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S. HRG. 111–695, Pt. 3

CONFIRMATION HEARINGS ON FEDERAL APPOINTMENTS

HEARINGS

BEFORE THE

COMMITTEE ON THE JUDICIARY
UNITED STATES SENATE

ONE HUNDRED ELEVENTH CONGRESS

FIRST SESSION

JULY 29, SEPTEMBER 9, and SEPTEMBER 23, 2009

Serial No. J–111–4

PART 3

Printed for the use of the Committee on the Judiciary



CONFIRMATION HEARINGS ON FEDERAL APPOINTMENTS

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NOMINATIONS OF BEVERLY BALDWIN MARTIN, NOMINEE TO BE UNITED STATES CIRCUIT JUDGE FOR THE ELEVENTH CIRCUIT; JEFFREY L. VIKEN, NOMINEE TO BE UNITED STATES DISTRICT JUDGE FOR THE DISTRICT OF SOUTH DAKOTA; AND, DAVID J. KAPPOS, NOMINEE TO BE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE

WEDNESDAY, JULY 29, 2009

U.S. SENATE,
COMMITTEE ON THE JUDICIARY,
Washington, DC

The Committee met, pursuant to notice, at 10 a.m., in room SD–226, Dirksen Senate Office Building, Hon. Patrick J. Leahy, Chairman of the Committee, presiding.

Present: Senators Klobuchar, Specter, Franken, Sessions and Hatch.

OPENING STATEMENT OF HON. PATRICK J. LEAHY, A U.S. SENATOR FROM THE STATE OF VERMONT

Chairman LEAHY. Good morning, everyone. Yesterday, the Judiciary Committee reported the nomination of Judge Sonia Sotomayor to be a justice on the United States Supreme Court. And this morning, we are holding our first confirmation hearing for lower court nominees since the Supreme Court vacancy arose in May.

The vacancies throughout the Federal courts have already risen to over 80. In addition, 27 upcoming vacancies have been announced. That is going to push Federal judicial vacancies to over 100. We worked very hard to fill the vacancies during the last presidency.

Back when I chaired this Committee and we had a President of the other party in the White House, we were able to reduce overall vacancies by two-thirds, from over 100 down to 34, and reduce circuit court vacancies to single digits.

Despite having received Federal judicial nominees since March from President Obama and despite having held hearings and reported those nominees in June, not a single Federal judge has been

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confirmed by the Senate all year. I believe the Senate has to do better.

I mention that because when I was Chairman of this Committee with a Republican President, I moved President Bush's nominees through faster than either of the Republican chairmen did for President Bush, because I did not want to go back to what had been, during President Clinton's time, when 61 of President Clinton's nominees were pocket filibustered by the other side.

I mention that because we tried very hard to have judges looked at as judges and to get out of partisan politics, and I hope we can get back to that. There is absolutely no excuse for not having moved yet. In fact, I notice even the U.S. Attorney recommended by Senator Sessions, the Ranking Member of this Committee, has been blocked. This is despite the fact that we cleared his nomination on the Democratic side of the aisle. This nominee of a Republican has been blocked by the Republican side. We have got to do better than that.

Now, both judicial nominations we consider today come to us with bipartisan support. President Obama's nomination of Judge Beverly Martin to be elevated from the U.S. District Court for the Northern District of Georgia to the Eleventh Circuit has the support of Georgia Senators, Senator Chambliss and Senator Isakson. Senator Isakson and I had a good chat about this yesterday on the floor. Senator Chambliss and I talked with Judge Martin this morning.

Jeffrey Viken has been nominated to serve on the U.S. District Court for the District of South Dakota and he has the support of South Dakota senior Senator, Senator Johnson, and Senator Thune.

Judge Martin is the fourth of President Obama's circuit court nominees to come before the Committee and the fourth with extensive experience as a well respected Federal district court judge.

When her nomination came to the Senate in 2000, it had the support of Senator Max Cleland, Democrat, and Senator Paul Coverdell, a Republican, also a friend of all of ours who died much too early.

Since her confirmation, she has managed a docket of 3,100 cases. Her nomination to the circuit court is rated unanimously well qualified by the ABA Standing Committee on the Federal Judiciary. I should note that is the highest rating they can give.

Before becoming a Federal judge, she served as the U.S. Attorney for the Middle District of Georgia; as an Assistant U.S. Attorney in that office; and as an Assistant Attorney General in the Office of the Attorney General of Georgia. It is no secret on this Committee that, as a former prosecutor, I love seeing people who have had prosecutorial experience.

Jeffrey Viken's wide-ranging experience makes him particularly qualified to serve as a judge on the U.S. District Court for the District of South Dakota. He is currently the Federal defender for the combined districts of North Dakota and South Dakota. I kind of gulp when I think of the land area that covers. I do not even want to think of how many times the size of Vermont that is.

He spent more than two decades at a South Dakota law firm. Before that, he served as the District of South Dakota's Acting U.S.

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Attorney and as an Assistant U.S. Attorney, again, a former prosecutor.

We will also include in today's hearing the nomination of David Kappos to be Director of the U.S. Patent and Trademark Office and Under Secretary of Commerce for Intellectual Property. He is well respected on both sides of the aisle, all parts of the intellectual property community, someone I have known for years.

He is no stranger to the members of the Committee. He has worked with Senator Hatch and I and others on patent reform legislation. Coalitions on all sides of that debate applauded his nomination. We know the PTO needs strong and accountable leadership. It has a significant backlog of applications and faces serious challenges and we need somebody who can work with us on patent reform legislation and also can run the department, because, ultimately, patent quality begins at the PTO and that requires effective leadership.

I am pleased that the President has nominated someone for this position with strong qualifications and abilities. I said to him earlier I do not know whether to give him congratulations or condolences, because it is going to be one of the toughest jobs in the government.

So I hope the hearing today can mark a new start in cooperating to fill vacancies. Republican objections have prevented the Senate from confirming nominees reported by the Judiciary Committee for over 2 months, since May 12, including, as I said, somebody sponsored by the Ranking Republican on this Committee, Senator Sessions.

There are currently 17 nominees reported by the Judiciary Committee pending on the executive calendar. A dozen have been installed on the Senate executive calendar since before the Fourth of July recess, five U.S. Attorneys, four Assistant Attorneys General, Chairman of the United States Sentencing Commission and others, as well as a number of judges. So I hope we can move forth.

[The prepared statement of Chairman Leahy appears as a submission for the record.]

Senator Hatch, former Chairman of this Committee, former Ranking Member of this Committee, experienced person who, at least once or twice a year, will agree with me on something. I am delighted to have you here.

[Laughter.]

STATEMENT OF HON. ORRIN HATCH, A U.S. SENATOR FROM THE STATE OF UTAH

Senator HATCH. Long-term listener to Senator Leahy.

[Laughter.]

Senator HATCH. It is a privilege to be with you, Mr. Chairman, and I appreciate your leadership of this Committee.

Judge Martin, welcome back to the Judiciary Committee. I was chairing the Committee when you first arrived. We have been proud of your service. And, Mr. Viken, we look forward to helping to confirm you.

Mr. Kappos, I agree with the distinguished Chairman. This is one of the toughest jobs in all of the Federal Government and I

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think you are not only up to the job, I think you can do a great job there, and I look forward to supporting you.

There is no question that America's ingenuity fuels our economy and we have to ensure that our patent system is as strong and vibrant as possible; not only to protect our country's premier position as the world leader in innovation, but, also, to secure our economic future.

So I support you. I will announce that in advance. I may not be able to stay for the whole hearing, but just know that I am very proud of you for being willing to leave the private sector and come to the government and work in this very difficult position.

You two nominees for judge, we are very grateful you are willing to serve and willing to participate in our government. We know that there are nice things that come from being a Federal judge, but there are a lot of difficulties, too, and we appreciate your willingness to serve.

Thank you, Mr. Chairman.

Chairman LEAHY. Thank you. I would note for the record that Senator Hatch and I have been good friends for decades.

Senator HATCH. That is true.

Chairman LEAHY. And we do enjoy teasing each other, but we have worked together and there has been an awful lot of Hatch-Leahy and Leahy-Hatch legislation that has passed this body.

We are going to go, as we normally do, by seniority of the Senators who are here. I appreciate you taking the time. I would note that, to the nominees, if the Senators, after they have introduced you, leave, that is not an indication how they feel about your qualifications. It is just that each one of these three Senators have several other committee meetings going on at this time.

We will begin with Senator Johnson.

PRESENTATION OF JEFFREY L. VIKEN, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE DISTRICT OF SOUTH DAKOTA, BY HON. TIM JOHNSON, A U.S. SENATOR FROM THE STATE OF SOUTH DAKOTA

Senator JOHNSON. Good morning and thank you, Mr. Chairman and members of the Committee. It is my great pleasure to be here this morning to introduce my friend, Jeff Viken, to be a Federal judge for our home State of South Dakota. I am also glad to see Jeff's wife, Linda Lea, is here.

I have known Jeff since law school at the University of South Dakota and know well of his qualifications to fill the post of U.S. district judge. It is a great honor that President Obama has placed on Jeff. We are very lucky in South Dakota to have a great member of the legal community nominated to this post.

Jeff has many years of public service and I look forward to his continued work for the people of our home state in the future.

Thank you for your consideration of this nominee.

Chairman LEAHY. Thank you very, very much. Before I move on to the others, you have introduced Jeffrey Viken. Mr. Viken, do you have other members of your family here? I mention this because at some point, this will be in the Viken archives and you will want to know who was here.

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Mr. VIKEN. Thank you, Mr. Chairman. My district is 124,000 square miles.

Chairman LEAHY. That is bigger than Vermont.

[Laughter.]

Mr. VIKEN. [Off microphone.]

Chairman LEAHY. Thank you. Thank you very much for having them all here. Senator Chambliss.

PRESENTATION OF BEVERLY BALDWIN MARTIN, NOMINEE TO BE U.S. CIRCUIT JUDGE FOR THE ELEVENTH CIRCUIT, BY HON. SAXBY CHAMBLISS, A U.S. SENATOR FROM THE STATE OF GEORGIA

Senator CHAMBLISS. Thank you very much, Mr. Chairman. It is a privilege for me to be here before you and my dear friend, Senator Hatch, Senator Franken to introduce to this Committee Beverly Martin. Beverly is a long-time dear friend, but her father and I go back even further than that, as a brand new lawyer in the Middle District of Georgia about 40 years ago.

You always, as young lawyers, as you know, try to look to the best lawyers around to emulate and to learn from. Beverly's father, her grandfather and her great-grandfather were all lawyers and her father was one of the outstanding lawyers in our state and somebody that I looked to early on to learn from.

So it is, indeed, a privilege to be back here 9 years after I came here to help introduce her before Chairman Hatch, at that point in time, to this Committee, regarding her nomination to the district court bench for the Northern District of Georgia.

Beverly brings a great tradition, not just a family tradition, to the bench. She served as a member of Attorney General Mike Bowers' team at the state level for many years, and, there, I had the opportunity to work with her from time to time, because I did an awful lot of condemnation work and we worked very closely with that group of lawyers at the state level. I knew then what an outstanding person and outstanding lawyer she is.

Beverly then went to become an Assistant U.S. Attorney in the Middle District and, ultimately, the U.S. Attorney, as she was named by President Clinton, and then was elevated to the bench on the Northern District of Georgia thereafter and, as the Chairman noted, she has handled over 3,100 cases during that 9 years, and she is so well respected by not just the judges who work with her every day, but by the lawyers that practice before her, and that is a real credit to her.

She is one of those special individuals and I know Senator Sessions, as a former U.S. Attorney, remembers the weed-and-seed program that was so popular. Beverly was a strong advocate of the weed-and-seed program during her U.S. Attorney days and she started programs in different parts of the district, in Valdosta, Columbus, Macon and Athens, and just did so many great things outside of the courtroom, just like she did inside the courtroom.

She is tough, but she is fair, and that is what I hear from lawyers who practice before her on a regular basis. She replaces another great Maconite, Lanier Anderson, who was appointed by President Carter back in the 1970's. He has served us well on the Eleventh Circuit and Beverly is going to bring not just a great tra-

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dition to the Eleventh Circuit from a family perspective, but she is an excellent lawyer. She is an excellent judge, and she is going to make a fine member of the Eleventh Circuit bench.

I look forward to supporting her as her nomination moves to the floor. I thank you again for the opportunity to be here today to introduce her.

Chairman LEAHY. Thank you very much. As I said, I enjoyed meeting her with you. Of course, Senator Chambliss and I have served together on another committee for years, on the Agriculture Committee, when he was chairman and since.

Senator Isakson.

PRESENTATION OF BEVERLY BALDWIN MARTIN, NOMINEE TO BE U.S. CIRCUIT JUDGE FOR THE ELEVENTH CIRCUIT, BY HON. JOHNNY ISAKSON, A U.S. SENATOR FROM THE STATE OF GEORGIA

Senator ISAKSON. Thank you, Chairman Leahy, Ranking Member Sessions. It is an honor for me to join with the senior Senator from Georgia, Saxby Chambliss, in introducing Judge Beverly Martin.

I suffer at an extreme disadvantage when it comes to judicial appointments. I am not an attorney. So I have to set a criteria that may be different in judging people, and there are three things I look for when I consider the judicial appointments. One is knowledge, second is integrity, and the third is judicial activism.

I was called out of a dinner at the Marriott downtown the day of the announcement by the President of Beverly Martin's nomination to the Eleventh Circuit. I received an emergency call, which I rarely get. It was from Mike Bowers, the former Republican Attorney General of the State of Georgia, now a practicing attorney, under whom Beverly Martin served in the Georgia Attorney General's office many years ago.

He said, "Johnny, I just want you to know I heard today that Beverly Martin has been nominated for the Eleventh Circuit. I want to tell you that I have never known a finer practicing attorney, never known a finer prosecutor," which I know the Chairman will identify with that remark, "and I think she will be an outstanding judge in the Northern District."

The last call I received today was from south Georgia, from an attorney by the name of Jimmy Franklin, just to tell me how much he thought of Judge Beverly Martin. But for me, on the case of judicial activism, I tried to look back at her record to find some way to give me an indication of her position on judicial activism and I came upon her testimony when she was before this Committee on judicial activism in her appointment to the Northern District.

If I can, I would like to quote her answer to this Committee. "Once a case is properly before a court, a judge is obligated to follow the United States Constitution, statutory law and the doctrine of stare decisis, to adhere to the legal precedent. The precept is paramount, because it is necessary to the stability of our system for individuals and commercial concerns to find predictability in our judicial system and anticipate what actions are legally permissible. United States district courts have a limited jurisdiction and it is the solemn obligation of a judge not to find jurisdiction where it does not exist."

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That was all I needed to know that Judge Martin was the type of judge that I am proud to be able to be before you today and introduce to you as a Georgian, a great justice, and a fine person.

Thank you, Mr. Chairman.

Chairman LEAHY. Thank you. Judge, this just elaborates on the very nice things that Senator Isakson said to me on the floor of the Senate. Judge, you have family members here, do you?

Ms. MARTIN. [Off microphone.]

Chairman LEAHY. I suspect two very proud gentlemen. Thank you. I thank all three of you for being here. I appreciate you being here. I know you have to be out—you are welcome to stay, of course, but I know you have all got committee meetings. So thank you very much.

I should note, while they are moving things around, that on David Kappos, he has been nominated by President Obama to be the Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office.

In March, he had testified before the Committee on patent reforms. He has spent his entire professional career with IBM Corporation; graduated with highest honors from University of California-Davis in 1983 with a degree in electrical and computer engineering; again, worked for IBM as an engineer; went to the general counsel's office after receiving his law degree from the University of California-Berkeley in 1990; has held several positions within the general counsel's office, now serving as vice president and assistant general counsel for intellectual property.

He serves on the board of directors of the American Intellectual Property Law Association, Intellectual Property Owners Association, the International Intellectual Property Association, as the vice president of the Intellectual Property Owners Association. I will put the rest of that in the record.

[The information appears as a submission for the record.]

Chairman LEAHY. Mr. Kappos, do you have family members here?

Mr. KAPPOS. Yes, I do.

Chairman LEAHY. For the Kappos archives, go ahead, please.

Mr. KAPPOS. [Off microphone.]

Chairman LEAHY. Oh, boy, you know how to get it. Where in Vermont?

Mr. KAPPOS. [Off microphone.]

Chairman LEAHY. Manchester.

Mr. KAPPOS. [Off microphone.]

[Laughter.]

Mr. KAPPOS. [Off microphone.]

Chairman LEAHY. No wonder the room is so full today.

[Laughter.]

Chairman LEAHY. We will check after with the staff to make sure we get all these names spelled correctly. Let us have the three nominees come forward and let me administer the oath, and we can begin.

[Nominees sworn.]

Chairman LEAHY. Let the record show that each of the nominees took the oath and agreed to it. We will start with you, Judge Martin, if you have an opening statement that you would like to give.

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STATEMENT OF BEVERLY BALDWIN MARTIN, NOMINEE TO BE UNITED STATES CIRCUIT JUDGE FOR THE ELEVENTH CIRCUIT

Ms. MARTIN. I do not have an opening statement, but I have got some people I would like to thank. On my way walking up here this morning, I remember that it was 35 years ago this summer that I was a summer intern for Senator Sam Nunn. So to be here this morning with both of my Senators from the State of Georgia is a big deal for me and I am grateful to them for being here.

I wanted to mention that in addition to my husband and my father, there are six of my law clerks here today, former, present and future; one that is going to start in 2 weeks. Also, I noticed a couple of my colleagues from my time as United States Attorney, and I appreciate them being here, as well. But most of all, thank you all for having me here this morning.

Chairman LEAHY. You had the privilege of serving with Sam Nunn. His wife, Colleen, was my wife's big sister when she came here. Spouses will help spouses of incoming Senators, and they often become friends forever. My wife has served in a similar position with a number of people. She did it with a young Senator from Illinois named Barack Obama, with Michelle Obama.

Mr. Viken.

[The biographical information of Beverly B. Martin follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Beverly Baldwin Martin

2. **Position**: State the position for which you have been nominated.

   United States Circuit Judge for the Eleventh Circuit

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   2388 U.S. Courthouse
   75 Spring Street, SW
   Atlanta, GA 30303

4. **Birthplace**: State date and place of birth.

   1955; Macon, Georgia

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1978-1981, University of Georgia School of Law; Juris Doctorate, awarded June, 1981

   1973-1976, Stetson University, Bachelor of Arts awarded June, 1976

   1972-1973, Mercer University, no degree

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

Employment:
August 2000 to present
United States Courts
2388 U.S. Courthouse
75 Spring Street, SW
Atlanta, GA 30303
United States District Judge

1994 – 2000
Office of the United States Attorney
300 Mulberry Street
Macon, GA 31201
United States Attorney (1998-2000)
Acting United States Attorney (1997-1998)
Assistant United States Attorney (1994-1997)

1984 – 1994
Office of the Attorney General of Georgia
40 Capitol Square
Atlanta, GA 30334
Assistant Attorney General

1981 – 1984
Martin & Snow
240 Third Street
Macon, GA 31201
Attorney

1980
Office of the Attorney General of Georgia
40 Capitol Square
Atlanta, GA 30334
Summer Intern

1977 - 1978
Butler, Binion, Rice, Cook & Knapp
Washington, D.C. (No longer a going concern)
Receptionist/Paralegal

1977
Can Manufacturers Institute
1730 Rhode Island Avenue, NW
Washington, D.C. 20036
Receptionist

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Other affiliations:
1990 – 2003
Lone Star Corporation
P. O. Box 1606
Macon, GA 31202
Member, Board of Directors

Since approximately 1990
J.M. & Star
P. O. Box 1606
Macon, GA 31202
Minority (6%) partner

1999 – 2000
Macon State College Foundation
100 College Station Drive A-228
Macon, GA 31206
Member, Board of Directors

1982 – 1984
Cronin-Martin, Inc.
(Exercise studio, no longer in business)
Shareholder

Approximately 1985-2000
Career Women's Network
Board member 1996-1997

2002-2005
Mercer University Walter F. George School of Law
1021 Georgia Avenue
Macon, Georgia 31207
Board of Visitors

2008 - present
Member, Board of Directors
Georgia Women of Achievement
P.O. Box 5851
Atlanta, GA 31107

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I have never served in the military.

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8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

   Named "Woman of Achievement" by Career Women's Network in Macon, Georgia in 1999.

   Named "Alumni of the Year" by Stratford Academy in Macon, Georgia in 1999.

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

   State Bar of Georgia (1981 to present)

   Atlanta Bar Association (approximately 2003 - 2008)

   Macon (Georgia) Bar Association (approximately 1995-2000)

   District Representative to Younger Lawyers Executive Comm (1981-1984)

   Member, Attorney General's Advisory Committee (January 2000 – August 2000)

10. **Bar and Court Admission**:

    a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

       State Bar of Georgia: 1981
       There has been no lapse in membership.

    b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

       Georgia Trial Courts: June, 1981

       Georgia Court of Appeals: October 22, 1981

       Georgia Supreme Court: October 22, 1981

       United States District Court for the Middle District of Georgia: August 15, 1981

       United States District Court for the Southern District of Georgia: May 22, 1989

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United States District Court for the Northern District of Georgia: April 22, 1991

United States Court of Appeals for the Eleventh Circuit: November, 1981

Supreme Court of the United States: December 11, 1989

There have been no lapses in membership.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Career Women's Network
Approximately 1985-2000
Board member 1996-1997
Chair, Scholarship Committee 1996-1997

Georgia Association of Women Lawyers
sporadically between 1981-1997

Habitat for Humanity
Member, Nurturing Committee, 1997

Lawyers Club of Atlanta
approximately 1985 to 2007

Board of Visitors, Mercer University Law School
2002-2005

American Judicature Society
approximately 1999

Georgia Women of Achievement
Board member, 2008 - present

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical

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implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

None of the organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

My only published article was one I did in law school. The name of the article was "European Economic Community— Article 119—British Equal Pay Act of 1970—Referral to European Court of Justice—Applicability to British Pension Plan and to Successive Employment Cases." (10 Ga. J. Int'l & Comp. L. 203 (1980)).

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

I testified before the United States Senate Judiciary Committee on May 25, 2000 in connection with my nomination to be United States District Judge for the Northern District of Georgia.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter.

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If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

I have spoken at a number of Continuing Legal Education seminars, primarily for Georgia lawyers. To the best of my recollection, this is a list of my speaking engagements.

Panel member, Federal Bar Association Continuing Legal Education for new lawyers on June 19, 2009.

State Bar of Georgia sponsored Continuing Legal Education for new lawyers on March 13, 2009.

Investiture of Chief Judge Yvette Miller for the Georgia Court of Appeals (I was one of seven speakers who gave brief remarks.)

Ceremony honoring the Honorable Orinda Evans for her public service on February 7, 2008.

Panel member, meeting of Federal Public Defenders in Phoenix on March 7, 2007.

Commencement address at Mercer University Law School on May 6, 2005.

Continuing Legal Education seminar held by the Atlanta Lawyers' Club on January 26, 2005.

Panel member, American Bar Association meeting in Atlanta on August 6, 2004.

Panel discussion at a meeting of the Federalist Society in Atlanta, Georgia on October 23, 2003.

I met with a small number of employment lawyers regarding federal employment practice on May 14, 2002.

I spoke at a continuing legal education seminar called Federal Civil Litigation in Georgia on May 1, 2001.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

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I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

Mercer Law School Commencement Address, Mercer Univ. News-Releases, June 1, 2005

"Martin Glides Through Senate," *Macon Telegraph*, June 20, 2000

"U.S. Attorney's Office Collects $4.5 Million," *Macon Telegraph*, December 4, 1999

"Police Keep Eye on Local Felons," *The Red & Black*, September 17, 1999

"Let state rules guide federal prosecutors." *The Atlanta Journal and Constitution*, July 18, 1999.

"Fort Hill 'Drug Kingpin" Receives Life Sentence, *Macon Telegraph*, May 20, 1999

"Law Enforcement Agencies Split $520,000 Seizure: Macon Police Take Home More Than $260,000," *Macon Telegraph*, April 20, 1999

"DuPont Settles Charges of Withholding Evidence," *New York Times*, January 2, 1999

"DuPont to donate $ 10 million to Georgia law schools to end settlement," *The Associated Press* January 2, 1999.

"DuPont to Give Millions to State's 4 Law Schools," *The Augusta Chronicle* January 2, 1999.

"State senator's son, football coach arrested in fire at car dealership," *The Associated Press* , December 11, 1998.

"Alleged drug dealer built mansion," *The Atlanta Journal and Constitution,* August 7, 1998.

"Police sweep nets 257 arrests in Atlanta," *The Atlanta Journal and Constitution,* May 30, 1998.

"Macon Woman Tapped To Be U.S. Attorney," *Macon Telegraph*, June 5, 1997.

"2 Georgians may get federal legal posts," *The Atlanta Journal and Constitution,* June 4, 1997.

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"Macon Man Sentenced to Life Without Parole: Alleged Victim Speaks at Sentencing," *Macon Telegraph*, June 29, 1996

"2 more former DFACS workers facing charges," *The Atlanta Journal and Constitution,* June 29, 1996.

"A 30 second glance at state and local news," *The Atlanta Journal and Constitution,* October 12, 1991.

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

On August 3, 2000, after confirmation by the United States Senate, President Clinton appointed me to be United States District Judge for the Northern District of Georgia. I presently hold that office and have held no other judicial office.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? Sixty-nine trials

During my time as a judge, approximately 3100 cases have been assigned to me, and of those, 1990 cases went to verdict or judgment. Of these approximate 1990 cases which went to judgment or verdict, 69 of them went to trial.

i. Of these, approximately what percent were:

jury trials? 75%; bench trials 25 % [total 100%]

civil proceedings? 57%; criminal proceedings? 43% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

See attached list.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

1. Jack Alderman v. James Donald, 1:07-cv-1474-BBM
Mr. Alderman challenged Georgia's lethal injection method of execution in his capacity as a death row inmate. The Supreme Court of the United States decided a similar case challenging Kentucky's lethal injection method of execution in Baze v. Rees, __ U.S.__, 128 S. Ct. 1520 (2008) during the pendency of my case. Under Eleventh Circuit precedent, Mr. Alderman's complaint was time-barred.

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Attorneys for Plaintiff:

Elizabeth K. Quinn, Hanna F. Madbak, James M. Ringer, Jeanette R. Blair, Maryana A. Kodner, Michael A. Siem, Sarah M. Chopp
Clifford Chance LLP
31 W. 52nd Street
New York, NY 10019
212-878-3489

Jason Richard Edgecombe, William E. Hoffman, Jr.
King & Spalding
1180 Peachtree Street, NE
Atlanta, GA 30309
404-572-4600

Thomas H. Dunn
Georgia Resource Center
303 Elizabeth Street
Atlanta, GA 30307
404-222-9202

Attorney for Defendant:

Eddie Snelling, Jr.
Office of State Attorney General
40 Capital Square, SW
Atlanta, GA 30334
404-463-8850

2. United States v. Davis, et al., 1:05-cr-316-BBM
This was a mortgage fraud case, charging twenty-one defendants with numerous counts of bank fraud, wire fraud and money laundering. The majority of defendants pled guilty, but five defendants went to trial, and all but one of the twenty-one defendants were convicted.

Counsel for the government were Douglas W. Gilfillan, who can be reached at 404-581-6186, William L. McKinnon, Jr., who can be reached at 404-581-6000, and Gale McKenzie, who can be reached at 404- 581-6045.

The defendant's lawyers were as follows:

Counsel for Clarence Davis was Donald Samuel, who can be reached at 404-262-2225.

Counsel for Virginia Novrit was Steven H. Sadow, who can be reached at 404-577-1400.

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Counsel for Olympia Ammons were Edwin Marger, who can be reached at 706-692-3060, Lynn Fant, who can be reached at 404-550-2375 and Jeffrey M. Witt, who can be reached at 314-607-6469.

Counsel for Mohammed Bayorh was Steven H. Sadow, who can be reached at 404-577-1400.

Counsel for Joseph Costánzo was Edward T. M. Garland who can be reached at 404-262-2225.

Counsel for Mohammad Hassamadi were Jay Strongwater, who can be reached at 404-872-1700, as well as Keri Patterson Ware and Robert Earl Wilson who can both be reached at 404-377-3638.

Counsel for Joe Jetton were Thomas Scott Clegg, who can be reached at 404-373-6420, Jennifer M. Daniels, who can be reached at 404-264-1500, and John R. Lovell who can be reached at 404-760-1116.

Counsel for David Kroll was Paul S. Kish, who can be reached at 404- 588-3991, and Seth Kirschenbaum who can be reached at 404-688-2000.

Counsel for Leon Lumsden was David MacKusick, who can be reached at 678-231-4268.

Counsel for Ronald D. Martin, Jr. was Dorian Murry who can be reached at 404-873-0093 and Kristopher P. Shepherd, who can be reached at 706-548-7249.

Counsel for Ricardo Myrie was Georgetta Glaves-Innes, who can be reached at 678-992-2675.

Counsel for Hassan Nimapoo was Bruce Howard Morris, who can be reached at 404-262-2500, and Wilmer ("Buddy") Parker III, who can be reached at 404-875-2700.

Counsel for Attemerell Smith was Robert L. Mack, Jr., who can be reached at 678-610-8155.

Counsel for Daryl Smith was Ricky Richardson, who can be reached at 404-892-6420.

Counsel for Randall Tharp was Patrick D. Deering, who can be reached at 404-659-6161.

Counsel for Fabian Wiltshire was Janice Singer, who can be reached at 404-262-6277.

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Counsel for Gregory Wings was Brian Steel, who can be reached at 404- 605-0023.

Counsel for Calvin Wright was Akil K. Secret, who can be reached at 404-241-8890.

3. M.C. Asset Recovery, LLC v. The Southern Co., 1:06-cv-417-BBM
This action was brought on behalf of certain creditors of Mirant Corporation, which was a wholly-owned subsidiary of Southern Company. M.C. Asset was appointed by the Bankruptcy Court to represent those creditors. Mirant was incorporated to serve as a holding company for Southern Company's merchant energy business operations, and ultimately went bankrupt. M.C. Asset brought this action alleging that the transfers to Southern Company constituted fraudulent transfers. Plaintiffs allege fraudulent transfers in the amount of $2 billion. This case has been actively litigated for three years, and the parties recently notified me that they had resolved the case by settlement. I wrote a number of Orders in the case during its pendency. One of my rulings is reported at 2006 WL 5112612. Counsel for M.C. Asset Recovery are the following:

A. Ross Rommel , Jr.,
Andrews & Kurth-TX
111 Congress, 17th Floor
Austin , TX 78701
512-320-9203

Basil A. Umari, Charles Yancey, David Griffith, Jennifer Gore, Paul Moak, Richard H. Caldwell, Robin Russell, David Zdunkewicz, John A. Lee, W. Scott Locher
Andrews & Kurth-TX
600 Travis Street
Suite 4200
Houston , TX 77002
713-220-4200

Charles E. Campbell and Nathan Garroway
McKenna Long & Aldridge-GA
303 Peachtree Street, N.E.
One Peachtree Center, Suite 5300
Atlanta , GA 30308-3201
404-527-4000

Counsel for The Southern Company

Gordon Lee Garrett , Jr., Janine C. Metcalf, David C. Kiernan and Ryan P. Reavis
Jones Day-Atlanta
1420 Peachtree Street, NE

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Suite 800
Atlanta , GA 30309-3053
404-521-3939

Gregory M. Gordon
Jones Day-Dallas
2727 North Harwood Street
Dallas , TX 75201
214-969-3759

Richard A. Chesley
Jones Day-Chicago
77 West Wacker Drive
Suite 3500
Chicago , IL 60601-1692
312-269-1525

Michael J. Bowers and Chris Annulewicz
Balch & Bingham LLP-Atlanta
Suite 700
30 Ivan Allen Jr. Boulevard, NW
Atlanta , GA 30308
404-261-6020

4. Acuity Brands, Inc. et al. v. Thomas & Betts Corp., 1:05-cv-228-BBM
This was a commercial dispute regarding representations which had been made to Acuity by Thomas & Betts when Acuity bought Thomas & Betts. I tried the case without a jury during February - March, 2007. The parties settled the case before I entered my findings of fact and conclusions of law.

Counsel for Acuity Brands, Inc. were:

Ronald Thomas Coleman , Jr., David B. Darden, Jodi Emmert Zysek, and Trishanda L. Treadwell
Parker Hudson Rainer & Dobbs
285 Peachtree Center Avenue, N.E.
1500 Marquis II Tower
Atlanta , GA 30303
404-523-5300

Counsel for Thomas & Betts were:

Harold Turner Daniel , Jr. and Kelli Smith Lott
Holland & Knight-Atlanta
1201 West Peachtree Street, N.E.
One Atlantic Center, Suite 2000

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Atlanta , GA 30309-3400
404-817-8500

Eric A. Robben, Jonathan E. Strouse, Karen Elaine Gossman, Richard R. Winter, Sarah E. Pace and
Holland & Knight, LLP-Chicago
30th Floor
131 South Dearborn Street
Chicago , IL 60603
312-263-3600

5. United States v Middlebrook, et al., 1:03-cr-431-BBM
This was the prosecution of five defendants for their role in a $2 million bank heist from the Wachovia money processing center. Some of the defendants pled guilty, but the remainder went to trial in March, 2004. All defendants were convicted.

Counsel for the government was Thomas Aloysius Devlin , Jr., who can be reached at 404-581-6000.

Counsel for Jonathan Remon Middlebrook was Cathy Morris Alterman, who can be reached at 404-688-8400.

Counsel for Darryl Dennard Shortt was Akil K. Secret, who can be reached at 404-241-8890.

Counsel for Larry Preston was Michael John Trost, who can be reached at 404-352-9300.

Counsel for Elester Middlebrook was R. Gary Spencer, who can be reached at 404-946-1830.

Counsel for Sal Mineo Simpson was Thomas C. Rowsey, who can be reached at 770-993-5317.

6. United States v. Knight, 1:02-cr-585-BBM
This was a multi-defendant drug case. A number of defendants pled guilty, and five went to trial in December, 2003. All defendants were convicted.

Counsel for the government were Robert C. McBurney, who can be reached at 404-581-6184, and Sandra Elizabeth Strippoli who can be reached at 404-581-6304.

Counsel for Ronald Knight were Jerome J. Froelich, who can be reached at 404-881-1111, and P. Bruce Kirwan, who can be reached at 404- 876-8111.

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Counsel for Byron Knight was W. Michael Maloof, who can be reached at 404-373-8000.

Counsel for Corey Lewis was Leonard Louis Franco, who can be reached at 404-875-1300.

Counsel for Gerald Thomas was Howard Jay Manchel, who can be reached at 404-522-1701.

Counsel for Henry Green was Dwight Lowell Thomas, who can be reached at 404-522-1400.

Counsel for Anthony Garza was Jose E. Chapa , Jr., who can be reached at 956-682-4308.

Counsel for Jose Hernandez Taurino was Bruce Harvey, who can be reached at 404-659-4628.

Counsel for Salomon Alvarez was Page Anthony Pate, who can be reached at 404-223-3310.

Counsel for Rudy Perez was Akil K. Secret, who can be reached at 404-241-8890.

Counsel for Kendell Ivory was Steven Howard Sadow, who can be reached at 404-577-1400.

Counsel for Timothy McClendon was George O. Lawson , Jr., who can be reached at 404-522-6964.

Counsel for Jose Garza was Stanley M. Baum, who can be reached at 404-262-6272.

7. United States v. Lewis Clay, 1:02-cr-380-BBM
This was a drug prosecution, which was not unusual except that it resulted in my imposing the only life sentence I have imposed during my time as a judge.

Counsel for the government was Jeff Brickman, who is now in private practice, and can be reached at 678-420-9300.

Counsel for Mr. Clay was Page Anthony Pate, who can be reached at 404-223-3310.

8. United States v. Charles Levon Smith, 1:01-cr-841-BBM
This was the prosecution of a number of convenience store robberies and a bank robbery. It is significant because I tried Mr. Smith three times - the first two trials

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ended in mistrials. At the third trial, Mr. Smith was convicted of the bank robbery.

Counsel for the government was William G. Traynor, who can be reached at 404-581-6294.

Counsel for Mr. Smith was Brian Mendelsohn, who can be reached at 404-688-7530.

9. Bogle, et al. v. McClure, et al., 1:00-cv-2071-BBM
This was a race discrimination case brought by seven librarians in the Atlanta library system against the City of Atlanta Public Library Board of Trustees. The case received a lot of press attention, and resulted in a very large monetary verdict against the members of the Library Board of Trustees, and in favor of plaintiffs.

The plaintiffs were represented by Michael J. Bowers and Christopher Scott Anulewicz, who can both be reached at 404-261-6020, and Kelly Jean Beard, who can be reached at 404-961-7233.

The defendants were represented at trial by June D. Green and Willie Jake Lovett, Jr. who can be reached at 404-730-7750.

10. Riverwood Int'l Corp. (k/n/a Graphic Packaging Int'l, Inc.) v. R. A. Jones & Co., 1:98-cv-2840-BBM
This was a patent case I inherited upon my arrival to the bench. This case was tried to a jury during July and August, 2001. The jury invalidated many of Riverwood's patents. The verdict was overturned by the Federal Circuit on account of a ruling I made regarding prior art.

Counsel for Riverwood at trial were Wellington M. Manning, Jr. and Tim F. Williams, who can be reached at 864-271-1592.

Counsel for R. A. Jones were Gregory F. Ahrens, who can be reached at 513-241-2324 and Jerry Blackstock, who is now deceased.

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

1. MC Asset Recovery, LLC v. The Southern Co., 1:06-cv-417-BBM
2006 WL 5112612 (12/11/06)
This action was brought on behalf of the creditors of Mirant Corporation, which was a wholly-owned subsidiary of Southern Company. M.C. Asset was appointed by the Bankruptcy Court to represent certain Mirant creditors. Mirant was

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incorporated to serve as a holding company for Southern Company's merchant energy business operations, and ultimately went bankrupt. M.C. Asset brought this action alleging that the transfers to Southern Company constituted fraudulent transfers. Plaintiffs allege fraudulent transfers in the amount of $2 billion. This case has been actively litigated for three years, and the parties recently notified me that they had resolved the case by settlement. I wrote a number of Orders in the case during its pendency. One of my rulings is reported at 2006 WL 5112612.

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2. Kish v. SunTrust Banks, Inc., 1:06-cv-968-BBM
Order on class certification (12/16/07) - docket no. 89
This was a consumer class action lawsuit brought against SunTrust Banks. The class asserted that SunTrust marketed and sold certificates of deposit representing that the interest rate paid on the CDs could bump up during the term of the CD, if market rates rose during that time. The class claimed that the representations made by SunTrust were illusory, and the system was set up such that the interest rate paid to consumers never bumped up. I certified the class, and the case ultimately settled.

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3. Weeks v. Harden Mfg. Corp. (11th Circuit sitting)
291 F.3d 1307 (11th Cir. 2002)

I was sitting by designation with the Eleventh Circuit, and was primarily responsible for writing this opinion. The plaintiff employee argued that his refusal to sign an employment contract containing a mandatory arbitration provision was statutorily protected activity, as required for a prima facie case of retaliation under Title VII or other employment statutes. The panel rejected the plaintiff's position.

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4. Buckley v. Haddock (11th Circuit sitting)
292 F. App'x 791 (11th Cir. 2008) (dissenting opinion)
Mr. Buckley brought this excessive force case against a Deputy Sheriff who tasered Mr. Buckley when he failed to follow orders after an arrest on a traffic violation. I was sitting by designation with the Eleventh Circuit, and each member of the three judge panel wrote a separate opinion. I wrote the dissenting opinion setting forth my conclusion that the Deputy's conduct constituted a Fourth Amendment violation and that the Deputy had fair notice that his conduct violated the Fourth Amendment.
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Attorney for Defendant-Appellant:

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5. United States v. Melo, (11th Cir. sitting); 259 F. App'x 248 (11th Cir. 2007)
I was sitting by designation with the Eleventh Circuit when I was assigned primary writing responsibility for this per curiam opinion. It was an appeal of the sentence imposed by the trial judge after a guilty plea by Mr. Melo. The panel found that the evidence in the record was not sufficient to support the sentence imposed, and remanded the case to the trial court for resentencing.

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6. United States v. Rodriguez (11th Circuit sitting)
259 F. App'x 270 (11th Cir. 2007)
I was sitting by designation with the Eleventh Circuit when I was assigned primary writing responsibility for this per curiam opinion. This was the second appeal of his conviction by Mr. Rodriguez, and the issues considered in this Order were limited to those from the pendency of the case on remand. The opinion addressed evidentiary rulings made by the trial judge, as well as a claim that certain delays earlier in the case were sufficient to constitute a due process violation. The panel upheld the conviction and sentence.
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7. United States v. Molina, 1:02-CR-586-19
Order re § 2255 petition (3/21/08) - doc. no. 1158
This was a federal habeas action brought by Ms. Molina, who learned after she had been tried and convicted of a drug conspiracy charge and a gun violation, that the government had offered her a plea deal prior to trial. The government did not dispute that a 5-year plea offer had been made to Ms. Molina's counsel. A hearing was held, during which the testimony revealed that in fact, the plea offer was not communicated to Ms. Molina perhaps not at all, but certainly not in Spanish, the only language she spoke. Thus, habeas relief was granted.

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8. Womack v. IRS (11th Circuit sitting)
510 F.3d 1295 (11th Cir. 2007)
I was sitting by designation with the Eleventh Circuit when I was assigned primary writing responsibility for this per curiam opinion. Both Chief Judge Edmondson and Judge Dubina contributed to the opinion, which addressed the tax treatment of lottery winnings. The panel held that such winnings should be treated as ordinary income, as opposed to a long term capital asset.

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9. Alderman v. Donald, 1:07-CV-1474-BBM
Order re prisoner civil rights (5/2/08) - doc. no. 148
Mr. Alderman was a Georgia death row inmate, who brought this action to challenge Georgia's lethal injection method of execution. The Supreme Court of the United States decided a similar case challenging Kentucky's lethal injection method of execution in Baze v. Rees, __U.S.__, 128 S. Ct. 1520 (2008) during the pendency of my case. Under Eleventh Circuit precedent, Mr. Alderman's complaint was time-barred.

Attorneys for Plaintiff:

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10. Tommy Hilfiger Licensing, Inc. v. Goody's Family Clothing, Inc., No. 00-cv-1934-BBM, 2003 WL 22331254 (5/9/03)
Tommy Hilfiger brought this action claiming that Goody's was selling counterfeit versions of its clothing. I conducted a bench trial in this matter, and concluded that the claims made by Hilfiger were supported by the evidence. A significant judgment was entered in favor of Hilfiger.

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e. Provide a list of all cases in which certiorari was requested or granted.

Because I sit in a trial court, I do not have reliable records regarding which of my cases go on from the Eleventh Circuit to request or receive Certiorari.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If

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any of the opinions listed were not officially reported, provide copies of the opinions.

United States v. Patrol Services, Inc., 1:98-cv-1348-BBM
The Eleventh Circuit reversed my award of attorneys fees to the relator's counsel in this case, finding that I had reduced the attorneys fees beyond what was legally permissible. The court remanded the case to me for reconsideration and recalculation of the award of attorneys fees. A copy of the Eleventh Circuit opinion is attached.

Riverwood Int'l Corp. (k/n/a Graphic Packaging Int'l, Inc.) v. R. A. Jones & Co., 1:98-cv-2840-BBM
After the trial of this patent case, the Federal Circuit reversed one of my rulings regarding prior art, and vacated the juror's verdict based on that ruling. Riverwood Int'l v. R.A. Jones & Co., 324 F.3d 1346 (Fed. Cir. 2003).

Rene Clinton v. City of Atlanta, 1:99-cv-338-BBM
I granted summary judgment to the City of Atlanta on Ms. Clinton's Americans with Disabilities Act claims, and the Eleventh Circuit reversed the ruling.

Thomas James Mahone v. Walter Ray, 1:99-cv-1001-BBM
I dismissed Mr. Mahone's claims against the Georgia Board of Pardons and Paroles and several of its members. The Eleventh Circuit reversed my ruling in part. Mahone v. Ray, 326 F.3d 1176 (11th Cir. 2003).

William Chavis v. Clayton County Sch. Sys., 1:99-cv-2843-BBM
Mr. Chavis brought this action against his employer, alleging that the school system retaliated against him because of his testimony at a hearing in a state magistrate court hearing about the conduct of one of his colleagues. I granted summary judgment to the school system, and the Eleventh Circuit reversed the judgment and remanded the case for trial. Chavis v. Clayton County Sch. Dist., 300 F.3d 1288 (11th Cir. 2002).

Gates v. Wetherington, 1:00-cv-581-BBM
I granted summary judgment in favor of the defendant prison guards in Mr. Gate's excessive force case. The Eleventh Circuit reversed, and remanded the case for trial.

Covad Commc'ns Co. v. Bellsouth Corp., 1:00-cv-3414-BBM
This case required an analysis of whether the Telecommunications Act of 1996 preempted antitrust claims brought pursuant to the Sherman Antitrust Act. I concluded that it did, and dismissed the anti-trust claims. On appeal, the Eleventh Circuit held that it did not, and reversed my ruling. See Covad Commc'ns Co. v. BellSouth Corp., 299 F.3d 1272 (11th Cir. 2002). At the time, there was a split among the Circuits on this question, and when the Supreme Court of the United States considered the question, it vacated the Eleventh Circuit's opinion. See,

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BellSouth Corp. v. Covad Commc'ns Co., 540 U.S. 1147 (2004). When the Eleventh Circuit considered the issue on remand, it revised its earlier opinion to agree with what I said in my original Order as to some claims, but not as to others. See Covad Commc'ns Co. v. BellSouth Corp., 374 F.3d 1044 (11th Cir. 2004).

United States v. Steven and Byron Pitts, 1:01-cr-733-BBM
The Pitts brothers appealed the sentence I imposed, arguing in part that I sentenced them at a time when the United States Sentencing Guidelines were deemed to be mandatory. Between the time that I sentenced the Pitts, and the time that the Eleventh Circuit considered their appeal, the Supreme Court of the United States decided United States v. Booker, 543 U.S. 220 (2005). Based on the Booker decision, the Eleventh Circuit remanded the case so that I could sentence the Pitts with knowledge that the sentencing guidelines were advisory, and not mandatory.

