Intellectual Property Counseling and Litigation

HORWITZ·HORWITZ GENERAL EDITORS



INTELLECTUAL PROPERTY COUNSELING AND LITIGATION

VOLUME 1

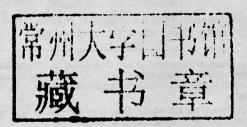
LESTER HORWITZ

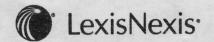
ETHAN HORWITZ

General Editors

2011

Filed Through: Release No. 48, April 2011





QUESTIONS ABOUT THIS PUBLICATION?

For questions about the Editorial Content appearing in these volumes or reprint permission, please call: Valri Nesbit, J.D. at
Customer Services Department at
Your account manager
Library of Congress Card Number: 88-070318 ISBN: 978-0-8205-1331-7

Cite this publication as:

Lester Horwitz, Ethan Horwitz, General Editors, Intellectual Property Counseling and Litigation, Ch. no., Title, § (Matthew Bender)

Example:

Lester Horwitz, Ethan Horwitz, General Editors, Intellectual Property Counseling and Litigation, Ch. 1, Defensive Measures Against Counterfeiting, § 1.01 (Matthew Bender)

Because the section you are citing may be revised in a later release, you may wish to photocopy or print out the section for convenient future reference.

This publication is designed to provide accurate and authoritative information in regard to the subject matter covered. It is sold with the understanding that the publisher is not engaged in rendering legal, accounting, or other professional services. If legal advice or other expert assistance is required, the services of a competent professional should be sought.

LexisNexis and the Knowledge Burst logo are registered trademarks and Michie is a trademark of Reed Elsevier Properties Inc., used under license. Matthew Bender and the Matthew Bender Flame Design are registered trademarks of Matthew Bender Properties Inc.

Copyright © 2011 Matthew Bender & Company, Inc., a member of the LexisNexis Group. All Rights Reserved.

No copyright is claimed in the text of statutes, regulations, and excerpts from court opinions quoted within this work. Permission to copy material exceeding fair use, 17 U.S.C. § 107, may be licensed for a fee of 25¢ per page per copy from the Copyright Clearance Center, 222 Rosewood Drive, Danvers, Mass. 01923, telephone (978) 750-8400.

Editorial Offices

www.lexisnexis.com

¹²¹ Chanlon Rd., New Providence, NJ 07974 (908) 464-6800 201 Mission St., San Francisco, CA 94105-1831 (415) 908-3200

Publication Table of Contents Intellectual Property Counseling and Litigation

VOLUME 1

PART I	INTRODUCTION
PART II	COUNSELING STRATEGIES FOR SUCCESSFUL PROTECTION OF INTELLECTUAL PROPERTY
Subpart A	Protecting the Subject Matter
Chapter 1	Defensive Measures Against Counterfeiting
Chapter 2	Drafting Patents with a View to Litigation
Chapter 3	Protecting Designs by Trademarks, Copyrights, and Design Patents
Chapter 4	Drafting and Enforcing Noncompetition Clauses for Employees
Chapter 5	Standards of Protectable Trade Secrets
Chapter 6	False Comparative Advertising
Chapter 7	Protecting Biotechnology
Chapter 8	Biotechnology Deposit Requirements
Chapter 9	The Chip Protection Act
Chapter 10	Chip Protection: Litigation, Licensing and International Issues

PART II	COUNSELING STRATEGIES FOR SUCCESSFUL PROTECTION OF INTELLECTUAL PROPERTY (CONTINUED)
Subpart A	Protecting the Subject Matter (Continued)
Chapter 11	Software Protection
Chapter 12	Process Patents
Chapter 13	Intellectual Property Protection of E-Commerce
Subpart B	Intellectual Property Strategies in Business Law Settings
Chapters 14-19	Reserved
Chapter 20	Arbitration and Arbitration Clauses
Chapter 21	Technology Joint Ventures

