

# 2007/2008 GREENBOOK

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

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

- BYLAWS, ARTICLE II

**MEMBER  
NATIONAL COUNCIL OF PATENT LAW ASSOCIATIONS**

The GREENBOOK constitutes a review of the period from June 2006 through December 1, 2007. The closing date for inclusion of new members was February 1, 2008, and for changes to membership contact information was December 1, 2007.

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

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•

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•

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# **PART I**





# **SECTION 1**

*Officers & Board of Directors*



*Christopher A. Hughes*  
*NYIPLA President*  
*2007-2008*

## OFFICERS AND BOARD OF DIRECTORS 2007-2008



*Front row (left to right):* NYIPLA Officers Charles R. Hoffmann, Dale L. Carlson, Anthony Giaccio, Christopher A. Hughes, Mark J. Abate, Theresa M. Gillis, Marylee Jenkins  
*Back row (left to right):* NYIPLA Board of Directors Ronald A. Clayton, Anthony F. LoCicero, David F. Ryan, Thomas J. Meloro, Philip T. Shannon, Alexandra B. Urban  
(not shown are Karl Milde, W. Edward Bailey, Jeffrey N. Myers.)

### OFFICERS 2007-2008

*President,* CHRISTOPHER A. HUGHES

One World Financial Center, New York, NY 10281-2101

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

*President Elect,* ANTHONY GIACCIO

One Broadway, New York, NY 10004

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

*First Vice-President,* MARK J. ABATE

599 Lexington Avenue, New York, NY 10022

Tel: (212) 459-7031 Fax: (212) 355-3333

*Second Vice-President,* DALE L. CARLSON

One Century Tower, New Haven, CT 06508

*Treasurer,* THERESA M. GILLIS

153 East 53rd Street, New York, NY 10022

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

*Secretary,* CHARLES R. HOFFMANN

6900 Jericho Turnpike, Syosset, NY 11791

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

*Immediate Past President,* MARYLEE JENKINS

1675 Broadway, New York, NY 10019

Tel: (212) 484-3928 Fax: (212) 484-3990

## **BOARD OF DIRECTORS 2007-2008**

ANTHONY F. LOCICERO (2010)  
90 Park Avenue, New York, NY 10016  
Tel: (212) 697-5335 Fax: (212) 286-0854

JEFFREY N. MYERS (2010)  
150 East 42nd Street, New York, NY 10017  
Tel: (212) 733-5061 Fax: (646) 383-9207

DAVID F. RYAN (2010)  
1214 Albany Post Road, Croton-on-Hudson, NY 10520  
Tel: (914) 271-2225

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

PHILIP T. SHANNON (2008)  
750 Lexington Avenue, New York, NY 10022  
Tel: (212) 912-2938 Fax: (866) 512-9916

W. EDWARD BAILEY (2008)  
7 Times Square, New York, NY 10036  
Tel: (212) 847-8723 Fax: (212) 703-8973

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

THOMAS J. MELORO (2009)  
787 Seventh Avenue, New York, NY 10019  
Tel: (212) 728-8248 Fax: (212) 728-8111

ALEXANDRA B. URBAN (2009)  
10 Farm Springs Road, Farmington, CT 06032  
Tel: (860) 676-5086 Fax: (860) 622-0218

## **SECTION 2**

*Committees: 2007-2008*

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

## **Committee on Alternative Dispute Resolution**

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

*Chair*

WALTER E. HANLEY, JR

*Board Liaison*

DAVID F. RYAN

DANIEL EBENSTEIN

WILLIAM FEILER

HUI LIU

THOMAS F. MEAGHER

CHARLES E. MILLER

MERRI MOKEN

JACK A. O'BRIEN

DAVID W. PLANT

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

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

*Chair*

MARK J. ABATE

*Board Liaison*

ANTHONY GIACCIO

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

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

*Chair*

DALE L. CARLSON

*Board Liaison*

ANTHONY GIACCIO

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

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

*Chair*

DOUGLAS R. NEMEC

*Board Liaison*

DAVID F. RYAN

*Members*

ROBERT ALDERSON

EDWARD MEILMAN

BRIAN MCQUILLEN

MAURICE ROSS

GERARD MCGOWAN

PETER SAXON

ESTHER H. STEINHAUER



## Committee on Continuing Legal Education

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

### *Chair*

DOROTHY R. AUTH

### *Board Liaison*

THOMAS J. MELORO

### *Members*

KAREN AXT	WAN CHIEH (JENNY) LEE
DAVID BOMZER	SONJA KEENAN
JENNIFER CHUNG	BENU MEHRA
ANNA ERENBURG	TOD MELGAR
RICHARD ERWINE	SUSAN PROGOFF
ANGIE HANKINS	MARY RICHARDSON
BENJAMIN C. HSING	IRENA ROYZMAN
KEITH ZULLOW	

## **Committee on Copyrights**

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

### *Chair*

DAVID A. EINHORN

### *Board Liaison*

RONALD A. CLAYTON

### *Members*

MICHAEL BRYNER	RICHARD KLAR
NICHOLAS EISENMAN	ANDREW KOENIG
LEESA FENDERSON	KIMBERLY KORN
TOMOHIKO KAMIYA	GEORGE MACDONALD
DOUGLAS KENYON	KATHLEEN MCCARTHY
ROBERT POWLEY	

## Committee on Design Protection

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

*Chair*

JONATHAN E. MOSKIN

*Board Liaison*

PHILIP T. SHANNON

*Members*

WILLIAM BASSLER

URSULA B. DAY

LEESA FENDERSON

POLINA L. GOLDENBERG

STEPHEN KAMPMEIER

KIMBERLY KORN

RODNEY C. KYLE

THOMAS SPATH

DAVID WEILD III

## Committee on International IP Law

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

### *Chair*

SAMSON HELFGOTT

### *Board Liaison*

KARL F. MILDE, JR.

### *Members*

ALBERT WAI-KIT CHAN	HUI LIU
KIM CHANG SIK	ALAN JAY MORRISON
ANDREW CHIEN	KENDRICK P. PATTERSON
SHARON CRANE	YUNLING REN
PAUL F. FEHLNER	IAN SCOTT
PETER F. FELFE	GUY W. SHOUP
POLINA L. GOLDENBERG	THOMAS E. SPATH
DOUGLAS KENYON	JOHN P. WHITE
DIMITRY KOGAN	HA KUNG WONG
RODNEY KYLE	FENG XU

## **Committee on Internet Law**

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

*Chair*

PAUL J. REILLY

*Board Liaison*

ALEXANDRA B. URBAN

*Members*

JAMES GIBSON  
ROBERTA KRAUS  
ABIGAIL RUBINSTEIN

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

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

*Chair*

CHARLES A. WEISS

*Board Liaison*

MARK J. ABATE

*Members*

BRIDGETTE AHN	CHARLES E. MILLER
THOMAS BECK	STEVEN J. MOORE
GREG DENNIS	ROBERT RANDO
PETER F. FELFE	DAVID RYAN
MELVIN GARNER	IRENA ROYZMAN
MARYLEE JENKINS	PETE SAXON
JEFFREY LEWIS	ROCHELLE K. SEIDE
JINNY SUH	

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

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

### *Chair*

ALLAN A. FANUCCI

### *Board Liaison*

JEFFREY N. MYERS

### *Members*

MICHAEL I. CHAKANSKY

MARK A. FARLEY

KAZUO MAKINO

E. BRADLEY GOULD

TED WEISZ

## Committee on Litigation Practice and Procedure

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

### *Chair*

JEFFERY M. BUTLER

### *Board Liaison*

THOMAS J. MELORO

### *Members*

MARY ANN C. BALL	STEPHEN LIEB
EDMOND R. BANNON	BRIAN MCQUILLEN
THOMAS H. BECK	THOMAS F. MEAGHER
ZAED BILLAH	BENU MEHRA
DAVID T. BOMZER	DANIEL MILLER
JENNIFER CHUNG	DOUGLAS R. NEMEC
ALISON HANSTEAD	KEVIN REINER
MICHAEL F. HURLEY	DAVID F. RYAN
CATHERINE LACAVERA	LAWRENCE SCINTO
GASPER LAROSA	VICTOR SOUTO
ESTHER STEINHAUER	

## **Committee on Meetings and Forums**

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

*Chair*

RICHARD W. ERWINE

*Board Liaison*

ALEXANDRA B. URBAN

*Members*

CHERYL H. AGRIS, PH. D.	PAMELA PARKER
DOROTHY AUTH	KENDRICK PATTERSON
JESSICA COPELAND	ROLAND PLOTTEL
SHARON CRANE	RORY RADDING
GERARD HADDAD	KEVIN REINER
ANGIE M. HANKINS	DEBRA RESNICK
BENJAMIN HSING	MARK SCHILDKRAUT
RICHARD KLAR	FRANK SEDLARCIK
DAVID LORENZ	TODD SMITH
RICHARD MARTINELLI	VICTOR SOUTO
JOHN MOEHRINGER	JENNIFER WU

## **Committee on Membership**

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

*Chair*

MARILYN MATTHES BROGAN

*Board Liaison*

RONALD A. CLAYTON

*Members*

DOLLY ALEVIZATOS	LESLIE K. MITCHELL
VICTORIA DOYLE	ALICIA RUSSO
ERIN HENNESSY	DEENA WEINHOUSE



## Nominating Committee

*Scope of the Committee.* It shall be the duty of this Committee to consider candidates to the elective offices of the Association and to submit to the members at the Annual Meeting of the Association the names of candidates which the Committee nominates for such elective offices according to Article VI, Section 4.

### *Chair*

MARYLEE JENKINS

### *Members*

JOHN D. MURNANE

JACK SLOBOD

ROBERT SCHEINFELD

EDWARD E. VASSALLO

## Committee of Past Presidents

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

### *Chair*

EDWARD E. VASSALLO

### *Board Liaison*

MARYLEE JENKINS

### *Members*

HOWARD B. BARNABY

KARL F. JORDA

LORIMER P. BROOKS

DAVID H.T. KANE

HUGH A. CHAPIN

STANTON T. LAWRENCE, JR.

BERT A. COLLISON

JEROME G. LEE

HON. WILLIAM C. CONNER

JOHN D. MURNANE

JOHN C. COOPER

ROBERT NEUNER

THOMAS L. CREEL

JOHN B. PEGRAM

RICHARD L. DELUCIA

JOSEPH J. PREVITO

WILLIAM F. EBERLE

PASQUALE A. RAZZANO

PAUL M. ENLOW

JOHN A. REILLY

EDWARD V. FILARDI

ALBERT ROBIN

FRANK W. FORD, JR.

M. ANDREA RYAN

MELVIN C. GARNER

PETER SAXON

WILLIAM J. GILBRETH

HERBERT F. SCHWARTZ

EDWARD HALLE

JOHN F. SWEENEY

CYRUS S. HAPGOOD

JOHN O. TRAMONTINE

DOUGLAS W. WYATT

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

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

### *Chair*

WILLIAM H. DIPPERT

### *Board Liaison*

JEFFREY N. MYERS

### *Members*

BRIDGETTE AHN  
DAVID BADANES  
MARY ANN C. BALL  
GERARD BILOTTO  
DAVID BOMZER  
ANTHONY BOTTINO  
RONALD BROWN  
KIM CHANG SIK  
DAVID CONCA  
PETER F. FELFE  
MELVIN GARNER  
GARY J. GERSHIK  
MICHAEL KAHN  
KRISTINA KONSTAS  
MURIEL LIBERTO

STEPHEN LIEB  
EDWARD A. MEILMAN  
CHARLES E. MILLER  
LAWRENCE PERRY  
THOMAS F. PRESSON  
JOSH REISBERG  
JOSEPH J. RICHETTI  
IRENA ROYZMAN  
PETER SAXON  
IAN SCOTT  
TIMUR SLONIM  
JOHN P. WHITE  
MILTON WOLSON  
FENG XU  
REN YUNLING

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

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

*Chair*

SUSAN E. MCGAHAN

*Board Liaison*

W. EDWARD BAILEY

*Members*

TO BE ANNOUNCED

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

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

*Chair*

JOHN T. MOEHRINGER

*Board Liaison*

W. EDWARD BAILEY

*Members*

JESSICA L. COPELAND  
REGINA M. LUTZ  
MAREN C. PERRY  
MARK J. SCHILDKRAUT  
BRAD M. SCHELLER

## Committee on Publications

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

*Chair and Bulletin Editor*  
ASHE P. PURI

*Greenbook Editor*  
STEPHEN J. QUIGLEY

*Graphic Designer*  
JOHANNA I. STURM

### *Members*

KATE CASSIDY  
ARUN CHANDRA  
SUJATA CHAUDHRI  
ARTHUR CUTILLO  
WILLIAM DIPPERT

CATHERINE GRATTON  
BENJAMIN C. HSING  
JOSEPH LOY  
MARY W. RICHARDSON  
RAYMOND VAN DYKE

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

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

*Chair*

HOWARD C. MISKIN

*Board Liaison*

KARL F. MILDE JR

*Members*

TO BE ANNOUNCED

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

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

*Chair*

AMY J. BENJAMIN

*Board Liaison*

ANTHONY LOCICERO

*Members*

DAVID BADANES	MICHELLE GRAHAM
GERARD BILOTTO	WILLIAM K. GUILD
ANTONIO BORELLI	JASON KORAL
KAREN BROMBERG	KATHLEEN MCCARTHY
PINA CAMPAGNA	ROLAND PLOTTEL
URSULA B. DAY	SUSAN PROGOFF
STEPHEN FEINGOLD	RICHARD MILLS ROBERTSON
	HOWARD SHIRE

## Young Lawyers Committee

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

### *Chair*

SONJA KEENAN

### *Board Liaison*

CHRISTOPHER A. HUGHES

### *Members*

BRIDGETTE AHN

AMY BECKMAN

ZAED BILLAH

TODD BREUER

ANDREW CHIEN

JENNIFER CHUNG

JESSICA COPELAND

ALISON HANSTEAD

KIMBERLY KORN

JENNY LEE

VINNY LEE

BENU MEHRA

RICHARD MILLS-ROBERTSON

LARRY ROSENTHAL

PAM PARKER

JENNIFER WU

**American Intellectual Property Law Education Foundation Liaison**

DANIEL A. DEVITO

**Joint Patent Practice Continuing Legal Education Liaison**

DOROTHY R. AUTH

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

SAMSON HELFGOTT  
THOMAS E. SPATH

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

JOHN B. PEGRAM  
MARYLEE JENKINS

**Committee on Diversity Schlorships**

W. EDWARD BAILEY





## **SECTION 3**

*Treasurer's Report 2006-2007*

## **ANNUAL REPORT OF THE TREASURER 2006-2007**

As described in detail in the report of the Association's Certified Public Accountant, the statement of income and expenses for the fiscal year 2006-2007 shows a net gain of \$148,552.