Loren F. v. Atlanta Indep. Sch. Sys., 1:01-cv-1532-BBM
Loren F.'s parents sued the Atlanta school system seeking reimbursement for the cost of sending him to private school. The parents alleged that the school system had failed to provide Loren F. with the special education services he was entitled to under the Individuals with Disabilities Education Act. I granted judgment to the school system as a matter of law. The Eleventh Circuit remanded the case for a bench trial. Loren F. ex rel. Fisher v. Atlanta Indep. Sch. Sys., 349 F.3d 1309 (11th Cir. 2003).

United States v. Carolyn Mitchell, 1:02-cr-393-BBM
The Eleventh Circuit remanded this case for resentencing, with direction to apply a one-level reduction in Ms. Mitchell's offense level. A copy of the unpublished Eleventh Circuit opinion is attached.

United States v. Henry Green, 1:02-cr-585-BBM-5
I imposed sentence upon Mr. Green at a time when the United States Sentencing Guidelines were deemed to be mandatory. After I sentenced him, and before the Eleventh Circuit addressed his appeal, the Supreme Court of the United States decided United States v. Booker, 543 U.S. 220 (2005). For that reason, the Eleventh Circuit remanded the case so that I could sentence Mr. Green based on an advisory guideline system.

United States v. Adan Miranda, 1:02-cr-586-BBM-4
The Eleventh Circuit reversed two of my rulings in this case. At the conclusion of his criminal trial, and after he had been convicted by the jury, I granted Mr. Miranda's Motion for a Judgment of Acquittal. The Eleventh Circuit found that there had been sufficient evidence to convict Mr. Miranda, and remanded the case for me to make a determination on Mr. Miranda's new trial motion. See United States v. Miranda, 425 F.3d 953 (11th Cir. 2005) Upon remand, I granted Mr. Miranda a new trial. The Eleventh Circuit reversed this decision as well, stating

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that Mr. Miranda's motion for a new trial had not been timely filed, and specifically reversing my finding of prosecutorial misconduct. United States v. Miranda, 220 F. App'x 965 (11th Cir. 2007).

United States v. Eliany Molina, 1:02-cr-586-BBM-19
After the jury convicted Ms. Molina, I granted her Motion for Judgment of Acquittal. The Eleventh Circuit reversed my ruling, and remanded the case for me to impose sentence upon Ms. Molina for the crimes of which she had been convicted. United States v. Molina, 443 F.3d 824 (11th Cir. 2006).

United States v. Jose Jaimes Cambray, 1:02-cr-586-BBM-2
I imposed sentence upon Mr. Cambray at a time when the United States Sentencing Guidelines were deemed to be mandatory. After I sentenced him, and before the Eleventh Circuit addressed his appeal, the Supreme Court of the United States decided United States v. Booker, 543 U.S. 220 (2005). For that reason, the Eleventh Circuit remanded the case so that I could sentence Mr. Cambray based on an advisory guideline system.

Parker v. Scrap Metal Processors, Inc., 1:02-cv-925-BBM
The Eleventh Circuit reversed two of my rulings in this case. After a substantial jury award, the defendants appealed and argued that I committed error in my charge to the jury. The charge I gave was provided by the plaintiff, and no one objected to it at the time I gave it. Nevertheless, the Eleventh Circuit held that I committed plain error in the jury charge, and remanded the case for retrial. See Parker v. Scrap Metal Processors, Inc., 386 F.3d 993 (11th Cir. 2004). On remand, I realized that only state law claims remained, and I remanded the case to state court for lack of federal jurisdiction. The Eleventh Circuit held that I abused my discretion in not exercising supplemental jurisdiction. Parker v. Scrap Metal Processors, Inc., 468 F.3d 733 (11th Cir. 2006).

Chep USA v. Mock Pallet Co., 1:02-cv-2053-BBM
After a jury trial in which the defendant received an award against the plaintiff, and the plaintiff recovered nothing, the Eleventh Circuit reversed a number of my rulings, and affirmed others. Chep USA v. Mock Pallet Co., 138 F. App'x 229 (11th Cir. 2005)

Williams v. Chatman, 1:02-cv-3362-BBM
This was the federal habeas action brought by Wayne Williams, who had been convicted in Atlanta's highly publicized child murders during the 1980's. I did not grant federal habeas relief to Mr. Williams, and the Eleventh Circuit did not disturb this outcome. However, on appeal, the Eleventh Circuit found that I did not have jurisdiction to address some of the issues I ruled on, and I did have jurisdiction to rule on some of the issues I failed to address. Williams v. Chatman, 510 F.3d 1290 (11th Cir. 2007).

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United States v. Middlebrooks, 1:03-cr-431-BBM
The Eleventh Circuit remanded this case for resentencing of two defendants after the Supreme Court decided United States v. Booker, 543 U.S. 220 (2005). I first sentenced these defendants prior to the Booker decision, and pursuant to what was deemed a mandatory guideline system. The Eleventh Circuit also found that I abused my discretion in making an evidentiary ruling, but found that the error was harmless. United States v. Middlebrooks, 141 F. App'x 834 (11th Cir. 2005).

United States v. Kirk Burns, 1:03-cr-506-BBM
The Eleventh Circuit remanded this case for resentencing in light of United States v. Davidson, 360 F.3d 1374 (11th Cir. 2004). The Circuit opinion is attached.

Ajaka v. Brooksamerica Mortgage Corp., 1:03-cv-977-BBM
I held that Mr. Ajaia was estopped from asserting certain claims under the Truth in Lending Act because he had failed to report his law suit on those claims in the schedules to his bankruptcy proceeding. My opinion is published at 2005 WL 6075374. The Eleventh Circuit reversed. See Ajaia v. Brooksamerica Mortgage Corp., 453 F.3d 1339 (11th Cir. 2006).

Hashemi v. Rutledge, 1:03-cv-2370-BBM
I granted summary judgment to two Deputy Sheriffs in this case asserting excessive force claims against them, and the Eleventh Circuit reversed the judgment. A copy of the Eleventh Circuit opinion is attached.

United States v. Hoang Nguyen, 1:04-cr-232-BBM
The Eleventh Circuit remanded this case with direction that I correct a clerical error in Mr. Nguyen's Judgment and Commitment Order. United States v. Hoang Nguyen, 2008 WL 4291613 (11th Cir. Sept. 19, 2008).

United States v. Michael Diaz, 1:04-cr-251-BBM
I ruled that Mr. Diaz requested to proceed with his trial without a jury. The Eleventh Circuit felt that the record demonstrated otherwise, and remanded the case for retrial with a jury. United States v. Diaz, 540 F.3d 1316 (11th Cir. 2008).

Levine v. World Financial, et al., 1:04-cv-1283-BBM
I granted a motion to dismiss the plaintiff's complaint for failure to state a claim on his Fair Credit Reporting Act claim. The Eleventh Circuit concluded that he had stated such a claim, and remanded the case in order that it could proceed to discovery. Levine v. World Fin. Network Nat'l Bank, 437 F.3d 1118 (11th Cir. 2006).

Eduardo Diaz v. Marcus Moseley, M.D., 1:04-cv-3056-BBM
I granted a Motion to Dismiss filed by the defendants who were prison doctors. The Eleventh Circuit reversed the Judgment stating that the record was not sufficiently developed to permit appellate review. A copy of the Eleventh Circuit opinion is attached.

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United States v. Campos-Diaz, 1:05-cr-241-BBM
The Eleventh Circuit did not disturb the substance of any rulings I made, but remanded the case for correction of a clerical error in the Judgment and Commitment Order. United States v. Campos-Diaz, 472 F.3d 1278 (11th Cir. 2006).

United States v. Ledbetter, 1:05-cr-409-BBM
The Eleventh Circuit remanded the case for resentencing, stating that the government had breached its plea agreement with Mr. Ledbetter at sentencing. A copy of the Eleventh Circuit opinion is attached.

Hawes v. Howerton, 1:05-cv-683-BBM
The Eleventh Circuit remanded this case to me twice. First, the court held that I entered an Order granting Mr. Hawes's Motion for Reconsideration when I did not have jurisdiction to do so, and remanded the case for me to vacate my Order. A copy of the Eleventh Circuit's opinion dated September 28, 2006 on this issue is attached. Thereafter, I granted the Warden's Motion to Dismiss Mr. Hawes's habeas petition because it was barred as a second or successive petition, or alternatively because it was time barred. The Eleventh Circuit remanded the case again stating that the record in the case was insufficient to establish whether Mr. Hawes's petition was successive. This opinion was dated December 27, 2007, and it is attached as well.

Skop v. City of Atlanta, 1:05-cv-1754-BBM
I granted summary judgment to the police officer in this case based on qualified immunity. The Eleventh Circuit concluded that the officer had committed a Fourth Amendment violation which was well established, and remanded the case for trial. Skop v. City of Atlanta, 485 F.3d 1130 (11th Cir. 2007).

United States v. Holmes, 1:06-cr-109-BBM
I denied a Motion to Suppress the search of Mr. Holmes's residence. On appeal, the Eleventh Circuit found that I had failed to consider one of the necessary factors in my evaluation of the search, and remanded the case for reconsideration. United States v. Holmes, 270 F. App'x 767 (11th Cir. 2008).

Mortgage Elec. Registration Sys. v. Booker, 1:06-cv-166-BBM
I denied Ms. Booker's Motion to Appeal *In Forma Pauperis*, and the Eleventh Circuit remanded with instruction to vacate the Order denying appeal, insofar as I had been without jurisdiction to issue it. A copy of the Opinion is attached. [Doc. No. 21]

United States v. Abdul L. Holyfield, 1:06-cr-175-BBM
Mr. Holyfield was charged with numerous counts of bank fraud and aggravated identity theft. The jury convicted him of seven of those counts. The Eleventh Circuit found that I admitted hearsay evidence into the trial, and reversed Mr. Holyfield's conviction on two of the seven counts for that reason. Mr. Holyfield's

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case was remanded for resentencing for that reason. United States v. Thomas, et al., 2009 WL 449184 (11th Cir. Feb. 24, 2009).

United States v. Smith, 1:06-cr-376-BBM
In a lengthy opinion, the Eleventh Circuit upheld Mr. Smith's conviction and the term of the sentence I imposed. However, the court held that I did not properly provide for Mr. Smith to serve his sentence concurrently with a state sentence imposed for the same conduct which was the subject of his federal conviction. Thus, the case was remanded with direction that I sentence Mr. Smith to the same term as the original sentence, but with express direction that it run concurrently with the state sentence. United States v. Smith, 2009 WL 567243 (11th Cir. Mar. 6, 2009).

United States v. Talbin D. Andrews, 1:07-cr-15-BBM
The Eleventh Circuit remanded this case for a correction of a clerical error in the Judgment & Commitment Order. A copy of the Opinion is attached.

Morgan v. Pac. Specialty Ins. Co., 1:07-cv-502-BBM
I granted summary judgment to the defendant insurance company. The Eleventh Circuit found that there were issues of fact to be decided by the jury, and reversed the judgment. A copy of the Eleventh Circuit opinion is attached [114].

Nicholson v. Shafe, 1:07-cv-2724-BBM
I granted the Defendant's Motion to Dismiss and awarded attorneys fees against the plaintiff. The Eleventh Circuit ruled that I committed error in dismissing the case. Nicholson v. Shafe, 558 F.3d 1266 (11th Cir. 2009).

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

I place all of my decisions on our court's CM/ECF system. This means that any decision I write is available to the public on the PACER system. I rarely designate whether a particular opinion of mine should be published or not published.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

United States v. Farley, 1:07-CR-0196-BBM
The defendant filed a motion asserting that a portion of 18 U.S.C. § 2241(c) was unconstitutional as applied to him. I agreed, and a copy of my order is attached.

The Lamar Co. v. City of Marietta, 1:07-cv-764-BBM
This was a First Amendment challenge to the City of Marietta's sign ordinance. I concluded that the ordinance did not impose sufficient time limits within which

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local officials were required to make a decision regarding a sign permit application. A copy of my order dated February 25, 2008 is attached.

Lamar Advertising Co. v. City of Douglasville, 1:02-cv-1554
Plaintiff challenged the City of Douglasville's sign ordinance as an as an unconstitutional restriction on the freedom of speech. I concluded that five provisions of the ordinance were unconstitutional prior restraints on speech under the First Amendment. 254 F.Supp.2d 1321 (N.D. Ga. 2003).

Marlyn Tillman v. Gwinnett County Sch. Sys., 1:04-cv-1180
This lawsuit asserted that the dress code for the Gwinnett County school system violated the First Amendment rights of Ms. Tillman's son, who was a student. I concluded that one of the dress codes at issue was void for vagueness, and granted certain declaratory relief to Ms. Tillman. This case was ultimately settled by the parties. A copy of my Order, dated November 23, 2005 is attached. Ms. Tillman filed a Motion for Reconsideration of the November 23, 2005 Order, which I granted in part. A copy of that Order, dated July 27, 2006, is attached as well.

Zibtluda, LLC v. Gwinnett County, 1:01-cv-1416-BBM
This action was brought as a First Amendment challenge to Gwinnett County, Georgia's adult entertainment ordinance. I entered a preliminary injunction prohibiting the county from enforcing the ordinance against the plaintiff. I held that the ordinance failed to set a definite time period within which county officials had to approve or deny an application for a license, thus constituting an unconstitutional prior restraint on speech. Gwinnett County quickly enacted a new ordinance which did meet constitutional requirements and I upheld the new ordinance. The Eleventh Circuit dismissed the appeal of my injunction Order as moot in light of the newly enacted ordinance, and affirmed my opinion upholding the new ordinance. A copy of my decision dated September 16, 2003 is attached.

Jack Alderman v. James Donald, 1:07-cv-147-BBM.
A Georgia death row inmate filed a § 1983 claim challenging Georgia's three-drug lethal injection method as unconstitutional. I denied Plaintiff's motion for summary judgment, and granted defendants' motion, thus dismissing the inmate's complaint because his claim was time-barred and the lethal injection protocol was substantially similar to that of Kentucky, which had been upheld by the Supreme Court in Baze v . Rees, 128 S.Ct. 1520, 170 L.Ed.2d 420 (2008) (plurality opinion). The Eleventh Circuit affirmed the dismissal.

Florida Association of Professional Lobbyists, Inc. v. Div. of Legislative Info Services, 525 F.3d 1073 (11th Cir. 2008). A state association of lobbyists attacking the constitutionality of a Florida statute that would have regulated legislative and executive lobbying in the State of Florida. Sitting by designation on the Eleventh Circuit, I wrote for the panel's opinion, which affirmed the District Court's decision to uphold the Act on First Amendment grounds. The

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panel certified three questions to the Florida Supreme Court because they presented novel questions of Florida constitutional law.

Kidd v. Cox, 1:06-cv-997
I sat on a three-judge panel which considered a constitutional challenge to Georgia Senate Bill 386. SB386 redistricted Georgia Senate Districts 46, 47 and 49, changing voting districts in Athens - Clarke County, Georgia and adjacent counties. The panel concluded that the plaintiffs failed to (1) carry their burden of showing that the redistricting plan was unrelated to legitimate redistricting criterion; (2) articulate manageable or politically-neutral standards that would make an equal protection political gerrymandering claim justiciable; or (3) demonstrate that the redistricting plan violated rights protected under the First Amendment. 2006 WL 1341302 (N.D. Ga., May 16, 2006)

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have been designated to sit with the Eleventh Circuit on two occasions—once during 2002, and once in October, 2007. I authored some opinions, and wrote or otherwise participated in other *per curiam* opinions. The following is a list of those opinions:

Weeks v. Harden Mfg. Corp., 291 F.3d 1307 (11th Cir. 2002)
This case was brought by an employee asserting that his refusal to agree to a compulsory arbitration provision constituted protected activity for purposes of establishing a prima facie case of retaliation. Our panel held that it did not. I authored this opinion, and Judge Ed Carnes contributed to it as well.

Womack v. Comm'r, 510 F.3d 1295 (11th Cir. 2007)
This opinion addressed the tax treatment of lottery winnings, holding that such winnings should be treated as ordinary income, as opposed to a long term capital asset. I authored this opinion with input from Chief Judge Edmondson and Judge Dubina.

Florida Ass'n of Prof'l Lobbyists, Inc. v. Div. of Legislative Info. Servs., 525 F.3d 1073 (11th Cir. 2008)
This per curiam opinion addressed a Constitutional challenge to a Florida statute which limited expenditures made by lobbyists, and set reporting requirements for lobbyists. The panel certified a question about the Florida Constitution to the Supreme Court of Florida. I was not primarily responsible for writing this opinion.

Canon Latin Am., Inc. v. Lantech (CR), S.A., 508 F.3d 597 (11th Cir. 2007)
This per curiam opinion vacated an injunction against a Cost Rican corporation

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which had been imposed by a lower court, and enjoined a legal action brought in Costa Rica. I did not have primary writing responsibility for this opinion.

Buckley v. Haddock, 292 F. App'x 791 (11th Cir. 2008)
This opinion addressed an excessive force claim. An opinion was written by each member of the 3-judge panel. I filed a dissenting opinion setting forth my analysis which would have resulted in a jury trial for the plaintiff.

United States v. Rodriguez, 259 F. App'x 270 (11th Cir. 2007)
This was a criminal appeal. I was primarily responsible for writing this opinion.

United States v. Melo, 259 F. App'x 248 (11th Cir. 2007).
This criminal appeal challenged Mr. Melo's sentence. I was primarily responsible for writing this opinion.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

Our court has a conflicts screening system. I am automatically recused, for example, from any case in which my husband's law firm is counsel. I have provided a list of any securities owned by my husband or by me, and the screening system automatically blocks any case involving those companies from being assigned to me. Because cases involving my husband's law firm and companies in which we own stock are never assigned to me, the issue of recusal never comes up. Nevertheless, I review the Certificates of Interested Persons called for by the Rules of our court to be sure they don't indicate any other type of conflict.

Prior to the time our court got the conflicts screening software, I entered an Order in each case in which I had a conflict. My conflicts were always a result of either the involvement of my husband's law firm, or ownership of stock in one of the parties by my husband or me. I have attached a list of every case in which I entered an Order of recusal. The two cases I next describe were unusual, and I believe require further explanation.

Prior to the time our court got the conflicts software, I relied on the parties to file the Certificate of Interested Parties called for by our rules, in order to determine whether I had a conflict. In the case of In re Mirant Securities, 1:02-cv-1467, the parties failed to file a Certificate of Interested Persons, and I issued some Orders in the case before I realized that I owned stock in more than one company named as a defendant in the case.

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I held a hearing with counsel to explain what I had done, and recused myself sua sponte, from the case by Order dated September 19, 2003.

I recused myself in a products liability case after handling it for some time. I realized that the son-in-law of the plaintiff was a friend, business associate and banker with whom my husband had a long term relationship. The son-in-law knew that the case was assigned to me, and he also knew I was married to his friend. He mentioned the case to my husband a couple of times. During the pendency of the case, we were moving, and my husband was shopping for a mortgage. Without thinking about my case, my husband ended up in discussions with my plaintiff's son-in-law about obtaining our loan. I felt this could create an appearance of impropriety, and recused myself sua sponte, without explanation. We did not ultimately get our loan with this banker. The case was Leathers v. Pfizer, Inc. 1:04-cv-615-BBM.

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

   I have had two *pro se* litigants sought to have me disqualified from their cases. The first is Walter Aycock, who sought to have me removed in two cases: Aycock v. City of Atlanta, 1:01-cv-88-BBM and Aycock v. Calk,1:02-cv-736-BBM. I declined to recuse myself because Mr. Aycock's complaints about me related to rulings I had made in his case. The second *pro se* litigant who has sought my recusal is Jessie Ray Cox, has done so in two cases: 1:08-cv-1456 and 1:08-cv-3238. I declined to recuse myself in this case as well, because Mr. Cox's assertions of bias on my part related to rulings I had made in his cases.

b. a brief description of the asserted conflict of interest or other ground for recusal;

   Mr. Aycock sought to have me removed from his cases because he felt I was biased in favor of the defendants, and did not give proper consideration to his exhibits. Mr. Cox asserted that my rulings indicated biased against all poor people of color.

c. the procedure you followed in determining whether or not to recuse yourself;

   In the Aycock and Cox cases, I declined to recuse myself based on the precedent in this Circuit, which provides that adverse rulings do not constitute a legal basis for recusal.

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

   After I realized my conflict belatedly in the Mirant case, I sold all of my equities, and invested the money in mutual funds to avoid similar problems in the future.

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15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

I served as Assistant Attorney General for the State of Georgia from December 1984 - May 1994. I was hired for that position by then-Attorney General Mike Bowers.

I served as United States Attorney in the Middle District of Georgia from 1997 to 2000. I became the acting United States Attorney on November 2, 1997. After Senate confirmation, I was appointed United States Attorney by President Clinton on March 2, 1998.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

When I graduated from college, I worked for several months (June - November, 1976) as a volunteer for the father of a friend of mine who was running for U.S. Congress (Billy Adams Campaign for Congress.) I generally did office work.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I did not serve as a law clerk to a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I have not practiced alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

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1994 – 2000
Office of the United States Attorney
300 Mulberry Street
Macon, GA 31201
United States Attorney (1998-2000)
Acting United States Attorney (1997-1998)
Assistant United States Attorney (1994-1997)

1984 – 1994
Office of the Attorney General of Georgia
40 Capitol Square
Atlanta, GA 30334
Senior Assistant Attorney General

1981 – 1984
Martin & Snow
240 Third Street
Macon, GA 31201
Attorney

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator in alternative dispute resolution proceedings.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

As an associate at Martin & Snow, I did ERISA work, represented creditors in bankruptcy proceedings, and sometimes represented indigent criminal defendants in state court.

From 1984-1991, while working as an Assistant Attorney General I represented the state in personal injury and property damage cases throughout Georgia. I did some employment litigation as well as some appellate work. I was given a supervisory position in 1991. In this position I supervised the work of other lawyers and the nature of my practice changed. I represented licensing boards in prosecuting health care professionals for matters affecting their licensure, and I also represented Georgia state court judges when they got sued.

From May, 1994-November, 1997 I prosecuted crimes charged by the

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Office of the U.S. Attorney for the Middle District of Georgia. I handled all aspects of my cases including the grand jury investigation, pretrial hearings, negotiating guilty pleas, trials and sentencing. I served as United States Attorney in the Middle District of Georgia from 1997 to 2000. I became the acting United States Attorney on November 2, 1997. After Senate confirmation, I was appointed United States Attorney by President Clinton on March 2, 1998. This was an office with approximately 60 employees. I worked with state, local and federal officials in the 70 county area in my district. I worked for the development of "Weed and Seed" sites in Albany, Athens, Macon and Valdosta. I served on the Attorney General's Advisory Council and as chair of the Executive Council for the Organized Crime Drug Enforcement Task Force for the Southeast Region.

Since August, 2000 I have served as a United States District Judge in Atlanta, Georgia. I preside over civil and criminal cases filed in my court, and issue written Orders on motions filed by the parties.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

At Martin & Snow, my typical client was a bank or small business needing to have a claim filed in bankruptcy court, or requiring a profit sharing or retirement plan. During the time I was an Assistant Attorney General, my clients were state agencies and state employees. During the time I was a federal prosecutor, I worked with federal agencies to prosecute those who violated federal criminal statutes.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

Since 1994, my practice has been exclusively litigation in federal court. As U.S. Attorney all of my practice was criminal. Before 1994, more than 90% of my practice was civil and in state court or administrative agencies.

i. Indicate the percentage of your practice in:
   1. federal courts: 60%
   2. state courts of record: 35%
   3. other courts:
   4. administrative agencies: 5%

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 60%
   2. criminal proceedings: 40%

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d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

During my years as a lawyer, I remember trying twelve cases— seven as sole counsel, two as lead, and three as second chair.

i. What percentage of these trials were:
   1. jury: 67%
   2. non-jury: 33%

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

1. United States v. Major, et al., 5:94-cr-44-WDO (M.D. Ga.)
This was the prosecution of a drug conspiracy indicted in August, 1994 and tried in October, 1996. I tried the case with Assistant United States Attorney Charles Calhoun, who can be reached at 478-752-3511. The judge was the Honorable Wilbur Owens. Two of the defendants were represented by Mr. Frank Hogue, who can be reached at 478-750-8040 and Ms. Sandra Popson, who can be reached at 478-742-6481.

2. United States v. Dean, 3:95-cr-1-DF (M.D. Ga.)
This was a drug prosecution with five defendants. All defendants pled guilty during 1995. The judge was the Honorable Duross Fitzpatrick. Some of the

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defendants were represented by Sandra Popson at 478-742-6481, Mr. Alan Wheeler at 478-742-7488 and Mr. Doye Green at 478-743-9517.

3. United States v. Graves, 5:95-cr-05-WDO (M.D. Ga.)
This was the prosecution of Mr. Graves for a firearms offense. The evidence was that Mr. Graves, who was a 3-time convicted felon used a firearm to facilitate the rape of a 14 year old girl. He was convicted by a jury in 1997, and sentenced to a term of life in prison.

I tried this case with Jessica Hagen, who can be reached at 404-572-4702. The judge was the Honorable Wilbur Owens. Opposing counsel was Robert Faulker, who no longer appears in the Georgia Bar directory as a practicing lawyer.

4. United States v. Pope, 5:95-cr-38-DF (M.D. Ga.)
I prosecuted Mr. Pope for possessing a firearm as a 3-time convicted felon. The case was tried in March, 1996. The judge was the Honorable Duross Fitzpatrick, and opposing counsel was Hale Almand, Jr. who can be reached at 404-746-2237.

5. United States v. Taylor, 5:93-cr-21-WDO (M.D. Ga.)
I prosecuted this counterfeit case. Mr. Taylor pled guilty and was sentenced in 1995. The judge was the Honorable Wilbur Owens, and opposing counsel was Floyd Buford, who can be reached at 478-742-3605.

6. In re: E.I. Dupont de Nemours & Co., 4:95-cv-36-HL (M.D. Ga.)
This was a case referred to me as United States Attorney for a contempt investigation regarding discovery violations committed by E.I. Dupont and its counsel. I did some fairly extensive work on the case. The trial judge, Hugh Lawson, ultimately imposed civil fines on Dupont and on its counsel. The lawyers involved in the case were Neal Pope who can be reached at 706- 324-0050, Richard Gill, who can be reached at 334-834-1180, Stephen Clay who can be reached at 404-815-6514, John Chandler, who can be reached at 404-572-4646, William Boice who can be reached at 404-815-6464 and John Fleming at 404-853-8000.

7. Price v. Ga. Dep't of Transp., 182 Ga. App. 353 (1987)
Price v. Ga. Dep't of Transp., 257 Ga. 535 (1987)
This case raised questions regarding protection of state employees by the state's sovereign immunity, and was litigated in both the Georgia Court of Appeals and Georgia Supreme Court. The trial judge was Rosser Malone, in the State Court of Dougherty County. Opposing counsel was Mr. Terry Marlowe, who can be reached at 229-878-6500.

8. Ga. Dep't of Transp. v. Bonnett, 257 Ga. 189 (1987)
This was a condemnation case raising legal questions which ultimately required a ruling from the Georgia Supreme Court. The trial judge was Judge John Crosby

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in the Superior Court of Tift County, Georgia. Opposing counsel was Hugh Gordon, who can be reached at 229-386-8004.

9. Miller v. Med. Ass'n of Ga., 262 Ga. 605 (1992)
This case litigated the constitutionality of a statute which was addressed by the Georgia Supreme Court. My co-counsel was Julia Anderson, now at 404-463-3630. Opposing counsel included Demetrius Mazacoufa at 404-897-1000, and Everett Gee at 434-736-3630.

10. In the Matter of Franklin Thomas McElwaney, 40 B.R. 66 (1984)
This was a fight between the Bankruptcy Trustee and the Federal Land Bank of Columbia over the assets of Mr. McElwaney. The judge was the Honorable Robert F. Hershner, Jr.. Opposing counsel were Ms. Lillian Lockery at 478-742-6145, and Mr. Thomas Talbot at 478-745-0885.

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

During the time I served as United States Attorney, the Justice Department had a program available to communities called "Weed & Seed." The idea was to bring communities together to weed out crime, and seed in opportunities. The Middle District of Georgia had none of these programs, but from 1997 to 2000, we started programs in Macon, Athens, Valdosta and Albany. One of the greatest things about it was that we developed partnerships with military installations in each of those cities to have summer camps with children from the Weed & Seed neighborhoods. Law enforcement officers and/or military personnel served as counselors for these camps. I felt we were able to expose these children to opportunities they might not otherwise have known about. It was a wonderful experience.

During the time I was at the Attorney General's office, I worked on an investigation into the lending practices of Fleet Finance Company. Fleet had a large number of loans in Georgia, which raised claims of usurious lending practices and fraudulent home repair schemes. The investigation resulted in a settlement with Fleet, by which it created a multimillion dollar loan pool for the benefit of the victims to be administered by the State of Georgia.

I have never performed lobbying activities for any client.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe

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briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have taught no courses. I have occasionally spoken at Continuing Legal Educations seminars for Georgia lawyers. Those occasions are set out above in response to 12d.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

    I deferred a portion of my compensation into a retirement account while I was employed with the State of Georgia and have continued to do so as an employee of the United States. I recently rolled-over my state deferred compensation account into my IRA. I have no arrangement or expectation of any future payments for any previous business or financial relationship or work done.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    I have no plans, commitments or agreements to pursue outside employment during my service with the court.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report.

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

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Our court has a conflicts screening system. I am automatically recused, for example, from any case in which my husband's law firm is counsel. I have provided a list of any securities owned by my husband or by me, and the screening system automatically blocks any case involving those companies from being assigned to me. Because cases involving my husband's law firm and companies in which we own stock are never assigned to me, the issue of recusal never comes up. Nevertheless, I review the Certificates of Interested Persons called for by the Rules of our court to be sure they don't indicate any other type of conflict.

b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

I will not sit in cases in which my husband's law firm appears as counsel, so long as he continues to be a partner in that firm. In all circumstances, I will follow the Code of Conduct for United States Judges and all applicable statutes, policies and procedures related to avoiding or resolving actual or potential conflicts.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

As a judge, federal prosecutor and assistant attorney general, there have been prohibitions on my representation of indigent clients. However, I currently serve on the Board of the Georgia Women of Achievement, which honors women in Georgia history. This Board emphasizes working with schools to expose young people to the accomplishments of these historic Georgia women.

While in Macon, Georgia, I served on the Board of Directors for a Community College Foundation, the purpose of which was to reach out to people who might otherwise not be able to pursue an education. Through my membership in the Career Women's Network, also in Macon, I worked on the scholarship committee. I spent time establishing an interview process, interviewing candidates, and awarding the scholarships. I also did work with the "Christmas in April" program and Habitat for Humanity while I was in Macon, both of which sought to improve housing for the needy.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or

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communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

On April 14, 2009, I received a call from Cassandra Butts of the White House counsel's office asking if I would fill out the application forms for this position. I was not interviewed by a committee. I had a telephone interview with staff from the Justice Department on Monday, April 21, 2009. Since that date I have had conversations with staff from the Justice Department, about the nomination paperwork and an interview appointment. On May 21, 2009, I met with Mr. Tom Perrelli, the Associate Attorney General as well as staff from the Department of Justice and from the White House Counsel's office for an interview. On June 15, 2009, I had a telephone conversation with Ms. Butts regarding the nomination process. My nomination was submitted to the United States Senate on June 19, 2009.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No one involved in the process has sought an implied assurance from me about how I would rule on any issue, case or question that might come before me as a judge on the court where I currently serve, or any other court.

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AFFIDAVIT

I, Brady B. Martin, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

JUNE 19, 2009
(DATE)

Brady B. Martin
(NAME)

Anne Marie Carver
(NOTARY)

ANNE MARIE CARVER
MY COMMISSION EXPIRES
NOV. 7, 2011
COBB CO., GEORGIA
NOTARY PUBLIC

STATEMENT OF JEFFREY L. VIKEN, NOMINEE TO BE UNITED STATES DISTRICT JUDGE FOR THE DISTRICT OF SOUTH DAKOTA

Mr. VIKEN. Good morning, Mr. Chairman. Just a word of thanks, Mr. Chairman, to you and Senator Sessions, Senator Hatch, Senator Franken, the members of the Committee, for your investment of time and your deliberative energy in the process of considering the confirmation of myself to serve on the Federal bench.

I, of course, greatly appreciate Senator Tim Johnson being present for the introduction and for President Obama's confidence in the nomination, and I am sure Beverly shares that thought with me, as well.

We are honored to be here and honored to have an opportunity to be considered for this form of public service. Thank you, sir.

Chairman LEAHY. Thank you very much. Mr. Kappos.

[The biographical information of Jeffrey L. Viken follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Jeffrey Lynn Viken

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the District of South Dakota

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Federal Public Defender
   703 Main Street, 2nd Floor
   Rapid City, SD 57701

4. **Birthplace**: State year and place of birth.

   1952; Huron, South Dakota

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1974 to 1977, University of South Dakota School of Law; Juris Doctor, May 1977

   1970 to 1974, University of South Dakota; Bachelor of Arts, May 1974

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

   Employment:

   2003 to present:
   Administrative Office of the United States Courts
   Office of the Federal Public Defender

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703 Main Street, 2nd Floor
Rapid City, SD 57701
I was appointed Federal Public Defender for the District of South Dakota by the United States Court of Appeals for the 8th Circuit in 2003. In 2005, the Court of Appeals appointed me the Federal Public Defender for the District of North Dakota to lead a combined-district organization for both North Dakota and South Dakota.

1992 to 2003:
Viken, Viken, Pechota, Leach & Dewell, LLP
1617 Sheridan Lake Road
Rapid City, SD 57702
I was a partner in this law firm.

1992 to 2003:
Lawyers for the People, Inc.
1617 Sheridan Lake Road
Rapid City, SD 57702
I was the Vice President of the Board of Directors of this corporation which owned and managed my law firm's interest in the office park and building which housed Viken, Viken, Pechota, Leach & Dewell, LLP.

1981 to 1992:
Finch, Viken, Viken & Pechota
304 Main Street
Rapid City, SD 57701
I was a partner in this law firm.

1981 to 1982:
Finch, Viken & Viken
304 Main Street
Rapid City, SD 57701
I was a partner in this law firm.

1977 to 1981:
United States Department of Justice
Office of the United States Attorney for the District of South Dakota
515 9th Street
Rapid City, SD 57701
I was an Assistant United States Attorney following graduation from law school in 1977. I served as First Assistant United States Attorney and, in 1981, as Acting United States Attorney for the District of South Dakota.

1975 to 1976
Legislative Research Council
Intern

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1975
Pennington County State's Attorney
Intern

Other Affiliations:

2001 to 2003
Red Cloud Indian School, Inc.
100 Mission Drive
Pine Ridge, SD 57770
Volunteer member of the Board of Directors

2001 to 2003
Wildlife Experiences, Inc.
P.O. Box 9663
Rapid City, SD 57709
Volunteer member of the Board of Directors

1989 to 2000
Museum Alliance of Rapid City, Inc., d/b/a The Journey Museum
222 New York Street
Rapid City, SD 57701
I was a volunteer member of the Board of Directors, Secretary/Treasurer, and Vice President of this nonprofit corporation.

1984 to 1986
Rapid City Arts Council
Board of Directors; I served on the Exhibit Committee for many years.

1982 to 1984
William Edward Recovery Center
Board of Directors

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I did not serve in the military. I registered for the selective service upon turning age 18.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

During my undergraduate studies at the University of South Dakota 1970 to 1974, I was selected to participate in the Honors Program, was inducted into Phi Beta Kappa, and

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earned a Bachelor of Arts Degree Magna Cum Laude with the designation University Scholar.

During my studies at the University of South Dakota School of Law 1974 to 1977, my moot court team won several "best brief" awards in regional competition, I received "best speaker" recognitions, and our three person team was selected to participate in the National Moot Court Competition in New York City in 1975.

The Martindale-Hubbell Law Directory has listed me as an AV rated attorney since 1996, the highest ranking for an attorney's legal ability and ethical standards in this national peer review system.

I have been selected as a Great Plains Super Lawyer in the practice of criminal defense in the biannual ratings for 2007 and 2009 by the publication *Minnesota Law and Politics*.

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

State Bar of South Dakota: I have been a member in good standing of the State Bar since graduation from law school in 1977. I have served on the following State Bar committees: Indian Law Committee; Model Rules of Professional Conduct Committee; Public Relations Committee; South Dakota Supreme Court/State Bar Committee on TV Cameras in the Courtroom; and the Criminal Law Committee.
South Dakota Trial Lawyers Association (SDTLA): I have been a member of SDTLA since 1977. I served two terms as an elected member of the Board of Governors and served on the Legislative Recruitment Committee and the Legislation and Public Affairs Committee. I was a member of the Association of Trial Lawyers of America from 1977 until 2003.

Defender Services Advisory Group (DSAG): I was elected by my Federal Defender colleagues to represent the 6th, 7th and 8th Circuits on this advisory group which serves as a consultative body for the Office of Defender Services, Administrative Office of the United States Courts. I was first elected to DSAG in 2005 and in 2008 was elected to chair DSAG beginning in 2009. I resigned my DSAG position effective April 1, 2009, following my recommendation for appointment to the federal bench.

Member, Federal Practice Committee for the United States District Court for the District of South Dakota, 2003 to present.

Ex Officio Member, Federal Practice Committee for the United States District Court for the District of North Dakota, 2005 to present.

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Chair, Merit Selection Panel, appointed by the United States District Court for performance review of the incumbent United States Magistrate Judge for the District of South Dakota, Western Division, 2000; Merit Selection Panel Member, 2004 and 2006. Pennington County Bar Association: I have been a member of our local county bar association since 1977. I was elected to serve as its Secretary/Treasurer in 1991, Vice-President in 1992, and President in 1993.

Black Hills Legal Services, Inc.: I served on the Board of Directors of this legal services organization beginning in 1987 and chaired the Board from 1988 to 1992.

Black Hills Criminal Defense Bar Association: I have been a member of this local bar group since 1985. I was elected Vice-President in 1985, 1986 and 1987. I served as President in 1988.

1985 to 2003; National Diocesan Attorneys Association

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

State Bar of South Dakota, admitted May 1977. There have been no lapses in membership.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

Bar of the South Dakota Supreme Court, 1977

United States District Court for the District of South Dakota, 1977

United States Court of Appeals for the Eighth Circuit, 1977

Supreme Court of the United States, 1980

Bar of the Oglala Sioux Tribal Court, 1981, inactive since 2003 appointment as Federal Public Defender

United States Court of Federal Claims, 1990

United States Court of Appeals for the Federal Circuit, 1995

United States District Court for the District of North Dakota, 2005

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11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

2001 to 2003; Red Cloud Indian School, Inc.
I was a volunteer member of the Board of Directors for this nonprofit corporation which operates a preschool program, two K-through-8 grade schools and a college-preparatory high school on Pine Ridge Indian Reservation in South Dakota.

2001 to 2003; Wildlife Experiences, Inc.
I was a volunteer member of the Board of Directors of this nonprofit organization.

1989 to 2000; Museum Alliance of Rapid City, Inc., d/b/a The Journey Museum
I was a volunteer member of the Board of Directors, Secretary/Treasurer, and Vice President of this nonprofit corporation.

1984 to 1986; I was a member of the Board of Directors for the Rapid City Arts Council, a local nonprofit organization which promotes the visual and performing arts. I served on the Exhibit Committee of the Arts Council for many years.

1982 to 1984; I served on the Board of Directors for the William Edward Recovery Center, a chemical dependency treatment project for children and adolescents. This organization is no longer in existence.

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

I have never been a member of any organization which currently discriminates or formerly discriminated on the basis of race, sex, religion or national origin.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor,

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editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

Quick Bear v. Leupp, Amalgamation of Church and State on the Rosebud. Published, South Dakota Historical Collections, Volume 38, 1976. Four copies supplied.

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

Criminal Justice Act panel attorney training programs for the District of North Dakota with presentations in Fargo, Grand Forks, Minot and Bismarck, North Dakota, June 1 to 5, 2009.

State Bar of South Dakota Continuing Legal Education program, Sioux Falls, South Dakota, April 17, 2009. I was the program chair for a seminar entitled Criminal Defense Artistry: Proficiencies & Perspectives. I emceed the program and introduced all speakers but did not substantively present on any topic.

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September 19, 2008 -- The University of South Dakota Law School held a forum on the Sixth Amendment. I participated as a panel member at the forum, which focused on the right to assistance from counsel.

United States Sentencing Commission Symposium On Alternatives To Incarceration, Washington, DC, July 2008. Panel speaker on the topic *Treatment for Special Needs of Native Americans.* Four copies of the transcript supplied.

In addition, I made speeches in connection with my duties with the South Dakota Democratic Party, including speeches at State Conventions.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following articles in which I was quoted:

February 29, 2008; "Prosecutors won't seek death penalty against former fugitive"; BYLINE: By Dave Kolpack, Associated Press Writer.

The Associated Press State & Local Wire; July 5, 2005, "Federal public defender system being developed in North Dakota."

Argus Leader; January 13, 2005; "Justices give judges leeway in sentencing."

The Associated Press State & Local Wire; October 25, 2002; "Johnson quiet, but has great sense of humor."

Lincoln Journal Star (Nebraska); November 26, 2001; "For Native children, refuge."

Argus Leader (Sioux Falls, SD); April 8, 2001; "Few thought Aberdeen native could climb so far."

Rocky Mountain News (Denver, CO); September 22, 1997; "Archbishop no stranger to abuse cases - South Dakota suit came during Chaput's tenure."

Rocky Mountain News (Denver, CO); February 23, 1997; "Marching orders from God - New archbishop Chaput plunges into spiritual issues with both energy and personal warmth."

Hartford Courant (Connecticut); August 30, 1996; "Democrats Of Two Minds: He's Great, Or He'll Do."

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Business Wire; January 12, 1996; "Race For The Presidency" to feature Gramm, Buchanan and Taylor on Jan. 18 show.

The Hotline; February 24, 1992; South Dakota Primary: Battle For The Heartland

ABC News; February 23, 1992; World News Sunday

The Boston Globe; February 21, 1992; "Prairie shootout - South Dakota may winnow the field."

United Press International; October 6, 1981; "Federal, AIM lawyers agree on procedure in camp suit."

The Associated Press; September 9, 1981; "Government Files Suit to Stop Occupation."

United Press International; September 8, 1981; "Indians abandon protest campsite."

The Associated Press; September 1, 1981; "Indians In Court Over The Black Hills -- As Defendants."

The Associated Press; August 31, 1981; "Forest Service Files Suit To Evict Sioux From Campsite."

The Associated Press; June 2, 1981; "Indian Lawyer Says Ruling Threatens Rights Of All Americans."

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

I have not held a judicial office.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? _____

i. Of these, approximately what percent were:

jury trials? ___%; bench trials ___% [total 100%]

civil proceedings? ___%; criminal proceedings? ___% [total 100%]

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b. Provide citations for all opinions you have written, including concurrences and dissents.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

e. Provide a list of all cases in which certiorari was requested or granted.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

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b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I have not served as a judge.

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.
Appointed Acting United States Attorney for the District of South Dakota, 1981. During the interim between the resignation of President Carter's appointed U.S. Attorney in 1981 and the installation of President Reagan's choice for South Dakota's U.S. Attorney, Andrew W. Bogue, Chief Judge of the United States District Court for the District of South Dakota, appointed me Acting United States Attorney.

Appointed Federal Public Defender for the District of South Dakota, 2003 to present. I am appointed by the United States Court of Appeals for the Eighth Circuit.

Appointed Federal Public Defender for the District of North Dakota, 2005 to present. I am appointed by the United States Court of Appeals for the Eighth Circuit. With this appointment, a combined-district Federal Public Defender organization was established for both judicial districts in the Dakotas. I lead a defender organization which provides effective representation to indigent criminal defendants across a 144,000 square mile territory which encompasses thirteen Indian reservations. My headquarters office is in Rapid City, South Dakota. I manage the representation of clients through branch offices in Pierre and Sioux Falls, South Dakota, and in Fargo and Bismarck, North Dakota.

I have had no unsuccessful candidacies for elective office or unsuccessful nominations for appointed office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

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Between 1982 and 2002, I volunteered for various activities in support of the South Dakota Democratic Party. I worked as a volunteer in the congressional campaigns of Tom Daschle and Tim Johnson, both of whom served South Dakota in the United States House of Representatives and in the Senate. I was elected at the county and state levels to serve as a member of the State Central Committee, the State Party Executive Board, and, from 1990 to 2000, as the Democratic National Committeeman for South Dakota. I have never held a paid position with any political campaign organization or political entity.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I have not served as a clerk to a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I have never practiced law alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

2003 to present:
Administrative Office of the United States Courts
Office of the Federal Public Defender
703 Main Street, 2nd Floor
Rapid City, SD 57701
I was appointed Federal Public Defender for the District of South Dakota by the United States Court of Appeals for the 8th Circuit in 2003. In 2005, the Court of Appeals appointed me the Federal Public Defender for the District of North Dakota to lead a combined-district organization for both North Dakota and South Dakota.

1992 to 2003:
Viken, Viken, Pechota, Leach & Dewell, LLP
1617 Sheridan Lake Road
Rapid City, SD 57702
I was a partner in this law firm.

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1981 to 1992:
Finch, Viken, Viken & Pechota
304 Main Street
Rapid City, SD 57701
I was a partner in this law firm.

1981 to 1982:
Finch, Viken & Viken
304 Main Street
Rapid City, SD 57701
I was a partner in this law firm.

1977 to 1981:
United States Department of Justice
Office of the United States Attorney for the District of South Dakota
515 9th Street
Rapid City, SD 57701
I was an Assistant United States Attorney following graduation from law school in 1977. I served as First Assistant United States Attorney and, in 1981, as Acting United States Attorney for the District of South Dakota.

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

I served as an Assistant United States Attorney from the time of my law school graduation in May 1977 until commencing private practice in November 1981. While employed by the Department of Justice, I prosecuted twenty-five felony cases through jury trial and resolved a substantial number of cases by plea. I was responsible for significant grand jury investigations. As a federal prosecutor, I worked extensively with federal, state and tribal law enforcement authorities. My work also included representing the government in civil litigation under the Federal Tort Claims Act. I briefed and argued more than two dozen cases in the United States Court of Appeals for the Eighth Circuit.

I entered the private practice of law in Rapid City, South Dakota, in 1981. For twenty-one years, my practice focused on plaintiff personal injury litigation and the defense of criminal cases in federal and state courts. I

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also defended civil cases for insurance companies, was legal counsel for the board of directors of a major jewelry manufacturing company, and advised small business owners. While in private practice, I tried twenty-three jury cases to conclusion in federal and state courts. A significant part of my civil and criminal client base was comprised of Indian people from the northern plains region.

