Nineteen Hundred and Twenty-two

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Mario Cuomo
Keynote Speaker at the 88th Annual Judges' Dinner

Governor Mario Cuomo is known as an intellectual, passionate, and challenging force for social responsibility and diversity. When he addresses the judges, NYIPLA members, and guests at the 88th Annual Dinner in Honor of the Federal Judiciary on March 26, he is sure to remind us of our collective American legacy.

Cuomo is the longest serving Democratic Governor of New York in modern history. He twice set New York records for highest popular vote ever achieved in a state-wide election. *The New York Times* called his tenure one of the most celebrated governorships in history. The conservative *National Review* said,

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The Fight Against False-Markers, The Real "Marking Trolls"

By Joseph A. Farco, Esq.

The Federal Circuit on October 7, 2009 heard oral argument in the matter of *Forest Group, Inc. v. Bon Tool Co.* regarding the construction of the penalty provision of 35 U.S.C. § 292 (the "patent false-marking statute"). Under the prevailing law established in 1910, deceptive false-marking cases overwhelmingly resulted in miniscule penalties (less than $1000). The *Forest Group* appeal presents an opportunity to update this nearly 100-year old precedent and fuel a stronger penalty provision. While this might create an influx of patent false-marking cases, its more immediate effect will be to hold patentees accountable for promoting their limited monopolies in the public forum.

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PRESIDENT'S CORNER

January 2010

Dear Fellow Members,

Much has happened since my first President's Letter, where I previewed this year's upcoming events. I am delighted to report the resounding success of these programs.

Our monthly luncheon meetings featuring timely topics have been well attended. In September, Hon. Michael Fleming of the Patent Office spoke about appellate practice and recent developments at the Board of Appeals and Patent Interferences. The following month, Hon. Arthur J. Gonzalez of the U.S. Bankruptcy Court for the S.D.N.Y. discussed the impact of bankruptcy on intellectual property. In December, Hon. Faith Hochberg and Hon. Patty Shwartz of the U.S. District Court for the District of New Jersey, as well as Arnold Calmann, Phil Johnson and Stephen Roth addressed the District of New Jersey's local patent rules and their impact on pharmaceutical patent litigation. Also in December, Annemarie Hassett, Ira Levy, Ben Hershkowitz and Anthony Giaccio presented an evening program concerning preparation of a patent damages case for trial. I would like to extend my gratitude to Rich Erwine and Rich Martinelli, chairs of the Meeting and Forums Committee, which oversees the luncheon meetings, for their superb management in providing such comprehensive presentations.

The fall one-day CLE Program, which was held at the Princeton Club in November, was well-received by a sold-out crowd of more than 150 attendees who were treated to some unique presentations. The speakers included Chuck Fish, Charles Miller, Doug Nemec, David Vickery, Michael Timmons and Joe DeGirolamo. The substantive content of the program was particularly impressive as it highlighted some extremely significant recent developments in the law. Dorothy Auth and Rich Parke planned and chaired the program, which received rave reviews.

On the Committee front, Alexandra Urban and Susan McGahan have energized the Corporate Practice Committee, which has held a number of meetings. Recently, its members participated in a study of patent prosecution practices of New York metropolitan area corporations. In addition, the Amicus Committee, chaired by John Hintz and Charlie Weiss, has filed briefs in six Federal Circuit cases thus far this year.

Finally, planning for the 88th Annual Dinner in Honor of the Federal Judiciary, which will occur on March 26, 2010, is in full swing. The Honorable Richard Linn of the U.S. Court of Appeals for the Federal Circuit will receive the NYIPLA Outstanding Public Service Award. Judge Linn has proven to be a leader of the patent bar through his selfless dedication to the development of intellectual property law. Our keynote speaker is former Governor Mario Cuomo, an intellectual, passionate and challenging force for social responsibility and diversity. Cuomo is a dynamic speaker, so expect to be entertained and informed by his remarks. As in the past, we will host a CLE program on the day of the dinner, which will include participation by some of the attending judges.

Looking ahead, your Association is moving forward with more informative programs and a number of committees are actively working on many interesting and topical projects. I urge you to consider joining and participating in one of our committees. There are many opportunities to become involved and exchange ideas with colleagues on the wide-ranging topics of intellectual property.

We extend our best wishes to all our members and friends for a happy and healthy 2010 and look forward to seeing you during the upcoming winter and spring activities.

Sincerely,
Mark J. Abate
President, New York Intellectual Property Law Association

An 88-Year Tradition

On Friday, March 26, 2010, members and guests of the NYIPLA will enjoy the ambiance and elegance of the Waldorf=Astoria in a tradition that began in 1922. For the past 87 years, the association has been paying tribute to federal judges and the intellectual property community at the Annual Dinner in Honor of the Federal Judiciary.

The first dinner was held on December 6, 1922. It was a rousing success with 258 people. NYIPLA members hosted 16 honored guests at 11 tables. Eleven judges attended from the Second Judicial District and the District of New Jersey. Among the attending judges was the renowned Hon. Learned Hand, who was appointed by President Taft in 1909 and spent 52 years on the federal bench. His cousin, Hon. Augustus Hand, was there as well. Also in attendance were the U.S. Commissioner of Patents, Hon. T.E. Robertson, and the presidents of the Patent Law Associations of Chicago, Cleveland, Pittsburgh, and the American Patent Law Association.