Chapter 22	Personal Liability of Officers and Directors for Corporate Infringement of Intellectual Property Rights
Chapter 23	The Interface Between Antitrust and Intellectual Property Law Principals
Chapter 24	Bankruptcy and Intellectual Property Licensing
Chapter 25	Intellectual Property Clauses in Government Contracts
Chapter 26	Tax Planning for Intellectual Property

PART II	COUNSELING STRATEGIES FOR SUCCESSFUL PROTECTION OF INTELLECTUAL PROPERTY (CONTINUED)
Subpart B	Intellectual Property Strategies in Business Law Settings (Continued)
Chapter 27	Export Control of Intellectual Property
Chapter 28	Privacy, Publicity and Intellectual Property
Chapter 29	Insurance Coverage for Intellectual Property Lawsuits
Chapters 30-39	Reserved
Subpart C	Counseling in the Foreign Setting
Chapter 40	Foreign Trademark Counseling and Strategy
Chapter 41	Strategies for Foreign Patenting of U.S. Inventions
Chapter 42	International Technology License Agreements
Chapter 43	Foreign Patent Litigation
Chapter 44	Reserved
Subpart D	The Role of Council
Chapter 45	Containing Costs in Intellectual Property Litigation

VOLUME 4

PART II	COUNSELING STRATEGIES FOR SUCCESSFUL PROTECTION OF INTELLECTUAL PROPERTY (CONTINUED)
Subpart D	The Role of Council (Continued)
Chapter 46	Legal Opinions in Intellectual Property Matters
Chapters 47-49	Reserved

PART III LITIGATING THE INTELLECTUAL PROPERTY CASE

Subpart A Evaluating and Resolving the Controversy Before Trial

Chapter 50	Risk Evaluation in Intellectual Property Litigation
Chapter 51	Settlement Techniques
Chapter 52	Willfulness and Defense to Willfulness
Chapter 53	Alternative Dispute Resolution
Chapter 54	Reserved
Subpart B	Jurisdiction and Causes of Action
Chapter 55	Jurisdiction and Venue Issues of Concern in Intellectual Property Litigation
Chapter 56	Checklist of Patent Causes of Action and Defenses (With Sample Pleadings)
Chapter 57	Checklist of Trademark and Unfair Competition Causes of Action and Defenses, Including Sample Pleadings
Chapter 58	Checklist of Trade Secret Causes of Action and Defenses, Including Sample Pleadings
Chapter 59	Checklists of Copyright Causes of Action and Defenses, Including Sample Pleadings
Chapters 60-64	Reserved

PART III	LITIGATING THE INTELLECTUAL PROPERTY CASE (CONTINUED)
Subpart C	Preliminary Relief
Chapter 65	Survey of Preliminary Injunction Requirements
Chapter 66	Federal Ex Parte Temporary Relief
Chapters 67-69	Reserved
Subpart D	Discovery
Chapter 70	Discovery in Patent Cases
Chapter 71	Discovery in Trademark Cases in the Courts and Trademark Trial and Appeal Board
Chapter 72	Discovery in Trade Secret Cases
Chapters 73-74	Reserved
Subpart E	Privilege
Chapter 75	Attorney-Client Privilege and Work-Product Immunity in Intellectual Property
Chapters 76-79	Reserved
Subpart F	Trial Techniques

Chapter 80	Selection and Preparation of a Patent Expert in a Patent Case
Chapter 81	Surveys
Chapter 82	Trial Techniques in Jury and Bench Trials of Patent Cases
Chapter 83	Trial Techniques in Trademark Cases
Chapter 84	Trial Techniques in Trade Secret Cases
Chapter 85	Trial Techniques in Jury and Bench Trials of Copyright Cases
Chapters 86-89	Reserved