Since 2003, I have served as a Federal Public Defender. During fiscal year 2008, I oversaw the representation of 842 federal defendants in the Districts of North Dakota and South Dakota. As a court unit executive for the federal judiciary, I manage an annual budget of five million dollars and supervise thirty-two judiciary employees.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

During my twenty-one years of private practice, I represented a broad range of clients from corporate entities to members of the clergy to middle class business owners to indigent clients who sought guidance on civil and criminal issues. The focus of my civil practice was plaintiff personal injury and wrongful death work. My criminal practice was limited almost exclusively to the defense of felonies in federal and state courts.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

I estimate that 95% of my civil and criminal practice involved litigation. During all stages of my career until 2003, I appeared in court frequently. Since my appointment as Federal Public Defender, I have appeared in court infrequently. The administrative and management obligations of my present work prevent me from regularly undertaking the representation of individual clients. My daily schedule does include significant work on pretrial and trial strategy with the ten Assistant Federal Defenders in our organization. I have tried one major jury case and argued three cases at the United States Court of Appeals since becoming the Defender in 2003.

i. Indicate the percentage of your practice in:
   1. federal courts: 66%
   2. state courts of record: 33%;
   3. other courts: 1% in tribal courts
   4. administrative agencies:

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 55%;
   2. criminal proceedings: 45%

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d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I have tried 49 jury cases to conclusion and approximately 8 cases to courts without a jury. I estimate that I had co-counsel in 9 of these cases. In all other cases, I was sole counsel.

i. What percentage of these trials were:
   1. jury: 86%
   2. non-jury: 14%.

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

1. *Black v. Secretary of Health and Human Services*, 93 F.3d 781 (Fed. Cir. 1996): National Vaccine Injury Compensation Act litigation. With my law partner James Leach, I represented a catastrophically injured Indian boy who was denied lifetime benefits after administrative proceedings under the Act. Because the client received medical care from the Indian Health Service for his vaccine injuries, he could not meet the statutory $1,000 out-of-pocket expense requirement. This result excluded many poor Indian children in the country from relief under the Act, which was an outcome not intended by Congress. I helped lead an advocacy effort which resulted in Congress amending the Act so that the out-of-pocket expense requirement would not exclude other Indian families from

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seeking a remedy for vaccine injuries. Representation of the minor claimant and his parents commenced in approximately 1989 and concluded in approximately 1997. The case was litigated in the United States Court of Federal Claims and in the United States Court of Appeals for the Federal Circuit. Co-counsel was James D. Leach, 1617 Sheridan Lake Road, Rapid City, SD 57702, telephone 605-341-4400. The claim was defended by a number of attorneys through the Department of Justice.

2. *Oglala Sioux Tribe of the Pine Ridge Indian Reservation v. United States, et al.*, 650 F.2d 140 (8th Cir. 1981): The Oglala Sioux Tribe brought a quiet title action seeking the return of the Black Hills and surrounding areas alleging an unconstitutional taking under the 5th Amendment. The United States District Court for the District of Nebraska, the Honorable Albert G. Schatz sitting by designation, dismissed the action for lack of jurisdiction based on a motion I filed and argued on behalf of the United States. The court concluded that the Indian Claims Commission Act was the exclusive remedy and that the Oglalas' claim had been adjudicated under that Act in *Sioux Nation of Indians v. United States*. The dismissal was affirmed by the U.S. Court of Appeals for the Eighth Circuit. I represented the United States at oral argument in the Eighth Circuit. I was lead defense counsel in this litigation. Co-defendant State of South Dakota was represented by then Attorney General Mark V. Meierhenry. Mr. Meierhenry's present address is 315 South Phillips Avenue, Sioux Falls, SD 57104, telephone 605-336-3075. Lead counsel for the plaintiff was Mario Gonzales, 522 7th Street, Ste. 202, Rapid City, SD 57701, telephone 605-716-6355.

3. United Airlines Flight 232 Disaster: I was lead counsel for the estate of Gladys Cooper, a Wyoming resident killed in Sioux City, Iowa, in the crash of United Airlines flight 232 on July 19, 1989. This case was handled under the rules governing complex civil litigation in United States District Court in Chicago. The litigation was against United Airlines, General Electric, McDonald Douglas and other parties deemed responsible for the mechanical failures which resulted in the crash of the United Airlines passenger jet. I negotiated a substantial settlement for the clients. Andrew Breffeilh of Jackson, Wyoming, was co-counsel and served as local counsel for the estate in Wyoming. Mr. Breffeilh is no longer practicing law. The numerous defendants were represented by a defendants' steering committee for the resolution of this case.

4. *United States v. Pam Holiday*: As an Assistant U.S. Attorney, I directed the lengthy federal grand jury investigation which ultimately resulted in a raid on the houses of prostitution in Deadwood, South Dakota, in 1980. Numerous federal crimes were under investigation which required the grand jury testimony of Deadwood's prostitutes as material witnesses. The focus of the federal law enforcement action was not local prostitution violations but rather homicide, gun running, gang activity and other matters which remain secret under rules governing the conduct of grand jury proceedings. The South Dakota Attorney General's Office filed the civil abatement action which closed the houses

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following the federal material witness raid. I prosecuted Madam Pam Holiday for tax code violations in United States District Court at Rapid City, the Honorable Andrew W. Bogue presiding. The case ended in a guilty plea. During the investigation and subsequent litigation, the State of South Dakota was represented by Assistant Attorney General James E. McMahon. Mr. McMahon's present address is P.O. Box 2554, Sioux Falls, SD 57101, telephone 605-332-5606. Defendant Pam Holiday was represented by Rapid City attorney and later state court judge John E. Fitzgerald, deceased.

5. *Marilyn Rynders v. DuPont, et al.*, 21 F.3d 835 (8th Cir. 1994): I was lead counsel for plaintiff Marilyn Rynders on a products liability claim against DuPont, Vitek Corporation and other defendants alleging negligent manufacture of the medical product known as proplast temporal mandibular joint implants. My client suffered permanent jaw joint injuries from failure of the product. At trial in United States District Court at Rapid City, South Dakota, the Honorable Richard H. Battey presiding, the jury found in favor of the defendants. The United States Court of Appeals for the Eighth Circuit affirmed. This was one of the first products cases of its kind tried in the United States based on failed proplast implants. Evidence was developed for the Rynders case which ultimately facilitated verdicts against the defendants in other jurisdictions. The defense legal team was led by William G. Porter, deceased, of Rapid City, South Dakota.

6. *United States v. Cyril Plumman*, 409 F.3d 919 (8th Cir. 2005): I was lead counsel for the defense of Cyril Plumman on multiple charges of aggravated sexual abuse arising under the Major Crimes Act. The case was tried in United States District Court at Pierre, South Dakota, the Honorable Charles Kornmann presiding. Mr. Plumman was acquitted on one count but was convicted on other abuse counts. The District Court sentenced Mr. Plumman to multiple mandatory life sentences believing that the Federal Sentencing Guidelines required that outcome. I argued the case at the United States Court of Appeals for the Eighth Circuit on the basis that the District Court erred in treating the Sentencing Guidelines as mandatory rather than advisory in light of the Supreme Court jurisprudence post-*Booker*. The Court of Appeals affirmed the convictions but vacated the mandatory life sentences and remanded for resentencing. Mr. Plumman received a term of years with no life sentence at post-appeal proceedings in District Court. My co-counsel was Assistant Federal Public Defender Edward Albright, 124 South Euclid Avenue, Ste. 202, Pierre SD 57501, telephone 605-224-0009. The prosecutor was Randolph Seiler, Assistant United States Attorney, P.O. Box 7240, Pierre SD 57501, telephone 605-224-5402.

7. *Pattie Hinkle v. Kadoka School District*: My wife and law partner Linda Lea Viken and I represented the plaintiff in this claim for money damages on behalf of high school teacher Pattie Hinkle in United States District Court at Pierre, South Dakota, in 1982. The Honorable Donald Porter, now deceased, presided. Ms. Hinkle brought this civil rights action alleging that she was fired from her long service as an educator because of her activism in the local teacher's union. The

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jury awarded our client money damages. The school district did not appeal the verdict. Co-counsel Linda Lea Viken practices law at 4200 Beach Drive, Ste. 4, Rapid City SD 57702, telephone 605-721-7230. The defendants were represented by attorney David Gerdes, P.O. Box 160, Pierre SD 57501, telephone 605-224-8803.

8. *People to Save Our Constitution, Inc. v. Cheyenne River Sioux Tribe*: My former law partner Terry Pechota and I represented the plaintiff, a group of tribal members, against the Tribe for violations of federal and tribal law in connection with elections on the Cheyenne River Reservation. We tried the case to the late Judge Donald Porter in United States District Court at Pierre, South Dakota. Our clients did not prevail but achieved some regularity in the election processes as a result of this dispute. Lead counsel for the defendant was Richard West, retired. Mr. West was subsequently Director of the National Museum of the American Indian in Washington, DC.

9. *State of South Dakota v. Dick Stoll*: My client was prosecuted by the South Dakota Attorney General's Office and the Meade County States Attorney on multiple rape allegations in South Dakota Circuit Court at Sturgis in 1983. The late Judge Robert Tschetter presided. This complex case involved a number of alleged victims who made spectacular claims of rape against my client, a well known person in the state volunteer fire department community. The case received extensive coverage in the local media for months, all of it slanted toward the guilt of my client. After a lengthy jury trial, Mr. Stoll was found not guilty on all counts. Lead counsel for the State of South Dakota was Ronald Campbell, 325 East 1st Avenue, Miller SD 57362, telephone 605-853-2456.

10. *Robert Koenig v. William Lambert and Diocese of Rapid City*, 527 N.W.2d 903 (SD 1995): This much publicized clergy sex abuse case was tried to a jury in Circuit Court for the Seventh Judicial Circuit at Rapid City before the Honorable Warren G. Johnson. I represented the Diocese of Rapid City which was the subject of allegations that the bishops of the diocese knew or should have known of Koenig's childhood sexual abuse by Catholic priest William Lambert. The jury returned an award of money damages against Lambert. The jury found the Diocese not liable because its bishops were without knowledge of Lambert's criminal activities and the claim was barred by the statute of limitations. This was one of the first clergy sex abuse cases in the country which resulted in a jury finding of no liability against a diocese. The verdict was upheld on appeal. Plaintiff's co-counsel were Rick Johnson, deceased, and Stephanie Pochop. Ms. Pochop practices law in Gregory, South Dakota. Her address is P.O. Box 149, Gregory SD 57533, telephone 605-835-8391. Counsel for defendant William Lambert was Joseph M. Butler, deceased, and Jeffrey G. Hurd. Mr. Hurd can be reached at P.O. Box 2670, Rapid City SD 57709, telephone 605-343-1040.

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18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

The most significant legal matter in my career not involving litigation was the establishment of the Federal Public Defender organization for the District of North Dakota. Shortly after my appointment as Federal Public Defender for the District of South Dakota in 2003, the Federal District Judges in North Dakota requested that I consider expanding defender services into that district. North Dakota was one of four remaining judicial districts in the United States without a Federal Public or Community Defender established pursuant to the Criminal Justice Act, 18 U.S.C. § 3006A. Between 2003 and the opening of our defender offices in North Dakota on November 1, 2005, I led the effort to analyze the practicality and logistics of forming a combined-district Federal Defender organization. I traveled throughout North Dakota speaking to judges, defense attorneys, prosecutors, probation staff and others involved in the federal criminal justice system. Though the Criminal Justice Act Plan for the District of North Dakota provided a competent panel of private practice attorneys available for appointment to represent indigent defendants in District Court, no support resources were available to defense counsel and trials were few in number. After my public education effort, the North Dakota State Bar conducted a survey of its membership to determine whether a combined-district defender organization was needed and supported in the district. The survey results confirmed greater than 80% support for the establishment of a Federal Public Defender organization for the District of North Dakota. The Federal District Judges and the Clerk of Court worked closely with me to achieve Circuit Court approval and authorization from the Administrative Office of the United States Courts to expand defense services into the district. With the assistance of the General Services Administration, we located and renovated professional office spaces for our staff in Fargo and Bismarck, North Dakota. Four Assistant Defenders, two professional investigators and two legal secretaries were hired from a large pool of applicants. Since opening our North Dakota offices in 2005, we have represented 976 indigent defendants vigorously and effectively. Our organization provides annual training opportunities for panel attorneys, consults with appointed counsel in complex cases, and maintains a specialized website and library resources for use by panel attorneys. The judges in the district have stated publicly that the establishment of our combined-district organization has significantly increased the quality of representation for indigent defendants in the District of North Dakota.

I have performed no lobbying activities on behalf of any client or organization.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe

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briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have not taught any courses during my legal career.

20. **Deferred Income/Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

I have no deferred income or future benefit arrangements from prior business relationships.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

I have no plans, commitments or agreements to pursue outside employment, with or without compensation, during my service with the court.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

See attached Financial Disclosure Report

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

I will handle all matters involving actual or potential conflicts of interest through the careful and diligent application of Canon 3 of the Code of Conduct for United States Judges as well as other relevant Canons and statutory provisions.

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My spouse, Linda Lea M. Viken, is a sole practitioner doing business under the name Viken Law Firm. She is a family law attorney whose practice is entirely within the jurisdiction of the courts of the State of South Dakota. A filing in federal court involving my spouse will be extremely rare and easily identifiable.

I have been out of private law practice for nearly six years. I have no financial interest in any law firm or with any former client, former law partner or matter pending in any law firm with which I was formerly associated.
Federal criminal and habeas corpus cases pending in the Federal Public Defender's Office at the time of my departure will present a conflict and will require recusal. Future cases in which present clients or former clients of the Federal Public Defender's Office appear as witnesses may present a conflict. Based on discussion with Chief Judge Karen Schreier, District of South Dakota, I plan to recuse myself under the circumstances noted. Chief Judge Schreier or another District Judge will be assigned to cases which require my recusal.

b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

Cases involving clients or former clients represented by the Federal Public Defender's Office during my tenure as Defender are easily identifiable from the court's record of appointed counsel. I will recuse myself from cases involving such clients as well as cases arising from clients represented during my time as Federal Defender.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

Throughout my 21 years of private practice, I regularly and frequently performed legal services at no charge or on a reduced fee basis for financially disadvantaged people. Forms of representation included drafting testamentary documents and contracts, negotiating disputes without litigation, resolving issues with insurance carriers or public benefit providers, addressing landlord-tenant issues, and undertaking representation in simple and complex criminal and civil litigation. Pro bono work was performed for clients in federal, state and tribal courts.

My commitment to seeking equal justice for indigent people was the motivation for my tenure on the Board of Directors of Black Hills Legal Services, Inc., from 1987 to 1992.As chair of the Legal Services Board from 1988 to 1992, I undertook pro bono representation and encouraged members of the local bar to offer their services free of charge to those who could not afford counsel in civil matters.

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After becoming Federal Defender in 2003, I initiated annual Law Day programs in regional schools heavily populated by financially disadvantaged students. Our staff attorneys and paralegals speak to approximately 1,000 middle school and high school students each year, primarily in institutions located on Indian reservations in the Dakotas. These presentations and discussions are intended to inform students about their constitutional and statutory rights and obligations in the hope that our instruction will encourage law abiding behavior and respect for the justice system.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

The January 2009 edition of the South Dakota State Bar Newsletter carried a notice that attorneys interested in filling a Federal District Court vacancy should apply to Drey Samuelson, Chief of Staff for United States Senator Tim Johnson. I followed the instructions provided in the notice and in subsequent communications from Mr. Samuelson to those who applied for the judgeship. There is no selection commission process used in this district. I submitted an application letter and resume to Mr. Samuelson. Thereafter, I responded to a detailed set of questions submitted to applicants. On February 24, 2009, I received a call from Mr. Samuelson advising that Senator Johnson intended to recommend me to fill an upcoming vacancy on the District Court in the Western Division at Rapid City, South Dakota. I met with Senator Johnson and Mr. Samuelson while in Washington, DC, on defender business on February 27, 2009, the day Senator Johnson announced his recommendation. Since March 12, 2009, I have been in communication with pre-nomination officials at the Department of Justice for guidance on the completion of required documents and for the scheduling of an initial telephonic interview. On May 21, 2009, I was interviewed by Associate Attorney General Thomas Perrelli and staff from the Office of White House Counsel at the Department of Justice.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No such communications have taken place.

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AFFIDAVIT

I, Jeffrey L. Viken, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

June 17, 2009
(DATE)

(NAME)

(NOTARY)

M.C.E. 8/5/11

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STATEMENT OF DAVID J. KAPPOS, NOMINEE TO BE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE

Mr. KAPPOS. Good morning. If it is OK, I do have a short statement that I would like to read, Chairman Leahy.

Chairman LEAHY. Please go ahead.

Mr. KAPPOS. Thank you. Chairman Leahy, Senator Sessions, distinguished members of the Senate Judiciary Committee, thank you very much for the opportunity to appear before you here today. I am very grateful to President Obama and to Secretary Locke for the trust that they have placed in me, and to you for considering my nomination as Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office.

It is exceptional and humbling under any circumstance to have the opportunity to serve one's country, but it is particularly so for me as the son and grandson of emigrants. My father, who you met just a moment ago, came to this country from Greece and my mother's parents came to the U.S. from Italy. So the opportunity to be here today is particularly poignant for me and it is, also, for my family.

If recommended by this Committee and confirmed by the Senate, I look forward to joining Secretary Locke, his team at Commerce, in their mission as stewards of American economic growth, job creation, and innovation. I have spent nearly my entire professional career in the field of intellectual property law and, indeed, my entire career around technology and innovation, first, as an electrical and computer engineer; then as a patent attorney handling matters before the U.S. PTO; litigating patent disputes both as defendant and as plaintiff; managing intellectual property matters in Asia; and, finally, as vice president and assistant general counsel for intellectual property law, managing IBM's IP interests globally.

So I have seen the intellectual property system from all sides. I care passionately about this field and the role intellectual property plays in advancing American innovation. So it is particularly exciting for me to be considered for the position of Director of the U.S. PTO, an organization that traces its roots to the Founding Fathers and to their understanding that promoting and rewarding innovation is critical to our country's success.

PTO faces many challenges, as we all know. Most immediate are those resulting from the economic downturn, the need for a stable and sustainable funding model, the need to address pendency concerns while preserving and enhancing patent quality, and the imperative to attract and retain skilled personnel at a time of fiscal constraint.

Secretary Locke has personally asked me to refashion the patent examination process to meet these challenges and in carrying forward this direction, I will focus substantial personal attention within the U.S. PTO as my top priority.

Additional challenges flow from rapid globalizing trade environment, impacting trademark and patent interests, as well as respect for intellectual property and the consequences where intellectual property is not respected. Longer term, the U.S. PTO is going to

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need to keep abreast of the astounding pace of technological change across a broad range of scientific disciplines.

It must constantly rethink how it carries out its constitutional imperative to promote innovation and scientific advancement for the public good, both in terms of the technology confronting the office and in terms of leveraging that technology and applying the law to that technology.

So as I consider these challenges, I am mindful of several things. I am mindful that the U.S. PTO serves the interests of all innovators in this country, small and large, corporate and independent, academic and applied, and, most importantly, the public interests. While I have spent my career to date at a large corporate enterprise, I am familiar with the concerns of all U.S. PTO constituents, including small and independent investors, the venture and startup community, public interest groups, the patent bar and many others, and I will reach out to all of them.

I am mindful of the incredible dedication of the thousands of U.S. PTO employees and the essential role they play in the success of the U.S. innovation system. I will work every day with the U.S. PTO employees and the unions that represent them to establish strong, positive relationships grounded in professional treatment for professional judgment.

I am acutely mindful that innovation today is global and that IP policy is of paramount importance, not only in our country, but also in the EU, in Japan, in China, Brazil, India and many other developing countries.

I will use my international experience and my understanding of global IP trends to help this administration represent the interests of American innovators globally.

Finally, I am mindful that the office for which I am being considered, working as part of Secretary Locke's team and within the administration's agenda, must be intensely focused on how to serve the American people at this time of economic uncertainty.

I believe the U.S. PTO can play a significant role in enhancing economic growth, creating jobs and advancing American innovation, and I hope to play a part of this important mission.

Again, I am grateful for the opportunity to address you here today and I am pleased to answer any questions.

[The biographical information of David J. Kappos follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR NON-JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   David James Kappos

2. **Position**: State the position for which you have been nominated.

   Undersecretary of Commerce and Director of United States Patent and Trademark Office

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: *1 North Castle Drive, Armonk NY, 10504*
   Residence: [redacted]

4. **Birthplace**: State date and place of birth.

   March 3, 1961; Palos Verdes, CA

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   George Washington University, School of Law; 8/89 – 5/90; no degree received
   UC Berkeley, Boalt Hall School of Law; 8/87 – 5/89; Juris Doctor degree received 5/90
   Syracuse University; 8/84 – 12/84, no degree received
   UC Davis; 8/79 – 8/83; BS Electrical and Computer Engineering degree received 8/83

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

   IBM Corporation, 12/90 to Present:

   Vice President and Assistant General Counsel, Intellectual Property Law and Strategy; I North Castle Drive, Armonk NY 10504; 5/2003-present
   Corporate Counsel, Intellectual Property Law; I North Castle Drive, Armonk NY 10504; 8/2000-4/2003
   Assistant General Counsel, Intellectual Property Law; Tokyo, Japan; 5/1998-7/2000
   Counsel, Intellectual Property Law; San Jose, CA; 7/1995-5/1998
   Attorney, Litigation; San Jose, CA; 7/1993-7/1995

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Attorney, Intellectual Property Law; San Jose, CA; 12/1990-7/1993
Trainee, Intellectual Property Law; Arlington, VA; 5/1989-12/1990
Engineer; Endicott, NY; 10/1983-5/1989 (excluding leaves of absence during law school attendance)

Intellectual Property Owners Association, Washington DC, Vice President, 1/2008-present
Intellectual Property Owners Education Foundation, Washington DC, member Board of Directors, 3/2008-present
American Intellectual Property Law Association, Arlington VA, member Board of Directors, 10/2006-present
International Intellectual Property Society, Morristown, NJ, member Board of Directors, 1/2001-present
Alexander Tognino Foundation, Ardsley NY, member Board of Trustees, 5/2008-present

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I have registered for the Selective Service.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

Tau Beta Pi Society
UC Berkeley academic scholarship
Graduation with highest honors, UC Davis

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

Intellectual Property Owners, Vice President, 1/2008 – present
Intellectual Property Owners Education Foundation, member Board of Directors, 3/2008 - present
American Intellectual Property Law Association, member Board of Directors, 10/2006 – present
Alexander Tognino Foundation, member Board of Trustees, 5/2008 - present
International Intellectual Property Society, member Board of Directors, approximately 1/2001 – present
American Bar Association (no record of dates available)
American Chamber of Commerce Japan Intellectual Property Law Committee, 5/1998-7/2000
Peninsula Intellectual Property Law Association, 1990-1998 (approx)

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

1990 - California
2002 - District of Columbia
2003 - New York

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

N/A

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

None

b. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

N/A

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

"Deferred Examination: A Solution Whose Time Has Come," Letter to the Editor, Managing Intellectual Property, April 2009
"Seeking a Balanced Approach to Inequitable Conduct Reform," publication pending 2009
"A Technological Contribution Requirement for Patentable Subject Matter: **Supreme Court Precedent and Policy", Northwestern Journal of Technology and Intellectual Property, Vol. 6, No.2, Spring 2008**
"It's Time for Patent Reform", BusinessWeek, March 28, 2007
"Point of View: We Must Stop the Race to the Bottom", IP Law and Business, April 1, 2007

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b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

"Opening Statement to Senate Judiciary Committee, Concerning S515," 2009
"Testimony of David J. Kappos Before the United States Senate Committee on the Judiciary," 2009
"Letter to The Honorable Dianne Feinstein," 2009
"Appendix to Letter from David J. Kappos to Members of Senate Judiciary Committee," 2009
"Working Together Toward A Sustainable Patent System," speech to Trilateral Patent Offices, 2008
"Working Together Toward A Sustainable Patent System," speaking notes for speech made to Trilateral Patent Offices, 2008
"Declaration of David J. Kappos, on Behalf of IBM, in Support of AIPLA Amicus Brief in Matter of GSK Preliminary Injunction Motion to Stay New PTO Rules," 2007
Letter to Jon Dudas recommending PTO data transparency, 2007

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

"Generic Prior Art Citation Document," speech to Industry Trilateral, 2008
"Working Together Toward A Sustainable Patent System," speech to Trilateral Patent Offices, 2008
"Working Together Toward A Sustainable Patent System," speaking notes for speech made to Trilateral Patent Offices, 2008
"Section 112 Issues in Computer Software Patents," speech to AIPPI, 2009
"US Patent Reform: Is it Within Reach?" speech to Council on Foreign Relations, 2009
"The Eco-Patent Commons," speech to AIPPI, 2008
"Intellectual Property and the Evolution of Innovation Models," speech to Interpat, 2008
"Fordham IP Law Institute 16th Annual Conference," speech at Fordham IP

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Law Institute 16th Annual Conference, 2008
"Calling The Pitches: US Intellectual Property Laws in an Era of Legislative Deadlock and Supreme Court Activism," speech to Licensing Executives Society, 2007

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

The following list represents all the interviews I have been able to identify through a search of my records and public databases.

2004	
May 8, 2004	Neil Munro, The National Journal
2005	
January 11, 2005	The Journal News, Julie Moran Alterio
2006	
October 24, 2006	Business Daily Update
February 20, 2006	InformationWeek, Eric Chabrow
August 21, 2006	Fortune, Nicholas Varchaver
January 14, 2006	Chicago Tribune, Jon Van
October 30, 2006	InformationWeek, Paul McDougall
February 2, 2006	Business Week Online, Michael Orey
February 13, 2006	Business Week, Michael Orey
October 30, 2006	COMMWEB
January 17, 2006	Deseret Morning News, Bloomberg News, Susan Decker
May 12, 2006	Business Wire
October 2006	Intellectual Property Today
2007	
September 2007	Inside Counsel
March 5, 2007	UPI
March 5, 2007	TechNews, Alan Sipress
March 5, 2007	The Washington Post, Alan Sipress
May 14, 2007	Business Week, Michael Orey, with Arlene Weintraub
May 7, 2007	InformationWeek, Chris Murphy
May 5, 2007	TechWeb

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March 5, 2007	Technology Daily
April 30, 2007	AFX International Focus
April 30, 2007	The Associated Press, Christopher S. Rugaber
October 25, 2007	Patently-O: Patent Law Blog, Dennis Crouch
October 26, 2007	Patent Baristas, Stephen Albainy-Jenei
April 24, 2007	Deseret Morning News, Suzanne Struglinski
February 28, 2007	Investor's Business Daily, Sheila Riley
Feb. 2, 2007	Jim Finkle, Reuters
Feb. 6, 2007	Nick Varchaver, Fortune Magazine
Feb. 7, 2007	Jim Puzzanghera, Los Angeles Times Neil Munro, National Journal Jess Bravin, Wall Street Journal Alan Sipress, Washington Post
March, 2007	Investors' Business Daily
April 12, 2007	Wired magazine, Jeff Howe
April, 2007	CNET
July 11, 2007	Joff Wild, IAM Magazine
July 31, 2007	Richard Waters, Financial Times (no story)
	Robert Scoble, Scobelizers blog (video interview posted to Internet)
Aug. 17, 2007	NPR Interview - NPR's talk of the Nation - Science Friday (reporter Ira Flatow)
Dec. 12, 2007	Fortune - Nick Varchaver (no story)
Dec. 20, 2007	Dow Jones (Stuart Weinberg Re LG Quanta case)

2008

September 26, 2008	Business Wire
October 14, 2008	China Business Newsweekly
September 16, 2008	The New Zealand Herald
September 15, 2008	The Associated Press, Joelle Tessler
January 15, 2008	The Calgary Herald (Alberta)
January 15, 2008	Ottawa Citizen
November 2008	Intellectual Property Today, Joseph N. Hosteny
Jan. 13, 2008	William Bulkeley, Wall Street Journal Matthew Miller, Bloomberg

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	Tom Abate, San Francisco Chronicle Martin LaMonica, CNET
Jan. 15, 2008	Diane Bartz, Reuters (Quanta)
Feb. 4, 2008	Stuart Weinberg, Dow Jones (re Patent Reform Legislation)
Feb. 5, 2008	Les Echos Interview
July 23, 2008	Joell Tessler, Associated Press (re Peer to Patent)
Dec. 18, 2008	Jeff Howe, Wired Magazine (re Peer to Patent)

2009

March 10, 2009	CQ Congressional Testimony
June 22, 2009	EWeek.com
May 4, 2009	Patently-O: Patent Law Blog, Dennis Crouch
February 16, 2009	Africa News
February 16, 2009	The Daily Trust (Nigeria) - AAGM, Hamisu Muhammad
June 21, 2009	Patently-O· Patent Law Blog, Dennis Crouch
April 2, 2009	Filewrapper.com
April 2009	Inside Counsel, Steven Seidenberg
March 10, 2009	National Journal's CongressDaily, Andrew Noyes
June 19, 2009	National Journal's CongressDaily, Andrew Noyes
January 14, 2009	Digital Journal
June 2, 2009	Business Week Online, Michael Orey
March 11, 2009	Consumer Electronics Daily
March 11, 2009	Washington Internet Daily
March 10, 2009	CongressNow, Jackie Hicken
January 2009 / February 2009	ABI Inform, Suzanne Bell
Jan. 7, 2009	Nick Varchaver/Roger Parloff, Fortune Magazine
Jan. 13, 2009	Justin Scheck, Wall Street Journal
Jan. 14, 2009	Ashlee Vance, New York Times
Jan. 30, 2009	Inside Counsel Magazine interview and coverage in April 2009 issue.
Feb. 11, 2009	Reuters quoted in story resulting from interview conducted in South Africa
March 18, 2009	Diane Bartz, Reuters
April 7, 2009	Corporate Counsel Magazine interview and coverage in June 2009 issue.

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March 10	Senate Judiciary Committee testimony -- quoted in EE Times and eWEEK.

13. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

None

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

I volunteered on the Obama primary and presidential campaigns by serving on the IP Law advisory team, calling voters, and travelling for a weekend to Pennsylvania to get out the vote.

14. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I did not serve as a clerk.

ii. whether you practiced alone, and if so, the addresses and dates;

I did not practice alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

IBM Corporation, 12/90 to Present:
Vice President and Assistant General Counsel, Intellectual Property Law and Strategy; 1 North Castle Drive, Armonk NY 10504; 5/2003-present
Corporate Counsel, Intellectual Property Law; 1 North Castle Drive, Armonk, NY 10504; 8/2000-4/2003
Assistant General Counsel, Intellectual Property Law; Tokyo, Japan; 5/1998-7/2000
Counsel, Intellectual Property Law; San Jose, CA; 7/1995-5/1998
Attorney, Litigation; San Jose, CA; 7/1993-7/1995

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Attorney, Intellectual Property Law; San Jose, CA; 12/1990-7/1993
Trainee, Intellectual Property Law; Arlington, VA; 5/1989-12/1990
Engineer; Endicott, NY; 10/1983-5/1989 (excluding leaves of absence during law school attendance)

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

During my career, I have focused on all aspects of intellectual property law including patents, trademarks, copyrights, and trade secrets.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

My clients include IBM inventors, technical management, and business management. As noted above, I have specialized in all aspects of intellectual property law.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

i. Indicate the percentage of your practice in:
1. federal courts;
2. state courts of record;
3. other courts;
4. administrative agencies

0%. My practice does not involve appearing in court or administrative agencies. Litigation-related matters comprise about 10% of my practice (100% during assignment to Corporate Litigation function from 1993 to 1995). My litigation experience has involved advising on strategy, briefs, motion papers, discovery materials, and trial preparation, but always with outside counsel handling proceedings in court, deposition, etc.

ii. Indicate the percentage of your practice in:
1. civil proceedings;
2. criminal proceedings.

0%. My practice does not involve appearing in court or administrative agencies. All of the litigation matters I have been involved in have been civil proceedings involving intellectual property.

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d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

None

i. What percentage of these trials were:
   1. jury;
   2. non-jury.

N/A

e. Describe your practice, if any, before the Supreme Court of the United States Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have filed several amicus briefs before the U.S. Supreme Court in intellectual property cases. Copies are enclosed.

15. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

   a. the date of representation;

   b. the name of the court and the name of the judge or judges before whom the case was litigated; and

   c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

I have not personally handled any litigation. My role in all litigation matters has been advisory in nature.

16. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

- I participated in leading Peer-to-Patent project working with the USPTO, JPO, and UK PO, to implement Internet-based systems enabling the public to submit prior art and commentary relating to published pending patent applications.

- I participated in leading Patent Quality Index project, an ongoing effort to create objective, computer-based means for rating the quality of issued patents and applications.

- I participated in leading Standards for Standards project, an ongoing effort to improve the interface between standard-setting and intellectual property.

- I participated in leading Eco-Patent-Commons project, an ongoing effort to enable holders of patents having ecologically beneficial uses to grant open licenses to those patents without sacrificing the non-ecological commercial value of those patents.

- I participated in leading IBM to 16 consecutive years as the leader in US patent issuances, and in many years of earning approximately $1 billion in IP income.

17. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

    None

18. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

    I own vested IBM options valued at approximately $147,000. As per an ethics agreement that I have entered into with the Department's designated agency ethics official, all of these vested options will be sold within 90 days of appointment.

    I own unvested IBM options and restricted stock valued at approximately $1.5 million,. However all of this deferred income will be cancelled upon resignation from IBM.

    I have an investment in a spec. house in Tenants Harbor, Maine. Original amount of investment was $100,000. Percentage share of profits (if any) is 38%. Current value of this investment is estimated as less than original amount invested.

19. **Outside Commitments During Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service? If so, explain.

    No

20. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    I am enclosing a copy of my SF278 submission.

21. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

The completed net worth statement is included at the end of this submission.

22. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, affiliations, pending and categories of litigation, financial arrangements or other factors that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

In connection with the nomination process, I have consulted with the Office of Government Ethics and the Department of Commerce's designated agency ethics official to identify potential conflicts of interest. Any potential conflicts of interest will be resolved in accordance with the terms of an ethics agreement that I have entered into with the Department's designated agency ethics official. I am not aware of any other conflicts of interest.

    b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

In connection with the nomination process, I have consulted with the Office of Government Ethics and the Department of Commerce's designated agency ethics official to identify potential conflicts of interest. Any potential conflicts of interest will be resolved in accordance with the terms of an ethics agreement that I have entered into with the Department's designated agency ethics official. I am not aware of any other conflicts of interest.

23. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each. If you are not an attorney, please use this opportunity to report significant charitable and volunteer work you may have done.

I participate extensively in major intellectual property law associations AIPLA and IPO. In this capacity I have devoted time and effort working to develop strong, balanced intellectual property laws that serve the public's interest in the availability of innovative products and services at competitive prices. Recent specific projects I have participated in include: development of model local patent rules for use by district courts; development of model patent jury instructions for use by district courts; submission of comments to EPO regarding its inquiry into software patents; submission of comments to SIPO regarding its implementing regulations for the third amendment to China's patent laws.

Additionally, in my role as IBM's chief IP lawyer I am leading a project in cooperation with New York Law School, in which IBM provides senior IP law attorneys to lead NYLS students in intellectual property-focused pro bono projects on behalf of disadvantaged people in New York City.

Finally, my wife is also an attorney. As of January 1, 2009, she left her practice at a major law firm to move into the pro bono sector full time, working for Pro Bono Partnership, a non-profit dedicated to providing free legal advice and education to other non-profits in the NY/CT/NJ area.

FINANCIAL STATEMENT David Kappos

NET WORTH

Provide a complete, current financial net worth statement which itemizes in detail all assets (including bank accounts, real estate, securities, trusts, investments, and other financial holdings) all liabilities (including debts, mortgages, loans, and other financial obligations) of yourself, your spouse, and other immediate members of your household.

ASSETS		LIABILITIES	
Cash on hand and in banks	$50,000	Notes payable to banks-secured	$50,000
U.S. Government securities-add schedule	$0	Notes payable to banks-unsecured	$0
Listed securities-add schedule	$1,848,372	Notes payable to relatives	$0
Unlisted securities--add schedule	$147,940	Notes payable to others	$0
Accounts and notes receivable:		Accounts and bills due	$5,000
Due from relatives and friends	$50,000	Unpaid income tax	$0
Due from others	$0	Other unpaid income and interest	$0
Doubtful	$0	Real estate mortgages payable-add schedule	$2,004,715
Real estate owned-add schedule	$4,860,000	Chattel mortgages and other liens payable	$0
Real estate mortgages receivable	$0	Other debts-itemize:	$0
Autos and other personal property	$150,000		
Cash value-life insurance	$0		
Other assets itemize:	$0		
		Total liabilities	$2,121,659
		Net Worth	$5,212,188
Total Assets	$7,333,847	Total liabilities and net worth	$7,333,847
CONTINGENT LIABILITIES		GENERAL INFORMATION	
As endorser, comaker or guarantor	$0	Are any assets pledged? (Add schedule)	No
On leases or contracts	$0	Are you defendant in any suits or legal actions?	No
Legal Claims	$0	Have you ever taken bankruptcy?	No
Provision for Federal Income Tax	$0		
Other special debt	None		

Schedule – Listed Securities

NB Kiminsky III	$198,427
Baron Partners Fund	$44,908
Rydex NASDAQ 100	$54,917
Meridian Growth Fund	$59,865
Dodge & Cox Intl. Stock Fund	$15,774
Vanguard Prime Money Mkt	$127,137
Vanguard GNMA	$6,454
Vanguard Euro Stock Index	$29,465
Vanguard Intl. Growth	$21,255
Vanguard Total Stk Mkt Index	$150,599
IBM Stock	$49,830
Fidelity total Stock Mkt	$528,387
Fidelity Small Cap Value Indx	$178,061
Fidelity Aggresv Life Strategy	$80,166
Fidelity Intl Stk Mkt Indx	$107,771
Fidelity Small Midcap Indx	$49,280
Fidelity Eur. Stk Indx	$18,823
Fidelity Stable Value	$127,253

Schedule – Unlisted Securities

Vested IBM Stock Options	$147,940

Schedule – Real Estate Owned

[redacted]	$2,500,000
	$1,260,000
	$1,100,000

Schedule – Real Estate Mortgages Payable

[redacted]	$897,915
	$689,800
	$417,000

AFFIDAVIT

I, David J. Kappos, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

July 6, 2009
(DATE)

David J. Kappos
(NAME)

Kathleen Koblosh
(NOTARY)

KATHLEEN KOBLOSH
NOTARY PUBLIC STATE OF NEW YORK
WESTCHESTER COUNTY
LIC. #01KO6198248
COMM. EXP. 12/15/2012

Deferred Examination: A Solution Whose Time Has Come

By Steven Bennett and David Kappos

There are over 1 million patent applications backlogged at the U.S. Patent & Trademark Office (USPTO), despite that it has a $2.1 billion budget and has hired thousands of new examiners in its effort to catch up. It is no exaggeration to declare that the examination process for U.S. patent applications is struggling. And no single change to the system will fix it. But a major component of the fix is well within our grasp: deferred examination. Deferred examination could easily be implemented. It is a sensible way for the patent community to help the USPTO direct its resources to the most important pending applications, and away from the unimportant ones. The advantages are many, and the drawbacks can be mitigated. The largest barrier to deferred examination is convincing the U.S. patent community that the time has come to adopt this tool.

Deferred Examination – A Reasonable, Balanced Process

A workable process for deferred examination offers an applicant the option to "pay as you go" for the services received from the PTO. The sidebar and diagram outline our proposal for deferred examination in the U.S. and demonstrate the various routes available to applicants.

While not widely used, the PTO already has a process for deferring examination of applications[1]. Since 2000, that procedure has enabled an applicant to request deferral for up to 36 months from the filing date. To defer, an applicant must pay a $130 processing fee (in addition to the regular filing fee) and choose the number of months for the deferral (between 1 and 36 months). After processing the request, the PTO grants the deferral for the requested number of months.

IBM proposes leveraging this existing deferral procedure and automating it. In our proposal, all applications for which deferral is requested are subject to a 36 month deferred examination period.[2] At filing, the applicant pays the filing

Key Features	Advantages
Mandatory publication at 18 months	• Harmonization with other patent systems • More prior art becomes available
Flexible, up to 36 month deferral of examination	• More prior art becomes available to examiners over time • Applicant can exit deferral at any time
Third party may trigger examination at any time	• Applications important to third parties are examined sooner • Non-practicing applicants forced to have their applications examined
Search and exam fees can be deferred	• "Pay as you go" • Cost savings for applications that are later abandoned • USPTO can focus on most important pending applications
Intervening rights to third parties	• Legal protection against late claims

[1] 37 CFR §1.103(d) and MPEP §709.

[2] We note that the particulars of our proposal can be adjusted in various ways. For example, while we speak of a 36 month deferral period, a different maximum duration could be elected. In addition, we encourage the USPTO to

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fee to enable the USPTO to review the application for completeness, assign it a serial number, calculate the 36 month deferral deadline, and set the application up in the electronic filing system. Since a deferral request does not need to be investigated by the USPTO, the $130 deferral processing fee is rescinded.

During the 36 month deferral period, the applicant chooses when to pay the search fee, which funds the PTO to perform and mail a search report. The search report is similar to ones issued by the EPO, with the cited documents categorized as X, Y, A, etc.

At 18 months, the application is published. If the search report is available, then it is published as well. Otherwise the search report is published later, separately.

The PTO's existing deferral process requires the applicant to choose the number of months for the deferral up front. In our proposal, the applicant is not forced to do this, but can exit the deferral period at any time, simply by paying the examination fee.

Once the applicant pays the examination fee, the application is examined as usual. If the examination fee is not paid by 36 months, then the application is automatically deemed abandoned.

When the application is published at 18 months, our proposal allows a third party to pay the examination fee (and search fee, if necessary), causing the application to exit deferral and proceed to examination.

IBM's Proposal for U.S. Deferred Examination Provides Several Deferral Routes

As shown in the diagram, our proposal for deferred examination provides an applicant with several deferral routes. In Route #1, the application and search report are both published at 18 months because the applicant has paid the search fee.

In Route #2, the applicant defers both the search and examination until later. Conversely, in Route #3, by paying all three fees up front, the applicant has opted out of the deferral period and the application proceeds through the patent office's search and examination.

Routes #4 and #5 show how an applicant can save fees (and attorney costs) by leveraging the deferral period. In Route #4, the applicant decides to abandon the case based on information reviewed in the search report. In Route #5, the applicant does not even need to pay for the search report before deciding to abandon the case.

Deferred Examination Benefits the USPTO, Patent Applicants, and the Public

Benefits to the USPTO

Because deferred examination results in applications going abandoned before examination, a deferred examination system would leave the PTO with fewer patent applications to examine – likely significantly fewer. Taking overseas experience of patent systems allowing deferred examination as a point of comparison, the examination percentage for EPO applications is 94% and for Japanese applications 67%[3]. A reasonable estimate for the United States, if appropriate incentives are provided to encourage applicants to abandon unnecessary applications, is that 10% would go abandoned without expenditure of PTO examination resources. With nearly 450,000 new applications filed per year, about 45,000

consider reallocating fees (currently $330, $540, and $220) to better match the funding needed for filing, searching and examination.

[3] There are several reasons why different patent offices employing different deferral processes see different examination percentages. For example, while the filing fee is inexpensive in Japan (about $150 (US)), the examination fee is about $2,000 for 10 claims, and about $2,600 for 30 claims. The high cost of examination affects the percentage of applications selected by applicants for examination in Japan.

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of those applications would be taken out of the examination queue, freeing up about 1 million hours of examination time for patent examiners to spend on applications that actually matter.

In addition to reducing its workload overall, deferred examination would enable the PTO to better examine the deferred applications that are selected for examination. During the period preceding examination, applicants will become aware of prior art related to patentability, enabling them to submit more robust information disclosure statements. While we would like to assume the examiner's search would have otherwise turned up this art, it is not necessarily the case. For example, some documents do not become available on public search sites until well after the documents otherwise become statutory prior art. Further, a large number of documents are originally in languages other than English. It takes time for an English translation to become available. The deferred examination period allows the U.S. examiner to benefit from information brought to light through the passage of time, resulting in better examination of patent applications.

Benefits to Applicants

Under the existing USPTO search and examination process, where all fees are paid upfront and prior art searches occur concurrent with examination, inventors have no incentive, and lack the predicate information, to withdraw applications prior to examination, even if the claimed inventions have been rendered demonstrably valueless in the period between filing and prosecution. Thus all applications take up USPTO examination resources and many applications are carried through to issuance that otherwise would have – should have – because they have no significant value as issued patents.

Deferred examination turns this unproductive process around, giving applicants the financial incentives and information to make intelligent decisions regarding the prosecution of their patent applications, informed by marketplace developments and newly discovered prior art. The financial incentive comes in the form of a lower filing fee that covers the USPTO's expenses associated with administrative handling of the new application, but not the cost of search and examination (which may never occur). Applicants of all sizes gain when they can cut their investment in applications that prove unimportant with time, focusing their resources instead on those applications more likely to generate value.

IBM's recommended deferred examination process includes the option of a search report sent to the inventor during the deferral period, prior to examination. The search report provides the applicant a better understanding of the challenges to come during examination, and enables her to make a more informed decision about whether to proceed with the expense of examination.

As for those applications that do proceed to examination, there is an additional benefit of faster processing time. Once an applicant decides to move forward with examination, it should proceed more quickly than in today's system since deferred examination will winnow out a significant number of applications that would otherwise take precedence in the examination queue.

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Benefits to the Public

While the benefits to the PTO and applicants are important, the benefits to the public from deferred examination are perhaps the most important. Today, the public finds a "patent thicket" covering many technologies. The public's burden to design around such patent thickets would be ameliorated if applicants dropped the many patents that are not valuable. Deferring examination promotes winnowing down applications as early in the process as possible. This gives the public clarity. Moreover, IBM's proposed system to defer examination provides the public with the search report if the applicant elects a separate search, giving the public additional clarity. And perhaps most importantly, the requirement of 18 month publication for all deferred applications adds reliability to the corpus of published searchable prior art without exception.

The best interests of the public are served by an efficient government. Through deferred examination, the USPTO is able to focus its efforts on the most important applications as determined by those in the best position to judge importance – the applicants themselves. The PTO gains efficiency by focusing on work that is important, as opposed to examining applications in rote mechanical order of receipt, as is done today, even when a significant amount of that work is obviated by the time it is commenced.

