

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

2012-2013

GREEN

BOOKLET

ASSOCIATION ANNUAL REVIEW

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Thomas J. Meloro

***NYIPLA President
2012-2013***



Standing Wanli Wu, Bruce C. Haas, Walter E. Hanley, Terri M. Gillis, *Immediate Past President*; Kevin C. Ecker, Annemarie Hassett, Ira Jay Levy

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2012-2013 YEAR IN REVIEW

It has been my pleasure to serve as President of the NYIPLA this past year. Even by the usual standards set by our members, 2012-2013 was an unusually productive and busy year. The Association year began the new term of our contract with Robin Rolfe Resources, Inc. for the management services of the Association's business. Robin Rolfe, Feikje van Rein and the entire team at RRR have proven to be able, efficient and pleasant collaborators with the NYIPLA's membership. We are very grateful to work with them, and look forward to continuing this relationship in the coming years.

The Association's members continue to be active in key areas of our mission – education and advocacy – in a manner which promotes collegiality and respect among practitioners. The Board supported all of these efforts, and also undertook some important projects with a view toward the long-term health and prosperity of the Association.

Education and Advocacy

The NYIPLA maintained its leadership role in educating lawyers, law students and judges on the significant developments in intellectual property law. This year, the Association held no less than fourteen programs in which CLE credits were awarded to attendees. The topics were varied, from patent law developments, to hot topics in trademark law, ethics matters, trial skills, and IP issues in fashion. Recognizing that our members' needs are varied, the NYIPLA's programs ranged from one-credit luncheon programs to evening seminars, half-day seminars and full-day panel programs.

This year, the CLE Committee and Meetings & Forums Committee conducted programs in several new locales that proved to be very popular. In September, the Association held a breakfast CLE at the offices of Philips Electronics North America Corporation in Briarcliff Manor, N.Y. This format enabled many practitioners who live or work in Westchester County to attend this important program right in their own "backyard." This development inspired another program on Long Island, held in February in Bethpage. The Long Island program was a big hit, with registrations topped only by the venerable full-day patent program. One major draw of NYIPLA CLE events has always been the

top-quality education in a conference setting that draws together co-counsel, clients, adversaries, friends, and new acquaintances who are all part of our New York IP community. The Westchester and Long Island programs took those attributes directly to our members, friends and neighbors outside of Manhattan, and should be touchstones for future NYIPLA programs.

The America Invents Act (AIA) has ushered in some of the biggest changes to patent law in decades. It therefore was natural for the NYIPLA to focus much of its education efforts on the AIA and its implementation. In addition to several panels of practitioners, we were fortunate to host the USPTO's AIA "Roadshow" in September. Other programs featured judges and high-ranking PTO officials sharing their perspectives on how the AIA has changed and will change the practice of patent law, both in the USPTO and in the courts.

The Association was founded in 1922 with a firm focus on advocacy. The founders would be proud that the Association filed six amicus briefs in the past year, in the U.S. Supreme Court and in the Court of Appeals for the Federal Circuit. The total matched the cumulative filings in the two previous years. The efforts of the Amicus Brief Committee, under the leadership of Charles Macedo, Dave Ryan and John Hintz, cannot be overstated. The Committee actively follows leading cases as they wind through the courts, proactively seeks consensus views and volunteers for drafting, and works with the Board to seek and implement the Board's decisions on amicus filings. This past year, the Association weighed in on important cases regarding patent eligibility under Section 101, antitrust considerations in settling Hatch-Waxman litigation, and patent exhaustion. The quality of the NYIPLA's efforts has not gone unnoticed – a Federal Circuit judge publicly noted the quality of the Association's amicus briefing this year. Kudos to all involved.

Special Board Projects

In addition to its usual role in event planning, committee work, and oversight of the Association's activities, the Board spent significant time this year on projects that have an eye toward the future of the Association.

The Membership Committee, led by Bill McCabe and John Moehringer, worked with the Board and RRR to revamp some membership procedures and identify sources of potential new members. The Board approved a new membership category for attorneys working in corporations, and focused outreach efforts to add new members from local corporations. In addition, Board member Annemarie Hassett spearheaded efforts with the Young Lawyers Committee to initiate a series of programs designed for relatively newly-minted lawyers. The YLC hosted a reception on transitioning from law school to legal practice, a session on building a network as a young lawyer, a CLE on use of experts in litigation, and an informal roundtable on expert depositions. Jonathan Auerbach, Mike Bullerman, Lauren Nowierski and their colleagues on the YLC are to be commended for all their efforts this year.

The Board also commissioned a full audit of the Association's finances, and held a lengthy session with the auditors regarding the results. The Association's finances were proven to be in very sound condition through this audit. The Board also worked with the auditors to develop and implement several formal policies on document retention, conflicts of interest, and whistleblower matters. The Board also worked with an ad hoc committee led by Terri Gillis and Walt Hanley on a thorough review and updating of the Association's bylaws. The ad hoc committee also included Past President Marylee Jenkins, Bob Baechtold and Paul Bondor. The Board eventually recommended revised Bylaws to the membership, which were adopted at the Annual Meeting in May.

Judges Dinner and Annual Meeting

The Judges Dinner and the Association's Annual Meeting are two flagship events on the Association calendar. The Judges Dinner was held on March 22, and was a resounding success. The events began with a CLE luncheon headlined by Federal Circuit Judge Kathleen O'Malley, District Judge Stanley Chesler, Chief Magistrate Judge Steven Gold, and USPTO Chief Administrative Judge James Smith, which addressed the interplay between patent litigation in the district courts and proceedings before the USPTO. The dinner itself

was well attended and well received. We were particularly privileged to present the Outstanding Public Service Award to Judge Barbara S. Jones, recently retired from the Southern District of New York bench. Judge Jones has been an exemplary public servant. In accepting the award, Judge Jones spoke of the rewards of public service, and remembered fondly her time on the bench with our late Past President, Bill Conner. Our dinner speaker, Michael Strahan, provided an engaging account of his life's journey from a student at a military base in Germany to a football star and then to a television personality. The federal judges are the real stars of our dinner, but it was nice to have a star from a different milieu on hand to complement those honored guests whom we are so pleased to recognize each year.

The Annual Meeting has grown in importance and reach in the past few years, and the 2013 session was the biggest in memory. The innovative CLE luncheon featured an "Attorney Feud" format which the audience greatly enjoyed. The afternoon workshops and committee meetings were an exceedingly productive capstone to the Association's business year. Following the Annual Meeting, we enjoyed a fine reception and dinner. Special thanks to Second Circuit Chief Judge Dennis Jacobs for his keynote remarks and to Judge Roslynn Mauskopf for presenting the Hon. William C. Conner Writing Competition Awards. Dorothy Auth deserves special recognition for all her efforts to organize the events.

Closing

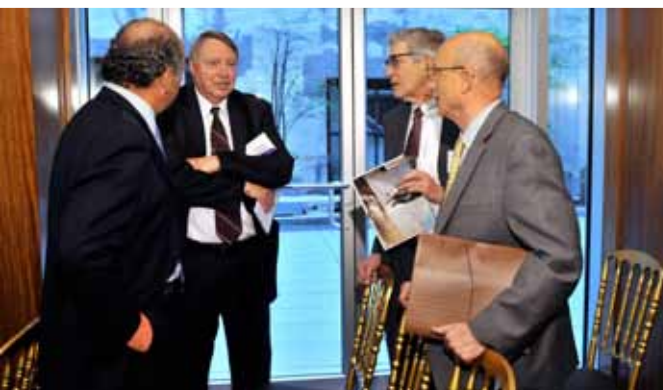
Thanks to all our Board members, Committee chairs and members, and other volunteers who make our Association such a vibrant source of learning, advocacy and fellowship. We stand on a sturdy foundation, built by the efforts of so many over these past decades. As we move to our bright future, we are encouraged by the dedication and enthusiasm of our membership and look forward to even greater success in the coming years. Let's all keep up the good work.

With kind regards,
Tom

Annual Meeting

On May 22, 2012, incoming Association President Tom Meloro welcomed members and guests at the Princeton Club. Tom expressed his appreciation for outgoing President Terri Gillis.

Keynote Speaker: Honorable Barbara S. Jones, District Judge of the United States District Court for the Southern District of New York.







