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Brunda, Bruce B., *Resolution of Patent Disputes By Non-Litigation Procedures* This article promotes the use of mediation, arbitration, and other non-litigation dispute resolution procedures to obtain a settlement, or other resolution of a patent controversy. The principal attributes and advantages of a number of non-litigation procedures are considered.	15	2 & 3	73	1987
Janicke, Paul M. & Roger S. Borovoy, *The Minitrial Approach to Resolving Patent Disputes* This article discusses how arbitration and mediation were used to reduce the complexity and expense of patent trials in *Shell v. Intel* and *Telecredit v. TRW*, respectively.	11	4	258	1983
Madson, Craig J., *Arbitration of Franchise Agreement Disputes* Including a well-conceived arbitration plan in a franchise agreement will combine the judicial safeguards of litigation with the cost-and-time-efficiency of private agreements between parties. This approach can also preserve ongoing cooperative business relationships, if done properly and both parties understand the agreement.	11	4	298	1983
Manbeck, Harry F., Jr., *Voluntary Arbitration of Patent Disputes -- The Background to 35 U.S.C. 294* The 1982 endorsement, by the 97th Congress, of voluntary binding arbitration -- embodied in statute at 35 U.S.C. § 294 -- should provide a stimulus for more arbitration of patent validity questions in the patent system.	11	4	268	1983
Pegram, John B., *An Analysis and Explanation of the Statutes Now Affecting Patent Arbitration*	11	4	274	1983

This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Appellate Practice

Banner, Mark T., *Frivolous Appeals and Attorney Fee Awards: The Federal Circuit Gets Serious With A Serious Problem* 13 3 & 4 318 1985

In the Federal Circuit, appeals will result in sanctions without a showing of "bad faith." This article discusses several cases that further delineate the Federal Circuit's treatment of frivolous appeals.

Chambers, J. Robert, *Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit* 13 3 & 4 361 1985

This article addresses the role of the jury in patent trials. The author examines decisions of the Federal Circuit in its first three years, focusing first on the issue of obviousness, and concluding with an analysis of other issues, including infringement, the section 112 defenses, inequitable conduct, and damages.

Goldstein, Jack C., *The Federal Circuit's Appellate Jurisdiction Over Federal District Court Patent Cases: The First Three Years* 13 3 & 4 271 1985

This article discusses three major issues related to the Federal Circuit's jurisdiction over patent cases, including the "finality" of the district court's decision (and the statutory or case law exceptions to, or expansions of, the final judgment rule); the district court's patent law jurisdiction under 28 U.S.C. section 1338(a) (1982); and the "in whole or in part" aspect of 28 U.S.C. section 1295(a)(1) (1982).

Re, Joseph R., *Federal Circuit Jurisdiction Over Appeals From District Court Patent Decisions* 16 2 169 1988

ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review 18 2 155 1990
This article examines how imported products can be challenged in dual path litigation involving the same parties and the same rights in both civil court and before the ITC. The article reviews the status of these jurisdictional issues, as well as issues concerning res judicata and appellate review. The author encourages changes that are responsive to, and in conformance with, U.S. jurisprudence.

Attorney-Client Privilege

Battersby, Gregory J. & Charles W. Grimes, *The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer* 15 2 & 3 231 1987
This article explores how attorney-client privilege and work-product immunity have been applied in the patent arena, particularly by counsel for an accused patent infringer. The author recognizes that the patent attorney is increasingly gaining recognition as performing a legal function, and the trend appears to be that application of the privileges will become more expansive.

DeGrandi, Joseph A., *The Attorney Client Privilege in Client Solicitation* 12 2 114 1984
This article deals with the scope of the attorney-client privilege as applied specifically to the patent field, primarily from the point of view of the private practitioner dealing with clients, both individual and small companies and corporations which do not have in-house patent counsel. The author has revised and updated the article which first appeared in AIPLA Quarterly Journal, Vol. 3, No. 2 (1975), taking into account the numerous decisions involving attorney-client privilege as it relates to patents.

DeVito, Daniel A. & Michael P. Dierks, *Exploring Anew the Attorney-Client Privilege and Work-Product Doctrine in Patent Litigation: The Pendulum Swings Again, This Time in Favor of Protection* 22 2 103 1994
This article discusses the developments of discovery privileges in the context of patent prosecution material, and submits that such protection is justified.

Einhorn, Harold, *The Control Group Problem*

in cases involving charges of inequitable conduct in the PTO when the alleged wrongdoer is the patent solicitor. There is pressure, then, to make the attorney a material fact witness. If the attorney does not testify, opposing counsel may raise a negative inference from the failure of the attorney to testify. The article explores this adverse inference rule.

Attorney Discipline

Lipman, Steven E., *Prosecution of Practitioners for Violation of the P.T.O. Code of Professional Responsibility: Facing the Realities of Losing Your License* 14 2 119 1986

This article discusses the ramifications of the apparent increased activity of the U.S. Patent and Trademark Office in matters of discipline since the promulgation in 1985 of its new Code of Professional Responsibility, the expansion of its procedures for the conduct of disciplinary proceedings for violations of that Code, and the establishment of its new Office of Enrollment and Discipline to investigate and prosecute those violations.

Biotechnology

Boehnen, Daniel A. & Steven J. Sarussi, *Relationships that Exist Between Patent Disputes and FDA Approval Dates Under the Drug Price Competition and Patent Term Restoration Act of 1984* 17 1 67 1989

The Drug Price Competition and Patent Term Restoration Act of 1984 governs the procedures for gaining FDA approval of generic drugs. Certain provisions of this Act can affect when the generic drug will be approved. The article focuses on the situation when the generic drug company alleges that the pioneer drug company's patent is either invalid or non-infringed. In this situation, the approval date can be affected by the relationship between the generic drug application and the patent protecting the listed drug, or the relationship among multiple generic drug applications. The article discusses these relationships and their effects on the approval of generic drugs.

Brinton, Joyce, *Biotechnology Licensing: Issues From the University Perspective* 16 3 & 4 479 1988

system. The article compares traditional Jewish law to U.S. law regarding protection to inventions of living matter.

Kraus, Heidi L., *A Different New Matter Standard for Biotechnology patent Applications Accompanied By a Deposit* 25 1 101 1997
This article discusses whether a biological deposit can and should overcome a deficiency in the disclosure of a biotechnology patent application due to material error, so that the error can be corrected without adding new matter. The article contends, that in certain cases, a biological deposit may render material errors inconsequential because the error would be obvious, to one skilled in the art, upon examination of the deposit. The article proposes a different new matter standard for biotechnology applications that are accompanied by a deposit.

Lentz, Edward T., *Adequacy of Disclosures of Biotechnology Inventions* 16 3 & 4 314 1988
The author discusses the rule on adequacy of disclosure of a patent application and how it should be applied to biotechnology inventions.

Murashige, Kate H., *Section 102/103 Issues in Biotechnology Patent Prosecution* 16 3 & 4 294 1988
This article explores the obviousness standard in biotechnology cases, attempting to provide guidance because obviousness is an inherently subjective standard. The article includes suggestions for overcoming the putative prima facie case.

Rohrbaugh, Mike L., *The Patenting of Extinct Organisms: Revival of Lost Arts* 25 3 371 1997
This article assesses the patentability of regenerated organisms, after being extinct in nature, under utility patent provisions. It provides insight into how the technology of regenerating formerly extinct organisms relates to, and is consistent with, the patentability requirements of statutory subject matter, utility, novelty, and non-obviousness.

Seay, Nicholas J., *Protecting the Seeds of Innovation: Patenting Plants* 16 3 & 4 418 1988
This article focuses on "unique" issues, problems and alternatives in the intellectual property law of plant biotechnological intentions.

Smith, G. Kenneth & Denise M. Kettleberger,

personnel, and the agency's journal entitled *China Patents and Trademarks*.

Jinqing, Zhu and Wu Sun, *Criteria of Patentability and Scope of Protection of the Chinese Patent Law* 13 2 116 1985

This article discusses the focus of the Chinese patent law. It discusses the particular criteria of patentability, and the restrictions on certain technical fields that China elected to adopt.

Lin, Maria C.H., *The Patent Law of the People's Republic of China* 13 2 107 1985

This article describes the background against which the Chinese patent system was developed. The author discusses how elements of the cultural revolution influenced the Chinese government to borrow from western models to modernize the legal framework that governs the technological industry.

Mingzheng, Hu, *General Characteristics of the Chinese Patent Law* 13 2 129 1985

This article summarizes the original Chinese patent laws. Areas highlighted include patents for inventions, utility models and designs, principles of national treatment and right of priority, right to apply for patent and right to patent, and the patentee's rights and obligations.

Yaozeng, Shen, *On the System for Granting Patents in China* 13 2 112 1985

This article offers a brief explanation of the system for the granting of patents for inventions in China. First, the author describes why China decided to choose an "examination" system, rather than a "registration" system. The author then describes the features and specifics of the Chinese system.

Yiping, Xu, *The Practice of Foreign Related Patent Prosecution of the Shanghai Patent Agency* 13 2 136 1985

This article describes the organization and functions of the third Chinese foreign-related patent agency, the Shanghai Patent Agency.

Zhengfa, Wang, *CCPIT Patent Agency* 13 2 123 1985

CCPIT is one of the foreign-related patent agencies designated by China. This article describes the organization and functions of this agency.

of the growing worldwide consensus in favor of protection of computer programs under traditional copyright principles. The authors also comment on how familiar, often rejected arguments against such copyright protection appear to underlie the current quest for the certainty of a defined "interface" between copyright and patent.

Hollaar, Lee A., *Justice Douglas Was Right: The Need for Congressional Action on Software Patents* 24 1 283 1996

Congress is in the best position to amend the patent law to provide three clear guidelines regarding patents of computer software: establish that computer processes are in fact patentable, protect "method" patent holders from distributors of those methods, and exclude information which has been stored in obvious ways from any novelty determination.

Jordan, Richard A., *On the Scope of Protection for Computer Programs Under Copyright* 17 3 199 1989

This article contains a discussion of the proper scope of copyright protection for both non-visual and visual aspects of computer programs.

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985

This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Laurie, Ronald S., *Comment: Use of a "Levels of Abstraction" Analysis for Computer Programs* 17 3 232 1989

This article suggests that Judge Learned Hand's "levels of abstraction" approach should be used to determine where a computer program lies on the conceptual idea-expression

property protection. First, the article summarizes the (then) current state of patent/copyright interface. The article then outlines various strategies for analyzing an interface situation. Finally, the article discusses the basic principles of intellectual property law.

Stephens, Keith & John P. Sumner, *Patenting Software Objects and Other Aspects of Object-Oriented Programs Under the New PTO Guidelines* 23 2 221 1995

The purpose of this article is to inform the software industry of the availability and advantages of patenting object-oriented software, not only generally, but with respect to software objects. The article also reviews how courts have addressed the patentability of software objects, and predicts how courts will address the issue in the future.

Stern, Richard H., *On Defining the Concept of Infringement of Intellectual Property Rights in Algorithms and Other Abstract Computer-Related Ideas* 23 3 401 1995

This article extrapolates from the concepts of copyright infringement and patent infringement under existing law, to define a concept of infringement of intellectual property rights in computer-related abstract ideas, such as algorithms, data structures, computerized methods of doing business, programming languages, and instructions sets.

Sumner, John P. & Steven W. Lundberg, *Patentable Computer Program Features As Uncopyrightable Subject Matter* 17 3 237 1989

This article demonstrates that, both with respect to "computer programs" as defined in the Copyright Act and with respect to user interface features, a clearly definable interface exists between copyright law and utility patent law. This interface can be used in virtually all fact situations to properly determine and limit the scope of copyright protection, thus leaving the protection of functional, utilitarian features to the utility patent system, as intended by Congress. A line can be drawn between the functional, utilitarian features of software and the non-functional, copyrightable aspects of software. The article further demonstrates that the functional, utilitarian features should receive protection exclusively from utility patents, or trade secrets, but should receive no protection from copyright law.

technical data. Next, it explains why the concept of "circumstantially relevant business information" actually provides a better description of what it is that businesses are concerned about "losing" to competitors than the often misused expression "trade secrets." Then, it looks at the reasons why we believe that circumstantially relevant business information is being given out by government agencies on a regular basis. Finally, it outlines the various policy arguments in favor of rapid dissemination of business information contained in agency records, especially information having to do with marketing information.

Constitutional Law

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985

This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Parrett, Sherman O., *The Expanded Authority of U.S. Magistrates: Has Congress Exceeded Constitutional Limits?* 12 3 212 1984

This article analyzes the constitutionality of the expanded powers of U.S. Magistrates, who do not have life tenure or undiminishable salaries. Under current law, U.S. Magistrates, upon consent of the parties, have the authority to try civil cases and enter judgments. The U.S. Court of Appeal for the First, Second, Third, Fifth, and Ninth Circuits have held this procedure to be constitutional. This article concludes, however, that the procedure is unconstitutional in view of relevant Supreme Court decisions.

Copyright

Abrahamson, Jeffrey, *Tuning Up for a New Musical Age: Sound Recording Copyright Protection in a Digital Environment* 25 2 181 1997

Laurie, Ronald S., *Comment: Use of a "Levels of Abstraction" Analysis for Computer Programs* 17 3 232 1989
This article suggests that Judge Learned Hand's "levels of abstraction" approach should be used to determine where a computer program lies on the conceptual idea-expression spectrum. The author criticizes the usual analysis of program similarities and differences as superficial and the "rules" used as gratuitous. He further urges judges to appreciate which elements in the process programmers regard as creative or stylistic and which they regard as standard, routine, banal, trivial, mechanical, or functionally dictated. The author hopes that by using this process, the scope of protection for various types of computer programs will become more clearly defined.

Long, Doris E., *Copyright and the Uruguay Round Agreements: A New Era of Protection Or An Illusory Promise?* 22 3 & 4 531 1994
This article explores the history of the Uruguay Round negotiations concerning copyright. The article then examines the portions of TRIPS and the Uruguay Round Agreements Act that concern the protection of copyrightable works. Further, the article examines whether TRIPS and the Uruguay Round Agreements Act will likely foster an era of international copyright protection.

Merges, Robert P., *Are You Making Fun of Me?: Notes on Market Failure and the Parody Defense in Copyright* 21 4 305 1993
This article discusses *Campbell v. Acuff-Rose* and the fundamental issues of copyright law the case raises.

Pilarski, John H., *User Interfaces and the Idea-Expression Dichotomy, Or, Are the Copyright Laws User Friendly?* 15 4 325 1987
While it appears that courts have differing conceptions of "idea" and "expression," the article's thesis is that the decisions are consistent when viewed in light of the purposes and policies of the copyright system. It must be noted that courts have the difficult task of balancing conflicting policies -- providing incentives to innovation through copyright protection, and encouraging progress through the free exchange of ideas. The article reviews court decisions addressing the idea of expression dichotomy in cases involving user interfaces.

faithful to the existing copyright statute and its policies, and is comprehensive enough to deal with the wide variety of computer-generated works.

Copyright -- International

Arden, Thomas P., *The Conflicting Treatments of Compilations of Facts Under the United States and British Copyright Laws* 19 4 268 1991

This article explores the divergence between the United States and British copyright laws concerning the protection of compilation of facts. It focuses on the change in the U.S. approach which began in 1991 with the Supreme Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Company.*

Long, Doris E., *Copyright and the Uruguay Round Agreements: A New Era of Protection Or An Illusory Promise?* 22 3 & 4 531 1994

This article explores the history of the Uruguay Round negotiations concerning copyright. The article then examines the portions of TRIPS and the Uruguay Round Agreements Act that concern the protection of copyrightable works. Further, the article examines whether TRIPS and the Uruguay Round Agreements Act will likely foster an era of international copyright protection.

Spector, David M., *Implications of the United States Adherence to the Berne Convention* 17 2 100 1989

This article analyzes how the Berne Convention of 1988 will affect not only companies selling, licensing, or distributing copyrighted works in other Berne member states, but also those doing so within the United States. Section II of the article summarizes copyright protection available overseas for works first published in the United States prior to the implementation of the Convention. Section III outlines some important Berne Convention rights and discusses the major advantages and disadvantages of U.S. adherence to Berne considered by Congress. Sections IV and V explore the impact on U.S. copyright law of the Berne prohibition against statutory formalities, and section VI examines the application of the Berne Convention to works and legal claims existing prior to the effective date of United States adherence. Finally, section VII discusses important

Samuelson, Pamela, *Survey on the Patent/ Copyright Interface for Computer Programs* 17 3 256 1989
In the fall of 1988, AIPLA surveyed its members on a set of issues relevant to the patent/copyright interface for computer programs. This article reports the author's analysis of the results of the survey. The survey results showed that there is a significant degree of exclusivity between patent and copyright law. There was, however, disagreement about whether the two laws are completely mutually exclusive, or overlap to some degree.

Smith, Richard, E. Robert Yoches & John F. Hornick, *Guide for the Perplexed: Where is the Problem and What We Do Until It is Solved* 17 3 215 1989
This article suggests that there is no need to fear a drastic divergence from well-accepted strategies for intellectual property protection. First, the article summarizes the (then) current state of patent/copyright interface. The article then outlines various strategies for analyzing an interface situation. Finally, the article discusses the basic principles of intellectual property law.

Sumner, John P. & Steven W. Lundberg, *Patentable Computer Program Features As Uncopyrightable Subject Matter* 17 3 237 1989
This article demonstrates that, both with respect to "computer programs" as defined in the Copyright Act and with respect to user interface features, a clearly definable interface exists between copyright law and utility patent law. This interface can be used in virtually all fact situations to properly determine and limit the scope of copyright protection, thus leaving the protection of functional, utilitarian features to the utility patent system, as intended by Congress. A line can be drawn between the functional, utilitarian features of software and the non-functional, copyrightable aspects of software. The article further demonstrates that the functional, utilitarian features should receive protection exclusively from utility patents, or trade secrets, but should receive no protection from copyright law.

Copyright Law Revision

Hollaar, Lee A., *Justice Douglas Was Right: The Need for Congressional Action on Software Patents* 24 1 283 1996

Practical uses of on-line databases for an international patent searcher include obtaining English-language versions of foreign-language reference publications; performing world-wide searches; supplementing "manual" novelty searches with global data; and rapidly obtaining information about a party's patent holdings for a particular technology.

Damages

Bolan, Robert O. & William C. Rooklidge, *Imputing Knowledge to Determine Willful Patent Infringement* 24 1 157 1996

Imputing knowledge of an employee to that employee's corporation in cases of willful patent infringement should only occur following the standards of agency law: where the employee has actual knowledge of the patent, understands its importance, and has a duty to report his or her knowledge to the corporation.

Brown, Harold R. III, *Proof of Lost Profits Damages Following Rite-Hite v. Kelley* 23 4 577 1995

This article first summarizes key points of the *Rite-Hite* decision. It then provides a review of Federal Circuit decisions relating to proof of lost profits damages generally.

Chambers, J. Robert, *Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit* 13 3 & 4 361 1985

This article addresses the role of the jury in patent trials. The author examines decisions of the Federal Circuit in its first three years, focusing first on the issue of obviousness, and concluding with an analysis of other issues, including infringement, the section 112 defenses, inequitable conduct, and damages.

Conley, Ned L., *An Economic Approach to Patent Challenges* 15 4 354 1987

This article examines some of the concepts and criteria which have been used by the courts in arriving at damages awards in patent infringement cases. The author suggests some approaches which might be used by litigants to influence a desirable result with respect to basic damages or reasonable royalty awards.

Frank, Peter B. & Michael J. Wagner, *Computing Lost Profits and Reasonable*

Product Configurations: Is There a Conflict With Patent Policy? 24 2, 3, 4 427 1996
This article explains the purposes of trade symbol protection and how standard trademark doctrine helps to protect the integrity of patent policy. The author insists that no great changes in existing trade dress doctrine are required to accommodate product configurations as trade dress.

Fryer, William T., III, *Design Patent System for the Twenty-First Century* 24 2, 3, 4 331 1996
The focus of this article is to identify improvements in the design patent system structure that will make it a better form of protection for the twenty-first century. The primary proposal is to add a system for early publication for design patent applications, with a provisional right to damages. Another recommendation is to provide a shorter route to infringement and patentability determinations for design applications.

Goffney, Lawrence J., Jr., *The New Patent and Trademark Paradigm for Design Patents* 24 2, 3, 4 317 1996
A review of the national design protection and a call for a more comprehensive international protection in the face of new computer technologies. The author insists that in this new computer age, countries will have to cooperate in this effort.

Marcus, Harry C. & Mark J. Abate, *Design Patent Infringement Put to Sea Without Guiding Charts* 22 2 135 1994
This article discusses design patent case law, argues that a recent Federal Circuit case was flawed, and urges the reaffirmation of a requirement of objective evidence to prove patent infringement under the design analog to the doctrine of equivalents.

Rangel-Ortiz, Dr. Horacio, *The Law of Designs: Mexican Legal System and TRIPS* 24 2, 3, 4 753 1996
This article examines Mexican Law from three different perspectives: (1) protection of industrial designs based on provisions of the industrial-property statutes that have governed the protection of inventions and trademarks; (2) the relevant provisions contained in copyright statutes as well as a brief presentation on how design law has developed since the Mexican Congress passed the first

Manufacture With Color 24 2, 3, 4 409 1996
A discussion of the PTO's recent consideration about whether to modify the regulations to permit color photographs and/or color drawings in lieu of formal drawings in design cases. This would protect color in combination with an article of manufacture.

Doctrine of Equivalents

Bardehle, Heinz, *Equivalents and International Patent Law Harmonization* 20 2 119 1992
This article advocates the need for worldwide codification and harmonization of the Doctrine of Equivalents. The article examines the World Intellectual Property organization's initiative on protection scope and claim interpretation, and urges for the full support of such an initiative.

Janicke, Paul M., *Heat of Passion: What Really Happened in Graver Tank* 24 1 1 1996
Examining the history and application of the Doctrine of Equivalents in patent law provides strong evidence in favor of abolishing the doctrine. Even if the doctrine is maintained in the fields of chemistry and biology (where broadened reissues will not prevent unscrupulous claims), judicial intervention should be a valid remedy in those areas.

Larson, Ronald E., *Balancing the Competing Policies Underlying the Doctrine of Equivalents in Patent Law* 21 1 1 1993
This article discusses the current standards for the Doctrine of Equivalents and why they are inadequate. The article then discusses the fundamentals of functional cooperation analysis. The article proposes functional cooperation analysis as a basis for explaining and harmonizing the Federal Circuit opinions interpreting equivalents.

Parker, Henrik D., *Doctrine of Equivalents Analysis After Wilson Sporting Goods: The Hypothetical Claim Hydra* 18 3 262 1990
This article discusses how the Federal Circuit, in *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, has explicitly dictated an entirely new and complex test for determining whether or not a patent claim is infringed under the Doctrine of Equivalents.

Preston, Albert W., Jr. & Dianne B. Elderkin,

find his or her conduct adjudged as lacking candor and good faith.

Baechtold, Robert L., *I'm Just Wild About Harry* 20 3 & 4 185 1992
This article comments on the motivation and analytical framework of the driving force behind the changes to the new Rule 56.

Bolan, Robert O. & William C. Rooklidge, *Imputing Knowledge to Determine Willful Patent Infringement* 24 1 157 1996
Imputing knowledge of an employee to that employee's corporation in cases of willful patent infringement should only occur following the standards of agency law: where the employee has actual knowledge of the patent, understands its importance, and has a duty to report his or her knowledge to the corporation.

Hoffman, Gary M. & Michael C. Greenbaum, *The Duty of Disclosure Requirements* 16 1 124 1988
This article outlines the positions of the courts and the PTO regarding the duty of disclosure requirement. It also sets forth procedures which attorneys and agents can follow to comply with the new requirements.

Lentz, Edward T., *Adequacy of Disclosures of Biotechnology Inventions* 16 3 & 4 314 1988
The author discusses the rule on adequacy of disclosure of a patent application and how it should be applied to biotechnology inventions.

Lynch, John F., *New Rule 56: The Second Time Around* 20 3 & 4 144 1992
This article comments and observes the implications of the new Rule 56 and offers the best way practitioners might adjust their procedures in light of the new provisions. This article suggests that the new provisions will generate new issues and arguments of unenforceability, thrusting fraud and inequitable conduct to the forefront of patent litigation.

Manbeck, Harry F., Jr., *The Evolution and Issue of New Rule 56* 20 3 & 4 136 1992
This article sheds light into the evolution of Rule 56, the issues related to the rules various incarnations, and highlights several AIPLA recommendations.

Tegtmeyer, Rene D., *The Patent and Trademark Office View of Inequitable*

This article surveys traditional approaches to protecting confidential business information and suggests a supplementary approach through employee handbook provisions drafted with the employer's interests in mind. The article then examines how and why employee handbooks should be harmonized with individual employment contracts for key employees. The article also examines the special problems confronting an employer when an employee is terminated.

McDaniel, Terry B., *Shop Rights, Rights in Copyrights, Supersession of Prior Agreements, Modification of Agreement, Right of Assignment and Other Contracts* 14 1 35 1986

This article suggests sample clauses of the employment agreement relating to shop rights, ownership of copyrights, the superseding effect of the agreement on previous agreements, modification of the agreement, assignment rights, and employee warranties related to conflicting agreements. The intent here is to apprise the reader of the types of clauses and the nature of specific clauses for consideration for inclusion in employment agreements.

Sayko, Andrew F., Jr., *New and Terminating Employees* 14 1 49 1986

This article discusses the constraints that can be placed on an employee by an employer when the employee changes jobs. The article also discusses statutorily defined inventions that an employee cannot be required to assign to his employer.

Essential Facilities Doctrine

Donahey, Teague I., *Terminal Railroad Revisited: Using the Essential Facilities Doctrine to Ensure Accessibility to Internet Software Standards* 25 2 277 1997

This article argues that the next version of computer operating system, which is in the process of being intertwined with Internet browser software, will be analogous to the railroad industry of the late 1800s in that the market will be subject to a natural monopoly due to substantial economies of scale. For this and other reasons, the essential facilities doctrine, a creative antitrust remedy emanating from *United States v. Terminal Railroad Ass'n of St. Louis*, 224 U.S. 383 (1912), would be a particularly useful and appropriate solution to many of the competition-related

background of the provision and the significance of it. The author advocates adoption of the Treaty.

Rackman, A.C., *The Patents County Court in the United Kingdom* 20 2 112 1992
This article focuses on the Patents County Court (PCC) established in the United Kingdom in 1990 by virtue of the Copyrights, Designs, and Patents Act of 1988.

Weissman, Peter, *Computer Software As Patentable Subject Matter: Contrasting United States, Japanese, and European Laws* 23 3 525 1995
This article explores the current state of the law regarding computer-related technologies as patentable subject matter in the United States, Japan, and Europe. It analyzes the effects of these laws, and provides a brief comparison and analysis among the different nations.

European Patent Office

Holm, Chris L., *Patent Prosecution Comparison Between the United States Patent and Trademark Office and the European Patent Office* 25 2 233 1997
This article examines four specific questions: (1) Is there a significant difference in the average prosecution time from the application filing date to the grant date for applications filed in the U.S. Patent Trademark Office ("PTO") as compared with the European Patent Office ("EPO"), and what is the average term of protection following a patent grant by the EPO?; (2) Are there significant differences (as in the U.S.) in the average EP prosecution times from the application filing date to the grant date for chemical, electrical, and general applications?; (3) Is there a significant difference time from the application filing date to the grant date for applications that claim a U.S. priority as compared to applications that do not claim a U.S. priority?; and (4) Does an early demand or a late demand have a significant effect on the time from application filing date to grant date for EPO applications?

European Union

Dinwoodie, Graeme B., *Federalized Functionalism: The Future of Design Protection In the European Union* 24 2, 3, 4 611 1996
An examination of European Union intellectual property law and the European Commission's proposals which would

the mark, trademark infringement, and other trademark issues.

Sutton, John P., *The Fact-Law Dichotomy in Trademark Cases* 12 4 310 1984
This article deals with the likelihood of confusion of the fact/law dichotomy. It also examines specific facts underlying the likelihood of confusion, as well as how this dichotomy is handled by the Federal Circuit and the Supreme Court.

Federal Adjudication -- Appellate Level

Rich, Giles S., *Thirty Years of This Judging Business* 14 3 139 1986
This article is an autobiographical account of Chief Judge Rich's highlighted experiences at the United States Court of Appeals for the Federal Circuit (CAFC), covering the last 30 years. Major topics include CCPA contributions, panel size, the standard of review, suggestions for En Banc, and the CAFC's internal decision review system.

Federal Agencies

Braverman, Burt A. & Frances J. Chetwynd, *Submitters Beware: The Perils of FOIA - Implementing Regulations* 12 1 33 1984
This article examines some of the more prevalent procedures employed by federal agencies in receiving and processing FOIA requests for confidential business information. It considers the distinctions among agencies' applications of those procedures, and the resulting lack of consistency, predictability and safeguards of submitter's rights which characterized the FOIA decision-making process in which the confidentiality of business information is determined. Finally, it concludes that agencies themselves cannot be expected to correct this condition and suggests that the solution can be found only in a comprehensive legislative declaration of submitter's rights.

Federal Circuit

Banner, Mark T., *Frivolous Appeals and Attorney Fee Awards: The Federal Circuit Gets Serious With A Serious Problem* 13 3 & 4 318 1985
In the Federal Circuit, appeals will result in sanctions without a showing of "bad faith." This article discusses

Gholz, Charles L., *Choice of Law in the United States Circuit Court of Appeals for the Federal Circuit* 13 3 & 4 309 1985
This article deals with the question of what law (both procedurally and substantively) the Federal Circuit should apply to non-patent aspects of patent appeals. The author proposes that the Court of Appeals for the Federal Circuit should not be bound by the law of the Circuit in which the district court/trial court is located, but rather should treat the law of all Circuits equally under the doctrine of comity.