With deferred examination, the USPTO can focus its work on important applications, without the distraction of the unimportant ones that are abandoned before prosecution. Examination is based on more complete information about the prior art, resulting in better examined applications and thus higher quality patents. The public gains certainty and the patent system gains credibility when the USPTO awards high quality patents.

A Balanced Deferred Examination System Addresses Countervailing Issues

Elsewhere in the world, deferred examination procedures are already available, and have proven effective for decades. The Netherlands adopted deferred examination in 1964; similar procedures were adopted in Germany in 1968, and in Japan in 1970.

Today, the United States has *de facto* deferred examination because many art units at the PTO do not examine applications for nearly 36 months. Through this *de facto* deferred examination, the public and patent applicants are accustomed to examination routinely being delayed for two, three,or more years. However, without an economic incentive to do so, applicants simply leave their unimportant applications in the system to use scarce PTO examination resources.

Surprising to many in the U.S. patent community, the U.S. also has *de jure* deferred examination procedure, as explained above. Although adopted in 2000, that process is not widely used since it has several disadvantages. First, there is a disincentive to use the deferral process since an applicant must pay a $130 processing fee. Second, the application is not added to the examination queue until after the deferral ends. Thus, the application may not be examined until well beyond the intended deferral period. Third, and most troubling, the applicant must specify the length of the deferral up-front even though the applicant does not have the necessary facts to choose the appropriate time period for deferral.

It is thus apparent that we currently enjoy the worst of all worlds, with a *de jure* deferral system that does not work, and a defacto deferral system that serves to exacerbate the problems of application backlog and patent quality. Surely, we can do better.

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While deferred examination has been successful for decades elsewhere, the United States has not yet chosen to adopt a useful deferred examination procedure. The arguments against deferred examination, which have hampered past proposals, are addressed by IBM's proposed approach.

Well-Aligned Incentives

Our proposal removes the disadvantages from the current unused *de jure* deferral system. There is no fee for deferral. The application keeps its place in the examination queue during the deferral. An applicant can exit the deferral at any time.

Greater Certainty

Our approach to deferred examination improves certainty. As with current practice, a patent application is filed with claims particularly pointing out the invention. Eighteen months later, the application and search report (if applicable) are both published. If the search report has not been requested by the applicant at the 18 month point, it is published as soon as it is requested by the applicant. Applicants are not allowed to request non-publication. The search report provides the public with more information than is currently provided at 18 months (or when later available). And of course – as is the law already – when the application is examined, prosecution history estoppel protects the public if the claims are amended.

Safeguarded Against Submarine Patents

Our approach to deferred examination does not promote "submarine" patents. Our proposal allows a third party to pay the search and examination fee at any time and force an application to be examined. There are two reasons a third party will do this: (1) for very important patent applications where the third party is keen to understand the scope of patent protection that will be granted; and (2) for patent applications that might threaten the third party. Armed with this right, a third party will be able to force an application to be searched and examined without deferral.

Intervening Rights to Protect Prior Good-Faith Commercialization

Our approach avoids unfair results for those who in good-faith commercialize the invention during the deferral period, though intervening rights. Under U.S. law, third parties are already protected by two forms of intervening rights. First, U.S. law provides for *equitable* intervening rights against claims in a reissued (or reexamined) patent that did not exist in the original patent. Second, *quasi* intervening rights are available where the claim in a patent is not substantially identical to the claim in its published application.

We agree with the approach of enacting *legal* intervening rights to protect a third party from "late claims" in a deferred patent application.[4] If the third party practices what is only later

[4] Harold C. Wegner among others, has advanced this idea. Mr. Wegner is a partner at Foley & Lardner and former director of the Intellectual Property Law Program at George Washington University Law School. Mr. Wegner offers compelling analysis of the USPTO backlog issue and how deferred examination can mitigate it. [Cite to paper, if possible.]

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claimed by the deferred patent applicant, then the third party retains a *legal* intervening right to practice that late-claimed invention. Rather than extending back to the patent's priority date, the patentee's monopoly would only extend back to the date that the late claim was added or amended.

Such *legal* intervening rights will not discourage applicants from using the deferral period, just as publication and *equitable* intervening rights have not discouraged applicants from filing patent applications or seeking reissue or reexamination.

No Extension of Patent Term

IBM's approach to deferred examination does not extend the inventor's patent monopoly. The act of deferring examination of a patent application would not enable the applicant to seek a patent term adjustment. As with other applications, the patent term would be 20 years from the priority date.

Faster Processing for Non-Deferred Applications

Deferred examination does not slow down an eager inventor. Deferred examination procedures are under the applicant's control. The applicant may request examination at any time. In fact, the availability of deferral will accelerate the examination of those applications that proceed to examination, since there will be fewer applications in the queue ahead of them.

New Business Opportunities for Patent Bar

We understand the concerns raised by members of the patent bar that some of their clients – particularly those outside of the United States who are already accustomed to deferring examination – may be quick to take advantage of deferring examination in the United States. Rather than fear lost income from applications that will be abandoned without examination, we believe that embracing deferred examination as a best practice in the best interests of the client can provide opportunities for new forms of client work. For example, the issuance of search reports before examination will require patent attorneys to review the cited art and counsel their clients on its impact. Moreover, clients will need guidance throughout the deferral period to choose the best times to proceed with the search, the examination, or to allow abandonment of a case. And clients will need guidance regarding the advisability of triggering examination of others' deferred applications.

Conclusion

Deferred examination is straightforward to implement. It is a best practice aimed at improving government efficiency by creating incentives for those in the best position to determine what work is important – patent applicants – to direct the government's resources at that work. It will save substantial USPTO resource, ease patent application pendency, and improve patent quality. All of these effects will enure to the benefit of the USPTO, patent applicants, and the public. The time has come to move beyond the patent-politics of the past, and adopt a balanced approach to deferred examination.

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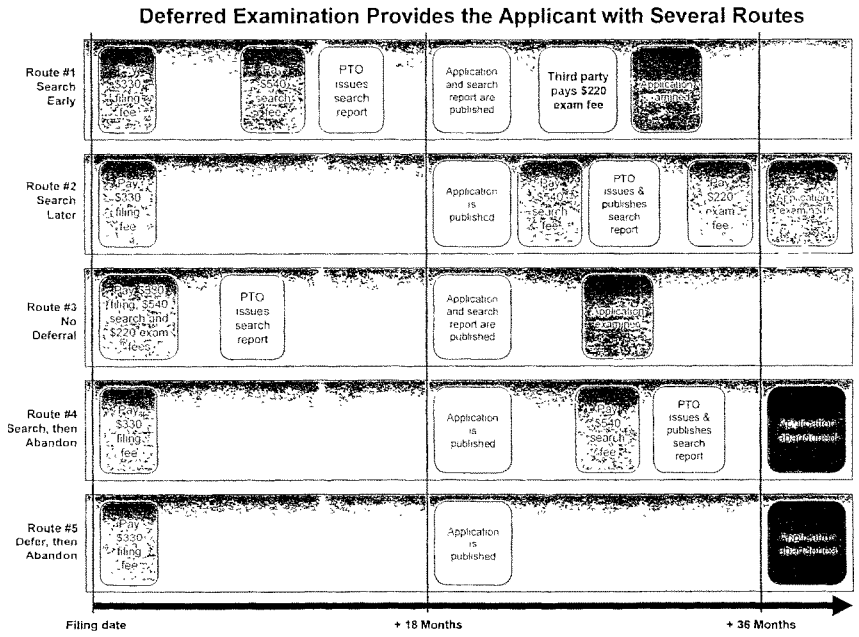

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Seeking a Balanced Approach to Inequitable Conduct Reform

Patents should be granted only for inventions that are new and nonobvious. The best way to achieve this goal is to ensure that examiners have access to the most pertinent prior art. Applicants' role in this effort is realized through the duty to disclose relevant information to the PTO. The inequitable conduct doctrine, in turn, is designed to enforce this duty, and more generally to ensure that applicants are candid in dealing with the PTO. Unfortunately, uncertainty in the scope and application of the doctrine has led to major concern on the part of patent applicants.

The defense of inequitable conduct is vastly overused. Uncertainty regarding its requirements provides anyone infringing a patent a potentially viable defense that could result in unenforceability of an entire patent family. An infringer who can not assert that the invention is unpatentable, or that he invented it first, or that he is not infringing, can nevertheless raise inequitable conduct as a defense and if successful, render all claims unenforceable against himself and any other infringer. Even if the defense fails, it is so easy to make the assertion that significant time, effort and cost are wasted. The resulting high frequency of assertion, and harsh consequences of success, have the confounding result of making applicants fear open communication with the USPTO during prosecution.

What the US patent system needs is a more balanced inequitable conduct doctrine, that encourages full disclosure and candor from applicants, but does not impose undue penalties for unintentional wrongs, and whose requirements are clear and easy to follow. We support a solution, proposed below, that would not substantially abolish or hamstring the inequitable conduct doctrine. We believe there should be strong consequences for those who intentionally mislead the PTO in order to secure a 20 year monopoly. Inequitable conduct is an important tool to ensure applicants and their representatives conduct themselves in front of the PTO with the highest level of candor. The proposal below is designed to achieve that goal, while at the same time bringing clarity and fairness to the doctrine, and reducing spurious charges by infringers.

Proposal:

1) Clarify, (perhaps by statute), that inequitable conduct must be established by "clear and convincing evidence".

2) Require evidence of intent separate, apart, and beyond the materiality of the information that was allegedly withheld or misrepresented. Relying on materiality as primary proof of intent is one of the root causes of overuse of the inequitable conduct defense, since it effectively collapses the two inquiries. Under current law, a patentee may be made subject to the severe consequences of a finding of inequitable conduct, including forfeiture of the ability to enforce a patent (and perhaps related patents) without separate proof of specific intent. Some lower level of mens rea is all that is required if the information is sufficiently material. Following the Federal Circuit's logic in Seagate, a standard such as "objective recklessness" could be set as the minimum requirement, to

be shown without reference to the materiality of the information alleged to be withheld or misrepresented.

2a) Those asserting the defense should be required to plead it with particularity (FRCP 9(b)) as would be required for common law fraud. [note from MU –CAFC recognizes IC as broader than fraud, but I would still suggest the rule 9(b) limitation]

3) Require the loser of the inequitable conduct defense to pay all costs *and fees* ?? of the other party for the entire litigation. This is financially harsh, but it will drive both the patentee and the alleged infringer to think very carefully about litigating all but the closest inequitable conduct issues.

3a) An alternative would be to require payment of fees attributable to the inequitable conduct defense. Another possible alternative would be to require payment of all or partial fees where the court determines that the inequitable conduct assertion was frivolous.

4) Establish a presumption, which must be overcome by the party asserting the inequitable conduct defense, that unless a claim has been found invalid/unpatentable based on the information alleged to have been intentionally withheld from or misrepresented to the PTO, there is no inequitable conduct. This point addresses the much-discussed "but-for" test, by using a presumption instead of a rigid rule. [Note that the test can also be balanced by giving the accused infringer the advantage of the presumption of intent in the case where the claim is found invalid/unpatentable over the un-disclosed information. MU – suggest deleting this last part. If inequitable conduct can result in unenforceability of the entire patent or a family, then this kind of "supermateriality" as to one claim is promoted to substitute for intent contrary to the above discussion about separating the inquiries]

5) Require that the defense of inequitable conduct cannot be plead until after validity and infringement have been determined. [MU – do you mean tried? Or is the idea here to wait for discovery as well? Seems burdensome]

6) Allow judges discretion in determining the penalty for inequitable conduct, from applying unenforceability to only those claim(s) to which the inequitable conduct applied to finding the whole patent or related patents unenforceable. Could also limit the penalty to requiring monetary damages in lieu of an injunction.

The optimal inequitable conduct doctrine is not one that patent holders would choose, or one that accused-infringers would choose, it is the one that is best for the public and the patent system. Finding this optimal doctrine implicates a delicate balancing process that is best pursued by adjusting a bit at a time until you achieve the sought-after equipoise. As such, it is likely most beneficial to implement one or two of the above changes, and measure over several years the impact on the inequitable conduct defense. Subsequent adjustments could then be made as needed.

The Role of the Courts

Aspects of inequitable conduct reform outlined above can readily be advanced through the courts: requiring independent evidence of intent; some aspects of cost/fee shifting; establishment and application of presumptions; and pleading order [order of addressing issues at trial?]. As to fee shifting, we would simply suggest more aggressive application of courts' existing power to impose fees on losing parties. Historically the courts have been very reluctant to assess fees against losers in patent litigation. But there is nothing preventing the courts from exercising the discretion currently available to them to do so. A positive example can be found in the recent Disney cell-phone camera case, where the court imposed sanctions against a patentee who asserted frivolous claims. We need courts to apply that same thinking in handling abusive claims of inequitable conduct.

The Role of the PTO

The PTO can and should play a role in addressing problems associated with inequitable conduct. The Office should add guidance in the MPEP and 37 CFR that it will presume that applicants are in compliance with the duty of disclosure, where applicants assist examiners by answering 105 requests and similar questions. A similar presumption could apply where applicants provide assistance above and beyond what is required, such as providing names of experts examiners can contact for additional information, or consent for their application to enter the Peer to Patent program that allows public review and comment. The PTO should train examiners to thank applicants on the record when applicants supply helpful information. If an applicant complied with such PTO requirements, or provided information beyond what was required, that could be persuasive to a jury and thus prevent an abusive inequitable conduct defense from succeeding or perhaps from being asserted at all. Also, the BOPA and reexamination/reissue examiners should be trained/instructed to comment positively in cases where applicants helpfully respond to Office requests. A patent that issues/reissues/gets a reexamination certificate with supportive Office comments in the record should be well-insulated against a spurious inequitable conduct charge. While we all know the PTO's regulations and statements in this regard are not binding on the courts, we believe they carry substantial weight in an area of PTO expertise like this one, and would do much to rebuild a respect-based relationship between the PTO and the applicant community.

Viewpoint March 28, 2007, 12:00AM EST text size: TT

It's Time for Patent Reform

Companies should focus on better ideas and work with Congress and the U.S. Patent & Trademark Office to fix the system

by David Kappos

If you follow the headlines, you may already know that the U.S. Supreme Court will rule shortly in a case that's likely to have big implications for everyone affected by patents. At issue in the case is whether an idea is too obvious to be patented. This may seem esoteric, but intellectual-property issues are striking closer to home for many people and point to the need for patent reform.

For instance, Research In Motion's (RIMM) BlackBerry service was in jeopardy of being shuttered last year until a patent dispute was settled out of court. A case involving Apple (AAPL) iPods was similarly settled. And with a record-setting award in a patent case involving MP3 files, it's safe to say that intellectual property now has the attention of many.

These types of issues and crises are finally being addressed by the Supreme Court, Congress, the U.S. Patent & Trademark Office (USPTO)—even the private sector.

Overprotection

To be successful, we need to restore a balanced approach that doesn't over- or under-protect the rights of patent holders. For instance, we currently overprotect by allowing patents on business methodologies that have no technical underpinnings. We publish patent applications, but then limit feedback that can be provided to the USPTO by experts from the public. This feedback could be invaluable in identifying cases where a patent may not be warranted.

The threat of lavish patent infringement awards can have a chilling effect, too. For example, patent award damages are often ratcheted up if the courts find the infringer to have intentionally ignored existing patent protections. So the system actually rewards those who haven't checked to see whether a patent already exists. Rules that lead companies to place blinders on their developers is a startling sign that patent law has lost touch with the concept of teaching the public about new inventions, which is, after all, the reason for granting patents.

Innovation Stifled

Then there's the matter of under-protecting patents. Even as the threat of penalty prompts some companies to rush the application process, some inventors may be slow to seek legal protection for ideas. That's because unlike other countries, the U.S. gives precedence to those who are first to invent, but not necessarily the first to file a patent application. That opens the door to disputes between a patent holder and a party that can argue it came up with the idea first—even if it hasn't yet applied for a patent.

Also, the sheer volume of patent filings makes it impossible for the USPTO to review patent applications in a timely fashion. All of this creates uncertainty, which is harmful to innovation and the economy.

And intellectual property is a big contributor to the economy: U.S. intellectual property is worth $5 trillion to $5.5 trillion, say economists Kevin Hassett and Robert Shapiro. That's more than the gross domestic product of any other country.

Congress Must Get Involved

Ned Davis Research found that 80% of the value of Standard & Poor's 500-stock index companies now comes from intangible value. And according to the U.S. Commerce Dept., American intellectual property comprises more than half of all U.S. exports, driving approximately 40% of the country's growth.

Given the stakes, it should be no surprise that the Supreme Court has accepted seven patent cases in the past two years—far more than in recent memory. The cases focus on issues involving shutting down suspected patent infringers, extending U.S. patent law overseas, and determining what kinds, and combinations, of ideas can be protected by patents.

But the courts merely interpret the legal equivalent of radiological charts; it is Congress that actually performs the surgery. And Congress does appear ready to operate, contemplating the most sweeping patent reforms in 50 years. Among other improvements, these reforms would require a systematic approach for assigning realistic values to infringed patents and provide a new way for parties to reassess a granted patent's validity without a lawsuit.

A Classic Arbitrage

While the USPTO is dependent on Congress to establish the patent laws, it has already started making internal improvements. This spring it is experimenting with a program that will enable expert volunteers, including those from IBM (IBM), to provide feedback to patent examiners on selected patent applications. Better and more efficient patent examination will improve patent quality by reducing the issuance of overbroad patents.

By bringing 21st-century knowhow to a 200-year-old institution, the USPTO is performing a classic arbitrage: pairing those who have expertise, motivation, and access to information with those who need it but lack the resources to generate it. The private sector is beginning to voluntarily help in other ways, too. For example, when IBM, the top holder of U.S. patents, seeks patents for business methods, it aims to do so only for those methods underpinned by deep technical content. Pure business methods can be difficult to examine and tempt some to seek patents of questionable merit.

A Role for Small Biz

IBM also is encouraging other patent practitioners to follow its lead with a sort of voluntary, corporate Hippocratic Oath that would institutionalize innovation-friendly patenting behavior. For instance, if more companies focused on ideas of higher technical quality, were transparent about which patents they owned or were applying for, helped review public patent filings, and permitted others to comment on their own pending patents, the likelihood of legal controversy would be reduced.

Small businesses also can play a role. There is a sense that for them, especially,

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the system has become too complex and expensive. Some smaller businesses have fallen prone to patent pawn shops, which buy patents cheap, only to resell or license those patents at disproportionate profits. If we are going to have meaningful patent reform, we need to give small businesses a voice. An online brainstorming forum this spring for small businesses might be a step in the right direction.

Consensus must underpin action. For while the Supreme Court can adjudicate, Congress legislate, and the USPTO and private sector innovate, we won't have broad progress until all parties work with one another, with the right balance, moderation, and the greater good at heart.

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IP Law and Business - Point Of View: We Must Stop The Race To The Bottom (Kappos Op-Ed)

IP Law and Business
1 April 2007
Point Of View: We Must Stop The Race To The Bottom; Column; The man in charge of managing IBM's intellectual property suggests that corporations need to police their own aggressive patent moves.
David Kappos
David Kappos is **IBM**'s vice president and assistant general counsel--intellectual property law.
We've reached a tipping point in grappling with our patent system. It's a system that now deals with a world in which ideas, numbers on a screen, slivers of silicon, or microscopic matter, can be more valuable than a factory, farm, or oil well.
In fact, ideas have become a competitive advantage, a currency of their own. U.S. intellectual property is worth $5–5.5 trillion, more than the gross domestic product of any other country, according to American Enterprise Institute economist Kevin Hassett and Clinton administration economist Robert Shapiro.
Given the stakes, it should be no surprise that in the last 18 months the U.S. Supreme Court has accepted more patent cases for review than in recent memory. Patent legislation is on the congressional agenda, too, with reforms being contemplated that could be the most sweeping in 50 years.
Why all the interest? Simple: Courts are clogged with patent infringement disputes of questionable merit, and untold millions are being spent on litigating and settling those cases in and out of court. The threat of litigation is frightening people away from participating in our innovation-based economy.
The impact of patent litigation is creeping closer to products and services near and dear to our hearts and wallets. For instance, if Research In Motion hadn't settled a lawsuit, a threatened shutdown of its BlackBerry text and phone service might have slowed commerce noticeably. And if Apple hadn't settled a suit over its iPods, there might have been a lot of grumpy people suffering symptoms of music withdrawal.
Of course, there are legitimate patent infringement claims. Patents are one way that individuals and enterprises are encouraged to invest in research and development. But with all the specious attacks, it's increasingly difficult to separate the good, the bad, and

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the ugly of patent litigation. What's more, due to the huge caseload of complex patent applications, it can now take three to five years for a patent to be approved.

That's why last year **International Business Machines** Corp. hosted a virtual conversation on the Web, in which 50 of the finest minds in industry, academia, government, technology and economics mulled over the patent crisis. This thoughtful, eight-week discussion showed that there was no panacea, but there are many actions that, collectively, can start to make a difference.

One of the many intriguing suggestions revolved around the notion of personal responsibility for behavior in acquiring patents—that private industry can do more than just wait for the Patent and Trademark Office (PTO) to improve the patent application process, for the courts to rule, or for Congress to legislate.

I believe it's time for a commitment above and beyond the PTO's Code of Professional Responsibility, which sets out only minimums of ethical behavior for those practicing before the PTO.

The rationale: As more companies involved in the creation, management, and sale of intellectual property take the pledge for a code of conduct, there will be calls for others to "certify" that they are behaving with integrity in their acquisition and handling of patents (a kind of self-service version of the Underwriters Laboratories and Good Housekeeping seals).

It's a little like holding the door open for someone, helping an athletic competitor in distress, or being extra courteous while driving. Goodwill begets goodwill.

The experts who discussed this issue in cyberspace concluded that in the intellectual property marketplace, good behavior frequently comes down to submitting "quality" patent applications. Among other things, that means due diligence to ensure that no one else has already patented your idea, and that your idea is not "obvious."

IBM will help the PTO in this regard, in pioneering a pilot program to begin this spring. Some of our engineers will review patent applications, and bring applicable prior art with explanatory comments to the attention of patent examiners. **IBM** will also allow the public to review and comment on many of our own patent applications. This level of review will help PTO examiners complete their work more effectively and expeditiously.

In addition, **IBM**, members of the open source community, and the PTO have been collaborating to improve the quality of patents—especially software patents—by making it easier for patent examiners and others to access electronically published source code and its related documentation. The source code and documentation are potential sources of prior art that can be used during the examination process. The project is known as the "Open Source as Prior Art."

As the recipient of the most U.S. patents for each of the past 14 years, **IBM** has the depth and skill to volunteer our efforts. But many others do, too, and should similarly offer their expertise.

When it comes to intellectual property, notions of "quality" are intertwined with transparency. This means that it should be clear who owns a patent application or patent. That may seem like a no-brainer, but some applicants and patentees intentionally conceal their ownership, or are vague about the scope of their patents, making it impossible for others to determine whether they might infringe. What if homeowners concealed their ownership records in the hopes of suing a trespasser? Not very neighborly.

Finally, quality patents should be limited to those with technical merit. To that end, **IBM**

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is reducing the number of patent applications it files that pertain to business methods, and will focus instead on inventions underpinned by compelling technical content. We encourage others to do the same.

The fact is that the intellectual property community can do better; it can take more responsibility for its actions. After all, the PTO doesn't submit applications of poor quality or employ questionable intellectual property practice—patent applicants and patent holders do. And neither Congress nor the judiciary can legislate or adjudicate innovation and ethics.

That starts with you and me.

David Kappos is **IBM**'s vice president and assistant general counsel–intellectual property law.

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A Technological Contribution Requirement for Patentable Subject Matter: Supreme Court Precedent and Policy

David J. Kappos, John R. Thomas & Randall J. Bluestone



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A Technological Contribution Requirement for Patentable Subject Matter: Supreme Court Precedent and Policy

By David J. Kappos,* John R. Thomas** & Randall J. Bluestone***

Throughout U.S. history, the constitutional and statutory standard for patent eligible subject matter has been sufficiently flexible to adapt to new technological innovations. For example, during the Industrial Revolution, the Supreme Court in *Cochrane v. Deener*[1] held that an improved method for manufacturing flour was patentable. At the dawn of the Information Age, the Supreme Court held that a claim directed to a chemical process which included a programmed digital computer was patentable,[2] and the Court's decision in *Diamond v. Chakrabarty*,[3] which approved the patenting of a new life form, a microbe capable of digesting petrochemicals, has been credited with advancing the modern era of biotechnology.

As a general matter, a robust notion of patentable subject matter best serves the United States in the twenty-first century. Within our innovation-driven economy, diverse industries have contributed numerous technical advances that are unquestionably suitable for patenting. The U.S. Patent and Trademark Office (USPTO) has, for example, appropriately awarded patents in the pharmaceutical, biotechnology, computer/electronics, biomedical, financial, mechanical and other important fields.

Since the Supreme Court last decided an issue of patent eligibility,[4] however, certain decisions of the Court of Appeals for the Federal Circuit have broadened the scope of subject matter deemed eligible for patenting, particularly in the area of business methods. Under the standard currently followed by the Federal Circuit, an invention is eligible for patenting if it merely achieves "a useful, concrete, and tangible result."[5] This lenient standard has converted the patent eligibility inquiry into an "end justifies the means" approach, resulting in patents arising from a diverse range of human behavior traditionally outside the realm of patent protection. Areas of endeavor deemed patentable under this lenient standard include, economic analyses,[6] artistic techniques,[7] athletic

* Vice President and Assistant General Counsel Intellectual Property Law, IBM. I acknowledge with gratitude the assistance of Paik Saber, Assistant General Counsel, Intellectual Property Law, IBM Asia Pacific, and Christopher A. Hughes, Partner Cadwalader, Wickersham & Taft LLP.

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[1] Cochrane v. Deener, 94 U.S. 780, 781, 791 (1877).

[2] Diamond v. Diehr, 450 U.S. 175, 191-93 (1981).

[3] Diamond v. Chakrabarty, 447 U.S. 303, 318 (1980).

[4] *Diehr*, 450 U.S. at 191-93.

[5] State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998).

[6] Method for Simultaneously Improving Educ., Econ., Ecological, Envtl., & Other Processes Vital to Comtys., U.S. Pat. No. 7,260,559 (filed Feb. 25, 2003).

[7] Painting Kit & Related Method, U.S. Pat. No. 6,213,778 (filed Dec. 14, 1999) (a method of painting a

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skills,[8] and abstract methods of doing business.[9] As one Federal Circuit jurist remarked, under that court's case law, "virtually anything is patentable."[10]

The Federal Circuit's permissive patentability standard stands at odds with the Constitution and the Supreme Court's consistent statements that an invention must contribute to the "Progress of [the] . . . useful Arts" in order to be eligible for patenting. In that constitutional context, patentable advances must be tied to a particular machine or apparatus, or alternatively, must reside in the physical transformation of an article to a "different state or thing."[11] Although a more recent Federal Circuit opinion has recognized that "the use of human intelligence in and of itself" is not patentable even where a practical result is achieved,[12] the Federal Circuit continues to hold that inventions that do not produce technologically useful results may be patented.[13] This standard fails to apply an important constraint upon the patent system without any doctrinal justification or alternative tempering principle.

This article makes the case that the technological contribution requirement for patentable subject matter should be restored. In Part I, this article reviews the extensive body of Supreme Court precedent governing patent eligibility. From this body of case law, we assert that the gravamen of the Supreme Court's precedent is that subject matter patentability is restricted to inventions that involve technological contributions, namely, tangible products or processes that are either (i) tied to a particular machine or apparatus or (ii) cause transformation or reduction of an article to a different state or thing, and in either instance produce technologically beneficial results.

Part II of this article considers conflicting developments at the Federal Circuit. In *State Street Bank*[14] and other opinions, the Federal Circuit has equated patentability to mere usefulness. This lenient "end justifies the means" standard renders all human endeavors subject to patenting. Although the recently issued panel decisions *In re Comiskey*[15] and *In re Nuijten*[16] have attempted to define some important restrictions upon the lenient patentability standard that was first articulated in *State Street Bank*, these decisions continue to allow patents to be granted on inventions that do not produce technologically useful results. Part II further explains how the Federal Circuit accomplished its shift in patent policy without any evidence suggesting that incentives are needed for innovation with respect to abstract business methods and other non-technological innovations, and without due consideration of the impact of such a shift upon the economy.

In Part III, this article asserts that the long-standing principles governing subject matter eligible for patenting should be maintained. Although no persuasive justification prompted the abrupt allowance, indeed explosion, of patents for business methods, the

surface using the posterior of an infant).

[8] Method of Putting, U.S. Pat. No. 5,616,089 (filed Mar. 29, 1996).

[9] Strategic Capability Networks, U.S. Pat. No. 6,249,768 (filed Oct. 29, 1998).

[10] Hughes Aircraft Co. v. United States, 148 F.3d 1385, 1385 (Fed. Cir. 1998) (Clevenger, J., dissenting) (citing *State St.*, 149 F.3d 1368).

[11] *See* Gottschalk v. Benson, 409 U.S. 63, 70-71 (1972).

[12] *In re* Comiskey, 499 F.3d 1365, 1378 (Fed. Cir. 2007).

[13] *Id* at 1379-80.

[14] State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368 (Fed Cir. 1998).

[15] *In re* Comiskey, 499 F.3d at 1365.

[16] *In re* Nuijten, 500 F.3d 1346 (Fed. Cir. 2007).

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breadth of coverage of such patents has raised important concerns. Among them are concerns that such patents are not restricted to a specific technological contribution, and therefore, may effectively appropriate all conceivable solutions to a particular problem. Such an overbroad monopoly thwarts progress of the useful arts by precluding legitimate attempts to design around a patent and by providing unjustified rewards beyond the contribution of the inventor. Part IV of this article concludes that, consistent with Supreme Court precedent on patent eligibility, a technological contribution should be required for subject matter patentability.

I. THE CONSTITUTION AND THE SUPREME COURT'S PRECEDENT ESTABLISH LIMITS UPON THE SUBJECT MATTER ELIGIBLE FOR PATENTING

A. Formative Principles

The Constitution speaks to the sorts of inventions that are appropriately patented. It provides:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.[17]

Historical context confirms that the Constitution restricts the scope of patent eligible subject matter. For example, the English Statute of Monopolies of 1623, upon which the U.S. patent system is largely based, provided an exception to the general prohibition against monopolies by granting a "privilege for the term of fourteen years or under [for] the sole working or making any manner of new manufactures . . . to the . . . inventor . . . ."[18] Notably, that Statute eliminated commercial practices from the scope of patentable exclusivity:

> [T]hose who formulated the Constitution were familiar with the long struggle over monopolies so prominent in English history, where exclusive rights to engage even in *ordinary business activities* were granted so frequently by the Crown for the financial benefits accruing to the Crown only. It was desired that in this country any Government grant of a monopoly for even a limited time should be *limited to those things which serve in the promotion of science and the useful arts*.[19]

Contemporaneous use of the term "useful arts" by the Founding Fathers further confirms that patent eligible subject matter was limited to technological or industrial innovations. The term "useful arts" was used in the context of the production of goods and the industrial, mechanical, and manual arts by a delegate to that Convention just days before

[17] U.S. CONST. art. I, § 8, cl. 8. *See also* THE FEDERALIST No. 43, at 294 (James Madison) (M. Walter Dunne ed., 1901) ("The right to useful inventions . . . belong[s] to the inventors.").

[18] Statute of Monopolies, 1623, 21 Jac. 1, c.3 (Eng.), *reprinted in* 9 DONALD S. CHISUM, CHISUM ON PATENTS, App. 8-3 (2005).

[19] *In re* Yuan, 188 F.2d 377, 380 (C.C.P.A. 1951) (emphasis added).

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the Constitutional Convention of 1787.[20] Likewise, Alexander Hamilton praised the patent system as a way of encouraging manufacturing industries and "[inventions] which relate to machinery" in the United States.[21]

Consistent with the constitutional foundation, the current patent statute, 35 U.S.C. § 101, provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Supreme Court has long held that the first three categories enumerated in § 101 — machines, manufactures and compositions of matter — refer to physical products. The Supreme Court has defined the term "machine" in § 101 to mean "a concrete thing, consisting of parts, or of certain devices and combination of devices."[22] The term "manufacture" in § 101 means "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery;"[23] and the phrase "composition of matter" has been defined to mean "all compositions of two or more substances and . . . all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids."[24]

The fourth § 101 category, "process", is defined in the patent statute as: "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."[25]

Although the meanings of the terms "process, art or method" are broad on their face, the Supreme Court's precedent "forecloses a purely literal reading of § 101."[26] In

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[20] The delegate gave examples of the "useful arts":

> Under all the disadvantages which have attended manufactures and *the useful arts*, it must afford the most comfortable reflection to every patriotic mind to observe their progress in the United States and particularly in Pennsylvania. . . . Permit me however to mention them under their general heads: meal of all kinds, ships and boats, malt and distilled liquors, potash, gunpowder, cordage, loaf-sugar, pasteboard, cards and paper of every kind, books in various languages, snuff, tobacco, starch, cannon, musquets, anchors, nails, and very many other articles of iron, bricks, tiles, potters ware, mill-stones, and other stone work, cabinet work, trunks and Windsor chairs, carriages and harness of all kinds . . . .

TENCH COXE, AN ADDRESS TO AN ASSEMBLY OF THE FRIENDS OF AMERICAN MANUFACTURES, 17-18 (Philadelphia, R. Aitkin & Son 1787) (emphasis added); *see also* JOSEPH BARNES, TREATISE ON THE JUSTICE, POLICY, AND UTILITY OF ESTABLISHING AN EFFECTUAL SYSTEM FOR PROMOTING THE PROGRESS OF USEFUL ARTS 4 (Francis Bailey 1792) (Patentable invention "consists in discoveries in science, and in the useful arts; by means of which agriculture, navigation, manufactures, and manual labor are, not only facilitated, but much promoted; and, indeed, to these they owe their present state of perfection.").

[21] ALEXANDER HAMILTON, THE REPORTS OF ALEXANDER HAMILTON: REPORT ON MANUFACTURES (Dec 5, 1791) 115-16, 175-76 (Jacob E. Cooke ed., Harper & Row 1964).

[22] Burr v. Duryee, 68 U.S. (1 Wall.) 531, 570 (1864).

[23] Diamond v. Chakrabarty, 447 U.S. 303, 308 (1980).

[24] *Id*

[25] 35 U.S.C. § 100(b) (2006).

[26] Parker v. Flook, 437 U.S. 584, 589 (1978); *see also* Diamond v. Diehr, 450 U.S. 175, 183 (1981) ("A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts,

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particular, the Supreme Court has consistently distinguished between concrete, specific and technologically-grounded aspects of innovative contributions, which are protectable via the patent system, from underlying abstract or general principles, which are not.

In an early landmark decision regarding patentable subject matter, *O'Reilly v. Morse*,[27] the Supreme Court revoked Morse's 8th claim, which recited:

> I do not propose to *limit myself to* the *specific machinery* or parts of machinery described in the foregoing specification and claims; *the essence of my invention being the use of* the motive power of the electric or galvanic current, which I call *electro-magnetism*, *however developed for marking or printing intelligible characters, signs, or letters, at any distances*, being a new application of that power of which I claim to be the first inventor or discoverer.[28]

The Supreme Court reasoned that the claim was "not warranted by law" because it would protect, and thereby prevent use of, all conceivable solutions to accomplish the recited result.[29]

> If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. . . . But yet if it is covered by this patent the inventor could not use it, nor the public have the benefit of it without the permission of this patentee.[30]

The Court explained that Morse was only entitled to a patent for the method of using electro-magnetism to print marks or signs at a distance that he actually invented: "he has not discovered that the electromagnetic current, used as a motive power, *in any other method, and with any other combination*, will do as well."[31]

Twenty years later, in *Rubber-Tip Pencil Co. v. Howard*,[32] the Supreme Court invalidated a claim reciting a rubber eraser having a hole to accept a pencil. The Court acknowledged that the idea of a pencil combined with a rubber eraser was a good one, but considered that its implementation so readily followed from the idea that it could not be patented. In striking down the patent, the Court explained that "an idea of itself is not patentable, but a new device by which it may be made practically useful is."[33]

O'Reilly and *Rubber-Tip Pencil* are bedrock cases for determining patent eligibility. Both opinions confirm that the patent system does not protect all types of processes nor does it protect abstract ideas. These cases also reinforce the important policy goal of maintaining "basic tools of scientific and technological work" within the

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performed upon the subject-matter to be transformed and reduced to a different state or thing.").

[27] O'Reilly v. Morse, 56 U.S. (15 How.) 62, 113 (1854).

[28] *Id* at 112 (emphasis added).

[29] *Id* at 113.

[30] *Id* at 112-13.

[31] *Id* at 117 (emphasis added).

[32] Rubber-Tip Pencil Co. v. Howard, 87 U.S. (20 Wall.) 498 (1874).

[33] *Id* at 507.

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public domain.[34] *O'Reilly* in particular makes it clear that process patents should not be allowed to appropriate all solutions to a problem. The Supreme Court has consistently applied the fundamental principles announced in *O'Reilly* and *Rubber-Tip Pencil* in the intervening years.

B. Modern Supreme Court Cases

Notably, in a trilogy of cases decided at the dawn of the Information Age, the Supreme Court considered computer-related inventions and confirmed its early precedent as applied to new fields of endeavor. In *Gottschalk v. Benson*,[35] the Court considered whether a claimed "method for converting binary-coded decimal (BCD) numerals into pure binary numerals" was eligible for patenting. The Court observed that the claimed method was not limited to any particular apparatus, context, or use. Rather, the claims "purported to cover any use of the claimed method in a general-purpose digital computer of any type."[36]

The *Gottschalk* Court concluded that the claimed method was not patentable.[37] Much as "one may not patent an idea," the Supreme Court explained, one may not patent the "formula for converting BCD numerals to pure binary numerals."[38] Observing that "the mathematical formula involved here has no substantial practical application except in connection with a digital computer," the Court explained that an issued patent including the claims-at-issue "would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself."[39] In reaching its decision, the Supreme Court acknowledged that the "[t]ransformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines."[40]

Parker v. Flook, the second case, involved claims drawn to a method for computing an "alarm limit" on any process variable involved in the catalytic chemical conversion of hydrocarbons.[41] When a process variable, such as temperature, pressure, or flow rate, exceeded a predetermined "alarm limit," an alarm signaled "an abnormal condition indicating either inefficiency or perhaps danger."[42] The only difference between the claimed method and conventional methods was the mathematical algorithm or formula used to calculate the alarm limit.[43]

The Supreme Court held that the claim was ineligible for patenting because it simply provided a formula for computing an updated alarm limit.[44] The application did not explain how to "select the appropriate margin of safety, the weighing factor, or any

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[34] *See* Gottschalk v. Benson, 409 U.S. 63, 67 (1972).
[35] *Id.* at 64.
[36] *Id.*
[37] *Id.* at 71-73.
[38] *Id.* at 71.
[39] *Id.* at 71-72.
[40] Gottschalk v. Benson, 409 U.S. 63, 70 (1972). *See, e.g.*, Expanded Metal Co. v. Bradford, 214 U.S. 366, 385-86 (1909) (sustaining a patent on a process for expanding metal that involved mechanical operations).
[41] Parker v. Flook, 437 U.S. 584, 585 (1978).
[42] *Id.*
[43] *Id.* at 585-86.
[44] *Id.* at 594-96.

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other variables. . . . Nor [did] it . . . contain any disclosure relating to the chemical processes at work, the monitoring of process variables, or the means of setting off an alarm or adjusting an alarm system."[45]

In accordance with the *Gottschalk* decision, the Supreme Court in *Parker* confirmed that a process does not automatically fall within the patentable subject matter of § 101 merely because a process implements a principle or mathematical formula in some specific fashion.[46] To permit otherwise "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."[47] Justice Stevens took pains to note that the "rule that the discovery of a law of nature cannot be patented rests, not on the notion that natural phenomena are not processes, but rather on the more fundamental understanding that they are not the kind of 'discoveries' that the statute was enacted to protect."[48] Justice Stevens further explained that an inventive application of a mathematical formula, principle or phenomenon of nature may be patented, but only if "there is some other inventive concept in its application."[49]

The Court further explained that "post-solution activity" — the adjustment of the alarm limit to the figure computed according to the formula — cannot "transform an unpatentable principle into a patentable process."[50] Justice Stevens appreciated that a skilled patent drafter could "attach some form of post-solution activity to almost any mathematical formula."[51] Yet "the concept of patentable subject matter under § 101 is not 'like a nose of wax which may be turned and twisted in any direction . . . .'"[52]

In the last case, *Diamond v. Diehr*, the invention was "a process for molding raw, uncured synthetic rubber into cured precision products."[53] According to the patent, the industry had been unable "to obtain uniformly accurate cures because the temperature of the molding press could not be precisely measured, thus making it difficult to . . . determine cure time."[54] To overcome this problem, the method required, among other things, constantly measuring the actual temperature inside the mold and then automatically feeding the temperature measurements into a computer that would repeatedly recalculate the cure time by use of a well-known equation.[55]

The Supreme Court held the claims to be patentable because "a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter."[56] Here, the "claims were not directed to a mathematical algorithm or an improved method of calculation but rather recited an improved process for molding rubber articles by solving a practical problem which had

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[45] *Id* at 586.
[46] *Id* at 593.
[47] Parker v. Flook, 437 U.S. 584, 593 (1978).
[48] *Id.*
[49] *Id* at 594.
[50] *Id* at 590.
[51] *Id.*
[52] *Id* (quoting White v. Dunbar, 119 U.S. 47, 51 (1886)).
[53] Diamond v. Diehr, 450 U.S. 175, 177 (1981).
[54] *Id* at 178.
[55] *Id*
[56] *Id* at 184.

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arisen in the molding of rubber products."[57] Justice Rehnquist appreciated that "[i]ndustrial processes such as this [sic] are the types which have historically been eligible to receive the protection of our patent laws."[58]

The Supreme Court further stated that "a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program, or digital computer."[59] Rather, "when a claim containing a mathematical formula implements or applies that formula in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect (*e.g.*, transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of § 101."[60] On the other hand, "laws of nature, natural phenomena, and abstract ideas" are excluded from patent protection.[61] Scientific truths, or the mathematical expression of them, are similarly outside the patent system, but "a novel and useful structure created with the aid of knowledge of scientific truth may be [patentable]."[62]

In these and other relevant patent cases, the Supreme Court has developed several cogent principles that constrain subject matter patentability:

(1) "Excluded from . . . patent protection are laws of nature, natural phenomena, and abstract ideas."[63]
(2) "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." [64]
(3) One may not patent an idea.[65]
(4) "Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work."[66]
(5) Mathematical algorithms are not patentable.[67]
(6) One cannot patent all solutions to a problem.[68]
(7) "It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself."[69]
(8) Insignificant post-solution activity or limiting an abstract idea to one technological environment will not render an abstract idea patentable.[70]

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[57] *Id.* at 181.
[58] *Id* at 184.
[59] Diamond v. Diehr, 450 U.S. 175, 187 (1981).
[60] *Id* at 192.
[61] *Id* at 185.
[62] *Id.* at 188 (quoting Mackay Radio & Telegraph Co. v. Radio Corp of Am., 306 U.S. 86, 94 (1939)).
[63] *Id.* at 185.
[64] Le Roy v. Tatham, 55 U.S. (14 How.) 156, 175 (1852).
[65] Gottschalk v. Benson, 409 U.S. 63, 67 (1972) (quoting Rubber-Tip Pencil Co. v. Howard, 87 U.S. (20 Wall.) 498, 507 (1874)).
[66] *Id*
[67] *See* Diamond v. Diehr, 450 U.S. 175, 186 (1981); Parker v. Flook, 437 U.S. 584, 586 (1978); *Gottschalk*, 409 U.S. at 71-72.
[68] *See* O'Reilly v. Morse, 56 U.S. (15 How.) 62, 113 (1853).
[69] *Diehr*, 450 U.S. at 182 n.7 (quoting Corning v. Burden, 56 U.S. (15 How.) 252, 267-68 (1853)).

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> (9) "A claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, but *never the function or result* of either, nor the scientific explanation of their operation."[71]

Although the Supreme Court has not addressed the issue of patent eligibility in a generation, its grant of certiorari in *Laboratory Corp. of America v. Metabolite Labs., Inc.* potentially suggests its renewed interest.[72] Given that the Federal Circuit decision under review included no discussion of § 101 whatsoever,[73] *LabCorp* was a rather unlikely candidate for discussion of the statutory subject matter issue. Ultimately this deficiency contributed to the Supreme Court's disposition of the case by dismissing the writ of certiorari as improvidently granted just three months later.[74]

Metabolite Laboratories is the proprietor of U.S. Patent No. 4,940,658 ('658 patent), which is directed to a method for detecting cobalamin or folate deficiency. Deficiencies in these vitamins can cause serious illness, but are readily treated via supplements. Claim 13 of the '658 patent recites:

> 13. A method of detecting a deficiency of cobalamin or folate in warm-blooded animals comprising the steps of:
>
> assaying a body fluid for an elevated level of total homocysteine; and
>
> correlating an elevated level of total homocysteine in said body fluid with a deficiency of cobalamin or folate.[75]

It should be appreciated that physicians have long tested blood for levels of homocysteine. The patentable advance of the '658 patent concerns the second, "correlating" step of claim 13. Arguably, this step merely claims the scientific discovery that elevated levels of homocysteine in the blood tend to demonstrate a deficiency in cobalamin or folate.

Metabolite brought suit against LabCorp for infringement of the '658 patent. Metabolite ultimately prevailed, obtaining over two million dollars in damages. On appeal, the Federal Circuit affirmed the judgment of infringement, in part upholding the '658 patent over LabCorp's assertions of its failure to satisfy the anticipation, obviousness, definiteness, written description, and enablement requirements.[76] The issue of statutory subject matter was not discussed in any respect within the court of appeals opinion.

In late 2004, LabCorp petitioned the Supreme Court for a writ of certiorari.[77] The Supreme Court responded by requesting the government to file a brief on one of the questions posed by LabCorp. As the Supreme Court framed the question:

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[70] *See Diehr*, 450 U.S. at 191-92; *Parker*, 437 U.S. at 590.

[71] Markman v. Westview Instruments, Inc., 517 U.S. 370, 373 (1996) (emphasis added).

