

2008/2009 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**

The GREENBOOK constitutes a review of the period from December 2007 through May 2009. In realigning the publication schedule so that it more closely coincides with the Association's year, this edition of the GREEN-BOOK covers a two year period.

The closing date for inclusion of new members and for changes to membership contact information was October 15, 2009.

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

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**EDITORIAL
STAFF**

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EDITOR-IN-CHIEF

Stephen J. Quigley

**THE ASSOCIATION'S
SECRETARY**

Charles R. Hoffmann

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BOARD OF DIRECTORS' LIAISON

Theresa M. Gillis

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New York Intellectual Property Law Association, Inc.**

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TABLE OF CONTENTS

PART I

	PAGE
Section 1 Officers; Board of Directors	3
Section 2 Committees.....	7
Section 3 Annual Report of the Treasurer 2007-2009.....	25
Section 4 Former Officers and Directors.....	29
Section 5 Members.....	37

PART II

THE YEAR IN REVIEW

Section 1 NYIPLA Annual Committee Reports.....	289
Section 2 Summary of NYIPLA Amicus Curiae Brief	319
Section 3 Association Events	321
Index.....	337

PART I

SECTION 1

Officers & Board of Directors



Anthony Giaccio
NYIPLA President
2008-2009

OFFICERS AND BOARD OF DIRECTORS 2008-2009



Front row (left to right): NYIPLA Officers Charles R. Hoffmann, Theresa M. Gillis, Anthony Giaccio, Dale L. Carlson, Alice C. Brennan, Christopher A. Hughes. Back row (left to right): NYIPLA Board of Directors Ronald A. Clayton, Anthony F. Lo Cicero, David F. Ryan, John Delehanty and Allan Fanucci. (not shown are Mark Abate, Thomas Meloro, Alexandra Urban, Jeffrey Myers, Doreen Costa,)

OFFICERS 2008-2009

President, ANTHONY GIACCIO

One Broadway, New York, NY 10004

Tel: (212) 504-6891 Fax: (212) 504-6666

President Elect, MARK J. ABATE

599 Lexington Avenue, New York, NY 10022

Tel: (212) 908-6419 Fax: (212) 425-5288

First Vice-President, DALE L. CARLSON

One Century Tower, New Haven, CT 06508

Tel: (203) 498-4385 Fax: (203) 782-2889

Second Vice-President, THERESA M. GILLIS

601 Lexington Avenue, New York, NY 10022

Tel: (212) 896-6631 Fax: (212) 896-6501

Treasurer, ALICE C. BRENNAN

One Verizon Way, Mail Code: VC52N058, Basking Ridge, NJ 07920-1097

Tel: (908) 559-7411 Fax: (908) 559-7111

Secretary, CHARLES R. HOFFMANN

6900 Jericho Turnpike, Syosset, NY 11791

Tel: (516) 822-3550 Fax: (516) 822-3582

Immediate Past President, CHRISTOPHER A. HUGHES

One World Financial Center, New York, NY 10281

Tel: (212) 504-6891 Fax: (212) 504-6666

BOARD OF DIRECTORS 2008-2009

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) 728-8111

ALEXANDRA B. URBAN (2009)

10 Farm Springs Road, Farmington, CT 06032

Tel: (860) 676-5086 Fax: (860) 622-0218

ANTHONY F. LO CICERO (2010)

90 Park Avenue, New York, NY 10016

Tel: (212) 697-5335 Fax: (212) 286-0854

JEFFREY N. MYERS (2010)

150 East 42nd Street, New York, NY 10017

Tel: (212) 733-5061 Fax: (646) 383-9207

DAVID F. RYAN (2010)

1214 Albany Post Road, Croton-on-Hudson, NY 10520

Tel: (914) 271-2225

DOREEN L. COSTA (2011)

30 Rockefeller Plaza, New York, NY 10112

Tel: (212) 408-2576 Fax: (212) 259-2576

JOHN M. DELEHANTY (2011)

666 Third Avenue, New York, NY 10017

Tel: (212) 692-6703 Fax: (212) 983-3115

ALLAN A. FANUCCI (2011)

200 Park Avenue, New York, NY 10166

Tel: (212) 294-3311 Fax: (212) 294-4700

SECTION 2

Committees: 2008-2009

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. 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

WALTER E. HANLEY, JR

Board Liaison

ALICE BRENNAN

Members

THOMAS F. CREEL	THOMAS F. MEAGHER
DANIEL EBENSTEIN	CHARLES E. MILLER
WILLIAM FEILER	MERRI MOKEN
STANLEY H. LIEBERSTEIN	JACK A. O'BRIEN
HUI LIU	DAVID W. PLANT
LAWRENCE SCINTO	

Committee on Amicus Briefs

Scope of the Committee. To coordinate the activities of the Association relating to preparation and submission of amicus briefs, and to make recommendations with respect thereto to the Board of Directors.

Chair

CHARLES WEISS

Board Liaison

DAVID F. RYAN

Members

BRIDGETTE AHN	CHUCK MILLER
TOM BECK	STEVEN MOORE
PETER FELFE	ROB RANDO
DENNIS GREGORY	IRENA ROYZMAN
MARYLEE JENKINS	DAVE RYAN
JEFF LEWIS	PETE SAXON
KEVIN MEEHAN	ROCHELLE SEIDE
JINNY SUH	

Committee on Antitrust, Inequitable Conduct and Misuse

Scope of the 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

DOUGLAS R. NEMEC

Board Liaison

DAVID F. RYAN

Members

PHILIP BLUM	SCOTT HOWARD
CLARK CRADDOCK	ROBERT ISACKSON
MICHAEL DALLAL	EDWARD MEILMAN
NICHOLAS GIOVE	SAFET METJAHIC

Committee on Biotechnology

Scope of the Committee. To consider intellectual property issues having an impact on the biotechnology sector, and to make recommendations with respect thereto to the Board of Directors.

Chair

THOMAS GALLAGHER

Board Liaison

ALLAN FANUCCI

Committee on Chemical/ Pharmaceutical

Scope of the Committee. To consider intellectual property issues having an impact on the chemical/pharmaceutical sectors, and to make recommendations with respect thereto to the Board of Directors.

Chair

MICHAEL K. LEVY

Board Liaison

ALLAN FANUCCI

Committee on Continuing Legal Education

Scope of the 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

DOROTHY R. AUTH

Board Liaison

THOMAS J. MELORO

Members

KAREN AXT	TOD MELGAR
AMY BENJAMIN	RICHARD PARKE
DAVID BOMZER	SUSAN PROGOFF
ANNA ERENBURG	DEBRA RESNICK
SONJA KEENAN	MARY RICHARDSON
WAN CHIEH LEE	IRENA ROYZMAN
RICHARD MARGIANO	KEITH ZULLOW

Committee on Coordinating

Scope of the Committee. To coordinate the information and efforts of the Amicus Briefs Committee, the Legislative Oversight Committee, and the USPTO Oversight Committee, and to make recommendations with respect thereto to the Board of Directors.

Chair

DAVID F. RYAN

Board Liaison

ANTHONY GIACCIO

Committee on Copyrights

Scope of the 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.

Chair

DAVID A. EINHORN

Board Liaison

RONALD A. CLAYTON

Members

MICHAEL BRYNER	ANDREW KOENIG
NICHOLAS EISENMAN	KIMBERLY KORN
LEESA FENDERSON	KATHLEEN MCCARTHY
DOUGLAS KENYON	GEORGE M. MCDONALD
RICHARD B. KLAR	ROBERT L. POWLEY

Committee on Corporate Practice

Scope of the Committee. To consider intellectual property issues having an impact on in-house intellectual property counsel, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs

SUSAN MCGAHAN and ALEXANDRA B. URBAN

Board Liaison

ALEXANDRA B. URBAN

Members

ERIC M. AGOVINO	GEORGE M. MACDONALD
ALICE C. BRENNAN	JAMES MARKARIAN
MICHELLE J. BURKE	KRISTIN JOSLYN MCNAMARA
VICTOR COLE	SAMUEL H. MEGERDITCHIAN
KEVIN C. ECKER	KELLY MERKEL
MATTHEW J. GOLDEN	MARK SCHILDKRAUT
JOY S. GOUDIE	FRANK P. SEDLARCIC
CAREN K. KHOO	JAIME A. SIEGEL
DAVID H. VICKREY	

Committee on Design Protection

Scope of the Committee. To study the protection of designs and related legislative proposals, and to make recommendations with respect thereto to the Board of Directors.

Chair

THOMAS E. SPATH

Board Liaison

JOHN DELEHANTY

Members

URSULA B. DAY
MARK D. MARIN

MONICA BHATTACHARYYA
JONATHAN MOSKIN

Committee on Discovery

Scope of the Committee. To consider discovery issues in intellectual property cases, and to make recommendations with respect thereto to the Board of Directors.

Chair

JEFFREY S. GINSBERG

Board Liaison

JOHN DELEHANTY

Committee on Electronics/Computers

Scope of the Committee. To consider intellectual property issues having an impact on the electronics/computer sectors, and to make recommendations with respect thereto to the Board of Directors.

Chair

NEIL P. SIROTA

Board Liaison

RONALD A. CLAYTON

Committee on Financial Industry

Scope of the Committee. To consider intellectual property issues having an impact on the financial sector, and to make recommendations with respect thereto to the Board of Directors.

Chair

ROBERT H. FISCHER

Board Liaison

RONALD A. CLAYTON

Committee on International IP Law

Scope of the 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, and to make recommendations with respect thereto to the Board of Directors.

Chair

SAMSON HELFGOTT

Board Liaison

ANTHONY LO CICERO

Members

JACOB ADAMS	MICHAEL MERCANTI
TOM BEAN	KEVIN MOSS
IRENE BROOKINS	WILLIAM O’SULLIVAN
DON CAMERON	GARO PARTOYAN
PINA CAMPAGNA	SHIPA PATEL
ALBERT WAI-KIT CHAN	JOHN PEGRAM
YONG CHEN	STEVEN PURDY
PAUL CONNUCK	RORY RADDING
PETER FELFE	VIC SIBER
JOHN GULBIN	KENNETH SONNENFELD
HANYONG LE	THOMAS SPATH
MATTHEW LOWE	SHIRLEY WANG

Committee on Internet Law

Scope of the 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

Committee on Inventors of the Year Awards

Scope of the Committee. To publicize, gather nominations, and review nominations for Inventors of the Year awards, and to make recommendations with respect thereto to the Board of Directors.

Chair

JOHN T. MOEHRINGER

Board Liaison

THERESA M. GILLIS

Committee on Law School Writing Competition Awards

Scope of the Committee. To publicize and conduct a law school writing competition on an intellectual property law topic, and to make recommendations with respect thereto to the Board of Directors.

Chair

MAREN PERRY

Board Liaison

THOMAS J. MELORO

Committee on Legislative Oversight

Scope of the Committee. To monitor and report to the Association developments relating to intellectual property legislation, and to make recommendations with respect thereto to the Board of Directors.

