R. § 1.116, (b), provides that (1) an amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office Action; or (2) an amendment presenting rejected claims in better form for consideration on appeal may be admitted.





# NYIPLA Proposed Comments and Recommendations to the USPTO on the USPTO's Proposed Rules Changes to Information Disclosure Statement Requirements and Other Related Matters

*Submitted on September 7, 2006 to the U.S. Patent and Trademark  
Office on behalf of the NYIPLA by President Marylee Jenkins and  
The Board of Directors*

The U.S. Patent and Trademark Office (the "Office") published a proposed rules package<sup>1</sup> on July 10, 2006 that, if adopted, will dramatically affect how patent applications are prosecuted in the United States. This memo briefly describes the substance of certain of these proposed rules changes, proposes comments for the Office to consider in evaluating whether these proposed rules should be adopted, and recommends alternatives for the Office to consider to improve the patent examination process.

## INTRODUCTION

The New York Intellectual Property Law Association (the "NYIPLA") is a professional association of more than 1,300 attorneys whose interests and practices lie in the area of patent, copyright, trademark, trade secret and other intellectual property law. The Association's members include in-house attorneys working for businesses owning patents or having to deal with the patents of third-parties, as well as attorneys in private practice who represent both patent owners and accused infringers. NYIPLA members represent both plaintiffs and defendants and also regularly participate in proceedings before the Office.

The Board appreciates that the Office is trying to manage the record number of patent applications being filed each year in the Office<sup>2</sup> and the reported backlog, and the Board supports the Office's review of its current practices and procedures to determine ways that the Office can continue to make the patent examination process more effective and efficient. However, the Office's proposed rules represent drastic changes that will have both far reaching and comprehensive consequences.

## **Changes to Information Disclosure Statement Requirements**

Pertinent proposed changes to the rules regarding Information Disclosure Statements can be summarized as follows:

1. Only twenty references can be cited prior to the first Office Action "on the merits" before more burdensome disclosure requirements become necessary.
2. Any English language reference having more than twenty-five pages requires detailed analysis.
3. Any foreign language reference requires detailed analysis.
4. Any reference cited after a first Office Action on the merits requires more detailed analysis.



5. Previously cited references must be reevaluated in light of changes to the claims and then appropriate comments must be filed.
6. A “safe harbor” provision is to be added to Section 1.56.

#### GENERAL COMMENT

The stated purpose of the proposed rules changes is to encourage early submission of relevant information and to discourage submission of information that is unimportant or does not add something new for an Examiner to consider. The Board certainly supports such goals; however, the Board respectfully submits that the proposed changes to Sections 1.56, 1.97, and 1.98 are too far reaching and, in fact, have the unintended consequence of interfering with effective prosecution of a patent application before the Office.

While the Office’s proposed rules changes apparently seek to reduce or minimize perceived burdens on Examiners resulting from untimely or extensive submissions of prior art, the Office has minimized an important concern to practitioners, namely, the consequences of being forced to provide detailed “explanations” (see proposed Section 1.98(a)(3)(iv)). The required explanations, including identification, correlation, and non-cumulative description, involve detailed analysis and legal and/or factual conclusions. Such analysis and conclusions are not only burdensome due to the extra costs to clients, but they also result in comments that could be misinterpreted at a later date, perhaps resulting in a charge of inequitable conduct. In addition, to the extent that the Office is urging applicants to cite

less prior art, there is more likelihood that a practitioner’s judgment will be questioned at a later time.

The Office is surely aware of the large number of reported cases where, under the present rules regarding disclosure, practitioners have been held responsible for not citing references that were believed by the practitioners to not be material. With the proposed rule changes urging that fewer references be cited and that, for ones cited, explanations be provided, more allegations of inequitable conduct are bound to follow. The Board has the following specific comments:

**Comment One: The proposed “threshold number” of twenty patents to be cited before a first Office Action is inappropriate.**

The Office’s comments indicate that the threshold number of twenty references that can be cited before more detailed analysis is required represents a “best” balance of the interests of the Office and the applicants. The Board submits that the Office’s determination of the number “twenty”, while interesting, essentially is unfair to the 15% of applications that, according to the Office’s statistics, would not be encompassed by that number.

