

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

2009-2010

GREEN

BOOKLET

ASSOCIATION ANNUAL REVIEW

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Mark J. Abate
NYIPLA President
2009-2010



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Seated (left to right): Alice Brennan, *Treasurer*; Dale Carlson, *President-Elect*; Mark Abate, *President*; Theresa Gillis, *First Vice President*; Charles Hoffmann, *Secretary*;
Standing (left to right): Anthony Giaccio, *Immediate Past President*; John Moehringer, *Board Member*; John Delehanty, *Board Member*; David Ryan, *Board Member*

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Annual Meeting and Awards Dinner

On May 20, 2009, incoming Association President Mark Abate welcomed members and guests at the NYIPLA Annual Meeting and Awards Dinner at the University Club. Mark expressed his appreciation for outgoing President Anthony Giaccio.



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.” The 2009-2010 IOTY was awarded to **Dr. Eric R. Fossum** for his extensive portfolio of patents related to CMOS pixel image sensors and the so-called “camera on a chip technology” that is at the heart of technologies ranging from cell phone cameras to swallowable pill cameras.

Conner Writing Competition Winner First Place

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

The Honorable Barbara S. Jones of the Southern District of New York presented the 2009-2010 Conner Writing Competition awards to:

Karen Zhou of the University of Maryland School of Law (First Place) for her paper *Patenting the Genome – An Economic Analysis of the Gene Patent Debate*





Conner Writing Competition Winner Second Place

Robin Brenner of Cardozo Law School (Second Place) for her paper *Use It or Lose It! Burdens of Proof in Non-Use Cancellation Actions: A Call for Balance in the Trademark Laws of Thailand, Indonesia, and India*

NYIPLA Diversity Scholarship Award

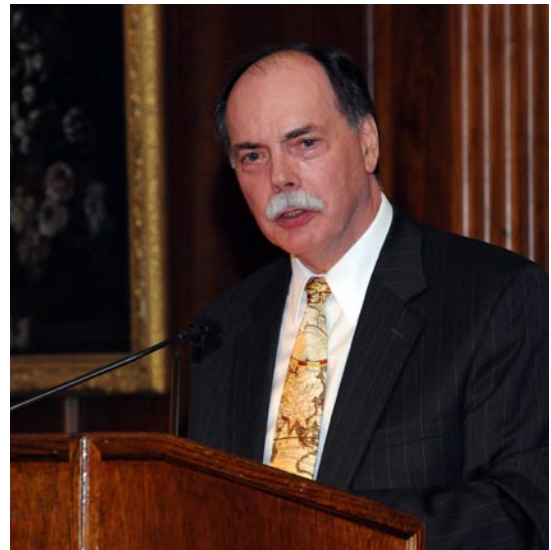
The NYIPLA awarded its 2009-2010 diversity scholarship program grant of \$10,000 to Fordham Law School. Edward Bailey presented the award. Accepting on behalf of Fordham was Professor Hugh Hansen.

The Association plans to 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 underrepresented in the legal profession.



Keynote Speaker: Honorable 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.







2009 – 2010 Committee Reports

AMICUS COMMITTEE *Charles Weiss and John Hintz, Co-Chairs*

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.

The Committee filed eight amicus briefs in seven separate cases:

- *Hyatt v. PTO* (Federal Circuit): introduction of new evidence in Section 145 actions; Chuck Miller, principal drafter.
- *Princo v. ITC* (Federal Circuit): standards for proving patent misuse in patent pool situations (two briefs, one at petition stage and one at merits stage); Dave Ryan, principal drafter.
- *Ariad v. Lilly* (Federal Circuit): existence of, and standards for, written description requirement; Charles Weiss, principal drafter.
- *Shire v. Sandoz* (Federal Circuit): preclusive effect of district court claim construction in case that set tles; Charles Weiss, principal drafter.
- *Tafas v. PTO* (Federal Circuit): new PTO rules on continuations and claims; Chuck Miller, principal drafter.
- *City of Ontario v. Quon* (Supreme Court): state employee's expectation of privacy in personal messages on employer-issued smart phone; Jonathan Moskin, principal drafter.
- *John Wiley & Sons v. Kirtsaeng* (Second Circuit): first sale doctrine in copyright law; Charles Weiss, principal drafter.

The Committee was more proactive than in the recent past as many of the briefs were filed on the Association's own initiative without requests for participation by interested parties. Another positive trend was an expansion of the Committee's work outside the traditional area of patent law – briefs were filed in the fields of copyright and privacy law.

The Association participates in the amicus brief notification network with other bar and professional associations, but has not filed any briefs jointly with other organizations.

ANTITRUST, INEQUITABLE CONDUCT AND MISUSE COMMITTEE *Douglas R. Nemec and Donald Rhoads, Co-Chairs*

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.

The Committee was presented with numerous interesting developments in the areas of reverse payments settlements, standard setting organizations and, most recently, inequitable conduct. The *Princo* and *Therasense* cases proved to be of particular interest and importance. Materials of interest were circulated to Committee members to stimulate discussion and an article titled "Delaying Generic Drugs: The Legal Landscape Surrounding Reverse Payment Agreements to Protect Patent Holders" by Committee member Safet Metjahic was published in the *Bulletin*.