Chair

JOHN W. RYAN

Board Liaison

CHARLES R. HOFFMANN

Member

CHRIS MCWHINNEY

Committee on License to Practice Requirements

Scope of the 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 with respect thereto to the Board of Directors.

Chair

JAY H. ANDERSON

Board Liaison

ALLAN FANUCCI

Committee on Licensing

Scope of the Committee. To consider intellectual property licensing issues, and to make recommendations with respect thereto to the Board of Directors.

Chair

PAUL RAGUSA

Board Liaison

CHARLES R. HOFFMANN

Committee on Litigation Practice and Procedure

Scope of the 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

BARTHOLOMEW VERDIRAME

Board Liaison

ANTHONY LO CICERO

Members

MARY ANN BALL

STANLEY LIANG

COLIN FOLEY

JEFFREY LIAO

DAVID C. HABER

DOUGLAS R. NEMEC

ALISON HANSTEAD

JOHN F. RESEK

Committee on Local Patent Rules

Scope of the Committee. To consider legislation and rules affecting practice and procedural matters in intellectual property litigation in the District Courts, and other matters relating to practice in such litigation, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs

DANIEL A. DEVITO and ROBERT C. SCHEINFELD

Board Liaison

ANTHONY LO CICERO

Member

VICTOR COLE

Committee on Meetings and Forums

Scope of the Committee. To prepare and conduct a series of monthly 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

RICHARD W. ERWINE

Board Liaison

ALEXANDRA B. URBAN

Members

CHERYL AGRIS	RORY RADDING
ANGIE HANKINS	KEVIN REINER
DAVID LORENZ	DEBRA RESNICK
RICH MARTINELLI	MARK SCHILDKRAUT
ROLAND PLOTTEL	VICTOR SOUTO
JENNIFER WU	

Committee on Membership

Scope of the 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

DOLLY ALEVIZATOS

VICTORIA J.B. DOYLE

ERIN HENNESY

LESLIE K. MITCHELL

ALICIA RUSSO

DEENA LEVY WEINHOUSE

Committee on Multinational IP Litigation

Scope of the Committee. To consider intellectual property issues relating to multinational litigations, and to make recommendations with respect thereto to the Board of Directors.

Chair

JEFFREY M. BUTLER

Board Liaison

ANTHONY LO CICERO

Members

DON CAMERON

WAYNE CONDON

ROBERT ISACKSON

HANYONG LEE

VERONICA MULLALLY

RORY RADDING

DIANA SANTOS

JOHN P. WHITE

Committee on Outreach

Scope of the Committee. To identify and create a strategy for the Association to reach out to organizations with which the Association has not traditionally interacted, and to make recommendations with respect thereto to the Board of Directors.

Chair

ALICIA RUSSO

Board Liaison

THOMAS J. MELORO

Committee on Patent Law and Practice

Scope of the Committee. To consider all aspects of patent laws and practice which affect the rights of United States entities in technology and to make recommendations with respect thereto to the Board of Directors.

Chair

WILLIAM H. DIPPERT

Board Liaison

JEFFREY N. MYERS

Committee on Patentable Subject Matter

Scope of the Committee. To consider all aspects of patentable subject matter in the United States, and to make recommendations with respect thereto to the Board of Directors.

Chair

PETER LUDWIG

Board Liaison

DAVID F. RYAN

Committee on Privacy Law

Scope of the Committee. To consider all aspects of privacy law in the United States, and to make recommendations with respect thereto to the Board of Directors.

Chair

JONATHAN E. MOSKIN

Board Liaison

DOREEN L. COSTA

Members

STEVEN C. BENNETT	MARGERY NATHANSON
SANDRA L. KIRSCH	MAURICIO PAEZ
JONATHAN MOSS	ROLAND PLOTTEL
JOEL SCHMIDT	

Committee on Protection of Privilege

Scope of the Committee. To consider all aspects of the protection of privilege in the United States, and to make recommendations with respect thereto to the Board of Directors.

Chair

PETER C. SCHECHTER

Board Liaison

ANTHONY LO CICERO

Committee on Publications

Scope of the 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 of Directors.

Chair

STEPHEN J. QUIGLEY

Board Liaison

DALE L. CARLSON

Members

SUJATA CHAUDHRI ROBERT GREENFELD
WILLIAM DIPPERT JOHN GULBIN
MARY RICHARDSON

Committee on Records

Scope of the Committee. It shall be the duty of this Committee to preserve the records and publications of this Association.

Co-Chairs

PETER SAXON and THOMAS L. CREEL

Board Liaison

DALE L. CARLSON

Committee on Trade Secret Law and Practice

Scope of the 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

PAUL W. GARITY

Board Liaison

DOREEN L. COSTA

Committee on Trademark Law and Practice

Scope of Committee: To consider all aspects of trademark law and practice, and to make recommendations with respect thereto to the Board of Directors.

Chair

AMY J. BENJAMIN

Board Liaison

DOREEN L. COSTA

Members

DAVID BADANES	JASON KORAL
KAREN BROMBERG	KATHLEEN MCCARTHY
PINA CAMPAGNA	SUSAN PROGOFF
URSULA DAY	JOEL KARNI SCHMIDT
STEVE FEINGOLD	HOWARD SHIRE
MICHELLE GRAHAM	DEBRA SMITH
DAVID WERNER	

Committee on Trial Advocacy and Preparation

Scope of the Committee. To consider trial advocacy and preparation issues, and to make recommendations with respect thereto to the Board of Directors.

Chair

ANNEMARIE HASSETT

Board Liaison

RONALD A. CLAYTON

Committee on USPTO Oversight

Scope of the Committee. To monitor operations and changes in the rules and regulations of the USPTO, and to report with respect thereto to the Board of Directors.

Chair

PETER G. THURLOW

Board Liaison

DAVID F. RYAN

Committee on Young Lawyers

Scope of the Committee. To address the concerns and needs of minorities, women and newly-admitted lawyers, and to report with respect thereto to the Board of Directors.

Chair

SONJA KEENAN

Board Liaison

ANTHONY GIACCIO

Members

ZAED BILLAH	JENNIFER LEE
REBECCA CANTOR	VINNY LEE
ANDREW CHIEN	GABRIELLE MARKESON
THOMAS DESIMONE	JULIE MARTIN
AIMEE DROUIN	GREG MASKEL
SIDDHARTH FERNANDES	BENU MEHRA
JOHN HALSKI	RICHARD MILLS-ROBERTSON
KRISTINA HANSON	ROBERT ROSASCO
ALISON HANSTEAD	LARRY ROSENTHAL
JASPAL HARE	DEBRA SMITH
AIMEE KAPLAN	ANDREW STEIN
KIMBERLY KORN	EDWARD TULIN
	JENNIFER WU

SECTION 3

Treasurer's Report 2007-2009

ANNUAL REPORTS OF THE TREASURER 2007-2009

THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC. STATEMENTS OF FINANCIAL POSITION - CASH BASIS APRIL 30

	<u>2009</u>	<u>2008</u>
ASSETS		
<hr/>		
CURRENT ASSETS		
Cash – Checking Accounts	\$1,066,429	\$1,104,052
Money Market Account	9,368	9,279
Certificate of Deposit – Due 5/5/09	84,993	83,558
Certificate of Deposit – Due 10/13/09	35,347	34,499
Certificate of Deposit – Due 5/5/09	87,795	85,532
Certificate of Deposit – Due 2/28/10	35,993	35,174
	<hr/>	<hr/>
TOTAL ASSETS	<u>\$1,319,925</u>	<u>\$1,352,094</u>
 NET ASSETS		
<hr/>		
Unrestricted Net Assets	<u>\$1,319,925</u>	<u>\$1,352,094</u>
TOTAL NET ASSETS	<u>\$1,319,925</u>	<u>\$1,352,094</u>

**THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.
STATEMENTS OF ACTIVITIES & CHANGES IN NET ASSETS - CASH BASIS
FOR THE YEARS ENDED APRIL 30**

	<u>2009</u>	<u>2008</u>
Changes in Unrestricted Net Assets		
<u>REVENUES</u>		
Annual Dues Income	\$265,545	\$178,305
CLE Program Income	118,633	79,580
Judges Dinner Income	1,154,769	1,196,055
Annual Meeting Income	16,375	15,280
Other Events Income	0	140,695
Interest Income / Other Income	7,588	15,276
Total Unrestricted Revenues	<u>\$1,562,910</u>	<u>\$1,625,191</u>
<u>EXPENSES</u>		
CLE Program Expense	\$89,666	\$59,699
Judges Dinner Expense	799,497	734,221
Annual Meeting Expense	31,557	19,859
CAFC Dinner Expense	11,127	127,999
Board of Directors Meeting Expense	13,925	10,135
Consulting Expense	574,166	366,667
Printing Expense	16,099	32,854
Membership Support Expense	3,955	3,317
Accounting Expense	7,628	2,416
Insurance Expense	16,100	1,631
Conner Inn of Court Sponsorship	10,000	0
Scholarship Expense	1,100	10,000
General Sponsorship Expense	5,000	5,000
Committee Meeting Expense	506	6,566
Administrative Expense	8,475	6,316
Website Expense	3,900	3,300
Young Lawyers Expense	139	3,586
Past Presidents Dinner Expense	0	9,904
Credit Card Processing Fees	1,641	3,859
Bank Service Charges	236	261
Miscellaneous Expense	362	0
Total Expenses	<u>\$1,595,079</u>	<u>\$1,407,560</u>
Increase (Decrease) in Unrestricted Net Assets	<u>(\$32,169)</u>	<u>\$217,631</u>
Unrestricted Net Assets at Beginning of Period	<u>\$1,352,094</u>	<u>\$1,134,463</u>
Unrestricted Net Assets at End of Period	<u>\$1,319,925</u>	<u>\$1,352,094</u>