Goldstein, Jack C., *The Federal Circuit's Appellate Jurisdiction Over Federal District Court Patent Cases: The First Three Years* 13 3 & 4 271 1985
This article discusses three major issues related to the Federal Circuit's jurisdiction over patent cases, including the "finality" of the district court's decision (and the statutory or case law exceptions to, or expansions of, the final judgment rule); the district court's patent law jurisdiction under 28 U.S.C. section 1338(a) (1982); and the "in whole or in part" aspect of 28 U.S.C. section 1295(a)(1) (1982).

Korniczky, Stephen S. & Don W. Martens, *Verdict Forms -A Peek into the "Black Box"* 23 4 617 1995
This article discusses use of special verdicts and written interrogatories under Rule 49 of the Federal Rules of Civil Procedure and how proper use of these devices can alleviate concerns normally associated with jury trials in patent cases.

Larson, Ronald E., *Balancing the Competing Policies Underlying the Doctrine of Equivalents in Patent Law* 21 1 1 1993
This article discusses the current standards for the Doctrine of Equivalents and why they are inadequate. The article then discusses the fundamentals of functional cooperation analysis. The article proposes functional cooperation analysis as a basis for explaining and harmonizing the Federal Circuit opinions interpreting equivalents.

Lewis, Jeffrey I.D., *Curing Double Patenting During Prosecution and After Issuance: When Once is Never Enough and Twice is Too Much* 21 1 34 1993
This article discusses double patenting. The article covers five double patenting decisions from the U.S. Court of Appeals for the Federal Circuit.

Reiss, Steven M., *Applying the Effects Test Theory of Personal Jurisdiction in Patent Infringement Actions* 23 1 99 1995
This article examines the basis for the effects test theory, its application in intellectual property cases, and how it may be applied by the Federal Circuit.

Tao, Jerome T., *An Examination of the Federal Circuit's Multi-Tiered Review of Patent Obviousness* 20 2 84 1992
This article reviews the Federal Circuit's multi-tiered approach to determinations of obviousness. The article concludes that the classification of obviousness as an issue of law is the most judicially sound and practical approach possible.

Wright, Bradley C., *Supplemental Claim Jurisdiction in the United States Court of Appeals for the Federal Circuit* 22 2 235 1994
This article reviews the circumstances under which the Court of Appeals for the Federal Circuit will find subject matter jurisdiction over appeals involving "supplemental" claims in patent-related cases.

Federal Courts

Mintz, Herbert H. & Richard B. Racine, *Anticipation and Obviousness in the Federal Circuit* 13 3 & 4 171 1985
This article examines the Federal Circuit's development of the law of anticipation and obviousness under 35 U.S.C. sections 102 and 103. Because application of section 102 precludes proof of certain facts which could establish non-obviousness, such as unexpected results and the so-called "secondary considerations," the distinction between sections 102 and 103 can be decisive. The article also warns that given the trend reflected in cases dealing with the law on public use and sale or offer to sell, inventors and the companies for which they work must pay close attention to activities which ultimately may be construed as these events -- events that can lead to forfeiture of the right to patent the discoveries embodied by these actions.

Federal Practice

Casey, Kevin R., *"Infectious Unenforceability:" The Extent Or Reach of Inequitable Conduct*

Procedure and how proper use of these devices can alleviate concerns normally associated with jury trials in patent cases.

Franchising

Madson, Craig J., *Arbitration of Franchise Agreement Disputes* 11 4 298 1983
Including a well-conceived arbitration plan in a franchise agreement will combine the judicial safeguards of litigation with the cost-and-time-efficiency of private agreements between parties. This approach can also preserve ongoing cooperative business relationships, if done properly and both parties understand the agreement.

Slade, Kenneth H., *Applicability of Franchise and Business Opportunity Laws to Distribution and Licensing Agreements* 15 1 1 1987
This article analyzes the scope of various franchise and business opportunity statutes and regulations, and explains the circumstances under which such rules can be applied to distribution and licensing agreements not generally thought to be franchises or business opportunities.

Fraud on the Patent Office

Amberg, Stanley L., *The PTO's New Duty of Disclosure/Fraud On the Patent Office Rules May Be a Trap for Unwary Practitioners* 20 3 & 4 163 1992
This article examines various provisions of the new Rule 56 and advises that practitioners who comply with the duty of disclosure requirements of the new rule may nevertheless find his or her conduct adjudged as lacking candor and good faith.

Baechtold, Robert L., *I'm Just Wild About Harry* 20 3 & 4 185 1992
This article comments on the motivation and analytical framework of the driving force behind the changes to the new Rule 56.

Casey, Kevin R., *"Infectious Unenforceability:" The Extent Or Reach of Inequitable Conduct On Associated Patents* 17 4 338 1989
A patent applicant's commission or omission of certain acts may constitute fraud or inequitable conduct on the Patent and Trademark Office ("PTO"). Courts will not enforce patents issued on applications obtained by inequitable conduct. However, if the conduct is not too egregious, patents associated with the tainted patent may still be

This article explores a different approach in the treatment of patent fraud by providing for a legislative option to remove patent fraud as a boilerplate from litigation, generate a balancing force to encourage early and voluntary prior art citation, and reserve patent fraud for the most egregious attempts at market domination.

Freedom of Information Act

Braverman, Burt A. & Frances J. Chetwynd, *Submitters Beware: The Perils of FOIA - Implementing Regulations* 12 1 33 1984

This article examines some of the more prevalent procedures employed by federal agencies in receiving and processing FOIA requests for confidential business information. It considers the distinctions among agencies' applications of those procedures, and the resulting lack of consistency, predictability and safeguards of submitter's rights which characterized the FOIA decision-making process in which the confidentiality of business information is determined. Finally, it concludes that agencies themselves cannot be expected to correct this condition and suggests that the solution can be found only in a comprehensive legislative declaration of submitter's rights.

Casey, William L., Jr., John E. Marthisen & Laurence S. Moss, *The Economic Impact of the Freedom of Information Act* 12 1 76 1984

This article examines the claim, voiced by the business sector, that federal disclosure policy under the Freedom of Information Act too often compromises trade secrets and technical data. Next, it explains why the concept of "circumstantially relevant business information" actually provides a better description of what it is that businesses are concerned about "losing" to competitors than the often misused expression "trade secrets." Then, it looks at the reasons why we believe that circumstantially relevant business information is being given out by government agencies on a regular basis. Finally, it outlines the various policy arguments in favor of rapid dissemination of business information contained in agency records, especially information having to do with marketing information.

O'Reilly, James T., *Trade Secrets: Asleep At the Switch?* 12 1 13 1984

Will Existing License Agreements Be Affected By Extended Patent Terms Under GATT 22 3 & 4 449 1994
This article examines the potential impact of GATT's extended patent terms on existing license agreements.

Irving, Thomas L. & Stacy D. Lewis, *Proving a Date of Invention and Infringement After GATT/TRIPS* 22 3 & 4 309 1994
This article discusses Uruguay Round amendments to Section 104 as well as the expanded definition of infringing activity under the Agreement.

Lemley, Mark A., *An Empirical Study of the Twenty-Year Patent Term* 22 3 & 4 369 1994
This article studies what the likely impact will be of the GATT provision that extends the length of time patentees receive protection for their patents in the United States.

Long, Doris E., *Copyright and the Uruguay Round Agreements: A New Era of Protection Or An Illusory Promise?* 22 3 & 4 531 1994
This article explores the history of the Uruguay Round negotiations concerning copyright. The article then examines the portions of TRIPS and the Uruguay Round Agreements Act that concern the protection of copyrightable works. Further, the article examines whether TRIPS and the Uruguay Round Agreements Act will likely foster an era of international copyright protection.

Mittelberger, Ralph A. & Gary M. Hnath, *Changes in Section 337 As a Result of the GATT-Implementing Legislation* 22 3 & 4 465 1994
This article describes changes, as a result of the Uruguay Round of GATT, to Section 337 of the Tariff Act of 1930 and predicts what impact these changes might have.

Pirkey, Louis T. & William G. Barber, *Treaties Bring Changes to U.S. Trademark Law and Practice* 22 3 & 4 509 1994
This article examines four treaties (GATT, NAFTA, the Trademark Law Treaty, and the Madrid Protocol) and the changes each brings (or may bring) to U.S. trademark law and practice.

Schwartz, Bryan A., *Beyond the Amendments: Federal and ITC Case Law Developments That May Determine the Long-Term Future of Section*

may be utilized to best protect proprietary information from being divulged from a competitor. The article primarily addresses the regulations applicable to the Department of Defense, since it is the largest procurement activity in the nation and the possessor of countless contractor-generated documents. This article also outlines the procedures generally applicable to opposing release of proprietary information under FOIA and reviews statutory exceptions and exemptions that are the most useful to the government contractor. It also focuses on the types of contractor-generated documents frequently requested under FOIA and the regulations and case law which may be relied upon to persuade an agency or a court to deny a FOIA request.

Government Patent Policies

Brown, Derek L.R., *Is the Haystack Getting Bigger Or the Needle Smaller? A Review of the Current Difficulties for the Patent Searcher* 11 1 & 2 126 1983
The three prevailing concerns for patent searchers -- space, availability, and user convenience -- must be addressed as the U.S. PTO moves to its "paperless" patent office. The desire of patent searchers to have a hard copy on hand, practical concerns regarding storage, and access necessitate the movement to electronic methodology.

Bryant, Dr. J. Howard & Donald P. Stein, *Automating the U.S. Patent Office* 11 1 & 2 25 1983
The PTO automation plan established in 1982 is expected to meet the objectives of improving the integrity of the data base and maintaining search quality while resulting in a net cost benefit to quickly make up for the initial financial investment.

Harmonization

Bardehle, Heinz, *Equivalents and International Patent Law Harmonization* 20 2 119 1992
This article advocates the need for worldwide codification and harmonization of the Doctrine of Equivalents. The article examines the World Intellectual Property organization's initiative on protection scope and claim interpretation, and urges for the full support of such an initiative.

Fiorito, Edward G., *The WIPO "Basic Proposal" for Harmonization of Patent Laws Viewed*

Conduct and Violation of the (Statutory) Duty of Disclosure 16 2 182 1988

This article reviews precedent on issues of fraud, inequitable conduct, and violation of the statutory duty of disclosure in the patent context. It focuses specifically on the evolutionary changes and sometimes inconsistent result brought about by the Federal Circuit's decisions.

Casey, Kevin R., *"Infectious Unenforceability:" The Extent Or Reach of Inequitable Conduct On Associated Patents* 17 4 338 1989

A patent applicant's commission or omission of certain acts may constitute fraud or inequitable conduct on the Patent and Trademark Office ("PTO"). Courts will not enforce patents issued on applications obtained by inequitable conduct. However, if the conduct is not too egregious, patents associated with the tainted patent may still be enforceable. If the conduct is sufficiently egregious, the court will refuse to enforce the associated patents as well, under the doctrine of unclean hands. This article suggests that courts take care to separate the doctrines of inequitable conduct and unclean hands. The answer depends on when, and before which body, the misconduct occurred. If the conduct occurs during patent prosecution before the PTO, the directly tainted patent is the only unenforceable patent. When the egregious conduct occurs during adversary proceedings before a court, the doctrine of unclean hands applies. This doctrine may render all of the associated patents unenforceable.

Chambers, J. Robert, *Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit* 13 3 & 4 361 1985

This article addresses the role of the jury in patent trials. The author examines decisions of the Federal Circuit in its first three years, focusing first on the issue of obviousness, and concluding with an analysis of other issues, including infringement, the section 112 defenses, inequitable conduct, and damages.

Dunner, Donald R., *Inequitable Conduct: Is the Sky Really Falling?* 16 1 27 1988

The author discusses reform that is being suggested regarding inequitable conduct, but emphasizes that he is

materiality of the withheld information. In light of these developments, it is likely that the inequitable conduct defense will continue to be used.

Trop, Timothy N., *Negative Inferences From the Absence of Attorney Testimony in Patent Cases* 15 1 50 1987

In patent cases, with increasing frequency, attention is focusing on the conduct of attorneys. Typically, this occurs when a defense of reliance on an opinion of counsel is raised to a charge of willful patent infringement. This also happens in cases involving charges of inequitable conduct in the PTO when the alleged wrongdoer is the patent solicitor. There is pressure, then, to make the attorney a material fact witness. If the attorney does not testify, opposing counsel may raise a negative inference from the failure of the attorney to testify. The article explores this adverse inference rule.

Wegner, Harold C., *Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in An Era of International Patent Harmonization* 16 1 38 1988

The author asserts that the examination of a patent application should be conducted ex parte, and should be exclusively governmental. An inter partes system should be added to the United States system, as is used in both Europe and Japan.

Injunctions

Metcalf, L. Craig, *Preliminary Injunctions and Their Availability: How to Defend Against the Early Injunction* 15 2 & 3 104 1987

This article discusses the evolution of the standards applied in issuing preliminary injunctions in patent infringement cases, before and after the creation of the Federal Circuit. The article also proposes some defensive tactics to aid accused infringers in defending against the early injunction.

Insurance

Lyerla, Bradford P. & Manuel A. Abascal, *Insurance Coverage for Intellectual Property Claims: The California vs. The New York Approach* 19 3 189 1991

This article raises and discusses issues and concerns that may arise in the course of litigation trade secret misappropriation cases under Section 337 of the Tariff Act,

This article analyzes priority questions in interference law in Europe. The article concludes that matters can be resolved essentially on the basis of technical submissions and Patent Office papers.

Kakinuki, John, *How the Japanese Handle Interference Issues in Their First-to-File World* 18 1 80 1990
This article discusses how the Japanese handle interference issues.

Mexic, Darryl & Kenneth Burchfiel, *Interference Law Developments in the Federal Circuit* 13 3 & 4 255 1985
The recent revision of the interference rules will effectively moot some of the points decided, e.g., those relating to the limited jurisdiction of the former Board of Patent Interfaces and the determination of what is ancillary to priority, because the jurisdiction of the newly-created Board of Patent Appeals and Interferences is considerably expanded, and now extends to matters such as patentability, which were outside the jurisdiction of the former Board. This article discusses how these changes have impacted the existing body in federal interference law.

Wilkes, Robert A., *The Canadian Viewpoint: A New Perspective Bridging the First-to-Invent and First-to-File World* 18 1 18 1990
This article reviews the Canadian Old Act and New Act (cases under section 45). The article outlines the new first-to-file system, as well as the new priority claim system.

International

Bardehle, Heinz, *Equivalents and International Patent Law Harmonization* 20 2 119 1992
This article advocates the need for worldwide codification and harmonization of the Doctrine of Equivalents. The article examines the World Intellectual Property organization's initiative on protection scope and claim interpretation, and urges for the full support of such an initiative.

Chen, Alexander C., *Climbing the Great Wall: A Guide to Intellectual Property Enforcement in the People's Republic of China* 25 1 1 1997
This article discusses China's recent commitment to enforcement of intellectual property law. The initial focus of

approach which began in 1991 with the Supreme Court's decision in *Feist Publications, Inc. v. Rural Telephone Service Company.*

Long, Doris E., *Copyright and the Uruguay Round Agreements: A New Era of Protection Or An Illusory Promise?* 22 3 & 4 531 1994

This article explores the history of the Uruguay Round negotiations concerning copyright. The article then examines the portions of TRIPS and the Uruguay Round Agreements Act that concern the protection of copyrightable works. Further, the article examines whether TRIPS and the Uruguay Round Agreements Act will likely foster an era of international copyright protection.

Spector, David M., *Implications of the United States Adherence to the Berne Convention* 17 2 100 1989

This article analyzes how the Berne Convention of 1988 will affect not only companies selling, licensing, or distributing copyrighted works in other Berne member states, but also those doing so within the United States. Section II of the article summarizes copyright protection available overseas for works first published in the United States prior to the implementation of the Convention. Section III outlines some important Berne Convention rights and discusses the major advantages and disadvantages of U.S. adherence to Berne considered by Congress. Sections IV and V explore the impact on U.S. copyright law of the Berne prohibition against statutory formalities, and section VI examines the application of the Berne Convention to works and legal claims existing prior to the effective date of United States adherence. Finally, section VII discusses important implications raised by the passage of the Berne Implementation Act and U.S. adherence to Berne.

International Chemical Patent Practice

Allam, Peter, *Chemical Patent Practice At the European Patent Office* 13 1 19 1985

The European Patent Office ("EPO") was very successful in its early years, owing much to its clear and concise law and regulations, and its flexibility in terms of what it requires of both applicants and itself. This article briefly describes some of the precedents and framework that underpin the EPO, as it applies to chemical patent practice.

Following the 1989 Amendments to Section 337 17 1 47 1989
Section 337 of the Tariff Act of 1930 provides U.S. patent holders with an action to prevent the importation or sale of any product that violates a U.S. patent. The authors believe that amendments to this Act passed in 1988 that make it easier to demonstrate violations and obtain relief will result in an increase in actions brought. The article describes a Section 337 suit in detail and provides suggestions and advice for practitioners.

Japan

Kalikow, Martin, *Automation of the European and the Japanese Patent Offices* 11 1 & 2 33 1983
The differences in current and planned automation between the U.S. PTO, JPO & the EPO reflect differences in their patent systems; most notably, the EPO and the JPO have the ability to achieve "paperless" administrative data bases, but not "paperless" searching data bases under the communication and retrieval hardware and software available as print.

Wachter, Mark F., *Patent Enforcement in Japan: An American Perspective for Success* 19 1 59 1991
This article, written by an American attorney litigating in Japan, outlines the basics of Japanese patent enforcement proceedings. The goal of the article is to provide a guide for attempting to enforce a Japanese patent in the Japanese court system to a foreign attorney with little knowledge of the system.

Weissman, Peter, *Computer Software As Patentable Subject Matter: Contrasting United States, Japanese, and European Laws* 23 3 525 1995
This article explores the current state of the law regarding computer-related technologies as patentable subject matter in the United States, Japan, and Europe. It analyzes the effects of these laws, and provides a brief comparison and analysis among the different nations.

Judicial Review

Bovee, Warren R., *Court Review of Magistrate's and Master's Decisions* 12 3 245 1984

well as issues concerning res judicata and appellate review. The author encourages changes that are responsive to, and in conformance with, U.S. jurisprudence.

Jury Trial Procedure & Review

Preston, Albert W., Jr. & Dianne B. Elderkin, *Malta v. Schulmerich: The Federal Circuit at a Crossroads In Its Search to Harmonize Substantive Patent Law With Jury Trial Procedure and Review* 20 1 49 1992

This article analyzes the situation when standards for jury trial procedures/review intersect with substantive doctrinal standards and how they are reconciled so as to render consistent verdicts. Malta, with its seemingly simple question of equivalence, represented a recognition by the Federal Circuit that jury determinations of equivalence require careful review to ensure proper application of substantive rules. The author opines that most juries can provide fair and informed verdicts and the patent bar has a great interest in encouraging such verdicts, so that a balance should be struck between substantive patent law, enabling rules of jury trial/procedure, and Seventh Amendment rights.

Legal Practice

Allcock, Harry M., *IFI / Plenum Data Company* 11 1 & 2 44 1983

At print time, the on-line commercial vendor IFI / Plenum Data Company's database contains information on over 600,000 U.S. chemical patent documents compiled since 1950, and all U.S. patents issued since 1965, searchable by criteria which are described in detail.

Brown, Derek L.R., *Is the Haystack Getting Bigger Or the Needle Smaller? A Review of the Current Difficulties for the Patent Searcher* 11 1 & 2 126 1983

The three prevailing concerns for patent searchers -- space, availability, and user convenience -- must be addressed as the U.S. PTO moves to its "paperless" patent office. The desire of patent searchers to have a hard copy on hand, practical concerns regarding storage, and access necessitate the movement to electronic methodology.

Bryant, Dr. J. Howard & Donald P. Stein, *Automating the U.S. Patent Office* 11 1 & 2 25 1983

This article discusses how arbitration and mediation were used to reduce the complexity and expense of patent trials in *Shell v. Intel* and *Telecredit v. TRW*, respectively.

Kalikow, Martin, *Automation of the European and the Japanese Patent Offices* 11 1 & 2 33 1983
The differences in current and planned automation between the U.S. PTO, JPO & the EPO reflect differences in their patent systems; most notably, the EPO and the JPO have the ability to achieve "paperless" administrative data bases, but not "paperless" searching data bases under the communication and retrieval hardware and software available as print.

Marmor, Alfred C., *What You Don't Know Can Hurt You: An Inside View of Derwent -- the Technological Information Specialists* 11 1 & 2 40 1983
At print time, the commercial vendor "Derwent" processes approximately 11,000 patent documents per week and contains approximately six million patent documents in its master file; in addition, approximately 15,000 scientific/technical journal articles are abstracted per year. Searching procedures for the electronic on-line data base and more detailed information on source material are described.

Mathews, J. Addison, *Document Delivery Systems for Today and Tomorrow* 11 1 & 2 102 1983
Technology available as of print time -- including microfilm, robotics, electronic film scanners, video disks, optical disks, and computerized searching of data bases -- provide building blocks for more efficient systems that will be applied in future patent libraries.

Moeller, Dr. Guido K., *Corporate Experience With On-Line Databases* 11 1 & 2 107 1983
Practical uses of on-line databases for an international patent searcher include obtaining English-language versions of foreign-language reference publications; performing world-wide searches; supplementing "manual" novelty searches with global data; and rapidly obtaining information about a party's patent holdings for a particular technology.

Riddles, Alvin J., *Overview* 11 1 & 2 18 1983
Machine-assisted searching and accompanying technologies are increasing in use and providing greater assistance in

Will Existing License Agreements Be Affected By Extended Patent Terms Under GATT 22 3 & 4 449 1994
This article examines the potential impact of GATT's extended patent terms on existing license agreements.

Jackson, Thomas H. & Cindy I. George, *Preparing for Patent Infringement Suit Settlement and Cross-Licensing With Lotus® 1-2-3®* 17 1 30 1989
This article describes how spreadsheet software can assist and enhance the patent suit settlement process. The software can calculate a net payment schedule from one party to another for past and future royalties. The authors used this information, along with estimated sales figures and the probabilities of success of each patent, as a guideline for achieving settlement.

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985
This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Slade, Kenneth H., *Applicability of Franchise and Business Opportunity Laws to Distribution and Licensing Agreements* 15 1 1 1987
This article analyzes the scope of various franchise and business opportunity statutes and regulations, and explains the circumstances under which such rules can be applied to distribution and licensing agreements not generally thought to be franchises or business opportunities.

Stratton, Jane L., *Representing Commercial Biotechnology Companies in Licensing Negotiations* 16 3 & 4 506 1988
This article presents business-drive issues that may be encountered during negotiations for biotechnology licensing.

Battersby, Gregory T. & Charles W. Grimes,
The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer 15 2 & 3 231 1987
This article explores how attorney-client privilege and work-product immunity have been applied in the patent arena, particularly by counsel for an accused patent infringer. The author recognizes that the patent attorney is increasingly gaining recognition as performing a legal function, and the trend appears to be that application of the privileges will become more expansive.

Casey, Kevin R., *Identification of Trade Secrets During Discovery: Timing and Specificity* 24 1 191 1996
Under the proposed procedural approach (compiled through state and federal case law and the author's own experience), different stages of litigation in trade secret misappropriation require different degrees of specificity in pleading and proof on the part of the plaintiff.

Conley, Ned L., *An Economic Approach to Patent Challenges* 15 4 354 1987
This article examines some of the concepts and criteria which have been used by the courts in arriving at damages awards in patent infringement cases. The author suggests some approaches which might be used by litigants to influence a desirable result with respect to basic damages or reasonable royalty awards.

Duft, Bradford J., *Patent Infringement and Biotechnology* 16 3 & 4 339 1988
This article describes and discusses the few contemporary biotechnology court opinions and decisions with respect to infringement as well as related questions of validity and how the requirement of proper claim interpretation affects these issues.

Frank, Peter B. & Michael J. Wagner,
Computing Lost Profits and Reasonable Royalties 15 4 391 1987
This article describes the analytical tasks required to satisfy the standards of proof for lost profits. The accounting issues surrounding the computation of the patent owner's lost profits on sales that would have been made absent the infringer's unlawful behavior, are also covered. Finally, issues surrounding the computation of a reasonable royalty

policies. California and New York courts are on opposite ends of the spectrum.

Madson, Craig J., *Arbitration of Franchise Agreement Disputes* 11 4 298 1983
Including a well-conceived arbitration plan in a franchise agreement will combine the judicial safeguards of litigation with the cost-and-time-efficiency of private agreements between parties. This approach can also preserve ongoing cooperative business relationships, if done properly and both parties understand the agreement.

Murashige, Kate H., *Section 102/103 Issues in Biotechnology Patent Prosecution* 16 3 & 4 294 1988
This article explores the obviousness standard in biotechnology cases, attempting to provide guidance because obviousness is an inherently subjective standard. The article includes suggestions for overcoming the putative prima facie case.

Pegram, John B., *An Analysis and Explanation of the Statutes Now Affecting Patent Arbitration* 11 4 274 1983
Congress' enactment of § 294 of the Patent Act raises both opportunities and challenges to patent infringement and validity litigants. The system generally provided for in the United States Arbitration Act (Title 9) may need to be tailored by mutual agreement of the parties, depending on the controversy involved.

Reiss, Steven M., *Applying the Effects Test Theory of Personal Jurisdiction in Patent Infringement Actions* 23 1 99 1995
This article examines the basis for the effects test theory, its application in intellectual property cases, and how it may be applied by the Federal Circuit.

Rudisill, Stephen G. & Richard C. Auchterlonie, *The Classic Defenses Updated* 15 2 & 3 209 1987
This article explores the "in public use" or "on-sale" defenses which an accused patent infringer may raise. Other defenses that are covered include enablement and best mode, inequitable conduct, misjoinder/non-joinder of inventors, misuse, and estoppel.

Long Arm Statutes

Reiss, Steven M., *Applying the Effects Test Theory*

concludes, however, that the procedure is unconstitutional in view of relevant Supreme Court decisions.

Masters

Bovee, Warren R., *Court Review of Magistrate's and Master's Decisions* 12 3 245 1984
This article provides an overview of the review of reports, findings, recommendations, and determinations made by Masters and Magistrates.

Williams, Sidney B., Jr. & Joan Thirstein, *Use of Masters in Litigation* 12 3 227 1984
This article examines the use of masters in litigation. It explores the history of masters as well as the role and duties of masters. It also delves in depth into the various sources of authority to appoint masters. Specifically, the article addresses the case for and against using a master in patent litigation cases.

Mexico

Rangel-Ortiz, Dr. Horacio, *The Law of Designs: Mexican Legal System and TRIPS* 24 2, 3, 4 753 1996
This article examines Mexican Law from three different perspectives: (1) protection of industrial designs based on provisions of the industrial-property statutes that have governed the protection of inventions and trademarks; (2) the relevant provisions contained in copyright statutes as well as a brief presentation on how design law has developed since the Mexican Congress passed the first intellectual property statutes; and (3) an analysis of the provisions addressing industrial design protection on the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and how such provisions have been implemented in domestic law.

Micro-organisms

Rohrbaugh, Mike L., *The Patenting of Extinct Organisms: Revival of Lost Arts* 25 3 371 1997
This article assesses the patentability of regenerated organisms, after being extinct in nature, under utility patent provisions. It provides insight into how the technology of regenerating formerly extinct organisms relates to, and is consistent with, the patentability requirements of statutory subject matter, utility, novelty, and non-obviousness.

Misuse

Pennwalt Redux - Judicial Uncertainty vs. Procrustean Bed 19 3 237 1991
This article discusses the "means clause" of 35 U.S.C. section 112. It traces judicial construction of the clause and how a patentee can establish infringement in cases involving equivalent means used by an infringer.

NAFTA

Mendes da Costa, Philip C., *NAFTA - The Canadian Response or Why Does the Canadian Patent Act Keep Changing?* 22 1 65 1994
Despite frequent changes in Canadian patent law, the implementation of NAFTA and the Intellectual Property Improvement Act will likely stabilize Canadian patent law for the near future.

Pirkey, Louis T. & William G. Barber, *Treaties Bring Changes to U.S. Trademark Law and Practice* 22 3 & 4 509 1994
This article examines four treaties (GATT, NAFTA, the Trademark Law Treaty, and the Madrid Protocol) and the changes each brings (or may bring) to U.S. trademark law and practice.

Silverstein, David, *Will Pre-Grant Patent Publication Undermine United States Trade Secret Law?* 23 4 695 1995
This article discusses the change to pre-grant publication of patent applications and its impact on trade secret protection.

Patent Act of 1790

Walterscheid, Edward C., *Charting a Novel Course: The Creation of the Patent Act of 1790* 25 4 445 1997
This article explores the origins of the Patent Act of 1790, and why it departed in various respects from the European patent custom and practice. A historical review demonstrates how much has changed in patent law, and also how much has remained the same.

Patent and Trademark Office

Boland, Lois E., *GATT/TRIPS: A Response From the United States Patent and Trademark Office* 22 3 & 4 425 1994
This article provides the Patent and Trademark Office's responses and comments to several other articles published

added to the United States system, as is used in both Europe and Japan.

Patent Attorneys

DeVito, Daniel A. & Michael P. Dierks, *Exploring Anew the Attorney-Client Privilege and Work-Product Doctrine in Patent Litigation: The Pendulum Swings Again, This Time in Favor of Protection* 22 2 103 1994

This article discusses the developments of discovery privileges in the context of patent prosecution material, and submits that such protection is justified.

Moore, Preston & Jackie Nakamura, *The United States Patent Marking and Notice Statute* 22 1 85 1994

This article discusses the basic requirements of the patent marking and notice statute, explaining many of the technical provisions and warning of potential legal pitfalls associated with compliance.