The most noteworthy accomplishment of the Committee for this term can be credited to Don Rhoads and his associate Mary Richardson, who invested significant effort to create an extranet site for materials of interest to the Committee. The site, which will be available to Committee members, contains materials organized into four folders: Case Law, Commentary, Briefs, and Legislation. Each folder is subdivided into folders labeled Patent Misuse, SSOs, Pharmaceutical Pay-for-Delay, and Miscellaneous. With the submission of materials by Committee members, this could become a very valuable resource for news and research on issues of antitrust, inequitable conduct and misuse.

CONTINUING LEGAL EDUCATION COMMITTEE

Dorothy R. Auth and Richard Parke, Co-Chairs

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.

The Association's Application for Renewal of Accredited Provider Status was submitted to the New York State Continuing Legal Education Board on January 30, 2008. Approval as an Accredited Provider of CLE programs for the period of August 28, 2008 through August 27, 2011 was renewed on November 5, 2008 for the following formats:

- Live classroom, for group participation;
- DVD, for self-study (individual participation); and
- Videotape, for self-study (individual participation).

The Association continues to provide educational courses that satisfy NYS CLE credits in accordance with NYS Rules, Regulations and Guidelines. 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 26, 2010. A distinguished panel, including three federal judges, presented a well-received discussion concerning the calculation of patent damages. The program had a total registration of 144, including 29 federal judges.

The NYIPLA is proud to support the excellent Conner Inn of Court CLE programs, which were conducted throughout the year.

The NYIPLA sponsored 10 CLE programs totaling 29 credit hours of legal education. Our videotape library currently contains 7 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 3, 2009 through May 18, 2010), the NYIPLA awarded approximately 1953.5 NYS CLE credits, comprising approximately 217 ethics credits, and approximately 1736.5 professional practice credits. Approximately 1049 attorneys attended CLE programs during this period. (These figures do not include the 26th Annual JPP seminar, or the May 12, 2010 Conner Inn of Court seminar.)

We continue to price programs as reasonably as possible. There were 22 financial aid requests in 2009-10, comprising 20 full scholarships and two partial scholarships.

In addition, 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: Amy Benjamin, David Bomzer, Anna Erenburg, John Halski, Sonja Keenan, Wan Chieh (Jenny) Lee, Richard Margiano, Tod Melgar, Debra Resnick, Mary Richardson, Irena Royzman, and Board Liaison Anthony Giacco.

COPYRIGHTS COMMITTEE

Ronald A. Clayton, Chair

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.

The main activity of the Committee was assisting the Amicus Committee in reviewing proposed cases involving copyright issues for consideration of filing of an amicus brief and reviewing proposed briefs in those cases where filing was recommended. This included *John Wiley & Sons v. Kirtsaeng* in the U.S. Court of Appeals for the Second Circuit.

CORPORATE PRACTICE COMMITTEE

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

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.

In November 2009, the Committee conducted a benchmarking/roundtable event in which a subcommittee led by James Markarian drafted and circulated 20 questions to the Committee directed to patent prosecution. The responses were anonymously submitted, analyzed and the results were compiled onto a spreadsheet that was shared with only the members who responded to the questionnaire. Based on the success of this first exercise, a second benchmarking/roundtable event is being planned which will focus on patent litigation practice.

At the request of a number of Committee members, monthly lunchtime teleconference meetings were established. During the first two calls, on March 17 and April 21, 2010, the following topics were discussed:

- 1) Section 292, patent marking, *qui tam* actions.
- 2) IP management: software solutions.
- 3) Structure of a corporate IP department and interaction with other corporate functional groups.
- 4) How is law firm performance and quality of work evaluated? How to ensure compliance by law firms with corporate policy.
- 5) Patent software/search tools.
- 6) Inventor compensation and remuneration.
- 7) IP training: how is this managed in-house?
- 8) Patent awards: creative non-monetary incentives for inventors.
- 9) Licensing and NPEs: standard processes for handling solicitations to license.

The Committee continues to 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, including specifically inviting the participation of other local in-house IP counsel in this Committee's activities as a "trial" NYIPLA membership.

DIVERSITY SCHOLARSHIP COMMITTEE

W. Edward Bailey, Chair

Scope of the Committee: To award a local law school that will select an outstanding law student interested in intellectual property as the recipient for the Hon. Giles S. Rich Diversity Scholarship.

This was the inaugural year for the NYIPLA Diversity Scholarship. The Committee, at the direction of the Association's Board of Directors, raised money through contributions from members of the Association. Additional funds were contributed from the Association to provide the first \$10,000 NYIPLA diversity scholarship to a local law school, Fordham University School of Law. Fordham selected Alex Li as the recipient of this scholarship.

The long term goal is the establishment of a 501(c)(3) organization to which tax deductible contributions may be made. We hope to be able to raise significant funds to establish a reservoir of money from which multiple NYIPLA diversity scholarships can be awarded to local law schools every year.

ELECTRONICS/COMPUTER COMMITTEE

Neil P. Sirota, Chair

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.

The Committee discussed a number of possible topics of interest for a Bulletin article and/or a CLE presentation and Committee members are giving further consideration regarding the selection of appropriate topics.

FINANCIAL INDUSTRY COMMITTEE

Robert H. Fischer, Chair

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.

The Committee discussed preparation of an article on the evolution of financial industry patent protection with an emphasis on software-related areas. An outline for the paper was circulated and discussed among the Committee members and comments were generally positive. The Committee will increase its efforts to convey the impact of technology and the increasing role that intellectual property will have in the financial industry.