PART III	LITIGATING THE INTELLECTUAL PROPERTY CASE (CONTINUED)
Subpart G	Relief
Chapter 90	Compensation in Patent Infringement Cases
Chapter 91	Damages for Trademark Infringement
Chapter 92	Fashioning Injunctions in Trademark Cases
Chapter 93	Damages in Copyright Cases
Chapter 94	Attorney's Fees for Frivolous Claims
Chapter 95	Gray Market and Other Unapproved Goods
Chapters 96-98	Reserved
Chapter 99	Interference Practice
PART IV	PRACTICE IN PARTICULAR TRIBUNALS
Subpart A	Practice in P.T.O. Forums
Chapter 100	Effective Presentation of Evidence in Proceedings Before the Patent and Trademark Office
Chapter 101	Reissue and Reexamination in the United States Patent and Trademark Office
Chapter 102	Practice on Appeal Before the Board of Patent Appeals and Interferences
Chapter 103	Inter Partes Practice at the Trademark Trial and Appeal Board
Chapter 104	Reserved

PART IV	PRACTICE IN PARTICULAR TRIBUNALS (CONTINUED)
Subpart B	Practice at the C.A.F.C. and Other Non-P.T.O. Tribunals under its Review
Chapter 105	Practice Before the U.S. Court of Appeals for the Federal Circuit
Chapter 106	Practice at the International Trade Commission
Chapter 107	U.S. Claims Court Practice
Index	

KENNETH R. ADAMO

Kenneth R. Adamo is the author of Chapter 56, "Checklist of Patent Causes of Action and Defenses (With Sample Pleadings)." Mr. Adamo is a Member of the Illinois, New York, Ohio and Texas Bars and is a partner at Jones, Day, Reavis & Pogue, Cleveland, Ohio and Dallas, Texas.

MILES J. ALEXANDER

Miles J. Alexander is the author of Chapter 51, "Settlement Techniques." Mr. Alexander is a senior partner of the Kilpatrick Stockton LLP law firm, which has offices in Atlanta, Augusta, Brussels, Charlotte, London, Miami, Raleigh, Reston, Stockholm, Washington and Winston-Salem.

VINCENT M. AMBERLY

Vincent M. Amberly is the revision author of Chapter 23, "The Interface Between Antitrust and Intellectual Property Law Principles." Mr. Amberly is a partner of David, Hagner, Kuney & Krupin, P.C., Washington, D.C.

HOWARD N. ARONSON

Howard N. Aronson is the author of Chapter 3, "Protecting Designs by Trademark, Copyright and Design Patents." Mr. Aronson is a founding partner of Lackenbach, Siegel, Marzullo & Aronson, P.C., Scarsdale, New York. He is a member of the New York bar and the Westchester County, New York State and American (Member, Patent, Trademark and Copyright Law Section) Bar Associations; New York Patent, Trademark and Copyright Law Association; American Intellectual Property Law Association; The Association of Trial Lawyers of America; The Federal Circuit Bar Association; The International Trademark Association, and is registered to practice before the United States Patent and Trademark Office as well as the Canadian Patent Office. As an author in the field of designs, he has published "Protection Against Use or Pictures of One's Goods by a Competitor Wastes Away Under Waist Away," 73 T.M.R. (1983); Global Colorblindness To Trademarks Is Dying, The National Law Journal, June 5, 1995, at p. C23. He was a panel speaker for the International Trademark Association on the subject of trademark searching. He is also co-author of TRADEMARK MANAGEMENT in the Business Law Monograph Series, published by Matthew Bender & Co.

ANDREW BAUM

Andrew Baum is the author of Chapter 103, "Inter Partes Practice at the Trademark Trial and Appeal Board." Mr. Baum is a member of Darby & Darby, P.C., New York City.

PAUL B. BELL

Paul B. Bell is the author of Chapter 80, "Selection and Preparation of a Patent Expert in a Patent Case." Mr. Bell is a member of Bell, Seltzer, Park & Gibson, Charlotte, North Carolina.

DAVID BENDER

David Bender is the author of Chapter 5, "Standards of Protectable Trade Secrets," and Chapter 11, "Software Protection." Mr. Bender is Of Counsel to White & Case, New York. He is the author of Computer Law: Software Protection and Litigation, published by Matthew Bender & Co.

AMY BENJAMIN

Amy Benjamin is the author of Chapter 46, "Legal Opinions in Intellectual Property Matters." Ms. Benjamin is an attorney with Darby & Darby in New York City.