The Association's net worth is \$1,134,463 and its financial condition continues to be sound. The Association continues to be in favorable condition as it begins the fiscal year 2007-2008.

**THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.  
STATEMENT OF ASSETS AND LIABILITIES  
FOR THE YEAR ENDING APRIL 30, 2007  
EXHIBIT A**

### **CURRENT ASSETS**

Cash – Checking Account – Citibank	\$399,763.00
Money Market Account	505,595.00
Certificate of Deposit – Due 5/5/07	80,835.00
Certificate of Deposit – Due 10/13/07	32,894.00
Certificate of Deposit – Due 5/5/07	81,541.00
Certificate of Deposit – Due 2/28/07	33,835.00

**TOTAL ASSETS** **\$1,134,463.00**

### **NET WORTH**

Balance – May 1, 2006	\$985,911.00
Plus: Net Gain for the Period Ended, April 30, 2007	\$148,552.00

**TOTAL NET WORTH** **\$1,134,463.00**

**THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION, INC.**  
**STATEMENT OF INCOME AND EXPENSES**  
**FOR THE YEAR ENDING APRIL 30, 2007**  
**EXHIBIT B**

**INCOME**

Annual Dues Income	\$187,850
CLE Program Income	125,830
Judges Dinner Income	1,042,745
Annual Meeting Income	7,980
Interest Income	12,051
	\$1,376,456
<b>TOTAL INCOME</b>	<b>\$1,376,456</b>

**EXPENSES**

CLE Program Expense	\$87,946
Judges Dinner Expense	672,649
Annual Meeting Expense	19,183
Board of Directors Meeting Expense	14,592
Consulting Expense	317,083
Printing Expense	34,869
Membership Support Expense	5,744
Accounting Expense	6,590
Insurance Expense	10,310
Scholarship Expense	10,000
Committee Meeting Expense	12,121
Administrative Expense	4,966
Website Expense	3,600
Awards Expense	2,500
Young Lawyers Expense	3,566
Past Presidents Dinner Expense	11,900
Credit Card Processing Fees	7,877
Bank Service Charges	272
Miscellaneous Expense	2,136
	\$1,227,904
<b>TOTAL EXPENSES</b>	<b>\$1,227,904</b>

**NET GAIN – EXHIBIT B** **\$148,552**



## **SECTION 4**

*Former Officers & Directors*

## PRESIDENTS

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

## SECRETARIES

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

## TREASURERS

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

## PRESIDENT ELECT†

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

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

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

†Amended May 24, 1979

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

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

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

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

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

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



## BOARD OF DIRECTORS

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

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**BOARD OF DIRECTORS**

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

*(Continued)*

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

Richard G. Berkley	1982-1985	John F. Sweeney	1992-1995
Barry Evans	1982-1985		2001-2002
Frank F. Scheck	1982-1985	Berj A. Terzian	1992-1995
	1991-1992	Ronald A. Bleeker	1995-1996
James W. Badie	1983-1986	William J. Brunet	1993-1996
Maria C.H. Lin	1983-1986	William F. Lawrence	1993-1996
Michael N. Meller	1983-1986	Herbert F. Schwartz	1993-1996
John B. Pegram	1983-1986		2000-2001
	1990-1991	Michael J. Kelly	1994-1997
Walter J. Baum	1984-1987	Thomas E. Spath	1994-1997
Herbert Blecker	1984-1987	Marilyn M. Brogan	1995-1998
William F. Lawrence	1984-1987	Richard DeLucia	1995-1998
Philip Furgang	1985-1988		2002-2003
Elsie M. Quinlan	1985-1988	Robert Neuner	1995-1998
Pasquale A. Razzano	1985-1988		2002-2003
	1995-1996	Theresa M. Gillis	1996-1999
Howard B. Barnaby	1986-1989	Edward E. Vassallo	1996-1999
	1999-2000		2006-2007
Samson Helfgott	1986-1989	Alice Brennan	1997-2000
M. Andrea Ryan	1986-1989	John Daniel	1997-2000
	1993-1994	Thomas A. O'Rourke	1997-2000
Alfred P. Ewert	1987-1990	Charles P. Baker	1998-2001
Leonard B. Mackey	1987-1990	Edward M. Blocker	1998-2001
William J. Gilbreth	1987-1990	Susan McHale McGahan	1998-2001
	1994-1995		2005-2006
Dale L. Carlson	1988-1991	Marylee Jenkins	1998-2001
	2004-2007	Mark J. Abate	1999-2002
John E. Kidd	1988-1991	Ira J. Levy	1999-2002
Evelyn M. Sommer	1988-1991	Dawn Buonocore	2000-2003
Thomas L. Creel	1989-1992	Cecilia O'Brien Lofters	2000-2003
	1996-1997	Rory J. Radding	2000-2003
Martin E. Goldstein	1989-1992	Thomas H. Beck	2001-2002
	1997-1998	Christopher A. Hughes	2001-2004
Stanley J. Silverberg	1989-1992	Robert C. Morgan	2001-2004
Robert L. Baechtold	1990-1993	Anthony M. Santini	2001-2004
Peter Saxon	1991-1992	William H. Dippert	2002-2005
David J. Mugford	1990-1993	Charles R. Hoffmann	2002-2005
Gregory J. Battersby	1991-1994	Jack D. Slobod	2002-2005
Edward V. Filardi	1991-1994	Melvin C. Garner	2004-2005
	1998-1999	Anthony Giaccio	2003-2005
Roger S. Smith	1991-1994	Laura A. Coruzzi	2003-2006
John D. Murnane	1992-1995	Daniel A. DeVito	2003-2006
	2005-2006	Robert C. Scheinfeld	2004-2007
		Vincent N. Palladino	2004-2007



## **SECTION 5**

*Bylaws*

## **ARTICLE I**

### **Name**

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

## **ARTICLE II**

### **Object**

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

## **ARTICLE III**

### **Members**

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

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

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

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

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

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

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

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

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

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

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

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



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

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

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

## **ARTICLE IV**

### **Officers**

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

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

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

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

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

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

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

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

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

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

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

## **ARTICLE V**

### **Directors**

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

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

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

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

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

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

## **ARTICLE VI**

### **Committees**

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

## **ARTICLE VII**

### **Meetings of the Association**

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



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

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

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

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

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

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

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

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

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

## **ARTICLE VIII**

### **Elections**

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

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

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

## **ARTICLE IX**

### **Suspensions and Expulsions**

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

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

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

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

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

## **ARTICLE X**

### **Property**

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

## **ARTICLE XI**

### **Amendments**

The Bylaws may be amended, but only by a two-thirds vote of the members entitled to vote present in person or by proxy at an annual meeting of the Association, or at a stated meeting called in accordance with the provisions of these Bylaws after notice mailed ten days before the meeting to each Active Member of the Association, such notice to contain a copy of the proposed amendment with a precise statement of the purpose thereof. The Association shall not pay the expenses of any such notice unless the proposed amendment has been approved by the Board of Directors.

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



## **SECTION 6**

*Rules on Admission*

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

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

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

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

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

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

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

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



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

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

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

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\* Adopted October 16, 1973.



# **SECTION 7**

*Members*

# Honorary Members\*

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

## Second Circuit-Court of Appeals

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

## Senior Circuit Judges

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

## District Court, Connecticut

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

\*This listing has last been updated November 2007

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

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

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

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

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

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

*(continued)*

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

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

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

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

**District Court, Vermont**

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

**Senior District Judges**

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

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

————— **Third Circuit-Court of Appeals** —————

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

————— **Senior Circuit Judges** —————

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

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

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

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

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

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

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



————— **Senior Circuit Judges** —————

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

————— **Secretary of Commerce** —————

Carlos M. Gutierrez	Washington, DC
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————— **Under Secretary of Commerce  
for Intellectual Property and  
Director of the United States Patent and Trademark Office** —————

Jon W. Dudas	Washington, DC
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————— **Deputy Under Secretary of Commerce  
for Intellectual Property and  
Deputy Director of the United States Patent and Trademark Office** —————

Margaret J.A. Peterlin	Washington, DC
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————— **Commissioner for Patents** —————

John J. Doll	Washington, DC
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————— **Deputy Commissioner for  
Patent Operations** —————

Peggy A. Focarino	Washington, DC
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————— **Deputy Commissioner for  
Patent Examination Policy** —————

John J. Love	Washington, DC
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————— **Deputy Commissioner for  
Patent Resources and Planning** —————

(Temporarily Vacant)

————— **Commissioner for Trademarks** —————

Lynne G. Beresford	Washington, DC
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————— **Register of Copyrights** —————

Marybeth Peters	Washington, DC
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*CLE Day-of-Dinner Program and Luncheon, March 23, 2007*



*85th Annual Dinner  
in Honor of the Federal Judiciary*

The New York Intellectual Property Law Association held its 85th Annual Dinner in Honor of the Federal Judiciary on March 23, 2007 at the Waldorf=Astoria Hotel. This year's Dinner set a record attendance.

President Marylee Jenkins welcomed the honored guests, members of the NYIPLA and their guests before introducing a trio of Juilliard students who opened the evening's events with an inspiring rendition of the National Anthem.

The Association's Fifth Annual Outstanding Public Service Award was presented to The Honorable Paul R. Michel, Chief Judge of the United States Court of Appeals for the Federal Circuit. The award was presented to Judge Michel in recognition of his dedication to the pursuit and administration of justice. Judge Michel's informative speech addressed the shared responsibility of our nation's system of justice that is placed on our judges and attorneys.

Keynote Speaker Tim Russert, moderator for NBC's Meet the Press, provided an informative and insightful review of the changing role of the media in presenting the political issues of the day.

This year's recipient of the Diversity Scholarship, as part of the Sidney B. Williams, Jr. Minority Scholarship Program of the American Intellectual Property Law Education Foundation (AIPLEF), was Deepak Parashar, a law student at the University of Alabama, Tuscaloosa. The presentation of the \$10,000 NYIPLA check was made by NYIPLA President Marylee Jenkins to John Delehanty, President of the AIPLEF and to Philip Johnson, Chairman of the AIPLEF's Board of Trustees.

*The 85<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary, March 23, 2007*









*The 85<sup>th</sup> Annual Dinner in Honor of the Federal Judiciary, March 23, 2007*








*Annual Meeting and Awards Dinner, May 23, 2007*



 On Wednesday, October 3, 2007, the New York Intellectual Property Law Association hosted a reception and dinner for the Federal Circuit Court of Appeals' visit to New York City which also commemorated the Court's 25th Anniversary. The event took place at the Starlight Roof of the Waldorf=Astoria Hotel. There were nearly 500 attendees, including judges, law school deans and professors, court clerks and administrative staff, NYIPLA officers, members and guests.

The evening began with a reception at the Waldorf=Astoria where the attendees had an opportunity to meet the judges of the Federal Circuit and other distinguished guests. Following the reception, the dinner commenced where the attendees had an opportunity to hear Chief Judge Paul R. Michel speak.

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## **Message from Chief Judge Paul R. Michel, United States Court of Appeals for the Federal Circuit**

On behalf of the judges and staff of the Court of Appeals for the Federal Circuit, I want you to know how pleased we are to be conducting oral arguments this week in New York City. It has been over a decade since our last visit. As you know, the Court routinely sits, usually once each year, in a major city outside of Washington, DC. In scheduling these sessions, we try to "ride circuit," sitting in all regions and in other major cities before returning somewhere to sit once again as we do this October here in New York.

We are grateful to the New York Intellectual Property Law Association for organizing this grand dinner and also for coordinating other events during our stay. Particular thanks go to Jeffrey Butler, Mark Abate, and their colleagues on the Host Committee. Among other events they helped arrange are panels at the law schools of Columbia

University, Fordham University, and New York University. In addition, a panel is sitting at the Court of International Trade and two panels at the Moynihan Courthouse of the Court of Appeals for the Second Circuit and the District Court for the Southern District of New York. Finally, they organized a Continuing Legal Education Program at the Association of the Bar of the City of New York at lunchtime on Thursday, October 4, our final day in New York City.

The Federal Circuit heard its first arguments 25 years ago this month. Although the statute creating the Court was enacted on April 2, 1982, its effective date was October 1. We marked the earlier date with a 25<sup>th</sup> Anniversary Special Session in Washington on April 2, 2007, and we now celebrate the later date with you tonight.

In 1982, the Court's most experienced member was your former president, the Honorable Giles Sutherland Rich. Even before joining the Court, Judge Rich made an historic contribution to modern patent law as one of the principal drafters of the Patent Act, approved by the Congress in 1952. Over half a century later, the Congress is reconsidering the Patent Act. Quite appropriately, it has heard from many witnesses in various industries. It is unfortunate in my view, however, that unlike the Congress in 1952, the present Congress has not sought out the advice of leading patent lawyers such as Judge Rich and the Honorable Pauline Newman, who served on your Board of Directors from 1968 to 1972. Nor has the Congress chosen to hear from district judges who actually try patent cases, such as those here this evening. I hope that leaders of the Bar will make their views known before Congress concludes its work on the pending bills, possibly this fall.

Meanwhile, we appreciate the fine hospitality of the NYIPLA, the law schools, and the Association of the Bar of the City of New York. We particularly want to thank NYIPLA president Christopher Hughes, as well as all those association members who have worked so hard to make this visit so successful. We are privileged to be in partnership with your Association and to share this evening with all of you in attendance.

By Paul R. Michel,  
Chief Judge







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**PART II**

**A YEAR  
IN REVIEW  
OF THE  
ASSOCIATION**

# Section 1

*NYIPLA*  
*Annual Committee Reports*

# NYIPLA ANNUAL COMMITTEE REPORTS 2006-2007 TERM

## ALTERNATIVE DISPUTE RESOLUTION

*Walter Hanley, Chair*

I wish to thank Marylee Jenkins, President of the NYIPLA, for appointing me to the position of Chair of the ADR Committee for the 2006-2009 term upon the retirement of Robert Tobin.

Shortly after my appointment in October 2006, I was contacted by Chuck Miller of Dickstein Shapiro LLP about having the ADR Committee take up for consideration a legislative proposal to make arbitration available to plaintiffs in §145 actions against the USPTO in the District Court for the District of Columbia. After forming the Committee, inclusive of Mr. Miller, its focus became the study and consideration of this proposal, which is outlined below. The proposal was also placed by Mr. Miller before the NYIPLA Committee on Patent law and Practice and the Committee on Legislative Oversight and Amicus Briefs, and an article by Mr. Miller about it was published in the January/February 2007 issue of the NYIPLA Bulletin.