In fact, the Board believes that there should not be any threshold number, particularly since there are certain very active technologies where large numbers of references are routinely and properly cited. However, if there must be a threshold number, the Board submits that a much higher number, such as fifty, would be a better balance of interests.

In addition, experienced patent practitioners know that there are many subject matter areas and particular

clients where typically much larger numbers of references must be mentioned in an Information Disclosure Statement due to a client's extensive work in a particular area of technology. To impart a particular number as a threshold above which there will be increasingly onerous disclosure and analysis requirements is unfair and unrealistic to these situations.

Further, the detailed analysis or explanation required by the proposed rule changes for large English language documents, foreign language documents, and references above a threshold number is unduly burdensome to applicants. The costs involved in having registered patent attorneys or agents undertake a detailed analysis of such references and then submit comments to the Office will greatly increase the cost of patent prosecution, which will have a huge impact on small companies and individuals. The Board believes that this detailed analysis requirement should either be eliminated altogether or modified to require only a general designation of relevant sections of a reference, such as that provided on a PCT Search Report.

**Comment Two: If there is a threshold number, the Office should not count the citation of references from a parent application against the threshold number for references cited in a continuing patent application.**

As mentioned in the Office's comments, an Examiner is supposed to review references from a parent application prior to examination of a continuing patent application, i.e., a continuation or divisional patent application. However, not all of those references will necessarily be men-

tioned on the face of a patent to issue unless the Examiner or the applicant specifically mentions each and every such reference during prosecution of that patent. The "strength" of the statutory presumption of validity under 35 U.S.C. § 282 is directly or indirectly affected by the references specifically mentioned on the face of a patent, and therefore an applicant would prefer to see each of the previously mentioned references specifically cited. Since it would be advantageous to have all of the references from a parent patent application mentioned on the face of a patent to issue from a continuing patent application, and since this would not be a burden on the Examiner who has already reviewed the references, the Board does not believe that the references from a parent application cited during prosecution of a continuing application should be counted against the threshold number, if any.

**Comment Three: The safe harbor provision does not absolve a practitioner from an allegation of inequitable conduct.**

The proposed safe harbor provision of proposed Section 1.56(f) is interesting in that it inherently recognizes the concerns of practitioners regarding inequitable conduct charges, as mentioned above. However, such language is of no force or effect outside the Office and there is no certainty that a court would be guided by it. This is reflected in the commentary that:

"... the Office is *hopeful* that a court in deciding a duty of disclosure issue will take this proposed safe harbor into account." Fed. Reg., Vol. 71, No. 131, p. 38812. (Emphasis added.)

More particularly, to the extent that a practitioner made a determination that

a reference was either cumulative or non-material and didn't cite it to the Office, there is nothing in proposed Section 1.56(f) that would insulate that practitioner from a later charge to the contrary.

Inequitable conduct is almost always an issue in patent litigation, and many times the basis of a charge of inequitable conduct is the failure to cite a relevant reference during prosecution. The standards of relevance and materiality have changed over the years, and a consequence of this has been a tendency on the part of patent practitioners to avoid determining what is relevant and instead leave it up to an Examiner to make that determination. The proposed rules are incredibly troublesome in that the thrust of the determination is now being directed at the patent practitioner by virtue of a limit on the number of references that can be cited and then obligations to provide explanations, followed by an obligation to then revisit these explanations dependent upon claim changes.

Notwithstanding the language in the Federal Register, there has been a long history in the federal courts of instances where patent practitioners have been held accountable and patents have been held invalid for errors in judgment. The rules changes proposed by the Office raise the accountability of the patent practitioner to a much higher level to the extent that one can only begin to imagine the long term consequences. The Office's comments to the contrary, this is a disaster waiting to happen.

## RECOMMENDATIONS

The Board does not necessarily agree that Sections 1.56, 1.97, and 1.98 need revision. However, to the extent that the Office feels it must make changes, the Board proposes the following:

1. The threshold number should be increased to at least fifty or eliminated altogether.
2. The explanation requirement of Section 1.98(a)(3)(iv) should be eliminated or modified to include only a general designation of relevant sections of a reference.
3. References cited in a parent patent application should be able to be cited in a continuing application without the references being counted against the threshold number.
4. The Office should hold public hearings on the proposed changes.