NYIPLA 2012

Annual Meeting CLE Luncheon:

ETHICAL ISSUES IN IP PRACTICE

EARN 2.0 NYS/NJ CLE ETHICS CREDITS

May 22, 2012
The Princeton Club, NY

Program Schedule

Registration	12:00 PM – 12:30 PM
Lunch	12:30 PM – 1:15 PM
Presentation	1:15 PM – 3:00 PM

PANEL 1: INEQUITABLE CONDUCT BEFORE AND AFTER THE AIA

Revision of Rule 1.56

Sydney Johnson, United States Patent and Trademark Office

Supplemental Examination (Sec. 12 of AIA)

Peter Thurlow, Jones Day

Effect of Failure To Disclose Best Mode

Irene Hudson, Fish & Richardson P.C.

Character and Fitness Perspective

Michael Ross, Law Offices of Michael Ross

PANEL 2: CONFLICTS

Conflicts Arising in Litigation

Eric Hubbard, Ropes & Gray LLP

Conflicts Arising in Prosecution

Joe Farco, Locke Lord LLP

Conflicts Arising from Performing Prosecution, Litigation and Licensing Tasks

Joe Casino, Amster, Rothstein & Ebenstein LLP

Character and Fitness Perspective

Michael Ross, Law Offices of Michael Ross

The CLE Luncheon preceded the NYIPLA 2012 Annual Meeting Awards Dinner.

Hosted by the Continuing Legal Education Committee



Award Recipients at the 2013 Annual Meeting

Inventors of the Year Award



The NYIPLA was pleased to recognize the 2013 Inventors of the Year, Drs. Edward Schuchman and Robert Desnick, for their extensive work in research and development of a treatment for Niemann-Pick Disease. Niemann-Pick is a rare, genetic disease that leads to lipid deposits collecting in the spleen, liver, and brain (due to a missing enzyme). Drs. Schuchman and Desnick are professors at the Icahn School of Medicine at Mt. Sinai and are two of the world's leading experts on Niemann-Pick disease with over 150 scientific publications on the topic. Their discoveries have not only led to a drug for the treatment of Niemann-Pick, but they have also discovered the genetic mutation causing the disease and how to screen for it. Drs. Schuchman's and Desnick's contributions in this field of research can have a profound effect on all those afflicted with this rare, genetic disease. Jessica Copeland and Eric Yecies presented the awards.

Hon. William C. Conner Writing Competition Winners



First Place Winner

David Kurlander

Benjamin N. Cardozo School of Law for his paper entitled *Rebalancing Pay-for-Delay: Why the Hatch-Waxman Act Should Be Given Weight in the Antitrust Analysis and What That Means for Reverse Payment Agreements*

Second Place Winner

Erica Schwartz

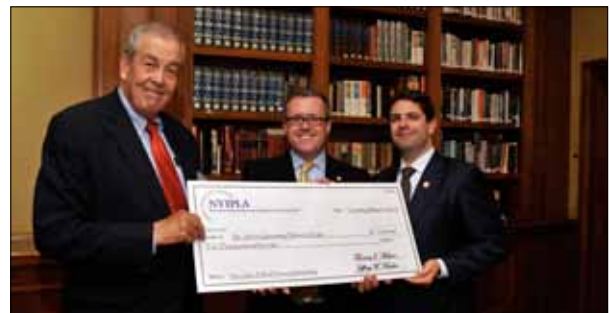
Benjamin N. Cardozo School of Law for her paper entitled *Red with Envy: Why the Fashion Industry Should Embrace ADR as a Viable Solution to Resolving Trademark Disputes*



NYIPLA Diversity Scholarship Award

Each year the Association awards at least one scholarship to offset tuition costs of a student from a background traditionally underrepresented in the legal profession, who is interested in Intellectual Property law, and who is currently attending a local law school.

The NYIPLA awarded its 2013-2014 Hon. Giles S. Rich NYIPLA Diversity Scholarship to the St. John's University School of Law, which will select a scholarship recipient from among its students. Edward Bailey presented the award, and Dean Larry Cunningham accepted on behalf of St. John's.



2012 – 2013 Committee Reports

AMICUS BRIEF

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.

Co-Chairs: *Charles R. Macedo, John M. Hintz and David F. Ryan*
Board Liaison: *Denise Loring*

Members: Michael Buchanan, Stacey Cohen, Melvin Garner, David Goldberg, James Gould, Scott Howard, Robert Isackson, Marylee Jenkins, Julia Kim, Michael Kasdan, Thomas Kowalski, Noah Leibowitz, Steven Lendaris, Jay Lessler, Jeffrey Lewis, Mira Martinez, Matthew McFarlane, Charles Miller, Jack Minnear, Robert Rando, Heather Schneider, Rochelle Seide, Victor Siber, Joseph Sozzani, Charles Weiss

During the past year, the Amicus Brief Committee prepared six amicus briefs that were filed on behalf of the Association. Amicus briefs were submitted to the Federal Circuit and the Supreme Court in *Association for Molecular Pathology v. Myriad Genetics, Inc.* and to the Federal Circuit in *CLS Bank Int'l v. Alice Corp.* to address patent-eligibility issues. Amicus briefs submitted to the Supreme Court in *FTC v. Actavis, Inc.* and in *Merck & Co. v. Louisiana Wholesale Drug Co.* addressed the issue of reverse payments in Hatch-Waxman cases. An amicus brief was also submitted to the Supreme Court in *Bowman v. Monsanto Co.* to address the applicability of the exhaustion doctrine for self-replicating technology. The Committee also participated in two CLE programs offered by the Association.

HON. WILLIAM C. CONNER WRITING COMPETITION

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.

Chairs: *Gary M. Butter and Pejman Sharifi*
Board Liaison: *Walter Hanley*

Members: Richard H. Brown, Mark Francis, Patrice Jean, Joshua Jaffe, Mira Martinez, Aparnaa Saini, Heather Schneider, Gary Yen

The Committee solicited and reviewed entries for the Hon. William C. Conner Writing Competition. We posted the announcement of the competition on the NYIPLA website in November. In December and January, emails were sent to professors and students at a number of law schools to encourage posting of the writing competition announcement at the school to ensure that the students were aware of the opportunity.

We received 29 submissions, which were divided into two groups and distributed to Committee members. Each Committee member reviewed and ranked the submissions in one of the two groups. The best submissions were then reviewed by all Committee members. The top three submissions were chosen by consensus during a full Committee teleconference and sent to the NYIPLA Board for its consideration. Based on the recommendations of the Committee and a further discussion during the April NYIPLA Board meeting, the winner and runner-up were selected by the Board:

1st Place: "Rebalancing Pay-for-Delay: Why the Hatch-Waxman Act Should Be Given More Weight in the Antitrust Analysis and What That Means for Reverse Payment Agreements," by David Kurlander (Benjamin N. Cardozo School of Law).

2nd Place: “Red with Envy: Why the Fashion Industry Should Embrace ADR as a Viable Solution to Resolving Trademark Disputes,” by Erica S. Schwartz (Benjamin N. Cardozo School of Law).

The Committee notified the winners and arranged for the presentations to be made at the Annual Meeting and Awards Dinner.

CONTINUING LEGAL EDUCATION (CLE)

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.

Co-Chairs: *Mark Bloomberg and Robert Rando*
Board Liaison: *Richard Parke*

Members: Andrew Berks, Adda Gogoris, Michael Johnson, Wan Chieh (Jenny) Lee, Susan Progoff, Mary Richardson, Alicia Russo, William Thomashower

NYS CLE ACCREDITED PROVIDER STATUS

The New York State Continuing Legal Education Board (“NYS CLE Board”) initially certified the New York Intellectual Property Law Association (“NYIPLA”) as an Accredited Provider of continuing legal education (“CLE”) in the State of New York on September 1, 1999. All NYIPLA live CLE courses and programs given from August 1, 1997 up to August 27, 1999 were retroactively approved. As of January 11, 2000, the NYS CLE Board approved our application for non-traditional formats for videotapes. Videotaped CLE courses and programs given from August 1, 1997 were retroactively approved. We received approval of the non-traditional CLE format (DVD) on August 15, 2005.

We submitted our Application for Renewal of Accredited Provider Status to the NYS CLE Board on May 1, 2011. Approval as an Accredited Provider of CLE programs for the period of August 28, 2011 through August 27, 2014 was renewed on October 3, 2011 for the following formats:

- Live classroom, for group participation;
- Prerecorded video, for self-study.