Stone, Gregory, *An Attorney's Duty to Preserve Client Confidences and Conflicts of Interest: The Problem of Representation Adverse to a Former Client* 12 2 157 1984

This article examines the trend that as the practice of law has become more complex, the potential for conflict of interest in representing clients who have adverse interests with former clients, have increased. The article examines the aspect of that trend that attorneys are being disqualified from continuing to represent a current client in litigation because of an actual or potential breach by the attorney of his duty to preserve a former client's confidences. The article first examines the substantial relationship test, its derivation, and its application. Then the article discusses some problems in implementation of the substantial relationship test. Finally, the effect of the Model Rules of Conduct are discussed.

Trop, Timothy N., *Negative Inferences From the Absence of Attorney Testimony in Patent Cases* 15 1 50 1987

In patent cases, with increasing frequency, attention is focusing on the conduct of attorneys. Typically, this occurs when a defense of reliance on an opinion of counsel is raised to a charge of willful patent infringement. This also happens in cases involving charges of inequitable conduct in the PTO

This article examines the issue of who proceeds first at a patent trial. The issue was complicated when a Federal Circuit Judge suggested that courts consider trying the issues of patent infringement and validity separately. The author believes that it is best not to split these issues, unless the split is based on the Federal Rules of Evidence. For example, in the declaratory judgment situation, the defendant patentee has the burden of proving the affirmative of the infringement issue, and should therefore, go first. Also, trying inequitable conduct issues separately may reduce confusion. In general, though, courts should endeavor to reduce the complexity of trials by gaining more control over the trial itself, rather than breaking up the order of proof and confusing presentation of evidence to the jury.

Jackson, Thomas H. & Cindy I. George, *Preparing for Patent Infringement Suit Settlement and Cross-Licensing With Lotus® 1-2-3®* 17 1 30 1989

This article describes how spreadsheet software can assist and enhance the patent suit settlement process. The software can calculate a net payment schedule from one party to another for past and future royalties. The authors used this information, along with estimated sales figures and the probabilities of success of each patent, as a guideline for achieving settlement.

Janicke, Paul M., *Heat of Passion: What Really Happened in Graver Tank* 24 1 1 1996

Examining the history and application of the Doctrine of Equivalents in patent law provides strong evidence in favor of abolishing the doctrine. Even if the doctrine is maintained in the fields of chemistry and biology (where broadened reissues will not prevent unscrupulous claims), judicial intervention should be a valid remedy in those areas.

Janicke, Paul M. & Roger S. Borovoy, *The Minitrial Approach to Resolving Patent Disputes* 11 4 258 1983

This article discusses how arbitration and mediation were used to reduce the complexity and expense of patent trials in *Shell v. Intel* and *Telecredit v. TRW*, respectively.

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses*

This article examines the Federal Circuit's development of the law of anticipation and obviousness under 35 U.S.C. sections 102 and 103. Because application of section 102 precludes proof of certain facts which could establish non-obviousness, such as unexpected results and the so-called "secondary considerations," the distinction between sections 102 and 103 can be decisive. The article also warns that given the trend reflected in cases dealing with the law on public use and sale or offer to sell, inventors and the companies for which they work must pay close attention to activities which ultimately may be construed as these events -- events that can lead to forfeiture of the right to patent the discoveries embodied by these actions.

Pravel, B.R., *Issues of Law and Fact At Appellate Level* 12 4 321 1984

This article examines issues of fact and law in both patent and trademark cases. With respect to patent cases the article discusses claim interpretation or construction, anticipation, obviousness, enablement under 35 U.S.C. § 112, utility and patent infringement. With regard to trademark cases, the article discusses the likelihood of confusion, the strength of the mark, trademark infringement, and other trademark issues.

Re, Joseph R., *Federal Circuit Jurisdiction Over Appeals From District Court Patent Decisions* 16 2 169 1988

This article reviews recent decisions dealing with the appellate jurisdiction of the Untied States Court of Appeals for the Federal Circuit over patent-related actions.

Reiss, Steven M., *Applying the Effects Test Theory of Personal Jurisdiction in Patent Infringement Actions* 23 1 99 1995

This article examines the basis for the effects test theory, its application in intellectual property cases, and how it may be applied by the Federal Circuit.

Silverstein, David, *Will Pre-Grant Patent Publication Undermine United States Trade Secret Law?* 23 4 695 1995

This article discusses the change to pre-grant publication of patent applications and its impact on trade secret protection.

Trop, Timothy N., *Negative Inferences From the Absence of Attorney Testimony in Patent Cases* 15 1 50 1987

This article supports the cases that extend copyright protection to computer programs. The authors argue that although copyright does not provide a bright line to divide the protectible from the unprotectible, neither does any other form of intellectual property right. The article discusses the legislative background, the *Whelan* case and other cases addressing the scope of copyright protection for software, and the significance of the growing worldwide consensus in favor of protection of computer programs under traditional copyright principles. The authors also comment on how familiar, often rejected arguments against such copyright protection appear to underlie the current quest for the certainty of a defined "interface" between copyright and patent.

Heinze, William F., Patent Mediation: *The Forgotten Alternative in Dispute Resolution* 18 4 333 1990

This article discusses the shortcomings of patent arbitration and the corresponding benefits offered by other, less publicized, dispute resolution procedures, particularly mediation. An examination of the historical development of arbitration, and the current laws concerning patent arbitration, reveals that many of the reasons for choosing arbitration over litigation apply equally well to patent mediation.

Hilti, Christian, *The Future European Community Patent System and Its Effects on Non-EEC Members* 18 3 289 1990

Following the agreement by the member states of the EEC that will enable parties to obtain unitary and autonomous European patents for the whole common market from the European Patent Office, this article outlines the future Community Patent system and its setting in the context of the existing national and international patent systems.

Macedo, Charles R.B., *First-To-File: Is American Adoption of the International Standard in Patent Law Worth the Price?* 18 2 193 1990

This article examines the newly proposed first-to-file standard and the advantages and disadvantages of having a single international standard of patentability based on seniority of filing rather than of invention. The article

rights in computer-related abstract ideas, such as algorithms, data structures, computerized methods of doing business, programming languages, and instructions sets.

Sumner, John P. & Steven W. Lundberg,
Patentable Computer Program Features As Uncopyrightable Subject Matter 17 3 237 1989
This article demonstrates that, both with respect to "computer programs" as defined in the Copyright Act and with respect to user interface features, a clearly definable interface exists between copyright law and utility patent law. This interface can be used in virtually all fact situations to properly determine and limit the scope of copyright protection, thus leaving the protection of functional, utilitarian features to the utility patent system, as intended by Congress. A line can be drawn between the functional, utilitarian features of software and the non-functional, copyrightable aspects of software. The article further demonstrates that the functional, utilitarian features should receive protection exclusively from utility patents, or trade secrets, but should receive no protection from copyright law.

Van Slyke, Paul C. & Mark M. Friedman,
Employer's Rights to Inventions and Patents of Its Officers, Directors and Employees 18 2 127 1990
This article discusses the issue of inventorship and the disputes which arise regarding the ownership of various rights associated with inventions and patents between employers and employees. The article focuses on a fictitious, yet realistic, case study, and analyzes the issues using the applicable laws.

Vick, John E., Jr., *Publish and Perish: The Patented Publication As a Bar to Patentability* 18 3 235 1990
A patent will not issue on subject matter in the public domain. Therefore, although publication is the cornerstone of academia, what is gained in academic recognition by publication must be balanced against the potential loss of patent rights. This article examines the printed publication doctrine as one of the many types of prior art that may be used against a patent application.

Patent Litigation

Coolley, Ronald B., *Magistrates: What They Are and How They Can be Used in Litigation* 12 3 186 1984

Analysis After Wilson Sporting Goods: The Hypothetical Claim Hydra 18 3 262 1990
This article discusses how the Federal Circuit, in *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, has explicitly dictated an entirely new and complex test for determining whether or not a patent claim is infringed under the Doctrine of Equivalents.

Pretty, Laurence H., *The Boundaries of Discovery in Patent Litigation: Privilege, Work Product and Other Limits* 18 2 101 1990
This article reviews the special problems in delineating the boundaries of discovery in patent litigation due to the public character of patents. Specifically highlighted are the boundaries of discovery created by the attorney-client privilege, work product immunity, and relevance.

Williams, Sidney B., Jr. & Joan Thirstein, *Use of Masters in Litigation* 12 3 227 1984
This article examines the use of masters in litigation. It explores the history of masters as well as the role and duties of masters. It also delves in depth into the various sources of authority to appoint masters. Specifically, the article addresses the case for and against using a master in patent litigation cases.

Patent Office Procedure

Bryant, Dr. J. Howard & Donald P. Stein, *Automating the U.S. Patent Office* 11 1 & 2 25 1983
The PTO automation plan established in 1982 is expected to meet the objectives of improving the integrity of the data base and maintaining search quality while resulting in a net cost benefit to quickly make up for the initial financial investment.

Herrell, Roger W. & Donald R. Piper, Jr., *Concurrent Use and Registration Rights* 11 3 177 1983
Knowledge of a third-party's rights is beneficial to a trademark registrant in asserting their own rights before either the PTO or the courts; the good-faith exception for concurrent user's rights will be upheld when properly established in the forum.

Wegner, Harold C., *Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in An Era of International Patent Harmonization* 16 1 38 1988

Imputing knowledge of an employee to that employee's corporation in cases of willful patent infringement should only occur following the standards of agency law: where the employee has actual knowledge of the patent, understands its importance, and has a duty to report his or her knowledge to the corporation.

Clark, Paul T., *Animal Invention Protection* 16 3 & 4 442 1988
This article asks whether the patent system in its present form can accommodate the flood of animal patent applications.

Kupferschmid, Keith M., *Prior User Rights: The Inventor's Lottery Ticket* 21 3 213 1993
This article discusses reform of patent law, and the issues involved in implementing a prior user right. The article discusses whether the U.S. should adopt a prior user right.

Manbeck, Harry F., Jr., *Voluntary Arbitration of Patent Disputes -- The Background to 35 U.S.C. 294* 11 4 268 1983
The 1982 endorsement, by the 97th Congress, of voluntary binding arbitration -- embodied in statute at 35 U.S.C. § 294 -- should provide a stimulus for more arbitration of patent validity questions in the patent system.

Pegram, John B., *An Analysis and Explanation of the Statutes Now Affecting Patent Arbitration* 11 4 274 1983
Congress' enactment of § 294 of the Patent Act raises both opportunities and challenges to patent infringement and validity litigants. The system generally provided for in the United States Arbitration Act (Title 9) may need to be tailored by mutual agreement of the parties, depending on the controversy involved.

Quillen, Cecil D., Jr., *Proposal for the Simplification and Reform of the United States Patent System* 21 3 189 1993
This article discusses issues not covered by the Advisory Commission on Patent Law Reform. The article goes beyond the report of the Commission and identifies substantive features of present U.S. patent law which are contrary to the objectives sought to be achieved by a patent system. The article then sets forth various substantive proposals for the reform and simplification of the U.S. patent system.

affords patentees free access to the courts to protect their rights, but which also affords accused infringers a reliable non-technical remedy for bad faith assertions of patents known to be invalid or not infringed.

Battersby, Gregory J. & Charles W. Grimes, *The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer* 15 2 & 3 231 1987
This article explores how attorney-client privilege and work-product immunity have been applied in the patent arena, particularly by counsel for an accused patent infringer. The author recognizes that the patent attorney is increasingly gaining recognition as performing a legal function, and the trend appears to be that application of the privileges will become more expansive.

Brown, Harold R., III, *Proof of Lost Profits Damages Following Rite-Hite v. Kelley* 23 4 577 1995
This article first summarizes key points of the *Rite-Hite* decision. It then provides a review of Federal Circuit decisions relating to proof of lost profits damages generally.

Brunda, Bruce B., *Resolution of Patent Disputes By Non-Litigation Procedures* 15 2 & 3 73 1987
This article promotes the use of mediation, arbitration, and other non-litigation dispute resolution procedures to obtain a settlement, or other resolution of a patent controversy. The principal attributes and advantages of a number of non-litigation procedures are considered.

Coggio, Brian D., Jennifer Gordon & Marsha G. Ajhar, *Damage Control -- What An Adjudged Infringer Can Do to Minimize the Resulting Damage* 15 2 & 3 250 1987
This article explores three means of limiting an adjudged infringer's ultimate exposure: (1) avoiding the entry of a permanent injunction; (2) avoiding increased damages and/or attorney's fees; and (3) reducing the compensatory damages awarded to the patentee.

Conley, Ned L., *An Economic Approach to Patent Challenges* 15 4 354 1987
This article examines some of the concepts and criteria which have been used by the courts in arriving at damages awards in patent infringement cases. The author suggests some approaches which might be used by litigants to influence a

This article discusses how a potential patent infringer can coordinate its defense with other businesses threatened by the same patent.

Hollaar, Lee A., *Justice Douglas Was Right: The Need for Congressional Action on Software Patents* 24 1 283 1996
Congress is in the best position to amend the patent law to provide three clear guidelines regarding patents of computer software: establish that computer processes are in fact patentable, protect "method" patent holders from distributors of those methods, and exclude information which has been stored in obvious ways from any novelty determination.

Holm, Chris L., *Patent Prosecution Comparison Between the United States Patent and Trademark Office and the European Patent Office* 25 2 233 1997
This article examines four specific questions: (1) Is there a significant difference in the average prosecution time from the application filing date to the grant date for applications filed in the U.S. Patent Trademark Office ("PTO") as compared with the European Patent Office ("EPO"), and what is the average term of protection following a patent grant by the EPO?; (2) Are there significant differences (as in the U.S.) in the average EP prosecution times from the application filing date to the grant date for chemical, electrical, and general applications?; (3) Is there a significant difference time from the application filing date to the grant date for applications that claim a U.S. priority as compared to applications that do not claim a U.S. priority?; and (4) Does an early demand or a late demand have a significant effect on the time from application filing date to grant date for EPO applications?

Irving, Thomas L. & Stacy D. Lewis, *Proving a Date of Invention and Infringement After GATT/TRIPS* 22 3 & 4 309 1994
This article discusses Uruguay Round amendments to Section 104 as well as the expanded definition of infringing activity under the Agreement.

Katz, Arie P., *Patentability of Living Matter Within Traditional Jewish Law: Is the Harvard House Kosher?* 21 2 117 1993

analysis as a basis for explaining and harmonizing the Federal Circuit opinions interpreting equivalents.

Lemley, Mark A., *An Empirical Study of the Twenty-Year Patent Term* 22 3 & 4 369 1994
This article studies what the likely impact will be of the GATT provision that extends the length of time patentees receive protection for their patents in the United States.

Marshall, John J., *Proximate Causation As the Grand Unification Theory of Patent Damages: An Analysis of Rite-Hite v. Kelley and King Instruments v. Perego* 23 4 645 1995
This article demonstrates that proximate causation is a grand unification theory that unites prior patent damage theories, such as lost profits based upon entire market value, projected sales, convoyed sales, replacement parts, and price erosion. The article also guides the practitioner in investigating the potential damage claims available for each case of patent infringement.

Mendes da Costa, Philip C., *NAFTA - The Canadian Response or Why Does the Canadian Patent Act Keep Changing?* 22 1 65 1994
Despite frequent changes in Canadian patent law, the implementation of NAFTA and the Intellectual Property Improvement Act will likely stabilize Canadian patent law for the near future.

Metcalf, L. Craig, *Preliminary Injunctions and Their Availability: How to Defend Against the Early Injunction* 15 2 & 3 104 1987
This article discusses the evolution of the standards applied in issuing preliminary injunctions in patent infringement cases, before and after the creation of the Federal Circuit. The article also proposes some defensive tactics to aid accused infringers in defending against the early injunction.

Moore, Preston & Jackie Nakamura, *The United States Patent Marking and Notice Statute* 22 1 85 1994
This article discusses the basic requirements of the patent marking and notice statute, explaining many of the technical provisions and warning of potential legal pitfalls associated with compliance.

Oddi, Samuel A.,

inequitable conduct, misjoinder/non-joinder of inventors, misuse, and estoppel.

Silverstein, David, *Will Pre-Grant Patent Publication Undermine United States Trade Secret Law?* 23 4 695 1995
This article discusses the change to pre-grant publication of patent applications and its impact on trade secret protection.

Smith, G. Kenneth & Denise M. Kettelberger, *Patents and the Human Genome Project* 22 1 27 1994
International cooperation in an effort to decode the human genome has recently been threatened by various organizations' attempts to obtain patent protection for DNA fragments of unknown function derived from the genome project. The article argues that efforts to obtain proprietary rights for gene fragments of unknown function may harm international cooperation essential to the human genome project. Further, the article urges the United States to forge a strong policy regarding the human genome project and patent issues that result from it.

Smith, P. McCoy, *Copyright, Suppression, and the Problem of the Unpublished Work: Lessons From the Patent Law* 19 4 309 1991
This article explores the recent trend in the use of copyright as a weapon to suppress writings. By analyzing the manner in which the patent laws treat suppression of innovations, the author hopes to shed light on the validity of allowing copyright holders suppressive power.

Stephens, Keith & John P. Sumner, *Patenting Software Objects and Other Aspects of Object-Oriented Programs Under the New PTO Guidelines* 23 2 221 1995
The purpose of this article is to inform the software industry of the availability and advantages of patenting object-oriented software, not only generally, but with respect to software objects. The article also reviews how courts have addressed the patentability of software objects, and predicts how courts will address the issue in the future.

Stern, Richard H., *Solving the Algorithm Conundrum: After 1994 in the Federal Circuit Patent Law Needs a Radical Algorithmectomy* 22 2 167 1994

This article discusses the "means clause" of 35 U.S.C. section 112. It traces judicial construction of the clause and how a patentee can establish infringement in cases involving equivalent means used by an infringer.

Walterscheid, Edward C., *Charting a Novel Course: The Creation of the Patent Act of 1790* 25 4 445 1997
This article explores the origins of the Patent Act of 1790, and why it departed in various respects from the European patent custom and practice. A historical review demonstrates how much has changed in patent law, and also how much has remained the same.

Walterscheid, Edward C., *Priority of Invention: How the United States Came to Have a "First-to-Invent" Patent System* 23 2 263 1995
The purpose of this article is to explore how, when, and why the United States adopted a "first-to-invent" patent system.

Wegner, Harold C., *Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in An Era of International Patent Harmonization* 16 1 38 1988
The author asserts that the examination of a patent application should be conducted ex parte, and should be exclusively governmental. An inter partes system should be added to the United States system, as is used in both Europe and Japan.

Weissman, Peter, *Computer Software As Patentable Subject Matter: Contrasting United States, Japanese, and European Laws* 23 3 525 1995
This article explores the current state of the law regarding computer-related technologies as patentable subject matter in the United States, Japan, and Europe. It analyzes the effects of these laws, and provides a brief comparison and analysis among the different nations.

Wiseman, Thomas G., *Biotechnology Patent Practice -- A Primer* 16 3 & 4 394 1988
The author provides guidance on technologies and how to avoid pitfalls with the PTO examiner.

Patents -- Fundamental Concepts

Chisum, Donald S., *Comment: Anticipation, Enablement and Obviousness: An Eternal Golden Braid* 15 1 57 1987

This article focuses on "unique" issues, problems and alternatives in the intellectual property law of plant biotechnological intentions.

Professional Responsibility

Kline, Michael J. & David E. Dougherty, *Avoiding Client Conflicts of Interest in An Era of Corporate Change* 14 2 104 1986

This article presents a hypothetical case that raises issues of conflicts of interest. The article explores the law of conflicts of interest as it relates to the hypothetical, and variants thereof, demonstrates the best ways to avoid similar problems, and suggests solutions for dealing with the problems raised in the hypothetical case.

Lipman, Steven E., *Introduction* 14 2 71 1986

Lipman, Steven E., *Prosecution of Practitioners for Violation of the P.T.O. Code of Professional Responsibility: Facing the Realities of Losing Your License* 14 2 119 1986

This article discusses the ramifications of the apparent increased activity of the U.S. Patent and Trademark Office in matters of discipline since the promulgation in 1985 of its new Code of Professional Responsibility, the expansion of its procedures for the conduct of disciplinary proceedings for violations of that Code, and the establishment of its new Office of Enrollment and Discipline to investigate and prosecute those violations.

Vapnek, Paul W., *Intellectual Property Law Practice in the 1980's: Dealing With the Expectations of a More Informed Clientele* 14 2 91 1986

This article explores the effect of rule changes and the impact of more sophisticated clients, private and corporate, on the practice of intellectual property law in the 1980's and beyond. A review of the present state of professional responsibility, and especially of how the courts have treated lawyers and law firms in disputes with clients and between each other, will provide a basis for an assay of the future.

Weiffenbach, Cameron, *Attorney Conduct and the U.S. Patent and Trademark Office* 14 2 73 1986

This article deals with the new disciplinary rules as administered by the Office of Enrollment and Discipline (OED). It covers the scope of the new rules, the nature of the

Imputing knowledge of an employee to that employee's corporation in cases of willful patent infringement should only occur following the standards of agency law: where the employee has actual knowledge of the patent, understands its importance, and has a duty to report his or her knowledge to the corporation.

Brown, Harold R. III, *Proof of Lost Profits Damages Following Rite-Hite v. Kelley* 23 4 577 1995
This article first summarizes key points of the *Rite-Hite* decision. It then provides a review of Federal Circuit decisions relating to proof of lost profits damages generally.

Chisum, Donald S., *Remedies for Patent Infringement* 13 3 & 4 380 1985
Recent developments in the law of remedies for patent infringement have altered the economics of the patent system, making it more worthwhile to invest in obtaining patent protection, negotiating licenses, planning activity to avoid infringement, and suits against apparent infringers. The Federal Circuit has favored this trend, emphasizing that doubts on questions of the amount of monetary relief should be resolved in favor of the patent owner and against the infringer, and liberalizing the availability of preliminary injunctive relief against infringement. This article reviews the decisions of the Federal Circuit on the subject of remedies for patent infringements that were rendered in its first three years.

Correll, Craig O., *Using Criminal Sanctions to Combat Trademark Counterfeiting* 14 4 278 1986
This article, written by in-house counsel for Ocean Pacific Sunwear, Ltd., provides methods of containing and combating counterfeiting of Ocean Pacific apparel products by means other than civil lawsuits. Their approach is quite practical and derived directly from their experiences in trying to fight a large problem with a limited amount of money.

McCoy, Michael D. & James D. Myers, *Ex Parte Seizure Order Practice After the Trademark Counterfeiting Act of 1984* 14 4 237 1986
This article begins with a discussion of the development of *ex parte* seizure proceedings prior to the new Act. The article next discusses the definition of a counterfeit mark under the

other patent systems. The article proposes that the U.S. enact a research exemption into law.

Right of Publicity

Gibson, Floyd A. & Rachel M. Healey,
The Right of Publicity Comes of Age 23 3 361 1995
This article discusses the protection of one's persona through a right of publicity claim by defining the cause of action and the applicable defenses to such a claim.

Ropski, Gary M. & Diane L. Marschang,
The Stars' Wars: Names, Pictures and Lookalikes 17 2 81 1989
There is no specific federal right of publicity statute, but several states have enacted legislation that serves to protect a celebrity's right of publicity. The express language of the statutes, however, differs from state to state regarding what is protected under the right of publicity, and some statutes fail to address important issues such as inheritability. This article examines recent developments in this area of law, and focuses on fair use, lookalikes, and preemption.

Role of Jury

Hofer, Roy E., *The CAFC and Fact/Law Questions in Patent Cases: The Jury's Role Burgeons!* 12 4 295 1984
This article focuses on the Court of Appeals for the Federal Circuit and its effect on patent cases, particularly on what it has done in the area of fact/law questions in patent infringement cases, the effect upon trial and appellate review of patent infringement cases, and the practical consequences of the Court of Appeals for the Federal Circuit labors in these areas.

Section 103

Tao, Jerome T., *An Examination of the Federal Circuit's Multi-Tiered Review of Patent Obviousness* 20 2 84 1992
This article reviews the Federal Circuit's multi-tiered approach to determinations of obviousness. The article concludes that the classification of obviousness as an issue of law is the most judicially sound and practical approach possible.

Section 112

Chahine, Kenneth G., *Enabling DNA and Protein*

Mittelberger, Ralph A. & Gary M. Hnath,
Changes in Section 337 As a Result of the GATT - Implementing Legislation 22 3 & 4 465 1994
This article describes changes, as a result of the Uruguay Round of GATT, to Section 337 of the Tariff Act of 1930 and predicts what impact these changes might have.

Schwartz, Bryan A., *Beyond the Amendments: Federal and ITC Case Law Developments That May Determine the Long-Term Future of Section 337 Litigation* 22 3 & 4 491 1994
This article discusses several significant developments in federal and ITC case law and assesses their potential long-term impact on Section 337 litigation.

Security Interests

Bahrick, Thomas L.,
Security Interests in Intellectual Property 15 1 30 1987
This article addresses the major areas of concern associated with the use of intellectual property as collateral in secured transactions. Suggestions are made for assessing ownership, drafting the security agreements, perfecting a security interest in intellectual property, and foreclosing on such property. Ultimately, it is argued that with a clarification of the federal recording provisions, or in the applicable provisions of the U.C.C., secured parties will be more confident in their ability to obtain value from intellectual property, and this will accelerate the realization of the full potential of intellectual property in secured transactions.

Settlement

Szczepanski, Steven Z., *Licensing or Settlement: Deferring the Fight to Another Day* 15 2 & 3 298 1987
An accused patent infringer should always consider obtaining a license under a patent. Considering other alternatives is appropriate when the accused infringer wants to pay up to terminate the controversy, or when the accused infringer is contemplating a challenge to the patent or its scope. By taking the license, the accused infringer eliminates the risk of patent litigation and defers the final decision to challenge indefinitely the license. This provides insurance and keeps the option to litigate open. These benefits should be thoroughly considered before commencing litigation.

Small Business

distributors of those methods, and exclude information which has been stored in obvious ways from any novelty determination.

Jackson, Thomas H. & Cindy I. George, *Preparing for Patent Infringement Suit Settlement and Cross-Licensing With Lotus® 1-2-3®* 17 1 30 1989

This article describes how spreadsheet software can assist and enhance the patent suit settlement process. The software can calculate a net payment schedule from one party to another for past and future royalties. The authors used this information, along with estimated sales figures and the probabilities of success of each patent, as a guideline for achieving settlement.

Stephens, Keith & John P. Sumner, *Patenting Software Objects and Other Aspects of Object-Oriented Programs Under the New PTO Guidelines* 23 2 221 1995

The purpose of this article is to inform the software industry of the availability and advantages of patenting object-oriented software, not only generally, but with respect to software objects. The article also reviews how courts have addressed the patentability of software objects, and predicts how courts will address the issue in the future.

Stern, Richard H., *On Defining the Concept of Infringement of Intellectual Property Rights in Algorithms and Other Abstract Computer-Related Ideas* 23 3 401 1995

This article extrapolates from the concepts of copyright infringement and patent infringement under existing law, to define a concept of infringement of intellectual property rights in computer-related abstract ideas, such as algorithms, data structures, computerized methods of doing business, programming languages, and instructions sets.

Vietzke, Lance L., *Software As the Article of Manufacture in Design Patents for Icons* 21 2 138 1993

This article argues that the software which produces an icon is the article of manufacture. The article then discusses the overlap of patent and copyright protection, and the history of the Xerox Corp. cases. Finally, the article discusses why

This article is intended to warn owners of trade secrets about how their intellectual property may be exposed in public documents.

Casey, Kevin R., *Identification of Trade Secrets During Discovery: Timing and Specificity* 24 1 191 1996
Under the proposed procedural approach (compiled through state and federal case law and the author's own experience), different stages of litigation in trade secret misappropriation require different degrees of specificity in pleading and proof on the part of the plaintiff.

Casey, William L., Jr., John E. Marthisen & Laurence S. Moss, *The Economic Impact of the Freedom of Information Act* 12 1 76 1984
This article examines the claim, voiced by the business sector, that federal disclosure policy under the Freedom of Information Act too often compromises trade secrets and technical data. Next, it explains why the concept of "circumstantially relevant business information" actually provides a better description of what it is that businesses are concerned about "losing" to competitors than the often misused expression "trade secrets." Then, it looks at the reasons why we believe that circumstantially relevant business information is being given out by government agencies on a regular basis. Finally, it outlines the various policy arguments in favor of rapid dissemination of business information contained in agency records, especially information having to do with marketing information.

O'Reilly, James T., *Trade Secrets: Asleep At the Switch?* 12 1 13 1984
This article reviews some of the litigation and legislation surrounding the Freedom of Information Act and how members of the American Patent Bar are falling asleep at the switch when it comes to protecting trade secrets after the enactment of FOIA. This article looks at expectations of trade secret protection, the history of the FOIA in the courts and in Congress, and current interpretations of the Act as well as legislative prospects.

Silverstein, David, *Will Pre-Grant Patent Publication Undermine United States Trade Secret Law?* 23 4 695 1995

Trademark Law

Chisum, Donald S., *Trademark Acquisition, Registration and Maintenance: A Primer* 19 2 124 1991
This article reviews trademark adoption and use, the 1988 Trademark Revisions Act's bona fide intent to use requirement, basic Patent and Trademark Office registration requirements and procedures, and registration and rights maintenance, including abandonment.

Devitt, Veronica Colby, *Coping With Statutes Which "Muddy the Waters" of Trademark Practice* 11 3 236 1983
State statutes -- particularly regarding trade name registration, trademark registration, banking and other professions, and franchising -- can directly and indirectly affect trademark owners' rights. In some cases, awareness provides enough protection to a client; in others, more affirmative action is warranted.

Helget, Gerald E., *Slogans - Protectible Marketing Tools?* 20 1 35 1992
This article focuses on the protection of slogans, pursuant to the Lanham Act amendments of 1988. The author proffers various inquiries as a first level of analysis assessing the protectability of the slogans, and addresses the viability of federal trademark protection for current, as well as future, use.