The proposed legislation would implement compulsory arbitration, at the election of the plaintiff patent applicant/owner, in suits against the USPTO in the U.S. District Court for the District of Columbia (“DDC”): (1) seeking review pursuant to 35 U.S.C. §§ 145 and 306 of Board of Appeals decisions finally rejecting claims in patent applications and reexamination proceedings, and (2) seeking review pursuant to 35 U.S.C. § 154(b)(4) of decisions by the Director denying patent term adjustments. Under current law, patent owners seeking review of Board decisions rejecting claims in patent applications and reexaminations can choose between a direct appeal to the Federal Circuit and a civil action in the DDC. The only avenue for review of a decision by the Director denying a patent term adjustment is a civil action in the DDC. Under the proposed legislation, on motion by the plaintiff, the DDC would initiate arbitration, under its supervision, before one or more arbitrators who have been certified by the court. The USPTO would have neither the right to request arbitration, nor the right to oppose it if requested by the plaintiff. The plaintiff would also have the right to elect to have one arbitrator or multiple arbitrators. The parties would have the opportunity to present evidence to the arbitrator(s) to the same extent they would if the matter were tried before the court. The arbitrators(s) would render a written decision setting forth the factual and legal basis for the decision. The decision would be entered as a judgment of the court, without review; however, it would not be citable as precedent for other cases.

Unlike a judgment resulting from a trial or other disposition by the court, a judgment entered on an arbitration decision would not be appealable to the Federal Circuit. As with §145 actions that are adjudicated by the DDC, all of the expenses of the proceeding, including the compensation of the arbitrator(s), would be borne by the plaintiff.

The following benefits and advantages of the proposal, among others, have been advanced:

1. Promotion of judicial economy by removing technologically complex cases from the DDC's trial calendar.
2. Promotion of speed and efficiency.
3. Promotion of technically accurate fact finding, because the panel of certified arbitrators would be experienced patent attorneys with requisite technical backgrounds.

The proposal and supporting material was distributed to the ADR Committee for review and comment, and a meeting was held at which the proposal was presented and discussed in detail. The points discussed by those in attendance included: the relative infrequency of §145 actions and how the availability of arbitration might increase the use of that avenue of review; whether the inability to appeal the arbitration decision will dissuade plaintiff's from seeking arbitration; and the quality of PTO examination in general, and whether the proposal, which is directed to insuring that meritorious inventions receive appropriate protection, is a legislative priority at the present time. The consensus of those present at the meeting was that the proposal has merit.

In the weeks following the meeting, I solicited further comments from the rest of the Committee, but received no additional comments. I also contacted the Chairs of the Committee on Patent law and Practice (William Dippert) and the Committee on Legislative Oversight and Amicus Briefs (Rochelle Seide) and requested that they distribute the proposal to the members of their Committees for comment. Mr. Dippert reported that the proposal had been taken up by a sub-committee of his Committee, and that the comments were generally favorable. Ms. Seide distributed the proposal to her Committee. I received only one comment from a member of her Committee, who questioned whether arbitration is appropriate for determining whether a patent should issue or what its scope should be in view of impact of patents on the public interest.

The relatively small number of comments received can be interpreted as indicating a perception that the proposed legislation is not a high priority at this time rather than any significant opposition to it, since most who expressed views about the proposal commented favorably. However, the one negative

comment about the appropriateness of arbitrators determining whether a patent should issue suggests that the lack of judicial review of the arbitration decision needs further study. It also appears that a better case must developed for the need for this legislation. The Committee will take up these aspects of the proposal, as well as other items for the Committee's agenda for the next year, at a future meeting.

## ANTITRUST, INEQUITABLE CONDUCT & MISUSE

*David Ryan, Chair*

The principal activities of the Committee this year related to consideration of developments in the law at the "interface" between intellectual property and the antitrust laws.

### **ANDA Settlement Payments**

Although the Supreme Court has denied certiorari in *FTC v. Schering-Plough*, the issue of the antitrust legality of settlement payments made by a Hatch-Waxman infringement plaintiff remains at issue in a number of lower federal court cases. The potential pertinence of *Professional Real Estate* ("PRE") to this issue was first pointed out in the *amicus* brief of the Association in *Andrx v. Kroger*, and has now been recognized by the Second Circuit panel in *Tamoxifen*.

Members of the Committee are working on an article summarizing the state of the law on settlement payments, including assessment of the effect if any of the recently issued report of the DOJ/FTC on the 2002 joint hearings.

### **Authorized Generics**

Although "big pharma" and the generic manufacturer's probably can agree that ANDA settlement payments are often procompetitive, there is likely to be less agreement on whether authorized generics should be permitted. The generics argue that launch of an authorized generic during the 180-day period of exclusivity, by either the innovator or a licensee, would unfairly impinge upon the incentives for generic challenges under Hatch-Waxman. In the absence of a statutory prohibition, however, only sales below cost by the authorized generic would seem to raise any Sherman Act Section 2 issues.

An article on authorized generics commissioned by the Committee and written by Stacey L. Cohen and Edward L. Tulin appeared in the January/February 2007 issue of the Bulletin.

### **Standard Setting**

Other members of the Committee are working on an article analyzing whether the types of conduct challenged in the *Rambus* and *Alcatel* litigations could give rise to equitable defenses cognizable under Section 283 which would bar injunctive relief under *eBay*, and whether such conduct also should support a claim for relief under the antitrust laws.

The article will consider whether *Walker Process* and *Independent Ink* require not only that the exclusionary potential of the infected claims must be measured against some economically meaningful relevant product market, but also that the representations made to the standard setting organization (“SSO”) should be sufficiently false or misleading and material to satisfy the common law fraud standard. The article also may consider the potential liberating impact of *Philips v. ITC* on the permissibility of package licensing by SSOs which has not yet been directly addressed in the literature.

### ***Medimmune v. Genentech***

As reported last year, members of the Committee were involved in the preparation of an *amicus* brief in support of petitioner in *Medimmune v. Genentech*, which involved the issue of whether declaratory judgment jurisdiction supports a licensee’s right to challenge the validity of a licensed patent without renouncing the protection of the license. The Supreme Court’s 8-1 decision in January rejected the Association’s position that a licensee should be required to abandon the protection of the license before challenging the licensed patents.

Members of the Committee are evaluating the impact of the decision on the finality of settlement agreements as well as its potential consequences for CAFC subject matter jurisdiction under 28 U.S.C. § 1295.

### **The Experimental Use Exception**

The same competitive impact arguments on *de facto* term extension made in the Association’s *amicus* brief in *Merck v. Integra* would seem to apply generally to all industries – irrespective of whether those industries make FDA filings. As reported last year, members of the Committee had recommended that a brief *amicus curiae* not be filed in the remand of the *Merck v. Integra* case to the Federal Circuit, but the oral argument on that remand revealed significant differences in approach as among the judges on the panel.

The Committee has been considering whether to recommend to the Board that the Association endorse a legislative proposal to extend the experimental use exemption of the Hatch-Waxman Act to industries which do not make submissions to the FDA, thus overruling *Madey v. Duke*.

### **Inequitable Prosecution Conduct Developments**

As reported last year, the Committee is continuing to monitor developments in the law of inequitable prosecution conduct. Some voted in favor of the Association filing a brief *amicus curiae* in support of the grant of certiorari in *Ferring*, but the decision was to do nothing unless certiorari was granted. The Federal Circuit decisions on IPC intent are in some disarray and particular results can appear panel dependent.



## **Interface Aspects Of Permanent Injunctions**

As reported last year, two members of the Committee also were involved in efforts to draft an *amicus* brief supporting respondent in the *eBay* case. An article about the case appeared in the July/August 2006 issue of the *Bulletin*.

Members of the Committee also have recommended that a brief *amicus curiae* be filed on behalf of the Association in support of the patentee in *Finisar v. DirecTV*, one of the first CAFC cases to deal with permanent injunction issues in the wake of *eBay*.

## **CONTINUING LEGAL EDUCATION**

***Amy J. Benjamin, Chair***

It has been a pleasure to serve as Chair of the Committee on Continuing Legal Education this year.

### **NYS CLE Accredited Provider Status**

The NYIPLA initially was certified by the New York State Continuing Legal Education Board as an Accredited Provider of continuing legal education in the State of New York on September 1, 1999. All of our 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.

Approval of the non-traditional CLE format (DVD) was received August 15, 2005. Certification was approved for the period April 27, 2004 through August 27, 2005. The NYIPLA was approved as an Accredited Provider of CLE programs for the period of August 28, 2005 through August 27, 2008, for live presentations and, for experienced attorneys only, videotapes (for individual viewing) and digital video discs (for individual viewing).

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

In compliance with the requirements of the New York State CLE Rules and Guidelines, we also filed an annual report with the New York State CLE Board on January 30, 2007 covering the 2006 calendar year.

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 23, 2007. Special invitations were sent to the Honored Guests attending the dinner. A distinguished panel, including two federal judges, presented a well-received discussion attended by 184 registrants. This year, fourteen federal judges attended this CLE program.

Since last year's report, the NYIPLA has sponsored 10 CLE programs totaling 26.5 credit hours of legal education, including one co-sponsored program. Our videotape library currently contains 17.50 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 16, 2006 CLE Program thru May 9, 2007 JPPCLE Program), the NYIPLA awarded approximately 5,800 NYS CLE credits, including approximately 670 ethics credits, and approximately 5,130 professional practice credits. In addition, there were approximately 1,507 attorneys who attended CLE programs during this program period.

We continue to price programs as close as possible to cover necessary costs. There were 15 financial aid requests in 2006-07.

### **Excellent Administrative Services Offered By Star Consulting**

All of the CLE-related administrative functions continue to be centralized with Star Consulting, with systems and procedures in place to provide continuous, coordinated support. This includes scheduling; communications with the hosting committee's program chairs, speakers and attendees; preparation and mailing of meeting notices; registration processing; preparation of Certificates of Participation, Course Evaluations and Certificates of Completion under the direction of the CLE Committee Chair; logistical planning and coordination; and providing video/DVD program availability. Star continues to update and improve CLE administrative operations with the addition of credit card processing of registrations, downloadable registration forms for the CLE programs and continues to provide on-site supervision of the programs. Star also assisted in the preparation of the year-end report to the NYS CLE Board and the accredited provider renewal application and audit. Star Consulting has also provided a critical service to the Association in budgeting programs so that we can continue to provide high quality legal education programs at a low cost to participants.

Star continues to use a broadcast e-mail system, which provides greater flexibility in communicating up-to-date CLE program information to our members.

Star has worked with the CLE Committee to explore and expand the venues and options for CLE programs including the Harvard Club, Penn Club and Princeton/Columbia Club, and maintains relationships with and coordinates our programs with current venues.

In sum, Star Consulting has provided excellent administrative services in support of the CLE program.

### **On The Horizon**

The following programs are anticipated for the upcoming period of time:

NYIPLA ANNUAL COMMITTEE REPORTS 2006-2007 TERM

- Spring Half –Day Seminar on June 18, 2007, anticipating 3.0 NYS Professional Practice CLE Credits and .5 NYS Ethics CLE Credit
- Monthly Committee on Meetings and Forums luncheon programs, each satisfying at least 1.0 NYS CLE credit.
- Fall One-Day Seminar in November
- Judge’s Dinner CLE Luncheon Program
- 24th Annual Joint Patent Practice Seminar in May 2008, anticipating 8.0 CLE credits, one of which will satisfy ethics requirements.

**Compliance**

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.

**NYIPLA CLE Programs**

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

Title: *Update on Patent Reform Issues*  
 Live Date: June 16, 2006  
 Instructor: Q. Todd Dickinson  
 Credits: 1.0 NYS Professional Practice CLE Credit  
 Cost: \$75/NYIPLA Member, \$85/NON-NYIPLA Member  
 Video/DVD: Not Available

Title: *The eBay Effect: A Change to Obtaining Injunctive Relief or Business As Usual for the Patent Litigator?*  
 Live Date: September 20, 2006  
 Instructor: Susan E. McGahan, Esq.  
 Credits: 1.0 NYS Professional Practice CLE Credit  
 Cost: \$80/NYIPLA Member, \$95/NON-NYIPLA Member  
 Video/DVD: Available

Title: *The U.S. Supreme Court and KSR International Co. vs. Teleflex: Impending Change to The Obviousness Standard for Patentability?*  
 Live Date: October 25, 2006

Instructor: James Dabney, Esq., Thomas Goldstein, Esq.,  
Marian Underweiser, Esq., Rochelle Seide, Ph.D.  
Credits: 2.0 NYS Professional Practice CLE Credits  
Cost: \$100/NYIPLA Member, \$125/NON-NYIPLA Member  
Video/DVD: Not Available

Title: *NYIPLA CLE Fall-One Day Program*  
Live Date: November 17, 2006  
Instructor: Five panels. Fifteen speakers.  
Credits: 6.0 NYS Professional Practice CLE Credits and  
1.5 NYS Ethics CLE Credits  
Cost: \$295/NYIPLA Member, \$350/NON-NYIPLA Member

Video/DVD: Available  
Title: *Enforcement of Intellectual Property at the ITC*  
Live Date: December 8, 2006  
Instructor: Hon. Paul J. Luckern  
Credits: 1.0 NYS Professional Practice CLE Credits  
Cost: \$85/NYIPLA Member, \$110/NON-NYIPLA Member  
Video/DVD: Not Available

Title: *Update on Fraud in the Trademark Office after  
Medinol Ltd. v. Neuro Vasx Inc.*  
Live Date: January 24, 2007  
Instructor: Frances Wolfson, Esq., Linda McLeod, Esq.  
Credits: 1.0 NYS Professional Practice CLE Credit  
Cost: \$85/NYIPLA Member; \$110/NON-NYIPLA Member  
Video/DVD: Available

Title: *What You Need to Know About E-Discovery*  
Live Date: February 16, 2007  
Instructor: Norman Simon, Esq., Steven Bennett, Esq.,  
Edward Vassallo, Esq.  
Credits: 1.5 NYS Professional Practice CLE Credit  
Cost: \$95/NYIPLA Member; \$120/NON-NYIPLA Member  
Video/DVD: Not Available

Title: *Preliminary Injunction Motions in Patent Litigation – Is This Your Day In Court?*  
Live Date: March 23, 2007  
Instructor: Hon. Randall R. Rader, Hon. Denise Cote, James Galbraith, Leora Ben-Ami  
Credits: 2.0 NYS Professional Practice CLE Credits  
Cost: \$110/NYIPLA Member, \$125/NON-NYIPLA Member  
Video/DVD: Not Available

Title: *Big Questions in Recent IP Cases*  
Live Date: April 20, 2007  
Instructor: Thomas Creel, Esq., William Jenks, Esq., Nicholas Groombridge, Esq.  
Credits: 1.5 NYS Professional Practice CLE Credits  
Cost: \$95/NYIPLA Member, \$120/NON-NYIPLA Member  
Video/DVD: Not Available

Title: *The Twenty-Third Annual Joint Patent Practice Program*  
Live Date: May 9, 2007  
Instructor: Five panels. Over 30 speakers.  
Luncheon Speaker: John J. Love, Deputy Commissioner for Patent Examination Policy, USPTO  
Credits: 7.0 NYS Professional Practice CLE Credits and 1.0 NYS Ethics CLE Credit  
Cost: \$350 and \$375 for late registration (*after* April 20, 2007)  
Video/DVD: Available

### **Conclusion**

It has been a pleasure serving this year as Chair of the Committee on Continuing Legal Education. It is my hope that the Association continues an aggressive approach to continuing legal education programs, whose 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 programs without the 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. I would like to personally thank Heather Chase, Michael Dallal, Theresa M. Gillis, Meyer A. Gross, Benjamin C. Hsing, Robert M. Isackson, Patrice P. Jean, Mark I. Koffsky, Benu Mehra, Donna M. Praiss, Jessica

Rando, Walter Scott, Thomas E. Spath, Esther Steinhauer, Alek Szecsy, Bartholomew Verdirame, Charles A. Weiss, John F. Witherspoon and Board Liaison Thomas J. Meloro for their continuing excellent support of the NYIPLA CLE efforts.