<sup>1</sup> See 71 Fed Reg 131, Changes to Information Disclosure Statement Requirements and Other Related Matters.

<sup>2</sup> In FY 2005, the Office received 384,228 Utility, Plant, and Reissue (UPR) patent applications, 25,304 Design applications, as well as 46,926 PCT applications. (Source: PTO's Performance and Accountability Report for Fiscal Year 2005).



# **PART III**

## **UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

# **SECTION 1**

*Summary of Workload*

**U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT  
 APPEALS FILED, TERMINATED, AND PENDING DURING THE TWELVE-MONTH PERIOD ENDING  
 SEPTEMBER 30, 2006**

<b>Source of Appeals</b>	<b>Pending 01-Oct-05</b>	<b>Filed</b>	<b>Total</b>	<b>By Judges</b>	<b>Other</b>	<b>Percent Reversed</b>	<b>Pending 30-Sep-06</b>
<b>Total</b>	<b>1,094</b>	<b>1,772</b>	<b>1,460</b>	<b>1,015</b>	<b>445</b>	<b>12</b>	<b>1,406</b>
Board of Contract Appeals	22	33	30	25	5	13	25
Court of International Trade	56	58	67	49	18	25	47
U.S. Court of Federal Claims	124	154	137	105	32	19	141
U.S. Court of Appeals for Veterans Claims	216	384	119	85	34	12	481
U.S. District Courts	376	522	496	357	139	13	402
Department of Veterans Affairs	2	3	3	2	1	0	2
International Trade Commission	8	9	10	6	4	40	7
Merit Systems Protection Board	244	508	506	329	177	8	246
Office of Compliance	4	0	4	4	0	0	0
Patent & Trademark Office	39	72	60	31	29	3	51
Writs*	3	29	28	22	6	0	4

NO APPEALS WERE MADE FROM DECISIONS OF THE SECRETARY OF AGRICULTURE, THE SECRETARY OF COMMERCE, OR THE OFFICE OF PERSONNEL MANAGEMENT.

\*THIS CATEGORY INCLUDES WRITS OF MANDAMUS, OTHER EXTRAORDINARY WRITS, PETITIONS FOR PERMISSION TO APPEAL, AND DISCRETIONARY PETITIONS FOR REVIEW.





## **SECTION 2**

*Biographies*

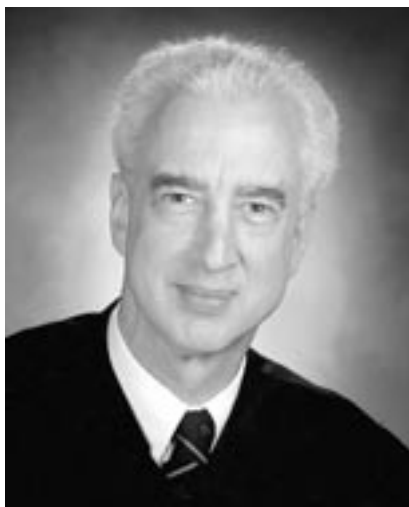


**MICHEL, PAUL R.**

United States Circuit Judge  
(Chief Judge)  
United States Court of Appeals  
for the Federal Circuit

Office Address:  
Howard T. Markey National  
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717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6297



Born: Philadelphia, Pennsylvania  
February 3, 1941

Judge Michel was nominated by President Reagan as Judge, U.S. Court of Appeals for the Federal Circuit on March 4, 1988, and entered duties of such office on March 8, 1988. Judge Michel graduated from Williams College in 1963 and graduated from the University of Virginia Law School in 1966.

Judge Michel served in the Philadelphia District Attorney's Office from 1966 to 1974. He was Assistant Watergate Special Prosecutor from 1974 to 1975; Assistant Counsel, Senate Intelligence Committee from 1975-1976; Deputy Chief, Public Integrity Section, and "Koreagate" prosecutor from 1976 to 1978; and Associate Deputy Attorney General from 1978 to 1981.