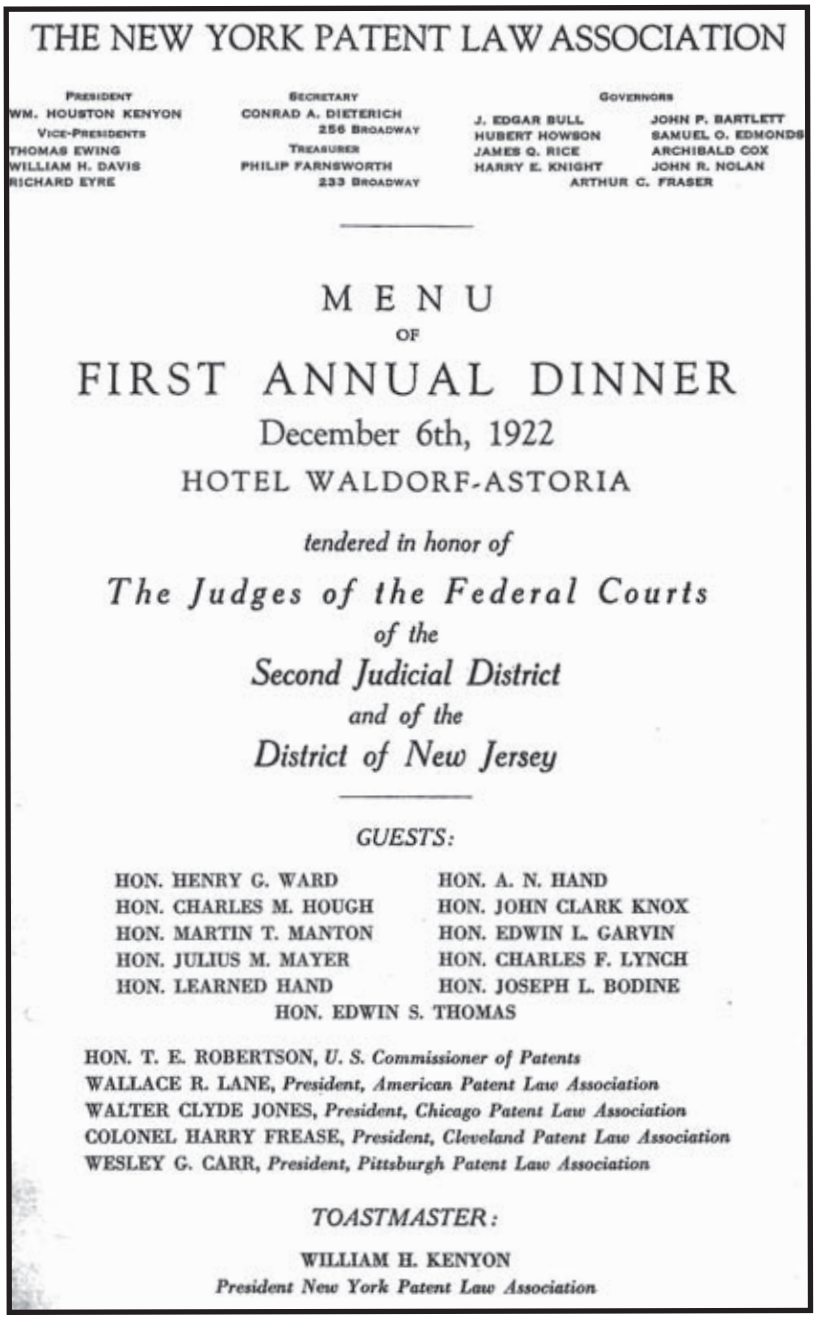
In the spirit of "patent law entertainment," the printed dinner menu appeared in the form of a patent submitted by fictional applicants "William A. Cook and Alphonse A. Chef." Some quotes from that menu:

"This invention relates to an improved Composition of Matter or Dinner. Among the objects of the invention is to provide a Dinner to promote good fellowship between the Bench and the Bar. A further objective of the invention is to provide a novel (that is, not more than a few days old) combination of elements, herinafter termed "courses," illustrated in the drawings and more particularly pointed out in the appended claims."

Setting the foundation for the Dinner's tradition of fine food and sumptuous desserts, the menu concluded with *"An Improved Composition of Matter consisting of Bombe of Nesselrode Ice Cream, with assorted cakes, macaroons, lady fingers and coffee."*

Through the years, the Dinner has continued to be the premier event for the NYIPLA. We have been honored with the attendance of distinguished judges and enlightening keynote speakers, including Ronan Tynan, Ed Koch, Tim Russert, Scott Turow, Tom Brokaw -- and this year's speaker, Mario Cuomo.

You can be a part of this historic event. Make your reservations to attend this year's dinner on Friday, March 26, 2010 at the Waldorf=Astoria. Reservation forms are available at www.nyipla.org, or call (201) 634-1870. Reservation deadline is February 9, 2010.



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MENU
OF
FIRST ANNUAL DINNER
December 6th, 1922
HOTEL WALDORF-ASTORIA

tendered in honor of
The Judges of the Federal Courts
of the
Second Judicial District
and of the
District of New Jersey

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TOASTMASTER:

WILLIAM H. KENYON
President New York Patent Law Association

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"Mario Cuomo has for years been hailed as both the philosopher-king and the humble conscience of the Democratic Party, a formidable, saintly genius of liberalism. Since his efflorescence at the 1984 Democratic convention, even many conservatives have accorded this, their archenemy, a certain respect."

Cuomo served New York through two national recessions and twelve years of federal policies that cut back on federal aid to New York and other states. Nevertheless, he balanced 12 budgets, reduced New York's largest tax, the income tax, by more than 20 percent; rebuilt much of the state's infrastructure; reduced the mortality rates on highways every year for seven years with the nation's first seat belt law and an aggressive anti-drunk-driving program; created the state's first Centers of Advanced Technology; and introduced programs like "Child Health Plus" and the "Children's Assistance Program," a reform of the New York welfare system that served as models for later federal programs now in place.