## COPYRIGHTS

### *David A. Einhorn, Chair*

This Committee has been exploring the issue of format protection for reality shows and plot lines. At issue is whether the Copyright Law should apply to the broad aspects which identify reality show formats. The case of *Ninox v. Fox Entertainment Group* was reviewed. Also discussed were several pending patent applications to Andrew Knight with the title “Process of Relaying a Story Having a Unique Plot”. It was decided that this Committee should analyze the issue of format protection to decide if we should take a position on the copyrightability or the patentability of such plots or TV show elements.

Secondly, the Committee has discussed the U.S. Supreme Court case, *eBay Inc. v. MercExchange LLC*. At issue is whether the holding of this case, which holds that a standard irreparable injury analysis must apply for the court to award a permanent injunction in a patent case, should also apply to copyright cases. Prior case law has suggested that a presumption of irreparable injury should apply in copyright cases.

The third issue which we reviewed was *Blueport Co. v. the U.S.*, which held that the federal government is immune to a claim of monetary damages under the Digital Millennium Copyright Act (“DMCA”). In that case, the government had allegedly hacked into a program in the field of Air Force manpower resource requirement reports to alter the program’s automatic expiration function for software (which prevented the software from being used beyond the licensed term). The U.S. Court of Federal Claims found that the U.S. government was immune from liability for its circumvention of this technology measure. A report is being prepared by a Committee member on this issue.

Fourth, this committee discussed the status of the remand of the *MGM v. Grokster* case back to the District Court. A committee member is currently preparing a report on the proceeding on remand.

Lastly, a discussion has been held concerning the status of various cases pertaining to the Google/Yahoo digital libraries litigations in the United States, Belgium and France. The Committee is following the developments in these cases.

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## DESIGN PROTECTION

*Jonathan E. Moskin, Chair*

The primary focus of the Design Committee has been to consider certain pending legislation in Congress (HR 2033 - originally introduced as HR 5055), which would amend the Copyright Act to create a limited term of protection (3 years) for fashion designs (a term defined in the legislation to include apparel, footwear, gloves, hats, belts and eyeglass frames).

We have had a number of meetings to consider the legislation and have prepared the attached report, which is all-but complete.

### **Report On HR 2033 –**

#### **Protection For Fashion Design**

HR 2033, the “Design Piracy Prohibition Act”, first introduced in the House of Representatives on March 30, 2006 as HR 5055 and reintroduced on April 25, 2007, would amend 17 USC § 1301 (the Vessel Hull Design statute) to override in part the limits against conferring copyright protection on utilitarian articles by creating a limited (three-year) copyright term for fashion designs “Fashion Design” is defined as “the appearance as a whole of an article of apparel, including its ornamentation.” “Apparel” is itself defined to include not only clothing, but gloves, footwear, hats, belts and eyeglass frames. The legislation requires that a design application be filed within three months after the design is first made public. The bill incorporates the test of infringement specified in 17 USC § 1309(e), under which the design owner must prove copying, and under which an accused design will not be deemed to infringe if it is original and not substantially similar to a protected design.

The primary sponsors of HR 2033 are Representatives Robert Goodlatte (R-VA) and William Delahunt (D-MA).

The legislation is being promoted primarily by the Council of Fashion Designers of America (“CFDA”). The July 27, 2006 testimony to the House subcommittee of Jeffrey Banks on behalf of the CFDA identifies the following three key points in support of the legislation: (i) America is now the source of original fashion designs in a way it was not many years ago (including styles such as a “Texas style” to which he refers); (ii) new technology has facilitated copying, thus exacerbating the harm to American designers from the absence of effective design protection; and (iii) the United States is unique among countries in the developed world in not having any form of fashion design protection. Mr. Banks testimony also suggests, on unknown grounds, that the law, if enacted, would only be used very selectively.

The NYIPLA Design Committee does not purport to question that there is considerable copying of fashion designs, one of the principal causes of which is the long-standing copyright doctrine against protecting designs of useful articles. We do believe that, as a general matter, protecting original designs serves to reward creativity and is consistent with the general purposes of Copyright. *See, e.g., Cohen v. Paramount Pictures Corp.*, 845 F.2d 851, (9th Cir. 1988) (“Courts have repeatedly stated that the Copyright Act was ‘intended definitively to grant valuable, enforceable rights to authors, publishers, etc., ... to afford greater encouragement to the production of literary works of lasting benefit to the world.’” Quoting *Washington Pub. Co. v. Pearson*, 306 U.S. 30, 36 (1939).) We have also reviewed the testimony of Christopher Sprigman contending that freedom to copy has, by some means, served to *encourage* creativity – at least among women’s fashion designers. Although we consider the position contrary to fundamental tenets of intellectual property law, and although we question how the same forces Professor Sprigman contends promote creativity in women’s fashion designs have evidently had no such effect on men’s fashion designs, we do not purport to possess economic or other data sufficient to quantify the extent to which original works of American or foreign fashion designers are being copied or the extent of the harm thereby sustained by such designers.

Although the Design Committee is supportive of appropriate legislation to protect fashion designs, indeed for this very reason, we nonetheless believe the proposed legislation may not be effective in remedying many such problems, primarily because the legislation only addresses one of several legal limits on design protection. Moreover, the Design Committee is concerned the legislation may also expose American (and foreign) producers of fashion designs to risks of liability and risks of litigation which could be remedied, at least in part, by requiring greater disclosure of the elements of a design claimed to be original. Finally, although designs have been registered abroad in substantial numbers (statistics for which are readily available at the website for the Office of Harmonization in the Internal Market (“OHIM”): <http://oami.europa.eu/en/office/stats.htm>.) it is less clear how regularly or with what success designers have litigated their claims. The Committee has been advised by foreign counsel that there is substantial litigation. However, we do not believe there have been sufficient reported precedents applying foreign law to serve as a meaningful guide whether Congress should adopt HR 2033 or how American courts might apply HR 2033 were it to become law in its present form. *See Susan Scafidi, Intellectual Property and Fashion Design*, reprinted in 1 Peter K. Yu, ed., *Intellectual Property and Information Wealth* (2006), tracing the history



of laws protecting fashion design, including the adoption by the European Union in 2002 of community-wide protection for original designs, Council Regulation 6/2002/EC, 2002 O.J. (L003), *id.* at 32, n. 65, and noting that “although few such disputes result in litigation, copyists who are challenged under French law frequently pay financial settlements to the original owners.” *Id.* at 24 n. 15. The author cites one litigation, *Societe Yves Saint Laurent Couture S.A. v. Societe Louis Dreyfus Retail Mgmt S.A.*, [1994] E.C.C. 512 (Trib. Comm. (Paris)), in which a Ralph Lauren “tuxedo dress” was found to have infringed an earlier such design by the plaintiff. Suffice it to say, the Committee does not believe foreign litigation practices are a sure or meaningful guide to how HR 2033 might be employed if enacted.

**Summary Of Conclusions:** As a result of these concerns, the Design Committee suggests in the pages that follow two modest amendments to the pending legislation: (i) to alter the definition of “fashion design” to help place greater attention on *specific elements* of designs that the creators consider original and protectable (as distinct from the current focus of legislation on the appearance of the design “as a whole”), and (ii) to confirm with greater specificity than currently provided that existing rights and remedies are left intact for particular aspects of designs. We do also believe that the goals sought to be advanced by HR 2033 would be best achieved if Congress were also to require a searchable database of new design registrations, both to provide notice to third parties and to permit such third parties to guide their conduct accordingly. However, we express no opinion as to whether protection other or broader than that contemplated – for instance for longer than the limited three-year term or for other types of designs – would be appropriate.

(1) **Clarifying the Definition of Fashion Design – Anticipated Difficulties Proving Infringement Under HR 2033.** Without questioning that copying of original fashion designs is harmful to American (and other) designers, it is less than clear how effective HR 2033 will be as a remedy against such copying. Indeed, although HR 2033 does provide a limited exception to the rule against protecting designs of useful articles, because HR 2033 also contemplates that under 17 USC § 1309(e), traditional copyright principles of infringement will apply, it seems likely that the designs having perhaps the greatest economic value will nonetheless remain very difficult to protect (even for the limited three-year term proposed).

Courts have long made clear that articles of clothing are utilitarian or functional and hence not entitled to copyright protection. *Fashion Originator’s Guild v. FTC*, 114 F.2d 80 (2d Cir. 1940), *aff’d*, 312 U.S. 457 (1941). Copyists have been deemed equally free to inform the public (truthfully and

non-misleadingly) that they have copied. *Societe Comptoir v. Alexander's Dep't Stores, Inc.*, 299 F.2d 33 (2d Cir. 1962). This limitation is made explicit in the Copyright Act itself, which, in defining the scope of protection for pictorial, graphic and sculptural works, specifies that:

Such works include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic or sculptural work only if, and to the extent that, such design incorporates pictorial, graphic or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101.

Courts have further made clear that to merit copyright protection, the original artistic elements of a design of a utilitarian article must be identifiable and capable of existing independently of the useful article itself. *See Mazer v. Stein*, 347 U.S. 201 (1954); *Kieselstein-Cord v. Associates by Pearl, Inc.*, 632 F.2d 989 (2d Cir. 1980). Undoubtedly the greatest limit on protection for original fashion designs is the rule that absent actual or at least conceptual separability of the artistic from the utilitarian, designs of useful articles are not copyrightable.

However, the current limited scope of protection for fashion designs is likely the result not only of the “inseparability” of original artistic elements of fashion designs from the articles themselves, but also of at least two distinct legal doctrines limiting copyright protection: (i) the scenes a faire doctrine, under which widely used themes necessary for any creative work are granted at most limited protection, and (ii) the merger doctrine, under which elements of original works that are on the borderline between protectable expression and unprotectable ideas are, again, afforded only limited if any protection. *See, e.g., Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 916 (2d Cir. 1980). It is the Design Committee’s concern that although HR 2033 would to some extent overcome the limits imposed by the utilitarian nature of clothing designs themselves, it does not address the limitations on protection under the scenes a faire or merger doctrines and hence may not serve to achieve its intended goals.

To better comprehend the nature of the Design Committee’s concerns, it is perhaps necessary to understand that many of the most original and experimental of fashion designs are also among the least successful commercially. Indeed, the sometimes inspired and sometimes outrageous haute couture designs that garner headlines and perhaps the greatest

attention of the fashion world are commonly worn by a select few and sell in limited numbers (often at significant overall financial losses to the designers that create them). Without suggesting there exists any strict inverse correlation for popular sales successes, the products having the greatest mass appeal will, for that very reason, often require familiar design features (or subtle plays upon such features) so as to appeal to the widest audience. (This, of course, does not include surface ornamentation such as two dimensional fabric patterns that are already protectable under existing copyright law.) Many of these familiar design elements (or variations upon them) have been used for many years and are in the public domain. Not only are they unprotectable under existing law, they will not likely be protectable under HR 2033.

No doubt many commercially successful fashion designs manage to integrate the novel and the familiar in new and pleasing ways. However, under the merger doctrine and the scenes a faire doctrine, even if HR 2033 were to become law, such settled copyright principles would likely require, as part of the infringement analysis, that those familiar elements be filtered out or accorded little if any weight in the overall comparison of registered design and any given design alleged to infringe. *See, e.g., Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir. 2003). This is true notwithstanding that HR 2033 defines a fashion design as the appearance “as a whole” of the subject article of apparel. As designers draw from a palate of design choices necessarily limited by the human form itself, the very history of fashion design will, under settled copyright principles, require that many if not most such design choices remain free for all to use (irrespective of whether “the appearance as a whole” of a design happens to be registered under HR 2033). Just so, it is foreseeable that infringement litigation under HR 2033 will often entail extensive expert testimony to demonstrate the historical prior use of many or all of the elements claimed by the plaintiff to be his or her original creation.

Invariably, litigations under HR 2033 will also generate heated disputes over what is or is not properly claimed within any given design registration; what were the sources of inspiration for the registered work (and hence whether it is original) and what were the sources of inspiration for the accused work (and hence whether it was independently created or whether it is substantially similar to the registered design). Although it is reasonably well-settled that one can not escape infringement by adding elements to a work copied from an original design, it can in fact be quite difficult to assess copying when a design incorporates elements from multiple pre-existing creative sources, some of which are in the public domain and others not. Thus, if a protectable fashion design can only be claimed in the entire

appearance of an article, copyists will likely be able to escape liability by selectively taking only specific original design elements from a given fashion design and incorporating them into another design which, “as a whole”, is not substantially similar to the original registered design. As under existing law, courts can and no doubt will take into account the “total look and feel” of the original and the accused work, but in this process the courts will need to be guided by a clear understanding of what new features truly distinguish the design in issue.

In short, given the long history to date during which many design choices that might now be claimed as proprietary under HR 2033 had (until now) been deemed part of the public domain, and given the likely necessity of using many such design elements in any article made to fit the human form, it is likely that in many instances (although hardly all) design registrations under HR 2033 will simply be one step in a process (perhaps a costly process) of determining to what extent, if any, given design elements can or cannot be protected under the scenes a fair or merger doctrines. To better understand why this is so, one must understand that under the copyright standard of originality, registered designs would (or at least could) be protectable (in whole or in part) provided there was no evidence the registrant itself actually copied the relevant design elements from a preexisting work. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 270 (2d Cir. 2001) (“an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required.”). Design registrations under HR 2033 thus could be secured for many plainly derivative works, leaving both third parties and the courts uncertain (without costly litigation to discover the underlying facts) what elements of any given registered design are even claimed to be original, much less which in truth are.