DAVID H. BERNSTEIN

David H. Bernstein is a co-author of Chapter 57, "Checklist of Trademark-Related Causes of Action and Defenses, Including Sample Pleadings." Mr. Bernstein is a member of the New York and Connecticut state bars and is a former law clerk to Judge Robert E. Keeton of the United States District Court for the District of Massachusetts.

ROBERT S. BRAMSON

Robert S. Bramson is the author of Chapter 46, "Legal Opinions in Intellectual Property Matters." Mr. Bramson is with the Unisys Corporation, Blue Bell, Pennsylvania.

MATTHEW DAVID BROZIK

Matthew David Brozik is the author of Chapter 83, "Trial Techniques in Trademark Cases." Mr. Brozik is a commercial litigator associated with the firm of Ackerman, Levine, Cullen & Brickman, LLP of Great Neck, New York. He is a member of the New York and New Jersey State Bars and the Intellectual Property Law Section of the New York State Bar Association.

RICHARD H. BURGESS

Richard H. Burgess is the author of Chapter 27, "Export Controls on Intellectual Property." Mr. Burgess is admitted to the Ohio, New York, and Delaware bars and is a counsel in the Legal Department of E. I. du Pont de Nemours and Company. Presently, he is chair of the Special Committee on Export Control of the American Intellectual Property Law Association.

THE HONORABLE ARTHUR L. BURNETT, SR.

The Honorable Arthur L. Burnett, Sr. is the author of Chapter 107, "U.S. Claims Court Practice." He is a former Magistrate, U.S. District Court for the District of Columbia and is now an Associate Judge, Superior Court of the District of Columbia.

DUANE BURTON

Duane Burton is the author of Chapter 59, "Checklists of Copyright Causes of Action and Defenses, Including Saple Pleadings." Mr. Burton practices law in Denver, Colorado. He is also the author of *Jury Instructions in Intellectual Property Cases*, published by the Big Foot Press.

T. RAO COCA

T. Rao Coca is the author of Chapter 10, "Chip Protection: Litigation, Licensing and International Issues." Mr. Coca holds both Ph.D. and J.D. degrees. He is a member of the Ohio bar and is Counsel of the Intellectual Property Law Department for International Business Machines Corporation, Tokyo.

RONALD B. COOLLEY

Ronald B. Coolley was the co-author of Chapter 22, "Personal Liability of Officers and Directors for

Corporate Infringement of Intellectual Property Rights." Mr. Coolley is a partner in Arnold, White & Durkee, Chicago, Illinois.

DONNA A. DEMAC

Donna A. Demac is the author of Chapter 28, "Privacy, Publicity and Intellectual Property Law." Ms. Demac, a lawyer, educator and member of the New York State bar, founded the Program on Copyright & the New Technologies at New York University in 1992. For the past ten years, she has taught courses on telecommunications policy and copyright at the graduate Interactive Telecommunications Program at NYU. Beginning in 1993, Ms. Demac will be a fellow at the Freedom Forum Media Studies Center at Columbia University, concentrating on copyright and the new electronic media.

JAMES A. DOBKIN

James A. Dobkin is the author of Chapter 21, "Technology Joint Ventures." Mr. Dobkin is a member of the Washington, D.C. and New York bars and is a partner in Arnold & Porter, Washington, D.C.

ROBERT C. DORR

Robert C. Dorr is the author of Chapter 66, "Federal Ex Parte Temporary Relief." Mr. Dorr is a partner in Dorr, Carson, Sloan & Peterson, Denver, Colorado.

DOUGLAS J. EDMONDS

Douglas J. Edmonds is a co-author of Chapter 55, "Jurisdiction and Venue Issues of Concern in Intellectual Property Litigation." Mr. Edmonds is associated with Spencer Fane Britt and Browne, Kansas City, Missouri.

WILLIAM THOMAS ELLIS

William Thomas Ellis is the author of Chapter 9, "The Chip Protection Act." Mr. Ells is a member of the bars of Virginia, New York and the District of Columbia, and is on the staff of the Intellectual Property Law Department for International Business Machines Corporation.