INTERNATIONAL IP LAW COMMITTEE

Samson Helfgott, Chair

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.

At the Committee's initial meeting, the current status of international activities were discussed and various handouts were distributed concerning these items.

Specific topics touched upon and analyzed were:

- a. Patent Prosecution Highway – members of the Committee noted the advantages of using this procedure which appears to be a very beneficial process in expediting allowance of cases and were encouraged to try it.
- b. Deferred Examination – the benefits and problems of a potential deferred examination system that might be introduced into the US were discussed and comparisons were made with existing foreign deferred examination systems.
- c. PCT – The current interest by the USPTO for improving the PCT was discussed and various approaches on how patent offices can make better use of the International Search Results to expedite the process during the National Phase were analyzed.
- d. As various international materials became available they were distributed to members of the Committee for review and discussion.

INTERNET LAW COMMITTEE

Benjamin Hershkowitz, Chair

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. The focus of the Committee has been the organization of a CLE program that will focus on IP issues faced by social networking and search engine sites. Proposed topics include:

- How Facebook and other social networking sites handle privacy issues
- The effect of *Bilski* on Internet based patents
- IPR issues associated with the Google books project
- The current state of play of finding jurisdiction based on web pages

Contacts with in-house counsel at appropriate companies have been initiated and when commitments are secured, the Committee will work further with the CLE Committee to arrange an appropriate time and venue.

The Committee also contributed an article to the Bulletin on the expansion of the top level domain names.

LAW SCHOOL WRITING COMPETITION COMMITTEE

Maren C. Perry, Chair

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.

The primary focus of the Committee was to solicit and review law student entries for the William C. Conner Writing Competition. The Committee received 35 submissions which was comparable to the previous year and a significant increase over prior years. Each Committee member reviewed the submitted materials. A teleconference was held by the Committee in an attempt to identify 10 papers that would be considered further by the Committee. Each Committee member re-read the 10 papers and ranked his or her top three. A full Committee meeting was held to discuss the results of the rankings and a consensus was reached with respect to the top four recommendations which were then forwarded to the NYIPLA Board for its consideration.

The 2010 winners were Karen Zhou from the University of Maryland School of Law for her paper *Patenting the Genome – An Economic Analysis of the Gene Patent Debate*, and Robin Brenner from the Cardozo School of Law for her paper *Use It or Lose It! Burdens of Proof in Non-Use Cancellation Actions: A Call for Balance in the Trademark Laws of Thailand, Indonesia, and India*.

LICENSE TO PRACTICE COMMITTEE

Jay H. Anderson, Chair

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.

After previously reporting to the Association regarding new USPTO rules providing for an annual practitioner maintenance fee, the Committee noted that the PTO did not collect the fee in FY09, and has not given any indication that it will collect the fee in FY10. The rule (37 CFR § 11.8(d)) remains in place, however, and may be implemented in the future.

The Committee also took note of a challenge to Section 470 of the New York State Judiciary Law, which requires that non-resident New York licensed attorneys maintain an office in the state. In *Schoenefeld v. State of New York*, the U.S. District Court for the Northern District of New York ruled that the Comity Clause of the U.S. Constitution could provide the basis for a suit challenging this provision. At this preliminary stage of the case, the state offered no substantial reasons for the provision's different treatment of residents and non-residents. This case may be of interest to Association members admitted to practice in New York but who reside outside the state.

LICENSING COMMITTEE

Paul Ragusa, Chair

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

The Committee conducted a review of several important topics in the field of IP licensing, including:

- Post-SanDisk declarative judgment actions
- IP rights in Section 365 bankruptcy settings
- Interpretation of "irrevocable" and "best efforts" in licensing agreements
- Certain tax issues in international IP transactions
- Avoiding common licensing pitfalls (indemnification, reps and warranties, etc.)

The Committee is currently working on developing these topics, with a goal of preparing a CLE presentation and/or article.

MEETINGS AND FORUMS COMMITTEE

Richard Martinelli, Chair

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.

The Committee presented a number of successful and well attended CLE Lunch Programs.

In June 2009, Judge Ron Clark of the Eastern District of Texas led a panel discussion on the emerging law of future damages and ongoing royalties in cases where injunctions are not granted. Also on the panel were Brian Napper of FTI Consulting, Inc. and Richard Erwine of Quinn Emanuel Urquhart & Sullivan, LLP. In addition to providing an informative background on the current state of the law, the panel presented an interesting discussion on the similarities and differences in quantifying past versus future damages.

In September 2009, an event was held featuring Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences, Michael R. Fleming. Chief Judge Fleming provided a number of helpful practice tips for counsel appearing before the Board and promoted use of the Board's "Electronic Hearing Room" which allows parties to conduct oral arguments without traveling to Virginia. Chief Judge Fleming also reported that due to an increase of filings arising from reexamination proceedings and a hiring freeze, pendency of cases before the Board is expected to increase in 2010.

In October 2009, Southern District of New York Bankruptcy Judge Arthur J. Gonzalez presented a program entitled "The Impact of Bankruptcy on Intellectual Property." The program was an excellent primer on the disposal of property through bankruptcy. It also specifically addressed the rights of intellectual property licensees granted pursuant to 11 U.S.C. §365 (n) which addresses disposal of the intellectual property of a bankrupt licensor.