As noted further in the ensuing section, rather than focus on the appearance “as a whole” of fashion designs, as HR 2033 does, it may well be that a more effective form of design protection would be one more narrowly focused on specific protectable elements and under which designers seeking protection would be encouraged (if not required) to disclose as part of the registration process itself those elements claimed to be original, or the specific selection and arrangement of elements claimed to be original. Although consistent with existing copyright law, such a form of protection would, in some respects, also be more akin to the existing scheme for protecting design patents. However, within the framework contemplated by HR 2033, such design protection would nonetheless incorporate the copyright infringement standard of substantial similarity rather than the design patent

standard under which, although nominally predicated on very much the same standard, as a practical matter, affords to design patents essentially no scope of protection beyond the literal design claimed. *See, e.g., Elmer v. ICC Fabricating, Inc.*, 67 F.2d 1571, 1577 (Fed. Cir. 1995) (“design patents have almost no scope”).

**(2) Proposed Modification of the Definition of a Fashion Design.**

Just as defendants accused of infringing registered designs will likely seek to challenge the scope of rights secured by design registrations under HR 2033, parties sincerely interested in avoiding infringement claims have a keen need to know, prior to launching a competing product, what it is the registrant claims is original so as to avoid copying those protected elements. Particularly given the lengthy history to date in which competing designers comfortably could assume all structural elements of designs were in the public domain, competitors henceforth will have a compelling interest knowing what is or is not being claimed to be original. Because the copyright standard of originality permits successive authors to claim the same subject matter as original, provided each did not actually copy the other, third parties have little, if any, way of knowing in advance what elements of a design registered under HR 2033 are deemed by the designer to be original and hence claimed to be proprietary. (Perhaps a fair parallel here is the relatively recent recognition by courts and the United States Patent Office that business methods can be patentable subject matter. Given the long history during which the law was otherwise, considerable confusion and uncertainty has arisen whether specific methods of operation claimed to be novel should be deemed unprotectable variations on the prior art. That uncertainty and confusion has been heightened by the absence of a readily searchable database of prior art.)

Because HR 2033 does not require or encourage at the time of registration identification of the elements of any given design claimed to be original but, rather, specifically defines a fashion design as “the appearance *as a whole* of an article of apparel”; because design applications would receive no substantive review prior to issuance, and because the legislation contemplates no searchable database of registered designs, HR 2033 may sow needless uncertainty, and may create opportunities for excessive and unnecessary litigation. Designers who create subject matter registrable under HR 2033 are the best able to identify what they contend is new and original in their works and should be encouraged to disclose the same to the world at large.

As suggested above, a potentially more valuable system of design registration (in some respects more similar to the existing design patent system

but also consistent with existing copyright law), would require (or at least permit) designers to specify what particular design elements or what particular selection and arrangement of design elements, is (or are) claimed to be original. That would help protect the interests of designers by giving notice to the world what is claimed to be proprietary; would help prevent needless litigation by affording junior users the means to conduct appropriate due diligence, and would simplify the issues that might arise in litigation. A searchable database of registered designs would also be of enormous benefit – both to design owners who might point to registrations themselves as a form of public notice and to competitors who would henceforth be able to take steps to avoid infringement.

Without substantially altering HR 2033, the Design Committee recommends that it should be amended modestly to define a fashion design as “the appearance of an article, either as a whole (to the extent the design as a whole is original), or as to particular aspects thereof, including its ornamentation, as specified by the registrant.”

**(3) What Is Copyrightable Subject Matter Under HR 2033?/Proposed Modification of Savings Provision of HR 2033.** Although HR 2033 does enumerate what types of products are eligible for protection as fashion designs, questions undoubtedly will arise whether some products do or do not fall within the list. Because HR 2033 carves out a special set of rights for a defined sub-class of arguably utilitarian products, without comprehensively addressing the issue of the protectability of original artistry incorporated in otherwise utilitarian designs, the legislation will, inevitably, lead to a certain level of arbitrary line-drawing. Costumes, for example, are not expressly covered. Costumes arguably are a form of apparel, which, perhaps even more so than other forms of apparel, often incorporate original individual design elements that are physically or conceptually separable from the utilitarian purpose of clothing the human body and hence satisfy or all-but satisfy existing copyright standards for protection. Notwithstanding such higher levels of non-functionality and (arguably) originality, costumes to date have had, at best, a very uncertain status and scope of protection under copyright law. *See Whimsicality, Inc. v. Rubies Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989) (finding fraudulent the registrant’s characterization of a costume as “soft sculpture” but noting, without reaching the question of copyrightability, that plaintiff “could have acknowledged in its applications that the articles in question were costumes, and have requested registration for only the features it claimed were separable.”); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663 (3d Cir. 1990) (finding no inherent utility in features of “nose

masks” resembling noses of a pig, elephant or parrot). It is hardly clear whether costumes would be protectable under HR 2033.

More broadly, by providing explicit protection for apparel as a special class of goods, the legislation may have the result (no doubt unintended) of displacing the patchwork of prior protections for at least some aspects of clothing designs – in particular, design features that can be identified separately from the utilitarian aspects of the garment or other product. Thus, although in the past unusual stitch patterns, fabric designs or surface ornamentation of clothing designs could often – if admittedly not always – be protected under copyright, the new statute may incline courts towards treating all aspects of apparel designs under one classification (the new one). Indeed by defining fashion design as “the appearance as a whole of an article of apparel, *including its ornamentation*”, courts might conclude that surface ornamentation, heretofore protectable for a full term of copyright, is now only protectable for three years and only as part of the ornamentation of the article of apparel considered “as a whole”. Under the new standard, such individual design elements may enjoy even less protection than allowed in the past if courts conclude that Congress considered what protection to allow to apparel generally and deliberately decided only to allow the limited form of protection provided under HR 2033. Just so, the requirement that a designer either register its fashion design within three months or forfeit protection may lead courts to refuse protection for design elements conceptually or physically separable from the useful article and heretofore protectable and registrable under existing copyright principles *at any time* during the full term of copyright as defined in 17 U.S.C. §304. There are of course reasons under existing law why the author of such a copyrightable design element might wish to apply sooner (indeed within three months to get the full benefit of the right to claim statutory damages), but it is not mandatory.

Although there is language in the bill preserving existing rights, HR 2033 § 2(h), the right to protect aspects of clothing designs or designs of other arguably utilitarian articles has never been so clear or well-settled that one can assume such subject matter will continue to be protected even if it falls outside the scope of HR 2033. In particular, specific design features that, under existing law, can be identified separately from the utilitarian aspects of the garment or other product should not lose protection. The Design Committee therefore recommends that Section 2(h) of HR 2033 be amended to provide that “other rights that may exist in designs protected hereunder, including *specific elements of fashion designs*, that may exist under provisions of the title other than this chapter” are not affected.

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## INTERNATIONAL IP LAW

### *Samson Helfgott, Chair*

This year, the Harmonization Committee was renamed the International IP Committee to address all international IP matters. We held an organization meeting which was well attended by most of the members. We divided the committee membership into three subcommittees: the International Patent Law Subcommittee, which was chaired by Tom Spath; the International Trademark and Copyright Subcommittee, chaired by Amy Beckman; and the Other International IP Issues Subcommittee, chaired by Amina Matlon.

During the course of the year, various members submitted items of interest and on a regular basis these were distributed to the members of the entire committee.

The various topics that were focused on included the report of the President of the European Patent Office, including various changes coming up in connection with the EPC 2000 going into effect at the end of 2007. We also kept up on the status of trilateral cooperation between the USPTO, the EPO and the JPO and the various proposals being discussed for harmonization and uniform format of patent applications.

During the course of the year, we also focused on cross boarder patent injunctions, enforcement of patent rights in China, changes in Australian copyright law, legislative initiative in the European patent law, and changes in the Brazilian law relating to genetic resources.

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## INTERNET LAW

### *Paul Reilly, Chair*

The following is an update on the activities of the Internet Law Committee. Over the past year, the committee has met via telephone and in-person on several occasions to discuss significant developments arising from intellectual property disputes involving the Internet.

One broached by the committee and most frequently discussed is legal publications is the conflict among the circuits as to whether or not the sale of keywords that incorporate another's trademark serves as use of a mark in commerce so as to render the party selling or acquiring the keyword liable for trademark infringement under the Lanham Act. *See e.g., Rescue-com Corp. v. Google Inc.*, 456 F.Supp. 2d 393 (N.D.N.Y. 2006) (not use in commerce); and *Merck & Co., Inc. v. Mediplan Health Consulting Inc.*, 425 F.Supp. 2d 402 (S.D.N.Y. 2006)(not use in commerce); *compare e.g., 800-JR-Cigar Inc. v. Go To.com Inc.*, 437 F.Supp. 2d 273 (D.N.J. 2006)



(sale of keyword constitute use in commerce as a matter of law); and *J.G. Wentworth SSC Ltd. v. Settlement Funding LLC*, 2007 WL 30115 (E.D. Pa. Jan. 4, 2007) (use in commerce). I anticipate that a resolution of this conflict will not likely occur in the near future but will continue to spur litigation.

Because of the prevalence of articles and conferences concerning keywords, the committee opted to focus on how Google is changing the landscape of copyright law, protection and enforcement. Indeed, over the past few years, Google has made a lot of headlines due to the onslaught of intellectual property lawsuits it has been facing. Specifically, the committee's paper discusses the major copyright-related lawsuits Google has faced from the use of thumbnail images to system caching to news headlines. The recently issued decision in the matter of *Perfect 10, Inc. v. Google Inc.*, 2007 WL 1428632 (9th Cir. May 16, 2007) is illustrative of Google's transformative/fair use defense and will now be incorporated into the paper. The 9th Circuit's decision also makes clear that the owner of a computer that does not store and serve the electronic information to a user is not displaying that information, even if such owner in-line links to or frames the electronic information. Thus, the 9th Circuit has adopted what has been called the "server test" and affirmed that plaintiff was not likely to succeed on its claim that Google's in-line linking to a full size infringing images on another web site constituted a direct infringement.

One of the more notable decisions incorporated into the article is *Field v. Google, Inc.*, 412 F.Supp.2d 1106 (D.Nev January 2006) wherein the court held that Google had an implied license to use plaintiff's copyrighted works. Specifically, the Court noted that an implied license can be found where the copyright holder engages in conduct from which the other party may properly infer that the owner consents to his use. Consent to use the copyrighted work need not be manifested verbally and may be inferred based on silence where the copyright holder knows of the use and encourages it. Because of plaintiff's awareness of the widely known industry standard, which enables Web site publishers to instruct a search engine not to cache the publisher's website by using a no-archive metatag, the Court found that Mr. Field's awareness and failure to implement the no-archive metatag coupled with his knowledge that Google would use his copyrighted works granted Google an implied license. Arguable, this defense now places the burden on the copyright owner to prevent a third party search firm from copying their materials on the Internet. Generally speaking, the party wishing to copy a copyrighted work must obtain permission or a license from the copyright

owner. Thus, Google's defense somewhat whittles away at traditional notions of copyright law based, in part, on the manner in which the Internet operates.

Other cases discussed in the article include *Parker v. Google, Inc.*, 78 U.S.P.Q.2d 1212 (E.D. Pa 2006) (archiving does not result in direct infringement because Google's automatic archiving and excerpting of plaintiff's web site in search results does not include the necessary volitional elements to constitute direct copyright infringement); *Agence France-Presse v. Google, Inc.* (copyrights in news headlines/transformational fair use); *The McGraw Hill Companies, Inc. v. Google, Inc.*, Civ. Action No. 1:05-cv-08881 (JES) (SDNY 2005) (online library project/fair use) and *Authors Guild v. Google Inc.*, Civ. Action No. 05 CV 8136 (SDNY 2005) (same).

With respect to the online-library project of Google, Microsoft recently blasted Google's practice of providing access to books online without the permission of authors and publishers asserting that it "systematically violates copyrights and deprives authors and publishers of an important avenue of monetizing their works." See Thomas C. Rubin's (Microsoft's associate general counsel for copyright, trademark and trade secrets) speech prepared for Association of American Publishers. Microsoft's comments, in my opinion, make manifest that Google's online library is a hotly contested dispute that will likely play a significant role in the development of the Internet and defining the line between transformative/fair use of copyrighted works and infringement.

Finally, with its acquisition of Youtube, Google has found itself on the other end of multimillion dollar copyright infringement claims. The outcome of such cases should provide further guidance to online service providers on how to insulate themselves from liability under the DMCA. We hope to include a brief section touching on the issues raised by the Youtube.

The committee plans to have the paper completed before the end of June for submission to the NYIPLA.



## LEGISLATIVE OVERSIGHT AND AMICUS BRIEFS

*Rochelle K. Seide, Chair*

This is the report for the Committee on Legislative Oversight and Amicus Briefs for this year.

The committee prepared and filed two amicus briefs in the US Supreme Court in *Medimmune v. Genentech* and *KSR v. Teleflex*. The committee considered, but did not prepare an amicus brief in *Microsoft v. AT&T* (no consensus). The committee (and then John Daniels) prepared a brief for filing

in the Seagate case before the Federal Circuit, but did not file a brief due to lack of approval by the Board. The committee also considered a request from Amgen to file an amicus brief in the US Supreme Court during the petitions stage in regard to the Federal Circuit's standard in claim construction, but did not prepare a brief. Finally, the committee has considered and is preparing a brief in the Finisar case before the CAFC dealing with the District Court's refusal to enter a permanent injunction. The case deals with some issues that were not resolved by E Bay. Dave Ryan has offered to prepare the brief.

The committee also provided to the Board a draft recusal policy for the amicus committee and Board, which is under consideration.

## LICENSING TO PRACTICE

*Allan A. Fanucci, Chair*

The Licensing to Practice Committee investigated to what extent a patent agent who is licensed to practice before the patent office (or who is an attorney in another state) can represent clients in related matters when they are not admitted in the particular state where they are practicing. Generally, such activities are principally limited to preparing and prosecuting patent applications at the patent office, but often the agent or non-admitted attorney is often asked to prepare assignment, licenses or patentability or infringement opinions. This inquiry was raised by an NYIPLA member who is a registered US patent agent and a member of the New Jersey bar but who practices as a patent agent in New York City.

Not surprisingly, the answer to this depends upon the particular law of the state. We found that Virginia, DC and Florida have held that a registered patent attorney not licensed in those states could provide patent-related services such as rendering validity and infringement opinions as aforesaid. New Jersey has decided that such patent-related services are the unauthorized practice of law and are prohibited. We found that New York has not yet decided this issue and our member asked whether our association would urge that the Virginia or Florida decisions be adopted.