Herrell, Roger W. & Donald R. Piper, Jr., *Concurrent Use and Registration Rights* 11 3 177 1983
Knowledge of a third-party's rights is beneficial to a trademark registrant in asserting their own rights before either the PTO or the courts; the good-faith exception for concurrent user's rights will be upheld when properly established in the forum.

Hewitt, Lester L. & Paul E. Krieger, *Anti-Monopoly -- An Autopsy for Trademarks* 11 3 151 1983
The 1982 Ninth Circuit Court of Appeal's "primary significance" test for genericism -- based on litigation involving the popular board game "Monopoly" -- was too narrowly applied and, if followed, will place too high a burden on mark owners.

Klein, Sheldon, *The Trademark Law Revision Act of 1988: An Analysis of the Mechanics and*

This article discusses the scope of U.S. trademark law vis-a-vis color, with an emphasis on recent developments regarding the registrability of color alone.

Trial Advocacy

Adamo, Kenneth R., *Basic Motion Practice for the Accused Infringer* 15 2 & 3 123 1987

This article explores the various Federal Rules of Civil Procedure, which can be used in aggressive motion practice by the accused infringer. The article advocates a well-planned motion practice for accused infringers, to narrow the issues, shape a more favorable case, and/or quickly kill one or all of the patentee's charges.

Barnhardt, John J., III, *Counterclaiming in Patent Infringement Litigation* 15 2 & 3 175 1987

This article examines the limitations of various counterclaims potentially available to the accused patent infringers in patent infringement actions for recovering damages, costs or fees from patentees who sue on inequitably obtained patents, further an anti-competitive purpose, or otherwise proceed in bad faith. The author concludes that liability for damages that are proximately caused by the bad faith assertions of the patent should not be made to depend upon the accused infringer's ability to establish malice, intent to defraud, or dominance of some cognizable product or geographic market. Also, liability should not depend on proof that the patent is being asserted in furtherance of a combination in restraint of trade or some other antitrust violation or unfair trade practice. Ultimately, a balance must be struck which affords patentees free access to the courts to protect their rights, but which also affords accused infringers a reliable non-technical remedy for bad faith assertions of patents known to be invalid or not infringed.

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This article examines Special 301 to provide a context in which to address its past performance, its current use, and the role it will play in the future.

Boland, Lois E., *GATT/TRIPS: A Response From the United States Patent and Trademark Office* 22 3 & 4 425 1994
This article provides the Patent and Trademark Office's responses and comments to several other articles published in this volume relating to the Uruguay Round Agreement and its implementation in the United States.

Irving, Thomas, L. & Stacy D. Lewis, *Proving a Date of Invention and Infringement After GATT/TRIPS* 22 3 & 4 309 1994
This article discusses Uruguay Round amendments to Section 104 as well as the expanded definition of infringing activity under the Agreement.

Rangel-Ortiz, Dr. Horacio, *The Law of Designs: Mexican Legal System and TRIPS* 24 2, 3, 4 753 1996
This article examines Mexican Law from three different perspectives: (1) protection of industrial designs based on provisions of the industrial-property statutes that have governed the protection of inventions and trademarks; (2) the relevant provisions contained in copyright statutes as well as a brief presentation on how design law has developed since the Mexican Congress passed the first intellectual property statutes; and (3) an analysis of the provisions addressing industrial design protection on the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and how such provisions have been implemented in domestic law.

Uniform Commercial Code

Hricik, David, *Allocation of the Risk of Infringement of Intellectual Property Rights Under Article 2 of the Uniform Commercial Code* 20 2 71 1992
This article explores the obligation and potential liability of both buyer and seller for infringement of intellectual property rights that arise under 35 U.S.C. § 2-312(3).

United Kingdom

Rackman, A.C., *The Patents County Court in the United Kingdom* 20 2 112 1992

This article discusses the developments of discovery privileges in the context of patent prosecution material, and submits that such protection is justified.

Pretty, Laurence H., *The Boundaries of Discovery in Patent Litigation: Privilege, Work Product and Other Limits* 18 2 101 1990

This article reviews the special problems in delineating the boundaries of discovery in patent litigation due to the public character of patents. Specifically highlighted are the boundaries of discovery created by the attorney-client privilege, work product immunity, and relevance.

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An Economic Approach to Patent Challenges, Conley, Ned L.	15	4	354	1987
An Empirical Study of the Effect of Patent Invalidity Judgments on the Abnormal Returns of Publicly Traded Securities, Kaufman, Page M.	19	4	282	1991

Bare-Fisted Competition or Palming Off? Protection of Product Design as Trade Dress Under the Lanham Act, Groff, Bradley K. 23 1 65 1995
Basic Motion Practice for the Accused Infringer, Adamo, Kenneth R. 15 2 & 3 123 1987
Battling the Counterfeiting Contagion: The Nuts and Bolts of Fighting Counterfeiters, Springut, Milton & Robert L. Tucker 14 4 263 1986
Beyond the Amendments: Federal and ITC Case Law Developments that May Determine the Long-Term Future of Section 337 Litigation, Schwartz, Bryan A. 22 3 & 4 491 1994
Biotechnology Licensing: Issues From the University Perspective, Brinton, Joyce 16 3 & 4 479 1988
Biotechnology Patent Practice -- A Primer, Wiseman, Thomas G. 16 3 & 4 394 1988
CCPIT Patent Agency, Zhengfa, Wang 13 2 123 1985
Changes in Section 337 as a Result of the GATT - Implementing Legislation, Mittelberger, Ralph A. & Gary M. Hnath 22 3 & 4 465 1994
Charting a Novel Course: The Creation of the Patent Act of 1790, Walterscheid, Edward C. 25 4 445 1997
Checklist: Employment Agreement Clauses 14 1 62 1986
Chemical Patent Practice at the European Patent Office, Allam, Peter 13 1 19 1985
Chemical Patent Practice in Great Britain, Burnside, Michael 13 1 33 1985
Chemical Patent Practice in the Republic of Germany, Lederer, Dr. Franz 13 1 52 1985
Chemical Patent Practice in the United Kingdom, West Germany, the European Patent Office and Japan -- Some Significant Differences, Pantuliano, Michael J. 13 1 9 1985
Choice of Law in the United States Circuit Court of Appeals for the Federal Circuit, Gholz, Charles L. 13 3 & 4 309 1985
Climbing the Great Wall: A Guide to Intellectual Property Enforcement In the People's

Copyright, Suppression, and the Problem of the Unpublished Work: Lessons From the Patent Law, Smith, P. McCoy	19	4	309	1991
Corporate Experience With On-Line Databases, Moeller, Dr. Guido K.	11	1 & 2	107	1983
Counterclaiming in Patent Infringement Litigation, Barnhardt, John J., III	15	2 & 3	175	1987
Court Review of Magistrate's and Master's Decisions, Bovee, Warren R.	12	3	245	1984
Criteria of Patentability and Scope of Protection of the Chinese Patent Law, Jinqing, Zhu and Wu Sun	13	2	116	1985
Curing Double Patenting During Prosecution and After Issuance: When Once is Never Enough and Twice is Too Much, Lewis, Jeffrey I.D.	21	1	34	1993
Damage Control -- What An Adjudged Infringer Can Do to Minimize the Resulting Damage, Coggio, Brian D., Jennifer Gordon & Marsha G. Ajhar	15	2 & 3	250	1987
Design Patent Infringement Put to Sea Without Guiding Charts, Marcus, Harry C. & Mark J. Abate	22	2	135	1994
Design Patent System for the Twenty-First Century, Fryer, William T., III	24	2, 3,4	331	1996
Design Protection for Articles of Manufacture With Color, Zarfas, Louis S.	24	2, 3,4	409	1996
Dialog, LEXIS & Westlaw: Using the Computer Search Through Legal and Technological Data Bases, Sprowl, James A.	11	1 & 2	90	1983
Doctrine of Equivalents Analysis After Wilson Sporting Goods: The Hypothetical Claim Hydra, Parker, Henrik D.	18	3	262	1990
Document Delivery Systems for Today and Tomorrow, Mathews, J. Addison	11	1 & 2	102	1983
Employee Handbooks: An Implied Employment Contract Approach to Protecting Confidential Business Information, Garry, Paul R. & Allison C. Blakley	14	1	3	1986

Generated By Increasingly Sophisticated Computer Programs, Wu, Andrew J.	25	1	131	1997
Full-text Patent Information Retrieval with LEXPAT, Hearn, Robert L.	11	1 & 2	73	1983
Functionality and Free Market Theory, Oddi, Samuel A.	17	3	173	1989
GATT/TRIPS: A Response From the United States Patent and Trademark Office, Boland, Lois E.	22	3 & 4	425	1994
General Characteristics of the Chinese Patent Law, Mingzheng, Hu	13	2	129	1985
German Utility Models After the 1990 Reform Act, Liesegang, Dr. Roland	20	1	1	1992
Guide for the Perplexed: Where is the Problem and What We Do Until It is Solved, Smith, Richard, E. Robert Yoches & John F. Hornick	17	3	215	1989
Heat of Passion: What Really Happened in Graver Tank, Janicke, Paul M.	24	1	1	1996
High-Tech Trademark: Selection and Use, McCarthy, J. Thomas & Christopher M. Pickett	21	4	265	1993
How the Japanese Handle Interference Issues in Their First-to-File World, Kakinuki, John	18	1	80	1990
How the United States Currently Handles the Interference Issues That Will Remain in a First-to-File World, Gholz, Charles L.	18	1	1	1990
How Will Existing License Agreements Be Affected By Extended Patent Terms Under GATT, Forman, David S. & Thomas W. Winland	22	3 & 4	449	1994
I'm Just Wild About Harry, Baechtold, Robert L.	20	3 & 4	185	1992
Identification of Trade Secrets During Discovery: Timing and Specificity, Casey, Kevin R.	24	1	191	1996
IFI / Plenum Data Company, Allcock, Harry M.	11	1 & 2	44	1983
Implications of the United States Adherence to the Berne Convention, Spector, David M.	17	2	100	1989
Imputing Knowledge to Determine Willful Patent Infringement, Bolan, Robert O. & William				

Introduction, Lipman, Steven E.	14	2	71	1986
Introduction, Adamo, Kenneth R.	15	2 & 3	71	1987
Introduction, Smith, Neil A.	14	4	231	1986
Is Intent an Important Element of Inequitable Conduct in the Patent and Trademark Office?, Heinke, Lowell L.	16	1	21	1988
Is the Haystack Getting Bigger or the Needle Smaller? A Review of the Current Difficulties for the Patent Searcher, Brown, Derek L.R.	11	1 & 2	126	1983
Issues of Law and Fact at Appellate Level, Pravel, B.R.	12	4	321	1984
Japanese Chemical Patent Practice, Nishitate, Kazuyuki, Yukio Uchida & Takashi Ishida	13	1	66	1985
Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit, Chambers, J. Robert	13	3 & 4	361	1985
Justice Douglas Was Right: The Need for Congressional Action on Software Patents, Hollaar, Lee A.	24	1	283	1996
Licensing or Settlement: Deferring the Fight to Another Day, Szczepanski, Steven Z.	15	2 & 3	298	1987
Litigating Trade Secret Cases at the International Trade Commission, Hnath, Gary M. & James M. Gould	19	2	87	1991
Magistrates: What They Are and How They Can Be Used in Litigation, Coolley, Ronald B.	12	3	186	1984
Making, Using and Selling Without Infringing: An Examination of 35 U.S.C. Section 271(e) and the Experimental Use Exception to Patent Infringement, Israelsen, Ned A.	16	3 & 4	457	1988
Malta v. Schulmerich: The Federal Circuit at a Crossroads in its Search to Harmonize Substantive Patent Law with Jury Trial Procedure and Review, Preston, Albert W., Jr. & Dianne B. Elderkin	20	1	49	1992
NAFTA - The Canadian Response or Why Does the Canadian Patent Act Keep Changing?,				

Convention, Wegner, Harold C.	14	3	154	1986
Patent Mediation: The Forgotten Alternative in Dispute Resolution, Heinze, William F.	18	4	333	1990
Patent Misuse: Must An Alleged Infringer Prove an Antitrust Violation?, Bennet, Joel R.	17	1	1	1989
Patent Prosecution Comparison Between the United States Patent and Trademark Office and the European Patent Office, Holm, Chris L.	25	2	233	1997
Patent Simplification Sans Patent Fraud, Wegner, Harold C.	20	3 & 4	211	1992
Patentability of Living Matter Within Traditional Jewish Law: Is the Harvard House Kosher?, Katz, Arie P.	21	2	117	1993
Patentable Computer Program Features as Uncopyrightable Subject Matter, Sumner, John P. & Steven W. Lundberg	17	3	237	1989
Patenting Software Objects and Other Aspects of Object-Oriented Programs Under the New PTO Guidelines, Stephens, Keith & John P. Sumner	23	2	221	1995
Patents and the Human Genome Project, Smith, G. Kenneth & Denise M. Kettelberger	22	1	27	1994
Pennwalt Redux - Judicial Uncertainty vs. Procrustean Bed, Waldbaum, Maxim H. & David Sipiora	19	3	237	1991
Practicalities and Potential Pitfalls When Using Provisional Patent Applications, Van Horn, Charles E.	22	3 & 4	259	1994
Preliminary Injunctions and Their Availability: How to Defend Against the Early Injunction, Metcalf, L. Craig	15	2 & 3	104	1987
Preparing for Patent Infringement Suit Settlement and Cross-Licensing with Lotus® 1-2-3,® Jackson, Thomas H. & Cindy I. George	17	1	30	1989
Prior User Rights: The Inventor's Lottery Ticket, Kupferschmid, Keith M.	21	3	213	1993
Priority of Invention: How the United States				

Restoration Act of 1984, Boehnen, Daniel A. & Steven J. Sarussi	17	1	67	1989
Releasability Under the Freedom of Information Act of Documents Submitted by Government Contractors, Virden, Prospere S., Jr. & Nancy A. Sutherland	12	1	50	1984
Remedies for Patent Infringement, Chisum, Donald S.	13	3 & 4	380	1985
Reply to Comments on the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences, Eisenberg, Rebecca S. & Robert P. Merges	23	1	61	1995
Representing Commercial Biotechnology Companies in Licensing Negotiations, Stratton, Jane L.	16	3 & 4	506	1988
Resolution of Patent Disputes By Non-Litigation Procedures, Brunda, Bruce B.	15	2 & 3	73	1987
Role of Patent Attorneys in Corporate Acquisitions and Divestments, Greely, Paul D.	17	1	20	1989
Section 102/103 Issues in Biotechnology Patent Prosecution, Murashige, Kate H.	16	3 & 4	294	1988
Section 337: A Familiar Road Into Strange Country, Leonard, Will E. & Roger D. Taylor	12	4	336	1984
Security Interests in Intellectual Property, Bahrick, Thomas L.	15	1	30	1987
Shop Rights, Rights in Copyrights, Supersession of Prior Agreements, Modification of Agreement, Right of Assignment and Other Contracts, McDaniel, Terry B.	14	1	35	1986
Slogans - Protectable Marketing Tools?, Helget, Gerald E.	20	1	35	1992
Small Entity Status: Who's "Small", Who Isn't, Who Should Be, and Why?, Sterba, Richard A.	25	4	425	1997
So the Copyright Office Has Refused to Register Your Claim -- What Does It Mean and What Can You Do About It?,				

The China Patent Agents (H.K.) Ltd., Gushu, Liu	13	2	121	1985
The Classic Defenses Updated, Rudisill, Stephen G. & Richard C. Auchterlonie	15	2 & 3	209	1987
The Conflicting Treatments of Compilations of Facts Under the United States and British Copyright Laws, Arden, Thomas P.	19	4	268	1991
The Control Group Problem in a Large Corporation - Revisited, Einhorn, Harold	12	2	103	1984
The Dilemma of Conflicting Precedent: Three Options in the Federal Circuit, Tramposch, Albert G.	17	4	323	1989
The Duty of Disclosure Requirements, Hoffman, Gary M. & Michael C. Greenbaum	16	1	124	1988
The Economic Impact of the Freedom of Information Act, Casey, William L., Jr., John E. Marthisen & Laurence S. Moss	12	1	76	1984
The Evolution and Issue of New Rule 56, Manbeck, Harry F., Jr.	20	3 & 4	136	1992
The Expanded Authority of U.S. Magistrates: Has Congress Exceeded Constitutional Limits?, Parrett, Sherman O.	12	3	212	1984
The Fact-Law Dichotomy in Trademark Cases, Sutton, John P.	12	4	310	1984
The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/ Reexamination: The First Three Years, Killworth, Richard A.	13	3 & 4	220	1985
The Federal Circuit's Appellate Jurisdiction Over Federal District Court Patent Cases: The First Three Years, Goldstein, Jack C.	13	3 & 4	271	1985
The Fifth Amendment and its Impact on Civil Actions Under the Trademark Counterfeiting Act of 1984, Wallen, Richard A. & Michael J. MacDermott	14	4	318	1986
The Future European Community Patent System and Its Effects on Non-EEC Members, Hilti, Christian	18	3	289	1990

The PTO's New Duty of Disclosure/Fraud on the Patent Office Rules May Be a Trap for Unwary Practitioners, Amberg, Stanley L.	20	3 & 4	163	1992
The Research Exemption: A Proposal, Bruzzone, Lauren C.	21	1	52	1993
The Revision of the Hague Agreement Concerning the International Deposit of Industrial Designs, Curchod, Francois	24	2, 3,4	599	1996
The Right of Publicity Comes of Age, Gibson, Floyd A. & Rachel M. Healey	23	3	361	1995
The Seventh Amendment Right to Jury Trial in Complex Civil Litigation: Historical Perspectives and a View From the Bench, Costantino, Hon. Mark A. & Daniel L. Master, Jr.	12	4	279	1984
The Stars' Wars: Names, Pictures and Lookalikes, Ropski, Gary M. & Diane L. Marschang	17	2	81	1989
The Status of Dual Path Litigation in the ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review, Ritscher, Michael J., Albert Tramposch, Thomas J. O'Connell and Lisa Barons	18	2	155	1990
The Trademark Law Revision Act of 1988: An Analysis of the Mechanics and Possible Effects of Intent-to-Use Legislation, Klein, Sheldon	16	2	153	1988
The Unauthorized Use of Patents By the United States Government Or Its Contractors, McGrath, Richard J.	18	4	349	1990
The United States Patent Marking and Notice Statute, Moore, Preston & Jackie Nakamura	22	1	85	1994
The WIPO "Basic Proposal" for Harmonization of Patent Laws Viewed From the U.S. Practitioner's Point of View, Fiorito, Edward G.	19	1	24	1991
The WIPO Patent Harmonization Treaty, Pagenberg, Dr. Jochen, I	19	1	1	1991
Thirty Years of This Judging Business,				

Will Pre-Grant Patent Publication Undermine United States Trade Secret Law?, Silverstein, David 23 4 695 1995

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Rich, Giles S.	14	3	139	1986
Trade Dress Protection for Product Configurations: Is There a Conflict With Patent Policy?, Dratler, Jay, Jr.	24	2, 3,4	427	1996
Trade Secrets: An Update on the Impact of State and Federal Efforts to Broaden the Public Right of Access to Court Records, Adolph, Thomas H., David Hricik & Jayme Partridge	23	2	161	1995
Trade Secrets: Asleep at the Switch?, O'Reilly, James T.	12	1	13	1984
Trademark Acquisition, Registration and Maintenance: A Primer, Chisum, Donald S.	19	2	124	1991
Trademarks in Europe 1991 and Beyond, Rosini, James E. & Christopher C. Roche	19	3	213	1991
Treaties Bring Changes to U.S. Trademark Law and Practice, Pirkey, Louis T. & William G. Barber	22	3 & 4	509	1994
Tuning Up For a New Musical Age: Sound Recording Copyright Protection in a Digital Environment, Abrahamson, Jeffrey	25	2	181	1997
U.S. Design Protection: Discussion of Status and Suggested Proposals, Thompson, William S.	24	2, 3,4	393	1996
Use of Masters in Litigation, Williams, Sidney B., Jr. & Joan Thirstein	12	3	227	1984
User Interfaces and the Idea-Expression Dichotomy, Or, Are the Copyright Laws User Friendly?, Pilarski, John H.	15	4	325	1987
Using Criminal Sanctions to Combat Trademark Counterfeiting, Correll, Craig O.	14	4	278	1986
Verdict Forms - A Peek Into the "Black Box", Korniczky, Stephen S. & Don W. Martens	23	4	617	1995
Voluntary Arbitration of Patent Disputes -- The Background to 35 U.S.C. 294, Manbeck, Harry F., Jr.	11	4	268	1983
What You Don't Know Can Hurt You: An Inside View of Derwent -- the Technological Information Specialists, Marmor, Alfred C.	11	1 & 2	40	1983

The Increasing Worldwide Significance of European Patent Litigation, Franzosi, Mario & Giustino de Sanctis	25	1	67	1997
The Law of Designs: Mexican Legal System and TRIPS, Rangel-Ortiz, Dr. Horacio	24	2, 3,4	753	1996
The Law-Fact Distinction - From Trial by Ordeal to Trial by Jury, Lee, Jerome G.	12	4	288	1984
The Minitrial Approach to Resolving Patent Disputes, Janicke, Paul M. & Roger S. Borovoy	11	4	258	1983
The New Guidelines on Protection of Computer Generated Icons and Typeface, Word, A. Hugo	24	2, 3,4	415	1996
The New Patent and Trademark Paradigm for Design Patents, Goffney, Lawrence J., Jr.	24	2, 3,4	317	1996
The New Skirmish in Patent Cases: Who Goes First at Trial and With What Evidence, Irani, Rita M.	17	4	364	1989
The Novelty Requirement in design Protection Law: The Benelux Experience, Spoor, Jaap H.	24	2, 3,4	725	1996
The Patent and Trademark Office View of Inequitable Conduct or Attempted Fraud in the Patent and Trademark Office, Tegtmeyer, Rene D.	16	1	88	1988
The Patent Law of the People's Republic of China, Lin, Maria C.H.	13	2	107	1985
The Patenting of Extinct Organisms: Revival of Lost Arts, Rohrbaugh, Mark L.	25	3	371	1997
The Patents County Court in the United Kingdom, Rackman, A.C.	20	2	112	1992
The Potential for Greater Utilization of Magistrates in Intellectual Property Cases as Viewed By a Magistrate, Burnett, Arthur L., Sr., Magistrate	12	3	201	1984
The Practice of Foreign Related Patent Prosecution of the Shanghai Patent Agency, Yiping, Xu	13	2	136	1985

Haynie, Laurie A.	21	1	70	1993
Software As the Article of Manufacture in Design Patents for Icons, Vietzke, Lance L.	21	2	138	1993
Solving the Algorithm Conundrum: After 1994 in the Federal Circuit Patent Law Needs a Radical Algorithmectomy, Stern, Richard H.	22	2	167	1994
Strategies and Antitrust Limitations for Multiple Potential Patent Infringers, Haley, Jeffrey T.	21	4	327	1993
Submitters Beware: The Perils of FOIA - Implementing Regulations, Braverman, Burt A. & Frances J. Chetwynd	12	1	33	1984
Supplemental Claim Jurisdiction in the United States Court of Appeals for the Federal Circuit, Wright, Bradley C.	22	2	235	1994
Survey on the Patent/Copyright Interface for Computer Programs, Samuelson, Pamela	17	3	256	1989
Tales From the Algorithm War: Benson to Iwahshi, It's Deja Vu All Over Again, Stern, Richard H.	18	4	371	1990
Terminal Railroad Revisited: Using the Essential Facilities Doctrine to Ensure Accessibility to Internet Software Standards, Donahey, Teague I.	25	2	277	1997
The Attorney Client Privilege in Client Solicitation, DeGrandi, Joseph A.	12	2	114	1984
The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer, Battersby, Gregory J. & Charles W. Grimes	15	2 & 3	231	1987
The Boundaries of Discovery in Patent Litigation: Privilege, Work Product and Other Limits, Pretty, Laurence H.	18	2	101	1990
The CAFC and Fact/Law Questions in Patent Cases: The Jury's Role Burgeons!, Hofer, Roy E.	12	4	295	1984
The Canadian Viewpoint: A New Perspective Bridging the First-to-Invent and First-to-File World, Wilkes, Robert A.	18	1	18	1990

Came to Have a "First-to-Invent" Patent System, Walterscheid, Edward C.	23	2	263	1995
Proof of Lost Profits Damages Following Rite-Hite v. Kelley, Brown, Harold R. III	23	4	577	1995
Proposal for the Simplification and Reform of the United States Patent System, Quillen, Cecil D., Jr.	21	3	189	1993
Prosecution of Practitioners for Violation of the P.T.O. Code of Professional Responsibility: Facing the Realities of Losing Your License, Lipman, Steven E.	14	2	119	1986
Protecting the Patent Rights of Small Businesses - Does the Bayh-Dole Act Live Up to its Promise?, Geary, William L., Jr.	20	1	10	1992
Protecting the Seeds of Innovation: Patenting Plants, Seay, Nicholas J.	16	3 & 4	418	1988
Protecting U.S. Intellectual Property Rights Abroad With Special 301, Bickham, Timothy C.	23	2	195	1995
Protection for Color Under U.S. Trademark Law, Samuels, Jeffrey M. & Linda B. Samuels	23	1	129	1995
Proving a Date of Invention and Infringement After GATT/TRIPS, Irving, Thomas L. & Stacy D. Lewis	22	3 & 4	309	1994
Proximate Causation as the Grand Unification Theory of Patent Damages: An Analysis of Rite-Hite v. Kelley and King Instruments v. Perego, Marshall, John J.	23	4	645	1995
Publish and Perish: The Patented Publication as a Bar to Patentability, Vick, John E., Jr.	18	3	235	1990
Reexamination -- The Patent Challenger's View, Speranza, William J. & Michael L. Goldman	15	2 & 3	85	1987
Reforming the Patent System for the 21st Century, Thompson, William S.	21	3	171	1993
Relationships That Exist Between Patent Disputes and FDA Approval Dates Under the Drug Price Competition and Patent Term				

Mendes da Costa, Philip C.	22	1	65	1994
Negative Inferences From the Absence of Attorney Testimony in Patent Cases, Trop, Timothy N.	15	1	50	1987
New and Terminating Employees, Sayko, Andrew F., Jr.	14	1	49	1986
New Rule 56: The Second Time Around, Lynch, John F.	20	3 & 4	144	1992
On Defining the Concept of Infringement of Intellectual Property Rights in Algorithms and Other Abstract Computer-Related Ideas, Stern, Richard H.	23	3	401	1995
On the Scope of Protection for Computer Programs Under Copyright, Jordan, Richard A.	17	3	199	1989
On the System for Granting Patents in China, Yaozeng, Shen	13	2	112	1985
Opinion Letter As to the Patentability of Certain Inventions Associated with the Identification of Partial CDNA Sequences, Eisenberg, Rebecca S. & Robert P. Merges	23	1	1	1995
Overview, Riddles, Alvin J.	11	1 & 2	18	1983
Patent Based Suits at the International Trade Commission Following the 1989 Amendments to Section 337, Krosin, Kenneth E. & Holly D. Kozlowski	17	1	47	1989
Patent Enforcement in Japan: An American Perspective for Success, Wachter, Mark F.	19	1	59	1991
Patent Information From Pergamon, Terragno, P. James	11	1 & 2	81	1983
Patent Information Retrieval in Practice, Daniszewski, Joseph P.	11	1 & 2	120	1983
Patent Infringement and Biotechnology, Duft, Bradford J.	16	3 & 4	339	1988
Patent Infringement and the United States Court of Appeals for the Federal Circuit, Duft, Bradford J.	13	3 & 4	342	1985
Patent Law Simplification and the Geneva Patent				

C. Rooklidge	24	1	157	1996
In Defense of the First-To-Invent Rule, Bloomberg, Coe A.	21	3	255	1993
Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in an Era of International Patent Harmonization, Wegner, Harold C.	16	1	38	1988
Inequitable Conduct Before the PTO - The Law in the Federal Circuit, Pretty, Laurence H.	13	3 & 4	240	1985
Inequitable Conduct: Is the Sky Really Falling?, Dunner, Donald R.	16	1	27	1988
"Infectious Unenforceability:" The Extent or Reach of Inequitable Conduct on Associated Patents, Casey, Kevin R.	17	4	338	1989
INPADOC - International Patent Documentation Center - History - Present Status - Future, Wratschko, Dr. Werner	11	1 & 2	61	1983
Insurance Coverage for Intellectual Property Claims: The California vs. The New York Approach, Lyerla, Bradford P. & Manuel A. Abascal	19	3	189	1991
Insurance Coverage of Intellectual Property Lawsuits, Robinson, William J.	17	2	122	1989
Intellectual Property Law Practice in the 1980's: Dealing With the Expectations of a More Informed Clientele, Vapnek, Paul W.	14	2	91	1986
Intellectual Property Protection Along Foreign Borders, Trainer, Timothy P.	21	4	313	1993
Intellectual Property Rights Associated With Biotechnology -- An International Trade Perspective, Fuller, I.L. Pep	16	3 & 4	529	1988
Interference Law Developments in the Federal Circuit, Mexic, Darryl & Kenneth Burchfiel	13	3 & 4	255	1985
Interference Questions in Europe, Harrison, David C.	18	1	65	1990
International Business Implications of the U.S. Best Mode Requirement, Forstner, James A.	21	2	157	1993
Introduction, Coolley, Ronald B.	14	1	1	1986