SECTION 4

Former Officers & Directors

PRESIDENTS

Wm. Houston Kenyon	1922-1925	Albert C. Johnston	1966-1967
John P. Bartlett	1925-1926	John T. Kelton	1967-1968
Hubert Howson	1926-1927	Hugh A. Chapin	1968-1969
Edwin J. Prindle	1927-1928	Edward Halle	1969-1970
Thomas Ewing	1928-1929	Alfred L. Haffner, Jr.	1970-1971
William A. Redding	1929-1930	Frank W. Ford, Jr.	1971-1972
Rickard Eyre	1930-1931	William C. Conner	1972-1973
Charles Neave	1931-1932	Joseph J. Previto	1973-1974
William H. Davis	1932-1933	Stanton T. Lawrence, Jr.	1974-1975
Oscar W. Jeffrey	1933-1934	Lorimer P. Brooks	1975-1976
Fritz V. Briesen	1934-1935	Morris Relson	1976-1977
George Ramsey	1935-1936	Bert A. Collison	1977-1978
William B. Greeley	1936-1937	John A. Reilly	1978-1979
Merrell E. Clark	1937-1938	William F. Eberle	1979-1980
Albert G. Davis	1938-1939	Jerome G. Lee	1980-1981
Clifton V. Edwards	1939-1940	Albert Robin	1981-1982
Theodore S. Kenyon	1940-1941	Paul M. Enlow	1982-1983
Dean S. Edmonds	1941-1942	Douglas W. Wyatt	1983-1984
Newton A. Burgess	1942-1943	Lee C. Robinson, Jr.	1984-1985
Stephen H. Philbin	1943-1944	John O. Tramontine	1985-1986
Robert W. Byerly	1944-1945	Karl F. Jorda	1986-1987
Lawrence Bristol	1945-1946	Paul H. Heller	1987-1988
Clair W. Fairbank	1946-1946	David H.T. Kane	1988-1989
R. Morton Adams	1946-1947	John B. Pegram	1989-1990
Charles H. Walker	1947-1948	Frank F. Scheck	1990-1991
Alan N. Mann	1948-1949	Peter Saxon	1991-1992
Worthington Campbell	1949-1950	M. Andrea Ryan	1992-1993
Giles S. Rich	1950-1951	William J. Gilbreth	1993-1994
Alexander C. Neave	1951-1952	Pasquale A. Razzano	1994-1995
Frank E. Barrows	1952-1953	Thomas L. Creel	1995-1996
Granville M. Brumbaugh	1953-1954	Martin E. Goldstein	1996-1997
Norman N. Holland	1954-1955	Edward V. Filardi	1997-1998
Floyd H. Crews	1955-1956	Howard B. Barnaby	1998-1999
W. Houston Kenyon, Jr.	1956-1957	Herbert F. Schwartz	1999-2000
Henry R. Ashton	1957-1958	John F. Sweeney	2000-2001
David S. Kane	1958-1959	Robert Neuner	2001-2002
James B.L. Orme	1959-1960	Richard L. DeLucia	2002-2003
Wallace H. Martin	1960-1961	Melvin C. Garner	2003-2004
Mark N. Donohue	1961-1962	John D. Murnane	2004-2005
Cyrus S. Hapgood	1962-1963	Edward E. Vassallo	2005-2006
Ralph L. Chappell	1963-1964	Marylee Jenkins	2006-2007
Harry R. Pugh, Jr.	1964-1965	Christopher A. Hughes	2007-2008
John N. Cooper	1965-1966		

SECRETARIES

Conrad A. Dietrich	1922-1925	Bert A. Collison	1968-1970
Crichton Clarke	1925-1931	Caspar C. Schneider, Jr.	1970-1973
R. R. Adams	1931-1934	Kenneth E. Madsen	1973-1977
Charles H. Keel	1934-1944	Paul H. Heller	1977-1981
David A. Woodcock	1944-1946	John B. Pegram	1981-1984
Elmer R. Helferich	1946-1949	Peter Saxon	1984-1987
Leland L. Chapman	1949-1952	Pasquale A. Razzano	1987-1990
William J. Barnes	1952-1955	William H. Dippert	1991-1996
Stewart L. Whitman	1955-1956	John F. Sweeney	1996-1998
Elmer R. Mandelbaum	1956-1958	Melvin C. Garner	1998-2000
Charles E. McTiernan	1958-1961	Edward E. Vassallo	2000-2002
Frank W. Ford, Jr.	1961-1964	Mark J. Abate	2002-2006
Alfred L. Haffner, Jr.	1964-1968	Theresa M. Gillis	2006-2007

TREASURERS

Philip Farnsworth	1922-1924	Mary-Ellen M. Timbers	1984-1989
Albert F. Nathan	1924-1931	Howard B. Barnaby	1989-1995
Frank E. Barrows	1931-1945	Gregory J. Battersby	1995-1997
John C. Blair	1945-1948	John D. Murnane	1997-2001
Albert C. Nolte	1948-1969	Marylee Jenkins	2001-2003
Henry C. Dearborn	1969-1973	Susan E. McGahan	2003-2005
Edward H. Valance	1973-1978	John Daniel	2005-2007
Arthur S. Tenser	1978-1982	Theresa M. Gillis	2007-2008
Alexander J. McKillop	1982-1984		

PRESIDENT ELECT†

Jerome G. Lee	1979-1980	Thomas L. Creel	1994-1995
Albert Robin	1980-1981	Martin E. Goldstein	1995-1996
Paul M. Enlow	1981-1982	Edward V. Filardi	1996-1997
Douglas W. Wyatt	1982-1983	Howard B. Barnaby	1997-1998
Lee C. Robinson, Jr.	1983-1984	Herbert F. Schwartz	1998-1999
John O. Tramontine	1984-1985	John F. Sweeney	1999-2000
Karl F. Jorda	1985-1986	Robert Neuner	2000-2001
Paul H. Heller	1986-1987	Richard L. DeLucia	2001-2002
David H.T. Kane	1987-1988	Melvin C. Garner	2002-2003
John B. Pegram	1988-1989	John D. Murnane	2003-2004
Frank F. Scheck	1989-1990	Edward E. Vassallo	2004-2005
Peter Saxon	1990-1991	Marylee Jenkins	2005-2006
M. Andrea Ryan	1991-1992	Christopher Hughes	2006-2007
William J. Gilbreth	1992-1993	Anthony Giaccio	2007-2008
Pasquale A. Razzano	1993-1994		

1ST 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

1ST VICE PRESIDENTS

Thomas L. Creel	1993-1994	Melvin C. Garner	2001-2002
Martin E. Goldstein	1994-1995	John D. Murnane	2002-2003
Edward V. Filardi	1995-1996	Edward E. Vassallo	2003-2004
Howard B. Barnaby	1996-1997	Marylee Jenkins	2004-2005
Herbert F. Schwartz	1997-1998	Christopher A. Hughes	2005-2006
John F. Sweeney	1998-1999	Anthony Giaccio	2006-2007
Robert Neuner	1999-2000	Mark J. Abate	2007-2008
Richard L. DeLucia	2000-2001		

2ND VICE PRESIDENTS

William H. Davis	1922-1923	Jerome G. Lee	1977-1979
Hubert Howson	1923-1926	Paul M. Enlow	1979-1981
Thomas Ewing	1926-1927	Lee C. Robinson, Jr.	1981-1983
Dean S. Edmonds	1927-1930	Karl F. Jorda	1983-1985
John C. Kerr	1930-1931	David H. T. Kane	1985-1986
S. Mortimer Ward, Jr.	1931-1933	John B. Pegram	1986-1987
Newton A. Burgess	1933-1936	Frank F. Scheck	1987-1988
Lawrence Bristol	1936-1939	Peter Saxon	1988-1989
Stephen H. Philbin	1939-1942	M. Andrea Ryan	1989-1990
Worthington Campbell	1942-1945	William J. Gilbreth	1990-1991
Giles S. Rich	1945-1947	Pasquale A. Razzano	1991-1992
David A. Woodcock	1947-1949	Thomas L. Creel	1992-1993
Thomas J. Byrne	1949-1951	Martin E. Goldstein	1993-1994
Victor D. Borst	1951-1953	Edward V. Filardi	1994-1995
Howard W. Dix	1953-1955	Howard B. Barnaby	1995-1996
Virgil C. Kline	1955-1957	Herbert F. Schwartz	1996-1997
George S. Hastings	1957-1959	Gregory J. Battersby	1997-1998
Lawrence B. Dodds	1959-1961	Robert Neuner	1998-1999
Cyrus S. Hapgood	1961-1962	Richard L. DeLucia	1999-2000
John N. Cooper	1962-1964	Melvin C. Garner	2000-2001
Albert C. Johnston	1964-1965	John D. Murnane	2001-2002
Hugh A. Chapin	1965-1967	Edward E. Vassallo	2002-2003
William R. Woodward	1967-1969	Marylee Jenkins	2003-2004
William C. Conner	1969-1971	Christopher A. Hughes	2004-2005
Stanton T. Lawrence, Jr.	1971-1973	Anthony Giaccio	2005-2006
Morris Relson	1973-1975	Mark J. Abate	2006-2007
Bert A. Collison	1975-1976	Dale L. Carlson	2007-2008
John A. Reilly	1976-1977		

3RD VICE PRESIDENTS

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	Manvel Whitmore	1933-1936
John P. Bartlett	1922-1924	Oscar W. Jeffrey	1934-1935
	1926-1927	John Parry	1934-1937
	1928-1943	Frederick S. Duncan	1934-1937
Arthur C. Fraser	1922-1924	Victor D. Borst	1934-1938
Harry E. Knight	1922-1924	Robert W. Byerly	1935-1938
Hubert Howson	1922-1925		1945-1948
	1927-1928	Albert G. Davis	1935-1938
	1922-1925		1939-1940
James Q. Rice		Ramsey Hoguet	1936-1937
Samuel O. Edmonds	1922-1926	Stephen J. Cox	1936-1939
John R. Nolan	1922-1926	R.J. Dearborn	1936-1939
Archibald Cox	1922-1929	Henry D. Williams	1937-1938
Wm. Houston Kenyon	1925-1926	William B. Greeley	1937-1938
Livingston Gifford	1923-1925	Dean S. Edmonds	1937-1940
Clifton V. Edwards	1924-1927		1942-1943
	1940-1941		1951-1954
John C. Kerr	1924-1927	Otto S. Schairer	1937-1940
Arba B. Marvin	1924-1927	H. Monroe Humason	1938-1939
C.C. Billings	1925-1928	Howard W. Dix	1938-1941
William G. McKnight	1925-1928	Kenneth S. Neal	1938-1941
Edwin J. Prindle	1925-1929	Louis P. Whitaker	1938-1941
Richard Eyre	1926-1929	Samuel E. Darby, Jr.	1939-1942
	1931-1932	Merrell E. Clark	1939-1940
S. Mortimer Ward, Jr.	1926-1929	Clair W. Fairbank	1939-1942
	1939-1942		1947-1948
Carl P. Goepel	1927-1930	Clarence D. Kerr	1940-1943
Alfred W. Kiddle	1927-1930	George F. Scull	1940-1943
John F. Neary	1927-1930	John B. Hayward	1941-1944
Merrel E. Clark	1928-1931	F. Bascom Smith	1941-1944
Wallace White	1928-1929	Thomas J. Byrne	1942-1945
	1929-1931		1946-1949
Alan N. Mann	1934-1936	William T. Kniesner	1943-1946
	1946-1948	Newton A. Burgess	1943-1944
	1949-1950	R. Morton Adams	1943-1945
Thomas Ewing	1929-1930		1947-1950
Lawrence Bristol	1929-1932	Harry G. Kimball	1943-1945
	1946-1947	Charles H. Walker	1943-1946
George E. Folk	1929-1932		1948-1951
Edmond Q. Moses	1929-1932	Stephen H. Philbin	1944-1945
	1941-1944	Victor S. Beam	1944-1947
William A. Redding	1930-1931	George T. Bean	1944-1947
James J. Cosgrove	1930-1933	Walter E. F. Bradley	1944-1945
Herbert H. Dyke	1930-1933		1945-1946
E. Clarkson Seward	1930-1933	Robert W. Byerly	1945-1946
Theodore S. Kenyon	1931-1934	William Bohleber	1945-1948
	1941-1942	Harry G. Grover	1945-1948
Lawrence Langner	1931-1934	Granville M. Brumbaugh	1946-1949
	1942-1945		1954-1955
Charles Neave	1932-1933	Worthington Campbell	1947-1949
Robert Starr Allyn	1932-1935		1950-1951
	1948-1949	Wallace H. Martin	1947-1950
Fritz V. Briesen	1932-1934		1961-1962
	1935-1936	Norman N. Holland	1948-1951
A. Parker-Smith	1932-1935		1955-1956
William H. Davis	1933-1934	Charles H. Keel	1948-1950
George Ramsey	1933-1934	Elmer R. Helfferich	1949-1950
	1936-1937	W. Houston Kenyon, Jr.	1949-1952
Leonard A. Watson	1933-1936		1957-1958
	1942-1945		