From 1981 to 1988, he was Counsel/Administrative Assistant to Senator Arlen Specter.

Judge Michel is the father of two daughters, Sarah and Margaret.

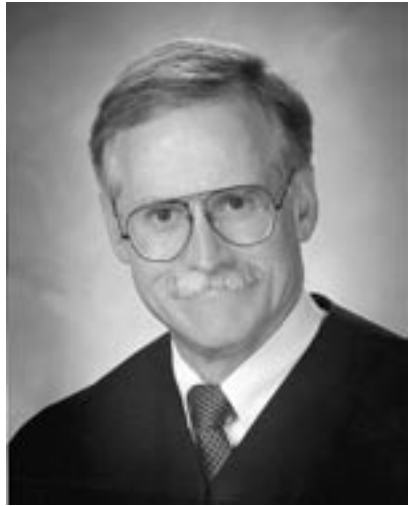
**BRYSON, WILLIAM C.**

United States Circuit Judge  
United States Court of Appeals  
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Washington, DC 20439

Telephone: 202-633-5808

Born: Houston, Texas  
August 19, 1945



Judge Bryson was nominated in June 1994 by President Clinton to be a circuit judge, United States Court of Appeals for the Federal Circuit and assumed the duties of the office on October 7, 1994. Judge Bryson received his A.B. degree from Harvard University in 1969 and a J.D. degree from the University of Texas School of Law in 1973.

From 1973 to 1974, Judge Bryson was a law clerk to the Hon. Henry J. Friendly, circuit judge, United States Court of Appeals for the Second Circuit, and the Hon. Thurgood Marshall, associate justice, United States Supreme Court from 1974 to 1975. In 1975, he joined the Washington, DC law firm of Miller, Cassidy, Larroca & Lewin as an associate. Judge Bryson served in the Department of Justice, Criminal Division from 1979 to 1986; the Office of Solicitor General from 1978 to 1979 and 1986 to 1994; and the Office of the Associate Attorney General in 1994.

Judge Bryson is married to Julia Penny Clark and has two children, Alice and Ellen.

## **DYK, TIMOTHY B.**

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

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Washington, DC 20439

Telephone: 202-633-6550

Born: Boston, MA  
1937



Judge Dyk was nominated for appointment as Circuit Judge, United States Court of Appeals for the Federal Circuit on April 1, 1998 by President Clinton. He was confirmed by the Senate on May 24, 2000 and entered into duty on June 9, 2000.

Judge Dyk graduated from Harvard College, A.B., (cum laude) in 1958 and from Harvard Law School, LL.B., (magna cum laude) in 1961.

Judge Dyk had previously been Law Clerk to Justices Reed and Burton (retired) from 1961 to 1962. He was Law Clerk to Chief Justice Warren from 1962 to 1963 and Special Assistant to Assistant Attorney General, Louis F. Oberdorfer from 1963 to 1964. Judge Dyk was Associate and Partner in the law firm of Wilmer Cutler & Pickering from 1964 to 1990. He was also Partner and Chair of the Issues & Appeals Practice area at the law firm of Jones, Day, Reavis and Pogue from 1990 until his nomination in 2000. Judge Dyk is an Adjunct Professor at the Yale, University of Virginia and Georgetown Law Schools.

## **GAJARSA, ARTHUR J.**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6570



Born: Norcia (Pro. Perugia) Italy  
March 1, 1941

Judge Arthur J. Gajarsa was confirmed to the United States Court of Appeals for the Federal Circuit on July 31, 1997 after having been nominated by President Clinton. He attended Rensselaer Polytechnic Institute from 1958 to 1962, where he received his B.S.E.E. He earned his Masters Degree in Economics from Catholic University in 1968, and received his J.D. from Georgetown University Law Center in 1967.