We continue to provide educational courses that satisfy NYS CLE credits in accordance with NYS CLE Board Regulations and Guidelines.

In compliance with the requirements of the NYS CLE Board Regulations and Guidelines, we also filed an annual report with the NYS CLE Board on January 28, 2013 covering the 2012 calendar year.

This year the Committee continued the CLE program series in conjunction with the NYIPLA Annual Dinner in Honor of the Federal Judiciary at The Waldorf Astoria New York on March 22, 2013. Special invitations were sent to the Honored Guests attending the dinner. A distinguished panel, including four federal judges, presented a well-received discussion. The program had a total registration of 113, including 17 federal judges.

During the program period (May 1, 2012 through April 30, 2013), the NYIPLA has sponsored 15 CLE programs. There were approximately 938 attorneys who attended CLE programs during this program period.

We continue to price programs as reasonably as possible to cover necessary costs. There were five financial aid requests granted in 2012-13 in the form of five partial scholarships.

All of the CLE-related administrative functions continued to be centralized with Robin Rolfe Resources, 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. Robin Rolfe Resources also assisted in the preparation of the year-end report to the NYS CLE Board and the accredited provider renewal application and audit. Robin Rolfe Resources continues to use a broadcast e-mail system, which provides greater flexibility in communicating up-to-date CLE program information to our members.

Robin Rolfe Resources has provided excellent administrative services in support of the CLE program.

ON THE HORIZON

The following programs are anticipated for the upcoming year (May 2013 through April 2014):

- Annual Meeting CLE Luncheon (Attorney Feud Presentation and Workshops)
- Half-Day Trademark & Copyright CLE Seminar on July 17, 2013
- Monthly Meetings & Forums programs, each satisfying at least 1.0 NYS CLE credit
- One-Day Patent CLE Seminar on January 16, 2014
- "Day of the Dinner" Luncheon CLE Program on March 28, 2014

COMPLIANCE

The NYIPLA 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 process, and the monitoring of program attendance.

CONCLUSION

It has been our pleasure serving this year as Co-Chairs of the Continuing Legal Education Committee. We hope that the NYIPLA continues an aggressive approach to continuing legal education programs. Our goal is to meet and exceed the needs of the intellectual property bar.

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: Andrew Berks, Adda Gogoris, Michael Johnson, Wan Chieh (Jenny) Lee, Susan Progoff, Mary Richardson, Alicia Russo, William Thomashower, and Board Liaison Richard Parke. We also would like to thank all the NYIPLA Committees that co-sponsored the monthly programs and the Meeting & Forums Committee, co-chaired by Colman Ragan and Debra Resnick, for organizing the programs.

NYIPLA CLE PROGRAMS

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

Title: 2012 Annual Meeting CLE Luncheon: Ethical Issues in IP Practice
 Date: May 21, 2012
 Panelists: Sydney Johnson, Peter Thurlow, Irene Hudson, Michael Ross,
 Eric Hubbard, Joe Farco, Joe Casino
 Credits: 2.0 Ethics
 Cost: \$140 Member; \$170 Non-Member
 Number of Registrants: 65
 Scholarships Awarded: 1

Title: 2012 June CLE Reception: An Outside Counsel Perspective:
 Maximizing Opportunities to Succeed with Colleagues and Clients
 Date: June 28, 2012
 Panelists: Leora Ben-Ami, Sona De, Marta Gross, Jeanna Wacker
 Credits: 1.0 Law Practice Management
 Cost: \$20 Member; \$50 Non-Member
 Number of Registrants: 40
 Scholarships Awarded: 1

Title: Hot Topics in Trademark Law
 Date: July 18, 2012
 Panelists: Honorable Thomas P. Griesa, Linda Chan, Perry Viscounty, Jonathan Moskin,
 Jane Pollack, Howard Shire, Pat Razzano
 Credits: 3.5 Professional
 Cost: \$195 Member; \$225 Non-Member
 Number of Registrants: 51
 Scholarships Awarded: 2

Title: AIA Implementation: How to Update Your Patent Strategies
 Date: September 20, 2012
 Panelists: Dana Colarulli, Edward Blocker, Raymond Farrell, Steven Lendaris
 Credits: 1.5 Professional
 Cost: \$75 Member; \$105 Non-Member
 Number of Registrants: 46

Title: USPTO America Invents Act (AIA) Roadshow
 Date: September 28, 2012
 Panelists: Teresa Stanek Rea, Peter Pappas, Honorable Mike Tierney, Honorable Sally Medley,
 Hiram Bernstein, Nicole Haines, Michelle Picard, Gerald Torres
 Credits: 4.0 Professional
 Cost: \$50 Member; \$80 Non-Member
 Number of Registrants: 86

Title: Ethical Considerations in the Use of Social Media
 Date: October 18, 2012
 Panelists: Steven C. Bennett, David A. Lewis, Peter F. McLaughlin, Professor David Bender
 Credits: 1.0 Ethics
 Cost: \$70 Member; \$100 Non-Member

Number of Registrants: 24
Scholarships Awarded: 1

Title: The Good, the Bad and the Truly Ugly: Visual Communication with the Jury
Date: October 24, 2012
Panelists: Suann Ingle, Nancy Geenen
Credits: 1.0 Professional
Cost: \$25 Member; \$55 Non-Member
Number of Registrants: 20

Title: Litigating Patent Cases in 2013: Patent Pilot Program, AIA, and e-Discovery
Date: December 6, 2012
Panelists: Honorable Faith S. Hochberg
Credits: 1.0 Professional
Cost: \$145 Member; \$175 Non-Member
Number of Registrants: 43

Title: One-Day Patent CLE Seminar
Date: January 17, 2013
Panelists: Honorable Mitchell Goldberg, William LaMarca, Sean Grygiel, Charles Miller, Stacey Cohen, William Thomashower, Adda Gogoris, Charles Macedo, Matthew McFarlane, Paul Ackerman, Jonathan Ball, Robert Katz, Pablo Hendler, Jon Gordon, Wan Chieh (Jenny) Lee, Andy Berks, Steven Hoffberg, Richard Brown
Credits: 5.0 Professional, 2.0 Ethics
Cost: \$420 Member; \$470 Non-Member
Number of Registrants: 128

Title: First-To-File: Is Your Company Ready for the Upcoming Changes to the Patent Laws?
Date: February 6, 2013
Panelists: Colman Ragan, Peter DeLuca, Michael Johnson, Sue Purvis, Mark Lesko, Walter Copan, Michael McEntee, Tom O'Rourke, Donna Tumminello
Credits: 3.0 Professional
Cost: \$0 No CLE; \$50 Member; \$80 Non-Member
Number of Registrants: 119

Title: Making Your Case: Effectively Using Experts in Patent Litigation
Date: February 28, 2013
Panelists: Thomas Meloro, Bindu Donovan, Lisa Ferri
Credits: 1.5 Professional
Cost: \$10 Student Member; \$20 Member; \$40 Non-Member
Number of Registrants: 38

Title: The Interplay Between Patent Litigation in the District Courts and Proceedings Before the Patent and Trademark Office
Date: March 23, 2013
Panelists: Circuit Judge Kathleen M. O'Malley, District Judge Stanley R. Chesler, Chief Magistrate Judge Steven M. Gold, Chief Administrative Judge James D. Smith, Mark Abate
Credits: 2.0 Professional
Cost: \$195 Member; \$225 Non-Member
Number of Registrants: 113

Title: Patentability and Enforceability of Mobile Apps

Date: April 25, 2013

Panelists: Robert J. Fluskey, Alfonzo I. Cutaia, Christopher E. Copeland

Credits: 1.0 Professional

Cost: \$60 Member; \$90 Non-Member

Number of Registrants: 29

Title: World IP Day: IP in Fashion

Date: April 26, 2013

Panelists: Amanda B. Agati, Heather Thomson, Rakiat Layo Gbadamosi, Professor Susan Scafidi

Credits: 1.0 Professional

Cost: \$0 No CLE; \$40 Member; \$70 Non-Member

Number of Registrants: 98

COPYRIGHT

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.