In particular, the Virginia State Bar Standing Committee on Unauthorized Practice found that a registered U.S. patent attorney who is not licensed in Virginia can properly give legal advice from a Virginia office on matters that are related exclusively to patent law, regardless of where the clients are located. The committee relied on Virginia's UPL Rule 9-102 and *Sperry v. Florida*, 373 U.S. 379 (1963), which held that a state cannot enforce its licensing requirements for lawyers against a non-lawyer who was registered to practice before the U.S. Patent Office. In a prior opinion, the committee found that a lawyer with a

federal practice in a multijurisdictional law firm can represent Virginia clients before federal agencies without being admitted in Virginia. DC has a related decision that is consistent with the Virginia decision.

In contrast, New Jersey has held that a patent attorney or agent not admitted to practice law in the State of New Jersey may not lawfully engage in any of the following activities within the State of New Jersey:

(a) He may not advise his client as to the ownership of an invention such as where a question of ownership arises by virtue of employment or other contractual relationship between his client and others.

(b) He may not advise his client as to what the client's rights may be under forms of legal protection available under federal or state law which are alternate to patent protection, such as trade secrets, unfair competition, trade marks, copyrights, and anti-trust law; provided, however, that he may advise his client that there are alternate forms of legal protection on which he should seek advice from an attorney admitted to practice in this state.

(c) He may not advise a client on matters concerning the validity of a patent, except incident to the filing and prosecution of a patent application.

(d) He may not advise a client on matters concerning the infringement of a patent, except incident to the filing and prosecution of a patent application.

(e) He may not advise a client in matters concerning the scope of the monopoly granted in a patent, except incident to the filing and prosecution of a patent application.

(f) He may not prepare contracts or licenses dealing with patent rights.

(g) He may not prepare assignments of patent rights, except such assignments as are filed simultaneously with a patent application.

(h) He may not advise his client in matters concerning contracts, licenses or assignments dealing with patent rights except as the same may directly affect and be incident to the filing and prosecution of a patent application.

(i) He may not advise a client respecting litigation in the Courts of the State of New Jersey, including litigation involving issues arising under patent law.

(j) He may not advise clients concerning rights or liabilities in connection with trade marks nor may he represent clients in the assertion of trade mark rights or in defense of liability under trade mark rules.

(k) He may not represent clients in the filing and prosecution of applications for registration of trade marks nor the prosecution of oppositions to the registration of trade marks in the United States Patent Office unless and except to the extent that Congress may preempt this field of law. He may not represent clients in the filing and prosecution of applications for registration of trade marks nor in the prosecution of opposition to the registration of trade marks in the Office of the Secretary of State of New Jersey.

Based on the differences between the states, we do not know if we would be able to convince New York to adopt the more lenient Virginia decision as a recommendation for patent agents wanting to practice more than patent prosecution in the State of New York.



## LITIGATION PRACTICE AND PROCEDURE

*Jeffrey M. Butler, Chair*

The following is a brief summary of the Committee's activities for the previous year, and our tentative goals for the coming year.

The Committee members have had an ongoing exchange of ideas, including various rounds of email "discussions. We also meet face-to-face, and, at our meeting in late February, we raised and addressed the following IP litigation issues:

1. The proposed District Court Patent Pilot Program.

Note: Earlier this year, the House passed H.R. 34, entitled "To establish a pilot program in certain United States district courts to encourage enhancement of expertise in patent cases among district judges. The legislation was referred to the Senate Committee on the Judiciary for further action in the Senate. The apparent goal is to "encourage enhancement of expertise in patent cases among district judges. Patent cases would be randomly assigned to the judges in a given district, but those judges who have not opted to hear such cases, may decline to do so (and such cases then would be reassigned to those judges in that district who have opted to hear such cases).

2. Jury selection in IP infringement litigation: A study of the trier of facts in such cases.

3. The *EchoStar* decision from the Fed. Cir. (and follow-on decisions from various courts). What is (will be) the impact of those decisions on the issues of waiver of privilege, etc.?

4. E-discovery: What issues are presented for IP cases?

Of those issues enumerated above, the first and third issues seemed to garner the most interest - at least at this stage - among the Committee members.

As for the Pilot Program, the Committee intends to monitor the legislative goings-on, and be prepared to report and/or comment thereon. We also would like to look at other models of such pilot programs (and it was suggested that, perhaps, such a program existed for the bankruptcy courts). We also briefly discussed "patent rules (such as those of the Northern District of California), and some Committee members questioned whether "hard-and-fast rules were appropriate in patent cases, or, rather, whether justice might perhaps be better served by allowing District Courts more latitude. We recognize that at least one other Committee of the Association is tasked

with examining patent rules. We would like to reach out to that other Committee and, perhaps, work with it to explore the impact of such rules on patent litigation.

The *EchoStar* “waiver case and the pending *In re Seagate Technology L.L.C. en banc* case seemed to be of considerable interest to a number of Committee members. Various Committee members expressed views on how the holdings in *EchoStar* and earlier cases already seem to have impacted IP litigation (including, e.g., opinions of counsel, duty of care, patent litigation strategies, etc.). We think that the fallout from *EchoStar*, along with the expected *en banc* decision in *In re Seagate*, should be followed and further explored by the Committee.

On electronic discovery, we briefly explored issues such as “virtual custody and control of documents, proprietary software applications, spoliation, metadata and “front-loading of discovery plans (and other timing / strategy issues). We think there are myriad issues relating to e-discovery, such as these, that we could and should continue to discuss.

I currently am soliciting further topics of interest from Committee members. (Already, there has been a request for the Committee to explore non-patent topics (e.g., trademark litigation or copyright litigation or trade secret litigation topics) in addition to the patent topics we have been exploring.

At our next meeting, we will further our discussion of the issues above, and we then will decide how we best can raise and present these issues with the Association. (Admittedly, some of the issues, above, still need to be fleshed out a bit, before they are discussed at a broader level.)

The Committee also is considering proposing a seminar on one or more litigation topics, including, e.g., “best practices in IP trials from the perspective of litigators and the bench. Another topic of interest is the issue of “tutorials in IP (especially patent) litigations. One interesting and promising proposal has been that the Committee organize and hold a seminar, in which we hope that one or more district court judges could be on a ‘panel’ along with one or two experienced IP litigators, perhaps even tapping the talents of members of the Committee. (Assuming the NYIPLA Board approves it, the Committee would like to work with the CLE Committee to see if CLE credit could be provided to speakers and attendees.)

Another chief activity of the Committee (particularly for the coming months) is arranging for the Federal Circuit to sit in New York City during the Autumn of 2007.

I have made arrangements with the law schools at Columbia Univ. and Fordham Univ., and Chris Hughes has made arrangements with NYU’s law school, for the Court to sit at each of those schools. Also, we are working

with the Fed. Cir. Bar Association to try to arrange for a social event for the first evening during the Court's visit, and we also will be planning and working on a dinner and social event to be hosted by the Association for another evening during the Court's visit.

In addition to court hearings and social events surrounding the Court's visit, the Committee would like to consider additional (possible) events such as a CLE program involving one or more Fed. Cir. judges (such as courtroom procedures, "pet peeves, a Fed. Cir. workshop of sorts, etc.); and a swearing-in ceremony for folks from this area desiring to be admitted to that court.



**MEETINGS AND FORUMS**

***Peter G. Thurlow, Chair***

The Committee has 26 members, most of whom have actively participated in Committee activities including planning and/or hosting a CLE Lunch Program.

The Committee held an organizational meeting at Jones Day Law Firm on August 9, 2006 to meet and plan CLE programs through fall and winter of 2006-2007.

**Monthly CLE Programs**

The Committee has organized seven CLE Lunch Programs this year and one non-CLE Webinar on Electronic Filing in the U.S. Patent and Trademark Office.

CLE Speakers this year included Mr. Q. Todd Dickinson, Vice President & Chief Intellectual Property Counsel at General Electric; the honorable Judge Paul Luckern of the United States International Trade Commission; Ms. Frances Henderson of the USPTO's Trademark Trial and Appeal Board; and Mr. William Jenks of from the Solicitor's Office at the United States Patent and Trademark Office.

For a further discussion on the 2006-Feb. 07 CLE programs, please see the Committee Report on Continuing Legal Education (above).



**MEMBERSHIP**

***Marilyn M. Brogan, Chair***

This year, the Membership Committee decided to target certain types of individuals whom we believe are under-represented in the Association. One of the target groups is female attorneys, and with the goal of attracting more women members, we held a Women's Wine Tasting/Networking Event on the

evening of April 11, 2007. The event took place at the law firm of Arent Fox, LLP, which firm, together with the NYIPLA, sponsored the event.

Approximately 60 people attended the function, which sold out in record time. The evening provided attendees an opportunity to network with members of the NYIPLA, as well as other IP attorneys, in a comfortable and relaxed atmosphere. Almost half of the attendees were not NYIPLA members, and this evening was therefore a great opportunity to introduce these newcomers to our organization, explain our activities and goals, and encourage them to join us.

The evening was a great success: it provided attendees an excellent opportunity to network with other women in the IP field, and it provided the NYIPLA an opportunity to introduce the organization to many potential new members. We received a number of inquiries from some of the attendees seeking information about the Association, and possible similar future events, and we have encouraged any such persons who are non-members to submit membership applications.

Additionally, as we have in the past, we continue to seek new members from non-members who attend the monthly luncheons; membership applications are made available at the luncheons for this purpose. Also, membership is encouraged at the reception held annually by the Young Lawyers' Committee.

The numbers as of May 16, 2007

Total Membership: 2294 • Total Paid Membership: 1526

New Members during this dues period: (May 2006- May 16, 2007) 268

Total New Student Members this dues period: 31

Total Lost Souls out of the 2294: 457

(Lost Souls are members who have left their firms and have no forwarding address. Every few months we try to find them on Martindale, with some small measure of success).

The breakdown of this year's paid members who are current with the 2006-07 dues is as follows:

\*Paid Active Members (admitted to practice 5+ years) = 974

\*Paid Active Members (admitted to practice less than 5 years) = 368

\*Paid Active Members (outside NJ, NY, VT, CT)

and includes Foreign = 88

Note: 17 Foreign Members in Database of which 10 are current with dues

\*Paid Retired Members = 30

\*Paid Student Members = 66

\*Life Members (not required to pay dues) = 17



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## PROFESSIONAL ETHICS AND GRIEVANCES

*Hunter T. Carter, Chair*

During 2007, the Association undertook a shift in the focus and purpose of the Committee on Professional Ethics and Grievances. Historically, the Committee was directed to hear grievances and determine whether to remove an attorney from membership for ethics reasons. This year, however, we commenced to shift the focus and become more oriented to understanding the unique ethics challenges facing our members.

At the beginning of the year, the Committee was formed as a result of various efforts, and held its organizational meeting at the offices of Arent Fox. The following persons attended or expressed a desire to serve as members of the Committee: Steven M. Amundson (Frommer Lawrence & Haug), Jennifer Chung (Frommer Lawrence & Haug), Michel O'Hara (Kenyon & Kenyon), Rory Radding (Morrison & Foerster LLP), James K. Stronski (Frommer Lawrence & Haug), Charles A. Weiss (Kenyon & Kenyon), Tiberiu Weisz (Gottlieb, Rackman & Reisman, P.C.).

As Chair of the Committee, I promoted a discussion of what our agenda should be, understanding that we should be reasonable and modest in our goals in this, our first transition year. Committee members identified several issues of importance, but none more than developing a greater understanding of the conflict of interest issues for our members that uniquely challenge them. We also identified as future areas of activity the convening of or participation in continuing legal education seminars on intellectual property-specific ethics matters and participation in publications in the Bulletin on topics of interest.

Inasmuch as my firm belongs to the Attorneys Liability Assurance Society, I attended the annual Patent Consultation Group convened by ALAS, and there, like in our Committee, attorneys were most interested in the conflict of interest issues confronted by intellectual property practitioners. ALAS reported confidential results of a survey conducted among their members concerning conflicts policies and conflict clearance systems and approaches. After a discussion among our members, we determined to consult with ALAS in order to obtain permission to take their survey and send it to NYIPLA member firms. A copy of the ALAS survey is attached to this report. Among the topics the survey explores are:

- How firms identify and screen for subject matter conflicts in patent prosecution
- How firms identify and screen for subject matter conflicts for word marks and design marks

- The extent to which firms that do patent opinion work litigation in related subject matter areas
- Docketing and document management/retention
- Due diligence practices
- Work for and with foreign associates
- Managing maintenance and fee payment obligations

We propose to engage with the new President and the Board of Directors in a discussion leading to the dissemination of the survey and the publication and analysis of its results.

The Committee will benefit from increased membership and a renewed focus by the Board on the changed purpose of the Committee, including closer links to the Publications and Continuing Legal Education Committees.

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## PUBLIC INFORMATION, EDUCATION, AND AWARDS

*Richard W. Erwine, Chair*

This year, again, the committee has been responsible for selecting the winners of the Conner Writing Competition and Inventor of the Year Award.

### **Conner Writing Competition**

The Committee reviewed approximately 20 submissions, and proposed the following as winner and runner-up:

**Winner:** “

Here Comes the Bride... And There Goes the Copyright” (Jayme L. Majek)

**Runner-up:**

“Rasmusson v. SmithKline Beecham Corp.: Distinguishing Between a Hunting License and the Next Great Invention” (Matthew Dowd)

### **Inventor of the Year**

The Committee also voted for the 2007 Inventor of the Year based on 6 nominations. The committee nominated Dr. Wang of United Biomedical as the Inventor of the Year.

The NYIPLA Board of Directors followed the Committee’s recommendations for both contests.

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## PUBLICATIONS

*Ashe P. Puri, Chair*

*Stephen J. Quigley, Greenbook Subcommittee Chair*

The focus of the Publications Committee has been two-fold. We are responsible for publishing the Bulletin, a bi-monthly publication consisting

of articles, Board-approved papers, columns and Association events. We are also responsible for publishing the annual Greenbook, a yearbook comprising of the Association's leadership and membership, Committee membership and bylaws (among other information). For the first time this term, the Greenbook included Board –Approved papers (e.g., Recommendations to the PTO, Proposed Local Patent Rules).

In addition, during the 2006-07 term, the Publications Committee published five issues of the Bulletin. We are proud to report that the issues this term have been some of the largest volumes to date. The issues have included new columns, including a Historian's Column, a Second Circuit procedural case review, as well as recurrent columns and activities, including the Southern District of New York Case Review and CLE program summaries.

The Committee has been active this term. Various members have submitted columns and articles for publication in the Bulletin. In addition, the members have engaged in proofreading and editing columns and articles.