Governor Cuomo appointed 112 judges, including all the judges of the New York State Court of Appeals during his tenure, as well as the first and second women judges, the first Black, the first Hispanic, and the first woman to serve as Chief Judge.

He declined invitations to run for president of the United States and to serve on the United States Supreme Court. A lawyer since 1956, he returned to the practice of law at Willkie Farr & Gallagher LLP in 1995.

Cuomo is a scholar on Abraham Lincoln and wrote *Why Lincoln Matters: Today More than Ever* (Harcourt, 2004). The book shows how Lincoln's big issues – equality, the role of government, war and peace, and the responsibilities of the fortunate few –still resonate in today's world.

It's time to make your reservations for the 88th Annual Dinner in Honor of the Federal Judiciary. The dinner will be held on Friday, March 26 at the Waldorf=Astoria Hotel. Reservation forms are available at www.nyipla.org, or call (201) 634-1870. The Reservation deadline is February 9, 2010. For further information, contact Louise Lessersohn at (201) 634-1870. ■

NYIPLA Calendar

88th Annual Dinner in Honor of the Federal Judiciary

➤ March 26, 2010 ◄

Waldorf=Astoria Hotel • 301 Park Avenue, New York

CLE Programs

NYIPLA CLE Day of Dinner Program

➤ Friday, March 26, 2010 ◄

Earn 2.0 NYS CLE Credits

The Starlight Roof at the Waldorf=Astoria Hotel • 301 Park Avenue, New York

Twenty-Sixth Annual Joint Patent Practice Seminar

➤ Thursday, April 29, 2010 ◄

Hilton New York • 1335 Avenue of the Americas, New York

Keynote Speaker: **Hon. Pauline Newman**, Circuit Judge
United States Court of Appeals for the Federal Circuit

More programs to come!

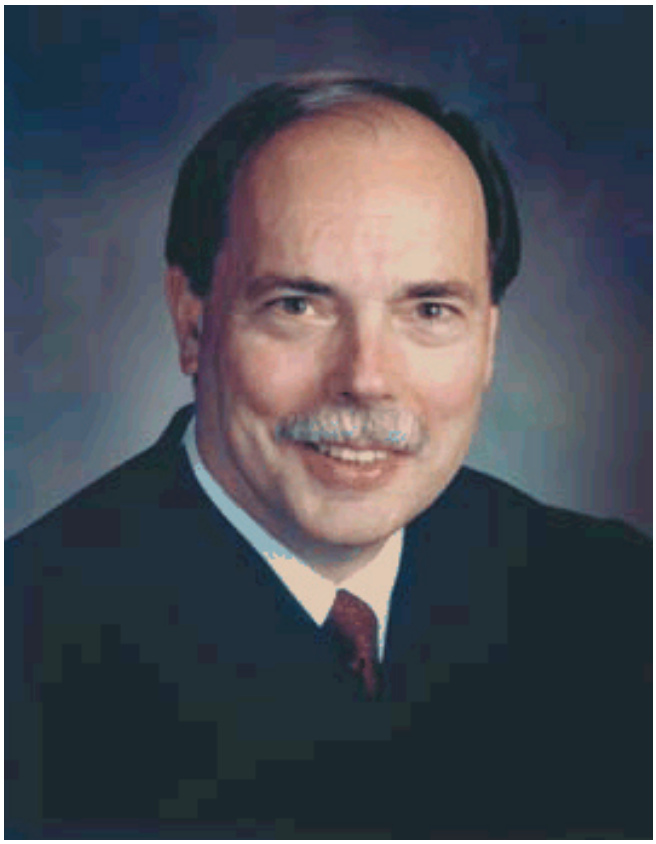
For Additional Information See: WWW.NYIPLA.ORG

NYIPLA to Honor Judge Richard Linn at 88th Judges' Dinner in March

The Honorable Richard Linn will receive the NYIPLA Outstanding Public Service Award at the 88th Annual Dinner in Honor of the Federal Judiciary on March 26, 2010, at the Waldorf=Astoria Hotel. For the past eight years, the Association has selected an OPS recipient in recognition of a lifetime dedicated to the pursuit and administration of justice. Judge Linn more than meets this standard.

Judge Linn is a Circuit Judge for the United States Court of Appeals for the Federal Circuit. He was nominated by President Clinton on September 28, 1999 and took the oath of office at the stroke of midnight on January 1, 2000 becoming the first federal judge of the 21st century.

Judge Linn received his B.E.E. from Rensselaer Polytechnic Institute in 1965 and a J.D. from Georgetown University Law Center in 1969. He began his career in intellectual property in 1965 as an examiner at the U.S. Patent Office while attending evening classes at Georgetown. After three years, he moved to the Office of Naval Research where he wrote and prosecuted patent applications while completing his last year in law school. He was the head of the intellectual property department at Marks, Murase & White for 20 years. During that time, he acted as lead or senior counsel in over 30 litigations in the United States. In 1997, he joined Foley & Lardner to manage and direct the Electronics Practice Group of the firm's Intellectual Property Department. He left the practice of law at the end of 1999 to become a Federal Circuit judge.



Judge Linn 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. In 2000, Judge Linn received 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 2003, and currently serves on the Law School's Intellectual Property Advisory Board. In 2006, Judge Linn was honored for dedication, service, and devotion to justice by the Austin Intellectual Property Law Association. Last year, he was awarded the 2009 New York Intellectual Property Law Association Leadership Award and the 2009 Jefferson Medal from the New Jersey Intellectual Property Law Association.