Co-Chairs: *Joel Schmidt and Thomas Kjellberg*
Board Liaison: *Charles Hoffmann*

Members: Joseph DiCioccio, Lauren Beth Emerson, James Gibson, David Jones, Kimberly Klibert, Josef Mensah, Glenn Ostrager, Michelle Riley

The Committee met by telephone conference to discuss emerging issues and topics for possible CLE programs as well as possible amicus briefs. The Committee co-organized and co-sponsored a CLE presentation and reception with the Meetings & Forums Committee and the Internet & Privacy Law Committee on October 18, 2012 at Willkie Farr & Gallagher LLP. The program was entitled, "Ethical Considerations in the Use of Social Media." The Committee considered the possibility of filing an amicus brief with the United States Supreme Court in *Jammie Thomas-Rasset v. Capitol Records, Inc.* However, after serious consideration, the Committee decided not to file a brief because some Committee members believed it was likely that *certiorari* would be denied. *Certiorari* was ultimately denied in that case. The Committee is currently working with the Trademark Law & Practice Committee on programming related to the July 17, 2013 Hot Topics in Trademark, Advertising, Copyrights & Design Patents Half-Day Seminar, and is also considering possible programs relating to 3D Printing and Online Piracy. The Committee plans to continue monitoring developments in copyright law, to seek opportunities to publish informational pieces, and to work with other committees to develop CLE programs

CORPORATE

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.

Chair: *George MacDonald*
Board Liaison: *Alexandra Frisbie*

Members: Tulloss Delk, Kevin Ecker, Jason Grauch, Gerard McGowan, Roland Plottel, Frank Sedlarcik, Jack Slobod, Marian Underweiser, Theodore Wills

The Committee was active in revising the annual dues structure to include a reduced membership rate for corporate counsel. In addition, the Committee worked with the CLE Committee and Board members to expand the CLE seminar locations outside the New York City area, including:

- a September 20, 2012 AIA CLE breakfast at Philips Electronics North America Corporation in Briarcliff Manor, NY;
- a February 6, 2013 CLE held at the Morrelly Homeland Security Center in Bethpage, NY; and
- a CLE Program on April 25, 2013 at the Law Offices of Hodgson Russ LLP in Buffalo, NY entitled, “Patentability and Enforceability of Mobile Apps.”

We held a Committee meeting by telephone on April 10, 2013 and we plan to hold monthly telephone calls and one or more in-person meetings in the next year to share ideas.

We are looking forward to an active year ahead.

INTERNET & PRIVACY LAW

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

Co-Chairs: Kevin Moss and Jonathan Moskin
Board Liaison: Charles Hoffmann

Members: Yonathan Arnoff, Gary Butter, Heather Chase, Charles Chen, Vivian Cheng, Kevin Ecker, Robert Feinland, Arianna Frankl, James Gibson, Carol Klinger, Cassidy Merriam, Clifford Michel, Laura Protzmann, Alan Tenenbaum

The Internet & Privacy Law Committee organized and hosted a CLE program entitled, “Ethical Considerations in the Use of Social Media.” The panel consisted of Steven C. Bennett (Jones Day), David A. Lewis (Hinshaw & Culbertson LLP), and Peter F. McLaughlin (Foley & Lardner LLP) and was moderated by David Bender, Adjunct Professor at the University of Houston Law Center. The panel discussed the impact of social media on the day-to-day practice of law and ethical issues unique to the use of social media such as the need to ensure security in mobile devices (such as a flash drive) or “friending” a potential witness.

The Committee has also organized a CLE Presentation for the May 21, 2013 Annual Meeting entitled, “Data Security & Risk Mitigation In Cyberspace.” The speakers will be John Merchant, CyberEdge Specialist at AIG, and Anne B. Sekel, Foley & Lardner LLP. The panel will again explore issues unique to practicing law in the era of social media, including risks of modern communication technologies and related burdens protecting confidentiality, permissible lawyer advertising, and unintended creation of attorney-client relations through blogging advice, as well as risks to businesses using social media, cloud computing and other new platforms from sources as diverse as hackers, disgruntled employees, and employee and subcontractor errors, and tools to ensure against such risks.

Finally, the Committee is working on an article for publication in the NYIPLA Bulletin on the FTC’s February 2013 Staff Report on privacy for mobile devices entitled, “Mobile Privacy Disclosures, Building Trust Through Transparency.”

INVENTOR OF THE YEAR (IOTY) AWARD

Scope of the Committee: To solicit, gather, and review nominations for the Inventor of the Year award, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: *Jessica L. Copeland and Eric H. Yecies*
Board Liaison: *Kevin C. Ecker*

Members: David Leichtman, Joseph Pieroni, Debra Drazen, Victor Cole, Tamara Coley

The 2013 Inventor of the Year Award Committee reviewed eleven (11) submissions for the Inventor of the Year award this year, including three (3) resubmissions. The Committee presented its top three (3) choices to the Board for discussion and approval. The Board agreed with the Committee's finding and decided to recognize Drs. Edward Schuchman and Robert Desnick from the Icahn School of Medicine at Mount Sinai for their extensive work in the treatment, prevention, and method of diagnosis of Niemann-Pick Disease.

Although the Committee intended to maintain the revised schedule of due dates agreed upon in 2012, Hurricane Sandy frustrated those intentions. Therefore, the Committee agreed to extend the deadlines for submission this year, but plans to revert back to the 2012 deadline schedule of October 15 for submissions and December 15 for nominations. One new feature this year was the Committee's compilation of a useful FAQ section on the NYIPLA website to provide information to potential nominators and candidates for the award. We believe this contributed to the Committee's receiving an increased pool of nominations.

We would like to recognize the entire Committee for their excellent work researching, reviewing, and ranking the submissions this year.

We also want to thank our Board liaison, Kevin C. Ecker, for his help navigating the process for the 2013 award.

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

Co-Chairs: *Colman Ragan and Debra Resnick*
Board Liaison: *Ira Jay Levy*

Members: Daniel Goldman, Matthew McFarlane, Douglas Nemec, Jaksha Tomic, Peter Vogl

This year, a main focus of the Meetings & Forums Committee was to attract more members to our CLE functions by hosting our functions at alternate venues with a lower price point. We also varied the timing of our gatherings to include both after-work functions and breakfast functions. We feel that this strategy was a success and we will continue the strategy into 2013-14. Below is a brief summary of the programs our Committee hosted in 2012-13.

The first event we hosted was held on September 20, 2012 at Philips Electronics North America Corporation in Briarcliff Manor, New York. This event focused on the September 2012 changes to the Patent Act included in the America Invents Act (AIA) and featured panelists from the USPTO, Philips

and private practice. By holding this event in Westchester County, New York and as a breakfast event, we were able to attract a large number of our members who live and work in Westchester.

Our next event was held on October 18, 2012 at Willkie Farr & Gallagher LLP as an after-work networking and CLE discussion on ethical issues associated with social media and the practice of law. By hosting this event after work at a law firm and at a lower price point, we were able to attract a good number of young attorneys and to have a nice environment for the panelists and attendees to enjoy refreshments and network in an informal setting. On December 6, 2012, we held a more traditional event, with Judge Faith Hochberg giving a presentation on patent issues she has seen from the bench, including issues arising with the new Patent Pilot programs and local patent rules as well as issues she expects to arise out of the AIA. This event was well attended and many attendees were able to engage Judge Hochberg in a question-and-answer session after the formal presentation.

Our final event was held on February 6, 2013 at the Morrelly Homeland Security Center in Bethpage, New York. This event was planned in collaboration with Accelerate Long Island, the Long Island Forum for Technology (“LIFT”) and the Long Island Software and Technology Network (“LISTNet”) and was designed to extend the reach of the NYIPLA into the Long Island community of technology companies and to begin collaborating with Accelerate Long Island, LIFT and LISTNet. This program featured three panels discussing the change to a first-inventor-to-file system in the United States and its expected impact on the technology companies, universities and small businesses of Long Island. Again, by holding the event at a new venue and offering a lower price point, we were able to dramatically increase the attendance at this event.

In the coming year, we hope to keep this momentum going and offer programs to our members and prospective members at convenient times and venues as well as continue the outreach to our members who live and work in the areas surrounding Manhattan, such as Northern New Jersey, Long Island, and Westchester County.

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.