Employer's Rights to Inventions and Patents of Its Officers, Directors and Employees, Van Slyke, Paul C. & Mark M. Friedman	18	2	127	1990
Employment Agreement Provisions: Definitions, Duties, Covenants Not to Compete, Assignment After Termination and Severability, Coolley, Ronald B.	14	1	20	1986
Enabling DNA and Protein Composition Claims: Why Claiming Biological Equivalents Encourages Innovation, Chahine, Kenneth G.	25	3	333	1997
Equivalents and International Patent Law Harmonization, Bardehle, Heinz	20	2	119	1992
Ex Parte Seizure Order Practice After the Trademark Counterfeiting Act of 1984, McCoy, Michael D. & James D. Myers	14	4	237	1986
Exploring Anew the Attorney-Client Privilege and Work-Product Doctrine in Patent Litigation: The Pendulum Swings Again, This Time in Favor of Protection, DeVito, Daniel A. & Michael P. Dierks	22	2	103	1994
Exporting Biotechnology: The Pitfalls, Griffen, Susan Haberman	16	3 & 4	542	1988
Federal Circuit Jurisdiction Over Appeals From District Court Patent Decisions, Re, Joseph R.	16	2	169	1988
Federalized Functionalism: The Future of Design Protection In the European Union, Dinwoodie, Graeme B.	24	2, 3,4	611	1996
First-To-File: Is American Adoption of the International Standard in Patent Law Worth the Price?, Macedo, Charles R.B.	18	2	193	1990
Fraud Statistics, Rowe, James L.	16	2	280	1988
Frivolous Appeals and Attorney Fee Awards: The Federal Circuit Gets Serious With A Serious Problem, Banner, Mark T.	13	3 & 4	318	1985
From Video Games to Artificial Intelligence: Assigning Copyright Ownership to Works				

Republic of China, Chen, Alexander C.	25	1	1	1997
Clinton Administration Expresses More than Intellectual Curiosity in Antitrust Issues Raised By Intellectual Property Licensing, Fogt, Howard W., Jr.	22	1	1	1994
Comment: Anticipation, Enablement and Obviousness: An Eternal Golden Braid, Chisum, Donald S.	15	1	57	1987
Comment: Reexamination "Catch 22", Lowin, David A.	14	3	218	1986
Comment: Use of a "Levels of Abstraction" Analysis for Computer Programs, Laurie, Ronald S.	17	3	232	1989
Comments on the Patentability of Certain Inventions Associated with the Identification of Partial CDNA Sequences, Chambers, Scott A.	23	1	53	1995
Computer Software as Patentable Subject Matter: Contrasting United States, Japanese, and European Laws, Weissman, Peter	23	3	525	1995
Computing Lost Profits and Reasonable Royalties, Frank, Peter B. & Michael J. Wagner	15	4	391	1987
Concurrent Use and Registration Rights, Herrell, Roger W. & Donald R. Piper, Jr.	11	3	177	1983
Coping with Statutes which "Muddy the Waters" of Trademark Practice, Devitt, Veronica Colby	11	3	236	1983
Copyright and the Uruguay Round Agreements: A New Era of Protection or an Illusory Promise?, Long, Doris E.	22	3 & 4	531	1994
Copyright Damages and the Value of Infringing Use: Restitutionary Recovery in Copyright Infringement Actions, Coleman, Andrew W.	21	2	91	1993
Copyright Protection for Architectural Works, Dremann, Christopher C.	23	3	325	1995
Copyright Protection for Computer Programs: Is the Sky Falling?, Goldberg, Morton David & John F. Burleigh	17	3	294	1989

An Empirical Study of the Twenty-Year Patent Term, Lemley, Mark A.	22	3 & 4	369	1994
An Examination of the Federal Circuit's Multi-Tiered Review of Patent Obviousness, Tao, Jerome T.	20	2	84	1992
Animal Invention Protection, Clark, Paul T.	16	3 & 4	442	1988
Answered Questions: New Developments Regarding Inequitable Conduct and Violation of the (Statutory) Duty of Disclosure, Adamo, Kenneth R.	16	2	182	1988
Anti-Monopoly -- An Autopsy for Trademarks, Hewitt, Lester L. & Paul E. Krieger	11	3	151	1983
Anticipation and Obviousness in the Federal Circuit, Mintz, Herbert H. & Richard B. Racine	13	3 & 4	171	1985
Applicability of Franchise and Business Opportunity Laws to Distribution and Licensing Agreements, Slade, Kenneth H.	15	1	1	1987
Applying the Effects Test Theory of Personal Jurisdiction in Patent Infringement Actions, Reiss, Steven M.	23	1	99	1995
Arbitration of Franchise Agreement Disputes, Madson, Craig J.	11	4	298	1983
Are You Making Fun of Me?: Notes on Market Failure and the Parody Defense in Copyright, Merges, Robert P.	21	4	305	1993
Attorney Conduct and the U.S. Patent and Trademark Office, Weiffenbach, Cameron	14	2	73	1986
Automating the U.S. Patent Office, Bryant, Dr. J. Howard & Donald P. Stein	11	1 & 2	25	1983
Automation of the European and the Japanese Patent Offices, Kalikow, Martin	11	1 &2	33	1983
Avoiding Client Conflicts of Interest in an Era of Corporate Change, Kline, Michael J. & David E. Dougherty	14	2	104	1986
Balancing the Competing Policies Underlying the Doctrine of Equivalents in Patent Law, Larson, Ronald E.	21	1	1	1993

This article focuses on the Patents County Court (PCC) established in the United Kingdom in 1990 by virtue of the Copyrights, Designs, and Patents Act of 1988.

Utility Models

Liesegang, Dr. Roland, *German Utility Models After the 1990 Reform Act* 20 1 1 1992

This article provides information concerning the 1990 German utility model reform in an effort to close the information gap among non-Germans seeking utility model protection. The article emphasizes that although German patents have longer duration periods, they are more expensive and are subject to opposition, while German utility model protection is less expensive, provides similar protection and enforcement as patents for 10 years (not including methods), and can be branched off a parent patent application.

Verdict Forms

Korniczky, Stephen S. & Don W. Martens, *Verdict Forms - A Peek into the "Black Box"* 23 4 617 1995

This article discusses use of special verdicts and written interrogatories under Rule 49 of the Federal Rules of Civil Procedure and how proper use of these devices can alleviate concerns normally associated with jury trials in patent cases.

Work Product Doctrine

Battersby, Gregory J. & Charles W. Grimes, *The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer* 15 2 & 3 231 1987

This article explores how attorney-client privilege and work-product immunity have been applied in the patent arena, particularly by counsel for an accused patent infringer. The author recognizes that the patent attorney is increasingly gaining recognition as performing a legal function, and the trend appears to be that application of the privileges will become more expansive.

DeVito, Daniel A. & Michael P. Dierks, *Exploring Anew the Attorney-Client Privilege and Work-Product Doctrine in Patent Litigation: The Pendulum Swings Again, This Time in Favor of Protection* 22 2 103 1994

trend appears to be that application of the privileges will become more expansive.

Coggio, Brian D., Jennifer Gordon & Marsha G. Ajhar, *Damage Control -- What An Adjudged Infringer Can Do to Minimize the Resulting Damage* 15 2 & 3 250 1987
This article explores three means of limiting an adjudged infringer's ultimate exposure: (1) avoiding the entry of a permanent injunction; (2) avoiding increased damages and/or attorney's fees; and (3) reducing the compensatory damages awarded to the patentee.

Rudisill, Stephen G. & Richard C. Auchterlonie, *The Classic Defenses Updated* 15 2 & 3 209 1987
This article explores the "in public use" or "on-sale" defenses which an accused patent infringer may raise. Other defenses that are covered include enablement and best mode, inequitable conduct, misjoinder/non-joinder of inventors, misuse, and estoppel.

Szczepanski, Steven Z., *Licensing or Settlement: Deferring the Fight to Another Day* 15 2 & 3 298 1987
An accused patent infringer should always consider obtaining a license under a patent. Considering other alternatives is appropriate when the accused infringer wants to pay up to terminate the controversy, or when the accused infringer is contemplating a challenge to the patent or its scope. By taking the license, the accused infringer eliminates the risk of patent litigation and defers the final decision to challenge indefinitely the license. This provides insurance and keeps the option to litigate open. These benefits should be thoroughly considered before commencing litigation.

Wright, Bradley C., *Supplemental Claim Jurisdiction in the United States Court of Appeals for the Federal Circuit* 22 2 235 1994
This article reviews the circumstances under which the Court of Appeals for the Federal Circuit will find subject matter jurisdiction over appeals involving "supplemental" claims in patent-related cases.

TRIPS

Bickham, Timothy C., *Protecting U.S. Intellectual Property Rights Abroad With Special 301* 23 2 195 1995

Possible Effects of Intent-to-Use Legislation 16 2 153 1988
The author explores the proposed Trademark Law Revision Act of 1988 and the impact its passage would have on trademark law. He advocates passage of the Act.

McCarthy, J. Thomas & Christopher M. Pickett,
High-Tech Trademark: Selection and Use 21 4 65 1993
This article attempts to provide a better perspective on the present state of the law governing high technology trademarks.

Pirkey, Louis T. & William G. Barber,
Treaties Bring Changes to U.S. Trademark Law and Practice 22 3 & 4 509 1994
This article examines four treaties (GATT, NAFTA, the Trademark Law Treaty, and the Madrid Protocol) and the changes each brings (or may bring) to U.S. trademark law and practice.

Ropski, Gary M. & Pamela J. Johnson,
A "Nonobvious" Framework for Analyzing Proof of Secondary Meaning 11 3 211 1983
The concepts provided for analyzing nonobviousness problems in patent law provide a helpful parallel framework for analysis of secondary meaning problems -- particularly with proof and factual inquiries-- faced by trademark law.

Ropski, Gary M. & Diane L. Marschang,
The Stars' Wars: Names, Pictures and Lookalikes 17 2 81 1989
There is no specific federal right of publicity statute, but several states have enacted legislation that serves to protect a celebrity's right of publicity. The express language of the statutes, however, differs from state to state regarding what is protected under the right of publicity, and some statutes fail to address important issues such as inheritability. This article examines recent developments in this area of law, and focuses on fair use, lookalikes, and preemption.

Rosini, James E. & Christopher C. Roche,
Trademarks in Europe 1991 and Beyond 19 3 213 1991
This article summarizes the changes in trademark law that have been happening within the European Community.

Samuels, Jeffrey M. & Linda B. Samuels,
Protection for Color Under U.S. Trademark Law 23 1 129 1995

This article discusses the change to pre-grant publication of patent applications and its impact on trade secret protection.

Trademark - Fair Use

Ropski, Gary M. & Diane L. Marschang,
The Stars' Wars: Names, Pictures and Lookalikes 17 2 81 1989
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Trademark -- Franchising

Devitt, Veronica Colby, *Coping With Statutes Which "Muddy the Waters" of Trademark Practice* 11 3 236 1983
State statutes -- particularly regarding trade name registration, trademark registration, banking and other professions, and franchising -- can directly and indirectly affect trademark owners' rights. In some cases, awareness provides enough protection to a client; in others, more affirmative action is warranted.

Trademark Cases

Pravel, B.R.,
Issues of Law and Fact At Appellate Level 12 4 321 1984
This article examines issues of fact and law in both patent and trademark cases. With respect to patent cases the article discusses claim interpretation or construction, anticipation, obviousness, enablement under 35 U.S.C. § 112, utility and patent infringement. With regard to trademark cases, the article discusses the likelihood of confusion, the strength of the mark, trademark infringement, and other trademark issues.

Sutton, John P.,
The Fact-Law Dichotomy in Trademark Cases 12 4 310 1984
This article deals with the likelihood of confusion of the fact/law dichotomy. It also examines specific facts underlying the likelihood of confusion, as well as how this dichotomy is handled by the Federal Circuit and the Supreme Court.

the software itself is the article of manufacture in design patents for software.

Weissman, Peter, *Computer Software As Patentable Subject Matter: Contrasting United States, Japanese, and European Laws* 23 3 525 1995
This article explores the current state of the law regarding computer-related technologies as patentable subject matter in the United States, Japan, and Europe. It analyzes the effects of these laws, and provides a brief comparison and analysis among the different nations.

Special 301

Bickham, Timothy C., *Protecting U.S. Intellectual Property Rights Abroad With Special 301* 23 2 195 1995
This article examines Special 301 to provide a context in which to address its past performance, its current use, and the role it will play in the future.

Trade Dress

Dratler, Jay, Jr., *Trade Dress Protection for Product Configurations: Is There a Conflict With Patent Policy?* 24 2, 3, 4 427 1996
This article explains the purposes of trade symbol protection and how standard trademark doctrine helps to protect the integrity of patent policy. The author insists that no great changes in existing trade dress doctrine are required to accommodate product configurations as trade dress.

Groff, Bradley K., *Bare-Fisted Competition or Palming Off? Protection of Product Design As Trade Dress Under the Lanham Act* 23 1 65 1995
This article argues that courts must make a greater effort to distinguish the design of a product itself from that of a product's packaging or labeling, recognizing that the former is typically protectible, if at all, only under the patent laws, whereas the latter is generally trade dress, protectible under the Lanham Act.

Trade Secrets

Adolph, Thomas H., David Hricik & Jayme Partridge, *Trade Secrets: An Update on the Impact of State and Federal Efforts to Broaden the Public Right of Access to Court Records* 23 2 161 1995

Geary, William L., Jr., *Protecting the Patent Rights of Small Businesses - Does the Bayh-Dole Act Live Up to its Promise?* 20 1 10 1992
This article sheds light on the proposed amendments to the 1980 Bayh-Dole Act, which would encourage participation in the Small Business Innovation Research Program by overcoming some of the deficiencies inherent in the Act. The Act, as originally written, made it possible for small businesses to effectively forfeit some of their intellectual property rights to Federal agencies in exchange for R&D sponsorship. The proposed amendments would create well-defined exceptions (i.e., application to only clearly patentable inventions) to protect the government's march-in rights, while simultaneously protecting small business interests.

Sterba, Richard A., *Small Entity Status: Who's "Small", Who Isn't, Who Should Be, and Why?* 25 4 425 1997
This article discusses the requisite qualifications for consideration as a small entity by the PTO and how to rectify an error in claiming this status. The article highlights inequities in the law with respect to who may qualify, focusing primarily on small business concerns. Finally, the author recommends a change in qualification standards to include annual receipts as a consideration.

Small Entities

Sterba, Richard A., *Small Entity Status: Who's "Small", Who Isn't, Who Should Be, and Why?* 25 4 425 1997
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Software

Hollaar, Lee A., *Justice Douglas Was Right: The Need for Congressional Action on Software Patents* 24 1 283 1996
Congress is in the best position to amend the patent law to provide three clear guidelines regarding patents of computer software: establish that computer processes are in fact patentable, protect "method" patent holders from

Composition Claims: Why Claiming Biological Equivalents Encourages Innovation 25 3 333 1997

This article demonstrates that modifications which alter the structure of DNA and protein compositions can be predicted, with sufficient reasonableness, to be considered enabling by any artisan skilled in the art. In addition, this article demonstrates that, although protein composition claims, limited by functional language, may not comply with traditional enablement analysis, they do fulfill the underlying purpose of the enablement doctrine.

Chambers, J. Robert, *Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit* 13 3 & 4 361 1985

This article addresses the role of the jury in patent trials. The author examines decisions of the Federal Circuit in its first three years, focusing first on the issue of obviousness, and concluding with an analysis of other issues, including infringement, the section 112 defenses, inequitable conduct, and damages.

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985

This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Section 337

Leonard, Will E. & Roger D. Taylor, *Section 337: A Familiar Road Into Strange Country* 12 4 336 1984

This article examines the jurisdiction and procedure of section 337 as well as the Unfair Act. It delves into economic issues including domestic industry, efficient and economic operation, injury, and prevention of establishment of an industry. The article also discusses remedies available under section 337.

1984 Act and the substantive and procedural requirements of that Act for obtaining *ex parte* seizure orders. In Part IV, it discusses obtaining such orders in situations not covered by the 1984 Act.

Smith, Neil A., *Introduction* 14 4 231 1986
This issue of the AIPLA Journal is devoted to the subject of trademark counterfeiting. It is a response to the large number of counterfeiting cases that are being handled by intellectual property practitioners.

Springut, Milton & Robert L. Tucker, *Battling the Counterfeiting Contagion: The Nuts and Bolts of Fighting Counterfeiters* 14 4 263 1986
This article details and explores some of the various actions a trademark owner can take to wage a full-scale battle against counterfeiting.

Wallen, Richard A. & Michael J. MacDermott, *The Fifth Amendment and Its Impact on Civil Actions Under the Trademark Counterfeiting Act of 1984* 14 4 318 1986
This article explores the effects of the Fifth Amendment upon civil counterfeiting actions and possible measures to minimize its impact.

Res Judicata

Ritscher, Michael J., Albert Tramposch, Thomas J. O'Connell & Lisa Barons, *The Status of Dual Path Litigation in the ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review* 18 2 155 1990
This article examines how imported products can be challenged in dual path litigation involving the same parties and the same rights in both civil court and before the ITC. The article reviews the status of these jurisdictional issues, as well as issues concerning res judicata and appellate review. The author encourages changes that are responsive to, and in conformance with, U.S. jurisprudence.

Research Exemption

Bruzzone, Lauren C., *The Research Exemption: A Proposal* 21 1 52 1993
This article examines the history of the research exemption in the United States, and reviews the statutory provisions of

complaints investigated by OED, and the investigative procedures and disciplinary proceedings.

Reexamination

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985

This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Lowin, David A., *Comment: Reexamination "Catch 22"* 14 3 218 1986

This article discusses the reexamination rules, particularly those involving the participation of a requester who is not also the owner of a patent being reexamined. After reexamination has been ordered, the requester's participation is substantially finished unless that requester is also the patent owner. This limitation on participation by a nonpatentee requester can leave one with a feeling of unfairness and lack of recourse, much like being caught in a "Catch 22." Some changes to the rules are proposed to permit limited, but increased, participation by requesters who are not the patent owner.

Speranza, William J. & Michael L. Goldman, *Reexamination -- The Patent Challenger's View* 15 2 & 3 85 1987

This article begins with a brief overview of the framework and procedure of the reexamination process. The article then explores the advantages and disadvantages of reexamination to the challenger, identifying which types of cases are most appropriate for reexamination to determine patentability, establish materiality, or avoid infringement.

Remedies

Bolan, Robert O. & William C. Rooklidge, *Imputing Knowledge to Determine Willful Patent Infringement* 24 1 157 1996

Three fundamental patent concepts are anticipation, enablement, and obviousness. These three distinct concepts have become intertwined like an intricately braided cord. The article concludes that, given the intricate relationship among the three fundamental concepts, broad statements about the relationship are dangerous and subject to misunderstanding.

Patents -- Medical

Chambers, Scott A., *Comments On the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences* 23 1 53 1995
This comment responds to an opinion on certain inventions associated with the identification of partial CDNA sequences.

Eisenberg, Rebecca S. & Robert P. Merges, *Reply to Comments On the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences* 23 1 61 1995
This comment responds to a critique of the author's earlier work.

Eisenberg, Rebecca S. & Robert P. Merges, *Opinion Letter As to the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences* 23 1 1 1995
This opinion letter gives a brief description of the NIH patent application and describes certain patentability issues presented by these applications.

Plants

Rohrbaugh, Mike L., *The Patenting of Extinct Organisms: Revival of Lost Arts* 25 3 371 1997
This article assesses the patentability of regenerated organisms, after being extinct in nature, under utility patent provisions. It provides insight into how the technology of regenerating formerly extinct organisms relates to, and is consistent with, the patentability requirements of statutory subject matter, utility, novelty, and non-obviousness.

Seay, Nicholas J., *Protecting the Seeds of Innovation: Patenting Plants* 16 3 & 4 418 1988

This article discusses problems with current law regarding the patenting of algorithms. The author proposes a new patent statute for algorithms and related subject matter.

Tegtmeyer, Rene D., *The Patent and Trademark Office View of Inequitable Conduct Or Attempted Fraud in the Patent and Trademark Office* 16 1 88 1988

This article addresses concerns regarding the adverse impacts of the duty of disclosure requirement. It addresses the AIPLA resolution. It also states key concerns of the PTO with how the duty of disclosure is designed to improve the quality of examination.

Van Horn, Charles E., *Practicalities and Potential Pitfalls When Using Provisional Patent Applications* 22 3 & 4 259 1994

This article describes the requirements and procedures applicable to provisional patent applications and how those requirements and procedures differ from those applicable to other types of patent applications. The article also discusses some of the benefits, risks, and filing strategies associated with provisional applications.

Vietzke, Lance L., *Software As the Article of Manufacture in Design Patents for Icons* 21 2 138 1993

This article argues that the software which produces an icon is the article of manufacture. The article then discusses the overlap of patent and copyright protection, and the history of the Xerox Corp. cases. Finally, the article discusses why the software itself is the article of manufacture in design patents for software.

Wachter, Mark F., *Patent Enforcement in Japan: An American Perspective for Success* 19 1 59 1991

This article, written by an American attorney litigating in Japan, outlines the basics of Japanese patent enforcement proceedings. The goal of the article is to provide a guide for attempting to enforce a Japanese patent in the Japanese court system to a foreign attorney with little knowledge of the system.

Waldbaum, Maxim H. & David Sipiora, *Pennwalt Redux - Judicial Uncertainty vs. Procrustean Bed* 19 3 237 1991

Functionality and Free Market Theory 17 3 173 1989
This article identifies and analyzes two interfaces between patent and copyright – the "statutory subject matter" interface (*i.e.*, what may be protected by patents and copyrights respectively) and the "protection" interface (*i.e.*, the scope of exclusivity granted under patents and copyrights respectively). In the course of this analysis, models for defining these interfaces are developed, which are then considered with regard to their respective economic consequences. The conclusion is that having an overlapping subject-matter interface should not have significant anti-competitive effects, while the same cannot be said for an overlapping protection interface. To avoid the adverse consequences of an overlapping protection interface, the doctrine of "functionality," as developed in trademark and unfair competition law, is proposed for separating "idea" from "expression" in the context of computer programs.

Pagenberg, Dr. Jochen, I,
The WIPO Patent Harmonization Treaty 19 1 1 1991
This article summarizes the proposed WIPO Treaty. It briefly examines each article of the Treaty, discussing the background of the provision and the significance of it. The author advocates adoption of the Treaty.

Reiss, Steven M., *Applying the Effects Test Theory of Personal Jurisdiction in Patent Infringement Actions* 23 1 99 1995
This article examines the basis for the effects test theory, its application in intellectual property cases, and how it may be applied by the Federal Circuit.

Ropski, Gary M. & Pamela J. Johnson,
A "Nonobvious" Framework for Analyzing Proof of Secondary Meaning 11 3 211 1983
The concepts provided for analyzing nonobviousness problems in patent law provide a helpful parallel framework for analysis of secondary meaning problems -- particularly with proof and factual inquiries-- faced by trademark law.

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The Classic Defenses Updated 15 2 &3 209 1987
This article explores the "in public use" or "on-sale" defenses which an accused patent infringer may raise. Other defenses that are covered include enablement and best mode,

This article addresses the legal and ethical issues of patenting new animal life raised within traditional Jewish law. The article discusses biotechnology patents and the U.S. system. The article compares traditional Jewish law to U.S. law regarding protection to inventions of living matter.

Kaufman, Page M., *An Empirical Study of the Effect of Patent Invalidity Judgments on the Abnormal Returns of Publicly Traded Securities* 19 4 282 1991

This article seeks to explore the valuation of patents by examining in particular the value of patents from the perspective of publicly traded securities. It focuses on the effect on the return on the stock of a publicly traded corporation when a court holds one or more of that corporation's patents invalid.

Korniczky, Stephen S. & Don W. Martens, *Verdict Forms -A Peek into the "Black Box"* 23 4 617 1995

This article discusses use of special verdicts and written interrogatories under Rule 49 of the Federal Rules of Civil Procedure and how proper use of these devices can alleviate concerns normally associated with jury trials in patent cases.

Kraus, Heidi L., *A Different New Matter Standard for Biotechnology Patent Applications Accompanied By a Deposit* 25 1 101 1997

This article discusses whether a biological deposit can and should overcome a deficiency in the disclosure of a biotechnology patent application due to material error, so that the error can be corrected without adding new matter. The article contends, that in certain cases, a biological deposit may render material errors inconsequential because the error would be obvious, to one skilled in the art, upon examination of the deposit. The article proposes a different new matter standard for biotechnology applications that are accompanied by a deposit.

Larson, Ronald B., *Balancing the Competing Policies Underlying the Doctrine of Equivalents in Patent Law* 21 1 1 1993

This article discusses the current standards for the Doctrine of Equivalents and why they are inadequate. The article then discusses the fundamentals of functional cooperation analysis. The article proposes functional cooperation

desirable result with respect to basic damages or reasonable royalty awards.

Fiorito, Edward G., *The WIPO "Basic Proposal" for Harmonization of Patent Laws Viewed From the U.S. Practitioner's Point of View* 19 1 24 1991
This article briefly summarizes the 24 substantive provisions of the WIPO draft treaty and comments on the impact harmonization will have on U.S. patent laws. The author also includes background to the proposed provisions, including the positions of the participants who drafted the treaty.

Forstner, James A., *International Business Implications of the U.S. Best Mode Requirement* 21 2 157 1993
This article examines the U.S. "best mode" requirement. The article examines whether there are similar requirements in foreign countries, and analyzes whether foreign applicants meet the best mode requirement.

Frank, Peter B. & Michael J. Wagner, *Computing Lost Profits and Reasonable Royalties* 15 4 391 1987
This article describes the analytical tasks required to satisfy the standards of proof for lost profits. The accounting issues surrounding the computation of the patent owner's lost profits on sales that would have been made absent the infringer's unlawful behavior, are also covered. Finally, issues surrounding the computation of a reasonable royalty payable to a patentee are addressed in cases involving unlawful manufacture, or use or sale of the patented product by the infringer.

Groff, Bradley K., *Bare-Fisted Competition Or Palming Off? Protection of Product Design As Trade Dress Under the Lanham Act* 23 1 65 1995
This article argues that courts must make a greater effort to distinguish the design of a product itself from that of a product's packaging or labeling, recognizing that the former is typically protectible, if at all, only under the patent laws, whereas the latter is generally trade dress, protectible under the Lanham Act.

Haley, Jeffrey T., *Strategies and Antitrust Limitations for Multiple Potential Patent Infringers* 21 4 327 1993

Thompson, William S., *Reforming the Patent System for the 21st Century* 21 3 171 1993
This article discusses various problems with the current patent system. It analyzes patent system constituencies, patent system parameters, and the opportunity for patent system reassessment.

Patents

Adamo, Kenneth R., *Introduction* 15 2 & 3 71 1987
Adamo, Kenneth R., *Basic Motion Practice for the Accused Infringer* 15 2 & 3 123 1987
This article explores the various Federal Rules of Civil Procedure, which can be used in aggressive motion practice by the accused infringer. The article advocates a well-planned motion practice for accused infringers, to narrow the issues, shape a more favorable case, and/or quickly kill one or all of the patentee's charges.
Adamo, Kenneth R., *Answered Questions: New Developments Regarding Inequitable Conduct and Violation of the (Statutory) Duty of Disclosure* 16 2 182 1988
The article reviews precedent on issues of fraud, inequitable conduct and violation of the statutory duty of disclosure in the patent context. It focuses specifically on the evolutionary changes and sometimes inconsistent result brought about by the Federal Circuit's decisions.
Barnhardt, John J., III, *Counterclaiming in Patent Infringement Litigation* 15 2 & 3 175 1987
This article examines the limitations of various counterclaims potentially available to the accused patent infringers in patent infringement actions for recovering damages, costs or fees from patentees who sue on inequitably obtained patents, further an anti-competitive purpose, or otherwise proceed in bad faith. The author concludes that liability for damages that are proximately caused by the bad faith assertions of the patent should not be made to depend upon the accused infringer's ability to establish malice, intent to defraud, or dominance of some cognizable product or geographic market. Also, liability should not depend on proof that the patent is being asserted in furtherance of a combination in restraint of trade or some other antitrust violation or unfair trade practice. Ultimately, a balance must be struck which

The author asserts that the examination of a patent application should be conducted ex parte, and should be exclusively governmental. An inter partes system should be added to the United States system, as is used in both Europe and Japan.

Patent Office Rule 56

Hoffman, Gary M. & Michael C. Greenbaum,
The Duty of Disclosure Requirements 16 1 124 1988
This article outlines the positions of the courts and the PTO regarding the duty of disclosure requirement. It also sets forth procedures which attorneys and agents can follow to comply with the new requirements.

Tegtmeyer, Rene D., *The Patent and Trademark Office View of Inequitable Conduct Or Attempted Fraud in the Patent and Trademark Office* 16 1 88 1988
This article addresses concerns regarding the adverse impacts of the duty of disclosure requirement. It addresses the AIPLA resolution. It also states key concerns of the PTO with how the duty of disclosure is designed to improve the quality of examination.

Patent Solicitation

DeGrandi, Joseph A., *The Attorney Client Privilege in Client Solicitation* 12 2 114 1984
This article deals with the scope of the attorney-client privilege as applied specifically to the patent field, primarily from the point of view of the private practitioner dealing with clients, both individual and small companies and corporations which do not have in-house patent counsel. The author has revised and updated the article which first appeared in AIPLA Quarterly Journal, Vol. 3, No. 2 (1975), taking into account the numerous decisions involving attorney-client privilege as it relates to patents.

Patent System

Bloomberg, Coe A.,
In Defense of the First-To-Invent Rule 21 3 255 1993
This article addresses divergent views regarding the first-to-invent system.

Bolan, Robert O. & William C. Rooklidge,
Imputing Knowledge to Determine Willful Patent Infringement 24 1 157 1996

This article examines an alternative to costly and lengthy Intellectual Property litigation -- the Magistrate System. This article discusses the history and creation of the Magistrate system, the practice under the current Magistrate system, forum shopping under the Magistrate system, the limits on Magistrate jurisdiction, and characteristics of the Magistrate system.