Judge Linn has demonstrated himself to be a leader of the Patent Bench and Patent Bar through his selfless dedication to the development of Intellectual Property Law focused American Inns of Court around the country. American Inns of Court are organizations that bring together judges, senior lawyers, junior lawyers, and students to promote the traditions of civility, excellence, and professionalism. There are currently ten IP focused Inns of Court that are members of the Linn Inn Alliance, including New York's Hon. William C. Conner Inn of Court. The NYIPLA and the entire IP community in New York are grateful to Judge Linn for his exemplary leadership.

NYIPLA members and guests will have an opportunity to honor and celebrate with Judge Linn at the Dinner on March 26. Firms who wish to take Congratulatory Notices in the Dinner Program may call (201) 634-1870, or email kmallozzi@nyipla.org. Forms for the Congratulatory Notices and Dinner Reservations are available at www.nyipla.org.

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A. THE FALSE-MARKING STATUTE: THEN AND NOW

The patent false-marking statute in Title 35 is unique as one of few *qui tam* statutes remaining in the American legal system[4] and the only penalizing statute in the Patent Laws.[5] The current statute, amended in 1952, states in pertinent part:

> Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article the word "patent" or any word or number importing that the same is patented … [or] that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public … Shall be fined not more than $500 for every such offense.

Before 1952, § 292 imposed a penalty of not less than one hundred dollars for every false-marking offense.[6] When the 1870 penalty provision came before the First Circuit in the 1910 case *London v. Everett H. Dunbar Corp.*, the requested penalty was $10,000, or the equivalent of $1,311,102.70 in 2008 dollars.[7] To avoid interpreting a penalty "result[ing] in the accumulation of an enormous sum of penalties, entirely out of proportion to the value of the articles," the statute was construed to penalize only each decision to mark, not each falsely marked article.[8] Even after the minimum $100 penalty was removed, courts still followed the 1910 case.[9] But under the current language, *London's* policy of avoiding an imposition of a minimum penalty no longer applies. Therefore, it seems that *London* now carries little if any precedential value on the law of assessing penalties for patent false-marking.

B. ORAL ARGUMENT IN THE FEDERAL CIRCUIT

The advocated "per article" penalty[10] serves a dual role: an adequate deterrent for deceptive marking and a reward for vigilant informers, the latter appearing to be the primary policy concern of the Federal Circuit panel during the *Forest Group* oral argument. At the core of the dialogue was whether imposing a penalty per falsely marked thing encourages marking trolls, *i.e.*, people who will seek opportunities to sue patentees for false-marking.

The defendant-appellant argued that penalties in cases brought by any plaintiff, marking troll or not, would not pose a problem because the district courts have discretion in proposing the penalty under the Federal Circuit's advocated reading of the statute.[11] To continue following *London*, the panel realized, would provide little incentive to bring false-marking lawsuits. "Marking trolls" police the deleterious effects of deceptive false-marking and, as the panel noted, could be rewarded for eliminating the people who are eliminating competition. By limiting the awards realizable under the false-marking statute, courts may indirectly discourage the core group of litigants who are capable of identifying and stopping a false-marker.

The appellee suggested that any change in the law was better left for Congress. But draftsmanship was not the issue – rather, it was the interpretation of the law's language. The panel mentioned that patent false-marking carries an anticompetitive effect which under the *London* rule would only work to the false-marker's benefit, *i.e.*, the benefits of falsely marking products to increase consumer appeal and exclude competitors outweigh penalties for violating the statute.[12] Left unchanged, it pays for companies to falsely mark their products with patent numbers, the precise harm to the public Congress meant to remedy in enacting the statute.

C. REPERCUSSIONS OF A "PER ARTICLE" PENALTY

1. More Opportunities To Stop Monopoly Trolls

It is possible that a "per article" penalty may induce waves of patent false-marking litigation. Arguably, § 292 plaintiffs are merely acting on Congress's intent to keep the public free of unwarranted patent monopolies. An increased number of proper § 292 suits aligns with the legislative purpose of stopping the anticompetitive effects of false-markers who act as monopoly trolls. There are no qualms concerning individuals who seek to oust an unwarranted patent monopoly from the public domain via an invalidity, unenforceability or antitrust claim. In fact, the law applauds these challenges to unwarranted or invalid patent monopolies.[13] Similarly situated to the aforementioned individuals, victorious § 292 plaintiffs achieve the same result: stopping unnecessary patent monopolies from encumbering the public.

2. A Penalty Award Driven By Antitrust Concerns

The oral argument raised the popular concern that under a "per article" penalty, a victorious § 292 plaintiff could reap large monetary awards. However likely this result might be, it is inciden-

tal to the penalty's deterrence function. Were the penalty provision merely a money making device, a false-marker could pay the potential plaintiff the asserted damages amount (discounted for litigation uncertainty) thereby avoiding a false-marking lawsuit altogether. This type of transaction would allow the false-marker an unwarranted monopoly over products in the public domain at the cost of paying off the § 292 plaintiff. But this result simply would not happen because by engaging in a transaction that perpetuates an anticompetitive arrangement, the false marker may run afoul of Federal antitrust laws.[14] Therefore, the statute's core anticompetitive purpose cannot be avoided by simply paying off the representative of the public.[15] Truly, the penalty provision is meant to deter anticompetitive behavior first and issue an award as an afterthought.