Prior to private practice, Judge Gajarsa served as a Patent Examiner at the U.S. Patent Office from 1962 to 1963, then as Patent Adviser to the U.S. Air Force, Dept. of Defense from 1963 to 1964, and Patent Adviser at Cushman, Darby and Cushman from 1964 through 1967. Judge Gajarsa clerked for Judge Joseph McGarraghy of the U.S. District Court for the District of Columbia from 1967 to 1968. From 1968 through 1969 Judge Gajarsa was an attorney for the Office of the General Counsel at Aetna Life and Casualty Co. Following this position, Judge Gajarsa served as Special Counsel and Assistant to the Commissioner of Indian Affairs at the Bureau of Indian Affairs at the Department of Interior from 1969 through 1971. Judge Gajarsa practiced law in Washington, D.C. from 1972 to the time he was nominated to the court with the following firms: Duncan and Brown; Gajarsa, Liss and Sterenbuch; Gajarsa, Liss and Conroy; Wender, Maruse and White; and Joseph, Gajarsa, McDermott & Reiner.

## **LINN, RICHARD**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6550



Judge Linn was appointed by President Clinton in 1999. He graduated from Rensselaer Polytechnic Institute (BEE, 1965) and Georgetown University Law Center (J.D., 1969).

Judge Linn was a patent examiner in the U.S. Patent and Trademark Office from 1965 to 1968, and then he was a patent agent with the U.S. Naval Research Laboratory for two years. He was an associate at Brenner, O'Brien, Guay & Conners from 1970 to 1971, a patent advisor at the U.S. Naval Air Systems Command from 1971 to 1972, and then an associate at Stepno & Neilan from 1972 to 1973.

Judge Linn was a partner at Stepno, Schwaab & Linn from 1973 to 1974, a partner at Imirie, Smiley & Linn from 1974 to 1977, and a partner at Marks and Murase, L.L.P., from 1977 to 1997, where he was member of the executive committee from 1987 to 1997. He was a partner/practice group leader at Foley & Lardner from 1997 to 1999. Judge Linn has been an Adjunct Professor at George Washington University Law School since 2001.

## **LOURIE, ALAN D.**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-5851

Born: January 13, 1935



Judge Alan D. Lourie was nominated to the United States Court of Appeals for the Federal Circuit by President Bush on January 25, 1990, and confirmed on April 5, 1990. Judge Lourie was Vice President, Corporate Patents and Trademarks, and Associate General Counsel of SmithKline Beecham Corporation. He joined the company in 1964, was named Assistant General Counsel and Director, Corporate Patents, in 1976, and appointed Vice President in 1977.

Judge Lourie received his Bachelor's degree from Harvard University (1956), his Master's degree in organic chemistry from the University of Wisconsin (1958), and his Ph.D. in chemistry from the University of Pennsylvania (1965). He received his J.D. degree from Temple University in 1970.

Judge Lourie has been Vice Chairman of the Industry Functional Advisory Committee on Intellectual Property Rights for Trade Policy Matters (IFAC 3) for the Department of Commerce and the Office of the U.S. Trade Representative. He was also treasurer of the Association of Corporate Patent Counsel. He has been President of the Philadelphia Patent Law Association and a member of the Board of Directors of the American Intellectual Property Law Association (formerly American Patent Law Association). He was a member of the U.S. delegation to the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property, held in Geneva in October and November 1982, and in March 1984. He was chairman of the Patent Committee of the Law Section of the Pharmaceutical Manufacturers Association from 1980 to 1985. He is also a member of the American Bar Association, the American Chemical Society and the Harvard Club of Philadelphia.



## **MAYER, HALDANE ROBERT**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6556

Born: Buffalo, New York  
February 21, 1941



Judge Mayer was appointed by President Reagan as Judge, U.S. Court of Appeals for the Federal Circuit, on June 15, 1987 and assumed the duties of such office on June 19, 1987. He received a B.S. degree from the U.S. Military Academy at West Point, New York in 1963 and was awarded a J.D. degree from the Marshall-Wythe School of Law, The College of William and Mary in 1971 where he was editor-in-chief of the William and Mary Law Review.