ROBERT A. FELSMAN

Robert A. Felsman is the author of Chapter 45, "Containing Costs in Intellectual Property Litigation." Mr. Felsman earned a B.S.M.E. from the University of Texas (1957), and his J.D. from the University of Houston (1963). He is a partner in Felsman, Bradley, Gunter & Dillon, Fort Worth, Texas. He is also the Chairman of the Intellectual Property Law Section, State Bar of Texas for 1987-88, and a Fellow in the Texas Bar Foundation.

MELVIN C. GARNER

Melvin C. Garner is the author of Chapter 58, "Checklist of Trade Secret Causes of Action and Defenses, Including Sample Pleadings," and Chapter 13, "Intellectual Property Protection of E-Commerce." Mr. Garner is a partner in Darby & Darby, P.C., New York City.

DAVID GAUNTLETT

David A. Gauntlett, is the author of Chapter 29, "Insurance Coverage for Intellectual Property Lawsuits." Mr. Gauntlett, a founding partner of Callahan & Gauntlett, specializes in policyholder litigation in a

variety of complex coverage disputes emanating from intellectual property, antitrust and environmental claims including bad faith cases and business litigation. He is currently Chair-Elect of the Intellectual Property Committee of the American Bar Association's Tort and Insurance Practice Section and is a nationally-recognized speaker and author. Mr. Gauntlett has spoken before such organizations as the American Bar Association, Practising Law Institute, the American Intellectual Property Law Association, and various state intellectual property bar associations. Mr. Gauntlett is currently lead counsel in over thirty intellectual property coverage disputes pending throughout the United States and is responsible for many precedent-making insurance coverage cases involving, in particular, patent, trademark and copyright infringement as well as trade secret misappropriatin.

RICHARD G. GEIB

Richard G. Geib is the author of Chapter 25, "Intellectual Property Clauses in Government Contracts." Mr. Geib is Patent Counsel for the Grumman Corporation, Bethpage, New York.

MICHAEL A. GOLLIN

Michael A. Gollin is a co-author of Chapter 70, "Discovery in Patent Cases." Mr. Gollin practices intellectual property and environmental law and litigation at 1275 Pennsylvania Avenue, S.W., Washington, D.C.

JOHN T. GOOLKASIAN

John T. Goolkasian is the author of Chapter 102, "Practice on Appeal before the Board of Patent Appeals and Interferences." Mr. Goolkasian is an Examiner-in-Chief at the Board of Patent Appeals and Interferences. He is a 1969 graduate of the Georgetown University Law Center, and a member of the Maryland and District of Columbia bars. He was appointed as an Examiner-in-Chief in June 1983 and has served in the Patent and Trademark Office, both as a Supervisory Primary Examiner and in the Office of the Assistant Commissioner of Patents. He is a former partner of the law firm of Schuyler, Birch, Swindler, McKie and Beckett, Washington, D.C.

JAMES W. GOULD

James W. Gould is a co-author of Chapter 82, "Trial Techniques in Jury and Bench Trials of Patent Cases." Mr. Gould is a member of the New York Bar and the bars of various Federal Courts, including the Supreme Court of the United States. He is a partner in Morgan & Finnegan, New York, New York.

MICHAEL A. GOULD

Michael A. Gould is the author of Chapter 6, "False Competitive Advertising." He is Director of Legal Affairs at International Management Group, New York City.

GERALD W. GRIFFIN

Gerald W. Griffin is a co-author of Chapter 6, "False Comparative Advertising." Mr. Griffin is a partner in Cooper & Dunham, New York City.

ANN LAMPORT HAMMITTE

Ann Lamport Hammitte is the author of Chapter 99, "Interference Practice." Ms. Lamport Hammitte is associated with Lahive & Cockfield, Boston, Massachusetts.

PAUL H. HELLER

Paul H. Heller is a co-author of Chapter 70, "Discovery in Patent Cases." Mr. Heller is a member of Kenyon & Kenyon, New York City.