In December 2009, Michael Buchanan of Patterson Belknap Webb & Tyler LLP and John Molenda of Jenner & Block LLP co-moderated a panel discussion entitled "The District of New Jersey's Local Patent Rules and Their Impact on Pharmaceutical Patent Litigation." The panel, which included the Honorable Faith Hochberg and the Honorable Patty Shwartz of the District of New Jersey; Philip Johnson, Chief IP Counsel of Johnson and Johnson; Arnold Calmann of Saiber LLC; and Stephen Roth of Lerner David Littenberg Krumholz & Mentlik LLP, provided an in-depth analysis of the rules, how the rules were formulated, and how the rules would affect pharmaceutical patent cases.

In February 2010, Director of the U.S. Patent and Trademark Office, David Kappos, presented a very well attended talk on activities at the USPTO. Director Kappos discussed a number of initiatives that the USPTO has recently undertaken in order to improve the quality of patent examination and provide better service to applicants. He also discussed his plans for additional upcoming initiatives to further improve and remake the USPTO to face the challenges it will see in the next decade.

MEMBERSHIP COMMITTEE

Joseph DeGirolamo and Paul Bondor, Co-Chairs

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.

Membership in the Association dipped slightly from the previous year, no doubt due in large part to widespread expense-cutting efforts undertaken by members and their firms in light of the economic downturn. The Committee continued to seek new members from non-member attendees at monthly luncheons and CLE events and by following up with lapsed members to renew their memberships. As we have seen in the past, the Association observed a spike in new members in advance of the Judges' Dinner.

- Total paid and active membership: 1434
- Total new members this dues period: 199
- Total new student members this dues period: 41

Breakdown of members currently in Membership Database who are current with 2009-10 dues:

- Paid Active Members (admitted to practice 5+ years) = 888
- Paid Active Members (admitted to practice less than 5 years) = 391
- Paid Associate Members (outside NJ, NY, VT, CT) and includes Foreign = 82
- Paid Retired Members = 32
- Paid Student Members = 41
- Life Members = 15

The Committee identified 784 members who had left their firms and have not notified the Association with new contact information. Efforts were made to locate these members with a small percentage of success.

MULTINATIONAL IP LITIGATION COMMITTEE

Jeffrey M. Butler, Chair

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.

The Committee has proposed a CLE seminar which would include a panel comprised of practitioners from various jurisdictions who would discuss and share observations, pointers, pros/cons, tips/pitfalls, etc. from their multinational IP litigation experiences. Numerous Committee members have expressed interest in participating on such a panel and the Committee is seeking European practitioners as well.

Some (preliminary) proposed topics for such a seminar include:

- Introducing our global IP strategies capabilities (legal, technical, business and cultural knowledge/skills/experience)
- Anatomy of a “typical” (coordinated) multinational/multi-jurisdictional IP litigation
- Benefits of coordinated multi-jurisdictional IP prosecution/procurement
- Formulating successful global IP strategies (defensive and for IP owners)
- Location and timing issues: deciding when and in which jurisdiction(s) to file the first action
- Strategic issues for plaintiff: what type of proceeding(s) to bring
- Strategic issues for plaintiff: pros and cons of parallel vs. serial proceedings
- Strategic issues for defendant: whether to bring, or petition for, an action in another jurisdiction (such as a declaratory judgment action, or reexamination, or nullity proceeding, or unfair competition investigation, or other action), in addition to mounting a defense in the jurisdiction(s) in which the defendant has been sued
- Strategic (business/legal) issues for defendant: redesign/design around?
- Strategic (business) issues for both parties: Identify pressure points (for settlement purposes, etc.)
- Party issues: deciding whom to sue in each jurisdiction
- Discovery/disclosure issues: information-gathering issues for proceedings within and outside the US; when and how it may be advantageous to utilize US discovery (under 28 U.S.C. §1782) in connection with a “foreign” proceeding
- Contending with differing approaches to legal privilege in different jurisdictions
- Efficiency issues (whether to sue, what kind of proceeding to initiate, etc.)
- Enforcement-of-judgment issues and scope of remedy
- Forum-shopping issues (comparing speed, cost, available relief and remedies, possible alternative or multiple claims/causes of action, etc.)

There is also interest in writing an article on one or more multinational litigation topics for publication.

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.
2. Reaching out to Association members who are employed by or who represent companies that have active IP issues in multiple jurisdictions in order to identify the types of multinational proceedings and to collate and disseminate data.
3. Informing the bar about multinational IP litigation issues by organizing an educational event (e.g., the seminar mentioned above).
4. In order to address the apparently widely held (mis-)perceptions about IP litigation in the US (e.g., involving perceptions about costs and risks, etc.), drafting educational materials about US IP litigation proceedings that may be used by multinational companies (particularly the foreign offices of such companies) so that multinational/foreign IP decision makers will be educated about the US IP litigation system and informed of the various options in the US legal system for addressing and resolving IP disputes.

PATENT LAW AND PRACTICE COMMITTEE

Bruce DeRenzi, Chair

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.

The Patent Law and Practice Committee was formed in August 2009. The undersigned attended the NYIPLA Board meeting on September 16, 2009, at which time Bruce DeRenzi was introduced as the new Chair of the Committee.

The Committee, at the request of and in coordination with Peter Thurlow, Chair of the USPTO Oversight Committee, participated in a Roundtable on January 20, 2010 at the U.S. Patent and Trademark Office to discuss the new BPAI Ex Parte Appeals Rules. Charles Miller of Dickstein Shapiro attended and took part in the discussion. In particular, Charles commented on the proposed potential rules by emphasizing the importance of creating a record at the Board level reflective of the entire PTO application proceedings, so as to facilitate appellate court review of the agency's decisions that are subjected to judicial review at the CAFC or in the DC federal district court.