Duft, Bradford J., *Patent Infringement and Biotechnology* 16 3 & 4 339 1988

This article describes and discusses the few contemporary biotechnology court opinions and decisions with respect to infringement as well as related questions of validity and how the requirement of proper claim interpretation affects these issues.

Franzosi, Mario & Giustino de Sanctis, *The Increasing Worldwide Significance of European Patent Litigation* 25 1 67 1997

This article discusses the possibility of litigating, in a single European country, the infringement of patents granted in other European and non-European countries. The article cites the Brussels Convention and the Lugano Conventions as permitting such litigation.

Hofer, Roy E., *The CAFC and Fact/Law Questions in Patent Cases: The Jury's Role Burgeons!* 12 4 295 1984

This article focuses on the Court of Appeals for the Federal Circuit and its effect on patent cases, particularly on what it has done in the area of fact/law questions in patent infringement cases, the effect upon trial and appellate review of patent infringement cases, and the practical consequences of the Court of Appeals for the Federal Circuit labors in these areas.

Lynch, John F., *An Argument for Eliminating the Defense of Patent Unenforceability Based on Inequitable Conduct* 16 1 7 1988

This article examines the fraud inequitable conduct defense in patent litigation cases. The author's argument is that the defense of unenforceability, because of inequitable conduct in the Patent and Trademark Office, should not be available in private patent litigation to render unenforceable a patent that is otherwise valid.

Parker, Henrik D., *Doctrine of Equivalents*

examines the current state of patent law and the effect that the first-to-file system would have on American patent law.

McGrath, Richard J., *The Unauthorized Use of Patents by the United States Government or Its Contractors* 18 4 349 1990

Although a patent gives the patent owner the right to exclude others from making, using, or selling an invention covered by his patent, pursuant to 28 U.S.C. section 1498(a), the United States Government has the right to use any U.S. patent, and the patent owner may exclude neither the Government nor its contractors from the use. This article discusses the option to file an administrative claim against the Government or to sue in U.S. Claims Court for just compensation for the unauthorized use of a patent.

Samuelson, Pamela, *Survey on the Patent/Copyright Interface for Computer Programs* 17 3 256 1989

In the fall of 1988, AIPLA surveyed its members on a set of issues relevant to the patent/copyright interface for computer programs. This article reports the author's analysis of the results of the survey. The survey results showed there is a significant degree of exclusivity between patent and copyright law. There was, however, disagreement about whether the two laws are completely mutually exclusive, or overlap to some degree.

Stern, Richard H., *Tales From the Algorithm War: Benson to Iwahshi, It's Deja Vu All Over Again* 18 4 371 1990

In its latest decision on algorithms, in *In re Iwahshi*, the Federal Circuit has effectively thrown the patent system's doors wide open to protection of algorithms if the correct formalities are observed. This article examines how this came to be and questions the sensibility of the result. It further considers whether there may be some better way to protect algorithms within the context of Intellectual Property Law.

Stern, Richard H., *On Defining the Concept of Infringement of Intellectual Property Rights in Algorithms and Other Abstract Computer-Related Ideas* 23 3 401 1995

This article extrapolates from the concepts of copyright infringement and patent infringement under existing law, to define a concept of infringement of intellectual property

In patent cases, with increasing frequency, attention is focusing on the conduct of attorneys. Typically, this occurs when a defense of reliance on an opinion of counsel is raised to a charge of willful patent infringement. This also happens in cases involving charges of inequitable conduct in the PTO when the alleged wrongdoer is the patent solicitor. There is pressure, then, to make the attorney a material fact witness. If the attorney does not testify, opposing counsel may raise a negative inference from the failure of the attorney to testify. The article explores this adverse inference rule.

Vietzke, Lance L., *Software As the Article of Manufacture in Design Patents for Icons* 21 2 138 1993

This article argues that the software which produces an icon is the article of manufacture. The article then discusses the overlap of patent and copyright protection, and the history of the Xerox Corp. cases. Finally, the article discusses why the software itself is the article of manufacture in design patents for software.

Walterscheid, Edward C., *Priority of Invention: How the United States Came to Have a "First-to-Invent" Patent System* 23 2 263 1995

The purpose of this article is to explore how, when, and why the United States adopted a "first-to-invent" patent system.

Patent Infringement and Imports

Krosin, Kenneth E. & Holly D. Kozlowski, *Patent Based Suits At the International Trade Commission Following the 1989 Amendments to Section 337* 17 1 47 1989

Section 337 of the Tariff Act of 1930 provides U.S. patent holders with an action to prevent the importation or sale of any product that violates a U.S. patent. The authors believe that amendments to this Act passed in 1988 that make it easier to demonstrate violations and obtain relief will result in an increase in actions brought. The article describes a Section 337 suit in detail and provides suggestions and advice for practitioners.

Patent Law

Goldberg, Morton David & John F. Burleigh, *Copyright Protection for Computer Programs: Is the Sky Falling?* 17 3 294 1989

and Reissue/Reexamination: The First Three Years 13 3 & 4 220 1985

This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Lewis, Jeffrey I.D., *Curing Double Patenting During Prosecution and After Issuance: When Once is Never Enough and Twice is Too Much* 21 1 34 1993

This article discusses double patenting. The article covers five double patenting decisions from the U.S. Court of Appeals for the Federal Circuit.

Lynch, John F., *An Argument for Eliminating the Defense of Patent Unenforceability Based on Inequitable Conduct* 16 1 7 1988

This article examines the fraud inequitable conduct defense in patent litigation cases. The author's argument is that the defense of unenforceability, because of inequitable conduct in the Patent and Trademark Office, should not be available in private patent litigation to render unenforceable a patent that is otherwise valid.

Marshall, John J., *Proximate Causation As the Grand Unification Theory of Patent Damages: An Analysis of Rite-Hite v. Kelley and King Instruments v. Perego* 23 4 645 1995

This article demonstrates that proximate causation is a grand unification theory that unites prior patent damage theories, such as lost profits based upon entire market value, projected sales, convoyed sales, replacement parts, and price erosion. The article also guides the practitioner in investigating the potential damage claims available for each case of patent infringement.

Mintz, Herbert H. & Richard B. Racine, *Anticipation and Obviousness in the Federal Circuit* 13 3 & 4 171 1985

when the alleged wrongdoer is the patent solicitor. There is pressure, then, to make the attorney a material fact witness. If the attorney does not testify, opposing counsel may raise a negative inference from the failure of the attorney to testify. The article explores this adverse inference rule.

Patent Cases

Bolan, Robert O. & William C. Rooklidge, *Imputing Knowledge to Determine Willful Patent Infringement* 24 1 157 1996

Imputing knowledge of an employee to that employee's corporation in cases of willful patent infringement should only occur following the standards of agency law: where the employee has actual knowledge of the patent, understands its importance, and has a duty to report his or her knowledge to the corporation.

Brown, Harold R. III, *Proof of Lost Profits Damages Following Rite-Hite v. Kelley* 23 4 577 1995

This article first summarizes key points of the *Rite-Hite* decision. It then provides a review of Federal Circuit decisions relating to proof of lost profits damages generally.

Duft, Bradford J., *Patent Infringement and the United States Court of Appeals for the Federal Circuit* 13 3 & 4 342 1985

This article is an overview of issues before the United States Court of Appeals for the Federal Circuit in its first three years. The author discusses the Court's treatment of several issues, including contributory, willful, and inducing infringement, as well as the defenses of "prosecution history estoppel," the "reverse doctrine of equivalents," "experimental use," and intervening rights.

Heinke, Lowell L., *Is Intent An Important Element of Inequitable Conduct in the Patent and Trademark Office?* 16 1 21 1988

The author comments on the changing definition of "gross negligence" and the role of intent as an element of inequitable conduct. It is difficult to advise clients about enforcing their patents, he says, while these definitions are changing.

Irani, Rita M., *The New Skirmish in Patent Cases: Who Goes First At Trial and With What Evidence* 17 4 364 1989

in this volume relating to the Uruguay Round Agreement and its implementation in the United States.

Bryant, Dr. J. Howard & Donald P. Stein, *Automating the U.S. Patent Office* 11 1 & 2 25 1983

Herrell, Roger W. & Donald R. Piper, Jr., *Concurrent Use and Registration Rights* 11 3 177 1983

Holm, Chris L., *Patent Prosecution Comparison Between the United States Patent and Trademark Office and the European Patent Office* 25 2 233 1997

Article examines four specific questions: (1) Is there a significant difference in the average prosecution time from the application filing date to the grant date for applications filed in the U.S. Patent Trademark Office ("PTO") as compared with the European Patent Office ("EPO"), and what is the average term of protection following a patent grant by the EPO?; (2) Are there significant differences (as in the U.S.) in the average EP prosecution times from the application filing date to the grant date for chemical, electrical, and general applications?; (3) Is there a significant difference time from the application filing date to the grant date for applications that claim a U.S. priority as compared to applications that do not claim a U.S. priority?; and (4) Does an early demand or a late demand have a significant effect on the time from application filing date to grant date for EPO applications?

Stephens, Keith & John P. Sumner, *Patenting Software Objects and Other Aspects of Object-Oriented Programs Under the New PTO Guidelines* 23 2 221 1995

The purpose of this article is to inform the software industry of the availability and advantages of patenting object-oriented software, not only generally, but with respect to software objects. The article also reviews how courts have addressed the patentability of software objects, and predicts how courts will address the issue in the future.

Wegner, Harold C., *Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in An Era of International Patent Harmonization* 16 1 38 1988

The author asserts that the examination of a patent application should be conducted ex parte, and should be exclusively governmental. An inter partes system should be

Bennet, Joel R., *Patent Misuse: Must An Alleged Infringer Prove An Antitrust Violation?* 17 1 1 1989
Before 1988, it was established patent misuse doctrine that a patent owner, who either commits an antitrust violation sufficiently related to the patent, or who extends his or her patent beyond its temporal or physical scope, could not enforce the patent. In 1988, Congress passed the Patent Misuse Statute, which rejected the requirement that an alleged infringer establish an antitrust violation to prove patent misuse. This article analyzes why the author believes the Court of Appeals for the Federal Circuit will likely depart from this established policy in the face of the 1988 law.

Casey, Kevin R., *Identification of Trade Secrets During Discovery: Timing and Specificity* 24 1 191 1996
Under the proposed procedural approach (compiled through state and federal case law and the author's own experience), different stages of litigation in trade secret misappropriation require different degrees of specificity in pleading and proof on the part of the plaintiff.

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985
This article summarizes the Federal Circuit's examination of two separate issues in its first three years -- non-art rejections/defenses and reissue/reexamination. In terms of non-art rejections/defenses, the author covers issues arising under 35 U.S.C. sections 101 and 112, including printed matter, computer programs, and definiteness. The author also covers double patenting, licensing, and antitrust/misuse issues. In the area of reissue/reexamination, the author covers intervening rights and constitutionality.

Rudisill, Stephen G. & Richard C. Auchterlonie, *The Classic Defenses Updated* 15 2 & 3 209 1987
This article explores the "in public use" or "on-sale" defenses which an accused patent infringer may raise. Other defenses that are covered include enablement and best mode, inequitable conduct, misjoinder/non-joinder of inventors, misuse, and estoppel.

Waldbaum, Maxim H. & David Sipiora,

of Personal Jurisdiction in Patent Infringement Actions 23 1 99 1995

This article examines the basis for the effects test theory, its application in intellectual property cases, and how it may be applied by the Federal Circuit.

Magistrates

Bovee, Warren R., *Court Review of Magistrate's and Master's Decisions* 12 3 245 1984

This article provides an overview of the review of reports, findings, recommendations, and determinations made by Masters and Magistrates.

Burnett, Arthur L., Sr., Magistrate, *The Potential for Greater Utilization of Magistrates in Intellectual Property Cases As Viewed By a Magistrate* 12 3 201 1984

This article elaborates upon the role of United States Magistrates in civil litigation as functional deputy judges in handling pretrial discovery disputes and pretrial settlement conferences, and in serving as substitute district judges in civil cases tried by consent before the United States Magistrate.

Coolley, Ronald B., *Magistrates: What They Are and How They Can Be Used in Litigation* 12 3 186 1984

This article examines an alternative to costly and lengthy intellectual property litigation -- the Magistrate System. This article discusses the history and creation of the Magistrate system, the practice under the current Magistrate system, forum shopping under the Magistrate system, the limits on Magistrate jurisdiction, and characteristics of the Magistrate system.

Parrett, Sherman O., *The Expanded Authority of U.S. Magistrates: Has Congress Exceeded Constitutional Limits?* 12 3 212 1984

This article analyzes the constitutionality of the expanded powers of U.S. Magistrates, who do not have life tenure or undiminishable salaries. Under current law, U.S. Magistrates, upon consent of the parties, have the authority to try civil cases and enter judgments. The U.S. Court of Appeal for the First, Second, Third, Fifth, and Ninth Circuits have held this procedure to be constitutional. This article

payable to a patentee are addressed in cases involving unlawful manufacture, or use or sale of the patented product by the infringer.

Franzosi, Mario & Giustino de Sanctis, *The Increasing Worldwide Significance of European Patent Litigation* 25 1 67 1997
This article discusses the possibility of litigating, in a single European country, the infringement of patents granted in other European and non-European countries. The article cites the Brussels Convention and the Lugano Conventions as permitting such litigation.

Hnath, Gary M. & James M. Gould, *Litigating Trade Secret Cases At the International Trade Commission* 19 2 87 1991
This article raises and discusses issues and concerns that may arise in the course of litigation of trade secret misappropriation cases under Section 337 of the Tariff Act, from the preparation and filing of the complaint through the remedy phase.

Janicke, Paul M., *Heat of Passion: What Really Happened in Graver Tank* 24 1 1 1996
Examining the history and application of the Doctrine of Equivalents in patent law provides strong evidence in favor of abolishing the doctrine. Even if the doctrine is maintained in the fields of chemistry and biology (where broadened reissues will not prevent unscrupulous claims), judicial intervention should be a valid remedy in those areas.

Janicke, Paul M. & Roger S. Borovoy, *The Minitrial Approach to Resolving Patent Disputes* 11 4 258 1983
This article discusses how arbitration and mediation were used to reduce the complexity and expense of patent trials in *Shell v. Intel* and *Telecredit v. TRW*, respectively.

Lyerla, Bradford P. & Manuel A. Abascal, *Insurance Coverage for Intellectual Property Claims: The California vs. The New York Approach* 19 3 189 1991
This article summarizes the different approaches to the issue of whether there exists insurance coverage for intellectual property claims under comprehensive business liability

Szczepanski, Steven Z., *Licensing or Settlement: Deferring the Fight to Another Day* 15 2 & 3 298 1987
An accused patent infringer should always consider obtaining a license under a patent. Considering other alternatives is appropriate when the accused infringer wants to pay up to terminate the controversy, or when the accused infringer is contemplating a challenge to the patent or its scope. By taking the license, the accused infringer eliminates the risk of patent litigation and defers the final decision to challenge indefinitely the license. This provides insurance and keeps the option to litigate open. These benefits should be thoroughly considered before commencing litigation.

Litigation

Adamo, Kenneth R., *Basic Motion Practice for the Accused Infringer* 15 2 & 3 123 1987
This article explores the various Federal Rules of Civil Procedure, which can be used in aggressive motion practice by the accused infringer. The article advocates a well-planned motion practice for accused infringers, to narrow the issues, shape a more favorable case, and/or quickly kill one or all of the patentee's charges.

Barnhardt, John J., III, *Counterclaiming in Patent Infringement Litigation* 15 2 & 3 175 1987
This article examines the limitations of various counterclaims potentially available to the accused patent infringers in patent infringement actions for recovering damages, costs or fees from patentees who sue on inequitably obtained patents, further an anti-competitive purpose, or otherwise proceed in bad faith. The author concludes that liability for damages that are proximately caused by the bad faith assertions of the patent should not be made to depend upon the accused infringer's ability to establish malice, intent to defraud, or dominance of some cognizable product or geographic market. Also, liability should not depend on proof that the patent is being asserted in furtherance of a combination in restraint of trade or some other antitrust violation or unfair trade practice. Ultimately, a balance must be struck which affords patentees free access to the courts to protect their rights, but which also affords accused infringers a reliable non-technical remedy for bad faith assertions of patents known to be invalid or not infringed.

meeting the information needs of the intellectual property fields. This double volume includes articles authored by both commercial proprietors and experts in the field.

Ropski, Gary M. & Pamela J. Johnson, *A "Nonobvious" Framework for Analyzing Proof of Secondary Meaning* 11 3 211 1983
The concepts provided for analyzing nonobviousness problems in patent law provide a helpful parallel framework for analysis of secondary meaning problems -- particularly with proof and factual inquiries-- faced by trademark law.

Sprowl, James A., *Dialog, LEXIS & Westlaw: Using the Computer Search Through Legal and Technological Data Bases* 11 1 & 2 90 1983
The techniques of legal research and searches using three major patent database information providers -- Dialog, LEXIS, and Westlaw -- are compared and contrasted, as well as described generally, for their utility to a practitioner.

Terragno, P. James, *Patent Information From Pergamon* 11 1 & 2 81 1983
At print time, the electronic publishing arm of the company Pergamon provides a service called "Video Patsearch," which allows retrieval and display of patent drawings along with text, among other described services, which are described in detail.

Wratschko, Dr. Werner, *INPADOC - International Patent Documentation Center - History - Present Status - Future* 11 1 & 2 61 1983
At print time, the Austrian limited liability company INPADOC has information on 10 million international patent documents and provides services using computer output on microfiche, magnetic tape, on-line services, responses to individual requests for information, and performs patent document copy service. This article describes this in detail.

Licensing

Brinton, Joyce, *Biotechnology Licensing: Issues From the University Perspective* 16 3 & 4 479 1988
This article asks questions and addresses common concerns of universities regarding university licensing for biotechnology innovations.

Forman, David S. & Thomas W. Winland, *How*

The PTO automation plan established in 1982 is expected to meet the objectives of improving the integrity of the data base and maintaining search quality while resulting in a net cost benefit to quickly make up for the initial financial investment.

Daniszewski, Joseph P., *Patent Information Retrieval in Practice* 11 1 & 2 120 1983

Du Pont, which as of print time has been granted 26,000 U.S. patents, has found that bibliographic information is available from commercial databases for 23,600 of those patents. The Master Plan of the U.S. PTO represents a valid approach to improving searching ability for patents in response to problems the company has faced in storing and retrieving patent information.

Devitt, Veronica Colby, *Coping with Statutes Which "Muddy the Waters" of Trademark Practice* 11 3 236 1983

State statutes -- particularly regarding trade name registration, trademark registration, banking and other professions, and franchising -- can directly and indirectly affect trademark owners' rights. In some cases, awareness provides enough protection to a client; in others, more affirmative action is warranted.

Hearn, Robert L., *Full-Text Patent Information Retrieval With LEXPAT* 11 1 & 2 73 1983

At print time, Mead's LEXPAT is a searchable electronic library with the full text of every patent issued by the U.S. PTO since 1975 (over 500,000 total), adding approximately 70,000, as they are issued. Searching information and other services are described in detail.

Herrell, Roger W. & Donald R. Piper, Jr., *Concurrent Use and Registration Rights* 11 3 177 1983

Knowledge of a third-party's rights is beneficial to a trademark registrant in asserting their own rights before either the PTO or the courts; the good-faith exception for concurrent user's rights will be upheld when properly established in the forum.

Janicke, Paul M. & Roger S. Borovoy, *The Minitrial Approach to Resolving Patent Disputes* 11 4 258 1983

This article provides an overview of the review of reports, findings, recommendations, and determinations made by Masters and Magistrates.

Judiciary Views

Costantino, Hon. Mark A. & Daniel L. Master, Jr., *The Seventh Amendment Right to Jury Trial in Complex Civil Litigation: Historical Perspectives and a View From the Bench* 12 4 279 1984

This article examines the advisability of establishing a complexity exception to the Seventh Amendment and proposes an effective alternative means by which goals of the proponents of both positions can be achieved.

Einhorn, Harold, *The Control Group Problem in a Large Corporation - Revisited* 12 2 103 1984

This article is an update of one which appeared in AIPLA Quarterly Journal, Vol. 3 (1975). The article focuses on the attorney client privilege and particularly how it is applied to corporations through the control group test. The article discusses the position of the United States Supreme Court on the control group rules as well as what federal rules of evidence have to say about it. The article further addresses the interactions of the control group test and state law and any practical consideration that arise.

Hofer, Roy E., *The CAFC and Fact/Law Questions in Patent Cases: The Jury's Role Burgeons!* 12 4 295 1984

This article focuses on the Court of Appeals for the Federal Circuit and its effect on patent cases, particularly on what it has done in the area of fact/law questions in patent infringement cases, the effect upon trial and appellate review of patent infringement cases, and the practical consequences of the Court of Appeals for the Federal Circuit labors in these areas.

Jurisdiction

Ritscher, Michael A., Albert Tramposch, Thomas J. O'Connell & Lisa Barons, *The Status of Dual Path Litigation In the ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review* 18 2 155 1990

This article examines how imported products can be challenged in dual path litigation involving the same parties and the same rights in both civil court and before the ITC. The article reviews the status of these jurisdictional issues, as

Burnside, Michael, *Chemical Patent Practice in Great Britain* 13 1 33 1985
This article examines the effects of the European Patent Convention on British Patent Law. The article also highlights the changes that the British Patent Act of 1977 has made to the system in Great Britain.

Lederer, Dr. Franz, *Chemical Patent Practice in the Republic of Germany* 13 1 52 1985
This article discusses recent developments in West German Patent Law, highlighting the areas of novelty, technical advance, inventive step, sufficiency of disclosure, unity of invention, claim structure, and specific inventions.

Nishitate, Kazuyuki, Yukio Uchida & Takashi Ishida, *Japanese Chemical Patent Practice* 13 1 66 1985
This article discusses recent developments in Japanese patent law, highlighting the areas of novelty, technical advance, inventive step, sufficiency of disclosure, unity of invention, claim structure, and specific inventions.

Pantuliano, Michael J., *Chemical Patent Practice in the United Kingdom, West Germany, the European Patent Office and Japan -- Some Significant Differences* 13 1 9 1985
Despite the advent of the European Patent Convention, differences still exist in the area of patent procurement among the several signatories. Furthermore, the differences between the Japanese Patent system and the European system have become even more pronounced. This article summarizes some of the differences, highlighting the areas of novelty, unity of invention, sufficiency of disclosure, claim structure, pharmaceuticals, and scope of claim protection.

International Trade Commission

Hnath, Gary M. & James M. Gould, *Litigating Trade Secret Cases At the International Trade Commission* 19 2 87 1991
This article raises and discusses issues and concerns that may arise in the course of litigation of trade secret misappropriation cases under Section 337 of the Tariff Act, from the preparation and filing of the complaint through the remedy phase.

Krosin, Kenneth E. & Holly D. Kozlowski, *Suits At the International Trade Commission*

the article is on China's perception of intellectual property rights. The article then discusses the progress that China has made in enforcing intellectual property rights. The author also proposes enforcement strategies to U.S. practitioners.

Curchod, Francois, *The Revision of the Hague Agreement Concerning the International Deposit of Industrial Designs* 24 2, 3, 4 599 1996

An outline of the new draft attempts to reconcile two conflicting goals of the revision of the Hague Agreement: attracting into the system countries with examining offices, such as the U.S. and Japan, while offering to applicants a simple, quick, and affordable means of obtaining protection for their designs abroad.

Forstner, James A., *International Business Implications of the U.S. Best Mode Requirement* 21 2 157 1993

This article examines the U.S. "best mode" requirement. The article examines whether there are similar requirements in foreign countries, and analyzes whether foreign applicants meet the best mode requirement.

Fuller, I.L. Pep, *Intellectual Property Rights Associated With Biotechnology -- An International Trade Perspective* 16 3 & 4 529 1988

This article advocates an increase in IPR protection in foreign countries. It encourages companies to support national laws and international agreements that give IPR protection to products and processes of biotechnology.

Goffney, Lawrence J., Jr., *The New Patent and Trademark Paradigm for Design Patents* 24 2, 3, 4 317 1996

A review of the national design protection and a call for a more comprehensive international protection in the face of new computer technologies. The author insists that in this new computer age, countries will have to cooperate in this effort.

International - Copyright

Arden, Thomas P., *The Conflicting Treatments of Compilations of Facts Under the United States and British Copyright Laws* 19 4 268 1991

This article explores the divergence between the United States and British copyright laws concerning the protection of compilation of facts. It focuses on the change in the U.S.

from the preparation and filing of the complaint through the remedy phase.

Robinson, William J., *Insurance Coverage of Intellectual Property Lawsuits* 17 2 122 1989
Comprehensive General Liability insurance may be used to pay the costs of defending almost any type of claim in an intellectual property case, including copyright, trademark, and trade name infringement, misappropriation of trade secrets, violation of the antitrust laws, and unfair competition. This article explores the structure and interpretation of an insurance policy, important statutes which affect these policies, the insured's obligations, advertising injury, and contractual liability coverage, discoverability of insurance, and bad faith issues.

Intellectual Property Cases

Burnett, Arthur L., Sr., Magistrate, *The Potential for Greater Utilization of Magistrates in Intellectual Property Cases As Viewed By a Magistrate* 12 3 201 1984
This article elaborates upon the role of United States Magistrates in civil litigation as functional deputy judges in handling pretrial discovery disputes and pretrial settlement conferences, and in serving as substitute district judges in civil cases tried by consent before the United States Magistrate.

Interference Law

Fisher, Bernard, *A European View Relating to Interference Issues in a First-to-File World* 18 1 52 1990
This article analyzes the first-to-file system and suggests that filings should be broader than anything one could hope to obtain a patent for, because one can always restrict an application but not enlarge the scope.

Gholz, Charles L., *How the United States Currently Handles the Interference Issues That Will Remain in a First-to-File World* 18 1 1 1990
This article outlines the manner in which interference proceedings are currently handled in the United States, and discusses amending this system to follow the Canadian, European, and/or Japanese systems.

Harrison, David C., *Interference Questions in Europe* 18 1 65 1990

opposed to extreme proposals that would change the law. He believes we should proceed slowly and cautiously in making any changes.

Heinke, Lowell L., *Is Intent An Important Element of Inequitable Conduct in the Patent and Trademark Office?* 16 1 21 1988
The author comments on the changing definition of "gross negligence" and the role of intent as an element of inequitable conduct. It is difficult to advise clients about enforcing their patents, he says, while these definitions are changing.

Hoffman, Gary M. & Michael C. Greenbaum, *The Duty of Disclosure Requirements* 16 1 124 1988
This article outlines the positions of the courts and the PTO regarding the duty of disclosure requirement. It also sets forth procedures which attorneys and agents can follow to comply with the new requirements.

Lynch, John F., *An Argument for Eliminating the Defense of Patent Unenforceability Based on Inequitable Conduct* 16 1 7 1988
This article examines the fraud inequitable conduct defense in patent litigation cases. The author's argument is that the defense of unenforceability, because of inequitable conduct in the Patent and Trademark Office, should not be available in private patent litigation to render unenforceable a patent that is otherwise valid.

Pretty, Laurence H., *Inequitable Conduct Before the PTO - The Law in the Federal Circuit* 13 3 & 4 240 1985
Although the Federal Circuit has criticized the defense of inequitable conduct before the PTO, several decisions have lowered the threshold for this defense. Materiality has been the most subjective of the available standards, asking whether there is a likelihood that a "reasonable" examiner would have considered the information "important" to the allowance of claims. The standard of intent sets a ceiling on good faith as an excuse for nondisclosure by references to what an actor in the applicant's position would reasonably have considered material enough to require disclosure, applying the most embracing standard of materiality. The Court has reversed trial court findings on its own assessment of the inference of intent to be drawn from the level of

From the U.S. Practitioner's Point of View 19 1 24 1991
This article briefly summarizes the 24 substantive provisions of the WIPO draft treaty and comments on the impact harmonization will have on U.S. patent laws. The author also includes background to the proposed provisions, including the positions of the participants who drafted the treaty.

Pagenberg, Dr. Jochen, I, *The WIPO Patent Harmonization Treaty* 19 1 1 1991
This article summarizes the proposed WIPO Treaty. It briefly examines each article of the Treaty, discussing the background of the provision and the significance of it. The author advocates adoption of the Treaty.

Rosini, James E. & Christopher C. Roche, *Trademarks in Europe 1991 and Beyond* 19 3 213 1991
This article summarizes the changes in trademark law that have been happening within the European Community.

Wegner, Harold C., *Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in An Era of International Patent Harmonization* 16 1 38 1988
The author asserts that the examination of a patent application should be conducted ex parte, and should be exclusively governmental. An inter partes system should be added to the United States system, as is used in both Europe and Japan.

Imports

Krosin, Kenneth E. & Holly D. Kozlowski, *Patent Based Suits At the International Trade Commission Following the 1989 Amendments to Section 337* 17 1 47 1989
Section 337 of the Tariff Act of 1930 provides U.S. patent holders with an action to prevent the importation or sale of any product that violates a U.S. patent. The authors believe that amendments to this Act passed in 1988 that make it easier to demonstrate violations and obtain relief will result in an increase in actions brought. The article describes a Section 337 suit in detail and provides suggestions and advice for practitioners.