3. Diligent Monopoly Inspection

Based on the oral argument, it seems that the Federal Circuit views the § 292 plaintiff as the least troll-like of the two parties in a patent false-marking case. That a "per article" penalty may increase efforts to seek out false-marking issues is a nearsighted observation. Over the long term, patent counsel would increase their awareness of client marking decisions and the marking decisions of competitors. Ultimately, the statute will delegate further duties on patent lawyers who are arguably best equipped to prevent false-marking and identify it in the public domain. These monopoly inspectors audit patent monopolies and ensure that there are proper representations of exclusionary rights in the public domain. The net effect is a proper patent marking system.

4. No Near Or Present Danger

At present, it is not only financially imprudent but also considered taboo to bring false-marking actions due to limited returns on victorious suits and the negative connotation of § 292 plaintiffs as "marking trolls." Bringing a false-marking suit carries serious risks: (1) substantial litigation costs, primarily due to the necessary discovery to prove intent to deceive, and (2) consequences of likely public exposure and scrutiny for bringing such a case. Though costs of litigation may be recoupable, a negative reputation achieved by bringing these sorts of actions is not.

Even when the Federal Circuit seems to have condoned a practice of removing falsely marked articles from the marketplace through § 292, it may still be likely that championing a fight against monopoly trolls results in only a Pyrrhic victory. In time, this view of § 292 plaintiffs may change, but the current possibility of a negative reputation among other patent lawyers and former and potential clients suggests that only the strongest false-marking cases will make their way to the courts.

D. CONCLUSION

The Federal Circuit has recognized that an increase in public defenders under the statute might actually reduce patent false-marking. Implicit in this recognition is the understanding that any additional costs born by the legal system in entertaining these cases will be outweighed by the economic benefits of alleviating threats to competition. Though § 292 suits may gain popularity in courts, the pace at which courts might see such actions will not be extreme considering the costs of maintaining such lawsuits and the potential for negative public perceptions of the § 292 plaintiff.

Nevertheless, the existence of a more powerful false-marking statute will undoubtedly impact the general practice of moderating product markings and place a greater duty on patent lawyers to be attentive to patent false-marking by their clients and their competitors.

Editor's Note: On December 28, 2009, the Court of Appeals for the Federal Circuit ruled in *Forest Group, Inc. v. Bon Tool Co.* that 1) "a party asserting false marking must show by a preponderance of the evidence that the accused party did not have a reasonable belief that the articles were properly marked," and 2) 35 U.S.C. § 292 considers falsely marking each article with intent to deceive as a separate offense, payable by a fine of not more than $500 per offense. The Court rejected the district court's $500 total fine made in reliance on *London v. Everett H. Dunbar Corp.*, and noted that the statute was rewritten in 1952.

The Court rejected the defendants' argument that such a reading would encourage "marking troll" suits, noting that such actions are explicitly permitted and encouraged by the statute's *qui tam* structure. The Court remanded for reassessment of the amount of the fine noting that the district court, in meting out a per-article fine of anywhere from "a fraction of a penny" to $500, has "the discretion to strike a balance between encouraging enforcement of an important public policy and imposing disproportionately large penalties for small, inexpensive items produced in large quantities."

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[1] Joseph A. Farco is an associate at the New York office at Locke Lord Bissell & Liddell LLP and specializes in patent litigation, transaction and prosecution. For questions or comments about this article, the author may be reached at (212) 415-8567 or at JFarco@lockelord.com. The author thanks Bob McAughan, a partner at the Houston office of Locke Lord Bissell & Liddell LLP, for the addition of his practical experience related to this issue.

[2] *Forest Group, Inc. v. Bon Tool Co.*, Appeal No. 2009-1044 (Fed. Cir. filed Oct. 29, 2008), Oral Argument on Appeal, http://oralarguments.cafc.uscourts.gov/searchscript.asp (Oct. 7, 2009) (on file with Federal Circuit Court of Appeals). Any reference to Federal Circuit panel discussions in this paper are with reference to this recording.

[3] The prevailing precedent originated from *London v. Everett H. Dunbar Corp.*, 179 F. 506, 507 (1st Cir. 1910). Under *London*, the penalty for false-marking was applied to each conscious choice to deceptively mismark, and not for each falsely marked article.

[4] In reciting that "Any person may sue for the penalty…," § 292(b) confers standing on any person to sue under §292(a), dividing the penalty between themselves and the United States. *See Pequignot v. Solo Cup Co.*, No. 1:07cv897, 2009 WL 874488 at *2 (E.D. Va. Mar. 27, 2009).

[5] 2 U.S.C.C.A.N. 2424 (1952) ("This [§ 292] is a criminal provision." It penalizes the actor rather than compensate for any injury).

[6] 35 U.S.C. § 50 (1946), R.S. § 4901 (1870).

[7] This penalty was sought for falsely marking 100 foot supporters. *London*, 179 F. at 509. The relative 2008 dollar amount reflects the value of the penalty in a 1910 economy (or GDP per capita). *See* Lawrence H. Officer and Samuel H. Williamson, "Six Ways to Compute the Relative Value of a U.S. Dollar Amount, 1790 to Present," MeasuringWorth, 2008, http://www.measuringworth.com/uscompare/ (last visited, November 16, 2009).