Committee member Charles Miller, along with co-author Dan Archibald, submitted an article to the NYIPLA Bulletin titled "The Proposed Patent Reform Act of 2010: The Negative Consequences For Patent Owners In Ex Parte Reexaminations." The article was published in the April/May edition of the Bulletin.

The Committee has discussed submitting additional articles to the Bulletin covering topics such as Pleading Inequitable Conduct After *Exergen*; Apportionment of Damages After *Lucent*; Specific Intent Requirement for Inducement; and Lower Standard for Patent Misuse -- *US Philips*.

PATENTABLE SUBJECT MATTER COMMITTEE

Peter Ludwig, Chair

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

The Committee focused its attention on the pending decision in the *Bilski* case. Also considered was the pending *Prometheus v. Mayo* litigation, the presence of the requisite *Bilski* "transformation" and the likely impact of the Supreme Court decision in *Bilski* on the issues in that case. The Committee will reconvene after the Supreme Court decision comes down in *Bilski*. At that time a report to the Association will be prepared.

PRIVACY LAW COMMITTEE

Jonathan Moskin, Chair

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.

The Committee's primary focus was the preparation of the *amicus* brief submitted to, and cited by, the U.S. Supreme Court in *City of Ontario, California, et al. v. Quon* which focused on the application of privacy policies regarding employees' use of office computers and email communications in light of the evolving universe of personal and mobile computing, and the swiftly changing and increasingly amorphous workplace in which new mobile computing technologies, new electronic storage media, as well as new communications media, are reshaping where and how Americans work.

PUBLICATIONS COMMITTEE

Stephen J. Quigley, Chair

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.

The Committee continued its dual role of publishing the NYIPLA Bulletin and Greenbook.

The Bulletin is a journal of articles of interest to the intellectual property community written by Association members, as well as reports on Association activities, CLE programs, columns, and a calendar of Association sponsored events.

During the past year, the Bulletin was published on a bi-monthly basis, ranging in size from 12 to 24 pages. Articles in the Bulletin covered a wide range of topics including search engine keywords, construction of Patent Law Section 112, patent false marking, new top level domain names and the proposed Patent Reform Act of 2010. Judge Richard Linn's comments at the Association's Annual Meeting and Governor Mario Cuomo's speech at the Judges' Dinner were reprinted in the Bulletin and memorial tributes to Judge William Conner and Al Robin were published. In addition to mailing copies of the Bulletin to all Association members, it is posted on the *nyipla.com* web site in color.

The Greenbook serves as both the directory of the Association members and a yearbook for the Association's activities. The 2008 – 2009 Greenbook published later than in the past in order to align it with the Association's year. Featured in the Greenbook were committee members and reports, a summary of the Association's amicus brief, the Treasurer's report and reports on the Association's major events: Annual Meeting and Dinner; Conner Inn of Court Reception; Day of Dinner Program; and the Judges' Dinner. Some Greenbook features were removed this year either because the information was available on the Association's web site or because of a lack of interest. These were the Association's bylaws and rules on admission, and the Federal Circuit biographies and work load statistics.

RECORDS COMMITTEE

Thomas L. Creel and Peter Saxon, Co-Chairs

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

After several Committee meetings and a meeting with the Board of Directors, a list of NYIPLA material that will be made electronically available in a format searchable by key words was developed. These materials include:

Greenbooks; Bulletins; CLE Materials; including Luncheons, Summer weekend conferences Annual Joint Day-long conferences with the Philadelphia and Connecticut associations; White papers; Amicus briefs, Amicus Committee guidelines and conflict guidelines; Policy papers, e.g., comments on the Rocket Docket Courts; Rule changes, proposals and the like; Congressional testimony; Connor Writing Competition winning papers; Links to books written by the Association, e.g., "The Guide to Patent Arbitration"; Yearly committee reports; By-laws of the Association; and Rules of the Association.

Other historical and general interest Association records include:

Judges' Dinner programs; Transcript of speeches at the Judges' Dinners; Material collected in connection with the 75th Anniversary Dinner, e.g., the early musicals presented at the dinners; List of speakers at the Judges' Dinners; Trophies and awards, i.e., Inventor of the Year; 1952 Patent Act materials; History and description of the current activities of the Association; and Correspondence and photographs of particular interest.

Organization of these records has begun. Dale Carlson, the Association Historian, has provided an index of the Association's historical records with membership records from the 1870s through the 1950s. Past Presidents have been contacted for their personal Association records repositories.

TRADE SECRET LAW AND PRACTICE COMMITTEE

Paul Garrity, Chair

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.

The Committee is actively seeking members and plans to coordinate with the Committee on Meetings and Forums to host a speaker on the intersection of trade secret law and the Computer Fraud and Abuse Act.

TRADEMARK LAW AND PRACTICE COMMITTEE

Steven R. Gustavson, Chair

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

The Committee is participating in the development of the 2010 half-day Trademark CLE program which will be held on July 15, 2010 at which Committee member Joel Karni Schmidt will be a speaker. The Committee plans to submit a proposal for a fall CLE program.