Co-Chairs: William J. McCabe and John T. Moehring
Board Liaison: Bruce Haas

Members: Maren Perry, Jessica Copeland, Alan Fanucci, Grace Yang, Arianna Frankl, Albert L. Jacobs, Jr., and Thomas E. Spath

Also special thanks to Board Members Kevin Ecker and Alexandra Frisbie

Overall membership was close to the prior year’s: 1298 members (2012-13) vs. 1321 members (2011-2012). To help encourage more corporate members the Association Bylaws were amended in 2012 to create a “Corporate Membership.” Corporate membership is offered to members of a corporate law department at a rate of \$150 per year. The Membership Committee worked with the Corporate Committee to help grow this segment of members. We have a total of 54 paid corporate members. It is also worth noting that student membership increased 18% to 116.

The Committee continues trying to locate lapsed members and to renew those memberships where possible. The new Association website helps to minimize membership lapses; members now can update their own contact information, so it is easier for the Association to stay in touch with members as they change location/firm affiliation.

2012-2013 Membership Year

- Total paid and active membership: 1298 (decrease of 23 since last year)
- Total new members this dues period: 76
- Total new student members this dues period: 84

For current members in the Association's membership database, those totals break down as follows:

- Paid active members (admitted to practice 3+ years): 914
- Paid active members (admitted to practice < 3 years): 128
- Paid corporate members: 54
- Paid associate members (outside NJ, NY, VT, CT): 49
- Paid retired members: 26
- Paid student members: 116
- Life members: 11

PATENT LAW & PRACTICE

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

Co-Chairs: Brian Rothery and Peter Thurlow
Board Liaison: Dorothy Auth

Members: Ojeiku Aisiku, Margaret Brivanlou, J. David Dainow, Allan Fanucci, Robert Feinland, Eric Greenbaum, Samson Helfgott, David Kaplan, Robert Katz, Chul-Woo Lee, Jay Lessler, Stanley Liang, Mark Marin, Edward Meilman, Thomas O'Rourke, Charles Ruggiero, William Sapone, Laura Sheridan, Thomas Spath, Jaksha Tomic, Clifford Ulrich, John White

The Patent Law & Practice Committee had an active year. The information below provides a brief summary of some of the more active areas.

The Patent Law & Practice Committee has been working with representatives from 30 national intellectual property law associations to arrange a CLE program with representatives from China's State Intellectual Property Office (SIPO) on Monday, June 3, 2013, at Cardozo Law School. Commissioner Tian from SIPO will be giving the keynote address at the CLE event. In addition, there will be approximately 20 Chinese attorneys joining the SIPO representatives from China's Association of Patent Agents, a non-profit group of professionals that practice intellectual property law in China. The Committee has also organized a reception for the SIPO representatives and patent agents for Sunday, June 2 at Jones Day. The Committee was also active in the fall of 2012 in China-related IP matters—we hosted a delegation of intellectual property government officials from the Shanghai Intellectual Property Office at Stroock & Stroock & Lavan LLP.

The Committee continues to be active in U.S. Patent and Trademark Office matters. In particular, the Committee has been closely following the implementation of the Leahy-Smith America Invents Act that was signed into law by the President in September 2011. In addition, the Committee continues to work with the USPTO on implementing the pro bono program in New York so that independent inventors and small businesses have an additional resource to obtain intellectual property advice. In addition, the Committee is preparing presentations focusing on U.S., European,

and Japanese law prosecution and litigation policies, for a CLE workshop that will be given during the NYIPLA Annual Meeting on Tuesday, May 21, 2013.

PATENT LITIGATION

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.

Co-Chairs: *Victor Cole and Scott Stimpson*
Board Liaison: *Anthony Lo Cicero*

Members: James Barabas, Brian Biddinger, David Boag, Richard Brown, Stacey Cohen, Randy Eisensmith, Joseph Farco, Mark Francis, Aaron Frankel, Michael Gabriel, James Gould, Anna Huang, Eric Hubbard, Irene Hudson, Robert Isackson, Robert Katz, Julia Kim, Steven Kline, David Leichtman, Stephanie Lollo, Richard Mandaro, Dennis McMahon, Brian McQuillen, Daniel Melman, Jack Minnear, James Muldoon, Clement Naples, Douglas Nemec, Peter Phillips, James Rhodes, Elias Schilowitz, Ognian Shentov, Milton Springut, Ksenia Takhistova, Alan Tenenbaum, Ron Vogel, Mark Waddell, Joshua Whitehill, Grace Yang

The NYIPLA Patent Litigation Committee had another productive year. It kicked off its first organizational meeting in July 2012, followed by in-person luncheons approximately every month, with strong attendance of its 40+ members. Committee members contributed to various CLE programs (including a joint Mock Oral Argument presentation on section 101 with the Amicus Brief Committee for the Annual Meeting), published numerous articles and presented at several industry conferences.

The Committee published e-discovery guidelines; continued to monitor the developments from implementation of the America Invents Act; assisted with data analyses and possible future publications regarding results of the Patent Pilot Program in New York and other states; took part in the FTC/ Department of Justice PAE (“Patent Assertion Entity”) workshop; monitored and commented on the implementation of Local Patent Rules for the EDNY and SDNY; and monitored important Federal Circuit and Supreme Court cases.

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 with respect thereto to the Board of Directors.

Co-Chairs: *Robert Greenfeld and Mary Richardson*
Board Liaison: *Wanli Wu*

Members: William Dippert, Alexandra Gil, John Gulbin, Dominique Hussey, Ted Wills

The Committee publishes the NYIPLA Bulletin on a bi-monthly basis, five times a year. The Green Booklet, published in the summer, is the annual record of the NYIPLA, replacing the former Greenbook.

The Bulletin is a journal of articles of interest to the intellectual property community written by Association members and guests. New items this year were publication of the first and second place Hon. William C. Conner Writing Competition winners’ articles and a feature called “IP Media Links.” Articles in the Bulletin during this year covered a wide range of topics including a review of the Federal Circuit’s *Myriad* decision (which later was taken up for review by the Supreme Court), the ongoing saga

of the legal battles of the heirs of the creators of Superman, ESI (Electronically Stored Information) Discovery Guidelines, counterfeit goods and related legislation, and review of Trademark Trial and Appeal Board cases. A number of these articles were authored by members of other committees of the Association, notably the Trademark Law & Practice and the Patent Litigation Committees.

Each edition of the Bulletin featured the President's Corner, the Historian's Corner, reports of the Association's CLE presentations, minutes of the Board of Directors' meetings, calendar of the Association's upcoming events, and Moving Up & Moving On – for publicizing news of members' transitions and accolades. Copies of the Bulletin were mailed to all Association members and posted on the nyipla.com website in color.

TRADEMARK LAW & PRACTICE

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.

Co-Chairs: *Pina Campagna and Kathleen McCarthy*
Board Liaison: *Anthony Lo Cicero*

Members: Magdalena Berger, James Bikoff, Marina Bongiorno, Charles Chen, Eryn Deblois, Erik Dykema, Raymond Farrell, Kimberly Klibert, Karlo Lugo, Diane Melnick, Andrew Moses, Angelo Notaro, Brendan O'Dea, Stephen Quigley, Birjees Rehman, Catherine Stockell, Peter Vogl

The Trademark Law & Practice Committee had 17 active members this year. The Committee has corresponded extensively and had several conference calls.

The Committee is presently planning the Hot Topics in Trademarks, Advertising, Copyrights & Design Patents CLE Seminar which will be held on July 17, 2013. The Committee has developed a list of current topics of interest and a list of potential speakers for the program.

The Committee has planned a CLE workshop for the NYIPLA Annual Meeting on May 21, 2013, which comprises a panel of speakers discussing recent notable Supreme Court and Federal Circuit decisions in the trademark and copyright areas.

In addition, several Committee members have contributed articles to the NYIPLA Bulletin throughout the year.

The Committee plans on working with other committees to organize a trademark-related luncheon program or after-work function in the coming year.

WEBSITE & RECORDS

Scope of the Committee: To oversee the Association's web-based presence and preservation of the Association's historical documents and records. Our Committee oversees both present-day and historical information for the Association. We oversee the design, updating, and maintenance of the Association's website and make recommendations for further improvements to the Association's web presence. In addition, we manage the gathering, care, archiving, and availability of the Association's publications, photographs, and other historical documents and records (relating as far back as to the founding of the Association in 1922) to identify matters of interest and relevance to the current membership.