[8] *London*, 179 F. at 507 (minimum $100 penalty applied to any article regardless of worth would be unjust). The *London* court followed three prior holdings that also resolved the statute as only penalizing each decision to mark. *Hotchkiss v. Samuel Cupples Wooden Ware Co.*, 53 F. 1018, 1021 (E.D. Mo. 1891) (falsely marking about 30 articles would lead to $40,000 award); *Hoyt v. Computing Scale Co.*, 96 F. 250 (S.D. Ohio 1899) (falsely marking 1,500 scales would have resulted in $150,000 penalty); *U.S. Condensed Milk Co. v. Smith*, 116 App. Div. 15, 18-19 (3d Dept. 1906) ($4,650 penalty for $11.16 worth of milk cans).

[9] *See Juniper Networks v. Shipley*, 2009 WL 1381873, * 6 (N.D. Cal. 2009) (the "[false marking] statute does not prescribe a distinct penalty for each individual article marked"); *Forest Group, Inc. v. Bon Tool Co.*, 2008 W.L 4376346, * 3 (S.D. Tex. 2008) ("…the First Circuit case is well-reasoned and persuasive"); *Bibow v. American Saw and Mfg. Co.*, 490 F. Supp. 2d 128, 129 (D. Mass. 2007) (per mark penalties of $200 million raises doubts "that the statute ever intended to create such a lucrative game of gotcha!"); *Icon Health & Fitness, Inc. v. Nautilus Group, Inc.*, 2006 WL 753002, *5 (D. Utah 2006) ("such a fine [per false marking advertisement] would be nothing short of astronomical."); *Sadler-Cisar, Inc. v. Commercial Sales Network, Inc.*, 786 F. Supp. 1287, 1296 (N.D. Ohio 1991) ("continuous markings over a given time constitute a single offense").

[10] The Federal Circuit panel indicated that the penalty applies to each falsely marked "thing" (article or not). For the purposes of this paper, however, the "per article" theory was the one advocated by the defendant-appellant and will be referred to as such.

[11] Given the language "not more than $500," the panel commented that courts could augment the award to fractions of the penny in order to devise in a more reasonable penalty.

[12] The panel asked whether it could possibly have been Congress's intent that companies mismark rampantly and be penalized at most $500.

[13] *Haughey v. Lee*, 151 U.S. 282, 285 (1894) (individuals should not be estopped from actions "to relieve the public from an asserted monopoly…"); *Genentech v. Medimmune*, 549 U.S. 16-18 (2007) (settlement of patent litigation does not bar subsequent declaratory judgment by patent licensee that patent is invalid, unenforceable or not infringed).

[14] A settlement that would restrain trade or perpetuate an unwarranted commercial monopoly could violate Sections 1 and 2 of the Sherman Antitrust Act. *See* 15 U.S.C. §§ 1, 2 (1890).

[15] If one were to accept this formulation of the issue, the § 292 plaintiff becomes analogous to a member of the Department of Justice in a Federal antitrust action.

In Memoriam

Albert Robin, a member of the NYIPLA for over 40 years and a past president (1981-82), died on October 28, 2009.

Mr. Robin's career spanned all aspects of trademark practice and litigation. In addition to his commitment to our Association, he had been a member of the board of directors of the AIPLA, served on the Trademark Review Commission, was counsel to the International Trademark Association, a member of the Commerce Department Public Advisory Committee for Trademark Affairs, and chairman of the New York City Bar Association Committee on Trademarks and Unfair Competition. He was also a member of the INTA/CPR National Panel of Distinguished Neutrals.

Contributions in his memory for pancreatic cancer research can be made to "Johns Hopkins University" and sent to:

Ralph H. Hruban, M.D.
Johns Hopkins Medical Institutions
401 North Broadway, Weinberg 2242
Baltimore, MD 21231-2410

Include Mr. Robin's name on the check.

Albert Robin – Mentor and Friend

By Howard Barnaby

I was saddened to receive the news of Al Robin's death. I had not spoken to him for a number of months and was not aware of his illness. What followed was a flood of memories spanning the thirty-five years I have known Al. In looking back on those years, I was comforted to see how our relationship had developed from one of mentoring into friendship.

I first met Al Robin in 1973 when I interviewed for an associate position at Watson Leavenworth Kelton & Taggart. Except for a two-year hiatus working as in-house trademark counsel, I spent my entire professional career with Al from 1974 until my retirement from the practice of law in 2004.

Since that time, I have worked at Yale University (Al's alma mater). Al enjoyed reminiscing with me about his time at Yale as well as current happenings on the campus. He also phoned me on occasion to pass along greetings from well wishers he had met at NYIPLA and INTA events.

I learned much from Al about the practice of law, trademark litigation and prosecution, licensing, opinion work and counseling clients. His was a very practical, common-sense approach that I came to admire. Whenever we litigated for our clients, it was always with a view toward trying to achieve a settlement of the disputed issues. Al believed that it was always preferable for two litigants to come to an agreement based on sound business judgment rather than to place their fate in the hands of a judge or jury. As long as neither side was entirely satisfied with a settlement, then Al felt that a good result was probably achieved. This always seemed to result in long-term benefits for clients.

On the other hand, when the situation arose, Al did not shy away from vigorously representing his clients in court, whether at the trial or appellate level. I always marveled at his ability to digest the issues in a case and to present them to the court. He was truly a quick study with an innate talent for cross-examination. I recall one trial in Reno, Nevada, at which Al was to cross-examine an expert witness on survey evidence. I found him the evening before "preparing" in the casino at a dice table. The next day, he made short shrift of our adversary's witness, totally discrediting his expert opinion and testimony.

Al also instilled in me the importance of contributing to bar association activities and the intellectual property field. He was responsible for mentoring a number of persons, myself included, from committee work in the NYIPLA through board membership to serve as the association president. I treasure the memories of my own time as an NYIPLA board member and officer and recall Al's sense of pride in my accomplishments.