TRIAL ADVOCACY AND PREPARATION COMMITTEE

Anne Hassett, Chair

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

The Committee developed, organized and hosted a CLE program on December 3, 2009 which focused on preparing a patent damages case for trial. The program was an excellent presentation of the issues that counsel now face in patent damages cases in view of the most recent Federal Circuit and district court decisions. The panelists were Ira Levy of Goodwin Procter, Ben Hershkowitz of Gibson Dunn & Crutcher, and Brian Napper of FTI Consulting. The 6 p.m. presentation was followed by a cocktail hour at the offices of Goodwin Procter.

For the 2010-11 year, the Committee is planning to prepare a program on selecting and presenting technical experts in patent cases tried before a jury.

USPTO Oversight Committee

Peter G. Thurlow, Chair

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.

The Committee worked directly with the United States Patent and Trademark Office on a number of proposed rule changes, represented the NYIPLA at several patent roundtables coordinated by the USPTO, and represented the NYIPLA on committees established by the U.S. Chamber of Commerce to enhance patent quality and improve the *ex parte* and *inter partes* reexamination process.

The Committee also represented the NYIPLA on the Deferred Examination roundtable held at the USPTO, and participated in meetings at the USPTO to discuss the general framework of adding deferred examination to the patent rules. The Committee represented the NYIPLA at the Board of Patent Appeals and Interferences (BPAI) roundtable and the joint USPTO-Patent Public Advisory Committee roundtable concerning recommendations to enhance patent quality. The Committee continues to work with the USPTO on patent quality matters. The Committee also wrote an article in the February/March 2010 NYIPLA Bulletin related to the USPTO's Strategic Objectives, which highlighted a number of programs that Director Kappos discussed during his NYIPLA CLE presentation in February 2010.

For the U.S. Chamber of Commerce, the Committee met and worked with USPTO officials from BPAI, the Commissioner's Office, the Office of Patent Legal Administration (OPLA), and the Central Reexamination Unit (CRU) to discuss ways to improve both the patent quality and the reexamination process.

YOUNG LAWYER'S COMMITTEE *Sonja Keenan and Andrew N. Stein, Co-Chairs*

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.

The Committee's premiere event was a cocktail gathering at the Chelsea Brewery in June, 2009. Special thanks are due to Larry Rosenthal, Vinny Lee and John Halski. The event was well received and very well attended. Attendees represented all of the YLC's target demographics, as we welcomed people from large law firms, small law firms, corporations, government, and law schools.

The Committee held other more informal gatherings throughout the year – all of which garnered excellent attendance.

The Committee continues reaching out to our members including hosting a large YLC event. The Committee also focuses on increasing the participation of our young lawyer members from corporations and law schools in the area. Without a committee specific to law students, it falls upon the YLC to bring law students into the fold of the Association. Law students, in particular, are a key constituency, as they represent our future membership at the "Active" level.

Annual Reports of the Treasurer 2009-2010
The New York Intellectual Property Law Association, Inc.
For the year ended April 30, 2010
Statements of Financial Position – Cash Basis

ASSETS	2010
CURRENT ASSETS	
Cash – Checking Accounts	920,015
Money Market Account	9,412
Certificate of Deposit – 3 month	85,320
Certificate of Deposit – 6 month	3,563
Certificate of Deposit – 6 month	88,655
Certificate of Deposit – 1 year	36,478
TOTAL ASSETS	1,175,543
NET ASSETS	
Unrestricted Net Assets	1,175,543
TOTAL NET ASSETS	1,175,543

Annual Reports of the Treasurer 2009-2010
The New York Intellectual Property Law Association, Inc.
Statements of Activities & Changes in Net Assets – Cash Basis
For the year ended April 30, 2010

Changes in Unrestricted Net Assets	2010
REVENUES	
Annual Dues Income	334,595
CLE Program Income	160,085
Judges Dinner Income	945,235
Annual Meeting Income	70,000
Other Events Income	13,444
Interest Income/ Other Income	2,802
Total Unrestricted Revenues	1,531,161
EXPENSES	
CLE Program Expense	95,363
Judges Dinner Expense	776,724
Annual Meeting Expense	30,947
Board of Directors Meeting Expense	14,577
Consulting Expense	644,907
Printing Expense	28,266
Membership Support Expense	6,383
Accounting Expense	20,000
Insurance Expense	9,512
General Sponsorship expense	16,500
Committee Meeting Expense	8,054
Administrative Expense	7,210
Website Expense	3,600
Young Lawyers Expense	6,000
Past President Dinner Expense	7,098
Bank Service Charge	404
Total Expenses	1,675,543
Increase (Decrease) in Unrestricted Net Assets	(144,382)*
Unrestricted Net Assets at Beginning of Period	1,319,925
Unrestricted Net Assets at End of Period	1,175,543

*After the final accounting for the Judges Dinner, NYIPLA made a profit.