BOARD OF DIRECTORS

Edmund H. O'Brien	1949-1952	Charles E. McTiernan	1963-1966
Giles S. Rich	1949-1950	Ralph L. Chappell	1964-1965
	1951-1954	Robert Osann	1964-1967
John Hoxie	1950-1951	Henry E. Sharpe	1964-1967
	1958-1961	William R. Woodward	1964-1967
Floyd H. Crews	1950-1953	John W. Brumbaugh	1965-1968
	1956-1957	John N. Cooper	1965-1966
Virgil C. Kline	1950-1952	W. Phillip Churchill	1966-1969
	1956-1957	William E. Dampier	1966-1969
Leslie D. Taggart	1950-1953	John R. Shipman	1966-1969
	1965-1968	Albert C. Johnston	1967-1968
Alexander C. Neave	1952-1953	Horace B. Fay	1967-1970
Frank E. Barrows	1953-1954	Joseph J. Previto	1967-1970
James B.L. Orme	1958-1959		1974-1975
	1960-1961	Arthur S. Tenser	1967-1970
Morris Kirschstein	1951-1954	John T. Kelton	1968-1969
Joe D. Daniels	1952-1955	Frederick C. Carver	1968-1971
Laurence B. Dodds	1952-1955	Robert S. Dunham	1968-1971
George E. Middleton	1952-1955	Alfred L. Haffner, Jr.	1968-1971
Henry R. Ashton	1953-1956		1971-1972
	1958-1959	Alan Latman	1968-1971
Victor D. Broman	1953-1956	Pauline Newman	1968-1972
Harry R. Mayers	1953-1956	Hugh A. Chapin	1969-1972
Stewart L. Whitman	1954-1955	Daniel H. Kane	1969-1972
Walter H. Free	1954-1957	Morris Relson	1969-1972
Cyrus S. Hapgood	1954-1957		1977-1978
	1963-1964	Edward Halle	1970-1971
A. Robert Noll	1955-1958	Ronald F. Ball	1970-1973
Leonard J. Robbins	1955-1958	Robert J. Sanders, Jr.	1970-1973
Clinton B. Townsend	1955-1958	Samuel L. Welt	1970-1973
George S. Hastings	1956-1957	Daniel H. Brown	1971-1974
Paul R. Ames	1956-1959	Jerome G. Lee	1971-1974
W. Brown Morton, Jr.	1956-1959	Frank W. Ford, Jr.	1972-1973
John Schulman	1957-1960		1981-1982
	1965-1968	George W. Price	1971-1974
Walter J. Halliday	1957-1960	Morton D. Goldberg	1972-1975
Paul S. Bolger	1957-1960	Kenneth E. Madsen	1972-1973
Donald L. Dickerson	1958-1961	William C. Conner	1973-1974
Trenton Meredith	1958-1961		1977-1980
Mark D. Donohue	1959-1960	Edward H. Valance	1972-1973
	1962-1965		1978-1980
David S. Kane	1959-1962	Evans Kahn	1973-1976
Harry R. Pugh, Jr.	1959-1962	Richard T. Laughlin	1973-1975
	1965-1966	Eric D. Offner	1973-1976
James B.L. Orme	1960-1961	Caspar C. Schneider, Jr.	1973-1976
Albert C. Johnston	1960-1962	George W. Whitney	1973-1976
John A. Reilly	1960-1963	Anthony R. DeSimone	1974-1977
Harry R. Sage	1960-1963	Martin Kalikow	1974-1977
Wallace H. Martin	1961-1962	Albert Robin	1974-1977
Russell G. Pelton	1961-1964		1982-1983
Gordon A. Wilkins	1961-1964	William F. Kilgannon	1975-1978
Lorimer P. Brooks	1961-1964	Michael J. Quillinan	1975-1978
	1976-1977	John A. Reilly	1975-1978
Sylvester J. Liddy	1961-1963		1979-1980
Henry W. Koster	1962-1965	J. Phillip Anderegg	1976-1978
Robert E. Isner	1962-1965	David H. T. Kane	1976-1979
Phillip T. Dalsimer	1963-1966		1989-1990
Stanton T. Lawrence, Jr.	1963-1966	John C. Vassil	1976-1979
	1975-1976		

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BOARD OF DIRECTORS *(Continued)*

Douglas W. Wyatt	1976-1979	Peter Saxon	1991-1992
	1984-1985	David J. Mugford	1990-1993
Paul M. Enlow	1977-1979	Gregory J. Battersby	1991-1994
	1983-1984	Edward V. Filardi	1991-1994
William F. Dudine, Jr.	1977-1980		1998-1999
Lee C. Robinson, Jr.	1978-1981	Roger S. Smith	1991-1994
	1985-1986	John D. Murnane	1992-1995
Bert A. Collison	1978-1979		2005-2006
John P. Sinnott	1978-1981	John F. Sweeney	1992-1995
Edgar W. Adams, Jr.	1979-1982		2001-2002
Stanley H. Lieberstein	1979-1982	Berj A. Terzian	1992-1995
Lawrence F. Scinto	1979-1982	Ronald A. Bleeker	1995-1996
John O. Tramontine	1979-1980	William J. Brunet	1993-1996
	1986-1987	William F. Lawrence	1993-1996
John M. Calimafde	1980-1983	Herbert F. Schwartz	1993-1996
William F. Eberle	1980-1981		2000-2001
Karl F. Jorda	1980-1983	Michael J. Kelly	1994-1997
	1987-1988	Thomas E. Spath	1994-1997
Alexander J. McKillop	1980-1983	Marilyn M. Brogan	1995-1998
Paul H. Heller	1981-1984	Richard DeLucia	1995-1998
	1988-1989		2002-2003
Siegrun D. Kane	1981-1984	Robert Neuner	1995-1998
Ewan C. MacQueen	1981-1984		2002-2003
Richard G. Berkley	1982-1985	Theresa M. Gillis	1996-1999
Barry Evans	1982-1985	Edward E. Vassallo	1996-1999
Frank F. Scheck	1982-1985		2006-2007
	1991-1992	Alice Brennan	1997-2000
James W. Badie	1983-1986	John Daniel	1997-2000
Maria C.H. Lin	1983-1986	Thomas A. O'Rourke	1997-2000
Michael N. Meller	1983-1986	Charles P. Baker	1998-2001
John B. Pegram	1983-1986	Edward M. Blocker	1998-2001
	1990-1991	Susan McHale McGahan	1998-2001
Walter J. Baum	1984-1987		2005-2006
Herbert Blecker	1984-1987	Marylee Jenkins	1998-2001
William F. Lawrence	1984-1987	Mark J. Abate	1999-2002
Philip Furgang	1985-1988	Ira J. Levy	1999-2002
Elsie M. Quinlan	1985-1988	Dawn Buonocore	2000-2003
Pasquale A. Razzano	1985-1988	Cecilia O'Brien Lofters	2000-2003
	1995-1996	Rory J. Radding	2000-2003
Howard B. Barnaby	1986-1989	Thomas H. Beck	2001-2002
	1999-2000	Christopher A. Hughes	2001-2004
Samson Helfgott	1986-1989	Robert C. Morgan	2001-2004
M. Andrea Ryan	1986-1989	Anthony M. Santini	2001-2004
	1993-1994	William H. Dippert	2002-2005
Alfred P. Ewert	1987-1990	Charles R. Hoffmann	2002-2005
Leonard B. Mackey	1987-1990	Jack D. Slobod	2002-2005
William J. Gilbreth	1987-1990	Melvin C. Garner	2004-2005
	1994-1995	Anthony Giaccio	2003-2005
Dale L. Carlson	1988-1991	Laura A. Coruzzi	2003-2006
	2004-2007	Daniel A. DeVito	2003-2006
John E. Kidd	1988-1991	Robert C. Scheinfeld	2004-2007
Evelyn M. Sommer	1988-1991	Vincent N. Palladino	2004-2007
Thomas L. Creel	1989-1992	Karl Milde	2005-2008
	1996-1997	Philip T. Shannon	2005-2008
Martin E. Goldstein	1989-1992	W. Edward Bailey	2005-2008
	1997-1998		
Stanley J. Silverberg	1989-1992		
Robert L. Baechtold	1990-1993		

SECTION 5

Members

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.

* Adopted October 16, 1973.

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Agris, Cheryl H. '03

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Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
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PART II

THE YEAR IN REVIEW

Section 1

NYIPLA
Annual Committee Reports

NYIPLA ANNUAL COMMITTEE REPORTS 2008-2009 TERM

AMICUS BRIEFS COMMITTEE

David F. Ryan, Chair

The Committee considered several requests from interested parties for amicus appearance in Federal Circuit cases, generally in connection with petitions for rehearing en banc. Because the time in which to file amicus briefs in support of petitions for rehearing is short, the Committee considered that amicus participation at this stage would be warranted only in cases of general importance in which a consensus of the Committee and Board in support of a position would be likely. Additionally, a substantial number of Committee members recused themselves from consideration of several requests, thereby limiting the resources available for preparation of a brief. As a result, the committee did not file amicus briefs in any of the matters in which participation was solicited by a party.

The Committee filed an amicus brief at the Federal Circuit in the *Tafas v. Dudas* (n/k/a *Tafas v. Doll*) case, which concerned the PTO's adoption of rules that substantially restricted continuation practice and the number of claims that could be presented for examination. The brief supported the challengers against the PTO, and argued for affirmance of the district court's judgment that the PTO did not have authority to adopt the proposed rules. The brief was prepared by Committee member Chuck Miller, with assistance from Committee member Bridgette Ahn and editorial comments from the chair. The committee will also be submitting an amicus brief in support of the challengers' petition for rehearing en banc.

The Committee considered filing an amicus brief at the Federal Circuit in the *In re Bilski* case, which concerned the scope of patentable subject matter under 35 U.S.C. § 101. In this matter, a large number of Committee members recused themselves, as did several Board members, and no consensus was reached.