Al Robin lived for the practice of law and the service of his clients. It is not surprising that he developed close friendships with many of these clients. I am grateful that he was able to continue in his practice until his final illness and know that his clients will share in my sense of loss.

I was fortunate to have Albert Robin as a mentor. But I am grateful to have been able to call him my friend. Godspeed, Al.

HISTORIAN'S CORNER

"As Time Goes By - On the Shoulders of Giants"

by Dale Carlson

In 1130 A.D., Bernard of Chartres is reputed to have said: "We are like dwarfs standing [or sitting] upon the shoulders of giants, and so [are] able to see more and farther than the ancients."

In 2009 A.D., our Association marked the passing of three IP giants - Lorimer P. Brooks [NYIPLA Pres. '75-'76], William C. Conner [NYIPLA Pres. '72-'73], and Albert Robin [NYIPLA Pres. '81-'82]. Each made significant contributions to the advancement of our Association and its objectives before, during, and after their time as NYIPLA President.

In their early years, Larry Brooks and Bill Conner shared a common interest in the science of radar. Bill served as a radar officer on an aircraft carrier during World War II. Larry was employed by the U.S. Army Signal Corps to help develop a radar target identification system that was utilized by the Allied Forces during World War II. That system formed the basis for the one used by the FAA to this day to identify airplane traffic.

Whereas Larry and Bill focused on patent law during their time in practice, Al's specialty was trademark law. In addition to the NYIPLA, Al was active in senior positions in INTA and its predecessor organization, the U.S. Trademark Association.

Dale Carlson, a partner at Wiggin & Dana, serves as the NYIPLA Historian, and as President-Elect.

Larry, Bill and Al each left a legacy of mentoring others within our Association. One mentee, Howard Barnaby [NYIPLA Pres. '98-'99], provides an appreciation of Al elsewhere in this issue of the Bulletin.

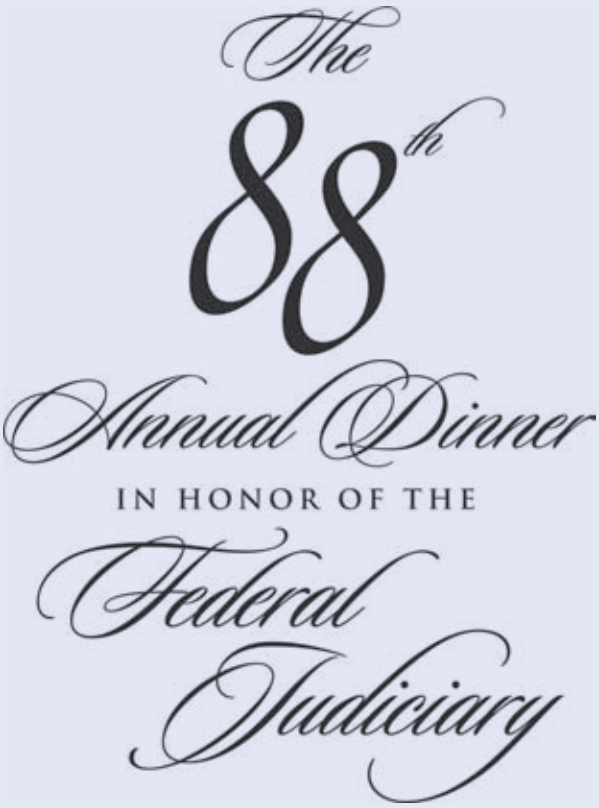
In his later years, Judge Conner went out of his way to encourage our Association to do what it might to promote experienced patent practitioners as candidates for the federal bench. Such encouragement mirrored that provided by Judge Giles S. Rich [NYIPLA Pres. '50-'51] in a 1997 speech before our Association.

Judge Rich put it thusly: "I have a suggestion for something this association should start thinking about. Although I have no plans for retiring, or taking senior status, or indulging in assisted suicide, any one of which would create a vacancy on my court [the Federal Circuit], nobody lives forever and finding a suitable nominee takes time - not to mention working up support. It would please me to know you were putting your best efforts behind finding me a successor."

Two years later, Judge Rich passed away at age 95, putting him in the record books as the longest-lived active federal judge in the history of our nation

Judge Rich's and Judge Conner's ideas regarding succession planning have new meaning in light of Chief Judge Paul R. Michel's recent announcement that he will retire from the Federal Circuit in May 2010.

Perched squarely on the shoulders of giants of our Association, our members can provide a clear vision from a unique vantage-point for next generation candidates to serve on the federal bench, including those qualified to fill the upcoming vacancy on the Federal Circuit. Doubtless that's what Judges Rich and Conner envisioned. Thankfully, we can too.



NYIPLA Annual Dinner in Honor of the Federal Judiciary

March 26, 2010

Waldorf=Astoria Hotel

Keynote Speaker

Governor Mario Cuomo

Outstanding Public Service Recipient

Honorable Richard Linn

Join the Tradition!

Reservation forms available at: www.nyipla.org

Reply by: February 9, 2010

For more information: (201) 634-1870

CLE Programs

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

On September 16, 2009, the NYIPLA Committee on Meetings and Forums presented a Continuing Legal Education ("CLE") luncheon program at the Harvard Club regarding Developments at and Tips for Working with the Board of Patent Appeals and Interferences. The speaker was Judge Michael R. Fleming, Chief Administrative Patent Judge of the United States Patent and Trademark Office and was hosted by Cheryl H. Agris, Principal of the Law Offices of Cheryl H. Agris, PhD, PC.