Co-Chairs: William Dippert and Wan Chieh (Jenny) Lee
Board Liaison: Jeffrey Butler

Members: Dale Carlson, Ronald E. Brown

Our Committee was very busy in its own, quiet way. The Committee continued to study the NYIPLA website and to compare it with the websites of other major IP organizations. The Committee concluded that the Association's website is in great shape and that there are no recommendations or changes to suggest to the Board in this regard.

In addition, the Committee continued to review the Association's historical documents to extract certain membership and organizational information, to identify events and issues of interest, to communicate those events and issues to the Association's historian for follow-up, and to determine which documents or other materials should be preserved and how they should be preserved. More particularly, the Committee is currently compiling a historic membership database, starting from the founding members of the Association. This is a continuing project that is expected to extend well into next year.

WOMEN IN IP LAW

Scope of the Committee: To facilitate and empower women in their practice of intellectual property law, and to make recommendations with respect thereto to the Board of Directors.

Co-Chairs: Sona De and Jeanna Wacker
Board Liaison: Leora Ben-Ami

Members: Tara Bhupathi, Jennifer BianRosa, Natasha Daughtrey, Tamara Coley, Marta Gross, Angie Hankins, Delphine Knight Brown, Abigail Langsam, Stephanie Lollo, Krista Rycroft, Pamela Schoenberg, Nicole Spence, Ruth Mary Thomas

The NYIPLA Women in IP Law Committee has spent this year working with the women on the Committee and on the NYIPLA Board to plan and conduct meetings with the Committee members, CLE events and networking events.

The Committee held an NYIPLA Women and Wine Tasting Networking Event & CLE in June 2012, hosted by Goodwin Procter LLP. The event began with a short panel discussion from successful women IP attorneys who discussed challenges they have faced in their careers and what it takes to succeed as outside counsel. The panel discussion was followed by a wine tasting event that allowed participants to meet and network. The event included wine vendors knowledgeable about the vintages to talk about the wines. The Committee also held an October 2012 speaking event where an outside trial consultant shared insight on preparation of themes for trial, trial graphics, and jury pools. The event was followed by a networking hour.

The Committee also held informal membership meetings in August 2012 and April 2013 where many constructive ideas were shared, both relating to mentorship and the growth and development of our Committee.

The Committee plans to continue to meet at the start of every other month for informal mentoring and sharing of useful practice points/success stories and plans to organize another formal CLE event later this fall. The Committee also plans to coordinate with the Website & Records Committee to post these upcoming events in order to reach more members of the NYIPLA who may be interested in participating.

Overall, the Women in IP Law Committee had a productive year. Many insightful ideas have been shared and continue to be brought forward in order to further develop this Committee and enable it to best serve its members and the NYIPLA community. Co-Chairs Sona De and Jeanna Wacker look forward to continuing to work with the Committee to facilitate its growth, making it an even greater resource in the coming year.

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.

Co-Chairs: *Jonathan Auerbach, Michael Bullerman, Lauren Nowierski*
Board Liaison: *Annemarie Hassett*

Members: Brian Biddinger, Francesca Butnick, C. Austin Ginnings, Kathryn Jones, Steven Kunen, Josef Mensah, Andrew Moses, Daniel Rabinowitz, Pamela Schoenberg, Jack Shaw, Nicole Spence, Gary Yen

The NYIPLA Young Lawyers Committee just wrapped up an eventful 2012-2013 year. The Committee has had approximately twelve members throughout the year, and is co-chaired by Jonathan Auerbach (Goodwin Procter LLP), Michael Bullerman (Kaye Scholer LLP), and Lauren Nowierski (Desmarais LLP). Annemarie Hassett (Goodwin Procter LLP) serves as the Committee's Board Liaison.

The Committee kicked off the year on July 12, 2012 with a panel discussion, *"Making and Leveraging Connections: How to Develop a Professional Network as a Young IP Lawyer,"* at the Princeton Club featuring panelists Past President Terri Gillis (Mayer Brown LLP), Second Vice President Dorothy Auth (Cadwalader, Wickersham & Taft LLP), Kevin Culligan (Goodwin Procter LLP), Board Member Kevin Ecker (Philips Intellectual Property & Standards), and Frank Sedlarcik (IBM). Committee Co-Chair Jonathan Auerbach moderated. The Committee co-hosted a Young Lawyer's reception with the AIPLA at Drinker Biddle & Reath LLP on August 10, 2012. On October 4, 2012, the Committee hosted a panel discussion, *"Life as a New IP Associate,"* at NYU Law School targeted at law students and newly practicing attorneys. Panelists included Committee members Austin Ginnings (Fitzpatrick, Cella, Harper & Scinto), Jack Shaw (Mayer Brown LLP), and Gary Yen (Kenyon & Kenyon LLP). Committee Co-Chair Lauren Nowierski moderated. On February 28, 2013, the Committee hosted a lunch CLE panel discussion, *"Making Your Case: Effectively Using Experts in Patent Litigation,"* which was held at Kaye Scholer LLP. The panelists included Bindu Donovan (Sidley Austin LLP), Lisa Ferri (Mayer Brown LLP), and President Tom Meloro (Willkie Farr & Gallagher LLP). Committee Co-Chair Michael Bullerman provided introductory remarks. The Committee is looking forward to an equally eventful 2013-2014 year, which kicks off on May 29, 2013, with a Young Lawyers Roundtable discussion: *"Expert Depositions in Intellectual Property Litigation."*

US BAR – JAPAN PATENT OFFICE

Co-Liaisons: *Raymond Farrell, Marylee Jenkins, John Pegram*

The US Bar – JPO Liaison Council comprises delegates from approximately 30 U.S. intellectual property organizations, which usually meets annually with high officials of the Japan Patent Office (JPO). Typically, each side makes presentations on subjects of interest to the other side in the fields of patent law, practice, and harmonization.

The Council met with JPO officials on June 27, 2012 in Washington, D.C. The NYIPLA was represented by John B. Pegram and Raymond E. Farrell. A report was previously circulated. A summary of that report is provided below.

The next meeting with the JPO will be in Tokyo on June 17, 2013. The NYIPLA will be represented by Mr. Pegram. Members of the delegation will also meet with judges of the Japan IP High Court on June 20, 2013, focusing on appeals from the JPO. A report of those meetings will be submitted for the NYIPLA Bulletin.

Details of the June 27, 2012 Meeting

Deputy Commissioner Takahashi Sakurai provided a JPO Update. The number of PCT applications filed in the JPO continued to increase, by 20% in 2011. Japanese companies are more focused on international filings and quality of cases, so domestic applications went down.

The JPO is focusing on issuing stronger, “internationally stable” patents through: harmonization, improving foreign language searching capability, cooperation on adoption of a common classification system, meeting global quality standards, and improvement of IT systems. Reduced time from examination request to first action is being achieved in the JPO through improved IT systems, increased outsourcing (especially in classification and 2/3 of the searching) and a small increase in the number of examiners. This time decreased to 23 months at the end of 2011. The goal is 11 months by the end of 2013.

Mr. Sakurai explained expansion of *Matome* examination, which seeks to expedite the examination process by bringing together related applications of a company before the same examiner and by increased use of interviews. He noted that the JPO is always open to meet with U.S. users, and that firms such as IBM and Microsoft meet regularly with Examining Groups.

Tomoki Sawai, Director of the International Division, said that the JPO strongly seeks harmonization of the patent laws of developed countries, emphasizing three points:

- The sovereignty of each country should be respected by pursuing “best practices,” rather than seeking compromises;
- The importance of harmonization for major countries should be recognized; and
- A bottom-up approach should be used to promote cooperation in examination.

He described several of the recent harmonization meetings including the establishment of regular meetings of the Trilateral Offices (the USPTO, EPO and JPO) and major European national patent offices at Tegernsee, in Southern Germany, and a meeting of heads of the IP5 offices in Corsica in June 2012. The Tegernsee group had agreed in April 2012 to carry out a series of studies on harmonization topics including: grace period, 18-month publication, the effect of prior applications (secret prior art), and prior user rights. The IP5 agreed at the Corsica meeting to establish a “Patent Harmonization Expert Panel” within the IP5, which is intended to engage China in such discussions.