88th Annual Dinner in Honor of the Federal Judiciary



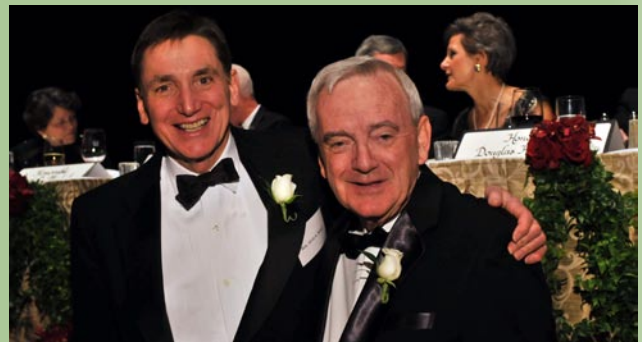
The New York Intellectual Property Association held its 88th Annual Dinner in Honor of the Federal Judiciary on March 26, 2010 at the Waldorf=Astoria. President Mark Abate welcomed the honored guests, members of the NYIPLA, and their guests. Students from The Julliard School opened the evening's events with a magnificent rendition of the National Anthem. The Association's Eighth Annual Outstanding Public Service Award was presented to the Honorable Richard Linn, Judge of the U.S. Court of Appeals for the

Federal Circuit. The Keynote Speaker was three-term New York Governor Mario M. Cuomo whose timely and insightful address focusing on where the United States is today, where it should be, and what must be done to get there.





Standing: Hon. Paul Michel, Thomas Meloro, Hon. Loretta Preska, Hon. Douglas Ginsburg, Charles Hoffmann, Hon. Norman Mordue, Hon. Paul Luckern, Alice Brennan *Sitting:* Mario Cuomo, Mark Abate, Hon. Richard Linn, Dale Carlson, Hon. James Spencer, Hon. Mark Wolf, Theresa Gillis, Hon. Raymond Dearie













CLE DAY OF DINNER PROGRAM AND LUNCHEON

Calculation of Damages in a Patent Case: Wright Brothers v. Curtis-Herring

EARN 2.0 NYS PROFESSIONAL PRACTICE CLE CREDITS

The Starlight Roof at the Waldorf=Astoria, 301 Park Avenue, NYC

The NYIPLA was proud to bring you the CLE Day of Dinner Program and Luncheon in conjunction with the 88th Annual Dinner in Honor of the Federal Judiciary on Friday, March 26, 2010 - ***Calculation of Damages in a Patent Case: Wright Brothers v. Curtis-Herring.***

There was an outstanding response to the Dinner from the Federal Judiciary. We were pleased to have the participation of the Federal Judiciary and the USPTO at the **CLE Day of Dinner** program.

The program included a reception, lunch, a mock argument and a discussion by a distinguished panel. The argument was focused on damages in a patent case, using facts of the century-old **Wright Brothers v. Curtis-Herring** case.

Sitting as judge for the argument was USPTO Deputy Director, **Sharon Barner**. Followed by a distinguished panel, including **Hon. Arthur Garajsa**, Circuit Judge, U.S. Court of Appeals for the Federal Circuit and **Hon. William G. Young**, District Judge, United States Court for the District of Massachusetts.

Welcome: **Mark J. Abate**, Goodwin Procter LLP

Introductory Remarks: **Hon. Richard Linn**, Circuit Judge, U.S. Court of Appeals for the Federal Circuit

Wright Brothers v. Curtis-Herring: Direct and Cross Examinations of Patent Damages Expert

Sharon Barner, USPTO Deputy Director –as the presiding Judge

John R. Lane, Frommer Lawrence & Haug LLP – as the expert for the patentee

Richard L. Rainey, Covington & Burling – as counsel for Wright Brothers

Robert G. Krupka, P.C., Kirkland & Ellis – as counsel for Curtis-Herring

Calculation of Damages in a Patent Case

Hon. Arthur Garajsa, Circuit Judge, U.S. Court of Appeals for the Federal Circuit

Hon. William G. Young, District Judge, U. S. Court for the District of Massachusetts

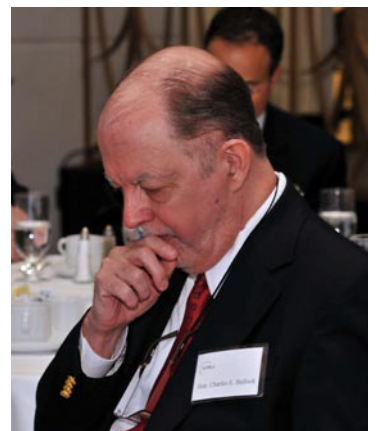
Edward E. Vassallo, Fitzpatrick Cella Harper & Scinto

Annemarie Hassett, Goodwin Procter LLP

Ira J. Levy, Goodwin Procter LLP: Moderator

Day of Dinner CLE Luncheon Program
"Wright Brothers v. Curtis-Herring: Direct and Cross Examinations of
Patent Damages Expert, and Calculation of Damages in a Patent Case"
March 26, 2010







2009 Spring Half-Day Hot Topics in Trademark & Copyright Law

Moderator Amy J. Benjamin, Benjamin Law PC

Rescue.com - Keyword Buys - Now That "Use" Has Been Accepted, How Will "Likelihood of Confusion" Be Established?

Howard J. Shire, *Kenyon & Kenyon*

ICANN Domain Name Proposed New Rules

Rita Rodin Johnston, *Skadden, Arps, Slate, Meagher & Flom*

Recent and Proposed Changes to the Madrid Protocol

Nadine H. Jacobson, *Fross Zelnick Lehrman & Zissu*

Trademark and Copyright Valuation, Monetization and Disposition in Bankruptcy

Fernando Torres, *Consort Intellectual Asset Management*

How Are Trademarks Viewed in Bankruptcy Proceedings?