Judge Mayer served in the Army of the United States from 1963 to 1975 and is currently a Lt. Colonel, retired, in the United States Army Reserve. He served as a law clerk to Judge John D. Butzner, Jr. of the U.S. Court of Appeals for the Fourth Circuit from 1971-1972. He was an associate in the law firm of McGuire, Woods, & Battle in Charlottesville, Virginia from 1975-1977, as well as a Lecturer at the University of Virginia School of Law. From 1977-1980, he served as a Special Assistant to Chief Justice Warren E. Burger. He was in private practice with Baker & McKenzie in Washington, DC from 1980-1981. He served as Deputy and Acting Special Counsel, United States Merit Systems Protection Board from 1981-1982 and from 1982-1987 served as a Judge in the United States Claims Court.

Judge Mayer married Mary Anne McCurdy and they have two daughters.

**MOORE, KIMBERLY A.**

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

*Formal photo not yet available*

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington DC 20439

Telephone: 202-633-6570

Born: Baltimore, MD  
1968

Judge Kimberly A. Moore was appointed to the United States Court of Appeals for the Federal Circuit on September 5, 2006 after having been nominated by President Bush.

Judge Moore has a Bachelor of Science in Electrical Engineering and a Master of Science both from Massachusetts Institute of Technology and received her J.D. from the Georgetown University Law Center in 1994. Following law school, she clerked for Judge Glenn L. Archer Jr., Chief Judge of the United States Court of Appeals for the Federal Circuit. She has also worked on intellectual property litigation at the law firm of Kirkland & Ellis.

Prior to her appointment to the bench, Judge Moore taught intellectual property courses at George Mason University School of Law while also serving as an IP litigation consultant to Morgan, Lewis & Bockius. She also taught at the University of Maryland School of Law and at Chicago-Kent College of Law and served as the Associate Director of the Chicago–Kent Intellectual Property Law Program.

Judge Moore is the co-author with the Judge Paul Michel, Chief Judge of the Federal Circuit Court of Appeals, and Raphael Lupo of the textbook *Patent Litigation & Strategy* (WEST 1999). She has authored numerous articles on intellectual property topics and has served as an expert in several patent litigations. At the time of her appointment, Judge Moore was the Editor-in-Chief of the *Federal Circuit Bar Journal*.

Judge Moore has three children with her husband Matt, who is a partner at Howrey LLP.

## **NEWMAN, PAULINE**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-5841

Born: New York, New York  
June 20, 1927



Judge Newman was nominated Judge, U.S. Court of Appeals for the Federal Circuit, by President Reagan on January 30, 1984 and assumed the duties of such office on May 7, 1984. She received a B.A. degree from Vassar College in 1947, an M.A. degree in Pure Science from Columbia University in 1948 and a Ph.D. in Chemistry from Yale University in 1952. She received an L.L.B. degree from New York University School of Law in 1958.

Judge Newman was employed with FMC Corporation in Philadelphia, Pennsylvania from 1954 through 1984. She was Director of Patents and Licensing at FMC Corporation at the time of her appointment to the bench.

Judge Newman has served as president of the Pacific Industrial Property Association, vice-president of the International Trademark Association (formerly the United States Trademark Association), director of the American Intellectual Property Law Association (formerly the American Patent Law Association), director of the American Chemical Society, director of the American Institute of Chemists, and has been a member of the executive committee of the International Patent and Trademark Association, and of the Council of the American Bar Association's Section on Patent, Trademark, and Copyright Law. From 1968 to 1972, Judge Newman was a member of the Board of Directors of the New York Intellectual Property Law Association (formerly the New York Patent, Trademark and Copyright Law Association). She has also served on several public advisory committees, including the Advisory Committee to the Domestic Policy Review of Industrial Innovation (Department of Commerce), the State Department Advisory Committee on International Intellectual Property and the Special Advisory Committee on International Intellectual Property, and the Special Advisory Committee on Patent Office Procedure and Practice. She was a member of the United States Delegation to the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property.

## **PROST, SHARON**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6550

Born: Newburyport, MA



Judge Sharon Prost was appointed to the United States Court of Appeals for the Federal Circuit by President Bush in 2001. Judge Prost received a B.S. from Cornell University in 1973; an M.B.A. from George Washington University in 1975; a J.D. from Washington College of Law, American University in 1979; and an LL.M. from George Washington University School of Law in 1984.