RANDALL A. HILLSON

Randall A. Hillson is a co-author of Chapter 55, "Jurisdiction and Venue Issues of Concern in Intellectual Property Litigation." Mr. Hillson is associated with Merchant and Gould, Minneapolis, Minnesota.

ETHAN HORWITZ

Ethan Horwitz is the author of Chapter 91, "Damages for Trademark Infringement," and Chapter 92, "Fashioning Injunction in Trademark Cases." Mr. Horwitz is a partner in Darby & Darby, P.C., New York City, and the Co-General Editor of this Publication. He is also the author of World Trademark Law, published by Matthew Bender & Co.

LESTER HORWITZ

Lester Horwitz is the author of Chapter 12, "Process Patents" and Chapter 41, "Strategies for Foreign Patenting of U.S. Inventions." Dr. Horwitz is a member of Ladas & Parry, New York City and a member of the New York and District of Columbia Bars. He is Co-General Editor of this publication and author of *Patent Office Rules and Practice*, published by Matthew Bender & Co.

GEORGE E. HUTCHINSON

George E. Hutchinson is the author of Chapter 105, "Practice Before the Court of Appeals for the Federal Circuit." Mr. Hutchinson is of counsel to Finnegan, Henderson, Farabow, Garrett & Dunner, Washington, D.C. He is a co-author of *Court of Appeals for the Federal Circuit: Practice & Procedure*, published by Matthew Bender & Co.

ROBERTA JACOBS-MEADWAY

Roberta Jacobs-Meadway is the author of Chapter 81, "Surveys," and co-author of Chapter 93 "Damages in Copyright Cases." Ms. Jacobs-Meadway is a partner in Panitch, Schwarze, Jacobs & Nadel in Philadelphia. She is a graduate of Rutgers University School of Law-Newark, where she was Associate Editor of the Rutgers Journal of Computers and Law. She has authored numerous articles for legal and business publications, including the outline "Survey Evidence in Trademark and Unfair Competition Litigation," 6 ALI-ABA COURSE MATERIALS 97, 98 (1982).

ALEXANDER C. JOHNSON, JR.

Alexander C. Johnson, Jr. is the author of Chapter 2, "Drafting Patents with a View to Litigation." Mr. Johnson is a member of the Oregon State Bar, admitted to practice before the U.S. Patent and Trademark Office, and is a principal of Marger, Johnson, McCollom & Stolowitz, Inc., Portland, Oregon.

BRUCE P. KELLER

Bruce P. Keller is a co-author of Chapter 57, "Checklist of Trademark-Related Causes of Action and Defenses, Including Sample Pleadings." Mr. Keller is a partner with Debevoise & Plimpton, New York, New York. He is a member of the New York, New Jersey and Massachusetts state bars, and the American Law Institute's Consultative Group on the Draft, Restatement, Third, Unfair Competition. He

is on the editorial boards of a variety of intellectual property journals and has written and lectured extensively on unfair competition law.

STEVE KIESELSTEIN

Steve Kieselstein is the author of Chapter 24, "Bankruptcy and Intellectual Property Licensing." Mr. Kieselstein is a member of the New York and New Jersey bars and is an associate at Berlack, Israels & Liberman, New York City.

ROBERT C. KLINE

Robert C. Kline is the author of Chapter 52, "Counsel's Opinion as a Defense to Willful Infringement." Mr. Kline is with Fitzpatrick, Cella, Harper & Scinto, Washington, D.C.

JEROME G. LE

Jerome G. Lee is a co-author of Chapter 82, "Trial Techniques in Jury and Bench Trials of Patent Cases." Mr. Lee is a member of the New York Bar and the bars of various Federal Courts, including the Supreme Court of the United States. He is the Senior Partner of Morgan & Finnegan, New York City.

STEVEN E. LIPMAN

Steven E. Lipman is a co-author of Chapter 106, "Practice at the International Trade Commission." Mr. Lipman is the resident partner at Fish & Richardson, Washington, D.C.