Inequitable Conduct

Adamo, Kenneth R., *Answered Questions: New Developments Regarding Inequitable*

337 Litigation 22 3 & 4 491 1994
This article discusses several significant developments in federal and ITC case law and assesses their potential long-term impact on Section 337 litigation.
Silverstein, David, *Will Pre-Grant Patent Publication Undermine United States Trade Secret Law?* 23 4 695 1995
This article discusses the change to pre-grant publication of patent applications and its impact on trade secret protection.
Van Horn, Charles E., *Practicalities and Potential Pitfalls When Using Provisional Patent Applications* 22 3 & 4 259 1994
This article describes the requirements and procedures applicable to provisional patent applications and how those requirements and procedures differ from those applicable to other types of patent applications. The article also discusses some of the benefits, risks, and filing strategies associated with provisional applications.
Geneva Patent Convention
Wegner, Harold C., *Patent Law Simplification and the Geneva Patent Convention* 14 3 154 1986
This article explores the major European and Japanese patent law simplifications of the past generation with a view toward determining which changes have worked well and should be introduced into the United States to put its research and development at a competitive parity with that of Europe and Japan. It also explores areas of change, particularly in Europe, that have failed to serve the cause of technological progress and should be altered by a harmonization treaty. The article then offers a number of specific proposals for revising and simplifying United States patent laws to make effective progress in achieving universal protection for U.S. technology.
Government Contracts
Virden, Prospere S., Jr. & Nancy A. Sutherland, *Releasability Under the Freedom of Information Act of Documents Submitted By Government Contractors* 12 1 50 1984
This article surveys issues relating to the release by the Government under FOIA of contractor-generated documents, with emphasis on preventive measures which

This article reviews some of the litigation and legislation surrounding the Freedom of Information Act and how members of the American Patent Bar are falling asleep at the switch when it comes to protecting trade secrets after the enactment of FOIA. This article looks at expectations of trade secret protection, the history of the FOIA in the courts and in Congress, and current interpretations of the Act as well as legislative prospects.

Virden, Prospere S., Jr. & Nancy A. Sutherland, *Releasability Under the Freedom of Information Act of Documents Submitted By Government Contractors* 12 1 50 1984

This article surveys issues relating to the release by the Government under FOIA of contractor-generated documents, with emphasis on preventive measures which may be utilized to best protect proprietary information from being divulged from a competitor. The article primarily addresses the regulations applicable to the Department of Defense, since it is the largest procurement activity in the nation and the possessor of countless contractor-generated documents. This article also outlines the procedures generally applicable to opposing release of proprietary information under FOIA and reviews statutory exceptions and exemptions that are the most useful to the government contractor. It also focuses on the types of contractor-generated documents frequently requested under FOIA and the regulations and case law which may be relied upon to persuade an agency or a court to deny a FOIA request.

GATT

Bickham, Timothy C., *Protecting U.S. Intellectual Property Rights Abroad With Special 301* 23 2 195 1995

This article examines Special 301 to provide a context in which to address its past performance, its current use, and the role it will play in the future.

Boland, Lois E., *GATT/TRIPS: A Response From the United States Patent and Trademark Office* 22 3 & 4 425 1994

This article provides the Patent and Trademark Office's responses and comments to several other articles published in this volume relating to the Uruguay Round Agreement and its implementation in the United States.

Forman, David S. & Thomas W. Winland, *How*

enforceable. If the conduct is sufficiently egregious, the court will refuse to enforce the associated patents as well, under the doctrine of unclean hands. This article suggests that courts take care to separate the doctrines of inequitable conduct and unclean hands. The answer depends on when, and before which body, the misconduct occurred. If the conduct occurs during patent prosecution before the PTO, the directly tainted patent is the only unenforceable patent. When the egregious conduct occurs during adversary proceedings before a court, the doctrine of unclean hands applies. This doctrine may render all of the associated patents unenforceable.

Lynch, John F., *New Rule 56: The Second Time Around* 20 3 & 4 144 1992

This article comments and observes the implications of the new Rule 56 and offers the best way practitioners might adjust their procedures in light of the new provisions. This article suggests that the new provisions will generate new issues and arguments of unenforceability, thrusting fraud and inequitable conduct to the forefront of patent litigation.

Manbeck, Harry F., Jr., *The Evolution and Issue of New Rule 56* 20 3 & 4 136 1992

This article sheds light into the evolution of Rule 56, the issues related to the rules various incarnations, and highlights several AIPLA recommendations.

Rowe, James L., *Fraud Statistics* 16 2 280 1988

This is a case study concluding that defense attorneys are optimistic about their ability to sustain a defense of fraud or misconduct. The figures also indicate that proof of relevance, intent, and scienter is more difficult than proving invalidity.

Tegtmeyer, Rene D., *A Refocusing On Inequitable Conduct in New Rule 56* 20 3 & 4 191 1992

This article examines the provisions of the new Rule 56 and focuses on the benefits of the new rule and their respective requirements, i.e., the clarification of the materiality standard, the inequitable conduct intent standard, the setting of content and time for Information Disclosure Statements, and the duty to disclose.

Wegner, Harold C., *Patent Simplification Sans Patent Fraud* 20 3 & 4 211 1992

On Associated Patents 17 4 338 1989
A patent applicant's commission or omission of certain acts may constitute fraud or inequitable conduct on the Patent and Trademark Office ("PTO"). Courts will not enforce patents issued on applications obtained by inequitable conduct. However, if the conduct is not too egregious, patents associated with the tainted patent may still be enforceable. If the conduct is sufficiently egregious, the court will refuse to enforce the associated patents as well, under the doctrine of unclean hands. This article suggests that courts take care to separate the doctrines of inequitable conduct and unclean hands. The answer depends on when, and before which body, the misconduct occurred. If the conduct occurs during patent prosecution before the PTO, the directly tainted patent is the only unenforceable patent. When the egregious conduct occurs during adversary proceedings before a court, the doctrine of unclean hands applies. This doctrine may render all of the associated patents unenforceable.

Irani, Rita M., *The New Skirmish in Patent Cases: Who Goes First At Trial and With What Evidence* 17 4 364 1989
This article examines the issue of who proceeds first at a patent trial. The issue was complicated when a Federal Circuit Judge suggested that courts consider trying the issues of patent infringement and validity separately. The author believes that it is best not to split these issues, unless the split is based on the Federal Rules of Evidence. For example, in the declaratory judgment situation, the defendant patentee has the burden of proving the affirmative of the infringement issue, and should therefore, go first. Also, trying inequitable conduct issues separately may reduce confusion. In general, though, courts should endeavor to reduce the complexity of trials by gaining more control over the trial itself, rather than breaking up the order of proof and confusing presentation of evidence to the jury.

Korniczky, Stephen S. & Don W. Martens, *Verdict Forms - A Peek Into the "Black Box"* 23 4 617 1995
This article discusses use of special verdicts and written interrogatories under Rule 49 of the Federal Rules of Civil

Marshall, John J., *Proximate Causation As the Grand Unification Theory of Patent Damages: An Analysis of Rite-Hite v. Kelley and King Instruments v. Perego* 23 4 645 1995
This article demonstrates that proximate causation is a grand unification theory that unites prior patent damage theories, such as lost profits based upon entire market value, projected sales, convoyed sales, replacement parts, and price erosion. The article also guides the practitioner in investigating the potential damage claims available for each case of patent infringement.

Mexic, Darryl & Kenneth Burchfiel, *Interference Law Developments in the Federal Circuit* 13 3 & 4 255 1985
The recent revision of the interference rules will effectively moot some of the points decided, e.g., those relating to the limited jurisdiction of the former Board of Patent Interfaces and the determination of what is ancillary to priority, because the jurisdiction of the newly-created Board of Patent Appeals and Interferences is considerably expanded, and now extends to matters such as patentability, which were outside the jurisdiction of the former Board. This article discusses how these changes have impacted the existing body in federal interference law.

Pretty, Laurence H., *Inequitable Conduct Before the PTO - The Law in the Federal Circuit* 13 3 & 4 240 1985
Although the Federal Circuit has criticized the defense of inequitable conduct before the PTO, several decisions have lowered the threshold for this defense. Materiality has been the most subjective of the available standards, asking whether there is a likelihood that a "reasonable" examiner would have considered the information "important" to the allowance of claims. The standard of intent sets a ceiling on good faith as an excuse for nondisclosure by references to what an actor in the applicant's position would reasonably have considered material enough to require disclosure, applying the most embracing standard of materiality. The Court has reversed trial court findings on its own assessment of the inference of intent to be drawn from the level of materiality of the withheld information. In light of these developments, it is likely that the inequitable conduct defense will continue to be used.

several cases that further delineate the Federal Circuit's treatment of frivolous appeals.

Brown, Harold R. III, *Proof of Lost Profits Damages Following Rite-Hite v. Kelley* 23 4 577 1995
This article first summarizes key points of the *Rite-Hite* decision. It then provides a review of Federal Circuit decisions relating to proof of lost profits damages generally.

Chambers, J. Robert, *Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit* 13 3 & 4 361 1985
This article addresses the role of the jury in patent trials. The author examines decisions of the Federal Circuit in its first three years, focusing first on the issue of obviousness, and concluding with an analysis of other issues, including infringement, the section 112 defenses, inequitable conduct, and damages.

Chisum, Donald S., *Remedies for Patent Infringement* 13 3 & 4 380 1985
Recent developments in the law of remedies for patent infringement have altered the economics of the patent system, making it more worthwhile to invest in obtaining patent protection, negotiating licenses, planning activity to avoid infringement, and suits against apparent infringers. The Federal Circuit has favored this trend, emphasizing that doubts on questions of the amount of monetary relief should be resolved in favor of the patent owner and against the infringer, and liberalizing the availability of preliminary injunctive relief against infringement. This article reviews the decisions of the Federal Circuit on the subject of remedies for patent infringements that were rendered in its first three years.

Duft, Bradford J., *Patent Infringement and the United States Court of Appeals for the Federal Circuit* 13 3 & 4 342 1985
This article is an overview of issues before the United States Court of Appeals for the Federal Circuit in its first three years. The author discusses the Court's treatment of several issues, including contributory, willful, and inducing infringement, as well as the defenses of "prosecution history estoppel," the "reverse doctrine of equivalents," "experimental use," and intervening rights.

strengthen the E.U.'s hand in international negotiations. This article examines the objectives that lie behind the European initiative and explains the legislative means chosen by the Commission to realize those objectives.

Experimental Use Exception

Israelsen, Ned A., *Making, Using and Selling Without Infringing: An Examination of 35 U.S.C. Section 271(e) and the Experimental Use Exception to Patent Infringement* 16 3 & 4 457 1988

This article analyzes the origin of the Doctrine of Experimental Use as a defense to patent infringement. It then analyzes modern cases considering Section 271(e) and the Experimental Use Doctrine. Finally, the author proposes an analytical framework within which experimental use issues can be evaluated.

Extinct Organisms

Rohrbaugh, Mike L., *The Patenting of Extinct Organisms: Revival of Lost Arts* 25 3 371 1997

This article assesses the patentability of regenerated organisms, after being extinct in nature, under utility patent provisions. It provides insight into how the technology of regenerating formerly extinct organisms relates to, and is consistent with, the patentability requirements of statutory subject matter, utility, novelty, and non-obviousness.

Fact/Law Distinction

Lee, Jerome G., *The Law-Fact Distinction - From Trial by Ordeal to Trial By Jury* 12 4 288 1984

This article examines the distinction between facts and law by examining the early status of the Fact-Law Distinction, the early recognition between matters of fact and law, promulgation of the statute of Westminister and the well recognition of the law and fact distinction.

Pravel, B.R., *Issues of Law and Fact At Appellate Level* 12 4 321 1984

This article examines issues of fact and law in both patent and trademark cases. With respect to patent cases the article discusses claim interpretation or construction, anticipation, obviousness, enablement under 35 U.S.C. § 112, utility and patent infringement. With regard to trademark cases, the article discusses the likelihood of confusion, the strength of

issues confronting the software industry today and in the future.

Europe - Patents

Bardehle, Heinz, *Equivalents and International Patent Law Harmonization* 20 2 119 1992
This article advocates the need for worldwide codification and harmonization of the Doctrine of Equivalents. This article also examines the World Intellectual Property Organization's initiative on protection scope and claim interpretation and urges for the full support of such an initiative.

Fiorito, Edward G., *The WIPO "Basic Proposal" for Harmonization of Patent Laws Viewed From the U.S. Practitioner's Point of View* 19 1 24 1991
This article briefly summarizes the 24 substantive provisions of the WIPO draft treaty and comments on the impact harmonization will have on U.S. patent laws. The author also includes background to the proposed provisions, including the positions of the participants who drafted the treaty.

Franzosi, Mario & Giustino de Sanctis, *The Increasing Worldwide Significance of European Patent Litigation* 25 1 67 1997
This article discusses the possibility of litigating, in a single European country, the infringement of patents granted in other European and non-European countries. The article cites the Brussels Convention and the Lugano Conventions as permitting such litigation.

Kalikow, Martin, *Automation of the European and the Japanese Patent Offices* 11 1 &2 33 1983
The differences in current and planned automation between the U.S. PTO, JPO & the EPO reflect differences in their patent systems; most notably, the EPO and the JPO have the ability to achieve "paperless" administrative data bases, but not "paperless" searching data bases under the communication and retrieval hardware and software available as print.

Pagenberg, Dr. Jochen, I, *The WIPO Patent Harmonization Treaty* 19 1 1 1991
This article summarizes the proposed WIPO Treaty. It briefly examines each article of the Treaty, discussing the

Conduct Or Attempted Fraud in the Patent and Trademark Office 16 1 88 1988
This article addresses concerns regarding the adverse impacts of the duty of disclosure requirement. It addresses the AIPLA resolution. It also states key concerns of the PTO with how the duty of disclosure is designed to improve the quality of examination.

Tegtmeyer, Rene D., *A Refocusing On Inequitable Conduct in New Rule 56* 20 3 & 4 191 1992
This article examines the provisions of the new Rule 56 and focuses on the benefits of the new rule and their respective requirements, i.e., the clarification of the materiality standard, the inequitable conduct intent standard, the setting of content and time for Information Disclosure Statements, and the duty to disclose.

Wegner, Harold C., *Patent Simplification Sans Patent Fraud* 20 3 & 4 211 1992
This article explores a different approach in the treatment of patent fraud by providing for a legislative option to remove patent fraud as a boilerplate from litigation, generate a balancing force to encourage early and voluntary prior art citation, and reserve patent fraud for the most egregious attempts at market domination.

Employment Agreements

Checklist: Employment Agreement Clauses 14 1 62 1986

Coolley, Ronald B., *Introduction* 14 1 1 1986
Brief overview of reasons for having employment agreements.

Coolley, Ronald B., *Employment Agreement Provisions: Definitions, Duties, Covenants Not to Compete, Assignment After Termination and Severability* 14 1 20 1986
This article defines concepts, including "confidential information" and "invention." The article also discusses topics such as "loss of pension benefits," "assignment after termination," and "severability."

Garry, Paul R. & Allison C. Blakley, *Employee Handbooks: An Implied Employment Contract Approach to Protecting Confidential Business Information* 14 1 3 1986

Malta v. Schulmerich: The Federal Circuit at a Crossroads In Its Search to Harmonize Substantive Patent Law With Jury Trial Procedure and Review 20 1 49 1992

This article analyzes the situation when standards for jury trial procedures/review intersect with substantive doctrinal standards and how they are reconciled so as to render consistent verdicts. Malta, with its seemingly simple question of equivalence represented a recognition by the Federal Circuit that jury determinations of equivalence require careful review to ensure proper application of substantive rules. The author opines that most juries can provide fair and informed verdicts and the patent bar has a great interest in encouraging such verdicts, so that a balance should be struck between substantive patent law, enabling rules of jury trial/procedure, and Seventh Amendment rights.

Waldbaum, Maxim H. & David Sipiora, *Pennwalt Redux - Judicial Uncertainty vs. Procrustean Bed* 19 3 237 1991

This article discusses the "means clause" of 35 U.S.C. section 112. It traces judicial construction of the clause and how a patentee can establish infringement in cases involving equivalent means used by an infringer.

Duty of Disclosure

Adamo, Kenneth R., *Answered Questions: New Developments Regarding Inequitable Conduct and Violation of the (Statutory) Duty of Disclosure* 16 2 182 1988

This article reviews precedent on issues of fraud, inequitable conduct, and violation of the statutory duty of disclosure in the patent context. It focuses specifically on the evolutionary changes and sometimes inconsistent result brought about by the Federal Circuit's decisions.

Amberg, Stanley L., *The PTO's New Duty of Disclosure/Fraud On the Patent Office Rules May Be a Trap for Unwary Practitioners* 20 3 & 4 163 1992

This article examines various provisions of the new Rule 56 and advises that practitioners who comply with the duty of disclosure requirements of the new rule may nevertheless

intellectual property statutes; and (3) an analysis of the provisions addressing industrial design protection on the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and how such provisions have been implemented in domestic law.

Spoor, Jaap H., *The Novelty Requirement in Design Protection Law: The Benelux Experience* 24 2, 3, 4 725 1996

Overview of the registration system for the design and model protection established by the joined forces of Belgium, the Netherlands, and Luxemburg ("BMDA"). The article explains the importance of the novelty requirement, which was meant to provide for a reliable registration system in the field of design protection. The author believes that this goal has not been adequately met because the novelty requirement has proved to be too restrictive.

Thompson, William S., *U.S. Design Protection: Discussion of Status and Suggested Proposals* 24 2, 3, 4 393 1996

This article proposes a system which would reduce the cost, and increase the speed, of the registration process. The clarity of the protection in this system would equal the present system which has, as its base, the drawings to illustrate the protected designs.

Woodring, Cooper C., *A Designer's View on the Scope of Intellectual Property Protection* 24 2, 3, 4 309 1996

The author discusses his views on design patents and gives a brief overview of intellectual property protection for designs and designers. The author speaks for the design community and encourages modifications and improvements to the U.S. design patent system.

Word, A. Hugo, *The New Guidelines on Protection of Computer Generated Icons and Typeface* 24 2, 3, 4 415 1996

Icons have become one of the most commonly used signs in our society today. These pictures are the core elements of the concept called graphical user interface (GUI) -- the computer industry's attempt to make personal computing user friendly. The article defines Icons as related to computers, and outlines the PTO procedures and guidelines for evaluating applications for protection of icons.

Zarfas, Louis S., *Design Protection for Articles of*

Royalties 15 4 391 1987
This article describes the analytical tasks required to satisfy the standards of proof for lost profits. The accounting issues surrounding the computation of the patent owner's lost profits on sales that would have been made absent the infringer's unlawful behavior, are also covered. Finally, issues surrounding the computation of a reasonable royalty payable to a patentee are addressed in cases involving unlawful manufacture, or use or sale of the patented product by the infringer.

Marshall, John J., *Proximate Causation As the Grand Unification Theory of Patent Damages: An Analysis of Rite-Hite v. Kelley and King Instruments v. Perego* 23 4 645 1995
This article demonstrates that proximate causation is a grand unification theory that unites prior patent damage theories, such as lost profits based upon entire market value, projected sales, convoyed sales, replacement parts, and price erosion. The article also guides the practitioner in investigating the potential damage claims available for each case of patent infringement.

Design Patents

Curchod, Francois, *The Revision of the Hague Agreement Concerning the International Deposit of Industrial Designs* 24 2, 3, 4 599 1996
An outline of the new draft attempts to reconcile two conflicting goals of the revision of the Hague Agreement: attracting into the system countries with examining offices, such as the U.S. and Japan, while offering to applicants a simple, quick, and affordable means of obtaining protection for their designs abroad.

Dinwoodie, Graeme B., *Federalized Functionalism: The Future of Design Protection In the European Union* 24 2, 3, 4 611 1996
An examination of European Union intellectual property law and the European Commission's proposals which would strengthen the E.U.'s hand in international negotiations. This article examines the objectives that lie behind the European initiative and explains the legislative means chosen by the Commission to realize those objectives.

Dratler, Jay, Jr., *Trade Dress Protection for*

Congress is in the best position to amend the patent law to provide three clear guidelines regarding patents of computer software: establish that computer processes are in fact patentable, protect "method" patent holders from distributors of those methods, and exclude information which has been stored in obvious ways from any novelty determination.

Corporate Practice

Daniszewski, Joseph P., *Patent Information Retrieval in Practice* 11 1 & 2 120 1983

Du Pont, which as of print time has been granted 26,000 U.S. patents, has found that bibliographic information is available from commercial databases for 23,600 of those patents. The Master Plan of the U.S. PTO represents a valid approach to improving searching ability for patents in response to problems the company has faced in storing and retrieving patent information.

Einhorn, Harold, *The Control Group Problem in a Large Corporation - Revisited* 12 2 103 1984

This article is an update of one which appeared in AIPLA Quarterly Journal, Vol. 3 (1975). The article focuses on the attorney client privilege and particularly how it is applied to corporations through the control group test. The article discusses the position of the United States Supreme Court on the control group rules as well as what federal rules of evidence have to say about it. The article further addresses the interactions of the control group test and state law and any practical consideration that arise.

Greely, Paul D., *Role of Patent Attorneys in Corporate Acquisitions and Divestments* 17 1 20 1989

This article describes why it is important, in the acquisition or divestment of any business or business segment, for corporations to have a law firm that specializes in patent law carefully review the intellectual property assets and liabilities of the acquired business prior to execution of any stock purchase or sale of assets agreement. In addition, the article focuses on the extent and depth of the review process, and the specific provisions that should be included in the acquisition agreement.

Moeller, Dr. Guido K., *Corporate Experience with On-Line Databases* 11 1 & 2 107 1983

implications raised by the passage of the Berne Implementation Act and U.S. adherence to Berne.

Copyright Interface

Goldberg, Morton David & John F. Burleigh, *Copyright Protection for Computer Programs: Is the Sky Falling?* 17 3 294 1989

This article supports the cases that extend copyright protection to computer programs. The authors argue that although copyright does not provide a bright line to divide the protectible from the unprotectible, neither does any other form of intellectual property right. The article discusses the legislative background, the *Whelan* case and other cases addressing the scope of copyright protection for software, and the significance of the growing worldwide consensus in favor of protection of computer programs under traditional copyright principles. The authors also comment on how familiar, often rejected arguments against such copyright protection appear to underlie the current quest for the certainty of a defined "interface" between copyright and patent.

Jordan, Richard A., *On the Scope of Protection for Computer Programs Under Copyright* 17 3 199 1989

This article contains a discussion of the proper scope of copyright protection for both non-visual and visual aspects of computer programs.

Oddi, Samuel A., *Functionality and Free Market Theory* 17 3 173 1989

This article identifies and analyzes two interfaces between patent and copyright – the "statutory subject matter" interface (*i.e.*, what may be protected by patents and copyrights respectively) and the "protection" interface (*i.e.*, the scope of exclusivity granted under patents and copyrights respectively). In the course of this analysis, models for defining these interfaces are developed, which are then considered with regard to their respective economic consequences. The conclusion is that having an overlapping subject-matter interface should not have significant anti-competitive effects, while the same cannot be said for an overlapping protection interface. To avoid the adverse consequences of an overlapping protection interface, the doctrine of "functionality," as developed in trademark and unfair competition law, is proposed for separating "idea" from "expression" in the context of computer programs.

Smith, P. McCoy, *Copyright, Suppression, and the Problem of the Unpublished Work: Lessons From the Patent Law* 19 4 309 1991

This article explores the recent trend in the use of copyright as a weapon to suppress writings. By analyzing the manner in which the patent laws treat suppression of innovations, the author hopes to shed light on the validity of allowing copyright holders suppressive power.

Stern, Richard H., *On Defining the Concept of Infringement of Intellectual Property Rights in Algorithms and Other Abstract Computer-Related Ideas* 23 3 401 1995

This article extrapolates from the concepts of copyright infringement and patent infringement under existing law, to define a concept of infringement of intellectual property rights in computer-related abstract ideas, such as algorithms, data structures, computerized methods of doing business, programming languages, and instructions sets.

Sumner, John P. & Steven W. Lundberg, *Patentable Computer Program Features As Uncopyrightable Subject Matter* 17 3 237 1989

This article demonstrates that, both with respect to "computer programs" as defined in the Copyright Act and with respect to user interface features, a clearly definable interface exists between copyright law and utility patent law. This interface can be used in virtually all fact situations to properly determine and limit the scope of copyright protection, thus leaving the protection of functional, utilitarian features to the utility patent system, as intended by Congress. A line can be drawn between the functional, utilitarian features of software and the non-functional, copyrightable aspects of software. The article further demonstrates that the functional, utilitarian features should receive protection exclusively from utility patents, or trade secrets, but should receive no protection from copyright law.

Wu, Andrew J., *From Video Games to Artificial Intelligence: Assigning Copyright Ownership to Works Generated By Increasingly Sophisticated Computer Programs* 25 1 131 1997

This article discusses the differences among certain computer-generated works, and suggests guidelines for a coherent system of assigning copyright that is reasonably

This article reviews the state of the law and technological developments leading to passage of the Digital Performance Right in Sound Recordings Act of 1995, and summarizes its legislative history and key provisions. The article then analyzes the impact of the Act, which became fully effective February 1, 1996.

Bolan, Robert O. & William C. Rooklidge, *Imputing Knowledge to Determine Willful Patent Infringement* 24 1 157 1996

Imputing knowledge of an employee to that employee's corporation in cases of willful patent infringement should only occur following the standards of agency law: where the employee has actual knowledge of the patent, understands its importance, and has a duty to report his or her knowledge to the corporation.

Coleman, Andrew W., *Copyright Damages and the Value of Infringing Use: Restitutionary Recovery in Copyright Infringement Actions* 21 2 91 1993

This article traces the development of the "value of use" remedy in both copyright and common law contexts. The author's conclusion is that this method of computing copyright damages is within the scope of the 1976 Act's scheme.

Dremann, Christopher C., *Copyright Protection for Architectural Works* 23 3 325 1995

This article discusses the historical development of protection for architectural plans and drawings and analyzes judicial treatment of copyright law.

Haynie, Laurie A., *So the Copyright Office Has Refused to Register Your Claim -- What Does It Mean and What Can You Do About It?* 21 1 70 1993

This article explains the significance of copyright registration within the context of an infringement suit. The article also discusses avenues of redress available. Finally, the article discusses the recent Atari case, which, the author concludes, provides new hope for disappointed applicants.

Jordan, Richard A., *On the Scope of Protection for Computer Programs Under Copyright* 17 3 199 1989

This article contains a discussion of the proper scope of copyright protection for both non-visual and visual aspects of computer programs.

Weissman, Peter, *Computer Software as Patentable Subject Matter: Contrasting United States, Japanese, and European Laws* 23 3 525 1995

This article explores the current state of the law regarding computer-related technologies as patentable subject matter in the United States, Japan, and Europe. It analyzes the effects of these laws, and provides a brief comparison and analysis among the different nations.

Wu, Andrew J., *From Video Games to Artificial Intelligence: Assigning Copyright Ownership to Works Generated By Increasingly Sophisticated Computer Programs* 25 1 131 1997

This article discusses the differences among certain computer-generated works, and suggests guidelines for a coherent system of assigning copyright that is reasonably faithful to the existing copyright statute and its policies, and is comprehensive enough to deal with the wide variety of computer-generated works.

Confidential Business Information

Braverman, Burt A. & Frances J. Chetwynd, *Submitters Beware: The Perils of FOIA - Implementing Regulations* 12 1 33 1984

This article examines some of the more prevalent procedures employed by federal agencies in receiving and processing FOIA requests for confidential business information. It considers the distinctions among agencies' applications of those procedures, and the resulting lack of consistency, predictability and safeguards of submitter's rights which characterized the FOIA decision-making process in which the confidentiality of business information is determined. Finally, it concludes that agencies themselves cannot be expected to correct this condition and suggests that the solution can be found only in a comprehensive legislative declaration of submitter's rights.

Casey, William L., Jr., John E. Marthisen & Laurence S. Moss, *The Economic Impact of the Freedom of Information Act* 12 1 76 1984

This article examines the claim, voiced by the business sector, that federal disclosure policy under the Freedom of Information Act too often compromises trade secrets and

spectrum. The author criticizes the usual analysis of program similarities and differences as superficial and the "rules" used as gratuitous. He further urges judges to appreciate which elements in the process programmers regard as creative or stylistic and which they regard as standard, routine, banal, trivial, mechanical, or functionally dictated. The author hopes that by using this process, the scope of protection for various types of computer programs will become more clearly defined.

Oddi, Samuel A., *Functionality and Free Market Theory* 17 3 173 1989

This article identifies and analyzes two interfaces between patent and copyright – the "statutory subject matter" interface (*i.e.*, what may be protected by patents and copyrights respectively) and the "protection" interface (*i.e.*, the scope of exclusivity granted under patents and copyrights respectively). In the course of this analysis, models for defining these interfaces are developed, which are then considered with regard to their respective economic consequences. The conclusion is that having an overlapping subject-matter interface should not have significant anti-competitive effects, while the same cannot be said for an overlapping protection interface. To avoid the adverse consequences of an overlapping protection interface, the doctrine of "functionality," as developed in trademark and unfair competition law, is proposed for separating "idea" from "expression" in the context of computer programs.

Samuelson, Pamela, *Survey on the Patent/Copyright Interface for Computer Programs* 17 3 256 1989

In the fall of 1988, AIPLA surveyed its members on a set of issues relevant to the patent/copyright interface for computer programs. This article reports the author's analysis of the results of the survey. The survey results showed that there is a significant degree of exclusivity between patent and copyright law. There was, however, disagreement about whether the two laws are completely mutually exclusive, or overlap to some degree.

Smith, Richard, E. Robert Yoches & John F. Hornick, *Guide for the Perplexed: Where is the Problem and What We Do Until It is Solved* 17 3 215 1989

This article suggests that there is no need to fear a drastic divergence from well-accepted strategies for intellectual

Choice of Law

Gholz, Charles L., *Choice of Law in the United States Circuit Court of Appeals for the Federal Circuit* 13 3 & 4 309 1985

This article deals with the question of what law (both procedurally and substantively) the Federal Circuit should apply to non-patent aspects of patent appeals. The author proposes that the Court of Appeals for the Federal Circuit should not be bound by the law of the Circuit in which the district court/trial court is located, but rather should treat the law of all Circuits equally under the doctrine of comity.