Japan adopted an expanded grace period, effective April 1, 2012, and experienced a 50% increase in applications relying on the grace period. The JPO is willing to accept a U.S.-style grace period and is actively seeking harmonization on this issue, but Europeans appear reluctant to change, especially the German chemical industry.

A Japan-China patent offices’ meeting was held in October 2011. Discussion topics included: the Patent Prosecution Highway (“PPH”) pilot program, harmonization, machine translation, and an exchange of views on patent legislation and practices. A further meeting was held in December 2011, when the topics were: trademark cooperation, misappropriated trademark application examination (CN companies using famous JP marks), and the examiner exchange program.

The Asian Trilateral meeting in December 2011 was devoted to a case study of inventive step, opinions on utility model protection, harmonization matrix, a common hybrid classification (competing with CPC), and machine translation cooperation (CN-JP, JP-KR, CN-KR). SIPO (China State Intellectual Property Office) has been encouraging the filing of utility model applications. The JPO is very concerned about the fact that SIPO expects to receive 900,000 utility model applications a year by 2015. The Asian Trilateral will study this matter, including the possibility of requiring examination of utility models.

Tatsuya Tada, Deputy Director of Examination Standards, reported on recent revisions of JPO Examination Guidelines. Examiners are now required to explain the specific reasons and grounds for a refusal based on the claim language and description, and to indicate to the applicant on how to amend in order to overcome the refusal. Mr. Tada pointed out that over 75% of the PPH applications filed in Japan from the United States are refused—at least initially—because of written description problems. Most of these refusals are due to errors in translation.

Yuichi Ito, Assistant Director of the International Division, reported on PPH developments. In particular, he explained the PPH *Mottainai* pilot program, which seeks to increase the value of the first examination of applications with the same priority. In the regular PPH program, an office of second filing (OSF) relies on examination by the office of first filing (OFF); however, the benefits of PPH are wasted when an office other than the OFF is the first to examine an application. In the PPH *Mottainai* pilot program, any office—including the OFF—may rely on the examination results from the office that first examines the application. This pilot program was launched on July 15, 2011 among the JPO, USPTO and six national patent offices. The EPO commenced participation on January 29, 2012.

US INTER-BAR/EPO

Co-Liaisons: Thomas E. Spath and Samson Helfgott

The U.S. Bar/EPO Liaison Council held its 28th annual meeting on October 10, 2012 at the European Patent Office conference facility in Munich, Germany. The NYIPLA was represented by Thomas Spath of Abelman Frayne and Schwab. The President of the European Patent Office, Benoit Battistelli, continued the President's tradition of attending the annual Council meeting; nine other EPO officials also participated in the meeting. The U.S. contingent consisted of 12 delegates from various national and regional bar associations in the United States, as well as in-house corporate intellectual property counsel. A formal "state of the EPO" report by the President was followed by presentations on a variety of topics of interest by the EPO officials; a presentation on the America Invents Act was made by John Pegram. As always, time was allotted for discussion of these topics and for comments on EPO practice and procedures from the U.S. representatives. (The full report and copies of the EPO papers are available on the Association's website.)

Special Events at 2013 Council Meeting

Although the location of the U.S. Bar/EPO Liaison Council meetings have traditionally alternated between Munich and the United States, the 2013 Council meeting will also be held in Munich in conjunction with the celebration of the 40th anniversary of the EPO. Participation by a significantly larger number of representatives is anticipated in view of the invitation extended by the EPO to attend the special events on the day preceding the Council meeting.

Annual Report of the Treasurer 2012-2013
The New York Intellectual Property Law Association, Inc.
Statements of Financial Position – Cash Basis
For the years ended April 30

	<u>2013</u>	<u>2012</u>
Revenues		
Judges Dinner - event fees	\$ 1,277,885	\$ 1,225,170
Continuing Legal Education (CLE) revenue	95,652	113,373
Membership dues	295,792	301,304
Other programs and events	26,092	14,773
Interest income	1,138	1,125
	<u>1,696,559</u>	<u>1,655,745</u>
Total revenues		
Expenses		
Judges Dinner	838,370	723,094
Continuing Legal Education (CLE) expenses	35,670	54,122
Other programs and events	91,975	79,448
Scholarships, awards and donations		24,500
Professional fees	313,154	299,678
Postage and mailing	9,550	4,895
Printing and publications	75,164	79,787
Office expense	16,881	16,077
Telephone	2,078	3,032
Insurance	2,541	8,689
Bad debt expense	24,000	
Miscellaneous	1,703	7,236
	<u>1,411,086</u>	<u>1,300,558</u>
Total expenses		
Change in unrestricted net assets	<u>285,473</u>	<u>355,187</u>
Net assets - unrestricted - beginning of year, as previously stated		1,457,422
Restatement		<u>(594,628)</u>
Net assets - unrestricted - beginning of year, as restated	<u>1,217,981</u>	<u>862,794</u>
Net assets - unrestricted - end of year	<u>\$ 1,503,454</u>	<u>\$ 1,217,981</u>

Annual Report of the Treasurer 2012-2013
The New York Intellectual Property Law Association, Inc.
Statements of Activities & Changes in Net Assets – Cash Basis
For the years ended April 30

	<u>2013</u>	<u>2012</u>
Cash flows from operating activities		
Change in net assets (Exhibit B)	\$ 285,473	\$ 355,187
Adjustments to reconcile change in net assets to net cash provided (used) by operating activities		
Decrease (increase) in assets		
Accounts receivable	27,000	(27,000)
Increase (decrease) in liabilities		
Accounts payable and accrued expenses	6,452	(582,675)
Deferred revenue	<u>(175)</u>	<u>4,060</u>
Net cash provided (used) by operating activities	<u>318,750</u>	<u>(250,428)</u>
Net change in cash and cash equivalents	318,750	(250,428)
Cash and cash equivalents - beginning of year	<u>1,211,931</u>	<u>1,462,359</u>
Cash and cash equivalents - end of year	<u><u>\$ 1,530,681</u></u>	<u><u>\$ 1,211,931</u></u>

91st Annual Dinner in Honor of the Federal Judiciary



The New York Intellectual Property Law Association held its 91st Annual Dinner in Honor of the Federal Judiciary on March 22, 2013 at The Waldorf Astoria New York Hotel.

President Tom Meloro welcomed the honored guests, members of the NYIPLA, and their guests. Joseph Bartning, Amy Buckley and Malena Dayen opened the evening's events with a magnificent rendition of the National Anthem.

The Association's Eleventh Annual Outstanding Public Service Award was presented to the Honorable Barbara S. Jones (ret.), former District Judge of the United States District Court for the Southern District of New York. The Keynote Address was given by Michael Strahan, former NFL player for the New York Giants and the new co-host on "Live! With Kelly and Michael."



Standing Hon. Gregory Sleet, Dorothy R. Auth, Hon. Charles Bullock, Hon. J. Curtis Joyner, Jeffrey M. Butler, Hon. Emily Hewitt, Hon. James D. Smith, Annemarie Hassett
Sitting Hon. Loretta A. Preska, Hon. Randall Rader, Hon. Barbara S. Jones, Thomas J. Meloro, Michael Strahan, Charles R. Hoffmann, Hon. Carol Bagley Amon, Anthony F. Lo Cicero









THE
WALDORF-ASTORIA
NEW YORK

MARCH 22, 2013

REGISTRATION &
RECEPTION

10:30 A.M. – 11:30 A.M.

LUNCH

11:30 A.M. – 12:20 P.M.

PRESENTATION

12:20 P.M. – 2:15 P.M.

2.0 NYS/NJS
CLE PROFESSIONAL
CREDITS FOR BOTH
NEWLY ADMITTED
AND EXPERIENCED
ATTORNEYS



THE
NEW YORK
INTELLECTUAL PROPERTY
LAW ASSOCIATION

In conjunction with
THE NYIPLA 91ST ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY
present

DAY OF THE DINNER CLE LUNCHEON

*The Interplay Between
Patent Litigation in the
District Courts and
Proceedings before the
Patent and Trademark Office*

SPEAKERS

CIRCUIT JUDGE KATHLEEN M. O'MALLEY
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

DISTRICT JUDGE STANLEY R. CHESLER
UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

CHIEF MAGISTRATE JUDGE STEVEN M. GOLD
UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW YORK

CHIEF ADMINISTRATIVE JUDGE JAMES D. SMITH
PATENT TRIAL AND APPEAL BOARD FOR THE U.S. PATENT AND TRADEMARK OFFICE

MODERATOR

MARK ABATE
NYIPLA PAST PRESIDENT, GOODWIN PROCTER LLP

Hosted by the
NYIPLA Continuing Legal Education Committee





Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®



HOT TOPICS IN TRADEMARK LAW!