A topic for discussion in the current year is Chuck Miller's proposal that the Association support adoption of legislation and court rules to provide for arbitration in civil actions seeking review of final administrative rulings by the PTO. The invocation of arbitration would be at the election of the plaintiff (the party aggrieved by the PTO determination and seeking review), and would extend to review of final PTO actions of (i) rejections in patent applications and ex parte reexams, (ii) patent term adjustments, and (iii) disciplinary matters. Following joinder of issue and plaintiff's

demand to arbitrate, the district court would refer the case to arbitration before a tribunal of one or more arbitrators selected from a panel of court-certified patent practitioners. The PTO would not be permitted to oppose the plaintiff’s demand to arbitrate. Fees and expenses for the arbitration would be taxed to the plaintiff consistent with the current fee-shifting provision of 35 U.S.C. § 145. The arbitral award would include a reasoned decision, and subject to confirmation, vacatur, or correction by the district court on any of the grounds specified in the Federal Arbitration Act. To the extent the award was confirmed, it would be entered as a judgment of the district court. To the extent adverse to the plaintiff, the judgment would be reviewable on appeal to the Federal Circuit. The arbitral proceedings would be part of the court record to ensure transparency of the process, but decisions would bind only the plaintiff and the PTO, and would be nonprecedential unless an appeal was taken and the Federal Circuit decided the appeal in a precedential opinion.

Some consideration was given to this proposal last year, but the intent in the current year is to consider the proposal more closely in conjunction with the ADR Committee and the Patent Law and Practice Committee. With division of the Committee’s responsibility and formation of a new Committee on Legislative Oversight, the proposal is more naturally the work of that committee.



ANNUAL MEETING COMMITTEE

Ira Levy, Chair

The Committee presented a very successful program this year entitled “Inequitable Conduct — Vaccine or Plague?” The Honorable Sharon Prost of the Court of Appeals for the Federal Circuit, the Honorable Susan G. Braden of the United States Court of Claims, the Honorable Paul A. Crotty of the Southern District of New York, and past NYIPLA presidents Melvin C. Garner and John F. Sweeney gave presentations on the topic. The program was moderated by W. Edward Bailey.

The program’s attendees were overwhelmingly impressed with the quality of the program, the written materials, and the speakers. The program’s topic was categorized as “timely and important,” and the presenters were variously described as “superb,” “awesome,” “excellent,” and “insightful.” At least one attendee commented on the “outstanding candor from the Bench.”

The Committee has preliminarily decided to focus on the issue of

the New York State CLE Board on January 30, 2009 covering the 2008 calendar year. The Association has moved aggressively to continue compliance with substantially expanded CLE procedures which include new requirements as to the format and content of the Certificate of Participation, the substantiation of the registration procedure and the monitoring of program attendance.

This year, the Committee continued the CLE program series in conjunction with the Association's Annual Dinner in Honor of the Federal Judiciary at the Waldorf=Astoria on March 27, 2009. Special invitations were sent to the Honored Guests attending the dinner. A distinguished panel, including three federal judges, presented a well-received discussion. The program had a total registration of 144, including eighteen federal judges.

The NYIPLA is proud to announce our co-sponsorship of the excellent Conner Inn of Court CLE programs. The first co-sponsored Conner Inn CLE Program was held on April 15, 2009.

Since last year's report, the NYIPLA has sponsored 12 CLE programs totaling 32 credit hours of legal education, including four co-sponsored programs. Our videotape library currently contains 8 credit hours of NYS CLE programs for the Association's calendar year which are made available to NYIPLA members, members of the bar, law firms, and corporations.

During the program period (June, 2008 through May 20 2009), the NYIPLA awarded approximately 3,972 NYS CLE credits, including approximately 744 ethics credits, and approximately 3,228 professional practice credits. In addition, there were approximately 1,352 attorneys who attended CLE programs during this program period. The Committee continues to price programs as close as possible to cover necessary costs. There were 17 financial aid requests in 2008-09.

All of the CLE-related administrative functions continue to be centralized with Star Consulting, with systems and procedures in place to provide continuous, coordinated support. This includes scheduling; communications with the hosting committee's program chairs, speakers and attendees; preparation and mailing of meeting notices; registration processing; preparation of Certificates of Participation, Course Evaluations and Certificates of Attendance under the direction of the CLE Committee Chair; logistical planning and coordination; and providing video/DVD program availability. Star continues to update and improve CLE administrative operations with the addition of credit card processing of registrations and downloadable registration forms for the CLE programs, and continues to provide on-site supervision of the programs. Star also assisted

in the preparation of the year-end report to the NYS CLE Board and the accredited provider renewal application and audit. Star Consulting has also provided a critical service to the Association in budgeting programs so that we can continue to provide high quality legal education programs at a low cost to participants.

Star continues to use a broadcast e-mail system, which provides greater flexibility in communicating up-to-date CLE program information to our members. Star has worked with the Committee to explore and expand the venues and options for CLE programs, including the Harvard Club, Penn Club and Princeton/Columbia Club, and maintains relationships with and coordinates our programs with current venues.

The following programs are anticipated for 2009 - 2010:

- * Half-Day Trademark Luncheon and Program on June 3, 2009, anticipating 3.0 NYS Professional Practice CLE Credits
- * Monthly Committee on Meetings and Forums luncheon programs, each satisfying at least 1.0 NYS CLE credit.
- * Fall One-Day Seminar in November 2009.
- * Judges' Dinner CLE Luncheon Program, March 26, 2010.
- * 26th Annual Joint Patent Practice Seminar in April 2010, anticipating 8.0 CLE credits, one of which will satisfy ethics requirements.

Since last year's report, the following NYS CLE accredited courses and programs were sponsored by the NYIPLA:



Title: CLE Spring Half-Day Trademark Program
Date: June 17, 2008
Instructors: Hon. Timothy C. Batten, Sr., Steven B. Pokotilow, Esq., Susan Progoff, Esq., Harley Lewin, Esq., Mimi Rupp, Esq., Amy B. Goldsmith, Esq., William Wright, Esq. and Susan Upton Douglass, Esq.
Credits: 3.0 NYS Professional Practice CLE Credits and .5 NYS Ethics CLE Credit
Cost: \$195 NYIPLA Member / \$225 non-NYIPLA Member
Video/DVD: Not Available
Number of Registrants: 97
Number of Participants Awarded Credit: 60
Scholarships Awarded: 2



Title: European Patent Office Presents
Date: June 26, 2008
Instructors: Dr. David Ellis and Dr. Sven Jonda
Credits: 2.0 NYS Professional Practice CLE Credit
Cost: \$130/NYIPLA Member; \$155/non-NYIPLA Member
Video/DVD: Not Available
Number of Registrants: 50
Number of Participants Awarded Credit: 43
Scholarships Awarded: 1



Title: Quanta Computer, Inc. v. LG Electronics, Inc.
Live Date: July 29, 2008
Instructor: Jeffrey I.D. Lewis, Esq., Gary M. Hoffman, Esq.,
Patricia Ann Millet, Esq., Marian Underweiser, Esq.,
Rufus Pichler, Esq., and Garrard R. Beeney, Esq.
Credits: 2.5 NYS Professional Practice CLE Credits
Cost: \$175/NYIPLA Member; \$200/non-NYIPLA Member
Video/DVD: Not Available
Number of Registrants: 67
Number of Participants Awarded Credit: 52
Scholarships Awarded: 0



Title: Handbags at High Noon: The Debate over
Intellectual Property and Fashion Design
Date: September 12, 2008
Instructor: Professor Susan Scafidi, Fordham University School of Law
Credits: 1.0 NYS Professional Practice CLE Credit
Cost: \$110/NYIPLA Member; \$135/non-NYIPLA Member
Video/DVD: Not Available
Number of Registrants: 108
Number of Participants Awarded Credit: 83
Scholarships Awarded: 2



Title: NYIPLA CLE Fall One-Day Program
Live Date: November 7, 2008
Instructors: Five panels. Fifteen speakers.
Credits: 5.0 NYS Professional Practice CLE Credits and
2.50 NYS Ethics CLE Credits
Cost: \$410/NYIPLA Member; \$460/non-NYIPLA Member

Video/DVD: Not Available
Number of Registrants: 137
Number of Participants Awarded Credit: 104
Scholarships Awarded: 2



Title: Getting the Most Out of Patent Mediation
Date: January 28, 2009
Instructors: Walter Hanley, Esq., Hon. Mary Pat Thyng, James M. Amend, Chief Circuit Mediator, US Court of Appeals for the Federal Circuit, Thomas Creel, Esq.
Credits: 1.5 NYS Professional Practice CLE Credit
Cost: \$155/NYIPLA Member; \$190/non-NYIPLA Member
Video/DVD: Not Available
Number of Registrants: 65
Number of Participants Awarded Credit: 35
Scholarships Awarded: 1



Title: Conner Inn of Court: Wright Brothers v. Herring-Curtiss: Oral Argument of Cross Motions for Summary Judgment of Infringement/Non-Infringement
Date: March 11, 2009
Instructors: Hon. Mark Fox, Mark Abate, Esq., Jeffrey Butler, Esq., Ronald Clayton, Esq., John Petrsonic, Esq.
Credits: 1.0 NYS Professional Practice CLE Credit
Cost: Free
Video/DVD: Not Available
Number of Registrants: 102
Number of Participants Awarded Credit: 27
Scholarships Awarded: 0



Title: Inequitable Conduct – Vaccine or Plague?
Date: March 27, 2009
Instructor: Hon. Sharon Prost, Hon. Susan G. Braden, Hon. Paul A. Crotty, Melvin C. Garner, Esq., John F. Sweeney, Esq.
Credits: 2.0 NYS Professional Practice CLE Credit
Cost: \$165/NYIPLA Member; \$190/non-NYIPLA Member
Video/DVD: Not Available

Number of Registrants: 144
Number of Participants Awarded Credit: 86
Scholarships Awarded: 3



Title: Conner Inn of Court: Wright Brothers v. Herring-Curtiss: On Appeal
Date: April 15, 2009
Instructors: Hon. William Conner, Hon. Richard Linn, Hon. Colleen McMahon, James Dabney, Esq., Jordan Garner, Esq., Annemarie Hassett, Esq., Kimberly McGraw, Esq.
Credits: 1.0 NYS Professional Practice CLE Credit
Cost: Free
Video/DVD: Not Available
Number of Registrants: 107
Number of Participants Awarded Credit: 31
Scholarships Awarded: 0



Title: The Twenty-Fifth Annual Joint Patent Practice Program
Date: April 30, 2009
Instructors: Five panels. Over 30 speakers.
Credits: 6.5 NYS Professional Practice CLE Credits and 1.5 NYS Ethics CLE Credit
Cost: \$410/\$440 Late Registration Fee
Video/DVD: Available
Number of Registrants: 453
Number of Participants Awarded Credit: 310
Scholarships Awarded: 5



Title: Conner Inn of Court: Ex Parte Oral Argument for TRO and Seizure of Counterfeit Goods
Date: May 14, 2009
Instructors: Hon. Richard Berman, Eugene Chang, Esq., Anthony Giaccio, Esq., Steven Gustavson, Esq., Shari Hyman, Esq., William McCabe, Esq., Jonathan Moskin, Esq., Martin Nagel, Esq.
Credits: 1.0 NYS Professional Practice CLE Credit
Cost: Free
Video/DVD: Not Available

Number of Registrants: 33
Number of Participants Awarded Credit: 26
Scholarships Awarded: 0



Title: Patent/Trade Secret Complementariness:
An Unsuspected Synergy
Date: May 15, 2009
Instructor: Professor Karl F. Jorda, Franklin Pierce Law Center
Credits: 1.0 NYS Professional Practice CLE Credits
Cost: \$140/NYIPLA Member; \$165/non-NYIPLA Member
Video/DVD: Not Available
Number of Registrants: 33
Number of Participants Awarded Credit: 22
Scholarships Awarded: 1

It would not have been possible for the Committee to achieve such successful CLE programming without the excellent support of the individual members of the Committee. These members have devoted extensive time and effort in planning programs and arranging for speakers and content: Karen Axt, Amy Benjamin, David Bomzer, Anna Erenburg, Richard Erwine, Wan Chieh (Jenny) Lee, Sonja Keenan, Susan Progoff, Mary Richardson, Irena Royzman, Keith Zullo and Board Liaison Thomas J. Meloro.