[72] Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354 (Fed. Cir. 2004), *cert. granted*, 546 U.S. 975 (2005), *and cert dismissed*, 126 U.S. 2921 (2006).

[73] Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F 3d 1354 (Fed. Cir. 2004).

[74] Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc., 126 S.Ct. 2921 (2006).

[75] *Id.* at 2924.

[76] Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1365-69 (Fed. Cir. 2004).

[77] Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354 (Fed. Cir. 2004), *petition for*

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> Respondent's patent claims a method for detecting a form of vitamin B deficiency, which focuses upon a correlation in the human body between elevated levels of certain amino acids and deficient levels of vitamin B. The method consists of the following: First, measure the level of the relevant amino acids using any device, whether the device is, or is not patented; second, notice whether the amino acid level is elevated and, if so, conclude that a vitamin B deficiency exists. Is the patent invalid because one cannot patent "laws of nature, natural phenomenon, and abstract ideas?"[78]

The Supreme Court subsequently granted certiorari notwithstanding the government's conclusion the Court should decline to review the case. Certiorari was granted with respect to the following question:

> Whether a method patent setting forth an indefinite, undescribed, and non-enabling step directing a party to "correlat[e]" results can validly claim a monopoly over a basic scientific relationship used in medical treatment such that any doctor necessarily infringes the patent merely by thinking about the relationship after looking at a test result.[79]

Although the Supreme Court presided over oral argument in the case, it ultimately denied the writ of certiorari as improvidently granted.[80] The strongly worded dissenting opinion of Justice Breyer (joined by Justices Stevens and Souter) remains of significance, however.[81] These three Justices not only believed that the claimed invention was unpatentable because it recited a phenomenon of nature. They additionally found it an easy case, no matter what the precise scope of the "phenomenon of nature" doctrine. Three Justices is, of course, just one short of the number needed to grant certiorari, and just two short of a majority of the Court. In view of the Court's renewed interest in the patent system, an appropriate case may well provoke a grant of certiorari on statutory subject matter in coming Terms.

C. The Technological Contribution Standard

A comprehensive understanding of subject matter patentability can be deduced directly from the Supreme Court's precedent. More specifically, patentable subject matter is restricted to inventions that involve technological contributions — namely, tangible products or processes that either (i) are tied to a particular machine or apparatus or (ii) cause transformation or reduction of an article to a different state or thing, and in either instance, produce technologically beneficial results. The long-standing principles governing subject matter eligible for patenting should be maintained such that, for example, a method of painting a surface using the posterior of an infant (U.S. Pat. No. 6,213,778) and a method for making jury selection determinations (U.S. Pat. No.

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cert filed, 2004 U.S. Briefs 607, (U.S. Nov. 3, 2004) (No. 04-607).

[78] Lab. Corp. of Am. Holdings v. Metabolite Labs , Inc., 543 U.S. 1185 (2005).

[79] Lab. Corp of Am. Holdings v. Metabolite Labs., Inc., 546 U.S. 975 (2005).

[80] Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc., 126 S.Ct. 2921 (2006).

[81] *Id*

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6,607,389) are not patentable subject matter because they do not produce technologically-beneficial results.

In summarizing the Supreme Court's existing standard, we recognize that the Court has used language suggesting that it may not be a definitive rule, but rather more akin to a presumption.[82] In the intervening years, however, no situation has been presented to the Supreme Court to justify an exception to this standard. This test sets forth a reasonable and balanced standard for subject matter eligibility.

The requirement for technological contribution is also consistent with numerous cases of the Supreme Court, referring to patents as properly directed toward "technology" and "technological growth and industrial innovation."[83] We have not found any cases from the Supreme Court that are inconsistent with the technological contribution requirement. Until recent years, lower courts had also recognized that patenting was confined to the "technological arts," a modern term recognized as synonymous with the phrase "useful arts" as it appears in the Constitution.[84]

This test is rooted in the constitutional requirement that patents are granted to promote the progress of useful arts. In historical context, the useful arts required a technological contribution. Supreme Court precedent reinforces the need for a technological contribution for patent eligibility. A fair reading of controlling Supreme Court cases in the aggregate provides the foundation for the standard that a claim to a process or method is not patentable unless it either (i) is tied to a particular machine or apparatus or (ii) causes transformation or reduction of an article to a different state or thing, and in either instance produces technologically beneficial results.

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[82] The *Gottschalk* Court stated:

> It is argued that a process patent *must* either be tied to a particular machine or apparatus or *must* operate to change articles or materials to a 'different state or thing.' We do not hold that no process could ever qualify if it did not meet the requirements of our prior precedents.

Gottschalk v. Benson, 409 U.S 63, 71 (1972) (emphasis added). However, the Supreme Court has not undertaken to define circumstances where a process outside its precedent would qualify for patent protection.

[83] *See, e g* , Pfaff v. Wells, 525 U.S. 55, 63 (1998) ("[T]he patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in *technology*, in return for an exclusive monopoly for a limited period of time.") (emphasis added); Markman v. Westview Instruments, Inc., 517 U.S. 370, 390 (1996) ("Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases, H.R. Rep. No. 97-312, pp. 20-23 (1981), observing that increased uniformity would 'strengthen the United States patent system in such a way as to foster *technological growth and industrial innovation.*'") (emphasis added); Bonito Boats v. Thunder Craft Boats, Inc., 489 U.S. 141, 150-51 (1989) (same); Diamond v. Diehr, 450 U.S. 175, 184 (1981) ("*Industrial processes* . . have historically been eligible to receive the protection of our patent laws.") (emphasis added); *Gottschalk*, 409 U.S. at 64 ("The claims were not limited to any particular art or *technology*, to any particular apparatus or machinery, or to any particular end use.") (emphasis added).

[84] *See* Diamond v. Chakrabarty, 447 U.S. 303 (1980); *In re* Bergy, 596 F.2d 952, 959 (C.C.P.A. 1979) ("We have previously pointed out that the present day equivalent of the term 'useful arts' employed by the Founding Fathers is '*technological arts.*'") (emphasis added), *aff'd sub nom., In re* Waldbaum, 457 F.2d 997, 1003 (C.C.P.A. 1979); *In re* Musgrave, 431 F 2d 882, 893 (C.C.P.A. 1970) ("All that is necessary, in our view, to make a sequence of operational steps a statutory 'process' within 35 U.S.C § 101 is that it be in the *technological arts* so as to be in consonance with the Constitutional purpose to promote the progress of 'useful arts.'") (emphasis added).

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II. Federal Circuit Decisions Have Applied an Unjustifiably Expansive Patent Eligibility Standard

A specific, and particularly troubling, arena where Federal Circuit rulings diverge from the Supreme Court's precedent is the eligibility of business methods for patenting. Historically, methods of doing business were not patentable subject matter and the 1952 Patent Act did not change this principle.[85] "Although the term 'process' was not added to 35 U.S.C. § 101 until 1952, a process [as shaped by the Supreme Court's precedent] has historically enjoyed patent protection because it was considered a form of 'art' as that term was used in the 1793 Act."[86] In an oft-quoted comment, Judge Rich explained that:

> Section 101, entitled "Inventions patentable," enumerates the categories of inventions subject to patenting. Of course, not every kind of an invention can be patented. Invaluable though it may be to individuals, the public, and national defense, the invention of a more effective organization of the materials in, and the techniques of teaching a course in physics, chemistry, or Russian is not a patentable invention because it is outside of the enumerated [statutory] categorie . . . . Also outside that group is one of the greatest inventions of our times, the diaper service.[87]

The dicta in the Federal Circuit decision in *State Street*, however, created a dramatic sea-change in the patentability of inchoate business methods. *State Street* involved a patent generally directed to a data processing system for implementing an investment structure that was developed for use in Signature's business as an administrator and accounting agent for mutual funds.[88] The district court invalidated the

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[85] *See, e g.*, Seagram & Sons, Inc. v. Marzall, 180 F.2d 26, 27-28 (D.C Cir. 1950) (method for testing beverages and like products to make advance determination of (Cont'd) consumer reactions and preferences not "new and useful art, machine, manufacture, or any new and useful improvements thereof"), Loew's Drive-in Theatres, Inc. v. Park-In Theatres, Inc., 174 F.2d 547, 553 (1st Cir. 1949) (patent claiming arranging automobiles such that occupants would have an unobstructed view of a screen or stage did "not involve an exercise of the faculty of invention"); Hotel Security Checking Co. v. Lorraine Co., 160 F. 467, 469-72 (2d Cir. 1908) ("cash-registering and account-checking" unpatentable "system of transacting business disconnected from the means for carrying out the system . . . ."); *In re* Patton, 127 F.2d 324, 327-28 (C.C P.A. 1942) (system of fighting fires using standardized and interchangeable firefighting equipment not patentable subject matter; "a system of transacting business, apart from the means for carrying out such system, is not within . . . [the patent statute] . . . nor is an abstract idea or theory, regardless of its importance or the ingenuity with which it was conceived, apart from the means for carrying such idea or theory into effect, patentable subject matter."); *In re* Wait, 73 F.2d 982, 982-83 (C.C.P.A. 1934) (method of buying and selling stocks, wherein one party advertised offer, another party accepted offer and such transaction was recorded, constituted unpatentable method of doing business); *In re* Sterling, 70 F.2d 910, 911-12 (C.C.P.A. 1934) (patent application directed to a particular arrangement of printed matter on bank checks and stubs not patentable subject matter); *Ex Parte* Turner, 1894 Dec. Comm'r Pat. 36, 36-37 (method to secure reading of advertisements not patentable because, *inter alia*, process carried no physical effect; "a plan or theory of action which, if carried into practice, could produce no physical results proceeding direct from the operation of the theory or plan itself is not an art within the meaning of the patent laws."); *Ex Parte* Abraham, 1869 Dec. Comm'r Pat. 59 (method for detecting and preventing tax evasion by employing stamps to be severed upon attachment to an article unpatentable; "[i]t is contrary . . to the spirit of the law . . . to grant patents for methods of book-keeping . . . .").

[86] *Diehr*, 450 U.S. at 182 (citing Corning v. Burden, 15 How. 267-68, 252, 14 L.Ed. 683 (1854)).

[87] Giles S. Rich, *Principles of Patentability*, 28 GEO. WASH. L. REV. 393, 393-94 (1960). Judge Rich was one of the principal drafters of the 1952 Patent Act as well as a Judge of the Court of Customs and Patent Appeals and the Court of Appeals for the Federal Circuit from 1957 to 1999.

[88] State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1370 (Fed Cir. 1998).

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patent for failure to claim statutory subject matter under § 101.[89] The Federal Circuit reversed the district court, ruling that the claims were directed to patentable subject matter because they produced a "useful, concrete and tangible result":[90]

> [T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result" — a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.[91]

Furthermore, although *State Street* quotes from *Diehr* that "anything under the sun made by man is patentable," that quote was taken out of context.[92] Congressional reports employed that phrase only with respect to machines and manufactures.[93] Certainly, § 101 does not say "anything under the sun made by man" is patentable subject matter, but rather references four specific categories.

While the Federal Circuit's holding in *State Street* regarding the claim at issue can be justified, we believe that dicta in the decision ignited the explosion of non-technological business method patents seen today. The Federal Circuit concluded that the claim was drawn to a system, not a method of doing business, and it included a number of structural elements as limitations — thus, the claimed invention was a machine that implemented a process. However, the expansive dicta in *State Street* are inconsistent with the Supreme Court's precedent.[94]

Acquiescing to the demands of patent applicants and responding to the *State Street* dicta, the USPTO dramatically changed course. Thus, for example, the USPTO promulgated "interim guidelines" stating that an invention need not lie within the "technological arts" to be patented.[95] Issued patents from such diverse areas as architecture, athletics, insurance, painting, psychology, and the law itself, reveal just how far afield the patent system has gone in granting patents in virtually any area of human endeavor, such as teaching a golf putting stroke or a method for lifting a box.[96]

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[89] *Id.*

[90] *Id.* at 1375.

[91] *Id.* at 1373

[92] *Id*

[93] *See* S. REP NO. 82-1979, at 2399 (1952) ("A person may have 'invented' a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled."); H.R. REP NO. 82-1923 (1952) (same).

[94] *See, e.g., State Street,* 149 F.3d at 1375 ("We take this opportunity to lay this ill-conceived exception [i.e., that business methods are not patentable] to rest.").

[95] *Official Gazette of the U S. Pat. & Trademark Off*, 1300 O.G. 142, No. 4 (Nov. 22, 2005). In reaction to the sweeping impact of *State Street*, Congress passed the First Inventor Defense Act of 1999, i.e., 35 U.S.C. § 273, to provide a defense to infringement of a business method patent if the accused infringer "had, acting in good faith, actually reduced the subject matter to practice at least 1 year before the effective filing date of such patent, and commercially used the subject matter before the effective filing date of such patent." First Inventor Defense Act of 1999, Pub. L. No. 106-113, 113 Stat. 1536 (codified as amended at 35 U S.C. § 273 (2000)) Beyond that limited purpose, there is nothing in the legislative history to suggest Congress intended to make any other changes to the United States patent laws. Thus, the Supreme Court's precedent on section 101 patent eligibility for business methods — as articulated in the *Gottschalk-Parker-Diehr* trilogy — remains the controlling standard.

[96] *See, e.g.*, Method For Demonstrating a Lifting Technique, U.S. Patent No. 5,498,162 (filed Sept. 6,

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In the context of business methods, the broad dicta in *State Street* reduced the historically separate subject matter requirement of § 101 to a mere "practical utility" determination.[97] The contrast in approach is clearly evident from the Supreme Court's precedent. In *Parker v. Flook*, for example, the case turned "entirely on the proper construction of § 101 of the Patent Act, which describes the subject matter that is eligible for patent protection."[98] Whether subject matter is eligible for patenting is an entirely separate inquiry from whether the claimed invention provides some useful result, i.e., whether it meets the separate utility requirement of § 101.[99]

No decision of the Supreme Court supports the broad proposition that merely because a method yields a useful result it should *ipso facto* be eligible for patenting. Rather, the Supreme Court has recognized that the utility requirement of 35 U.S.C. § 101 is a distinct and separate test from the eligibility requirement of § 101. A mere "useful result" standard is much too lenient to determine whether subject matter is eligible for patenting. As Judge Rich so aptly stated decades ago, the diaper service (prior to the advent of disposable diapers) was undoubtedly one of the greatest business creations in its day, invaluable to countless individuals. However, despite its usefulness, the diaper service does not fall within one of the four enumerated categories of § 101.[100]

In his dissent from the Supreme Court's dismissal of the writ of certiorari in *Metabolite* as improvidently granted,[101] Justice Breyer recognized as much. Identifying this inconsistency between the Court's precedent and that of the Federal Circuit, Justice Breyer explained that the Supreme Court had never equated patentable subject matter with mere utility. He further identified three cases where the Court held a claimed invention to constitute unpatentable subject matter despite the fact it had achieved a useful, concrete, and tangible result.[102]

Although only two Justices joined with Justice Breyer in his dissenting opinion, his observations had no direct impact upon the law of patent eligibility. They appear to have been keenly felt nonetheless. Possibly influenced by Justice Breyer's dissent from the dismissal of certiorari in *Metabolite*, the Federal Circuit recently issued two decisions that revisited, and essentially revised, the holding of *State Street*. In *In re Nuijten*,[103] and *In re Comiskey*,[104] the Federal Circuit imposed restrictions on the broad scope of patentable subject matter it first announced in *State Street*.

1994), Method and Apparatus for Improving Putting Skill, U.S. Patent No. 6,447,403 (filed Sept. 11, 2000), Methods of Exchanging an Obligation, U.S. Patent No. 6,912,510 (filed May 9, 2000), Character Assessment Method, U.S. Patent No. 5,190,458 (filed Apr. 17, 1991), *and* Method and Apparatus For Funding Education By Acquiring Shares of Students Future Earnings, U.S. Patent No. 5,809,484 (filed May 24, 1995).

[97] *State Street*, 149 F.3d at 1375 ("The question of whether a claim encompasses *statutory subject matter should* not *focus on* which of the four categories of subject matter a claim is directed to — process, machine, manufacture, or composition of matter — but rather on the essential characteristics of the subject matter, in particular, its *practical utility*.") (emphasis added).

[98] Parker v. Flook, 437 U.S. 584, 588 (1978).

[99] *See id*

[100] *See* Rich, *supra* note 87, at 393.

[101] Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc., 126 S.Ct. 2921 (2006).

[102] Justice Breyer identified *O'Reilly v. Morse*, *Gottshalk v. Benson*, and *Parker v. Flook* as involving claimed inventions that achieved useful, concrete, and tangible results that nonetheless were held not to be patentable subject matter.

[103] *In re* Nuijten, 500 F.3d 1346 (Fed. Cir. 2007).

[104] *In re* Comiskey, 499 F.3d 1365 (Fed. Cir. 2007).

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In *In re Nuitjen*,[105] the Court of Appeals concluded that claims directed toward transitory electrical and electromagnetic signals propagated through a medium were not encompassed with any of the categories of statutory subject matter. Judge Gajarsa took pains to note that *State Street* should not be read to hold that the four subject matter categories were "rendered irrelevant, non-limiting, or subsumed into an overarching question about patentable utility."[106] According to *Nuitjen*, the statutory subject matter inquiry required a careful review into whether the claimed invention could be fairly identified as a process, machine, manufacture, or composition of matter.[107] If the claimed invention did not fall into at least one of those categories, it was not patentable, whether or not it achieved a useful result.

In a second opinion, *In re Comiskey*,[108] the Federal Circuit ruled that claims directed solely towards a "method for mandatory arbitration resolution regarding one or more unilateral documents" also did not comprise patentable subject matter. Upon reviewing the Supreme Court opinions, Judge Dyk reasoned that the prohibition against patenting abstract ideas incorporated two aspects.[109] First, he explained, abstract ideas that lack a practical application are unpatentable. Even if an abstract idea may be put to practical use, however, the idea may only be patented if "it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter."[110] The Federal Circuit concluded that controlling precedent held "that the application of human intelligence to solve practical problems is not in and of itself patentable."[111]

Applying these standards to the case before it, the *Comiskey* court held that claims directed towards the "mental process of resolving a legal dispute between two parties by the decision of a human arbitrator" were not patentable. Because such claims sought to patent the "use of human intelligence in and of itself," they were held to be unpatentable.[112] However, the Federal Circuit determined that other claims calling for a computer implementation of the arbitration method were considered patentable subject matter. According to the Federal Circuit, "these claims in combining the use of machines with a mental process, claim patentable subject matter."[113] As a result, the Court of Appeals remanded the matter to the USPTO to determine whether the computer-implemented claims would have been obvious.

Nuijten and *Comiskey* took steps towards reconciling Federal Circuit standards with controlling Supreme Court precedent. In our view, however, these two decisions do not fully reconcile the case law of the Court of Appeals with that of the Supreme Court. In particular, the Federal Circuit still considers computer-implemented methods to constitute patentable subject matter, no matter what the nature of the method or the outcome it achieves. We know of no Supreme Court opinion that allows patents to issue on computer-implemented methods where essential features of a claimed invention are not

[105] *In re* Nuijten, 500 F.3d at 1369.
[106] *Id.* at 1354.
[107] *Id.*
[108] *In re* Comiskey, 499 F.3d at 1381.
[109] *Id.* at 1376.
[110] *Id.*
[111] *Id.* at 1378.
[112] *Id.* at 1379.
[113] *Id.* at 1380.

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technological. In particular, the Court's latest statement concerning patentable subject matter, *Diamond v. Diehr*, emphasized that the claimed mathematical algorithm was put to use in curing rubber, an industrial process that had long been subject to patenting.[114] This invention could not contrast more strongly with the invention in *Comiskey*, where the claimed method resulted in the resolution of legal disputes.

The distinction between *Diehr* and *Comiskey* is significant. Given the ubiquity of computers and other enabling technologies in modern life, a rule by which unpatentable subject matter is transformed into a patentable invention by coupling it with a machine significantly dilutes the practical import of statutory subject matter limitations within the patent law. Under the *Comiskey* rule, the patent drafter need merely claim an invention in terms of a "system" or "machine" for accomplishing a particular method. The *Comiskey* rule is one of mere formality, for such drafting techniques qualify otherwise unpatentable methods as statutory subject matter, yet place few practical limitations upon the scope of the claims. In such a world, the policy rationales supporting limits on the scope of patentable subject matter are poorly served.

It is easy to imagine, for example, patents upon all manner of artistic methods implemented using computers or cameras, or even painting or sculpting clay. The results of such aesthetic methods have long been the subject of protection via copyright, rather than patents. They are traditionally classified as fine, rather than useful arts, and they are not amenable to the objective analyses that patenting standards such as novelty, nonobviousness, enablement, and claim definiteness require.[115] In addition, the performance of such aesthetic methods relies upon human judgment rather than being repeatable in an industrial sense. The scope of protection of such patents also raises significant concerns. The enclosure of an entirely new art movement — such as cubism, impressionism, or even expressionism — through patenting seems entirely possible, for if such a movement can be articulated in words, it may be captured in a patent claim. Under the *Comiskey* rule, such aesthetic methods nonetheless can qualify as patent eligible subject matter if their claims call for the nominal use of a machine, manufacture, or composition of matter.

Despite these shortcomings, *Nuijten* and *Comiskey* do take steps towards reviving patent eligibility principles which restore boundaries upon the scope of patent eligible subject matter to maintain both incentives to innovate and the ability to compete, and ultimately provide a sound balance between proprietary rights and preservation of the public domain. Movements at the Federal Circuit have also been reflected at the USPTO where a number of decisions of the Board of Patent Appeals and Interferences have affirmed rejections based on non-statutory subject matter, including a method of hedging commodity consumption risk costs,[116] a method of bringing new "startup" products to market,[117] and a method of evaluating an intangible asset.[118] As these decisions are appealed to the Federal Circuit, and perhaps ultimately subject to consideration by the

[114] Diamond v. Diehr, 450 U.S. 175 (1981).

[115] *See* Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342 (Fed. Cir. 2005) (concluding that the claim limitation "aesthetically pleasing" was indefinite).

[116] *Ex parte* Bilski, No. 2002-2257 (Sept. 26, 2006).

[117] *Ex parte* Feguson, No. 2003-1044 (Aug. 27, 2004).

[118] *Ex parte* Bowman, No. 1999-0583 (June 12, 2001).

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Supreme Court, further opportunities will exist to further define limitations on the scope of patentable subject matter.

III. INNOVATION AND COMPETITION POLICY CONCERNS RAISED BY BUSINESS METHOD PATENTS

Not only is an unrestricted sense of patentable subject matter disfavored by sound innovation policy, it conflicts with the requirement, stipulated by the Constitution and consistently articulated by the Supreme Court's precedent, that patentable subject matter must fall within the "useful arts." Allowing methods of doing business lacking a technical contribution to be patent eligible subject matter raises important innovation and competition policy concerns.[119]

A. Patent-Based Incentives are not Needed to Spur Business Method Innovation

The decision to issue patents on particular subject matter involves, in the words of Thomas Jefferson, a determination of those "things which are worth to the public the embarrassment of an exclusive patent . . . ."[120] In this regard, the evidence suggesting a sudden need for patent-based incentives to promote the development of business concepts is conspicuous by its absence. "Nowhere in the substantial literature on innovation is there a statement that the United States economy suffers from a lack of innovation in methods of doing business. Compared with the business practices of comparable economies we seem to be innovators . . . ."[121]

Among the reasons for the persistent, favorable record of commercial entrepreneurship in the United States are existing federal and state regimes, including unfair competition law, trade secrets, copyright, and the misappropriation doctrine, that have long policed free riding and allowed business pioneers to reap the rewards of their ideas.[122] In conjunction with market-based incentives, including the desire to seize first-mover and learning-curve advantages, the current legal framework has resulted in a flourishing environment for business innovation in the United States. No plausible argument supports the view that patent protection is needed for non-technological business methods to solve a market failure problem, fill a legal void, or ultimately enhance social welfare.

B. Business Method Patenting Raises Significant Competitive Concerns

Although no convincing justification exists for allowing patents on non-technological methods of doing business and other abstract ideas, the breadth of coverage of such patents has raised significant competitive concerns. Among them is that such patents are not restricted by the Constitution and the precedent articulated by the

[119] Examples of abstract business methods include U.S. Patent Nos. 5,947,526 (claim 1 reciting method for tracking personal expenditures) and 5,668,736 (claim 1 reciting method for remodeling an existing building).

[120] Graham v. John Deere Co., 383 U.S. 1, 9 (1966).

[121] Leo J. Raskind, *The State Street Bank Decision. The Bad Business of Unlimited Patent Protection for Methods of Doing Business*, 10 FORDHAM INTELL. PROP., MEDIA & ENT. L.J., 61, 92 (1999).

[122] *See id.* at 93.

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Supreme Court. Rather, they may effectively appropriate all possible solutions to a particular problem. This direct restraint upon the ability of competitors to develop alternatives to the patented invention thwarts a principal aspiration of the patent system — fostering new alternatives.[123]

Consider, for example, the ubiquitous automated teller machine (ATM). A review of the patent rolls reveals numerous ATM patents concerning such mechanical, electrical, and computer-implemented inventions as card readers, touch screens, cash dispensers, statement printers, and antitheft mechanisms. As evidenced by the robust competition within the contemporary ATM industry, such patents have both preserved the incentives of industry participants to innovate and allowed their competitors to market alternative designs. However, in view of the Federal Circuit's endorsement of patents on inchoate business methods, a contemporary inventor's claim to the very concept of an ATM would be considered eligible for patenting under § 101. Much like claim 8 of Morse's telegraphy patent, such a patent would effectively prevent all others from designing alternative mechanisms for meeting the same marketplace needs. The potential adverse impact of this hypothetical patent upon competition not just in the ATM industry, but within the banking industry itself, is apparent.

The lack of a plausible justification for patents on non-technological business methods and human behavior, coupled with the anticompetitive consequences of issuing these patents and the Supreme Court's precedent in this area, counsels for reassertion of Supreme Court jurisprudence to restrict patentable subject matter to instantiated products and processes. Modern society's dizzying pace of technological change, with its accompanying changes to marketplace conditions and commercial practices, should by no means lead to an alteration of these established principles. Nor does the Supreme Court's recognition that the patent system should keep pace with unforeseeable fields of scientific or technological discovery[124] compel a contrary result. Business concepts are not an unforeseeable field, and in fact, they long predate the patent system.[125]

In *State Street*, the Federal Circuit articulated broad-sweeping dicta without making an inquiry into whether the patenting of non-technological methods of doing business raises competitive concerns or whether traditional patent-based incentives were actually needed to spur methods of doing business. "Jefferson saw clearly the difficulty in 'drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.'"[126] The ambit of patentable subject matter should return to that range of innovation that truly justifies tolerating the "embarrassment of an exclusive patent."

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[123] *See* Brenner v. Manson, 383 U.S. 519, 534 (1966) ("Until [a] process claim has been reduced to production of a product shown to be useful, the metes and bounds of that monopoly are not capable of precise delineation. It may engross a vast, unknown, and perhaps unknowable area."); Slimfold Mfg. Co. v. Kinkead Indus., Inc., 932 F.2d 1453, 1457 (Fed. Cir. 1991) ("Designing around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose.").

[124] *See Chakrabarty*, 447 U.S. at 315-16.

[125] *See, e.g.*, John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1145-46 (1999).

[126] Graham v. John Deere Co., 383 U.S. 1, 9 (1966).

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IV. CONCLUSION

The gravamen of the Supreme Court's precedent is that subject matter patentability is restricted to inventions that involve technological contributions, namely, tangible products or processes that either (i) are tied to a particular machine or apparatus or (ii) cause transformation or reduction of an article to a different state or thing, and in either instance, produce technologically-beneficial results. In *State Street*, the Federal Circuit departed from this standard without any evidence that incentives are needed for innovation with respect to abstract business methods and other non-technological innovations, and without due consideration of the impact that such a shift would have on the economy. Although more recent Federal Circuit cases have moved toward restoring controlling Supreme Court standards, their holdings continue to allow patents to issue on products and processes that achieve only non-technological results. Consistent with the Supreme Court's precedent on § 101, a technological contribution should be required for subject matter patentability, which would render non-technological business methods outside the scope of patentable subject matter.

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Opening Statement to Senate Judiciary Committee, Concerning S.515

Chairman Leahy, Ranking member Specter, and members of the Judiciary Committee. My name is David Kappos, I serve as IBM's Vice President and Assistant General Counsel for Intellectual Property Law and Strategy. I am grateful for the opportunity to testify before this Committee in support of patent system reform.

IBM is committed to ensuring that our patent system is robust and that the United States economy is strong. We have been the leading assignee of issued patents in the United States for 16 consecutive years, we earn about one billion dollars annually in intellectual property related income. IBM also invests more than six billion dollars a year in research and development, and generates about 100 billion dollars of revenue annually providing products and services. IBM is therefore uniquely positioned to promote a balanced patent system that will benefit patentees, producers, and the public.

The patent system must balance the interests of all industries. IBM is not a member of any of the coalitions formed to advocate on behalf of particular industries. Rather, IBM believes these interests are reconcilable, and meaningful compromise can be achieved, so that the patent system will meet the needs of innovators in all industries, and most importantly, serve the best interests of the American public.

The nature of innovation has changed. Today, we benefit from inventions made possible through highly collaborative and interconnected technologies. Many of the products consumers demand are complex, include contributions from multiple innovators, and incorporate hundreds if not thousands of patented inventions. At the same time, many new innovations require investments of unprecedented size to achieve a single new product protected by a single patent. For the United States to remain competitive our patent system must accommodate all of these innovation models. Yet our patent laws have not been significantly updated for over 50 years.

IBM believes enactment of S. 515 is necessary for our nation to remain intellectually and economically competitive.

While progress has been made in recent years through judicial reform in areas such as obviousness, injunctions, willfulness, and most recently venue in patent litigation, much remains to be done to restore balance to our patent system. The problem of poor quality patents persists. Uncertain patent rights create speculation and lead to excessive litigation.

IBM supports S. 515's approach to improving patent quality, including "first window" post grant review, enhanced inter partes reexamination, and preissuance submission of information. These reforms reduce the impact of poor quality patents by making it easier to promptly challenge the validity of a patent without resort to litigation, and without subjecting patentees to an undue period of uncertainty.

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A particular point of contention has been and remains the appropriate standard for reasonable royalty damages determinations. As with other issues that have been resolved despite competing interests, IBM believes this issue is reconcilable and a balanced solution can be achieved.

In IBM's experience, the current legal standard for determining reasonable royalty damages does not provide the certainty needed to enable modern business to operate effectively. As a result, the precious time of skilled scientists and engineers is too often spent defending against costly and time-consuming litigation, instead of creating innovations that drive economic growth.

In reforming the law in this area, we must nevertheless be mindful of the fundamental importance of ensuring that patentees are appropriately compensated, or the patent system will fail to provide the incentive innovators require.

IBM believes the Supreme Court provided critical guidance in its recent unanimous Quanta decision. In addressing the related issue of patent exhaustion, the Court focused on the essential features of the invention to determine if the patentee had received full compensation. An approach using the Quanta standard as a starting point will provide the guidance needed to properly compensate the inventor by focusing the damages inquiry appropriately.

IBM believes that by improving patent quality and reducing wasteful patent litigation, S. 515 will remove roadblocks to the development and implementation of new innovations, spurring economic growth. For the United States to maintain innovation leadership, our patent system must be in the future what it has been in the past – the best in the world. The need to act is urgent, the goal is achievable, and failure to act will harm our nation's economic interests. We urge enactment of the Patent Reform Act of 2009. Thank you.

Key messages

1. Urgency – we must act now to modernize our patent system and restore balance.
2. This is an achievable goal – compromise has been reached in many areas (post grant) and will be achieved in others (damages) so long as we don't over-proscribe and consider everyone's interests
3. Failure to act will harm our economic interests

TESTIMONY OF David J. Kappos
Vice President and Assistant General Counsel
Intellectual Property Law and Strategy
IBM Corporation
Before the
United States Senate Committee on the Judiciary
March 10, 2009

Mr. Chairman, Ranking Member Specter, and members of the Committee. My name is David J. Kappos and I am Vice President and Assistant General Counsel for Intellectual Property Law and Strategy for the IBM Corporation. I appreciate the opportunity to offer IBM's views on patent law reform and the actions that this Committee should take to preserve America's innovation leadership and competitiveness in the world, and to encourage investment to produce economic growth and create jobs.

IBM supports S. 515, the Patent Reform Act of 2009, and urges the Committee to pass this important piece of legislation to create a contemporary U.S. patent system. The last half-century has been a time of unprecedented technological change. However, during this same period, the laws governing our U.S. patent system have not been significantly updated to reflect these changes. Innovation today is characterized by diverse forms of collaboration, multidisciplinary problem-solving, interconnected technologies, and complex products incorporating multiple inventions. The patent system must adapt to these changes.

SUMMARY

IBM is committed to ensuring that our patent system is robust and that the United States economy is strong. We have been the leading assignee of issued patents in the United States for 16 consecutive years, and we earn about $1 billion annually in intellectual property related-income. IBM also invests more than $6 billion a year in research and development, and earns about $100 billion annually providing products and services. IBM is therefore uniquely positioned to promote a balanced patent system that will benefit patentees, producers, and the public.

The patent system must balance the interests of all industries. IBM is not a member of any of the coalitions that have formed to advocate on behalf of particular industries. Rather, IBM believes that these interests are reconcilable and meaningful compromise can be achieved so that the patent system will meet the

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needs of innovators in all industries, and most importantly, serve the best interests of the American public.

The nature of innovation has changed. Today, we benefit from inventions made possible through highly collaborative and interconnected technologies. Many of the products that consumers demand are complex and include contributions from multiple innovators that incorporate hundreds if not thousands of patented inventions. At the same time, many new innovations require investments of unprecedented size to achieve a single new product protected by a single patent. For the United States to remain competitive our patent system must accommodate all of these innovation models. Yet our patent laws have not been significantly updated for over 50 years. IBM believes that enactment of S. 515 is necessary for our nation to remain intellectually and economically competitive.

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IBM believes that by improving patent quality and reducing wasteful patent litigation, S. 515 will remove roadblocks to the development and implementation of new innovations, spurring economic growth. For the United States to maintain innovation leadership, our patent system must be in the future what it has been in the past – the best in the world. The need to act is urgent, the goal is achievable, and failure to act will harm our nation's economic interests. We urge enactment of the Patent Reform Act of 2009.

IBM IS A TECHNOLOGY LEADER

IBM is an innovation company and inventions are critical to our success. In 2008, for the 16th consecutive year, IBM was the recipient of more U.S. patents than any other assignee. IBM received over 4,000 U.S. patents, the first company ever to do so in a single year. We have a deep appreciation of, and commitment to, technology development and scientific pursuits. During the company's nearly 100-year history, its employees have included five Nobel laureates, five National Medal of Science recipients, and seven winners of the National Medal of Technology. IBM has invented industries such as hard disk drives, relational databases, and RISC computers.

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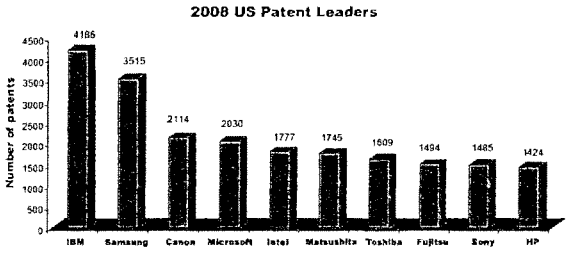
IBM Patent Leadership



- IBM ranked #1 in U S patents for 16th consecutive year
- Over 6,000 IBM inventors were responsible for the 4,186 patents received by IBM in 2008. They reside in 44 different states and territories in the U S and 27 other countries globally
- More than 40,000 patents in IBM's global patent portfolio

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IBM employs approximately 120,000 people in the U.S., located in each of the 50 states and the District of Columbia. Their jobs depend on IBM's success in the global economy. Most of these are high-skill, high-wage jobs, including thousands of technical positions in software engineering, hardware development, technical services, consulting, research and manufacturing. The majority of IBM's worldwide jobs in hardware development, software engineering and research are in the U.S.

In addition to developing, manufacturing and delivering information technology, we focus on delivering innovative solutions to IBM clients. Nearly half of IBM's U.S. employees work in our services business, including thousands of consultants and technical experts who serve clients operating around the world. Our clients want an innovation partner who can help them apply and integrate technology in ways that deliver new and lasting value. IBM is at the forefront of innovation in new products and services, and entirely new business models.

The United States is IBM's largest market in terms of revenue, and IBM invests heavily here. For example, in 2007 over 75% of IBM's $6.2 billion in research and development (R&D) spending was invested in the U.S. Of the over 39,000 U.S. patents issued to IBM between 1993 and 2007, 90% were based on inventions made in the U.S. This R&D investment has made it possible for IBM to generate about $1 billion in IP-related income annually and has enabled IBM to operate a profitable global business with annual revenue exceeding $100 billion.

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THE NATURE OF INNOVATION HAS CHANGED

IBM strives to maintain and foster an innovation culture not only to meet our clients' demands, but also to remain competitive and thereby benefit our shareholders, our employees, and the communities we serve. Demands on our business and the businesses of our clients, partners and competitors are driven by new global marketplace realities. If America is to remain competitive, create jobs, and continue to be one of the most innovative nations on earth, it must adapt to these new realities.

In the Industrial Age, innovation primarily was the result of work by individuals or small groups within an enterprise. Today, interconnected technologies have created an environment that allows groups of people to innovate together across enterprises and national boundaries. This rich environment enables the development of multifunction products and services, and creates efficiencies and synergies through the contributions of many different creative sources. Many of the products that consumers demand are complex, include contributions from multiple innovators, and incorporate hundreds if not thousands of patented inventions. We benefit from inventions that are made possible through this "collaborative" innovation.

Incorporating innovation from multiple sources is enabled by: (1) open innovation environments; (2) technology standards, where innovators work collaboratively to create a common platform for product-level competition; and (3) licensing and cross-licensing of technology to gain access to others' innovations. The diversity and interconnectedness of modern innovation models increases the need for predictability and clarity in determining the valid scope of patent rights, as well as valuing them for licensing purposes. For example, a licensing agreement that directly affects two parties is likely to indirectly affect many more. As a result, there is a heightened sensitivity to uncertainty. Such uncertainty in this context will increase transaction costs and make it increasingly difficult for innovators and implementers to trade the intellectual property (IP) rights needed to bring innovative products and services to consumers.

Collaborative innovation through open platforms and standards has blossomed across numerous industries in recent years. Such development occurs in diverse ways. It may be horizontal -- in which multifunction products such as computer systems incorporate innovative features from multiple sources -- or vertical, in which single function products such as pharmaceuticals reflect

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inventions from multiple "upstream" and "downstream" participants in the development "chain".[1]

So, what role should U.S. patent policy play in making sure that we continue to be a nation of innovators? How should the patent system help us to capture these technological developments and translate them into differentiators for American prosperity and drivers of growth?

THE U.S. PATENT SYSTEM HAS NOT KEPT PACE WITH THE CHANGING NATURE OF INNOVATION

The U.S. patent system is widely acknowledged as underpinning America's leadership in innovation and IBM strongly shares this view.

Patents play as important a role for IBM as they do for any other U.S. company. They provide an incentive to innovate by protecting our inventions while providing us the freedom of action to bring new products and services to market and partner with our clients to meet their needs. Patents spur successive innovation because patentees must disclose their inventions to the public, enabling others to build upon these innovations. As America competes in a global economy, we must rely on innovation for competitive advantage. Ensuring that our patent system properly promotes innovation is therefore central to America's ability to compete and to produce economic growth and jobs.

Unfortunately, we continue to see developments that threaten the ability of the U.S. patent system to keep pace with and respond to changes in the nature of innovation. The U.S. patent system must be properly positioned to help our country maintain and grow its innovation leadership.

Two significant developments arise from the failure of our patent system to adapt: the granting of low quality patents, and the adverse effects of excessive patent litigation.

Low Quality Patents: High-quality patents that have been properly prepared and examined to ensure that they meet all of the legal and policy objectives of the patent system increase certainty around intellectual property rights, reduce contention and free resources to focus on innovation. We believe the

[1] *Rising in the East,* The Economist, January 3, 2009, at 47. Citing as an example the Apple iPhone: "Apple's contribution is the design and software – and importantly, integrating the innovations of others." *See also* Carl Shapiro and Mark Lemley, *Patent Holdup and Royalty Stacking,* 85 Texas Law Review 1991 (2007).

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quality of patents issued in the U.S. has diminished, and that the substantial improvements needed to address this quality crisis are not possible without Congressional action.

Patent professionals are concerned about patent quality and are not confident that matters will improve. In August 2005, the Intellectual Property Owners Association (IPO) conducted a survey of its member corporate patent professionals regarding their views on U.S. patent quality. The findings are revealing. Over half (51.3%) said they rate the quality of patents in the U.S. as poor or less than satisfactory. This conclusion did not significantly vary based on industry. When asked whether they thought patent quality would decline, improve, or stay the same over the next three years, 28.7% responded that they thought patent quality would worsen, and 51.2% thought things would stay the same. Responses varied some by industry, but the most noticeable differences were in responses by smaller companies (under $1 billion in revenue) and by companies in the computer, electronics, and software industry, where the percentage of respondents expecting a decline in patent quality was nearly twice the average. Forty-four percent of smaller company respondents thought that patent quality would get worse and 40% of the computer, electronics, and software industry respondents thought that quality would worsen.[2]

The U.S. Patent and Trademark Office (USPTO) has not been able to keep pace with the avalanche of applications it has received in recent years. In fiscal year 2007, the USPTO received nearly 485,000 patent applications which represented a seven percent increase over the previous year. The backlog of applications is growing. The USPTO has been hiring more examiners to reduce the backlog. But with such a significant increase in the number and complexity of applications, it is difficult to assure high quality.

Excessive Patent Litigation: Patent litigation has increased significantly for more than a decade, in part driven by low patent quality that creates uncertainty around intellectual property rights, spawning increased speculation. This excessive litigation threatens to sap America's innovative capacity and its ability to compete in the world if left unaddressed.

[2] *See* IPO Survey: Corporate Patent Quality Perceptions in the U.S. 2, 4-5 (Sep. 20, 2005).

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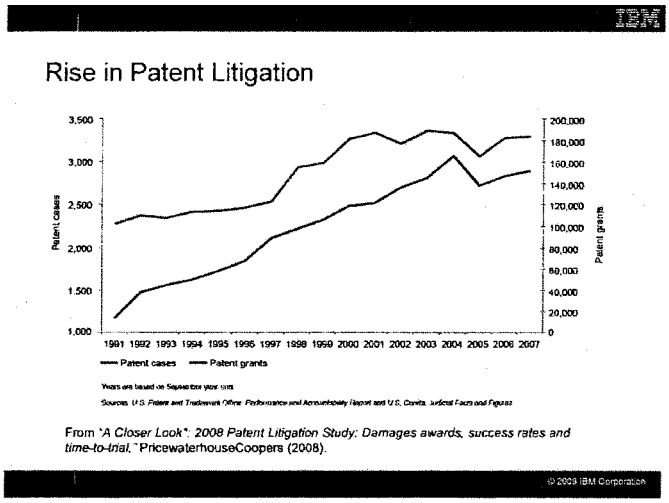

Chart from *"A Closer Look": 2008 Patent Litigation Study: Damages awards, success rates and time-to-trial,"* PricewaterhouseCoopers (2008).

The number of patent infringement suits filed annually in the U.S. nearly doubled in the ten years ending in 2004, going from 1,617 in 1994 to 3,075 in 2004.[3] There were 2,830 cases filed in 2006.[4] Patent litigation has remained at this elevated level with some fluctuations.[5] The National Academy of Sciences reported in its 2004 study on improving the U.S. patent system that the number of patent infringement lawsuits settled or disposed of in federal court doubled between 1996 and 2002 from 1,200 to 2,400 cases per year.[6] In 2007, nearly 2,800 U.S. district court patent cases were terminated, over 3,600 cases remained pending, and nearly 2,900 new cases were filed.[7] From 2006 to 2007, the number

[3] *See* "2007 Patent and Trademark Damages Study*," PWC Advisory: Crisis Management 8 (2007), available at http://www.pwc.com/extweb/service.nsf/docid/3ca24a75615f03948025711e004b69a0/$file/2007_Patent_Study.pdf; *see also* 2007 Annual Report of the Director: Judicial Business of the United States Courts 150 (U.S. Government Printing Office, 2008).

[4] J. Shawn McGrath and Kathleen M. Kedrowski, *Trends in Patent Damages* 1 (IP Remedies, American Bar Association Section of Litigation website, Nov. 2007); available at http://www.abanet.org/litigation/committees/intellectual/articles.html

[5] *See* Presentation by Professor Paul M. Janicke, "Patent Damages February 2009" during the Federal Trade Commission "The Evolving IP Marketplace" Workshop panel discussion on February 11, 2009 ("2700 PATENT SUITES FILED PER YEAR"); available at http://www.ftc.gov/bc/workshops/ipmarketplace/

[6] A PATENT SYSTEM FOR THE 21ST CENTURY 32 (National Academies Press 2004).

[7] 2007 Annual Report of the Director: Judicial Business of the United States Courts 207 (U.S. Government Printing Office, 2008). Data covers the 12-month period ending September 30, 2007.

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of U.S. district court patent cases pending three years or more increased by over 15% from 353 to 408.[8]

Patent litigation, according to the Phoenix Center for Advanced Legal and Economic Public Policy Studies, costs the economy $4.5 billion annually.[9] In a survey conducted in 2007, the American Intellectual Property Law Association found that the median cost to a party in bringing a patent infringement case to trial verdict with less than $1 million at stake was about $600,000 and in a case with more than $25 million at stake, the median cost was $5 million for each side.[10] These figures do not include private settlements in the form of negotiated license agreements to avoid litigation. In its August 2005 patent quality survey, IPO also asked its member company respondents if, in the next 3 years, they expect the resources spent on patent litigation to increase, decrease, or stay the same. Almost 74% said they expect to spend more resources on patent litigation.[11]

This high level of patent litigation, particularly in the IT industry, shows that valuation issues are not being resolved in negotiation. IBM believes that this indicates both that patents of uncertain scope and validity are being enforced, and reasonable royalty damages determinations are not providing the needed guidance for the IP licensing market.