RALPH A. LOREN

Ralph A. Loren is the author of Chapter 53, "Alternative Dispute Resolution." Mr. Loren is a partner at the law firm of Lahive & Cockfield, Boston, Massachusetts. He has lectured extensively on intellectual property litigation practice and settlement alternatives.

RICHARD E. LYON

Richard E. Lyon is the author of Chapter 72, "Discovery in Trade Secret Cases." Mr. Lyon is a partner in Lyon & Lyon, Los Angeles.

HARRISON E. MC CANDLISH

Harrison E. Mc Candlish is the revision author of Chapter 102, "Practice on Appeal Before the Board of Patent Appeals and Interferences." He is a 1959 graduate of the George Washington University Law School (J.D.) and a member of the Virginia State Bar. He was appointed as an Examiner-in-Chief in 1984 to what was then known as the Board of Appeals in the United States Patent and Trademark Office and later became an original member of the Board of Patent Appeals and Interferences where he served as an Administrative Patent Judge until his retirement in 1995. Prior to his service on the board, he was in private practice for 25 years and was a partner in the law firm of LeBlanc, Nolan, Shur and Nies.

FRED E. MCKELVEY

Fred E. McKelvey is the author of Chapter 100, "Effective Presentation of Evidence in Proceedings Before the Patent and Trademark Office." Mr. McKelvey is the Solicitor for the U.S. Patent and Trademark Office, Arlington, Virginia.

M. MARGARET MC KEOWN

M. Margaret McKeown is a co-author of Chapter 84, "Trial Techniques in Trade Secret Cases." Ms. McKeown is a partner in Perkins Coie, Seattle, Washington, where she is chairman of the High Technology Group. She was previously in the firm's Washington, D.C., office and also serve as a White House Fellow.

JAY K. MEADWAY

Jay K. Meadway is a co-author of Chapter 93, "Damages in Copyright Cases." Mr. Meadway is with Panitch Schwarze Jacobs & Nadel, Philadelphia, Pennsylvania.

THOMAS A. MILLER

Thomas A. Miller is a co-author of Chapter 22, "Personal Liability of Officers and Directors for Corporate Infringement of Intellectual Property Rights." Mr. Miller is a partner in Arnold, White & Durkee, Houston, Texas.

KATE H. MURASHIGE

Kate H. Murashige is the author of Chapter 7, "Protecting Biotechnology," and Chapter 8, "Biotechnology Deposit Requirements." Ms. Murashige is a partner in Ciotti & Murashige, Menlo Park, California.

VINCENT N. PALLADINO

Vincent N. Palladino is the author of Chapter 95, "Gray Market Goods." Mr. Palladino is a member of Fish & Neave, New York City.

LOUIS P. PETRICH

Louis P. Petrich is the author of Chapter 85, "Trial Techniques in Jury and Bench Trials of Copyright Cases." Mr. Petrich is a member of the California Bar and bars of various federal district and appellate courts. He is a member of Leopold, Petrich & Smith, a Professional Corporation, of Los Angeles, California and was the President of the Los Angeles Copyright Society for 1987–1988.

MARVIN PETRY

Marvin Petry is the author of Chapter 26, "Tax Planning for Intellectual Property." Mr. Petry is a partner in Larson and Taylor, Arlington, Virginia. He is also the co-author of *Taxation of Intellectual Property and Technology*, published by Matthew Bender & Co.

LOUIS T. PIRKEY

Louis T. Pirkey is the author of Chapter 83, "Trial Techniques in Trademark Cases." Mr. Pirkey is a member of the firm of Arnold, White & Durkee in its offices in Austin, Texas. He is a member of the Trademark Review Commission, a past Chairman of the Intellectual Property Law Section of the State Bar of Texas, past director of the United States Trademark Association, member of the United States Delegation to the Diplomatic Conference on the Revision of the Paris Convention and is currently serving as President of the Austin Intellectual Property Law Association.

David W. Plant is the author of Chapter 20, "Arbitration and Arbitration Clauses." Mr. Plant is a partner at Fish & Neave, New York City.