COPYRIGHTS

David A. Einhorn, Chair

The Copyrights Committee has been exploring the following issues this year:

- The copyrightability of fragrances. The Dutch High Court recently found the odor of perfumes to be copyrightable. However, courts in France have determined that, although considered to be the work of skilled artisans, such odors do not constitute copyrightable expression. This issue has yet to be addressed by courts in the United States and may present a good issue for a committee report.
- The copyrightability of directorial works and stage directions. The Society of Stage Directors and Choreographers has long advocated for copyright protection for directorial works. The Dramatists Guild has advocated against such protection on the ground that a director's

copyright would diminish the significance of the playwright's copyright in the underlying work.

- Format protection for reality shows, i.e., what is protectable expression versus unpatentable ideas?

- Recent developments regarding the infringement of architectural copyrights.

- Recent cases concerning secondary liability on the Internet (including the Perfect 10 Ninth Circuit cases).

- Other on-line issues, such as deep linking and framing, as possible violations of the copyright owners' rights.

Furthermore, the Committee will be monitoring developments regarding the U.S. Supreme Court's March 2, 2009 decision to review a Second Circuit opinion that a district court lacked jurisdiction to approve a copyright action settlement because some of the works involved were not registered by the U.S. Copyright Office.

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CORPORATE PRACTICE COMMITTEE

Susan E. McGahan and Alexandra B. Urban, Co-Chairs

The goals of the newly formed Committee include focusing on IP-related issues that affect in-house counsel, highlighting these issues in articles for publication in the NYIPLA Bulletin as well as in CLE programming in conjunction with the Committees on Meetings & Forums and CLE, and making recommendations to the NYIPLA Board of Directors with respect to these issues. This Committee will also work with other NYIPLA committees that focus on topics of interest to in-house counsel, such as licensing, protection of privilege, international IP litigation, electronic discovery, IP insurance/liability, and patent reform.

Where appropriate, this Committee will also work with the Amicus Committee to consider issues that have an impact on in-house counsel, and with the Membership Committee to increase corporate counsel membership in the Association.

A number of in-house IP counsel have joined the Committee, including counsel from Pfizer, Forest Labs, Revlon and Schering-Plough. The Committee is continuing to seek active members from the NY-NJ-CT in-house IP bar. In addition, the Committee plans to invite professors of patent, trademark, copyright and related IP subjects from law schools in NY, NJ and CT to join the Committee and, if possible, offer them a reduced cost to participate in committee events.

any of the nominated inventors. The Committee reached a consensus with respect to the top two recommendations for the *Inventors Of The Year Award*. These recommendations as well as materials related to all six submissions were provided to the NYIPLA Board for its consideration.

The Board decided to recognize both top recommendations and granted the *Inventors Of The Year Awards* for 2009 to:

- Dr. Sadeg M. Faris (Reveo) for his lifetime contributions with over 200 patents spanning diverse fields of technology such as superconductivity, electro-optics, energy, water technologies, DNA sequencing and nanolithography.

Drs. James J. Wynne, Samuel E. Blum and Rangaswamy Srinivasan (IBM) for their significant invention in U.S. Patent No. 4,784,135 that led to the current success of LASIK and PRK laser vision correction procedures.

The Committee notified the winners and made the arrangements for the presentations to be made at the NYIPLA Annual Dinner. The Committee intends to meet shortly after the Annual Dinner to review and prepare the rules and announcements for the 2010 *Inventors Of The Year Award*.

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LICENSING TO PRACTICE REQUIREMENTS

Jay H. Anderson, Chair

The Committee discussed, and brought to the Association's attention, new rules and procedures implemented by the USPTO: (1) an annual practitioner maintenance fee, and (2) online updating of contact information at the USPTO Office of Enrollment and Discipline.

The annual practitioner maintenance fee, effective the current fiscal year, is now codified at 37 C.F.R. §11.8(d) and provides for a \$118.00 payment to the USPTO Director to be paid by all active registered patent agents and attorneys.

In order to receive timely reminders to pay the fee, all practitioners are asked to update their roster entry online. We suggest that Association members check their roster entries and submit a change of address to the USPTO if necessary; use their new USPTO-supplied user ID and password to update and maintain their roster entries; and pay the annual fee online.

Details of these items were the subject of an article in the March/April issue of the NYIPLA Bulletin.

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LITIGATION PRACTICE AND PROCEDURE

Bartholomew Verdirame, Chair

The Committee considered a number of topics and selected the following which are of current interest: (1) the impact of District Court Local Rules on Intellectual Property cases; (2) the impact of proposed patent reform legislation; (3) judicial trends anticipated from key decisions, such as *In re Bilski*, *In re Seagate*, and *KSR Int'l v. Teleflex*; (4) trademark and copyright litigation trends; (5) the effect of bankruptcy or possible bankruptcy on intellectual property litigation; (6) comparison of litigation in the District Courts and the International Trade Commission; and (7) follow-on biologics legislation and litigation.

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LOCAL PATENT RULES COMMITTEE

Daniel DeVito and Robert Scheinfeld, Co-Chairs

The Committee has resolved to do at least the following:

1. Assess the current state of play. The Committee will assess which districts (since our last analysis in mid-2006) have adopted local patent rules and how these rules compare to the NYIPLA's proposed rules. When the Committee investigated this previously, only the Eastern District of Texas, Northern District of California, Western District of Pennsylvania, and Northern District of Georgia had local patent rules. Since then, district courts in at least New Jersey, Massachusetts, Illinois, and California have adopted rules. The Committee will identify and review the new rules, note meaningful differences, and perhaps provide suggested updates/revisions to the NYIPLA's proposed rules based on what is learned.

2. Quantify and analyze all the patent cases filed in the Southern and Eastern Districts of New York since mid-2006. The tasks will be to: (1) learn whether the judges are aware of the NYIPLA's previously published rules, are the rules being used and, if so, have they been successfully implemented?; (2) learn whether practitioners are proposing use of the NYIPLA's proposed rules; and (3) spot and identify trends in these patent cases which may support the Courts' adoption of the NYIPLA proposed rules with respect to (i) burdensome motion practice, including motions to compel information that the NYIPLA rules would automatically provide; (ii) prolonged cases, with repeated scheduling changes; (iii) inconsistent Markman procedures among judges in the same district;

and/or (iv) inconsistent discovery rulings regarding, for instance, opinions of counsel, waiver, and damages.

There will need to be a solid basis for urging the Courts to formally adopt the NYIPLA rules. Although former Chief Judge Mukasey was in favor of providing something to the judges to “demystify patents,” he was not inclined at the time either to “open the floodgates” for additional local rules in other areas of the law or to attract more litigation. Although he is no longer on the Southern District bench, the Committee will need to focus on making patent cases easier for the judges to manage (and resolve).

The Committee’s near-term goal is to report to the NYIPLA President and Board its conclusions, likely recommending a plan of action assuming the Committee believes it should proceed with the NYIPLA proposed rules. The Committee will include, for instance, a recommendation covering when and to whom local rules should again be proposed, what those rules should look like, and what additional efforts, if any at all, should be made to publicize these rules.



MEETINGS AND FORUMS

Richard W. Erwine, Chair

The Committee is working to set up interesting and informative CLE lunch programs that cover a wide range of intellectual property topics.

The Committee arranged two CLE Lunch Programs for this year. Professor Karl F. Jorda of the Franklin Pierce Law Center gave a talk in May 2009 on the synergies between patents and trade secrets. The Committee also arranged a panel on patent mediation in January 2009, including U.S. Magistrate Judge Mary Pat Thyng, James M. Amend, the Chief Circuit Mediator for the Federal Circuit, and Thomas L. Creel, Esq. This group provided perspectives on patent mediations for district court and Federal Circuit cases.

The Committee is finalizing plans for three programs later in 2009, including a panel on patent damages featuring U.S. District Court Judge Ron Clark of the Eastern District of Texas (June 2009), a talk by Chief Judge Michael Fleming of the Board of Patent Appeals and Interferences (September 2009), and a talk by U.S. Bankruptcy Judge Arthur J. Gonzalez of the Southern District of New York (October 2009).

For further discussion of the 2008-2009 CLE programs, see the report of the Continuing Legal Education Committee.

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MEMBERSHIP
Marilyn M. Brogan, Chair

Membership in the Association has exceeded the previous year's numbers.

As in the past, the Committee continues to seek new members from non-members who attend the monthly luncheons and CLE events. Additionally, in December 2008, the Committee sent a special mailing to Association members who had failed to pay dues and we are pleased to report that of the 260 letters mailed, responses were received from 154 who renewed their memberships and brought their dues current.

Also, as in the past, there was a spike in new members shortly before the Judges' Dinner who took advantage of the reduced dinner fee for members.

Specifics for the membership for the year 2008 – 2009:

- Paid and Active Membership: 1551
- New Members during this dues period: 261
- New Student Members this dues period: 47
- Lost Souls: 681 (Members who have left their firms and have not notified the Association with new contact information. The Committee attempts to locate these members on Martindale.com with a small percentage of success.)

The breakdown of members currently in the membership database who are current with the 2008-09 dues:

- ~ Paid Active Members (admitted to practice 5+ years) = 972
- ~ Paid Active Members (admitted to practice less than 5 years) = 385
- ~ Paid Associate Members (outside NJ, NY, VT, CT) and includes Foreign = 85
- ~ Paid Retired Members = 30
- ~ Paid Student Members = 54
- ~ Life Members = 16

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MULTINATIONAL IP LITIGATION COMMITTEE
Jeffrey M. Butler, Chair

Since 2009 was the Committee's inaugural year, much of the work focused on considering exactly what this new Committee can and should

undertake in view of its prescribed scope and mission: "... to consider intellectual property issues relating to multinational litigations."