EARN 3.5 NYS/NJS CLE CREDITS



AGENDA

- | | |
|---------------|--|
| 12:00 - 12:30 | Registration |
| 12:30 - 1:15 | Lunch |
| 1:15 - 1:45 | Keynote Speaker Honorable Thomas P. Griesa
<i>United States District Court for the Southern District of New York</i> |
| 1:45 - 2:15 | Insider's Look at New gTLD Program
Marylee Jenkins , Arent Fox LLP |
| 2:15 - 2:45 | Key Word Advertising – Dos and Don'ts After Rosetta Stone
Perry Viscounty , Latham & Watkins LLP |
| 2:45 - 3:00 | Refreshment Break |
| 3:00 - 3:30 | Behavioral Advertising and Privacy Considerations
Jonathan Moskin , Foley & Lardner LLP |
| 3:30 - 4:00 | Sports Sponsorships
Jane Pollack , Citigroup |
| 4:00 - 4:30 | Proving Damages in Trademark Cases – What is Required, and How To Do It
Howard Shire , Kenyon & Kenyon LLP |
| 4:30 - 5:00 | Update on Dilution in the TTAB and the Courts
Pat Razzano , Fitzpatrick Cella Harper & Scinto |

Hosted by the Continuing Legal Education Committee Co-Chairs Mark Bloomberg and Robert Rando
in conjunction with the Trademark Law & Practice Committee Co-Chairs Pina Campagna and Kathleen McCarthy

Wednesday, July 18, 2012
The Princeton Club, NY

AGENDA

8:00 AM - 8:45 AM Continental Breakfast

8:45 AM - 8:55 AM Welcome Remarks

8:55 AM - 10:40 AM Panel 1 Implementation and Effects of the America Invents Act

Moderator **William Thomashower** *Schwartz & Thomashower LLP*

- New Rules Regarding First Inventor to File **William LaMarca** *United States Patent and Trademark Office*
- Reexamination Strategy **Sean Grygiel** *Fish & Richardson, P.C.*
- ADR, Judicial Recourse, and Estoppel in Post-Grant Review **Charles Miller** *Dickstein Shapiro LLP*
- Joinder **Stacey Cohen** *Skadden, Arps, Slate, Meagher & Flom LLP*

10:40 AM - 10:55 AM Refreshment Break

10:55 AM - 12:15 PM Panel 2 Validity and Infringement of Method Claims

Moderator **Adda Gogoris** *Merchant & Gould, P.C.*

- Supreme Court and Federal Circuit Cases Regarding Abstract Ideas **Charles Macedo** *Amster, Rothstein & Ebenstein LLP*
- Supreme Court and Federal Circuit Cases Regarding Laws of Nature **Matthew McFarlane** *Robins, Kaplan, Miller & Ciresi LLP*
- *Akamai* – Inducement of Infringement **Paul Ackerman** *Dorsey & Whitney LLP*

12:15 PM - 12:55 PM Lunch

12:55 PM - 1:30 PM Keynote Speaker Honorable Mitchell Goldberg

United States District Court for the Eastern District of Pennsylvania

1:30 PM - 3:15 PM Panel 3 Ethical Considerations in Patent Prosecution and Litigation

Moderator **Wan Chieh (Jenny) Lee** *King & Spalding LLP*

- Supplemental Examination **Jonathan Ball** *Greenberg Traurig, LLP*
- PTO New Regulations on Rule 1.56 **Robert Katz** *Eaton & Van Winkle LLP*
- Update on Inequitable Conduct Decisions Since *Therasense* **Pablo Hendler** *Ropes & Gray LLP*
- Effect of *Hyatt* on Prosecution Strategy **Jon Gordon** *Frommer Lawrence & Haug LLP*

3:15 PM - 3:30 PM Refreshment Break

3:30 PM - 4:50 PM Panel 4 Issues Arising in Licensing Patents

Moderator **Andy Berks** *Nostrum Pharmaceuticals LLC*

- Allocation of IP Rights in Research Agreements **Andy Berks**
- Licensing with Government Agencies and Academic Institutions
Steven Hoffberg *Ostrolenk Faber LLP*
- Admissibility of Settlement Agreements **Richard Brown** *Day Pitney LLP*

4:50 PM - 5:00 PM Closing Remarks

EARN NYS/NJS CLE 7.0 CREDITS INCLUDING 2.0 ETHICS CREDITS

Hosted by the Continuing Legal Education Committee

Co-Chairs Mark Bloomberg and Robert Rando



Monthly CLE Programs

An Outside Counsel Perspective: Maximizing Opportunities to Succeed with Colleagues and Clients

June 28, 2012

Panelists: Leora Ben-Ami, Sona De, Marta Gross, Jeanna Wacker

*Hosted by the Women in IP Law Committee
Co-Chairs: Sona De and Jeanna Wacker*



AIA Implementation: How to Update Your Patent Strategies

September 20, 2012

Panelists: Edward Blocker, Dana Colarulli,
Raymond Farrell, Steven Lendaris

*Hosted by Meetings & Forums Committee
Co-Chairs: Colman Ragan and Debra Resnick
With appreciation to Kevin Ecker*



Making and Leveraging Connections: How to Develop a Professional Network as a Young IP Lawyer

July 12, 2012

Panelists: Jonathan Auerbach, Dorothy Auth, Kevin Culligan,
Kevin Ecker, Terri Gillis, Frank Sedlarcik

*Hosted by the Young Lawyers Committee
Co-Chairs: Jonathan Auerbach, Michael Bullerman, Lauren Nowierski*



USPTO American Invents Act (AIA) Roadshow

September 28, 2012

Panelists: Hiram Bernstein, Nicole Haines, Honorable Sally Medley,
Peter Pappas, Michelle Picard, Teresa Stanek Rea,
Honorable Mike Tierney, Gerald Torres

*Hosted by the Patent Law & Practice Committee
Co-Chairs: Brian Rothery and Peter Thurlow*



Monthly CLE Programs

Ethical Considerations in the Use of Social Media

October 18, 2012

Panelists: Professor David Bender, Steven Bennett, David Lewis, Peter McLaughlin

Hosted by Meetings & Forums Committee

Co-Chairs: Colman Ragan and Debra Resnick

in conjunction with Internet & Privacy Law Committee

Co-Chairs: Jonathan Moskin and Kevin Moss

and Copyright Committee, Co-Chairs: Joel Schmidt and Thomas Kjellberg



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

October 24, 2012

Speakers: Nancy Geenen, Suann Ingle

Hosted by the Women in IP Law Committee

Co-Chairs: Sona De and Jeanna Wacker



First-To-File: Is Your Company Ready for the Upcoming Changes to the Patent Laws?

February 6, 2013

Panelists: Walter Copan, Peter DeLuca, Michael Johnson, Mark Lesko, Michael McEntee, Tom O'Rourke, Sue Purvis, Colman Ragan, Donna Tumminello

Hosted by Meetings & Forums Committee

Co-Chairs: Colman Ragan and Debra Resnick

With appreciation to Raymond Farrell



Monthly CLE Programs

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

December 6, 2012

*Hosted by Meetings & Forums Committee
Co-Chairs: Colman Ragan and Debra Resnick*



Speaker:
Honorable Faith S. Hochberg

Making Your Case: Effectively Using Experts in Patent Litigation

February 28, 2013

Panelists: Bindu Donovan, Lisa Ferri, Thomas Meloro

*Hosted by the Young Lawyers Committee
Co-Chairs: Jonathan Auerbach, Michael Bullerman, Lauren Nowierski*



Patentability and Enforceability of Mobile Apps

April 25, 2013

Panelists: Christopher Copeland, Alfonzo Cutaia, Robert Fluskey

*Hosted by World IP Day Committee
Liaison: Jessica Copeland*



World Intellectual Property Day: IP in Fashion

April 26, 2013

Panelists: Amanda Agati, Rakiat Layo Gbadamosi, Professor Susan Scafidi, Heather Thomson

*Hosted by World IP Day Committee
Liaison: John Moehringer*



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