As a matter of patent policy, the requirements for patentability and patent validity should be clear and predictable. As the U.S. Supreme Court in *Festo* explained, "[t]he monopoly [conferred by a patent] is a property right; and like any property right, its boundaries should be clear."[12] Otherwise, the public cannot discern the scope of the patent until after all infringement litigation has concluded and will not invest in innovative products that might potentially fall within the patent's scope.[13]

Court awarded reasonable royalty determinations provide the backdrop against which all patent settlements and patent licensing activities are measured. Collectively, these settlements and licenses define an IP market in which developers and implementers of IP come together to trade the rights necessary to

[8] *Id.* at 64.
[9] Ford et al. *Quantifying the Cost of Substandard Patents Some Preliminary Evidence,* PHOENIX CENTER POLICY PAPER SERIES 1, 3, 29 (Phoenix Center for Advanced Legal and Economic Public Policy Studies, Sep. 2007).
[10] REPORT OF THE ECONOMIC SURVEY 2007 25 (American Intellectual Property Law Association, 2007)
[11] *See* IPO Survey: Corporate Patent Quality Perceptions in the U.S. 6 (Sep. 20, 2005).
[12] Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722, 730 (2002).
[13] *See* Bonito Boats, Inc. v. Thunder Craft Boats, Inc , 489 U.S. 141, 150 (1989).

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provide goods and services. This market must function efficiently, minimizing market friction and transaction costs that are ultimately passed along to consumers. Thus, it is paramount that royalties fairly compensate the patentee and fairly charge the licensee. Damages awards that reflect the economic value of an innovation appropriately balance interests and act as essential references for IP market participants, since patentees and licensees are respectively neither overcompensated/overcharged nor under-compensated/undercharged. IBM believes that an efficient IP market is important for promoting innovation, including for the development of complex products incorporating multiple inventions[14] that have become commonplace; and that an efficient IP market rests heavily on the ability to predict with a high degree of certainty the legal remedies available for patent infringement.[15]

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[14] While multi-function products tend to have high visibility in the IT sector, there is a similar issue in biotechnology due to the multiparty nature of research. Some entities such as universities perform fundamental or "upstream" innovation while other "downstream" entities productize. *See* Michael Heller and Rebecca Eisenberg, *Can Patents Deter Innovation? The Anticommons in Biomedical Research,* Science, New Series, Vol. 280, No 5364 (May 1, 1998), pp. 698-701

[15] The U.S. economy as a whole will benefit from an efficient IP market where certainty in damages determinations ensures efficient access to innovation, reduces transaction costs, and avoids unwarranted speculation. To offer the products that consumers desire and to license the related IP, providers need an efficient market in which IP rights can be readily valued and exchanged. Where there is divergence between licensor's and licensee's views regarding fair and reasonable licensing fees, transaction costs rise and the market becomes inefficient. Multiple parties make the problem more complex and increase sensitivity since more parties must agree regarding IP valuation Without certainty, there is also a heightened risk of speculation. For example, parties may be encouraged to enforce patents for purposes of extracting high royalties from the producers of goods and services, while producers may be encouraged to hold out against taking licenses for purposes of extracting access to innovations at low royalty rates The inability to agree on a royalty fee prevents innovators from being compensated, prevents products and services from reaching the market, and increases the incidence of costly litigation.

As products have become increasingly complex and integrated, the licensing necessary for the IP market to function has become more complicated. Companies need to consider not only their own internally developed technology and IP, but also the technology and IP of others.[15] The oft-cited example of the computer, or even the CPU itself, containing hundreds if not thousands of patented innovations is illustrative. Similarly, a pharmaceutical product may incorporate the "fundamental" research of a university combined with the targeted product development of a pharmaceutical firm.[15] The typical licensee/product-seller must consider all the fees to be paid to all patentees in order to make and sell its product. And the licensor/innovator must consider the role its innovation plays in the applicable product.

When a patented invention is included in a product of any kind, including in a complex multifunction product, its economic value should be determined based on the substance of the invention. Economic value should not be affected by the inclusion or omission of background or contextual elements added to the patent's claims. Nor as a general proposition should economic value be affected by the aggregate cost of a complex multifunction product in which the invention is incorporated. This substance-based approach is fair to both the licensor and the licensee, avoiding both under-compensation and over-compensation. It also enhances predictability and certainty by causing all parties to focus on the inherent value of the patented invention. The public benefits when innovators/licensors and producers/licensees are able to readily come to terms regarding an invention's economic value.

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Market complexity creates significant challenges for determining royalty fees. As such, licensors and licensees will continue to be influenced in their negotiations by the legal standard for reasonable royalty damages and its application. This is not surprising – both parties understand that reasonable royalty damages is the metric by which the licensing fee should be judged since it is the measure for damages if they are forced to litigate. Given the challenging developments in the market and the resulting challenges in licensing, it is of paramount importance that the law of damages provides clear guidance.

As U.S. businesses, governments, and communities become increasingly interdependent, our nation's competitiveness will be even more susceptible to weaknesses in our country's patent system. The Congress must take action to reshape U.S. patent law to be responsive to the fundamental economic and technological shifts taking place. The goal of reforming U.S. patent law should be to preserve U.S. leadership in innovative capacity, enabling U.S. businesses to capitalize on developments in technology, infrastructure and business organization and making them differentiators for American prosperity.

THE PATENT REFORM LEGISLATION WILL BRING THE CHANGES NEEDED TO SPUR INNOVATION

IBM believes both patent quality problems and excessive litigation must be addressed, and S. 515 does that effectively. Although there are many provisions in the bill that enable a contemporary patent system, IBM's testimony focuses on the provisions in the legislation that address patent quality and reform reasonable royalty damages.

Improving Patent Quality: There are two crucial reforms in the legislation that should be implemented to improve patent quality. Both of these reforms are designed to open up agency patentability determinations to the public to encourage the public to come forward with relevant information not previously discovered or disclosed. First, the bill creates the opportunity for third parties to submit prior art to the USPTO during the patent prosecution process with commentary on how that prior art is relevant to the application under consideration. This important and broadly supported change will be highly effective in raising patent quality, particularly because it takes advantage of the fundamental shift toward collaborative innovation. More and more collaborative communities are thriving today and their collective knowledge can be harnessed to bring forward information, especially prior art, relevant to the examination process.

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Second, IBM believes it is vitally important to have an administrative proceeding to allow the public to bring forward relevant information, post-issuance, about whether a patent was properly issued. This will increase the quality of patents and will provide a low cost alternative to litigation. The solution in the bill represents a reasonable compromise between the need to provide a meaningful way to bring forward relevant information and concerns that the administrative proceeding will be used to harass the patentee. The bill provides the ability to challenge the patent in a post-grant-review proceeding for one year following issuance based on a broad array of grounds related to patentability. After one year, the public can bring forward relevant information through an "improved" version of the existing inter partes reexamination administrative proceeding. The improved inter partes reexamination proceeding will no longer prevent a challenger from going to court at a later time on an issue that was not raised in the proceeding. Further, in addition to patents and printed publications, a challenger may submit evidence that the claimed invention was in public use or on sale in the U.S. more than one year prior to the application. This is evidence that the examiner could have used to reject the patent application during prosecution, but which a third party currently can only use to challenge the validity of an issued patent by going to court.

Maintaining a meaningful ability to challenge low quality patents administratively is important to strengthening and preserving the integrity of the U.S. patent system. For the IT industry especially, being able to bring forward relevant evidence more than a year after issuance of the patent is necessary because it is difficult, if not impossible, to watch for all the potentially applicable patents that the USPTO issues. There can be many hundreds if not thousands of patents in an IT product. It is not uncommon to be unaware of a patent until a letter is received claiming that payment is due because the patent covers the IT product.

Both of these proposed reforms will help to minimize patents being granted on inventions that are not new or are obvious.

Reforming "reasonable royalty" damages: The reasonable royalty damages provision in S. 515 balances the varying needs of U.S. industries and businesses and IBM views this provision as a compromise. This provision allows the court to accommodate varying business models by deciding which of three listed methods should be used by the court and the jury to determine damages for patent infringement. We recognize that this provision has generated concern in the past. As a result, we discuss below an alternative which we believe will adequately

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address the full range of how inventions are used in products and services across industries and will maximize the chance that a "reasonable" royalty is granted in every case.

As discussed above, IBM believes that IP market efficiency can be ensured by focusing the damages calculation on the economic value of the essential features of the subject invention. In particular, IBM recommends to the Committee that the legislation ensure this focus by: (1) incorporating *Quanta*'s "essential features" concept into the damages determination; (2) ensuring district courts increase precision in Entire Market Value Rule ("EMVR") and Convoyed Sales determinations; and (3) requiring district courts to better exercise their gatekeeper powers to cause rigorous expert analysis and review of damages evidence and reasonable royalty determinations. IBM believes these recommendations are representative of best practices that are supported by Supreme Court and Federal Circuit law.

Incorporate *Quanta* "Essential Features" Standard into Damages Determination

Application by analogy of the Supreme Court's formulation of the "essential features" of a patented invention in the *Quanta* case to damages determinations will focus the damages determination on the value of what the inventor actually invented. In the unanimous *Quanta* decision, the Supreme Court held that if a patentee sells (or licenses another to sell) a product that includes all the essential features of a patented invention,[16] then the patent rights are "exhausted," meaning that the patent can no longer be asserted against downstream buyers of that product. The underlying theory behind the patent exhaustion rule is that "in such a transaction, the patentee has bargained for, and received, an amount equal to the full value of the goods."[17] In other words, the patentee received full compensation when the product was sold, and is not entitled to collect an additional royalty.[18] The connection between *Quanta* and the law of exhaustion on the one hand, and the determination of patent damages on the other, is the Court's renewed focus on the substance of the invention in determining the proper scope of patent protection.

[16] The "essential features" exclude "common processes" or "standard parts," even if included in the claims. *See* Quanta, 128 S.Ct. at 2120. Determining what constitutes the "invention" is of course fundamental to the determination of damages under the patent statute, which requires that damages are no "less than a reasonable royalty for the use made of the invention by the infringer." 35 U.S.C. Sec. 284.

[17] B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1426 (Fed. Cir. 1997); *see also* Adams v. Burke, 84 U.S. (17 Wall.) 453, 456-57 (1874); Keeler v. Standard Folding Bed Co., 157 U.S. 659, 663-64 (1895).

[18] *See* PSC v. Symbol Techs., 26 F. Supp. 2d 505, 510 (W.D.N.Y. 1998) ("The purpose of the exhaustion doctrine is to 'prevent[] patentees from extracting double recoveries for an invention . . . .' Cyrix Corp v. Intel Corp., 846 F. Supp. 522, 539 (E.D. Tex.), aff'd 42 F.3d 1411 (Fed. Cir. 1994)")

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For complex products incorporating many inventions and unpatented elements, focus on the "essential features" results in fair compensation for the patentee. It does not overcompensate by including the value contributed by others, nor does it under-compensate by excluding the value provided by the patented invention. The standard is flexible and applies fairly to all inventions. Where, for example, the invention is in a combination of elements itself, the Court in *Quanta* recognized that the elements of the combination could not be evaluated separately or the invention's "essential features" would be lost.[19]

Focusing on the invention's essential features also assists fact-finders in determining equitable compensation. Inventors receive the same value whether or not background or contextual elements are added to their claims. An invention of significant scope and value should be entitled to a large royalty regardless of whether it is claimed precisely or includes additional elements that are not essential to the invention. Likewise, a minor improvement should be entitled to a limited royalty regardless of whether the claim includes elements that are unrelated to patentability.[20] Basing reasonable royalty damages on the economic value of the essential features of the invention should thus properly compensate the inventor by focusing the inquiry on the invention itself. Furthermore, as the essential features are determined objectively through examination of the public record of the patent file history, this approach will increase the predictability and certainty necessary for the functioning of an efficient IP market.[21]

There Must Be More Precision in EMVR Analysis and Convoyed Sales.

Due to the increasing complexity of products, including systems incorporating many individual and grouped components, application of the EMVR and the related Convoyed Sales doctrine have become widespread. In these situations, for convenience and simplicity, damages analysis tends to emphasize the product environment in which a "component of a component" within a

[19] *See* Quanta, 128 S.Ct. at 2121 (2008) ("Aro's warning that no element can be viewed as central to or equivalent to the invention is specific to the context in which the combination itself is the only inventive aspect of the patent"). The Court also held that the patent exhaustion doctrine applies to process claims. *Id.* at 2117.

[20] In this context, a "significant" invention, for the purposes of calculating damages, is one of significant economic value, and a "minor improvement" is similarly an invention of limited economic value. An invention may be significant technologically but limited in value, or limited in technological impact but significant in value. In either case, the substance of the invention must be determined first, and then its value can be assessed.

[21] In proposing incorporation of the *Quanta* standard in determining reasonable royalties, we do not suggest that this is the end of the inquiry. To the contrary, much of the existing damages jurisprudence contains helpful constructs and models for assisting in the determination of an appropriate royalty. We propose simply that the inquiry should begin with the determination of the essential features of the invention and that this will provide an objective focus for the full analysis of compensatory damages.

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component[22] is placed, rather than the more precise and relevant issue of whether the infringing product corresponds closely to the invention. In a recent case covering a product of this type, Federal Circuit Judge Rader, sitting by designation in the District Court, recognized the significant burden of proof that application of the EMVR should require:

> Moreover, neither Cornell nor Dr. Stewart has offered sufficient economic proof that the component of a component of a part of the server and workstation systems drove demand for the entire server and workstation products and entitles Cornell to damages on sales of Hewlett-Packard's entire servers and workstations.[23]

It is important to encourage widespread and vigorous application of this evidentiary threshold so that the "reach" of patent protection afforded an invention does not extend beyond the actual invention and onto unrelated components or features of a product incorporating the invention, unless the invention is in fact "**the** basis for customer demand" for the entire product that nevertheless includes other functions or features.

Finally, as IBM understands application of the EMVR, it may be based on demand driven by the claimed invention as expressed by all of its respective limitations.[24] IBM suggests that, in an environment characterized by the proliferation of complex products incorporating multiple inventions, the fairest application of the law would require evaluating whether the demand is driven by the invention itself -- i.e., by the essential features of the patented invention. This avoids giving weight to claim elements that may be unrelated to the invention in applying the EMVR.

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[22] Cornell University v. Hewlett-Packard Co., 2008 U.S. Dist. LEXIS 41848 (N.D.N.Y May 27, 2008)(Rader, J., sitting by designation) (In this case the court excluded testimony of a damages "expert" for failure to consider apportionment and show a connection between the patented feature and the market demand for a complex multi-featured product.)

[23] *Id.* at 7.

[24] Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538 (Fed. Cir. 1995) ("Subsequently, our predecessor court held that damages for component parts used with a patented apparatus were recoverable under the entire market value rule if the patented apparatus 'was of such paramount importance that it substantially created the value of the component parts.' Marconi Wireless Telegraph Co. v. United States, 99 Ct Cl. 1, 53 U.S.P.Q. (BNA) 246, 250 (Ct. Cl 1942), aff'd in part and vacated in part, 320 U.S. 1 (1943). We have held that the entire market value rule permits recovery of damages based on the value of a patentee's entire apparatus containing several features when the patent-related feature is the 'basis for customer demand.' State Indus., 883 F.2d at 1580, 12 U.S P.Q.2D (BNA) at 1031; TWM Mfg. Co. v. Dura Corp., 789 F.2d 895, 900-01, 229 U.S.P.Q. (BNA) 525, 528 (Fed. Cir.), cert. denied, 479 U.S. 852, 93 L. Ed. 2d 117, 107 S. Ct. 183 (1986)."). In Rite-Hite, the court declined to apply the Entire Market Value Rule to the dock levelers since they did not function together with the patented vehicle restraint to achieve one result, but could have been used independently. *See id.* at 1549-50.

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Judicial Gatekeeping Needs to Be Strengthened

In the Cornell case mentioned above, the Court also excluded the testimony by the damages expert because the purported expert failed to "show a sound economic connection" between the claimed invention and the proffered royalty base.[25] IBM believes that such strong gatekeeping is highly supportive of an efficient market in IP, and should be required of the courts. District courts that provide clear articulation of the logic and factors relied upon in their damages decisions provide a better foundation for review. Such articulation also would provide the clear guidance for negotiators that is critical for commercial entities and the public. Rigorous requirements for damages experts, coupled with clear articulation of the bases for damages determinations, creates certainty for licensors and licensees alike, improving the efficiency of IP markets.

CONCLUSION

The nature of innovation has changed. The drivers of growth today are quite different from those in previous eras. America must rely more than ever before on the ability of its citizens to innovate to create economic growth and maintain competitive advantage.

The patent reform debate thus far unfortunately has been characterized as adversarial, pitting one set of industries against another set of industries. To be sure, industries use the patent system in different ways and these differences affect how they view some reform proposals. However, we believe any differences are not insurmountable.

The Framers of our Constitution wisely gave Congress the express power "[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". Our patent system is facing real problems and urgent Congressional action is needed to address them. IBM urges you to enact S. 515 and reform our patent laws to remove the roadblocks to development of new innovations and seize new opportunities to spur economic growth.

Thank you again for the opportunity to present IBM's views.

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[25] *See* Cornell University v. Hewlett-Packard Co., 2008 U.S. Dist. LEXIS 41848.

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March 22, 2009

The Honorable Dianne Feinstein
U.S. Senate
SH-331 Hart Senate Office Building
Washington, D.C. 20510-0504

Dear Senator Feinstein:

Thank you for your letter requesting IBM's views on draft legislative language regarding post-grant-review, damages, venue, and inequitable conduct. IBM appreciates the opportunity to offer its perspective on these issues.

In your letter, you expressed concern for protecting "the innovative property rights that are so vital to our economy —particularly in California— while paying careful attention to ensure there is a balance between differing business models and industries. . . ". IBM agrees. IBM has over 10,000 employees in California, and they are among the most innovative in the world. Last year, IBM inventors in California received 399 U.S. patents, 9.5 percent of the total U.S. patents issued to IBM as assignee. Many new technologies have sprung from our Almaden Research Center, Silicon Valley Laboratory, and San Jose site, including storage systems (such as hard disk drives and other high volume, high speed devices), structured and unstructured information databases, search engines, text analytics, advanced/super computing techniques, nanotechnology, and "green" energy-related initiatives. IBM believes that the interests of all industries are reconcilable and meaningful compromise can be achieved so that the patent system will meet the needs of innovators in all industries, and most importantly, serve the best interests of the American public. I will address each of the issues you have identified in turn.

Post-Grant Review/Inter Partes Reexamination

IBM supports S. 515's approach to post-issuance administrative review proceedings to allow the public to bring forward relevant information about whether a patent was properly issued. S. 515's approach will increase the quality of patents and will provide a low cost alternative to litigation. The bill provides the ability to challenge a patent in a post-grant review proceeding for one year following issuance based on a broad array of grounds related to patentability. The public can bring forward relevant information after one year through an "improved" version of the existing inter partes reexamination proceeding. The improved inter partes reexamination proceeding will no longer prevent a challenger from going to court at a later time on an issue that was not raised in the proceeding. The grounds for bringing information forward under inter partes reexamination are much narrower than under post-grant review, minimizing any concern about harassment.

With respect to the principles in your discussion draft, IBM agrees that the burden of proof should be preponderance of the evidence. Also, the patent should not be presumed valid during post grant review, as the discussion draft states, merely for challenges during the first 12 months, but rather this rule should apply for challenges brought after 12 months as well. IBM does not agree with a

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number of other proposals. For example, limiting the grounds for challenge during the first 12 months only to prior art, printed publications and written statements in the record of the patent application will constrain the public from bringing forward relevant information regarding the validity of issued patents and thus will allow poor quality patents to stand. IBM also does not believe that a challenge after the first 12 months should be limited to instances where the challenger is facing imminent suit. Limiting challenges in this manner effectively forecloses the public from bringing forward information regarding patent validity, allowing invalid patents to remain in force.

Reasonable Royalty Damages

In IBM's experience, the current legal standard for determining reasonable royalty damages does not provide the certainty needed to enable modern business to operate effectively. As stated in my testimony before the Senate Judiciary Committee, IBM believes a balanced solution for reasonable royalty damages can be achieved and recommends the approach outlined in my letter to Members of the Judiciary Committee, dated March 19, 2009, a copy of which is attached to this letter. IBM's proposal calls for creation of a framework consisting of a strong gatekeeper provision, guidance based on the accepted legal principle set forth in the Supreme Court's Quanta case[1], and application of the entire market value rule (EMVR) only where the invention is "**the** basis for customer demand" for the entire product.

You make two legislative proposals for determining damages: (1) a gatekeeper provision plus codification of the so-called 15 Georgia-Pacific factors[2] and (2) a gatekeeper provision plus language that states, in part, that "[a] reasonable royalty shall reflect the economic value fairly attributable to the infringer's use of the claimed invention as embodied in the infringing product or process at the time of the infringement. . . the court will direct the jury to consider any other specific relevant factors or methodologies . . . based on the evidence . . . including . . . the entire market rule, convoy sales, or comparable licensing." The "gatekeeper" language is an improvement over existing law. However, the additional language in both provisions is not acceptable.

Under proposal (1), codifying the Georgia Pacific factors will not address overcompensation of patentees for the use of an inventive component contained in a complex multi-component product. Professor Paul Janicke, in a recent presentation at a Federal Trade Commission hearing, described the current standard for determining reasonable royalty damages as the "The *Georgia Pacific* grab bag", stating it "could cause runaway juries" and it places "[n]o controls on how the logic should go". In addition, codifying the Georgia Pacific factors necessarily excludes courts from considering other relevant factors.

Proposal (2) would improperly focus damages awards on what has been claimed in the patent rather than what was invented by codifying the term "claimed invention". This is an inflexible approach that will harm certain industries, especially the information technology (IT) industry. In the IT industry claims are often drafted to include, in addition to the invention, other non-necessary

[1] Quanta Computer, Inc. v. LG Elecs., Inc., 128 S. Ct. 2109 (U.S. 2008)
[2] Georgia-Pacific v. Unites States Plywood Corp., 318 F. Supp. 116 (S.D.N.Y. 1970)

elements included for the purpose of aligning the claim language with products incorporating the invention as a component. In contrast, the flexible "essential features" formulation derived from Quanta would achieve appropriate compensation for different types of inventions, regardless of how they are claimed. Also, the phrase "the entire market rule, convoy sales, or comparable licensing" standing alone is problematic because it elevates these factors or methodologies without defining them.

The approach outlined in my March 19th letter provides sufficient guidance to properly compensate the inventor for the value of the invention, while at the same time giving courts the discretion and flexibility to consider the appropriate facts and circumstances in reaching a reasonable royalty determination.

Venue

Two federal appeals courts recently addressed venue for patent cases; the 5th Circuit in In re Volkswagen AG, 5th Cir., No. 07-40058 (October 10, 2008), and the Federal Circuit in a subsequent decision applying 5th Circuit law, In re TS Tech USA Corp, Fed. Cir., Misc. No. 888 (December 29, 2008). Both are well-reasoned and achieve the appropriate result for venue. IBM defers to the judgment of the Senate as to whether it is appropriate to address venue in legislation.

Inequitable Conduct

The inequitable conduct doctrine promotes integrity, ensuring that patent applicants act with the utmost candor and good faith before the patent office. This doctrine also protects the public by ensuring that examiners have the best prior art. The doctrine is not without flaws, however. IBM believes that an appropriate balance can be achieved by changes that would limit instances of harassment of patent owners while at the same time preserving the public interest by maintaining a robust doctrine. Attached to this letter is a paper prepared by IBM, "Seeking a Balanced Approach to Inequitable Conduct Reform", that provides options for clarifying the doctrine so that it remains strong while avoiding inappropriate assertions. The proposed language in your letter would unduly narrow the doctrine to only those instances in which a claim would not have been allowed by the examiner based on the misrepresentation or omission at issue, and where at least one of the claims subject to the misconduct charge was found invalid by the court. The doctrine should apply more broadly to encourage good faith disclosure by applicants.

Respectfully submitted,

David J. Kappos
IBM Vice President and Assistant General Counsel,
Intellectual Property Law and Strategy

Attachments

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Appendix to Letter from David J. Kappos to Members of Senate Judiciary Committee, dated March 19, 2009

Cases and materials analyzing the essential features of a claim

A. Patentable subject matter
B. Claim preamble
C. Inventorship
D. Contributory infringement under 35 U.S.C. § 271(c)
E. Infringement under 35 U.S.C. § 271(f)(1)
F. Restriction and unity of invention
G. Disclosure and written description requirements
H. "Environmental" claim drafting and damages
I. Excerpts from the file histories of five IBM U.S. patents with Arizona inventors

A. Patentable subject matter analysis considers the significance of claim features

For the purposes of the patentable subject matter analysis of 35 U.S.C. § 101, courts should not give weight to claim limitations that do not impose "meaningful limits" on claim scope, such as those that amount to insignificant extra-solution activity or are merely field of use statements.

1. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008)
"First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. *See Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *See Flook*, 437 U.S. at 590." *Id.* at 961-62.

2. *Diamond v. Diehr*, 450 U.S. 175 (1981)
"[I]nsignificant postsolution activity will not transform an unpatentable principle into a patentable process. Ibid. To hold otherwise would allow a *competent draftsman* to evade the recognized limitations on the type of subject matter eligible for patent protection." *Id.* at 191-92 (emphasis added) (footnote omitted); *see also Parker v. Flook*, 437 U.S. 584, 590 (1978) ("The notion that post-solution activity, no matter how conventional or obvious in itself, can transform an unpatentable principle into a patentable process exalts *form over substance*." (emphasis added)).

3. *In re Grams*, 888 F.2d 835 (Fed. Cir. 1989)
Courts have analyzed whether a claim limitation is a mere "data gathering step" that should receive no weight in the section 101 analysis. *Id.* at 839 ("Though [the claim] analysis can be difficult, it is facilitated somewhat if, as here, the only physical step [in the claim] involves merely gathering data for the algorithm. As stated in *In re*

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Christensen, 478 F.2d 1392, 1394, 178 U.S.P.Q. (BNA) 35, 37-38 (CCPA 1973): 'Given that the method of solving a mathematical equation may not be the subject of patent protection, it follows that the addition of the old and necessary antecedent steps of establishing values for the variables in the equation cannot convert the unpatentable method to patentable subject matter.'").

B. Non-essential language in a claim preamble may not limit the scope of the claim

1. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343 (Fed. Cir. 2002)
Analyzing whether an element in the preamble is a limitation on the scope of the claim has required determining whether the element is an "essential" part of the invention. *Id.* at 1347 (stating that as a general rule "a preamble limits the claimed invention if it recites *essential structure or steps*, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Id.* (emphasis added)).

2. *Poly-America v. GSE Lining Tech.*, 383 F.3d 1303 (Fed. Cir. 2004)
Courts have found that preamble language was limiting because it was an "important" or "fundamental" characteristic of the invention. *Id.* at 1310 ("Our analysis shows that the inventor considered that *the 'blown-film' preamble language represented an important characteristic of the claimed invention.* We therefore agree with the district court's conclusion that a '[r]eview of the entirety of the '047 patent reveals that the preamble language relating to 'blown-film' does not state a purpose or an intended use of the invention, but rather discloses a *fundamental characteristic* of the claimed invention that is properly construed as a limitation of the claim itself.'" (emphasis added)); *see also Bicon, Inc. v Straumann Co.*, 441 F.3d 945, 952-53 (Fed. Cir. 2006) ("We conclude, as did the district court, that the preamble to claim 5 of the '731 patent recites *essential elements* of the invention pertaining to the structure of the abutment that is used with the claimed emergence cuff." (emphasis added)).

3. *TDM America v. US*, 2009 WL 455775 (Ct. Fed. Cl., Feb. 20, 2009)
As recently as a few weeks ago, the Court of Federal Claims applied the rule that "[o]nly if the preamble recites essential structure or steps or is 'necessary to give life, meaning, and vitality' to the claim does it limit the claimed invention." *Id.*, 2009 WL 455775 at *23 ("In the present claims, the term 'processing' as referenced in the preamble does not recite an essential step or give life to the claims. Nor is it an antecedent later used in the body of the claim. Therefore, the Court adopts Plaintiff's construction of the term and will not read a limitation into 'processing.'").

C. Courts analyze the significance of the claim feature(s) that a person contributed to determine if that person is an inventor

1. *Nartron Corp. v. Schukra*, 2009 U.S. App. LEXIS 4529 (Fed. Cir. Mar. 5, 2009)
Analyzing whether a person was an inventor has required determining whether the element of the invention that the person contributed is a significant part of the invention. *Id.*, 2009 U.S. App. LEXIS 4529, at *10-11 (holding that "the contribution of the extender [of the alleged inventor] is insignificant when measured against the full dimension of the invention of claim 11, not just because it was in the prior art, but

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because it was part of existing automobile seats, and therefore including it as part of the claimed invention was merely the basic exercise of ordinary skill in the art.").

2. *Pannu v. Iolab Corp.*, 155 F.3d 1344 (Fed. Cir. 1998)
Restating the general rule that "[a]ll that is required of a joint inventor is that he or she (1) . . . (2) make a contribution to the claimed invention that is *not insignificant in quality, when that contribution is measured against the dimension of the full invention*, and (3) . . . ." *Id.* at 1351 (emphasis added).

D. Contributory infringement analysis focuses on a component of a claim

1. 35 U.S.C. § 271(c)

"Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting *a material part of the invention*, knowing the same to be *especially made or especially adapted for use in an infringement* of such patent, and *not a staple article or commodity of commerce suitable for substantial noninfringing use*, shall be liable as a contributory infringer." 35 U.S.C. § 271(c) (emphasis added).

In assessing whether there has been a contributory infringement, courts will determine whether or not a component is "especially made or especially adapted for use in an infringement" of the patent, as well as whether or not the component is "a staple article or commodity of commerce suitable for substantial noninfringing use." *See Mentor H/S v Medical Device Alliance*, 244 F.3d 1365, 1379 (Fed. Cir. 2001) (reversing grant of JMOL of no contributory infringement where defendant offered substantial evidence that the accused component was not a staple item suitable for substantial noninfringing use); *C.R. Bard, Inc. v. Advanced Cardiovascular Sys.*, 911 F.2d 670, 674 (Fed. Cir. 1990) (reversing grant of summary judgment of contributory infringement because there was a genuine issue of fact as to whether the accused component had any use except through practice of the patented method).

2. *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176 (1980)
The rationale behind § 271(c) is that a party should be liable for infringement where they made the essential claim element, even if they did not make all the elements of the claim. *Id.* at 213 ("[B]y enacting §§ 271(c) and (d), Congress granted to patent holders a statutory right to control nonstaple goods that are capable only of infringing use in a patented invention, and that are essential to that invention's advance over prior art.").

3. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476 (1964)
A contributory infringer is liable for damages equal to the full value of the invention even though the contributory infringer only made some of the elements of the claim; the patent owner cannot receive damages equal to the value of the invention from both a direct

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infringer and contributory infringer. *Id.* at 512 ("[A]fter a patentee has collected from or on behalf of a direct infringer damages sufficient to put him in the position he would have occupied had there been no infringement, he cannot thereafter collect actual damages from a person liable only for contributing to the same infringement.").

4. *AdvanceMe Inc. v. RapidPay, LLC*, 509 F.Supp.2d 593, 607 (E.D. Tex. 2007)
To determine whether there has been a contributory infringement, courts have considered whether the "defendant supplied an important component of the infringing part" of the claimed method or apparatus. *Id.* at 607; *see also id.* at 627 ("MMT and Reach supplied *important and necessary components* of the patented method and system by providing capital to merchants under their programs which were only paid through forwarding of portions of payments by merchant processors, and by providing payment instructions to merchant processors that required performance of claim elements of the patented method." (emphasis added)).

5. *Oxford Gene Technology Ltd. v. Mergen Ltd.*, 345 F.Supp.2d 444 (D. Del. 2004)
In assessing whether there has been a contributory infringement, courts will determine whether or not a component constitutes a material part of the invention. *Id.* at 466. ("[T]he microarray component is a material part of the invention because it is the support upon which the claimed methods of use are performed."); *see also Rohm and Haas Co. v. Dawson Chemical Co.*, 599 F.2d 685, 688 (5th Cir. 1979) ("Section 271 contains one other requirement that the component or material 'constitut(e) a material part of the invention.' We here assume that propanil will also meet this test, since it is the active ingredient in producing the weed-inhibiting effect of the patented method."), *affirmed*, 448 U.S. 176 (1980).

E. Under § 271(f)(1), infringement analysis requires determining the substantiality of claim components

1. 35 U.S.C. § 271(f)(1)
"Whoever without authority supplies or causes to be supplied in or from the United States all or a *substantial portion of the components* of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer." 35 U.S.C. § 271(f)(1) (emphasis added).

2. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007)
Liability for infringement can attach to "components" of a patented invention. *Id.* at 449.

3. *Moore U.S.A. v. Standard Register*, 144 F.Supp.2d 188 (W.D.N.Y. 2001)
In assessing whether there has been an infringement under § 271(f)(1), courts will determine whether or not the components shipped by the defendant constitute a "substantial portion" of the components of a patented invention. *Id.* at 195 (defendant had supplied "substantially all" of the claimed forms' components because the defendant brought the paper and glue from the United States, even though it had not bought the

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accused forms' perforated portions); *see also Rothschild v. Ford Motor Co.*, 2 F.Supp.2d 941, 947 (E.D.Mich. 1998) ("These three components include two burners and a cooling mechanism. This court finds that no reasonable juror could conclude that these three components, taken together or viewed separately, comprise 'all' or a 'substantial portion' of the components making up the Ford Reclaimer.").

F. Restriction and unity of invention determinations require identification of essential characteristics and special technical features of claims

1. MPEP 803.02 - Markush Claims
"Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a *substantial structural feature essential to that utility*." U.S. Pat. & Trademark Office, Manual of Patent Examining Procedure (8th Ed., rev. 7, July 2008) (herein, "MPEP") § 803.02 (emphasis added).

2. MPEP 806.03 - Single Embodiment, Claims Defining Same Essential Features
"Where the claims of an application define the *same essential characteristics* of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are *>not directed to distinct inventions; rather they are< different definitions of the same disclosed subject matter, varying in breadth or scope of definition." MPEP § 806.03 (emphasis added).

3. MPEP 806.05(c) - Criteria of Distinctness Between Combination and Subcombination
"To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a *>serious< search burden >if restriction were not required< as evidenced by separate classification, status, or field of search. See MPEP § 808.02." MPEP 806.05(c).

"The inventions are distinct if it can be shown that a combination as claimed:
(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and . . ." MPEP 806.05(c); *see also* Donald S. Chisum, Chisum On Patents (Matthew Bender, 2008) § 12.03 (explaining that under MPEP 806.05(c), "[t]he Office gives three examples for guidance in applying the first requirement, that is, that the particulars of the subcombination not be *essential to the patentability* of the combination." (emphasis added)).

4. 37 C.F.R. § 1.475 - Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage
"(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention'). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding *special technical features*. The expression 'special technical features'

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shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."
37 C.F.R. § 1.475(a) (emphasis added).

G. Disclosure and written description requirements may involve evaluation of essential novelty and essential or critical features of a claim

1. MPEP 608.01(p) - Completeness
"While the prior art setting may be mentioned in general terms, *the essential novelty, the essence of the invention*, must be described in such details, including proportions and techniques, where necessary, as to enable those persons skilled in the art to make and utilize the invention." MPEP § 608.01(p) (emphasis added).

2. MPEP 2163 - Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, "Written Description" Requirement
"The claimed invention as a whole may not be adequately described if the claims require an *essential or critical feature* which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art." MPEP § 2163(I)(A) (emphasis added).

H. Patent attorneys are trained to draft claims to include non-essential features solely to artificially increase the royalty base

1. Robert C. Faber, Landis on Mechanics of Patent Claim Drafting (Practicing Law Institute, 5th ed., Nov. 2007)

"Claim writers pursue claims to large combinations, and particularly narrower claims to large combinations, because *royalties or damages might be based on the value of the large combination* including the invention *instead of 'the Invention.'*" *Id.* § 8:4 (emphasis added).

As Landis explains, prior to 1969 the Patent Office would reject claims that included more elements than the actual invention under the formal ground of "old combination or overclaiming." *Id.* "In keeping with its custom of discarding or drastically liberalizing nonart rejections the C.C.P.A. threw out the classic 'old combination' doctrine in 1969." *Id.* (footnote omitted).

2. Jeffrey G. Sheldon, How to Write a Patent Application (Practicing Law Institute, Release 21A, Jan. 2008)

"§ 6.5.7 Claim the Environment of the Invention"

"*It is always desirable to have a high royalty base in litigation. One way to do this is by claiming the environment of an invention.* Referring to the prior 'toaster oven' example, a claim directed to a thermostat for a toaster oven has an inherently smaller royalty base

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than a claim directed to a toaster oven that includes the patentable thermostat. When negotiating a license or arguing damages before a jury, it would be better to work from a high royalty base that includes the entire toaster oven."
"As another example, most waterbed mattresses are used with waterbed frames, and many manufacturers provide frames with the mattress. Therefore, a patent directed to a novel waterbed mattress should also include claims for the combination of the frame and mattress to increase the possible royalty base."

Id., § 6.5.7 (emphasis added).

3. Steve Shear, "Excerpts from Working GuideBook: Drafting Patent Claims" (https://www.patentseminars.com/content/excerpts6.pdf?mainpage=booksforms6.asp&navigation=descripmenu.asp&menu=book)

". . . Why is it so important to consider drafting claims covering all of the system possibilities that the patentable product might be integrated into?

The answer has to do with damages and royalties that you might demand if your patent is infringed and/or a third party wants to negotiate some type of settlement or license and/or the judge/jury wants to award damages. If your patent has claims that merely cover the seat worth let us say $22 you will get less, no doubt, then if the patent claims cover not only the seat but also the entire bicycle or motorcycle.

Let me take an extreme example of this. Suppose your client has invented a new carburetor (selling for let's say $1200) especially suitable for use in one of those Peterbilt type over the road trucks (selling for in the neighborhood of $75,000). Clearly, you are going to draft end product claims to *the carburetor, the primary subject matter*. However, you will also want to have system claims to the truck itself including the carburetor. You may not win a royalty of 5% of the cost of the truck should you find yourself in the position to negotiate, *but I would bet you will get more than 5% of the carburetor cost that you would have received if you didn't have those truck claims*, which brings us to Absolute Rule #36.

MY ABSOLUTE RULE #36
After you have drafted end product claims (the primary subject matter) covering your invention, ask yourself (and the Inventor) if there are any systems into which the product in question is likely to be or could be integrated. If the answer is yes, you should consider preparing system claims including your product *in order to increase (hopefully) you[r] royalty/damage ceiling*."

Id. at 15 (italics added, underlying in original).

4. Bradley C. Wright, Drafting Patents for Litigation and Licensing (BNA 2008). (http://books.google.com/books?id=9cdbEU_2tbwC&pg=PA199&lpg=PA199&dq=patent+claim+drafting+damages&source=bl&ots=Z7p0pHFdSe&sig=Qu1_i1tSEPbgEuI4eHl

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Section 3.IV.R, "Maximizing Damages and Royalties Through Claim Drafting"
"Given that damages (whether in the form of lost profits or a reasonable royalty) will be based on what is claimed in the patent, patent attorneys can influence the amount of damages through careful claim drafting. Suppose, for example, that an invention relates to a new type of speech compression that can be carried out on a computer chip. A claim directed to the computer chip programmed with the inventive algorithm might have a royalty base tied to the value of similar computer chips that carry out similar functions. If such computer chips typically sell for $10 each and if a reasonable royalty is determined to be five percent of the value of the chip, the reasonable royalty for purposes of calculating damages would be 50 cents per computer chip. Suppose that the invention has potential applicability in devices such as mobile telephones whose value is $100 or more. . . . Suppose further that the patent drafter has included an apparatus claim covering a mobile telephone incorporating the novel computer chip . . . . *The patent owner would then have an easier time establishing infringement damages based on the more expensive combination of components, because the value of the patent would be measured by the claims.* Similarly, if the patent drafter included a claim directed to a computer system incorporating such a chip, the royalty base on which damages could be based would also be much higher than the base for a claim covering solely the computer chip. *Consequently, giving careful thought to particular industries and combinations in which the patented invention might be used can lead to claims targeting a broader royalty base.* In addition to the advantages these confer in litigation, such claims can strengthen the patent owner's position in licensing negotiations."

Id., at page 199-200 (emphasis added).

I. A sample of excerpts from file histories of U.S. patents shows that examiners often identify the inventive features of a claim as the reason for allowance

Below is a sample of brief excerpts from the file histories of five IBM U.S. patents with Arizona inventors. These file histories are available on public PAIR (at http://portal.uspto.gov/external/portal/pair). References are to the Examiner's reason for allowance for each issued U.S. patent.

1. Patent No. 7,444,478

"However, none of the prior art of record teaches that the modified segments threshold represents a number of segments that have been modified, as recited by the present claim, as amended." Notice of Allowance, page 4.

"There are many systems in the prior art that set indicators when a threshold is met or exceeded. Claim 1 avoids this interpretation by also specifying that the high priority out of sync indicator is reset when the number of modified segments is greater than the threshold; this, in combination with the added limitation that the modified segments

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threshold represents a number of segments that have been modified, is not taught by the prior art of record." Id., page 5.

2. Patent No. 7,490,203

"As per independent claim 1, prior arts of record fail to teach or suggest writing by each of the processing systems, data used by the processing system to the logical device assigned to the processing system in the shared storage device in response to receiving the signal and in response to obtaining the requested lock." Notice of Allowance, page 3.

3. Patent No. 6,941,328

"Claims 2-5, 9-12, 15-17 are allowable over the prior art of record because the prior art of record fails to teach or fairly suggest receiving operation comprising reviewing contents of the source data to identify individual data objects therein, and also reviewing any aggregation data objects in the source data to identify all constituent data objects thereof, wherein the applying and forming operations are performed separately for each data object whether in individual or aggregated form, as detailed in independent claims." Notice of Allowance, page 2.

4. Patent No. 7,496,952

"As per claims 1, 9, 15, and 16, generally, the prior art of record, United States Patent No. 5,941,947 to Brown et al. and United States Patent No. 6,609,113 to O'Leary et al., fails to teach alone, or in combination, other than hindsight, at the time of the invention, the features as discussed and remarked upon in the response of 07/14/08. Nowhere in the prior art is found, collectively, the italicized claim elements (i.e., 'wherein the operation of comparing the person's input credentials to the set of access credential information for node users at least partially overlaps in time with the operation of comparing the person's input credentials to the set of access credential information for admin users; wherein the node table contains a set of access credential information for a different class of users than the set of access credential information contained in the admin table') at the time of the invention; serving to patently distinguish the invention from said prior art." Notice of Allowance, page 2.

5. Patent No. 7,483,927

"In independent claim 16, a method comprising the teaching of 'generating a token identifying the merged metadata; and receiving a subsequent query with the token from the client node, wherein the token is used to execute the subsequent query against the merged metadata identified by the token,' taken with the other limitations of the claim, were not disclosed by, would not have been obvious over, nor otherwise fairly disclosed by the prior art of record." Notice of Allowance, page 2.

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Trilateral Offices Conference: "Working Together Toward a Sustainable Patent System"

The Time Has Come to Harmonize Around the PCT

Good morning; it is a pleasure to join you today. Thanks to the EOP and President Brimelow for hosting this meeting, and for giving me the opportunity to speak.

I will briefly address 5 points today:

1. 21st Century innovation environment
2. Challenges faced by patent system within that environment
3. Comments on recent efforts to address challenges
4. the PCT as the long-term sustaining answer
5. End with animated demonstration of a future vision for patent offices working together under the framework of the PCT

- Looking at innovation environment starting off the 21st century, you see major shifts taking place:
  - IP is becoming the focus of competition
  - Innovation is the top CEO level concern
  - New models for collaboration have taken hold
  - Clearly, we need a strong patent system in this environment, but it also needs to be more integrated, open, flexible
  - And then there are the patent system challenges, reflecting these major trends:
    - Filing rates are increasing.
    - Patents are becoming increasingly important as information and inventions become more valued assets.
    - The time from idea to product is shrinking, further stressing a system already collapsing under the load.
    - We also know that these issues are not localized, but that the importance of patents and innovation is expanding globally, prompting interests in developed and developing countries worldwide.
  - The goal in addressing these problems is not merely to maintain or sustain, but to change the global patent system to meet the demands of the 21st century. The problems – they're shared problems – shared among patent applicants and the offices – and the solutions will be – must be – shared solutions, with all members of the patent community changing our practices.

- The recent announcement by the trilateral offices plus SIPO and KIPO of a cooperative framework is a positive step. But there is lots more we can do:
  - We need to take cooperation and collaboration among patent offices to another level so that duplication of effort is minimized and trust among the offices is maximized. Said differently, together we must do with the collective major patent offices what we've already done in the business world to benefit from globalization and collaboration opportunities brought about by information technology advances.

There we already facilitate, expect, and even demand that colleagues collaborate across time zones, languages, companies, and different legal regimes. We tie supply and value chains together end-to-end globally – systems and processes involving far greater complexity and far more people than are involved in all the patent operations around the world put together.

- If we can do it in the business world, we – together – can do it in the patent world.
- What is needed:
  - A global collaborative program that creates real leverage:
  - More than just an examiner receiving a document from another examiner and taking action in isolation, but a process by which examiners (and others as well) exchange insights, facts, views, strategies, and perspectives on a real-time basis.
  - This type of interaction not only saves time but enhances examination quality in the various offices, enabling best practices, best prior art, and best arguments to enhance the operations of all the offices.

- This type of collaboration will require some courageous actions – implementation of ideas that challenge old assumptions and interests. But, as the challenges intensify, so must our creativity and fortitude to address those challenges.

- The problems we're discussing here are global - they affect all industries across all geographies. To address them, the patent system must evolve to operate globally and cooperatively.
  - Bilateral treaties are helpful toward probing for best practices, and for gradually untying Gordian knots. But bilateral treaties are inherently sub-global, and sub-optimal.

- So we've got some tough problems, and some current solutions that are sub-optimal.
- But a comprehensive solution is available to us – it's the PCT.
- We can address our myriad challenges through the framework of the PCT – it is the closest existing framework to what is needed.
  - The uniformity of procedure, the widespread acceptance of PCT, the openness of participation, and openness in process provide a good and efficient foundation for strengthening the infrastructure of the global patent system.
  - The common timescales of the PCT provide a framework to synchronize the work of patent offices and facilitate truly global search and examination.

- As a first step toward a common PCT-based system, industry and offices should agree on a standard of search and exam that has broad acceptability and applicability across geographies. This standard should focus on process (e.g. databases to search...) rather than substantive patent law.
  - With groundrules set, real efficiency and real collaboration during search and search report preparation can be achieved.
  - With groundrules set, collaboration can take place across worldwide patent offices, between patent offices and the public, and among the public.