The Committee held its annual luncheon meeting on April 23, 2007 to discuss goals for next year, including new layouts and content for the Bulletin. In addition, the Committee approved a new cover for the 2007-08 Greenbook.



## **TRADE SECRET LAW AND PRACTICE**

*Howard C. Miskin, Chair*

Trade secret law has never been an exciting subject in litigation or committee activity. In litigation charging trade secret infringement or misuse of trade secrets or unfair competition in using another's trade-secret, it is difficult to prove the taking, misuse or even what is the trade secret allegedly taken, which makes it difficult to successfully litigate a case.

However, the tide seems to be changing. High damage trade secret cases are emerging, especially in the biotech and data communications fields. In today's mobile society a large number of highly technical or persons are available in the job market. New employees are being hired laterally for specific work due to downsizing or changing focus of products. Employees move easily from one company to another especially in the high-tech fields. Intentionally or not, these employees bring with them matters in which they were working or even developed. Many cases show these individuals are hired because of the work they have and their knowledge in specific fields. They are sought after by competitive companies. While these critical employees probably have employment agreements, this does not stop the hiring.



exploring the issue of whether the Association should submit an amicus brief to the Court of Appeals on the Punchgini case.

The Committee met several times to review other issues and consider projects of interest to the Association membership, including ways to address common grievances with trademark prosecution and opposition matters in the USPTO; the proposed new rules for oppositions/cancellations in the TTAB and whether anything can be done to change them/prepare for their implementation; and a possible study of trademark prosecution costs/fee arrangements.

▼ ▼

**U.S. BAR/EUROPEAN PATENT  
OFFICE LIAISON COUNCIL**

***Samson Helfgott and Thomas E. Spath,  
Council Representatives***

A summary of the September 15, 2006 U.S. Bar/European Patent Office Liaison Council meeting can be found in November/December 2006 issue of the Bulletin. The next meeting of the USB/EPO Liaison Council will be on Sunday evening, September 23<sup>rd</sup> and all day Monday, September 24<sup>th</sup>, 2007. Samson Helfgott will again attend on behalf of NYIPLA.

▼ ▼

**YOUNG LAWYERS**

***Alozie N. Etufugh, Chair***

The Young Lawyers' Committee (YLC) kicked off the year with new committee members and its annual reception at the *Opia* Restaurant & Lounge. Members of the committee, prospective members, other committee members and law students were all in attendance during the event. The committee was also honored by the presence of our outgoing NYIPLA President, Marylee Jenkins, who offered some words on the Association and encouraged non-members to join while also encouraging members to participate in committee activities and Association events. A total of 72 attendees were present at the reception - comprising of 65 attorneys and 7 law students.

Over the year, we laid the groundwork for two other projects - our law school outreach and the YLC newsletter column. The outreach project will be geared toward law students interested in Intellectual Property law.

The project would entail visits by committee members to local law school Intellectual Property classes. During the visits, committee members would offer information about the Association and the daily practice of Intellectual Property law. We hope to have everything set for the Fall semester.

Our newsletter column would feature topics of interest for young members of the Association such as career strategies, financial planning, etc. The hope is to collect and publish articles from committee members and from the entire body of the Association.

We wish to thank all other Committee chairs and members for their support during the year and ask for their continued support for our future and ongoing projects.

## **Section 2**

*Summary of NYIPLA  
Amici Curiae Briefs*

**The Association filed the following amici curiae briefs in the United States Supreme Court:**

***Medimmune, Inc. v. Genentech, Inc.* (05-608)**

A patent licensee in full compliance with its license obligations should not be permitted to sue so as to declare the licensed patent invalid, unenforceable or not infringed. A patent licensee should not be able to wield the sword of patent challenge while at the same time using the license as a shield against infringement liability and the risk of an injunction. A patentee should not be required to grant an unconditional waiver of its right to sue for infringement if the licensee can challenge a licensed patent without consequence.

***KSR International Co. v. Teleflex Inc. and Technology Holding Co.* (04-1350)**

The Court of Appeals for the Federal Circuit did not err in holding that a claimed invention cannot be held “obvious” and thus unpatentable under 35 U.S.C. §103(a) in the absence of some proven teaching, suggestion or motivation that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. The Federal Circuit’s teaching-suggestion-motivation test has provided an objective, predictable, and reliable means of applying Section 103 and preventing hindsight analysis from plaguing the obviousness determination. The test is consistent with the Supreme Court’s precedent and has served the patent system well.

**The Association filed the following amicus brief in the United States Court of Appeals for the Federal Circuit:**

***Finisair Corporation v. The DirecTV Group, Inc., et al* (07-1023, 07-1024)**

The district court abused its discretion in both entering the unauthorized compulsory license and in refusing to enter the permanent injunction. Two issues need to be addressed in order to ameliorate the widespread confusion in the district courts:



1. Whether the district court's assumption that it was free to fix a royalty for future damages and enter a compulsory license (a) can be justified by either statute or case law, and (b) can be harmonized with the Congressional policy repeatedly and explicitly recognized by the Supreme Court under which, with the exception of a single isolated historical aberration, legislative proposals to sanction such compulsory licenses have been universally rejected.

2. Whether the district court's refusal to enter a permanent injunction after a jury finding of willful infringement of claims which were found neither invalid nor unenforceable (a) can be justified under the historical precedents culminating in the Supreme Court's unanimous opinion in *eBay Inc. v. MercExchange, L.L.C.*, \_\_\_ U.S. \_\_\_, 126 S.Ct. 1837 (2006), and (b) can be harmonized with the policies reflected in the 200-year history of the Supreme Court's construction of the terms of the public's bargain with the patentee under the Patent Clause of the U.S. Constitution.

The full text of these briefs are posted on the Association's web site at [www.nyipla.org](http://www.nyipla.org).



# **PART III**

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

# **SECTION 1**

*Summary of Workload*

**U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT  
 APPEALS FILED, TERMINATED, AND PENDING DURING THE TWELVE-MONTH PERIOD ENDING  
 SEPTEMBER 30, 2007**

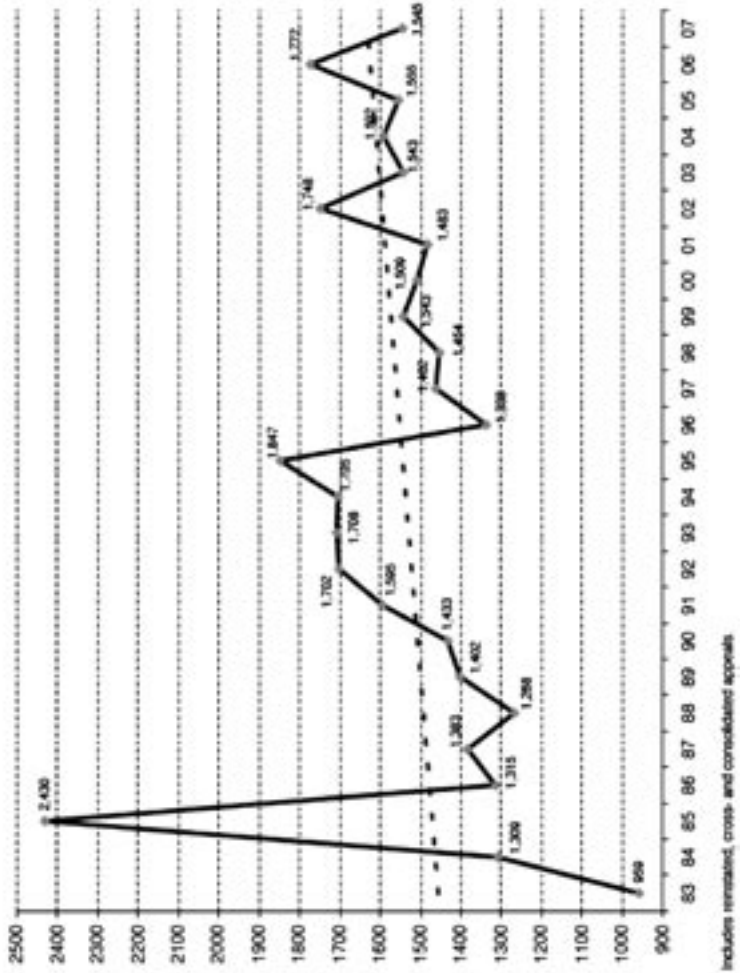
Source of Appeals	Pending 1-Oct-06	Filed	Terminations				Pending 30-Sep-07
			Total	By Judges	Other	Percent Reversed	
Total	1,406	1,545	1,718	1,257	461	14	1,233
Board of Contract Appeals	25	16	29	23	6	0	12
U.S. Court of International Trade	47	67	54	46	8	33	60
U.S. Court of Federal Claims	141	188	185	137	48	14	144
U.S. Court of Appeals for Veterans Claims	481	319	387	301	86	16	413
U.S. District Courts	402	439	504	363	141	17	337
Department of Veterans Affairs	2	3	4	3	1	0	1
International Trade Commission	7	38	18	14	4	0	27
Merit Systems Protection Board	246	389	436	288	148	8	199
Office of Compliance	0	4	0	0	0	0	4
Patent & Trademark Office	51	52	69	51	18	17	34
Writs*	4	30	32	31	1	0	2

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

# United States Court of Appeals for the Federal Circuit

## Historical Caseload

Appeals Filed FY 1983 - FY 2007

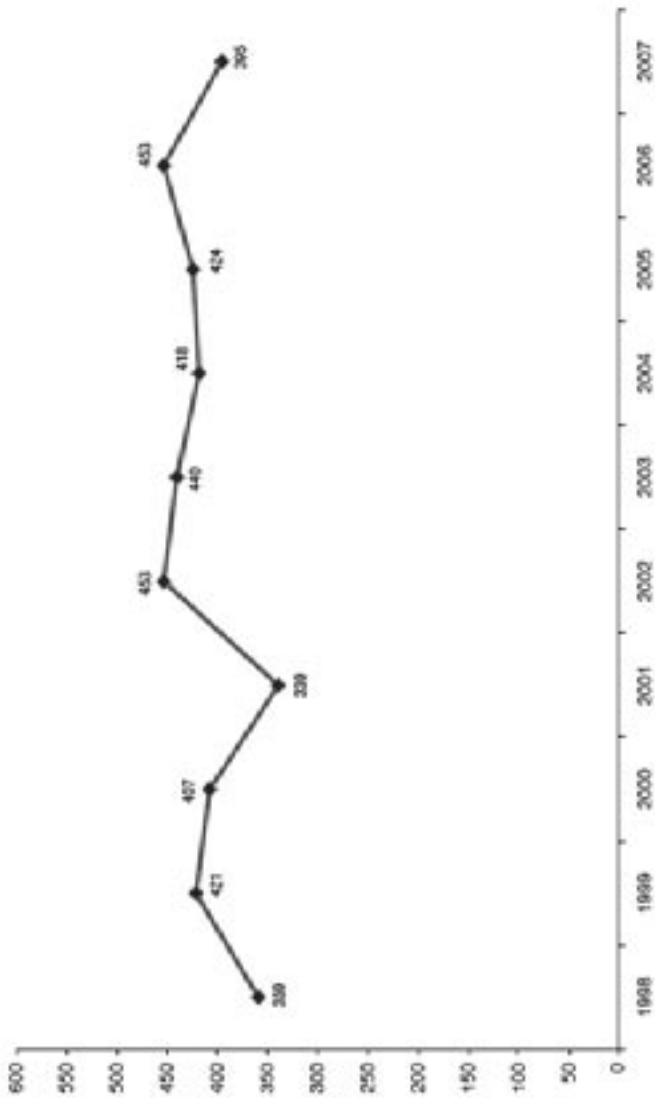


Includes reinstated, cross- and consolidated appeals.

# United States Court of Appeals for the Federal Circuit

## Patent Infringement Appeals from the U.S. District Courts

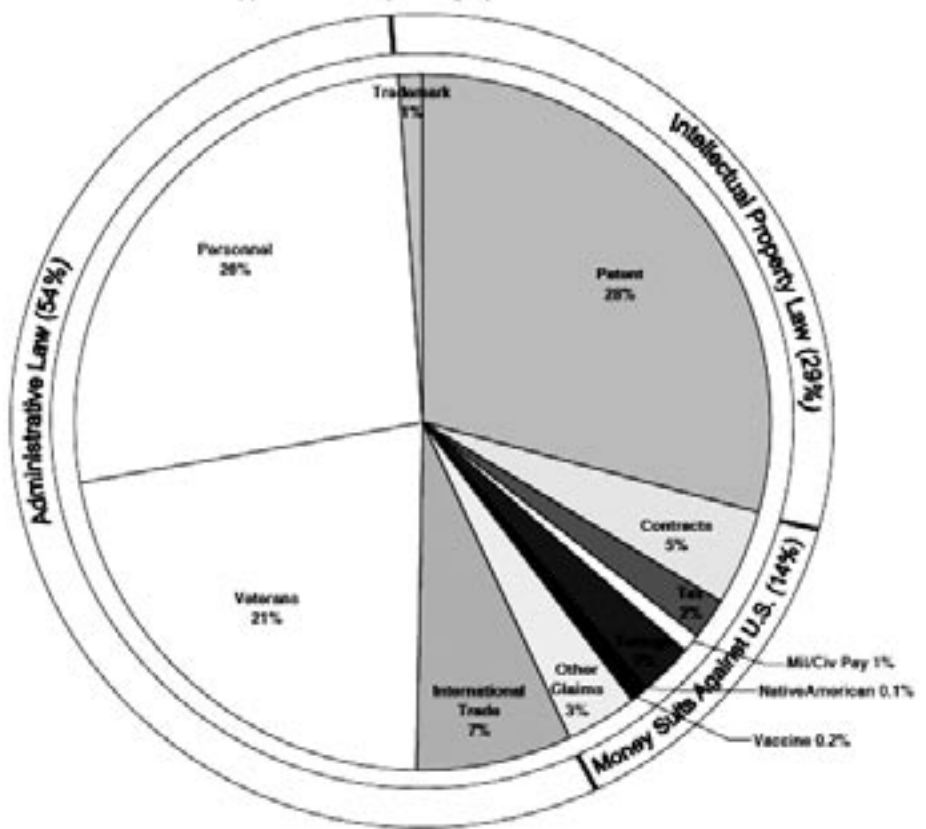
FY 1998 - FY 2007



Includes reinstated, cross- and consolidated appeals.