Cloning Arts

Rohrbaugh, Mike L., *The Patenting of Extinct Organisms: Revival of Lost Arts* 25 3 371 1997

This article assesses the patentability of regenerated organisms, after being extinct in nature, under utility patent provisions. It provides insight into how the technology of regenerating formerly extinct organisms relates to, and is consistent with, the patentability requirements of statutory subject matter, utility, novelty, and non-obviousness.

Complex Litigation

Costantino, Hon. Mark A. & Daniel L. Master, Jr., *The Seventh Amendment Right to Jury Trial in Complex Civil Litigation: Historical Perspectives and a View From the Bench* 12 4 279 1984

This article examines the advisability of establishing a complexity exception to the Seventh Amendment and proposes an effective alternative means by which goals of the proponents of both positions can be achieved.

Computer Programs

Goldberg, Morton David & John F. Burleigh, *Copyright Protection for Computer Programs: Is the Sky Falling?* 17 3 294 1989

This article supports the cases that extend copyright protection to computer programs. The authors argue that although copyright does not provide a bright line to divide the protectible from the unprotectible, neither does any other form of intellectual property right. The article discusses the legislative background, the *Whelan* case and other cases addressing the scope of copyright protection for software, and the significance

Patents and the Human Genome Project 22 1 27 1994
International cooperation in an effort to decode the human genome has recently been threatened by various organizations' attempts to obtain patent protection for DNA fragments of unknown function derived from the genome project. The article argues that efforts to obtain proprietary rights for gene fragments of unknown function may harm international cooperation essential to the human genome project. Further, the paper urges the United States to forge a strong policy regarding the human genome project and patent issues that result from it.

Stratton, Jane L., *Representing Commercial Biotechnology Companies in Licensing Negotiations* 16 3 & 4 506 1988
This article presents business-drive issues that may be encountered during negotiations for biotechnology licensing.

Wiseman, Thomas G., *Biotechnology Patent Practice -- A Primer* 16 3 & 4 394 1988
The author provides guidance on technologies and how to avoid pitfalls with the PTO examiner.

Border Controls

Trainer, Timothy P., *Intellectual Property Protection Along Foreign Borders* 21 4 313 1993
This article discusses border enforcement of IPR.

China

Chen, Alexander C., *Climbing the Great Wall: A Guide to Intellectual Property Enforcement in the People's Republic of China* 25 1 1 1997
This article discusses China's recent commitment to enforcement of intellectual property law. The initial focus of the article is on China's perception of intellectual property rights. The article then discusses the progress that China has made in enforcing intellectual property rights. The author also proposes enforcement strategies to U.S. practitioners.

Chinese Patent Law

Gushu, Liu, *The China Patent Agents (H.K.) Ltd.* 13 2 121 1985
This article describes the functions of one of the three foreign-related patent agencies designated by China. The author discusses the application process, training of

This article asks questions and addresses common concerns of universities regarding university licensing for biotechnology innovations.

Chahine, Kenneth G., *Enabling DNA and Protein Composition Claims: Why Claiming Biological Equivalents Encourages Innovation* 25 3 333 1997

This article demonstrates that modifications which alter the structure of DNA and protein compositions can be predicted, with sufficient reasonableness, to be considered enabling by any artisan skilled in the art. In addition, this article demonstrates that, although protein composition claims, limited by functional language, may not comply with traditional enablement analysis, they do fulfill the underlying purpose of the enablement doctrine.

Duft, Bradford J., *Patent Infringement and Biotechnology* 16 3 & 4 339 1988

This article describes and discusses the few contemporary biotechnology court opinions and decisions with respect to infringement as well as related questions of validity and how the requirement of proper claim interpretation affects these issues.

Fuller, I.L. Pep, *Intellectual Property Rights Associated With Biotechnology -- An International Trade Perspective* 16 3 & 4 529 1988

This article advocates an increase in IPR protection in foreign countries. It encourages companies to support national laws and international agreements that give IPR protection to products and processes of biotechnology.

Griffen, Susan Haberman, *Exporting Biotechnology: The Pitfalls* 16 3 & 4 542 1988

This article describes the two major sets of U.S. export regulations, the Export Administration Regulations and the International Traffic in Arms Regulations, as they govern the transfer of biotechnological commodities and technical data.

Katz, Arie P., *Patentability of Living Matter Within Traditional Jewish Law: Is the Harvard House Kosher?* 21 2 117 1993

This article addresses the legal and ethical issues of patenting new animal life raised within traditional Jewish law. The article discusses biotechnology patents and the U.S.

in a Large Corporation - Revisited 12 2 103 1984

This article is an update of one which appeared in AIPLA Quarterly Journal, Vol. 3 (1975). The article focuses on the attorney client privilege and particularly how it is applied to corporations through the control group test. The article discusses the position of the United States Supreme Court on the control group rules as well as what federal rules of evidence have to say about it. The article further addresses the interactions of the control group test and state law and any practical consideration that arise.

Pretty, Laurence H., *The Boundaries of Discovery in Patent Litigation: Privilege, Work Product and Other Limits* 18 2 101 1990

This article reviews the special problems in delineating the boundaries of discovery in patent litigation due to the public character of patents. Specifically highlighted are the boundaries of discovery created by the attorney-client privilege, work product immunity, and relevance.

Stone, Gregory, *An Attorney's Duty to Preserve Client Confidences and Conflicts of Interest: The Problem of Representation Adverse to a Former Client* 12 2 157 1984

This article examines the trend that as the practice of law has become more complex, the potential for conflict of interest in representing clients who have adverse interests with former clients, have increased. The article examines the aspect of that trend that attorneys are being disqualified from continuing to represent a current client in litigation because of an actual or potential breach by the attorney of his duty to preserve a former client's confidences. The article first examines the substantial relationship test, its derivation, and its application. Then the article discusses some problems in implementation of the substantial relationship test. Finally, the effect of the Model Rules of Conduct are discussed.

Trop, Timothy N., *Negative Inferences From the Absence of Attorney Testimony in Patent Cases* 15 1 50 1987

In patent cases, with increasing frequency, attention is focusing on the conduct of attorneys. Typically, this occurs when a defense of reliance on an opinion of counsel is raised to a charge of willful patent infringement. This also happens

This article reviews recent decisions dealing with the appellate jurisdiction of the Untied States Court of Appeals for the Federal Circuit over patent-related actions.

Tramposch, Albert G., *The Dilemma of Conflicting Precedent: Three Options in the Federal Circuit* 17 4 323 1989

This article analyzes three options that the Federal Circuit can use to resolve conflicting precedent. The author discusses the advantages and disadvantages of each option. The first option, using the earlier of the conflicting opinions, is characterized as rational, but not practical, when there is a long gap between the conflicting opinions. The second option is for the full court to issue an abbreviated opinion on the unclear issue of law only, without considering the facts or other issues of the case. The author points out that while this approach is streamlined and efficient, it cuts against the constitutional requirement that a federal court may decide only a live case or controversy. Finally, the third option, considering the most recent opinion as controlling, is described as practical because it allows the court to consider all cases and it best reflects the court's current thinking.

Wright, Bradley C., *Supplemental Claim Jurisdiction in the United States Court of Appeals for the Federal Circuit* 22 2 235 1994

This article reviews the circumstances under which the Court of Appeals for the Federal Circuit will find subject matter jurisdiction over appeals involving "supplemental" claims in patent-related cases.

Appellate Review

Pravel, B.R., *Issues of Law and Fact At Appellate Level* 12 4 321 1984

This article examines issues of fact and law in both patent and trademark cases. With respect to patent cases the article discusses claim interpretation or construction, anticipation, obviousness, enablement under 35 U.S.C. § 112, utility and patent infringement. With regard to trademark cases, the article discusses the likelihood of confusion, the strength of the mark, trademark infringement, and other trademark issues.

Ritscher, Michael A., Albert Tramposch, Thomas J. O'Connell & Lisa Barons, *The Status of Dual Path Litigation in the*

Congress' enactment of § 294 of the Patent Act raises both opportunities and challenges to patent infringement and validity litigants. The system generally provided for in the United States Arbitration Act (Title 9) may need to be tailored by mutual agreement of the parties, depending on the controversy involved.

Antitrust

Bennet, Joel R., *Patent Misuse: Must An Alleged Infringer Prove an Antitrust Violation?* 17 1 1 1989

Before 1988, it was established patent misuse doctrine that a patent owner, who either commits an antitrust violation sufficiently related to the patent, or who extends his or her patent beyond its temporal or physical scope, could not enforce the patent. In 1988, Congress passed the Patent Misuse Statute, which rejected the requirement that an alleged infringer establish an antitrust violation to prove patent misuse. This article analyzes why the author believes the Court of Appeals for the Federal Circuit will likely depart from this established policy in the face of the 1988 law.

Gotts, Ilene Knable & Howard W. Fogt, Jr., *Clinton Administration Expresses More than Intellectual Curiosity in Antitrust Issues Raised By Intellectual Property Licensing* 22 1 1 1994

Recent enforcement activity by both the Federal Trade Commission and the Department of Justice signify increased federal activism by the Clinton Administration in intellectual property related matters.

Haley, Jeffrey T., *Strategies and Antitrust Limitations for Multiple Potential Patent Infringers* 21 4 327 1993

This article discusses how a potential patent infringer can coordinate its defense with other businesses threatened by the same patent.

Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/Reexamination: The First Three Years* 13 3 & 4 220 1985

Contractors	12	1	50	1984
Wachter, Mark F., *Patent Enforcement in Japan: An American Perspective for Success*	19	1	59	1991
Wagner, Michael J. & Peter B. Frank, *Computing Lost Profits and Reasonable Royalties*	15	4	391	1987
Waldbaum, Maxim H. & David Sipiora, *Pennwalt Redux - Judicial Uncertainty vs. Procrustean Bed*	19	3	237	1991
Wallen, Richard A. & Michael J. MacDermott, *The Fifth Amendment and Its Impact on Civil Actions Under the Trademark Counterfeiting Act of 1984*	14	4	318	1986
Walterscheid, Edward C., *Charting a Novel Course: The Creation of the Patent Act of 1790*	25	4	445	1997
Walterscheid, Edward C., *Priority of Invention: How the United States Came to Have a "First-to-Invent" Patent System*	23	2	263	1995
Wegner, Harold C., *Inequitable Conduct and the Proper Roles of Patent Attorney and Examiner in an Era of International Patent Harmonization*	16	1	38	1988
Wegner, Harold C., *Patent Law Simplification and the Geneva Patent Convention*	14	3	154	1986
Wegner, Harold C., *Patent Simplification Sans Patent Fraud*	20	3 & 4	211	1992
Weiffenbach, Cameron, *Attorney Conduct and the U.S. Patent and Trademark Office*	14	2	73	1986
Weissman, Peter, *Computer Software as Patentable Subject Matter: Contrasting United States, Japanese, and European Laws*	23	3	525	1995
Wilkes, Robert A., *The Canadian Viewpoint: A New Perspective Bridging the First-to-Invent and First-to-File World*	18	1	18	1990
Williams, Sidney B., Jr. & Joan Thirstein, *Use of Masters in Litigation*	12	3	227	1984
Winland, Thomas W. & David S. Forman, *How Will Existing License Agreements Be Affected By Extended Patent Terms Under GATT*	22	3 & 4	449	1994
Wiseman, Thomas G., *Biotechnology Patent Practice -- A Primer*	16	3 & 4	394	1988
Woodring, Cooper C., *A Designer's View on the Scope of Intellectual Property Protection*	24	2, 3,4	309	1996

Related Ideas	23	3	401	1995
Stern, Richard H., *Solving the Algorithm Conundrum: After 1994 in the Federal Circuit Patent Law Needs a Radical Algorithmectomy*	22	2	167	1994
Stern, Richard H., *Tales From the Algorithm War: Benson to Iwahshi, It's Deja Vu All Over Again*	18	4	371	1990
Stone, Gregory, *An Attorney's Duty to Preserve Client Confidences and Conflicts of Interest: The Problem of Representation Adverse to a Former Client*	12	2	157	1984
Stratton, Jane L., *Representing Commercial Biotechnology Companies in Licensing Negotiations*	16	3 & 4	506	1988
Sumner, John P. & Keith Stephens, *Patenting Software Objects and Other Aspects of Object-Oriented Programs Under the New PTO Guidelines*	23	2	221	1995
Sumner, John P. & Steven W. Lundberg, *Patentable Computer Program Features as Uncopyrightable Subject Matter*	17	3	237	1989
Sun, Wu and Zhu Jinqing, *Criteria of Patentability and Scope of Protection of the Chinese Patent Law*	13	2	116	1985
Sutherland, Nancy A. & Prospere S. Virden, Jr., *Releasability Under the Freedom of Information Act of Documents Submitted by Government Contractors*	12	1	50	1984
Sutton, John P., *The Fact-Law Dichotomy in Trademark Cases*	12	4	310	1984
Szczepanski, Steven Z., *Licensing or Settlement: Deferring the Fight to Another Day*	15	2 & 3	298	1987
Tao, Jerome T., *An Examination of the Federal Circuit's Multi-Tiered Review of Patent Obviousness*	20	2	84	1992
Taylor, Roger D. & Will E. Leonard, *Section 337: A Familiar Road Into Strange Country*	12	4	336	1984
Tegtmeyer, Rene D., *A Refocusing on Inequitable Conduct in New Rule 56*	20	3 & 4	191	1992
Tegtmeyer, Rene D., *The Patent and Trademark Office View of Inequitable Conduct or Attempted*				

Dual Path Litigation in the ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review 18 2 155 1990
Robinson, William J., *Insurance Coverage of Intellectual Property Lawsuits* 17 2 122 1989
Roche, Christopher C. & James E. Rosini, *Trademarks in Europe 1991 and Beyond* 19 3 213 1991
Rohrbaugh, Mark L., *The Patenting of Extinct Organisms: Revival of Lost Arts* 25 3 371 1997
Rooklidge, William C. & Robert O. Bolan, *Imputing Knowledge to Determine Willful Patent Infringement* 24 1 157 1996
Ropski, Gary M. & Diane L. Marschang, *The Stars' Wars: Names, Pictures and Lookalikes* 17 2 81 1989
Ropski, Gary M. & Pamela J. Johnson, *A "Nonobvious" Framework for Analyzing Proof of Secondary Meaning* 11 3 211 1983
Rosini, James E. & Christopher C. Roche, *Trademarks in Europe 1991 and Beyond* 19 3 213 1991
Rowe, James L., *Fraud Statistics* 16 2 280 1988
Rudisill, Stephen G. & Richard C. Auchterlonie, *The Classic Defenses Updated* 15 2 &3 209 1987
Samuels, Linda B. & Jeffrey M. Samuels, *Protection for Color Under U.S. Trademark Law* 23 1 129 1995
Samuelson, Pamela, *Survey on the Patent/Copyright Interface for Computer Programs* 17 3 256 1989
Sanctis, Giustino de & Mario Franzosi, *The Increasing Worldwide Significance of European Patent Litigation* 25 1 67 1997
Sarussi, Steven J. & Daniel A. Boehnen, *Relationships that Exist Between Patent Disputes and FDA Approval Dates Under the Drug Price Competition and Patent Term Restoration Act of 1984* 17 1 67 1989
Sayko, Andrew F., Jr., *New and Terminating Employees* 14 1 49 1986
Schwartz, Bryan A., *Beyond the Amendments: Federal and ITC Case Law Developments That May Determine the Long-Term Future of Section 337 Litigation* 22 3 & 4 491 1994
Seay, Nicholas J., *Protecting the Seeds of Innovation:*

and Obviousness in the Federal Circuit	13	3 & 4	171	1985
Mittelberger, Ralph A. & Gary M. Hnath, *Changes in Section 337 as a Result of the GATT - Implementing Legislation*	22	3 & 4	465	1994
Moeller, Dr. Guido K., *Corporate Experience With On-Line Databases*	11	1 & 2	107	1983
Moore, Preston & Jackie Nakamura, *The United States Patent Marking and Notice Statute*	22	1	85	1994
Murashige, Kate H., *Section 102/103 Issues in Biotechnology Patent Prosecution*	16	3 & 4	294	1988
Myers, James D. & Michael D. McCoy, *Ex Parte Seizure Order Practice After the Trademark Counterfeiting Act of 1984*	14	4	237	1986
Nakamura, Jackie & Preston Moore, *The United States Patent Marking and Notice Statute*	22	1	85	1994
Nishitate, Kazuyuki, Yukio Uchida & Takashi Ishida, *Japanese Chemical Patent Practice*	13	1	66	1985
O'Connell, Thomas J., Michael A. Ritscher, Albert Tramposch & Lisa Barons, *The Status of Dual Path Litigation in the ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review*	18	2	155	1990
O'Reilly, James T., *Trade Secrets: Asleep at the Switch?*	12	1	13	1984
Oddi, Samuel A., *Functionality and Free Market Theory*	17	3	173	1989
Pagenberg, Dr. Jochen, I, *The WIPO Patent Harmonization Treaty*	19	1	1	1991
Pantuliano, Michael J., *Chemical Patent Practice in the United Kingdom, West Germany, the European Patent Office and Japan -- Some Significant Differences*	13	1	9	1985
Parker, Henrik D., *Doctrine of Equivalents Analysis After Wilson Sporting Goods: The Hypothetical Claim Hydra*	18	3	262	1990
Parrett, Sherman O., *The Expanded Authority of U.S. Magistrates: Has Congress Exceeded Constitutional Limits?*	12	3	212	1984
Partridge, Jayme, Thomas H. Adolph & David Hricik, *Trade Secrets: An Update on the Impact of State and Federal Efforts to Broaden the*				

Lundberg, Steven W. & John P. Sumner, *Patentable Computer Program Features as Uncopyrightable Subject Matter*	17	3	237	1989
Lyerla, Bradford P. & Manuel A. Abascal, *Insurance Coverage for Intellectual Property Claims: The California vs. The New York Approach*	19	3	189	1991
Lynch, John F., *An Argument for Eliminating the Defense of Patent Unenforceability Based on Inequitable Conduct*	16	1	7	1988
Lynch, John F., *New Rule 56: The Second Time Around*	20	3 & 4	144	1992
MacDermott, Michael J. & Richard A. Wallen, *The Fifth Amendment and Its Impact on Civil Actions Under the Trademark Counterfeiting Act of 1984*	14	4	318	1986
Macedo, Charles R.B., *First-To-File: Is American Adoption of the International Standard in Patent Law Worth the Price?*	18	2	193	1990
Madson, Craig J., *Arbitration of Franchise Agreement Disputes*	11	4	298	1983
Manbeck, Harry F., Jr., *The Evolution and Issue of New Rule 56*	20	3 & 4	136	1992
Manbeck, Harry F., Jr., *Voluntary Arbitration of Patent Disputes -- The Background to 35 U.S.C. 294*	11	4	268	1983
Marcus, Harry C. & Mark J. Abate, *Design Patent Infringement Put to Sea Without Guiding Charts*	22	2	135	1994
Marmor, Alfred C., *What You Don't Know Can Hurt You: An Inside View of Derwent -- the Technological Information Specialists*	11	1 & 2	40	1983
Marschang, Diane L. & Gary M. Ropski, *The Stars' Wars: Names, Pictures and Lookalikes*	17	2	81	1989
Marshall, John J., *Proximate Causation as the Grand Unification Theory of Patent Damages: An Analysis of Rite-Hite v. Kelley and King Instruments v. Perego*	23	4	645	1995
Marthisen, John E., William L. Casey, Jr. & Laurence S. Moss, *The Economic Impact of the Freedom of Information Act*	12	1	76	1984

Law	13	2	116	1985
Johnson, Pamela J. & Gary M. Ropski, *A "Nonobvious" Framework for Analyzing Proof of Secondary Meaning*	11	3	211	1983
Jordan, Richard A., *On the Scope of Protection for Computer Programs Under Copyright*	17	3	199	1989
Kakinuki, John, *How the Japanese Handle Interference Issues in Their First-to-File World*	18	1	80	1990
Kalikow, Martin, *Automation of the European and the Japanese Patent Offices*	11	1 &2	33	1983
Katz, Arie P., *Patentability of Living Matter Within Traditional Jewish Law: Is the Harvard House Kosher?*	21	2	117	1993
Kaufman, Page M., *An Empirical Study of the Effect of Patent Invalidity Judgments on the Abnormal Returns of Publicly Traded Securities*	19	4	282	1991
Kettelberger, Denise M. & G. Kenneth Smith, *Patents and the Human Genome Project*	22	1	27	1994
Killworth, Richard A., *The Federal Circuit Treatment of Non-Art Rejections/Defenses and Reissue/ Reexamination: The First Three Years*	13	3 & 4	220	1985
Klein, Sheldon, *The Trademark Law Revision Act of 1988: An Analysis of the Mechanics and Possible Effects of Intent-to-Use Legislation*	16	2	153	1988
Kline, Michael J. & David E. Dougherty, *Avoiding Client Conflicts of Interest in an Era of Corporate Change*	14	2	104	1986
Korniczky, Stephen S. & Don W. Martens, *Verdict Forms - A Peek into the "Black Box"*	23	4	617	1995
Kozlowski, Holly D. & Kenneth E. Krosin, *Patent Based Suits at the International Trade Commission Following the 1989 Amendments to Section 337*	17	1	47	1989
Kraus, Heidi L., *A Different New Matter Standard For Biotechnology Patent Applications Accompanied By A Deposit*	25	1	101	1997
Krieger, Paul E. & Lester L. Hewitt, *Anti-Monopoly --An Autopsy for Trademarks*	11	3	151	1983
Krosin, Kenneth E. & Holly D. Kozlowski, *Patent Based Suits at the International Trade Commission Following the 1989*				

The Duty of Disclosure Requirements	16	1	124	1988
Griffen, Susan Haberman, *Exporting Biotechnology: The Pitfalls*	16	3 & 4	542	1988
Grimes, Charles W. & Gregory J. Battersby, *The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer*	15	2 & 3	231	1987
Groff, Bradley K., *Bare-Fisted Competition or Palming Off? Protection of Product Design as Trade Dress Under the Lanham Act*	23	1	65	1995
Gushu, Liu, *The China Patent Agents (H.K.) Ltd.*	13	2	121	1985
Haley, Jeffrey T., *Strategies and Antitrust Limitations for Multiple Potential Patent Infringers*	21	4	327	1993
Harrison, David C., *Interference Questions in Europe*	18	1	65	1990
Haynie, Laurie A., *So the Copyright Office Has Refused to Register Your Claim -- What Does It Mean and What Can You Do About It?*	21	1	70	1993
Healey, Rachel M. & Floyd A. Gibson, *The Right of Publicity Comes of Age*	23	3	361	1995
Hearn, Robert L., *Full-Text Patent Information Retrieval With LEXPAT*	11	1 & 2	73	1983
Heinke, Lowell L., *Is Intent an Important Element of Inequitable Conduct in the Patent and Trademark Office?*	16	1	21	1988
Heinze, William F., *Patent Mediation: The Forgotten Alternative in Dispute Resolution*	18	4	333	1990
Helget, Gerald E., *Slogans - Protectable Marketing Tools?*	20	1	35	1992
Herrell, Roger W. & Donald R. Piper, Jr., *Concurrent Use and Registration Rights*	11	3	177	1983
Hewitt, Lester L. & Paul E. Krieger, *Anti-Monopoly -- An Autopsy for Trademarks*	11	3	151	1983
Hilti, Christian, *The Future European Community Patent System and Its Effects on Non-EEC Members*	18	3	289	1990
Hnath, Gary M. & James M. Gould, *Litigating Trade Secret Cases at the International Trade Commission*	19	2	87	1991
Hnath, Gary M. & Ralph A. Mittelberger, *Changes in Section 337 as a Result of the GATT - Implementing Legislation*	22	3 & 4	465	1994

Large Corporation - Revisited	12	2	103	1984
Eisenberg, Rebecca S. & Robert P. Merges, *Opinion Letter As to the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences*	23	1	1	1995
Eisenberg, Rebecca S. & Robert P. Merges, *Reply to Comments on the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences*	23	1	61	1995
Elderkin, Dianne B. & Albert W. Preston, Jr., *Malta v. Schulmerich: The Federal Circuit at a Crossroads in its Search to Harmonize Substantive Patent Law with Jury Trial Procedure and Review*	20	1	49	1992
Fiorito, Edward G., *The WIPO "Basic Proposal" for Harmonization of Patent Laws Viewed From the U.S. Practitioner's Point of View*	19	1	24	1991
Fisher, Bernard, *A European View Relating to Interference Issues in a First-to-File World*	18	1	52	1990
Fogt, Howard W., Jr., *Clinton Administration Expresses More Than Intellectual Curiosity in Antitrust Issues Raised By Intellectual Property Licensing*	22	1	1	1994
Forman, David S. & Thomas W. Winland, *How Will Existing License Agreements Be Affected By Extended Patent Terms Under GATT*	22	3 & 4	449	1994
Forstner, James A., *International Business Implications of the U.S. Best Mode Requirement*	21	2	157	1993
Frank, Peter B. & Michael J. Wagner, *Computing Lost Profits and Reasonable Royalties*	15	4	391	1987
Franzosi, Mario & Giustino de Sanctis, *The Increasing Worldwide Significance of European Patent Litigation*	25	1	67	1997
Friedman, Mark M. & Paul C. Van Slyke, *Employer's Rights to Inventions and Patents of Its Officers, Directors and Employees*	18	2	127	1990
Fryer, William T., III, *Design Patent System for the Twenty-First Century*	24	2, 3, 4	331	1996
Fuller, I.L. Pep, *Intellectual Property Rights Associated With Biotechnology -- An International Trade Perspective*	16	3 & 4	529	1988

Chambers, J. Robert, *Jury Trials in Patent Cases: The Uncertain Course of the Federal Circuit*	13	3 & 4	361	1985
Chambers, Scott A., *Comments on the Patentability of Certain Inventions Associated With the Identification of Partial CDNA Sequences*	23	1	53	1995
Chen, Alexander C., *Climbing the Great Wall: A Guide to Intellectual Property Enforcement In the People's Republic of China*	25	1	1	1997
Chetwynd, Frances J. & Burt A. Braverman, *Submitters Beware: The Perils of FOIA - Implementing Regulations*	12	1	33	1984
Chisum, Donald S., *Comment: Anticipation, Enablement and Obviousness: An Eternal Golden Braid*	15	1	57	1987
Chisum, Donald S., *Remedies for Patent Infringement*	13	3 & 4	380	1985
Chisum, Donald S., *Trademark Acquisition, Registration and Maintenance: A Primer*	19	2	124	1991
Clark, Paul T., *Animal Invention Protection*	16	3 & 4	442	1988
Coggio, Brian D., Jennifer Gordon & Marsha G. Ajhar, *Damage Control -- What An Adjudged Infringer Can Do to Minimize the Resulting Damage*	15	2 & 3	250	1987
Coleman, Andrew W., *Copyright Damages and the Value of Infringing Use: Restitutionary Recovery in Copyright Infringement Actions*	21	2	91	1993
Conley, Ned L., *An Economic Approach to Patent Challenges*	15	4	354	1987
Coolley, Ronald B., *Employment Agreement Provisions: Definitions, Duties, Covenants Not to Compete, Assignment After Termination and Severability*	14	1	20	1986
Coolley, Ronald B., *Introduction*	14	1	1	1986
Coolley, Ronald B., *Magistrates: What They Are and How They Can Be Used in Litigation*	12	3	186	1984
Correll, Craig O., *Using Criminal Sanctions to Combat Trademark Counterfeiting*	14	4	278	1986
Costantino, Hon. Mark A. & Daniel L. Master, Jr., *The Seventh Amendment Right to Jury Trial in Complex Civil Litigation: Historical Perspectives and a View from the Bench*	12	4	279	1984

Security Interests in Intellectual Property	15	1	30	1987
Banner, Mark T., *Frivolous Appeals and Attorney Fee Awards: The Federal Circuit Gets Serious With A Serious Problem*	13	3 & 4	318	1985
Barber, William G. & Louis T. Pirkey, *Treaties Bring Changes to U.S. Trademark Law and Practice*	22	3 & 4	509	1994
Bardehle, Heinz, *Equivalents and International Patent Law Harmonization*	20	2	119	1992
Barnhardt, John J., III, *Counterclaiming in Patent Infringement Litigation*	15	2 & 3	175	1987
Barons, Lisa, Michael A. Ritscher, Albert Tramposch and Thomas J. O'Connell, *The Status of Dual Path Litigation in the ITC and the Courts: Issues of Jurisdiction, Res Judicata and Appellate Review*	18	2	155	1990
Battersby, Gregory J. & Charles W. Grimes, *The Attorney-Client Privilege and Work Product Immunity in the Eyes of the Accused Infringer*	15	2 & 3	231	1987
Bennet, Joel R., *Patent Misuse: Must an Alleged Infringer Prove an Antitrust Violation?*	17	1	1	1989
Bickham, Timothy C., *Protecting U.S. Intellectual Property Rights Abroad With Special 301*	23	2	195	1995
Blakley, Allison C. & Paul R. Garry, *Employee Handbooks: An Implied Employment Contract Approach to Protecting Confidential Business Information*	14	1	3	1986
Bloomberg, Coe A., *In Defense of the First-To-Invent Rule*	21	3	255	1993
Boehnen, Daniel A. & Steven J. Sarussi, *Relationships that Exist Between Patent Disputes and FDA Approval Dates Under the Drug Price Competition and Patent Term Restoration Act of 1984*	17	1	67	1989
Bolan, Robert O. & William C. Rooklidge, *Imputing Knowledge to Determine Willful Patent Infringement*	24	1	157	1996
Boland, Lois E., *GATT/TRIPS: A Response From the United States Patent and Trademark Office*	22	3 & 4	425	1994
Borovoy, Roger S. & Paul M. Janicke, *The Minitrial Approach to Resolving Patent*				