Anna Erenburg, *Cadwalader, Wickersham & Taft*

Security Interests/Assignment of Trademarks in Corporate Transactions

Peter J. Toren, *Kasowitz Benson Torres & Friedman*

Fraud at the Trademark Office: TTAB's Medinol Approach Hits the Federal Circuit

Kathleen E. McCarthy, *King & Spalding*



2009 Fall One-Day Patent CLE Program

Earn a Total of 7.0 NYS CLE Credits includes 1.5 Ethics and 5.5 Professional Practice CLE Credits

Panel 1 – Latest Developments in Statutory Interpretation

Moderator: Sonja Keenan, *Cadwalader, Wickersham & Taft LLP*

- Will *Bilski* Change the Face of Patentable Subject Matter Under 35 USC §101** Thomas F. Presson, *Frommer Lawrence & Haug LLP*
- A Renewed Debate over Written Description: *Ariad v. Lilly*** Gregory L. Diskant, *Patterson, Belknap, Webb & Tyler LLP*
- What Was Once Not Enabled is Now Obvious to Try: 35 USC §103 - Post *KSR In re Kubin*** Jonathan David Ball, *King & Spalding LLP*
- Cost Saving Strategies in Pursuing Global Patenting** Matthew J. Golden, *Schering-Plough Corporation*

Panel 2 – Litigation Issues

Moderator: T. David Bomzer, *Day Pitney LLP*

- Patents without Borders: Two Perspectives** A. Antony Pfeffer, *Kenyon & Kenyon LLP*
 - **Infringement – 35 USC 271 (f) - How to in View of *St. Jude*?**
 - **Patent Claim – Drafting to Obtain Extraterritorial Effect**
- New Evidence in District Court after BoA Rejection– *Hyatt v. Doll*** Charles E. Miller, *Dickstein Shapiro LLP*
- A New Troll? Patent Attorneys and Section 292** Michael J. Timmons, *Johnson & Johnson*
- Is Damages Reform Desirable? Views on the Damages Provisions in the Patent Reform Act of 2009**
Charles M. Fish, *Chadbourne & Parke LLP*

Keynote Speaker: Carl Shapiro, Deputy Assistant Attorney General, for Economic Analysis, Dept. of Justice

Panel 3 – Licensing Issues

Moderator: Douglas R. Nemec, *Skadden, Arps, Slate, Meagher & Flom LLP*

Reading between the Lines: Implied Terms in Patent License and Settlement Agreements

- Panelists: John M. DiMatteo, *Wilkie Farr & Gallagher LLP*
Hon. Kathleen A. Roberts (Ret.), *JAMS*
David H. Vickrey, *Akzo Nobel, Inc.*

WORKSHOP DISCUSSION: “How to Settle a Patent Infringement Case”

Recent cases have made it very complicated to settle cases without undesirable ramifications. *Medimmune* means most patentees are suing first and attempting settlement later, which can sour the process and burdens the system. *eBay* means that patentees may risk losing the right to enjoin future infringers if they grant a license as part of settlement. And *Quanta/Transcore* complicates the process of granting licenses in settlements without exhausting the ability to go after other players in the mix. And how do *Corebrace* and *Epistar* play into license/settlement talks? A perfect storm that seems to guarantee proliferation of litigation.

Panel 4 – Ethics Issues

Moderator: Karen J. Axt, *Cadwalader, Wickersham & Taft LLP*

- Pleading Inequitable Conduct Requires Identification of Specific Facts** Joseph A. DeGirolamo, *Joseph A. DeGirolamo, LLC*
- Untactful Litigation Tactics: Harming Yourself and Your Client**
Hon. Claire J. Cecchi, *Magistrate Judge, U.S. District Court, District of New Jersey*
James P. Doyle, *Axinn, Veltrop & Harkrider LLP*
- Managing Conflicts: Untying the Knot** Ira J. Levy, *Goodwin Procter LLP*

The Issue of Future Damages/Ongoing Royalties Post eBay

June 26, 2009

Speakers:

Hon. Ron Clark, Richard Erwine, Brian Napper



Richard W. Erwine, Debra Resnick, Hon. Ron Clark and Brian W. Napper

Appellate Practice and Recent Developments: Board of Patent Appeals and Interferences

September 16, 2009

Speaker: Hon. Michael R. Fleming



The Impact of Bankruptcy on Intellectual Property

October 16, 2009

Speaker: Hon. Arthur J. Gonzalez



Hon. Arthur J. Gonzalez, Kevin Reiner

Preparation of a Patent Damages Case for Trial

December 3, 2009

Speakers: Anne Hassett, Benjamin Hershkowitz, Ira J. Levy, Brian Napper

The District of New Jersey's Local Patent Rules and Their Impact on Pharmaceutical Patent Litigation

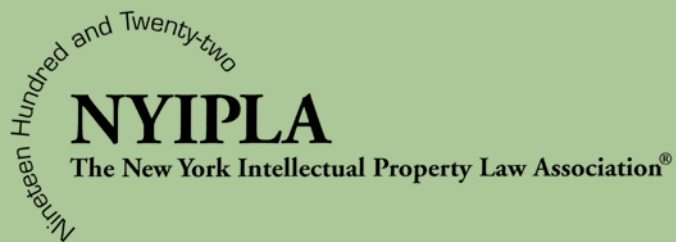
December 11, 2009

Speakers: Hon. Faith Hochberg, Hon. Patty Shwartz, Arnold Calmann, Philip Johnson, Stephen Roth

"What's In Store from the USPTO"

February 5, 2010

Speaker: David Kappos



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