Judge Prost served as Labor Relations Specialist for the United States Civil Service Commission from 1973 to 1976 and Labor Relations Specialist/Auditor for the United States General Accounting Office from 1976 to 1980. Judge Prost was a Field Attorney for the Federal Labor Relations Authority from 1980 to 1983 and an Attorney for the Internal Revenue Office from 1983 to 1984.

She was Assistant Solicitor, Associate Solicitor, and Acting Solicitor for the National Labor Relations Board from 1984 to 1989. Judge Prost was also Chief Labor Counsel (Minority) for the Senate Committee on Labor and Human Resources from 1989 to 1993, as well as Minority Chief Counsel, Deputy Chief Counsel, and Chief Counsel for the Committee on the Judiciary in the United States Senate from 1993 to 2001.

Judge Prost has two children: Matthew and Jeffrey.

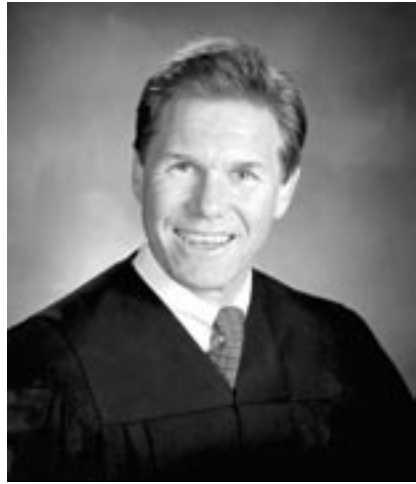
**RADER, RANDALL R.**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-5861

Born: Hastings, Nebraska  
April 21, 1949



Judge Rader was nominated by President Bush on June 12, 1990. On August 3, 1990 the Senate approved the nomination. Judge Rader graduated from Brigham Young University (B.A., 1974) and George Washington University National Law Center (J.D., 1978).

Since 1988, Rader has served on the U.S. Claims Court, and he was counsel to Senator Orrin Hatch (R-Utah) from 1981 to 1988. He also served as chief counsel/staff director on the minority side of the Senate Judiciary Committee's Subcommittee on Patents, Copyrights, and Trademarks (1987-1988), as chief counsel for the Subcommittee on the Constitution, and as general counsel for the Senate Judiciary Committee from 1981 to 1986.

Judge Rader is an Associate Professor of Patent Law at the University of Virginia School of Law and of Trial Advocacy at the National Law Center, The George Washington University.

**SCHALL, ALVIN A.**

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

Office Address:  
Howard T. Markey National  
Courts Building  
717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6562

Born: New York, New York  
April 4, 1944



Alvin A. Schall was appointed to the United States Court of Appeals for the Federal Circuit by President Bush on August 17, 1992 and assumed the duties of office on August 19, 1992. Prior to his appointment, from 1988 to 1992, Judge Schall served as an Assistant to the Attorney General of the United States, with responsibility for civil matters, under Attorneys General Dick Thornburgh and William P. Barr.

From 1987 to 1988, Judge Schall was a member of the Washington, D.C. law firm of Perlman and Partners. From 1978 to 1987, Judge Schall served in the Commercial Litigation Branch of the Civil Division of the Justice Department, first as Trial Attorney and then as Senior Trial Counsel. From 1973 to 1978, Judge Schall was an Assistant United States Attorney in the Office of the United States Attorney for the Eastern District of New York, where he served first in the Criminal Division and then in the Appeals Division, initially as Deputy Chief and then as Chief.

From 1969 to 1973, Judge Schall was an Associate with the law firm of Shearman and Sterling in New York City. Judge Schall is the author of "Federal Contract Disputes and Forums," Chapter 9 in *Construction Litigation: Strategies and Techniques*, published by John Wiley & Sons 1989.

Judge Schall graduated from Tulane Law School in 1969 (J.D.). He received his undergraduate degree (B.A.) from Princeton University in 1966.

Judge Schall is married to the former Sharon Frances LeBlanc. The Schalls have two children: Amanda and Anthony.

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