- With groundrules set, common work-saving tools can be used by examiners worldwide to achieve uniform, superior, more certain results

THE PCT HAS SHORTCOMINGS, BUT THEY CAN BE OVERCOME

- Trust and credibility across patent offices can be established.
  - International searches conducted in some offices are not trusted in other offices – but there would be no such issue of trust if all offices participated in the international search.
  - International examiner opinions from some offices are not universally respected - this arises from variations in patentability standards, differences in grace periods, variations in patentable subject matter; numbers and styles of claims, etc – but again, with collaboration, the important issues would surface and be addressed at the earliest possible stage of examination.

- International search and examination are not currently broadly accepted, or in some cases, even used in the national search and examination
  - With rigorous application of the framework already embodied in the PCT, international search and examination can be uniformly raised to a global standard – then international search and examination will be uniformly accepted.

WHAT WE (INDUSTRY AND PATENT OFFICES) NEED TO DO

- Three major actions are needed.
- First, it's the PCT: recognize that the PCT is the appropriate direction.
  - Embrace the PCT as the framework of choice to improve the system to address our many challenges.

- Second, establish quality standards among the trilateral patent offices:
  - Define what it means to perform a quality examination. Standardize across offices, and tie to rewards and accountability.
  - Drive improvements in the quality of search and exam to a new level that yields search results and examiner opinions having credibility and applicability everywhere → grow trust and confidence in the PCT.
  - Specifically, create the "global" search where:
    - Search examiners from multiple offices/geographies define, share and evolve search terms, then focus on searching their own portion of the prior art.
    - The international search becomes global search, including results from multiple collaborating search examiners.
    - Peer to Patent which has been endorsed by U.S. President Elect Obama, is utilized to enhance search results by leveraging collaboration with and

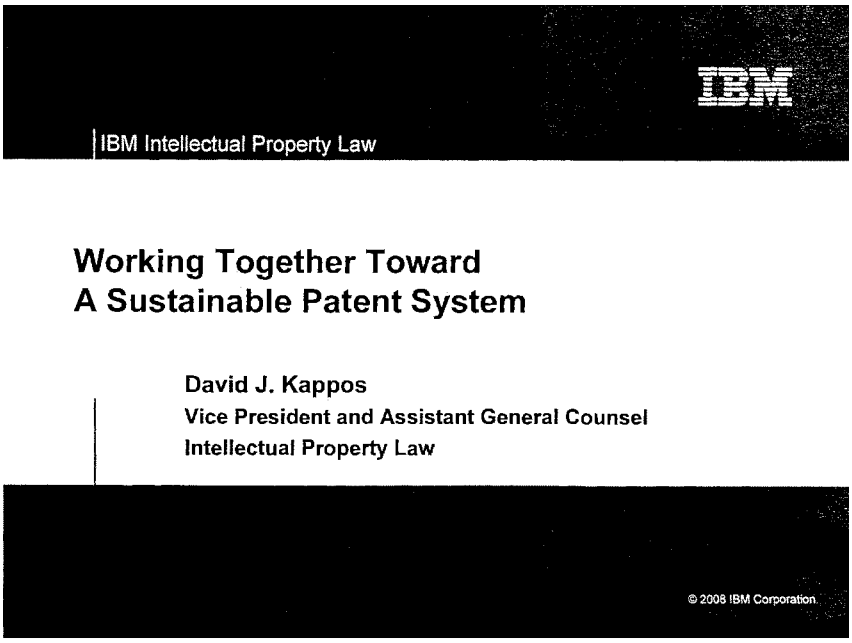
among the public – particularly in a multilateral format instead of multiple, separate efforts.

- Capability of P2P could be expanded - results of collaboration automatically sent to all offices that have counterparts of the subject application.
- Pilots began in US in 07, Japan in 08 (UK planning for 09, other countries also considering). Experience to date in U.S. and Japan very encouraging.

- Moreover, comments of an examiner from another office should be considered presumptively correct – especially where examiner cites and translates the meaning of a document in his/her native language. Applicant must challenge/overcome the presumption if desired.

- This leads to the global quality examination: Drawing on the search results, examiners automatically find and collaborate with each other electronically to ensure common understanding and application of the prior art - sharing materials, ideas, approaches, objections, exam reports, relevant art, and information properly submitted by others.

- Third, and finally, the PCT-based vision of examiners across the trilateral offices collaborating during application examination will require 21st Century tools to effortlessly facilitate that collaboration.


IBM
IBM Intellectual Property Law
Working Together Toward
A Sustainable Patent System
David J. Kappos
Vice President and Assistant General Counsel
Intellectual Property Law
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Environment

Innovation is top issue for CEOs

Economic challenges create a new IP marketplace

Increased competition for ideas

Strong patent systems required to enable collaboration

The past:

- Proprietary
- Controlled
- Unique

The future:

- Open
- Collaborative
- Shared
- Integrated

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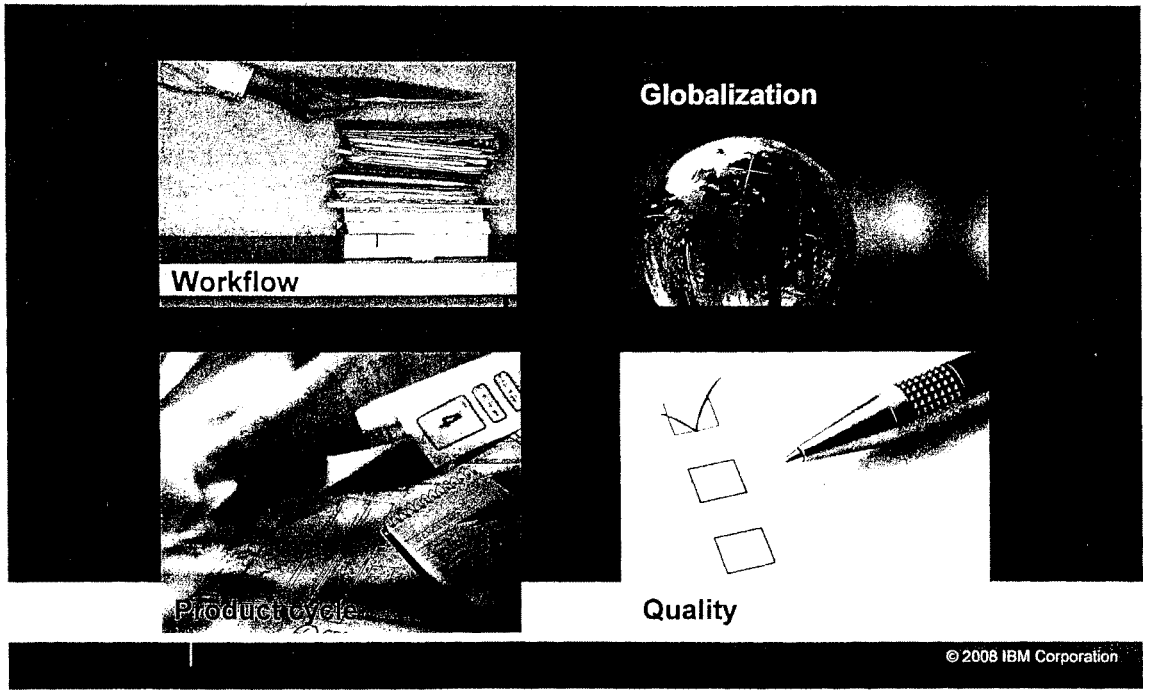
Challenges faced by patent offices



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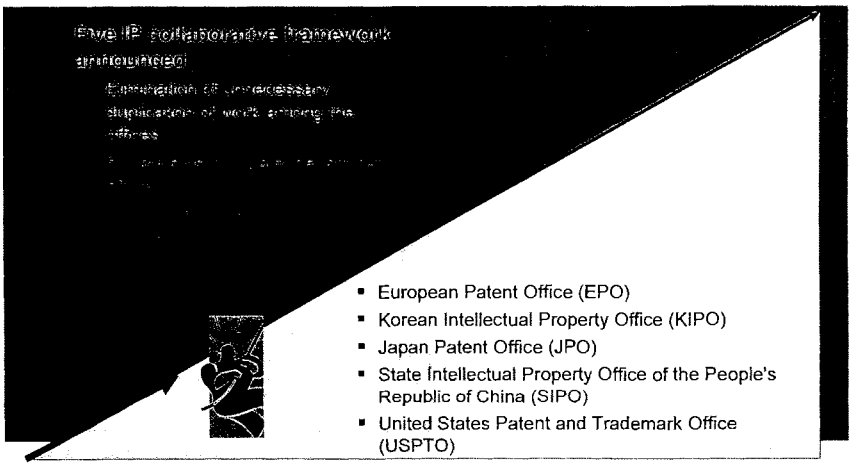
Advances in patent office collaboration



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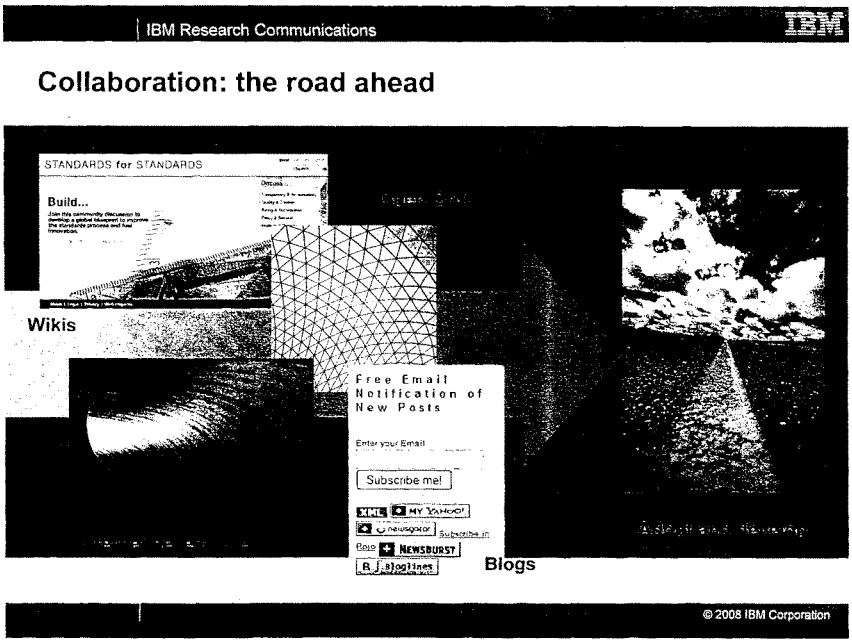
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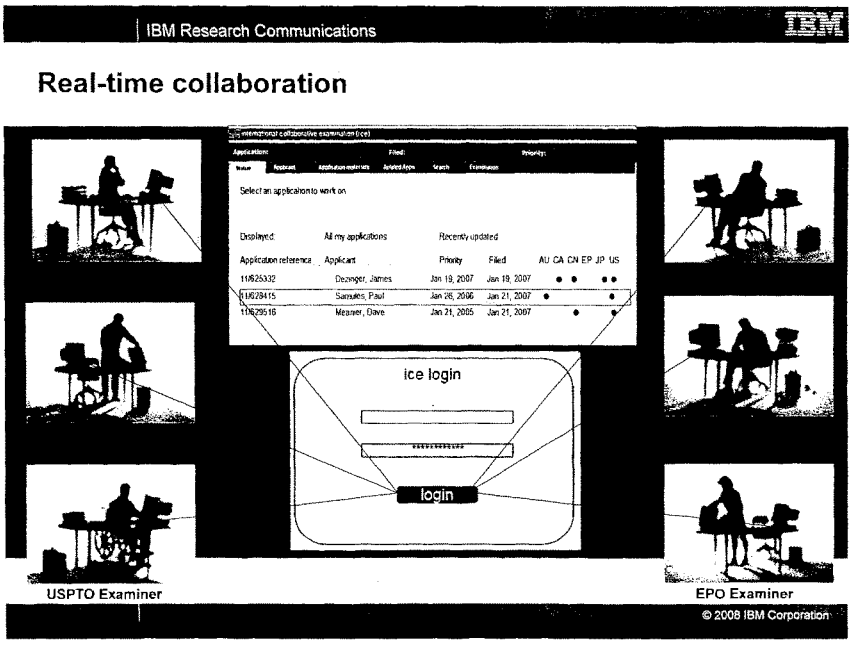
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IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
(Alexandria Division)

SMITHKLINE BEECHAM CORPORATION, d/b/a GLAXOSMITHKLINE, SMITHKLINE BEECHAM PLC, and GLAXO GROUP LIMITED, d/b/a GLAXOSMITHKLINE, Plaintiffs, v. JON W. DUDAS, in his official capacity as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and UNITED STATES PATENT AND TRADEMARK OFFICE, Defendants.	Civil Action No. 1:07-CV-01008-JCC-TRJ

DECLARATION OF DAVID J. KAPPOS, ON BEHALF OF IBM, IN SUPPORT OF AIPLA AMICUS BRIEF IN MATTER OF GSK PRELIMINARY INJUNCTION MOTION TO STAY NEW PTO RULES

I, David J. Kappos, declare under penalty of perjury that:

I am the Vice President and Assistant General Counsel, Intellectual Property Law, of International Business Machines Corp. ("IBM"). The matters referred to in this declaration are based on my personal knowledge and if called as a witness I could, and would, testify competently thereto.

1. International Business Machines Corp. ("IBM") of Armonk, New York, employs over 380,000 people worldwide in its information technology business with over 120,000 of those employees being in the United States.
2. IBM spends approximately $6 billion each year in developing leading edge products and services across a broad range of computer hardware, software and services, and in performing advanced research in laboratories in the United States, Europe and Asia.

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3. In addition to its own innovation in product and service development and advanced research, IBM collaborates with others including those at universities and many other information technology enterprises.
4. IBM attracts the highest caliber of information technology scientists, product developers, and technical personnel. IBM employees have received honors and recognition from the scientific community including 5 Nobel prizes, 10 inductions into the National Inventors Hall of Fame, 5 National Medals of Science, 6 Turing Awards and numerous memberships in the National Academy of Sciences and National Academy of Engineering.
5. Many IBM employees are inventors and, as a result, IBM has been the number one U.S. patentee for the past 14 years.
6. IBM is aware of the new USPTO rules published August 21, 2007, and is currently engaged in an intensive effort to determine what is required to comply with the new rules, and to undertake the actions necessary to effect compliance.
7. Due to retroactivity requirements imposed by the new USPTO continuation and claims rules published August 21, 2007, IBM will be required to review its entire portfolio of over 25,000 pending U.S. patent applications filed before November 1, 2007 (the effective date of the new USPTO rules) to identify each of its pending patent applications which, even by chance, has a common inventor and the same filing date (or claims the same benefit or priority date) as another pending IBM U.S. patent application or issued patent, since IBM must identify all such "related" cases to the USPTO under new USPTO Rule 78(f)(1).
8. An initial search shows IBM has nearly 30,000 "related" pairs of cases to consider and approximately 10,000 of such "related" cases to identify to the USPTO under new Rule 78(f)(1). The vast majority of these cases were filed before the new rules were published or otherwise known to IBM, and all were filed before the effective date.

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9. Once such "related" cases are identified, the new USPTO rules require IBM to review the "related" cases to determine if they have "substantial overlapping disclosure" and, if so, IBM must take action as set forth in new USPTO Rule 78(f)(2) to address a newly created rebuttable presumption of "patentably indistinct" claims under new USPTO Rule 78(f)(2). IBM expects that in a large number of cases this action will require preparation and filing of rebuttals explaining how the "related" cases contain only patentably distinct claims, or filing of terminal disclaimers with explanations of why there are two or more "related" cases containing patentably indistinct claims.
10. If the arguments made by IBM in response to the Rule 78(f)(2) requirements are not accepted, IBM will likely be forced to cancel claims or combine patent applications. Any claims cancelled will mean an irreparable loss of rights in patent applications filed before the new rules were in effect, published or otherwise known.
11. To comply with the retroactive requirements of new Rule 78(f), IBM must start incurring expenses now to change its internal patent application docketing system, to locate and track the thousands of pre-existing "related" cases that must be identified to the USPTO, and to prepare to take action in those pre-existing cases as required before the February 1, 2008, deadline set for those actions under the new USPTO rules.
12. To comply with the retroactive requirements of new Rule 78(f), IBM must also start incurring outside counsel expenses now to obtain advice on complying with the requirements with respect to thousands of applications outside counsel are handling for IBM.
13. To comply with the retroactive requirements of new Rule 78(f), IBM must also begin changing its patent application prosecution practices in pre-existing applications, which will irreparably result in a loss of intellectual property rights for applications which were in proper form under the previous USPTO rules but which now need either to have

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claims cancelled or to have the application abandoned to comply with the new USPTO rules.

14. To comply with the retroactive requirements of new Rule 78(f), initial estimates are that IBM will incur over 10 million dollars in legal fees and internal expenses, not including the loss to IBM of the value of intellectual property rights foregone by IBM to comply with the new USPTO rules.

15. The expenses IBM incurs in responding to the retroactive requirements of the new rules will divert resources that otherwise would be directed to the protection of new IBM intellectual property. This diversion will result in irreparable loss to IBM of intellectual property rights.

I declare under penalty of perjury that the foregoing is true and correct, to the best of my knowledge and belief.

Executed on this 24th day of October, 2007.

_____

David J. Kappos

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(2) Compliance with new Rule 78(f)(2) for applications filed before November 1, 2007 does not help improve patent quality or reduce the backlog of unexamined patent applications being handled by the USPTO and may even increase patent application pendency. Applying Rule 78(f)(2) to currently pending applications will only result in the USPTO receiving many new prosecution papers such as reports of "related" cases, rebuttals of presumptions of patentably indistinct claims, terminal disclaimers with explanations of why there are two or more pending applications with patentably indistinct claims, etc., which USPTO Examiners will need to review and act upon. This will consume substantial Examiner time, thereby slowing prosecution of these pending applications. However, this activity is unlikely to reduce the number of pending patent applications beyond what would result from current prosecution which already requires patent applicants to disclose to the USPTO information material to patentability under Rule 56. The net effect is increased burden on Examiners with little or no reduction in the backlog of pending patent applications beyond what the USPTO will achieve under the new rules applied only prospectively, in conjunction with current Rule 56.

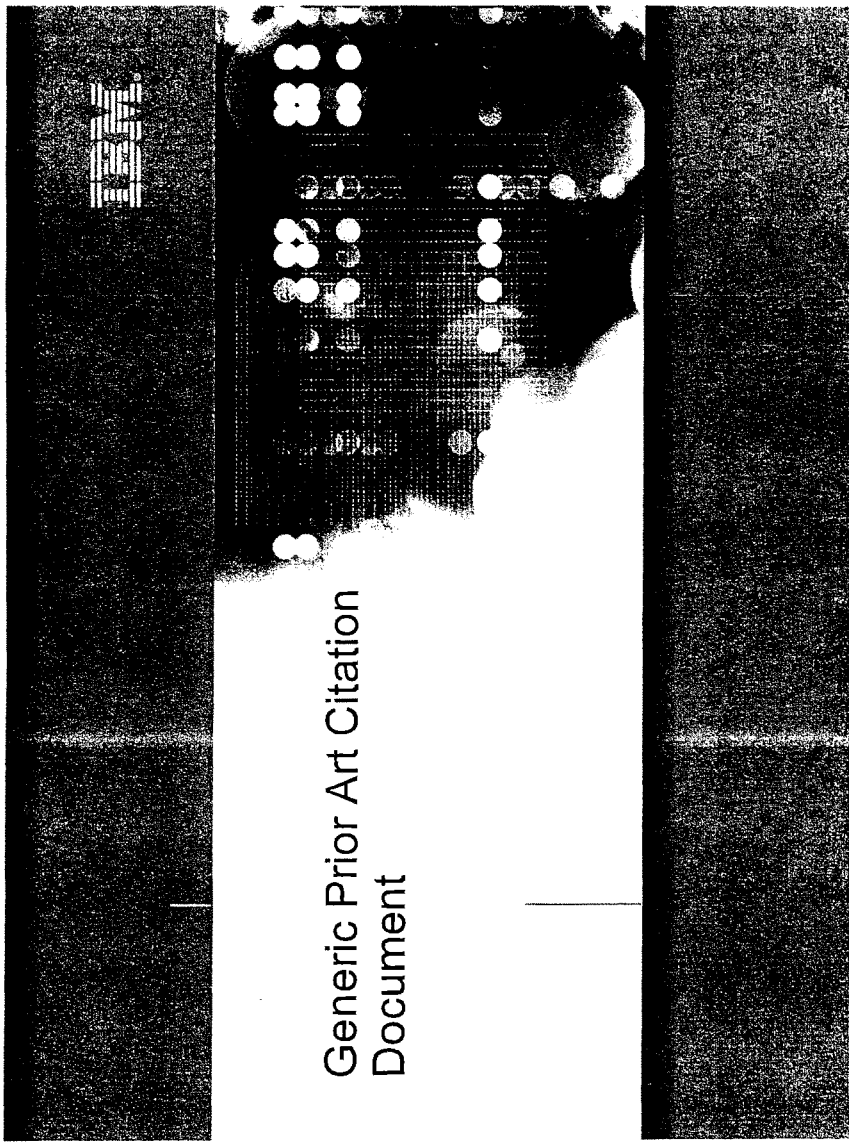
(3) Compliance with new Rule 78(f)(2) for applications filed before November 1, 2007 unnecessarily impinges on patent application filing strategies applicants may have undertaken in the past in full compliance with USPTO rules in effect at that time. For example, an applicant who may have separately filed on the same day related apparatus and method claims in properly cross-referenced patent applications with a common specification and common inventor, or who is prosecuting in parallel continuation or divisional applications with claims in different statutory classes, will likely need to comply with the rebuttal requirements of new Rule 78(f)(2)(ii)(A) which could limit claim scope in both applications. This would be unnecessary if new Rule 78(f) applied only to applications filed after November 1, 2007. Going forward, patent applicants can adjust their filing strategies in view of the new USPTO rules in ways not possible with respect to their pending patent applications filed before November 1, 2007.

In view of the foregoing, we request that the USPTO waive the requirements of new Rule 78(f) for all patent applications filed before November 1, 2007

Sincerely,

David J. Kappos
Vice President & Assistant General Counsel
Intellectual Property Law

cc: Hon. Margaret J. A. Peterlin
Hon. John J. Doll
James A. Toupin
Eleanor Meltzer


Generic Prior Art Citation
Document



Drawbacks of the current system

- Duplication of effort by the different patent offices
  - Reduced legal certainty for the applicant and the public at large
  - Unnecessary expenses at patent offices, passed on to applicants
  - Longer processing times
- Duplication of effort by applicant, who must submit the same information in different ways, on different forms and in different languages for each patent office.





The proposed solution

- **Generic Prior Art Citation Document**
  - To be used by all patent offices and applicants,
  - In all circumstances concerning the recordal of prior art documents,
    - Official search reports,
    - US Information Disclosure Statements and
    - EPO post filing acknowledgement of the prior art
  - The document is based on the PCT International Search Report form, and as such would be easily adopted for PCT and EPO searches
  - A family of patents will gather a number of citation documents as the individual family members progress, which will lead to the formation of a contiguous series of documents listing all prior art relevant to the family as a whole.
  - A standard Generic Citation Document specification is recommended, defining the format of the document.



CITATION DOCUMENT

Citation Document Type	Index
"d" disclosure at filing or IDS	Consecutive numbering of citation documents for the patent family
"e" official search report (Shaded cells reserved for this type)	
"f" post-filing acknowledgement of prior art	

Application no.

A. CLASSIFICATION OF SUBJECT MATTER

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum Documentation Searched (Classification system followed by classification symbols)

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the search (name of data base and, where practical, search terms used)

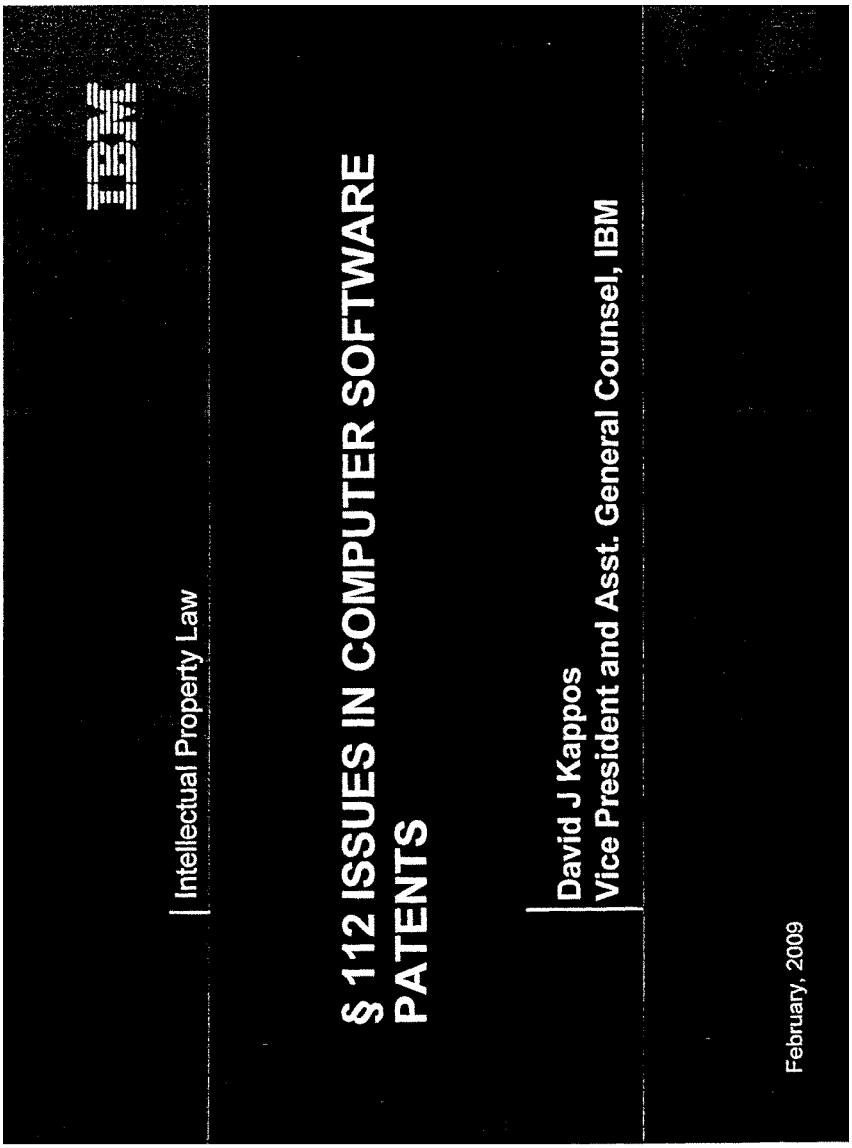
IDS only Examiner initials*	Category*	C. DOCUMENTS CONSIDERED TO BE RELEVANT Citation of document, with indication, where appropriate of the relevant passages	Voluntary comments attached	Relevant to claim No.



Advantages of the proposed solution

- **Facilitates reuse of search and disclosure information from earlier related applications.**
  - Standard layout means that the form can be completed or understood even if it is in a language with which the user is unfamiliar
- **Promotes the establishment of a single repository of citation information for a patent family as a whole, augmented by different protagonists during the course of patent examination.**
- **Complements and enhances the search sharing proposal of the five major intellectual property offices (IP5) by ensuring that citations from each office are available in a standardised form easily recognizable to the examiners of other offices.**
- **Reflects the IP5 goal of reusing and building upon the work of other offices.**




IBM
Intellectual Property Law
§ 112 ISSUES IN COMPUTER SOFTWARE PATENTS
David J Kappos
Vice President and Asst. General Counsel, IBM
February, 2009

Agenda

- There is a crisis of clarity in IT patents
- Courts and the PTO are seeking solutions
- Focus on "Best Practices" promotes patent quality
- Change is inevitable

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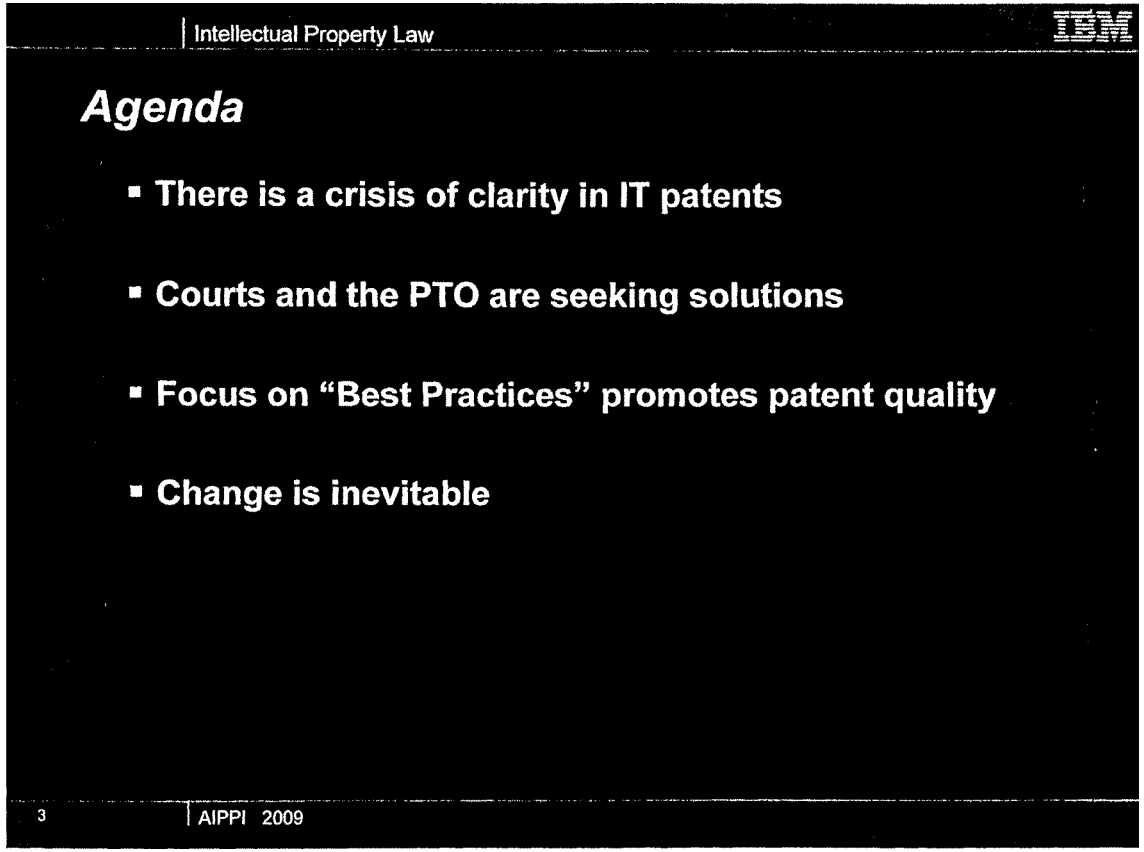

62345.173

There is a crisis of clarity in IT patents

- Courts & PTO rely too heavily on 101, 102, and 103 to evaluate patentability, forcing these tools to apply where 112 would address specific problems more precisely.
- 112 is not stressed in examination.
  - Patents claim results, e.g. "single means" for achieving the desired function.
  - Problem is particularly acute in IT, where there has never been a single, comprehensive, standard lexicon (compare the chemical arts, where basic components enjoy generally-accepted meanings, i.e. through the use of the periodic table).

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There is a crisis of clarity in IT patents

"By improving predictability and clarity in our patent system, we will help foster an environment that encourages innovation. Giving the Patent and Trademark Office (PTO) the resources to improve patent quality . . . will reduce the uncertainty and wasteful litigation that is currently a significant drag on innovation."

-- President Obama's Technology and Innovation Plan

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Agenda

- There is a crisis of clarity in IT patents
- Courts and the PTO are seeking solutions
- Focus on "Best Practices" promotes patent quality
- Change is inevitable

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Courts and the PTO are seeking solutions

- Ex parte Miyazaki – precedential decision of BPAI (November 19, 2008). Board accords examiners more discretion in rejecting claims for failure to comply with 112 than is accorded courts for invalidating issued patent claims.
  - Examiners may reject claims as ambiguous without using CAFC constructs to preserve validity.
    - "The applicant has an opportunity and a duty to amend the claims during prosecution to more clearly and precisely define the metes and bounds of the claimed invention and to more clearly and precisely put the public on notice of the scope of the patent."
  - During examination, applicants must recite "means for" to trigger coverage under 112(6).
- Continuation rules proposal; accelerated examination
  - Attention to 112 issues, i.e. through ESD.

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Courts and the PTO are seeking solutions

"The USPTO, as the sole agency vested with the authority to grant exclusionary rights to inventors for patentable inventions, has a duty to guard the public against patents of ambiguous and vague scope. Such patents exact a cost on society due to their ambiguity that is not commensurate with the benefit that the public gains from disclosure of the invention." -- Ex parte Miyazaki

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Courts and the PTO are seeking solutions

The Federal Circuit agrees:

"We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation."

-- Halliburton Energy Servs. v. M-ILLC 514 F.3d 1244, 1255 (Fed. Cir. 2008)

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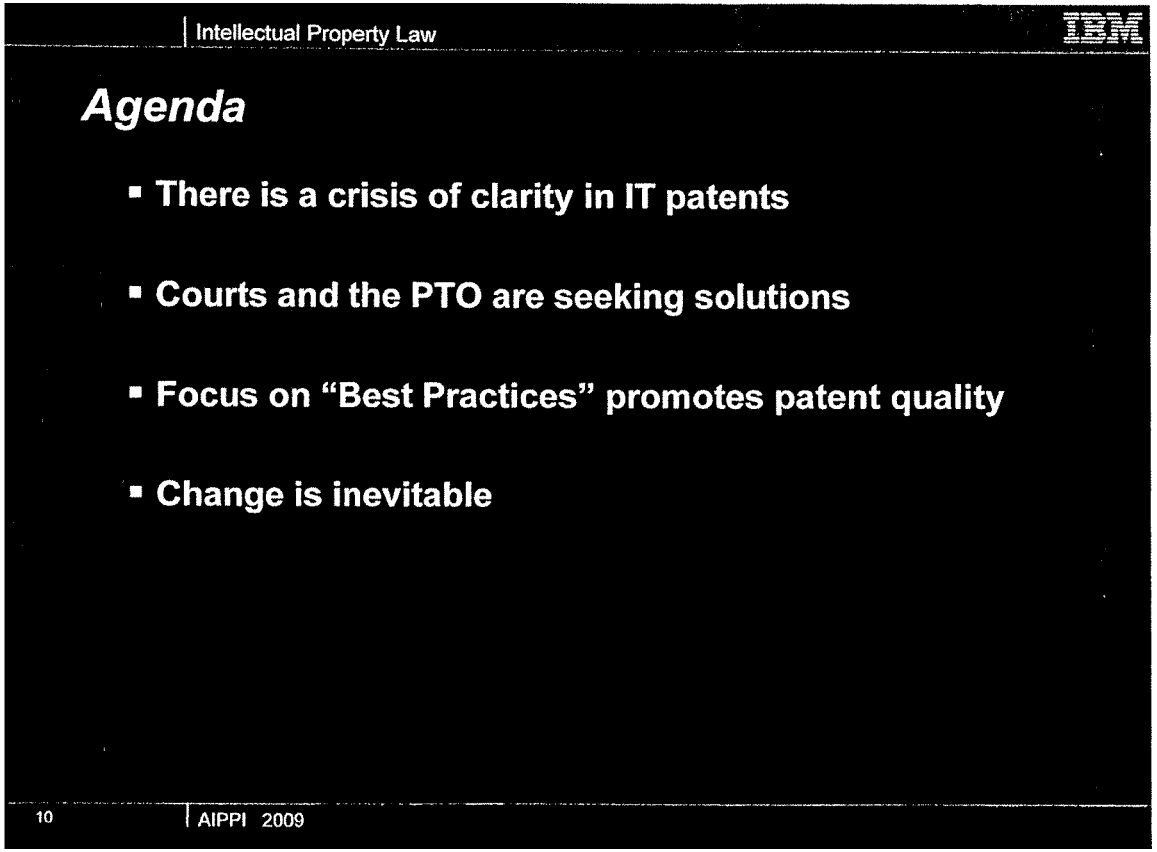

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Focus on best practices will promote patent quality

- Use plain English – don't invent claim terms unless absolutely necessary to define the invention, and only if a glossary of claim terms is used.
- Ensure that every claim element is shown in the drawings and explained in the specification.
- For "means plus function" claims, ensure that the specification includes the necessary structure to support the claims.
- Use electronic tools, where available (e.g. Lexis optimizer) to catch drafting errors.
- If you can not describe the invention clearly and unambiguously, there may not be one.

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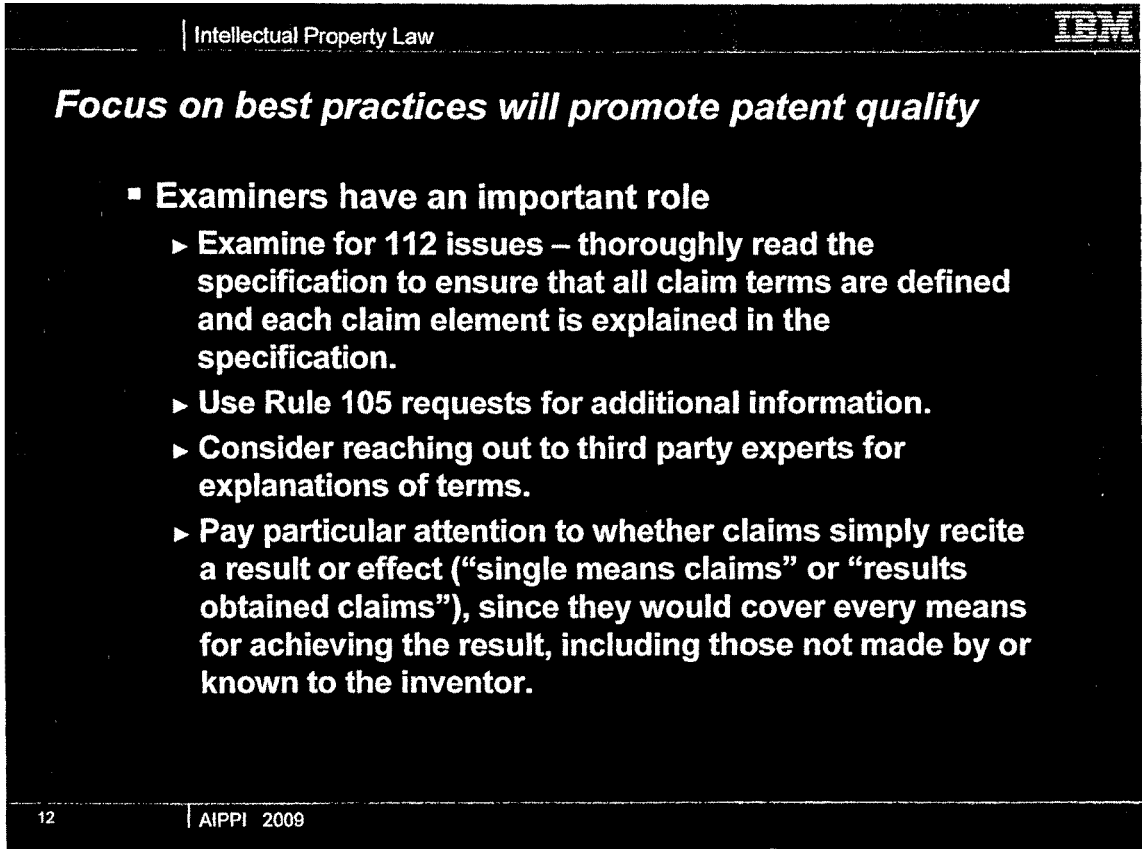

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Focus on best practices will promote patent quality

- Validity challenges – litigation
  - Evaluate claim terms for words that imply a structure but in fact are merely substitutes for "means for".
  - Consider whether the PHOSITA for satisfying enablement and written description requirements during examination has the same skill/knowledge level as the PHOSITA for determining obviousness.

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Consistent PHOSITA for 112 and 103

112: Clarity

Sufficiency of specification
Clarity of claims

Promotes:
Public Notice
Advances state of the art

Novelty and Nonobviousness

Level of advance
Relationship to prior art

Promotes:
Patent Quality
Proper balance of incentives

PHOSITA

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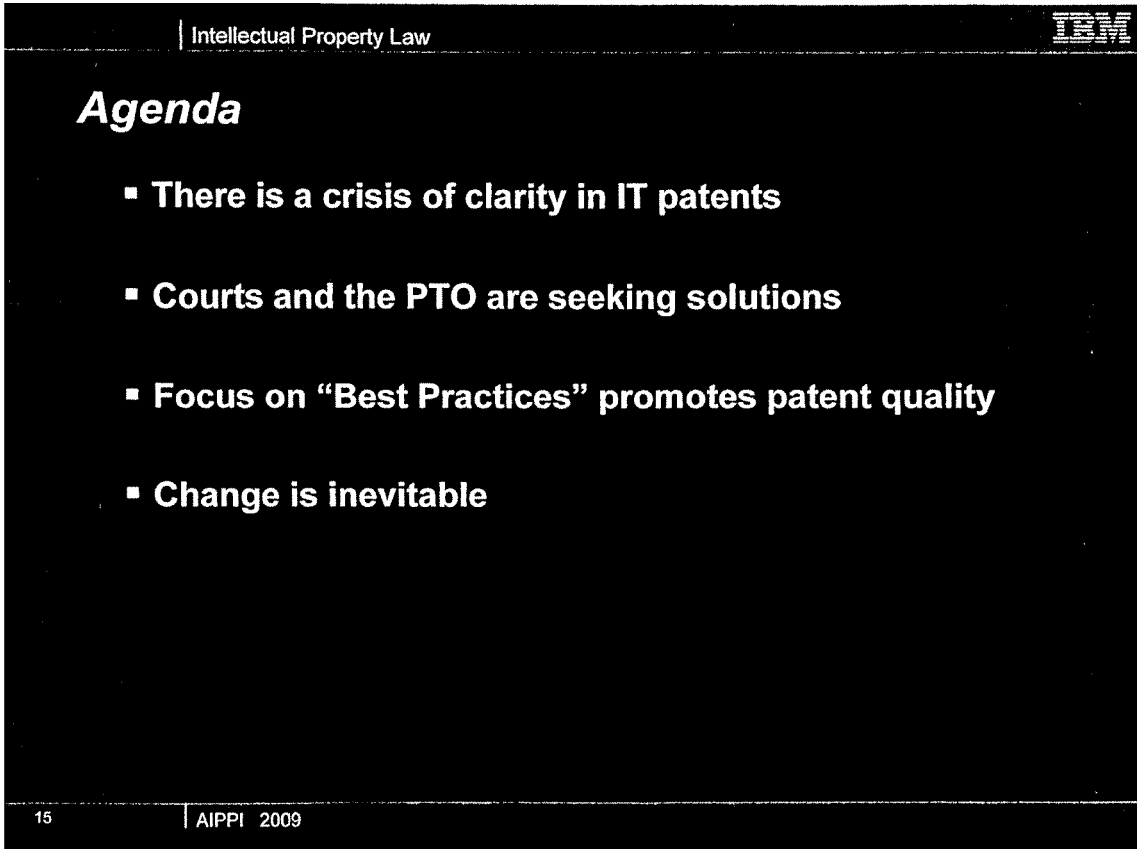

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Change is inevitable

"My Administration is committed to creating an unprecedented level of openness in Government. We will work together to ensure the public trust and establish a system of transparency, public participation, and collaboration. Openness will strengthen our democracy and promote efficiency and effectiveness in Government."

- WHITE HOUSE MEMORANDUM FOR THE HEADS OF EXECUTIVE DEPARTMENTS AND AGENCIES on Transparency and Open Government

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Changes in PTO practice

- Requirement for IDS/1449 – style check off list correlating claim terms to the specification.
  - E-filing may allow hyper-linking.
- Require applicants to provide a detailed showing of support in the specification for claim amendments and new claims, for example those presented in a CIP application.
- Support inclusion in post grant review of 112 issues.
- Provide advisory opinions regarding the meaning of claim terms for a fee.
- Consider sponsoring on-line dictionary of terms built by the public or identifying preferred existing dictionaries.
  - These definitions would be controlling unless the applicant clearly provides an alternate definition.
- Use on-line collaboration, such as P2P, for 112 issues during examination.