Cheryl H. Agris and Hon. Michael R. Fleming

Judge Fleming provided a wealth of useful and timely materials. Several practice tips were provided for preparing appeal briefs. He emphasized that it was important to point out where in appellants' view the patent examiner erred. Further, information regarding the potential impact of *KSR v. Teleflex* and *Bilski v. Doll (Kappos)* on appellate practice was provided. Judge Fleming also discussed when it would be useful to request an oral argument and provided tips for preparing for this event. He reminded the audience that it is not necessary to come to Alexandria and that oral arguments may be presented via an "Electronic Hearing Room".

The program concluded with a discussion of recent trends in appeal briefs filed. Judge Fleming noted that there has been a large increase, particularly with respect to reexaminations. However, due to the hiring freeze, pendency of appeal briefs at the Board of Patent Appeals and Interferences will be increased from 6.4 months to as many as 14 months in 2010.

CALL FOR MEMORABILIA

The Committee on Records is seeking publications, photographs, records, and other Association documents and materials (even the golf trophy!) for contribution to the NYIPLA's archives. Please dig through your files and send items of interest to either of the co-chairs:

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CLE Programs

TOPIC: The Impact of Bankruptcy on Intellectual Property

On October 16, 2009, the NYIPLA Committee on Meetings and Forums hosted a CLE luncheon at the Harvard Club, presented by the Honorable Arthur J. Gonzalez, bankruptcy judge in the Southern District of New York. The program, entitled "The Impact of Bankruptcy on Intellectual Property", was well attended, drawing not only intellectual property practitioners but also bankruptcy attorneys and those from other disciplines.

Judge Gonzalez began the program by discussing various federal bankruptcy statutes and their relevance to intellectual property. He noted that intellectual property is part of the bankruptcy estate just like any other property. Also, like any other property, the trustee or debtor-in-possession can use, license, or dispose of its intellectual property.

Judge Gonzalez then conducted a detailed discussion of 11 U.S.C. §365 related to executory contracts. He observed that intellectual property licenses are executory contracts under the statute, and can be assumed or rejected in bankruptcy like other executory contracts. However, Congress added subsection (n) to the statute to provide intellectual property licensees certain rights and impose on the trustee (or debtor-in-possession) certain obligations. Judge Gonzalez brought out that a split exists among the circuits in interpreting an important provision of that statute.

Judge Gonzalez also discussed his unique experience of trying a patent case in his bankruptcy court which raised a number of non-bankruptcy issues and challenges.

Judge Gonzalez closed the formal portion of his program by discussing recent trends in Chapter 11 cases. He noted that pendency has decreased significantly, and that companies have increasingly utilized asset sales under 11 U.S.C. §363. The General Motors and Chrysler bankruptcies (Judge Gonzalez presided over the Chrysler case) are recent examples of this.

The program concluded with an extended question and answer session with the audience.

Hon. Arthur J. Gonzalez, Kevin Reiner, Esq.

ARTICLES

The Association welcomes articles of interest to the IP bar.

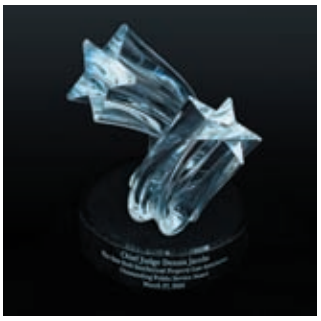
Please direct all submissions by e-mail to:

Stephen J. Quigley, **Bulletin Editor, at**

squigley@ostrolenk.com

History of the Outstanding Public Service Award

When Judge Richard Linn receives the NYIPLA Outstanding Public Service Award on March 26 at the Waldorf=Astoria, he will join an illustrious roster of recipients. The Association began giving the award in 2003 when it was awarded to the late Hon. William C. Conner of the United States District Court for the Southern District of New York. For the past eight years, the Association has chosen its recipients in recognition of a lifetime dedicated to the pursuit and administration of justice. Judge Linn will be the fourth recipient from the Federal Circuit. Two judges from the Second Circuit and two from the Southern District of New York have received the award.



Last year, Judge Dennis Jacobs, Chief Judge of the United States Court of Appeals for the Second Circuit, received this award.

Recipients of the Outstanding Public Service Award

2009	Honorable Dennis Jacobs	Second Circuit
2008	Honorable Howard T. Markey (posthumously)	Federal Circuit
2007	Honorable Paul R. Michel	Federal Circuit
2006	Honorable Joseph M. McLaughlin	Second Circuit
2005	Honorable Pauline Newman	Federal Circuit
2004	Honorable Robert J. Ward (posthumously)	Southern District of NY
2003	Honorable William C. Conner	Southern District of NY

Nineteen Hundred and Twenty-two
NYIPLA
The New York Intellectual Property Law Association®

A CALL FOR NOMINATIONS
FOR THE 2010 NYIPLA
INVENTOR OF THE YEAR AWARD

Each year, the New York Intellectual Property Law Association presents the *"Inventor of the Year Award"* to pay tribute to an individual or group of individuals who, through their inventive talents, have made worthwhile contributions to society by promoting "the progress of Science and useful Arts."

We encourage you to nominate one or more candidates. The Inventor of the Year Award enables the Association to extend recognition to deserving innovators and inventors, and promote the practice of intellectual property law.

In order to be eligible for the Award, nominees must have received one or more U.S. patents for his / her / their invention(s) contributing to modern society. A nomination form for submitting candidates may be obtained from the Association website (**NYIPLA.org**) . Please forward your nominations no later than **January 28, 2010**. Please see the nomination form or the Association website for further rules and information.

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