We think it is appropriate to take a broad view of the term "multinational IP litigation" and recommend that it be deemed to include, among other things:

(i) IP litigations in two or more countries (whether parallel or seriatim) involving related IP rights;

(ii) IP litigations in two or more countries (whether parallel or seriatim) involving the same IP owner and the same accused IP infringer and related accused products or services;

(iii) court, administrative or other proceedings that may be initiated or requested in a given country (e.g., in a given country's patent office or customs agency, etc.) in lieu of, or in addition to, or as an aid to, an IP-infringement court proceeding in another country;

(iv) court, administrative or other proceedings that may be initiated in a given "foreign" country that may advantageously position a litigant in a U.S. IP litigation; and

(v) court, administrative or other proceedings that can be initiated or requested in the U.S. (e.g., an ITC investigation, a reexamination, a customs investigation, etc.) that may advantageously position a litigant in a "foreign" IP litigation.

We have noted that data have been published recently indicating that, as compared with IP litigations in other jurisdictions around the globe, IP litigation in the U.S. is viewed (mostly from outside the U.S.) as highly uncompetitive (based on comparative costs, risks and burdens, time-to-resolution, and other factors).

We also have noted that some IP owners and some accused IP infringers advantageously institute parallel proceedings (or seriatim proceedings) in the U.S. and in one or more other jurisdictions. On the other hand, we are aware that some IP owners and some accused IP infringers do not appear to be wellversed in the various potential global IP litigation options (that is, the types of IP-related proceedings that are available in various jurisdictions, the availability thereof as parallel and/or seriatim and/or alternative proceedings, the timing issues associated with such proceedings, etc.).

In view of these observations, the Committee has set the following priorities for the coming year:

1. Reaching out to Association members who have experience in multinational IP litigation proceedings (as broadly defined above) to become active Committee members and to obtain relevant information from such members.

consider submitting comments if and when rules regarding deferred examination are proposed.

With regard to risk minimization, there have been a number of informal discussions among committee members regarding the risk factors of patent prosecution before the USPTO. Areas of particular concern are:

Docketing: The docketing of papers from the USPTO and responses thereto continues to be a source of concern, regardless of which docketing software is used. It is understood that, despite the availability of several different commercial software packages, there still are occasional lapses due to either “glitches” or inputting errors.

Correspondence to and from the USPTO: Many patent practitioners and firms are not taking advantage of the service of the USPTO whereby Office Actions and other USPTO correspondence are forwarded by e-mail rather than through the U.S. Postal Service. While neither procedure is 100% reliable, e-mail systems seem to have fewer problems once properly implemented. There also can be savings in terms of docketing and document manipulation issues.

Address changes; maintenance fee addresses: As attorneys have changed firms and firms have either merged or gone out of existence, there has been more focus on (1) having the USPTO records reflect new addresses and (2) knowing which attorneys are associated with given files. While the present use of customer numbers has often simplified notification requirements, there are still many opportunities for error. The Committee believes that greater attention has to be paid by individual attorneys and firms to the particular and maddening requirements of the USPTO. It also should be appreciated that, even if all proper documents are filed, changes may not be given effect until the second or third filing.

A critical “sub-set” of address changes is maintenance fee address information. Many attorneys and firms do not appreciate that the more traditional notification forms and procedures do not affect changes to the maintenance fee address that may be assigned to a particular issued U.S. patent. There is at least one pending legal malpractice action that reflects the serious consequences of the failure to make appropriate changes in maintenance fee addresses.

Additional areas of concern include the USPTO’s Patent Application Information Retrieval (PAIR) service and situations when an attorney or firm wants to withdraw from representation before the USPTO. While current USPTO procedures are better than past procedures, it is believed that further improvements are needed so that U.S. patent attorneys do not have

The Twenty-Fourth annual meeting of the U.S. Inter-Bar EPO Liaison Council commenced at the EPO headquarters in Munich, Germany on November 17, 2008. Thomas E. Spath served as the NYIPLA representative at this meeting. The EPO was represented by President Alison Brimelow and principal directors, directors, examiners, and lawyers representing several European Patent Directorates.

1. Operations: During 2007, 220,500 European Convention patent applications were filed, an increase of about 5% over 2006. Combined filings for EPO direct and PCT were up about 3% by October 2008, compared to 2007. Of the applications filed in 2007, about 49% came from the EPC Contracting States, 25% from the U.S., and 16% from Japan, percentages that are consistent with those of prior years. An increasing number of European patent applications are being filed on-line. In 2007, 42% of direct European filings and 56% of PCT filings were made via the Internet, each category increasing by 10% over the previous year.

While the number of searches completed during 2007 increased, the number of requests for European applications decreased, but the number of PCT searches increased. In 2007, the number of requests for accelerated examination under the PACE program decreased and was only about 4% of the total cases.

The EPO continued with its efforts to keep pendency times within acceptable limits. The average time taken to grant a patent in 2007 was 43.7 months, slightly less than the year before, and continuing the trend in pendency reduction. European searches were completed in 6.6 months. The opposition rate continues to be low, with the 2007 opposition rate being 5.2%. The number of patents granted during 2007 was less than in 2006.

As a result of the rising demand for European patents and the growing complexity of the applications filed, quality assurance in the grant procedure based on ISO 9001 continued as a goal. In 2007, the EPO Boards of Appeal received an increase of 75% in cases over those in 2006 and settled, or finally decided, a slightly higher number of appeal cases than the previous year.

The EPO maintains a database of over 60 million searchable documents that covers 78 countries and has bibliographic data for 66 million documents.

2. International and Legal Affairs: With the accession of Norway in January 2008, the EPO now has 34 Member States, plus five additional Extension States. EPC ratification proceedings are now in progress in San Marino, and other invitations are outstanding.

In an effort to develop greater certainty in the area of computer-

implemented inventions, the President of the EPO referred four questions to the Enlarged Board of Appeal (EBA). The particular questions submitted have been the subject of some criticism, and it is not clear when the EBA may issue a decision.

A pilot project ran from April 2007 to April 2008 utilizing the results of work done by the National Patent Offices (NPO) of AT (Austria), DE (Germany), DK (Denmark), and GB (Great Britain) on national applications later filed in the EPO and claiming priority from the first national filing. EPO examiners retained discretion on a case-by-case basis to decide how much to utilize the NPO work. Only 200 applicants chose to participate. In a second phase, the EPO has identified 1100 cases that have been published nationally and requested the national examination results from the respective NPOs.

The Trilateral Offices (USPTO, Japan, and EPO) have continued to enhance the work-sharing schemes with limited numbers of applications in diverse technologies, and a pilot program in two specific technical areas. China and Korea have also indicated interest in participating with the Trilateral group. This group, referred to as “IP5,” had two high-level meetings in 2008. A meeting of working groups may be hosted in China in 2010.

As a result of the apparent lack of interest in the Community Patent, no further action had been scheduled.

The London Agreement entered into force on May 1, 2008, following ratification by France, and is expected to bring about a drastic reduction in translation costs. Due to worsening world-wide financial conditions, it is not clear that these savings will be available for patent budgets.

Work continues on the European Patent Litigation Agreement (EPLA) draft text which would unify litigation of European patents within Europe. It would provide for a central division and regional division located in the Participating States. Obstacles remain and no progress on moving forward with this project was reported.

With respect to international harmonization of patent laws, progress by the Group B+ Working Group has been limited and there are no current plans for a future meeting.

3. **New Initiatives:** The EPO’s Principal Director of International Legal Affairs and Patent Law described a program of Strategic Renewal which was identified by the topic “Raising the Bar.” The stated objective of this program is to ensure that the EPO grants patents for inventions with sufficient inventive merit to fulfill the patent system’s purpose of promoting innovation for the greater good of society. Working groups will analyze the internal EPO practices to ensure that existing standards and practices are

being applied. Evaluation of the appropriate standard for patentability within the current framework of the EPC will be undertaken and any proposed changes will be considered. An external practice group will consider ways of ensuring that applicants adhere to appropriate quality standards and establish procedures to give applicants the opportunity to clarify the claims prior to searching in order to expedite the processing of the application.

A preview of anticipated fee increases was also provided by the Director of DG5. The EPO's budget is funded by income from procedural fees and national renewal fees, and the latter have diminished as the average patent life has dropped from about ten years to seven years. The levying of fees is also being considered as a means to adapt applicant behavior, i.e., increasing the excess claims fees and specification page fees.

The desirability of adapting a U.S. origin application to EPO formal requirements before its filing with the EPO was discussed. Cited as an obstacle was professional service fees incurred by applicants for modifying an application prepared for USPTO filing using what was considered best practices to an application conforming more closely to EPO practice.



YOUNG LAWYERS

Sonja Keenan, Chair

The Committee hosted a cocktail event for young members of the Association at the Chelsea Brewery on June 25, 2009. It was a great success with over 125 people attending including members, non-members and summer associates. The event included a guided tour of the brewery and a short tutorial on the brewing process.

The Committee has discussed organizing events such as happy hours and dinners so that young members of the Association can network with colleagues. While these events would not be officially sponsored by the NYIPLA, they would serve to reach out to young members and increase involvement with the Association.

Section 2

*Summary of NYIPLA
Amicus Curiae Brief*

Tafas v. Dudas (2008-1352)

This case concerned the PTO's adoption of rules that substantially restricted continuation practice and the number of claims that could be presented for examination. The Committee filed amicus briefs at the Federal Circuit in the appeal by the PTO from the district court, and in support of rehearing en banc after a panel of the Federal Circuit reversed in part the district court's judgment enjoining application of the new rules.

The briefs supported the challengers' argument that the PTO did not have authority to adopt the proposed rules. They addressed the limited scope of rule making permitted the PTO by statute, and argued that the proposed rules worked substantive changes that exceeded that grant of authority. The briefs also demonstrated that the proposed rules would impose substantial hardships on applicants and were unwarranted as a matter of policy.

After the Federal Circuit granted rehearing en banc, the PTO and challengers requested and received a 60-day stay of the case given the appointment and confirmation of a new Director. The case had been scheduled for en banc oral argument in October 2009, but was removed from the calendar. It remains to be seen what action the PTO will take under leadership of the new Director, and if it will press forward with the new rules, modify them in part, or withdraw them.

Section 3

Association Events

Annual Meeting and Dinner

May 21, 2008

More than 100 members and guests attended the NYIPLA'S Annual Dinner at the University Club where incoming Association President Anthony Giaccio provided an overview of the past year and events planned for the upcoming year.

KEYNOTE SPEAKER

Professor Hugh Hansen, Professor of Constitutional Law and Intellectual Property Law at the Fordham University School of Law, compared the IP world of 1988 with the much more fragmented IP community today.

INVENTOR OF THE YEAR

The Inventor of the Year award recognizes an individual or group who, through inventive talents, has made worthwhile contributions to society by promoting "the progress of Science and useful Arts." Two awards were granted this year:

Dr. Bernard S. Meyerson of the IBM Systems & Technology Group for his groundbreaking research in Si/SiGe technology and discoveries that led to the formation of device quality silicon-germanium (SiGe) films for use in ultrafast transistors.