# United States Court of Appeals for the Federal Circuit

Appeal Filed by Category, FY 2007





## **SECTION 2**

*Biographies*

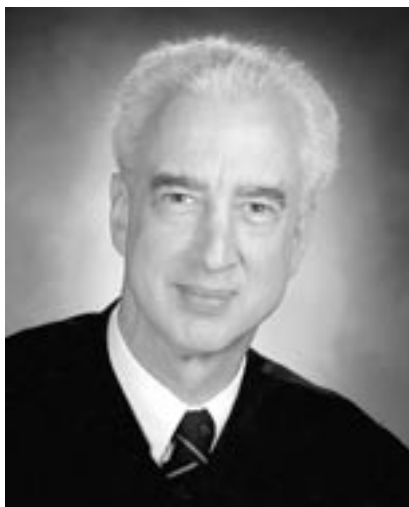


**MICHEL, PAUL R.**

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

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Washington, DC 20439

Telephone: 202-633-6297



Born: Philadelphia, Pennsylvania  
February 3, 1941

PAUL R. MICHEL was appointed as a Circuit Judge to the United States Court of Appeals for the Federal Circuit by President Ronald Reagan in 1988. On December 25, 2004, after 16 years on the court, he assumed the duties of Chief Judge. Chief Judge Michel has written over 300 opinions in patent, trademark, takings, contract, tax, veterans' rights, international trade and government personnel cases. He is the recipient of the Eli Whitney Prize, the Katz-Kiley Prize, and the Jefferson Medal for "outstanding contribution ... to the progress of science and useful arts." In 2003, he was named by *Managing Intellectual Property* magazine as one of the 50 most influential people in the world in intellectual property. Since October 2005, he has been a member of the Executive Committee of the Judicial Conference of the United States, the governing body of the Judicial Branch. He has taught at George Washington and other law schools, made many presentations to various city, state, national and international bar associations and participated in the training of judges of other nations.

**BRYSON, WILLIAM C.**

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

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

Telephone: 202-633-5808

Born: Houston, Texas  
August 19, 1945



WILLIAM C. BRYSON was appointed by President William J. Clinton in 1994. Prior to his appointment, Judge Bryson was with the United States Department of Justice from 1978 to 1994. He was with the United States Department of Justice, Criminal Division, from 1979 to 1986 and he was an Associate at the Washington, DC law firm of Miller, Cassidy, Larroca and Lewin from 1975 to 1978. Judge Bryson served as Law Clerk to the Honorable Henry J. Friendly, United States Court of Appeals for the Second Circuit from 1973 to 1974, and as Law Clerk to the Honorable Thurgood Marshall, Supreme Court of the United States, from 1974 to 1975. Judge Bryson received an A.B. from Harvard University in 1969 and a J.D. from the University of Texas School of Law in 1973.

**DYK, TIMOTHY B.**

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717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6550

Born: Boston, MA  
1937



TIMOTHY B. DYK was appointed by President William J. Clinton in 2000. Prior to his appointment, Judge Dyk was Partner and Chair, Issues and Appeals Practice Area, at Jones, Day, Reavis and Pogue from 1990 to 2000. He was Adjunct Professor at Yale Law School from 1986 to 1987 and 1989, at the University of Virginia Law School in 1984 and 1985, and from 1987 to 1988, and at the Georgetown University Law Center in 1983, 1986, 1989 and 1991. Judge Dyk was Associate and Partner, Wilmer Cutler and Pickering from 1964 to 1990. From 1963 to 1964, Judge Dyk served as Special Assistant to Assistant Attorney General Louis F. Oberdorfer. He also served as Law Clerk to Chief Justice Warren from 1962 to 1963, and to Justices Reed and Burton (retired) from 1961 to 1962. Judge Dyk received an A.B. from Harvard College in 1958 and an LL.B. from Harvard Law School in 1961. He was First President of the Edward Coke Appellate Inn of Court from 2000 to 2002 and President of the Giles Sutherland Rich Inn of Court from 2006 to 2007.

**GAJARSA, ARTHUR J.**

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



ARTHUR J. GAJARSA was appointed by President William J. Clinton in 1997. Prior to his appointment, Judge Gajarsa was a partner in the Washington, DC law firm of Joseph, Gajarsa, McDermott and Reiner, P.C. from 1987 to 1997. Since 2003, Judge Gajarsa has been an Adjunct Professor at the Georgetown University Law Center. From 1980 to 1987, he was a Partner in the law firm of Wender, Murase and White. From 1978 to 1980 he was a Partner in the law firm of Gajarsa, Liss, and Conroy and from 1971 to 1972 he was an Associate with Duncan and Brown. Judge Gajarsa served as Special Counsel and Assistant to the Commissioner of Indian Affairs, Bureau of Indian Affairs, Department of Interior from 1969 to 1971. He was an attorney with the Office of General Counsel, Aetna Life and Casualty Co. from 1968 to 1969. Judge Gajarsa served as Law Clerk to Honorable Joseph McGarraghy, United States District Court for the District of Columbia from 1967 to 1968. Judge Gajarsa received a B.S.E.E. from Rensselaer Polytechnic Institute in 1962, an M.A. from Catholic University of America in 1968, and a J.D. from Georgetown University Law Center in 1967.

## **LINN, RICHARD**

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RICHARD LINN was appointed by President William J. Clinton in 1999. Prior to his appointment, Judge Linn was a Partner and Practice Group Leader at the Washington, DC law firm of Foley and Lardner from 1997 to 1999. He was a Partner and head of the intellectual property department at Marks and Murase, L.L.P. from 1977 to 1997. Judge Linn served as Patent Advisor, United States Naval Air Systems Command from 1971 to 1972, was a Patent Agent at the United States Naval Research Laboratory from 1968 to 1969, and served as a Patent Examiner at the United States Patent Office from 1965 to 1968. He was a member of the founding Board of Governors of the Virginia Bar Section on Patent, Trademark, and Copyright Law and served as Chairman in 1975. Judge Linn was a recipient in 2000 of the Rensselaer Alumni Association Fellows Award. He served as an Adjunct Professor and Professional Lecturer in Law at George Washington University Law School from 2001 to 2004. Judge Linn is a past president of the Giles Sutherland Rich Inn of Court and an honorary member of the Richard Linn American Inn of Court. He received a B.E.E. from Rensselaer Polytechnic Institute in 1965, and a J.D. from Georgetown University Law Center in 1969.

**LOURIE, ALAN D.**

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717 Madison Place N.W.  
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Telephone: 202-633-5851

Born: January 13, 1935



ALAN D. LOURIE was appointed by President George H. W. Bush in 1990. Prior to his appointment, Judge Lourie was Vice President, Corporate Patents and Trademarks and Associate General Counsel from 1977 to 1990, Director, Corporate Patents from 1976 to 1977, Assistant Director, Corporate Patents from 1970 to 1976, and Patent Agent from 1964 to 1970 at SmithKline Beecham Corporation. From 1959 to 1964, he served as Chemist, Literature Specialist and Patent Liaison Specialist with Wyeth Laboratories. He was a Chemist at Monsanto Co. from 1957 to 1959. He also held the position of Vice Chairman, Industry Functional Advisory Committee on Intellectual Property Rights for Trade Policy Matters (IFAC 3) for the Department of Commerce and the Office of the United States Trade Representative from 1987 to 1990. He was a member of the Judicial Conference Committee on Financial Disclosure from 1990 to 1998, and is a member of the Committee on Codes of Conduct from 2005 to present. He was awarded the Jefferson Medal for outstanding contributions to intellectual property law in 1998. Judge Lourie received an A.B. from Harvard University in 1956, an M.S. from the University of Wisconsin in 1958, a Ph.D. from the University of Pennsylvania in 1965, and a J.D. from Temple University in 1970.



## **MAYER, HALDANE ROBERT**

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Telephone: 202-633-6556

Born: Buffalo, New York  
February 21, 1941



HALDANE ROBERT MAYER was appointed by President Ronald Reagan in 1987, and served as Chief Judge from 1997 to 2004. Judge Mayer served on the United States Claims Court from 1982 until his appointment to the Federal Circuit. He was an adjunct professor at George Washington University National Law Center and the University of Virginia School of Law. He served as Deputy and Acting Special Counsel, and was in private practice in Charlottesville, Virginia, in the 1970s, and in Washington, DC, in the early 1980s. Judge Mayer served as Special Assistant to the Chief Justice of the United States, Warren E. Burger, for three years, and as Law Clerk to the Honorable John D. Butzner, Jr., United States Court of Appeals for the Fourth Circuit. Judge Mayer served in the Army from 1963 to 1975, in the Infantry and the Judge Advocate General's Corps. He was awarded the Bronze Star, Meritorious Service, and Army Commendation Medals, the Combat Infantryman Badge, Parachutist Badge, Ranger Tab, and Ranger Combat Badge. He retired as Lieutenant Colonel. Judge Mayer received a B.S. from the United States Military Academy, and a J.D. from The College of William and Mary, where he was editor-in-chief of the William and Mary Law Review.

**MOORE, KIMBERLY A.**

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717 Madison Place N.W.  
Washington DC 20439

Telephone: 202-633-6570

Born: Baltimore, MD  
1968



KIMBERLY A. MOORE was appointed by President George W. Bush in 2006. Prior to her appointment, Judge Moore was a Professor of Law from 2004-2006 and Associate Professor of Law from 2000 to 2004 at the George Mason University School of Law. She was an Assistant Professor of Law at the University of Maryland School of Law from 1999 to 2000. She served both as an Assistant Professor of Law from 1997 to 1999 and the Associate Director of the Intellectual Property Law Program from 1998 to 1999 at the Chicago-Kent College of Law. Judge Moore clerked from 1995 to 1997 for the Honorable Glenn L. Archer, Jr., Chief Judge of the United States Court of Appeals for the Federal Circuit, and was an Associate at Kirkland & Ellis from 1994 to 1995. From 1988 to 1992, Judge Moore was employed in electrical engineering with the Naval Surface Warfare Center. Judge Moore received her B.S.E.E. in 1990, M.S. in 1991, both from the Massachusetts Institute of Technology, and her J.D. (cum laude) from the Georgetown University Law Center in 1994. Judge Moore has written and presented widely on patent litigation. She co-authored a legal casebook entitled Patent Litigation and Strategy and served as the Editor of The Federal Circuit Bar Journal from 1998 to 2006.

**NEWMAN, PAULINE**

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717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-5841

Born: New York, New York  
June 20, 1927



PAULINE NEWMAN was appointed by President Ronald Reagan in 1984. From 1982 to 1984, Judge Newman was Special Adviser to the United States Delegation to the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property. She served on the advisory committee to the Domestic Policy Review of Industrial Innovation from 1978 to 1979 and on the State Department Advisory Committee on International Intellectual Property from 1974 to 1984. From 1969 to 1984, Judge Newman served as director, Patent, Trademark and Licensing Department, FMC Corp. From 1961 to 1962 she worked for the United Nations Educational, Scientific and Cultural Organization as a science policy specialist in the Department of Natural Resources. She served as patent attorney and house counsel of FMC Corp. from 1954 to 1969 and as research scientist, American Cyanamid Co. from 1951 to 1954. Judge Newman received a B.A. from Vassar College in 1947, an M.A. from Columbia University in 1948, a Ph.D. from Yale University in 1952 and an LL.B. from New York University School of Law in 1958.

**PROST, SHARON**

United States Circuit Judge  
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717 Madison Place N.W.  
Washington, DC 20439

Telephone: 202-633-6550

Born: Newburyport, MA



SHARON PROST was appointed by President George W. Bush in 2001. Prior to her appointment, Judge Prost served as Minority Chief Counsel, Deputy Chief Counsel, and Chief Counsel of the Committee on the Judiciary, United States Senate from 1993 to 2001. She also served as Chief Labor Counsel (Minority), Senate Committee on Labor and Human Resources from 1989 to 1993. She was Assistant Solicitor, Associate Solicitor, and Acting Solicitor of the National Labor Relations Board from 1984 to 1989. She was an Attorney at the Internal Revenue Service from 1983 to 1984, and Field Attorney at the Federal Labor Relations Authority from 1980 to 1983. Judge Prost also served as Labor Relations Specialist/Auditor at the United States General Accounting Office from 1976 to 1980 and Labor Relations Specialist at the United States Civil Service Commission from 1973 to 1976. Judge Prost received a B.S. from Cornell University in 1973, an M.B.A. from George Washington University in 1975, a J.D. from the Washington College of Law, American University in 1979, and an LL.M. from George Washington University School of Law in 1984.

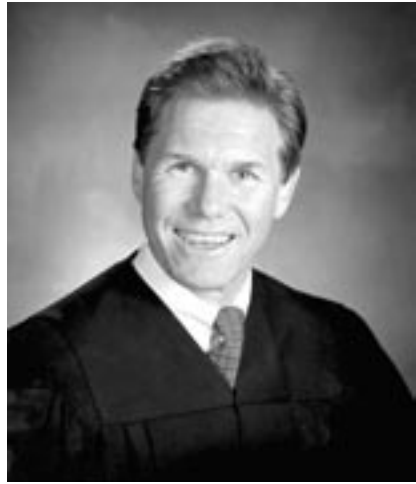
**RADER, RANDALL R.**

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

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Howard T. Markey National  
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717 Madison Place N.W.  
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Born: Hastings, Nebraska  
April 21, 1949



RANDALL R. RADER was appointed to the United States Claims Court by President George H. W. Bush in 1989 and served on that court until his appointment to the Federal Circuit in 1990. Prior to his appointment, Judge Rader served as Minority Chief Counsel, Staff Director, Senate Committee on the Judiciary, Subcommittee on Patents, Trademarks, and Copyrights from 1987 to 1988. He also served as General Counsel and Chief of the Senate Committee on the Judiciary's Subcommittee on the Constitution from 1981 to 1986, and as Counsel in the House of Representatives from 1975 to 1980. Judge Rader taught Patent Law at the University of Virginia School of Law and at the George Washington University National Law Center, and Comparative Patent Law at Georgetown University Law Center. Judge Rader is the author of a casebook entitled Patent Law, published by West Publishing in 1998.

**SCHALL, ALVIN A.**

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

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

Telephone: 202-633-6562

Born: New York, New York  
April 4, 1944



ALVIN A. SCHALL was appointed by President George H. W. Bush in 1992. Prior to his appointment, Judge Schall served as Assistant to the Attorney General of the United States from 1988 to 1992. He was a member of the Washington, DC law firm of Perlman and Partners from 1987 to 1988. He served as Trial Attorney and Senior Trial Counsel, Civil Division, United States Department of Justice, from 1978 to 1987. Judge Schall was an Assistant United States Attorney, Office of the United States Attorney for the Eastern District of New York, from 1973 to 1978, and served as Chief of the Appeals Division from 1977 to 1978. From 1969 to 1973, Judge Schall was in private practice with the New York City law firm of Shearman & Sterling. Judge Schall received a B.A. degree from Princeton University in 1966 and a J.D. degree from Tulane Law School in 1969.

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