PASQUALE A. RAZZANO

Pasquale A. Razzano is the author of Chapter 65, "Survey of Preliminary Injunction Requirements." Mr. Razzano is a member of Fitzpatrick, Cella, Harper & Scinto, New York City.

JOHN RICHARDS

John Richards is the author of Chapter 42, "International Technology License Agreements," and Chapter 43, "Foreign Patent Litigation." Mr. Richards is a member of Ladas & Parry, New York City.

FRANK E. ROBBINS

Frank E. Robbins is the author of Chapter 101, "Reissue and Reexamination in the United States Patent and Trademark Office." Mr. Robbins is a partner in Venable, Baetjer, Howards & Civiletti, Washington, D.C.

AUGUST E. ROEHRIG. JR.

August E. Roehrig, Jr. is the author of Chapter 75, "Attorney-Client Privilege and Work-Product Immunity in Intellectual Property." Mr. Roehrig is a member of Wall & Roehrig, Syracuse, New York. He formerly practiced intellectual property law and did trial work in Chicago for twenty years.

HEIDI L. SACHS

Heidi L. Sachs is a co-author of Chapter 84, "Trial Techniques in Trade Secret Cases." She is an associate at Perkins Coie, Seattle, Washington, specializing in intellectual property law.

SANDRA A. SELLERS

Sandra A. Sellers is a co-author of Chapter 106, "Practice at the International Trade Commission." Ms. Sellers is a partner in William Brinks Olds Hofer Gilson & Lione, Washington, D.C.

NEIL A. SMITH

Neil A. Smith is the author of Chapter 71, "Discovery in Trademark Cases in the Courts and Trademark Trial and Appeal Board." Mr. Smith is a partner in Limbach, Limbach & Sutton, San Francisco, California.

MILTON SPRINGUT

Milton Springut is a co-author of Chapter 1, "Defensive Measures Against Counterfeiting." Mr. Springut is a member of the firm of Liebermann, Rudolph & Nowak, New York City.

J. RODMAN STEELE, JR.

J. Rodman Steele, Jr. is the author of Chapter 4, "Drafting and Enforcing Non-Competition Clauses for Employees." Mr. Steele is a member of Quarles & Brady in West Palm Beach, Florida. He is the author of *Protecting Corporate Trade Secrets* in the Business Law Monograph Series, published by Matthew Bender & Co.

RICHARD J. TAYLOR

Richard J. Taylor is the author of Chapter 40, "Foreign Trademark Counseling and Strategy." Mr. Taylor is Senior Trademark Attorney, Colgate-Palmolive Company, New York City. He is a member of the New York Bar, and Chairman, International Trademark Committee, United States Trademark Association. He is a former member of the faculty (*Maitre assistant associate*) of the Law School of the University of Paris I-Pantheon-Sorbonne.

DAVID K. TELLEKSON

David K. Tellekson is a co-author of Chapter 55, "Jurisdiction and Venue Issues of Concern in Intellectual Property Litigation." Mr. Tellekson is associated with Merchant & Gould, Minneapolis, Minnesota.

ROBERT L. TUCKER

Robert L. Tucker is a co-author of Chapter 1, "Defensive Measures Against Counterfeiting." Mr. Tucker is in practice at 160 East 84th Street, New York City.

MARC B. VICTOR

Marc B. Victor is the author of Chapter 50, "Risk Evaluation in Intellectual Property Litigation." Mr. Victor is a Menlo Park, California, attorney specializing in the evaluation of large, complex litigation. He is also president of Litigation Risk Analysis, Inc., in which role he instructs senior attorneys nationwide in how to perform the kind of risk evaluation illustrated in his chapter.

MAXIM H. WALDBAUM

Maxim H. Waldbaum is the author of Chapter 90, "Compensation in Patent Infringement Cases." Mr. Waldbaum is a member of Fried, Frank, Harris, Shriver & Jacob, New York City. He is the co-author of Acquiring and Protecting Intellectual Property Rights in the Business Law Monograph Series, published by Matthew Bender & Co.