Dr. Pedro M. Buarque De Macedo of Catholic University of America for his research related to glass science that has resulted in a wide variety of beneficial applications, including fiber optics, defense fuels, disposal techniques for radioactive and hazardous waste materials, and improved high density foam glass materials that are stronger and lighter than concrete and may be more resistant to terrorist attacks or natural disasters.

CONNER WRITING COMPETITION WINNERS

This award, named in honor of to the Honorable **William C. Conner**, Senior District Judge, Southern District of New York, and past president of the NYIPLA, recognizes excellence in writing by law students in the field of intellectual property law.

Judge Conner presented the awards to:

Kiran Nasir Gore from Brooklyn Law School (First Place) for her paper "Trademark Battles in a Barbie Cyber World."

Thomas Foley from Emory University Law School (Second Place) for his paper "Show Me the Money!: Third-Party Copyright Infringement Liability Reaches Investors & Lenders."

Hon. William C. Conner Inn of Court Reception

January 15, 2009

The NYIPLA co-sponsored a dinner celebrating the inauguration of The Hon. William C. Conner Inn of Court at the Union League Club of New York on January 15, 2009. Judge Conner, who passed away on July 9, 2009, had served our IP community with distinction as a patent attorney, as Past President of our Association, and as a Senior District Court Judge.

The Conner Inn (www.innsofcourt.org/inns/connerinn) comprises a crosssection of judges, lawyers and law students having an interest in IP law. The goal of the Inn is to encourage civility, excellence and professionalism within the profession.



The Conner Inn is the seventh IP-focused Inn of Court in the nation. Together, they comprise the “Linn Inn Alliance”, which serves to facilitate the exchange of program information among the IP Inns, and to welcome attendance at Inn meetings across the country by visiting members from other IP Inns.

NYIPLA President Anthony Giaccio delivered the welcoming remarks. The Dinner Committee was chaired by NYIPLA Board Member Thomas Meloro and the Commemorative Journal Committee was chaired by NYIPLA’s First Vice President Dale Carlson.



L to R: Melvin Garner, John Lane, Prof. Hugh Hansen, Hon. Timothy Dyk, Hon. Paul Michel, Hon. Colleen McMahon, Hon. William C. Conner, Hon. Barbara Jones, Hon. Richard Linn, Hon. Pauline Newman, Anthony Giaccio, Thomas Meloro

CLE Day of Dinner Program and Luncheon

March 27, 2009



The program topic, Inequitable Conduct – Vaccine or Plague?, was particularly timely in view of the recent decision by the Court of Appeals for the Federal Circuit in *Larson Mfg. Co. v. Aluminart Products Ltd.*, 559 F.3d 1317, 90 U.S.P.Q. 2d 1257 (Fed Cir. 2009).

A distinguished panel of speakers comprised of Hon. Sharon Prost, Circuit Judge, U.S. Court of Appeals for the Federal Circuit; Hon. Susan G. Braden, U.S. Court of Claims Judge; Hon. Paul A. Crotty, District Judge for the Southern District of New York; Melvin C. Garner of Darby & Darby; John F. Sweeney of Lock Lord Bissell & Liddell; and W. Edward Bailey of Lovells, addressed the current status of the inequitable conduct defense, courtroom strategies and questions of reform.



CLE Day of Dinner Program and Luncheon, March 27, 2009



Linn Inn Reception March 27, 2009



87th Annual Dinner in Honor of the Federal Judiciary



The New York Intellectual Property Law Association held its 87th Annual Dinner in Honor of the Federal Judiciary on March 27, 2009 at the Waldorf=Astoria.

President Anthony Giaccio welcomed the honored guests, members of the NY-IPLA, and their guests. Cadets from the U.S. Military Academy at West Point opened the evening's events with a magnificent rendition of the National Anthem.



The Association's Seventh Annual Outstanding Public Service Award was presented to the Honorable Dennis Jacobs, Chief Judge of the United States Court of Appeals for the Second Circuit.



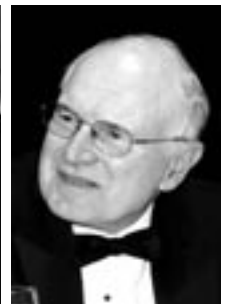
The Keynote Speaker was Tom Brokaw, journalist, author, and for 21 years, anchor and managing editor of NBC Nightly News.



The 87th Annual Dinner in Honor of the Federal Judiciary, March 27, 2009



Front row (left to right): Tom Brokaw, President Anthony Giaccio, Chief Judge Dennis Jacobs (Second Circuit Court of Appeals), President Elect Mark Abate, Judge Sharon Prost (Federal Circuit Court of Appeals), Chief Judge Raymond Deane (Eastern District of New York), First Vice President Dale Carlson, Chief Judge Edward Damich (Court of Federal Claims) **Second row** (left to right): Chief Judge Mark Wolf (District of Massachusetts), Second Vice President Theresa Gillis, Chief Judge Richard Arcara (Western District of New York), Chief Judge James Spencer (Eastern District of Virginia), Secretary Charles Hoffmann, Chief Judge Garrett Brown, Jr. (District of New Jersey), Chief Judge Donetta Ambrose (Western District of Pennsylvania), Treasurer Alice Brennan



The 87th Annual Dinner in Honor of the Federal Judiciary, March 27, 2009



The 87th Annual Dinner in Honor of the Federal Judiciary, March 27, 2009



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The 87th Annual Dinner in Honor of the Federal Judiciary, March 27, 2009



The 87th Annual Dinner in Honor of the Federal Judiciary, March 27, 2009



Annual Meeting and Awards Dinner

May 20, 2009



Incoming President Mark Abate and outgoing President Anthony Giaccio

Incoming Association President Mark Abate welcomed members and guests at the NYIPLA's Annual Dinner at the University Club. Mark expressed his appreciation for outgoing President Anthony Giaccio and with First Vice President Theresa Gillis as the evening's Master of Ceremonies, presented the Inventors of the Year and Intellectual Property Law Educator Award.

Inventors of the Year

The Inventor of the Year award recognizes an individual or group who, through inventive talents, has made worthwhile contributions to society by promoting "the progress of Science and useful Arts." Two awards were granted this year:



Dr. Sadeg Faris receiving the NYIPLA Inventor of the Year Award from John Moehringer

Dr. Sadeg Faris for his contributions related to electro-mechanical sciences. Dr. Faris epitomizes the consummate inventor with over 200 patents spanning diverse fields in technology including superconductivity, electro-optics, energy, water technologies, DNA sequencing and nanolithography.

Dr. James J. Wynne, Dr. Samuel E. Blum and Dr. Rangaswamy Srinivasan for their work in the field of medicine. Their significant invention (U.S. Patent No. 4,784,135) led to the current success of LASIK and PRK laser vision correction procedures.



Dr. Rangaswamy Srinivasan and Dr. James J. Wynne receiving the NYIPLA Inventors of the Year Award from John Moehringer

2009 Intellectual Property Law Educator Award – Karl F. Jorda

Professor Jorda, former president of this Association, and currently the David Rines Professor of Intellectual Property Law and Industrial Innovation at the Franklin Pierce Law Center, was the recipient of the NYIPLA's 2009 Intellectual Property Law Educator Award. Professor Jorda teaches Technology Licensing and Intellectual Property Management at the Franklin Pierce Law Center and also directs the activities of the Germeshausen Center for the Law of Innovation and Entrepreneurship.



Prof. Karl F. Jorda receiving the NYIPLA Intellectual Property Law Educator Award from Mark Abate and Terri Gillis

Conner Writing Competition Winners

This award, named in honor of the late Honorable William C. Conner, Senior District Judge, Southern District of New York, and past president of the NYIPLA, and namesake of the new Conner Inn of Court for Intellectual Property Law recognizes excellence in writing by law students in the field of intellectual property law.

Judge Conner presented the awards to: **Victoria Elman** of Cardozo School of Law (First Place) for her paper *Girl Talk on Trial in 2009: Could Fair Use Prevail?* and **Brian R. Day** of The George Washington University Law School (Second Place) for his paper *Collective Management of Music Copyright in the Digital Age: The Online Clearinghouse*.



Victoria Elman receiving the Conner Writing Competition Award from Hon. William C. Conner

NYIPLA Diversity Scholarship Award

The NYIPLA awarded its first diversity scholarship program grant of \$10,000 to Fordham Law School. Accepting on behalf of Fordham were Professor Hugh Hansen and Karen A. Deasy of the law school's Office for Development.

The Association will award at least one scholarship annually to offset tuition costs for a student in a local law school with an interest in intellectual property law who is from a background traditionally under-represented in the legal profession. A Diversity Scholarship Committee has been created to enlist the support of, and donations from, the local IP community.



Prof. Hugh Hansen and Karen Deasy of Fordham Law School receiving the NYIPLA Diversity Scholarship Grant from Mark Abate and Edward Bailey

Keynote Speaker – Hon. Richard Linn, Circuit Judge, United States Court of Appeals for the Federal Circuit

Judge Linn's talk focused on the factors that contributed to an attorney's ability to be a leader in the practice of law: integrity, judgment, confidence, diligence, vision and trust.



Index

Part I

	PAGE
Board of Directors.....	6
Committees	7-23
Alternative Dispute Resolution	9
Amicus Briefs	9
Antitrust, Inequitable Conduct and Misuse	10
Biotechnology.....	10
Chemical/ Pharmaceutical	10
Continuing Legal Education.....	11
Coordinating	11
Copyrights	12
Corporate Practice	12
Design Protection	13
Discovery.....	13
Electronics/Computers	14
Financial Industry	14
International IP Law	15
Internet Law.....	15
Inventors of the Year Awards.....	16
Law School Writing Competition Awards	16
Legislative Oversight.....	16
License to Practice Requirements	17
Licensing	17
Litigation Practice and Procedure	17
Local Patent Rules.....	18
Meetings and Forums	18
Membership.....	19
Multinational IP Litigation	19
Outreach	19
Patent Law and Practice	20
Patentable Subject Matter.....	20
Privacy Law.....	20
Protection of Privilege.....	21
Publications	21
Records	21
Trade Secret Law and Practice	22
Trademark Law and Practice.....	22
Trial Advocacy and Preparation	22
USPTO Oversight.....	23
Young Lawyers.....	23

continued

Index

continued

Former Officers and Directors	29-36
Presidents	31
Secretaries	31
Treasurers	32
President-Elect	32
1st Vice Presidents	32-33
2nd Vice Presidents	33
3rd Vice Presidents	33
Board of Directors	34-36
Guidelines for Life Membership	38
Members	37-286
Life	39-40
Active	41-255
Retired	257-262
Associate	263-278
Foreign	279-280
Student	281-286
Officers	4-5
Table of Contents	v
Treasurer's Report	25-27

Part II

The Year In Review	
Section 1: NYIPLA Annual Committee Reports	289-317
Section 2: Summary of NYIPLA Amicus Curiae Brief	319-320
Section 3: Association Events	321-335

Photography by: Christopher Ottaunick