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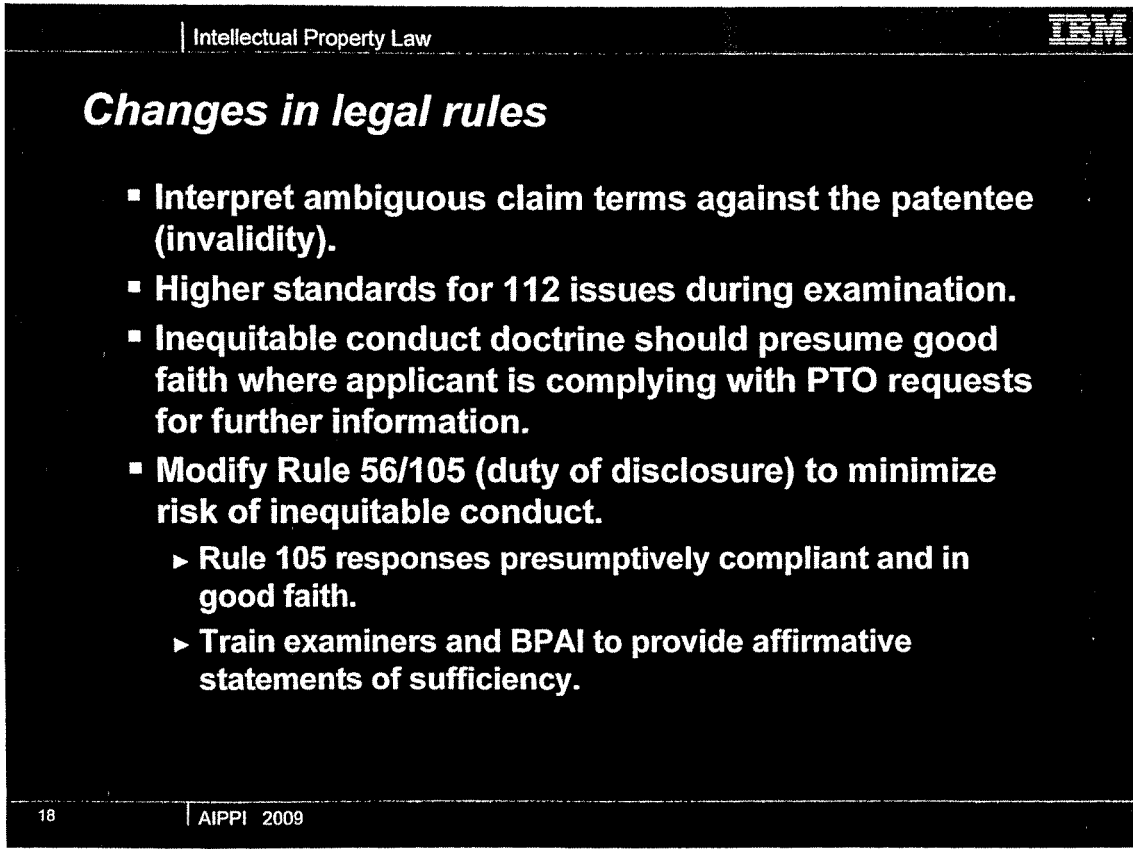

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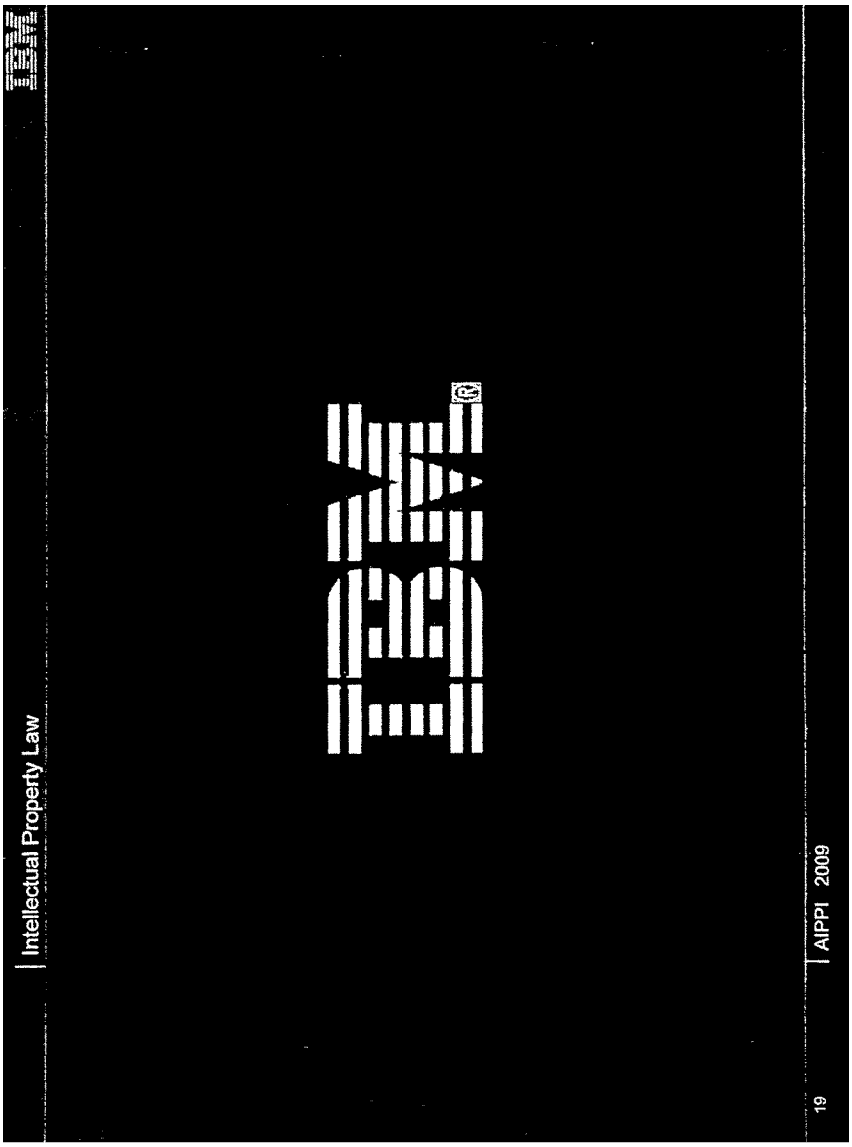
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Intellectual Property Law
19
AIPPI 2009

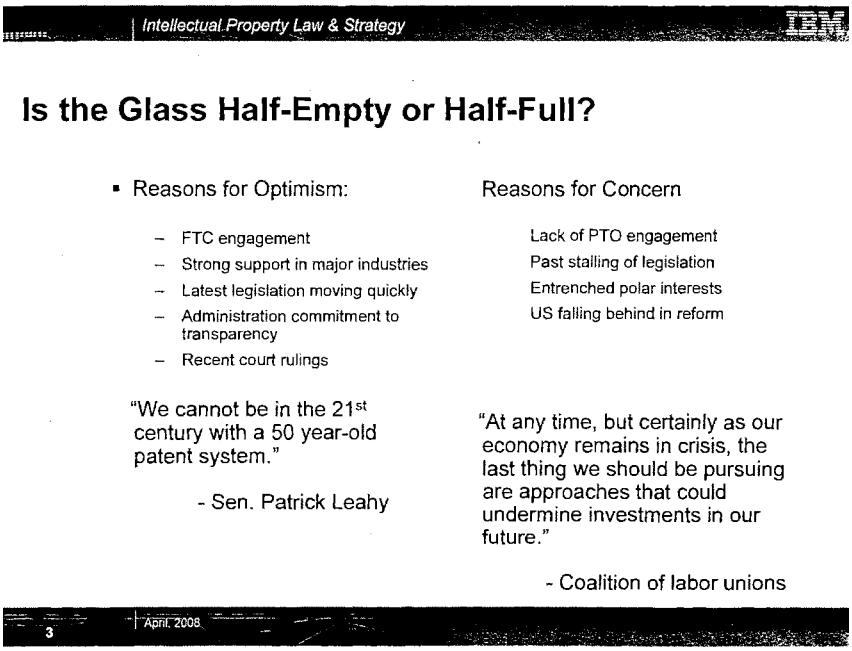


US Patent Reform: Is it Within Reach?

David J. Kappos
Vice President & Assistant General Counsel
IBM IP Law & Strategy




Intellectual Property Law & Strategy
IBM
The Need for Reform is Growing
▪ Weakening economy
▪ Diversion of innovation resources to litigation issues
▪ Continuing crisis in patent quality
▪ Growing backlogs
▪ Increasing interconnectedness of products, components, technologies
▪ Global integration requires more harmonious systems
2
April 2008


Intellectual Property Law & Strategy
IBM
Is the Glass Half-Empty or Half-Full?
Reasons for Optimism:
FTC engagement
Strong support in major industries
Latest legislation moving quickly
Administration commitment to transparency
Recent court rulings
"We cannot be in the 21st century with a 50 year-old patent system."
- Sen. Patrick Leahy
Reasons for Concern
Lack of PTO engagement
Past stalling of legislation
Entrenched polar interests
US falling behind in reform
"At any time, but certainly as our economy remains in crisis, the last thing we should be pursuing are approaches that could undermine investments in our future."
- Coalition of labor unions
3
April, 2008

Congress is Actively Seeking Legislative Solution

- 2007: Progress Stalled
  - Passed by House but Senate never voted
  - Presidential election intervened
  - Venue, damages, inequitable conduct, post-grant opposition, AQS all unresolved

2009: New Momentum

- Bi-cameral, bi-partisan bill introduced
- Senate hearings held quickly
- Venue, post-grant opposition appear resolved
- AQS omitted, inequitable conduct omitted for now
- Consensus building around approach to resolve damages issue

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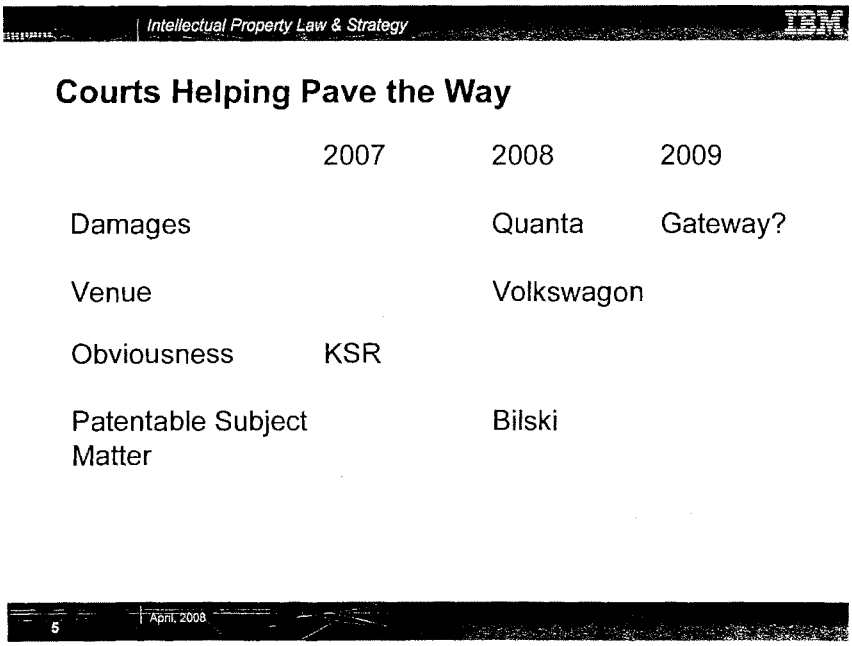
Intellectual Property Law & Strategy
IBM
Courts Helping Pave the Way
2007
2008
2009
Damages
Quanta
Gateway?
Venue
Volkswagon
Obviousness
KSR
Patentable Subject Matter
Bilski
5
April, 2008

Resolving Related Issues

- Deferred examination
- Innovation tools for patent quality and transparency are working
  - Peer to Patent
  - PQI
- Tri-lateral discussions on Research sharing
  - I.C.E.

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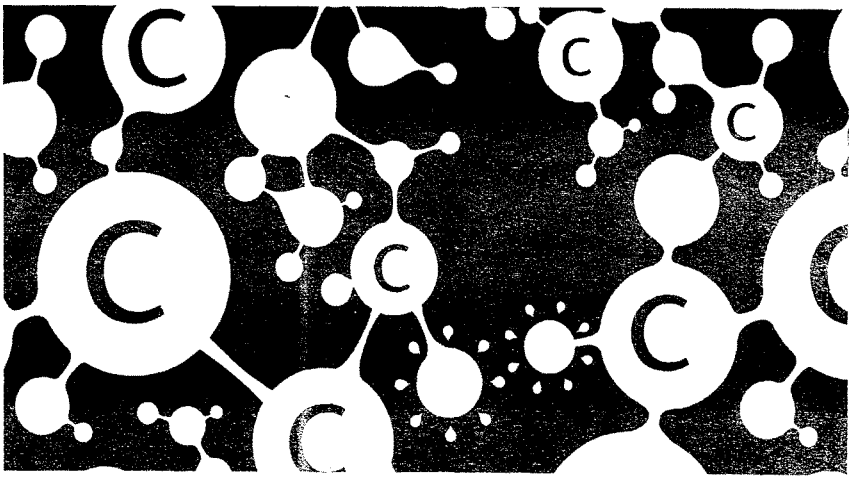

eco-patent

WBCSD Liaison Delegate Meeting

David J Kappos, Esq.
Vice President and Assistant General Counsel, IPLaw and Strategy
IBM Corporation

AIPPI Meeting – September 2008

www.wbcsd.org



- A new initiative launched by four companies and the WBCSD on January 14, 2008
  - IBM, Nokia, Pitney Bowes and Sony
- A collection of patents that directly or indirectly improve or protect the environment
- Patents are pledged by companies and other intellectual property rights holders
  - Made available to anyone for use free of charge
  - Provided on dedicated public Web site hosted by WBCSD
- A leadership opportunity for global business to help protect the planet

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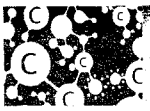

- Sharing patents that protect the environment is a way to:
  - Address a wide range of challenges and threats to our planet
  - Foster new collaboration and innovation
- Businesses may hold patents that provide environmental benefit and are not an essential source of business advantage for them
  - May provide greater value in a public commons
  - Businesses not expected to contribute their 'crown jewels'
- The Commons facilitates sharing such patents to promote eco-efficiency and sustainable development
- Enables technology innovation to meet social innovation

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- Patents pledged must be for innovations that provide 'environmental benefits'
  - As either their direct purpose or as an indirect benefit
- Examples of environmental benefits:
  - Energy conservation or efficiency
  - Pollution prevention (source reduction, waste reduction)
  - Use of environmentally preferable materials or substances
  - Materials reduction or increased recycling ability
- Which patents are pledged is at the discretion of each business
- A business need pledge only one patent to join the Commons

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- Provides an efficient channel for sharing innovations
- Provides a catalyst for further innovation
  - Can facilitate collaboration and new business opportunities
  - Can reduce development cost for environmentally sound innovations
- Helps introduce the pledger's technology and vision of the future to others – who may select the technology and adopt the vision
- Allows patent pledger to terminate as to those who assert patents against the pledger
- Provides global recognition for leadership in fostering sustainable development

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- The Eco-Patent Commons provides free access to patents they can leverage to improve the environmental aspects of their operations
- The information is readily available in one easily accessible place
- Provides an avenue by which they can identify and connect with others with whom they may want to partner on further innovation and development
- Enables them to participate in furthering sustainable development

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- Contact any of the representatives on the next slide to express your interest and discuss joining the Eco-Patent Commons
- Contact your Intellectual Property function and examine your business's patent portfolio
- Identify patents your business may want to contribute to the Commons
- Even one patent is sufficient for participation and can make a significant difference in helping to further sustainable development

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62345.202



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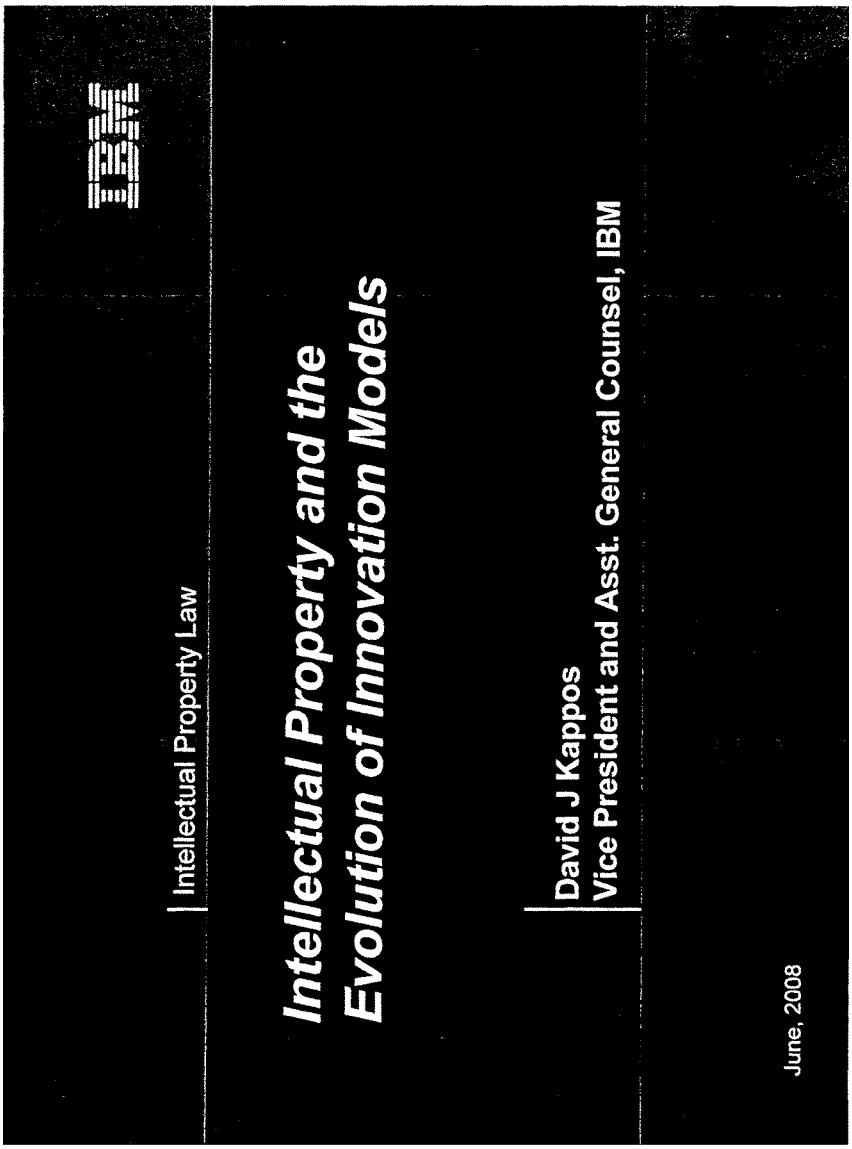
IBM
Intellectual Property Law
Intellectual Property and the Evolution of Innovation Models
David J Kappos
Vice President and Asst. General Counsel, IBM
June, 2008

Agenda

- IP Strategy in the Knowledge Economy
- The Changing Nature of Innovation
- Evolving Innovation Models in Bio and Pharma

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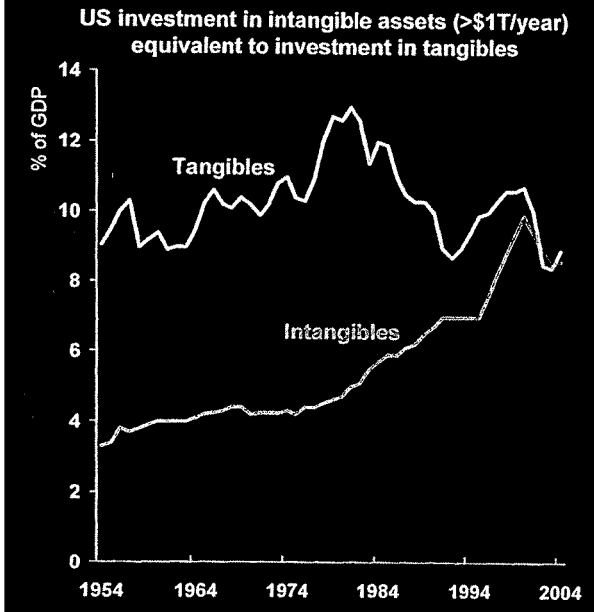
IP is the Currency of the Knowledge Economy



"Intellectual property is the backbone of America's economy"
U.S. Commerce Secretary Carlos Gutierrez

Japan intends to "bring about a nation founded on intellectual property"
Japanese Prime Minister Junichiro Koizumi

"The competition of the future world is a competition for Intellectual Property Rights"
Chinese Premier Wen Jiabao

~80% of the value of modern companies comes from intangible assets

Sources: US Federal Reserve – Nakamura, Ned Davis Research

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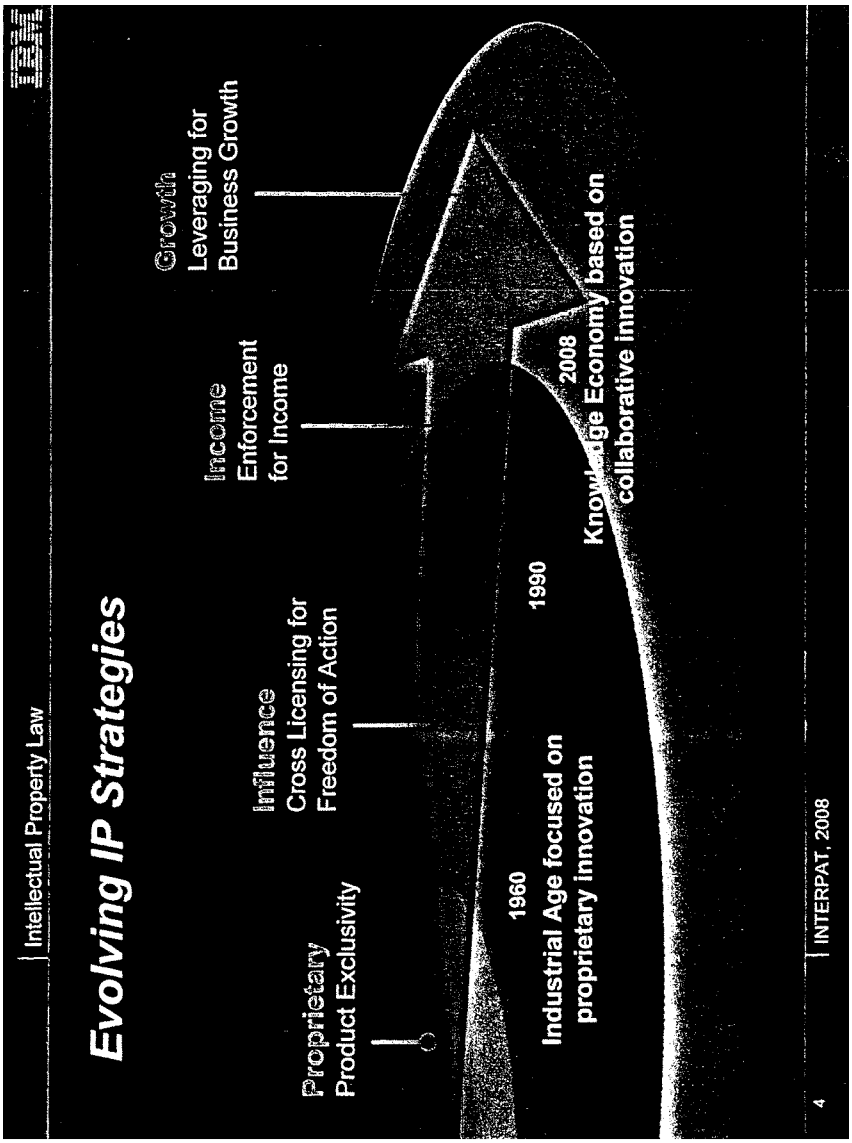
IBM
Intellectual Property Law
Evolving IP Strategies
Proprietary
Product Exclusivity
Influence
Cross Licensing for
Freedom of Action
Income
Enforcement
for Income
Growth
Leveraging for
Business Growth
1960
Industrial Age focused on
proprietary innovation
1990
2008
Knowledge Economy based on
collaborative innovation
4
INTERPAT, 2008

Open or Proprietary?

Industries are evolving to a new equilibrium





Industry direction

Totally Open

Totally Proprietary

More transparent, More community involvement

Where do we need to be today to drive innovation, solve customer problems, and accelerate growth?

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Agenda

- IP Strategy in the Knowledge Economy
- The Changing Nature of Innovation
- Evolving Innovation Models in Bio and Pharma

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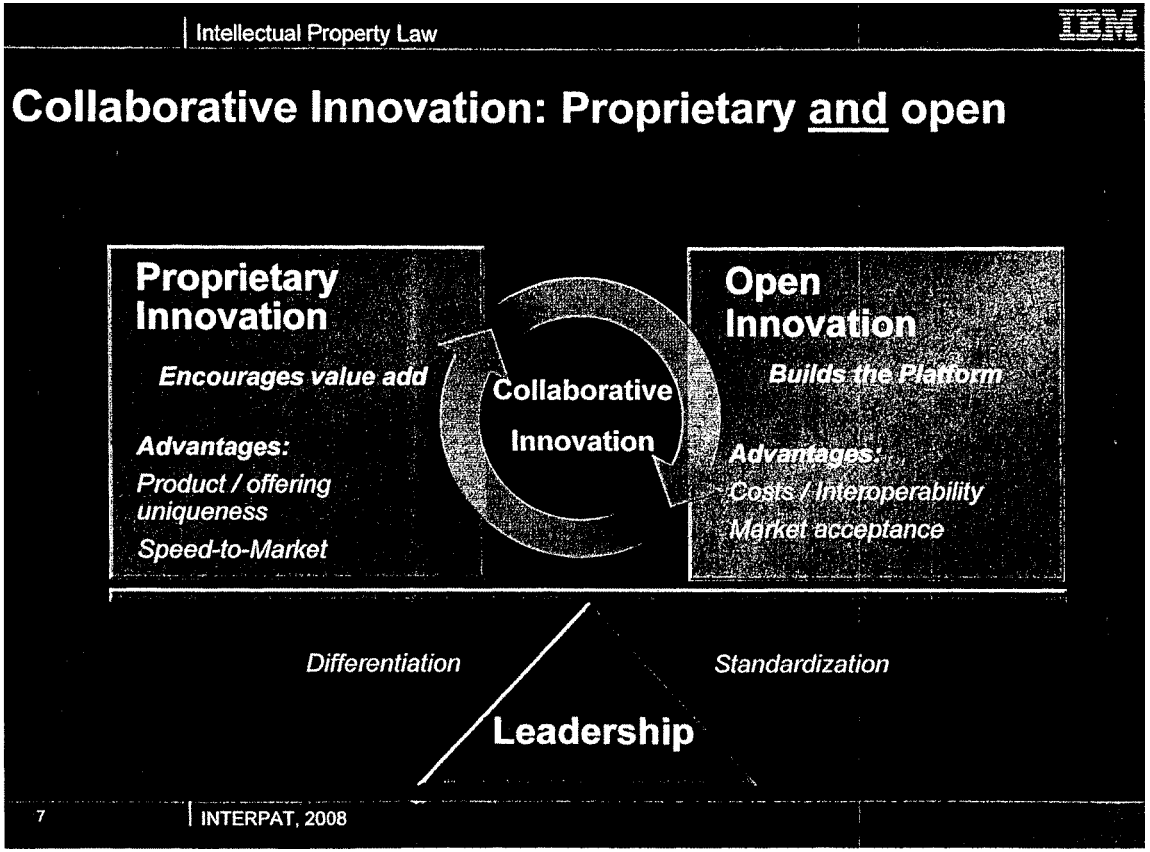

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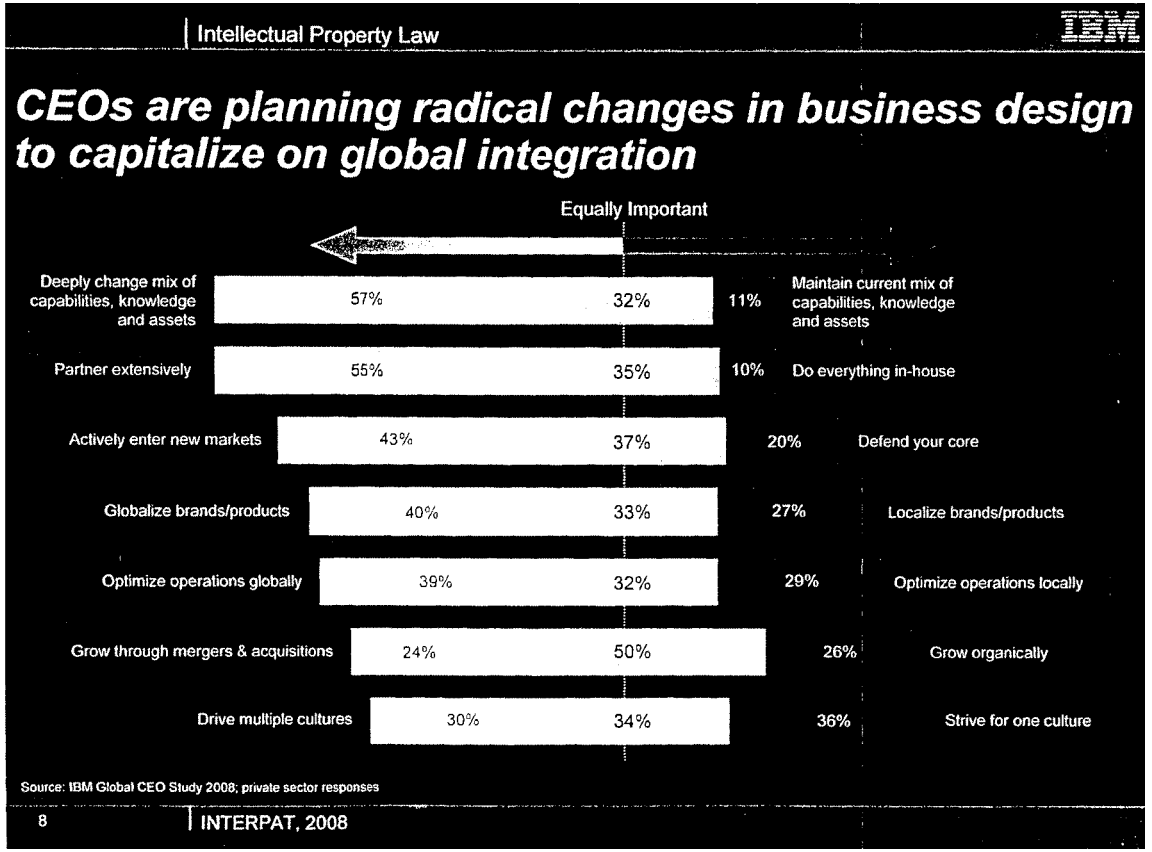

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The Business of Open Standards

- **Leverage**
  - ► **Broadly Adopted Technological Platform**
    'Industrial 'free trade agreements'
- **Opportunity**
  - ► **Focus On Differentiation and Value Add**
    'Cooperate on platform –
    compete on differentiation'
- **Customers**
  - ► **Increased choice & price options**
    - **Range of vendors with different:**
      - – **Price points**
      - – **Functionality options**
      - – **Service support options**
  - ► **Product utility enhanced via interoperability**



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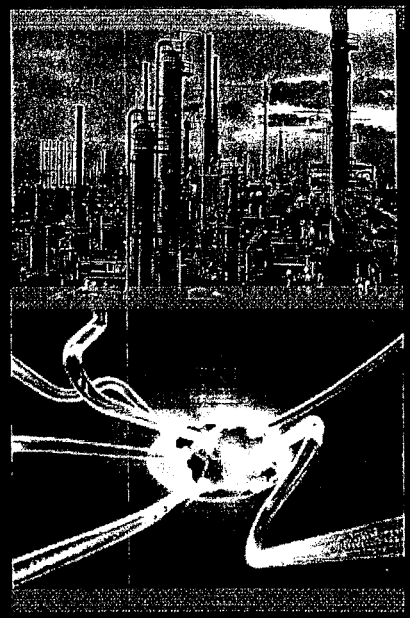
Open Standards as the New Infrastructure

Paradigm Shift for IP Leverage In the Information Economy

- **Industrial Economy - Vertically Integrated Firms**
  - **Ford Motor Co. Assembly Line Pioneer**
    - **Owned Rubber Tree Plantations to produce raw materials for tires**
  - **Standards emerge to address intra-firm interoperation**
  - **IP used to *protect* internal infrastructure *by excluding* competitors**
- **Information Economy - Virtually Integrated Firms**
  - **Global Network enables outsourcing and specialization in the 'Flat World'**
  - **Standards enable business componentization and networked interoperation**
  - **IP used to *shape* external infrastructure *by opening access to IP* thus influencing the development of standards**



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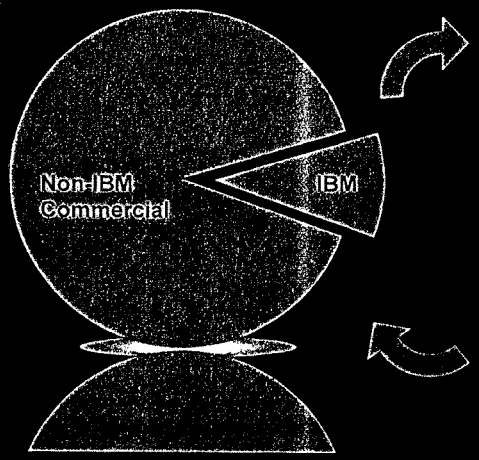
The IBM Linux story: Leveraged development expense



IBM Linux Technology Center	
$50M/yr	IBM Unique
$50M/yr	Common
$100M/yr	Total

An operating environment costing one fifth of the independent IBM approach

Non-IBM Commercial Linux Development Expenses (e.g. Intel, Nokia, Hitachi, etc.)	
$450M – 700M	Company Unique
$450M – 700M	Common
$900M – 1,400M	Total

Source: IBM figures: IBM Software Group, External figures: Open Source Development Laboratory

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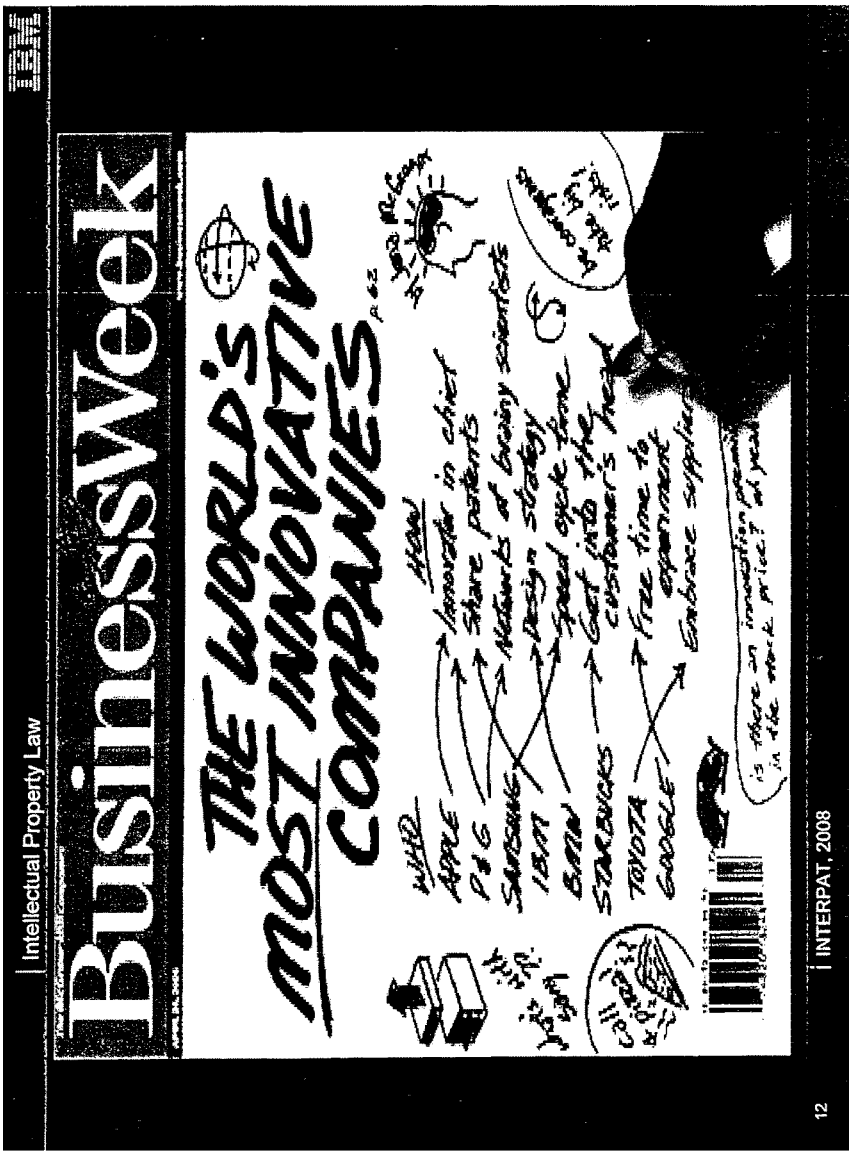
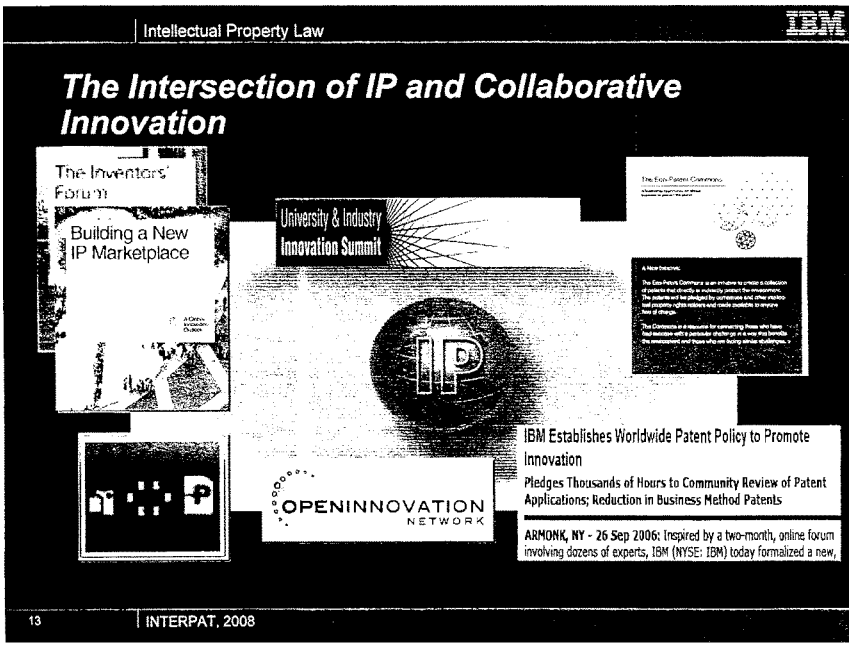

Intellectual Property Law
IBM
BusinessWeek
THE WORLD'S MOST INNOVATIVE COMPANIES
12
INTERPAT, 2008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The Inventors' Forum
Building a New IP Marketplace
University & Industry Innovation Summit
IP
OPENINNOVATION NETWORK
IBM Establishes Worldwide Patent Policy to Promote Innovation
Pledges Thousands of Hours to Community Review of Patent Applications; Reduction in Business Method Patents
ARMONK, NY - 26 Sep 2006: Inspired by a two-month, online forum involving dozens of experts, IBM (NYSE: IBM) today formalized a new,
13
INTERPAT, 2008

Agenda

- IP Strategy in the Knowledge Economy
- The Changing Nature of Innovation
- Evolving Innovation Models in Bio and Pharma

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Evolving Innovation Models in Bio and Pharma

"Someone outside your organisation today knows how to answer your specific question, solve your specific problem or take advantage of your current opportunity better than you do. You need to find them and find a way to work collaboratively and productively with them."

-- Alan Lafley, Proctor & Gamble CEO, Wikinomics

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Collaborative Innovation in Bio and Pharma

- **Connect & Develop** - "It's our version of open innovation: the practice of accessing externally developed intellectual property in your own business and allowing your internally developed assets and know-how to be used by others." -- Gil Cloyd, CTO
  - ▸ Over 1,000 active agreements:
    - Inbound: Olay® regenerist & Outbound: Calsura™ absorbable calcium
    - Joint Venture: Inverness Medical Innovations, Inc. – at home diagnostic testing
- **Innocentive (Eli Lilly)**
- **YourEncore (P&G and Eli Lilly)**

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Open Innovation in Bio and Pharma

Cambia

- International non-profit organization primarily devoted to public interest issues such as public health and natural resource management.
- BiOS – "open source" for biotechnology
  - ► Encourages collaboration by creating a "protected commons" for research and development of ideas.

Science Commons

- Creative Commons for scientific content
- Not necessarily free but subject to pre-negotiated terms and standardized data formats
  - ► Neurocommons: beta open source knowledge management system for biomedical research
  - ► Healthcommons: virtual marketplace or ecosystem where participants share data, knowledge, materials and services to accelerate research to cure disease.

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Intellectual property will become one of the key geopolitical issues of the 21st century. Already, focus has begun to shift from protecting IP to maximizing intellectual capital, which is based on shared ownership, investment, and capitalization.

FOREIGN AFFAIRS

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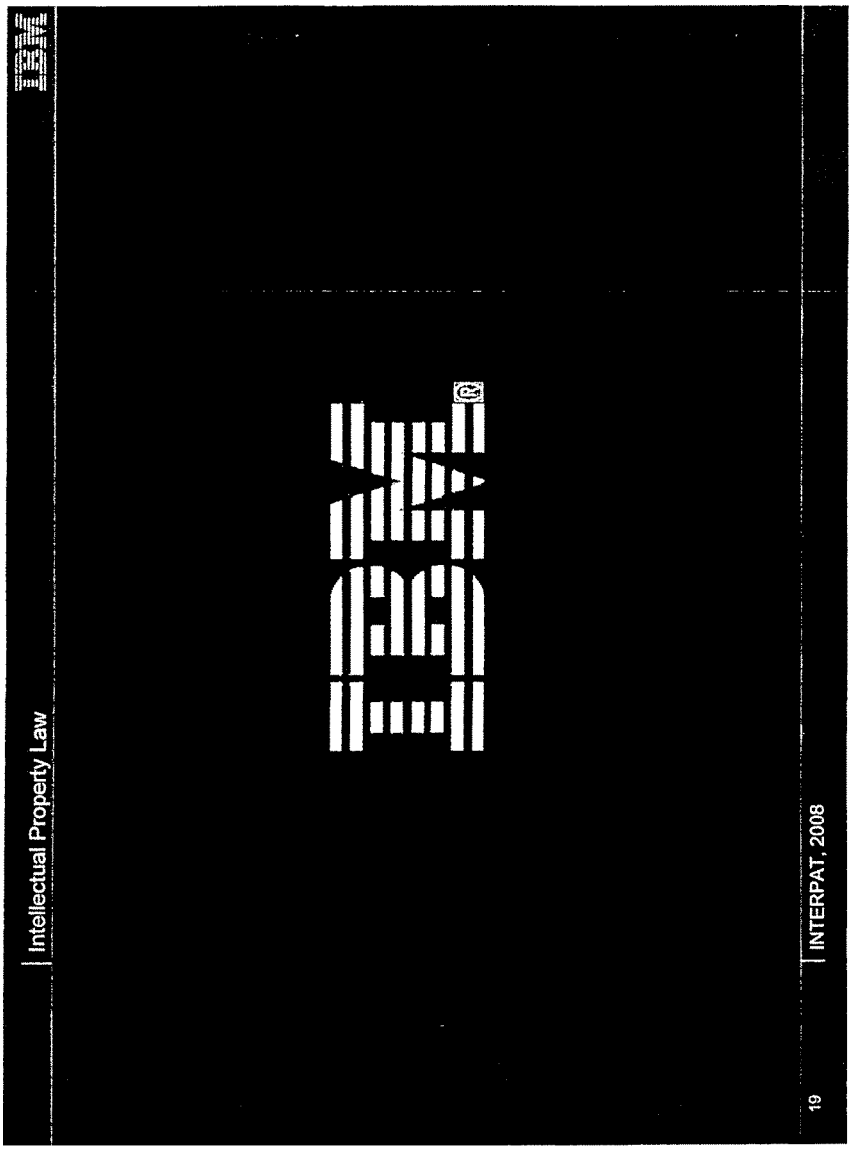
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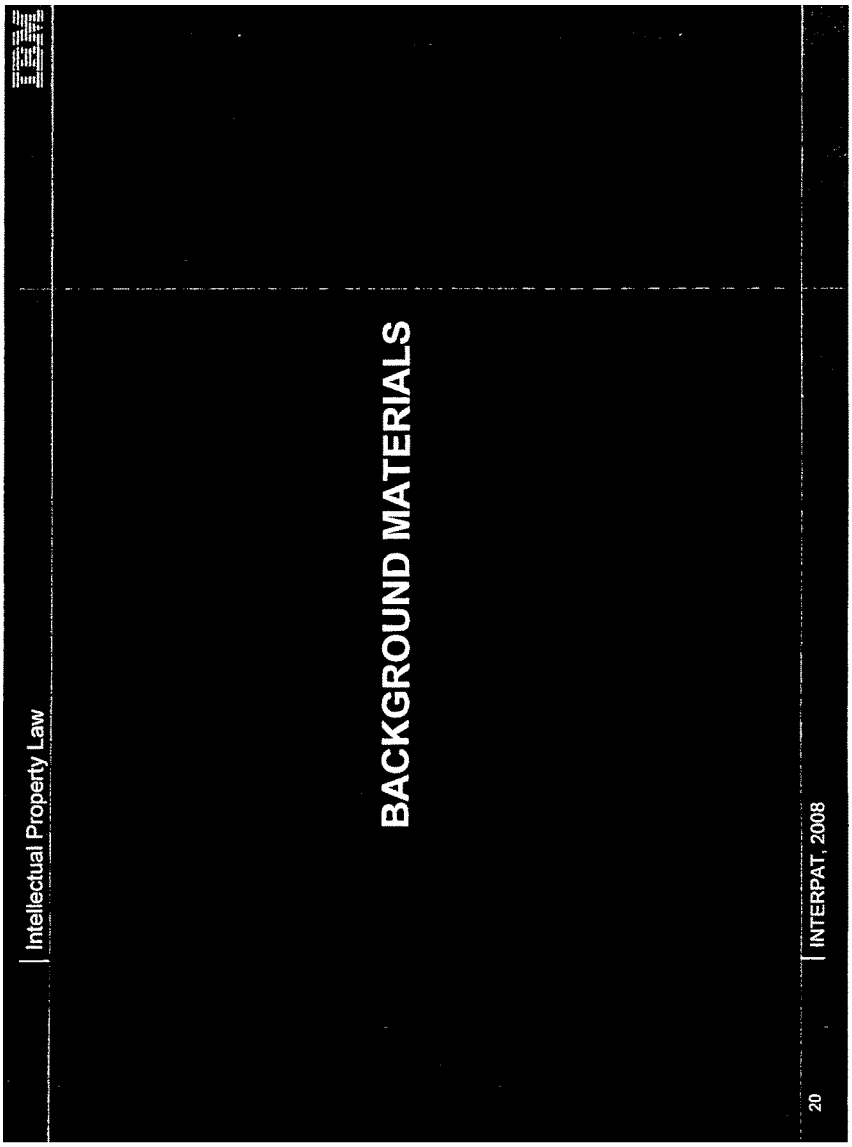
Intellectual Property Law
19
INTERPAT, 2008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Intellectual Property Law
BACKGROUND MATERIALS
20
INTERPAT, 2008

Intellectual Property Is the Currency of Knowledge

- "Intellectual property is the principal engine for the creation of wealth in our society..." Hon. James E. Rogan (former USPTO)
- "...we must begin the important work of developing a framework capable of analyzing the growth of an economy increasingly dominated by conceptual products" Alan Greenspan
- The importance of IPR in the Indian economy will have to be understood properly. Tomorrow's wars will be fought not by conventional weapons, guns, missiles and so on, but in the knowledge markets with new thermonuclear weapons called information and knowledge. Dr. R.A. Mashelkar DG CSIR - India
- It is beneficial to China itself to protect IP and to generate a legal environment for scientific creativity and technological scattering, and to create a favorable market for attracting foreign investment both financially and technologically. State IP Office (SIPO) - PRC

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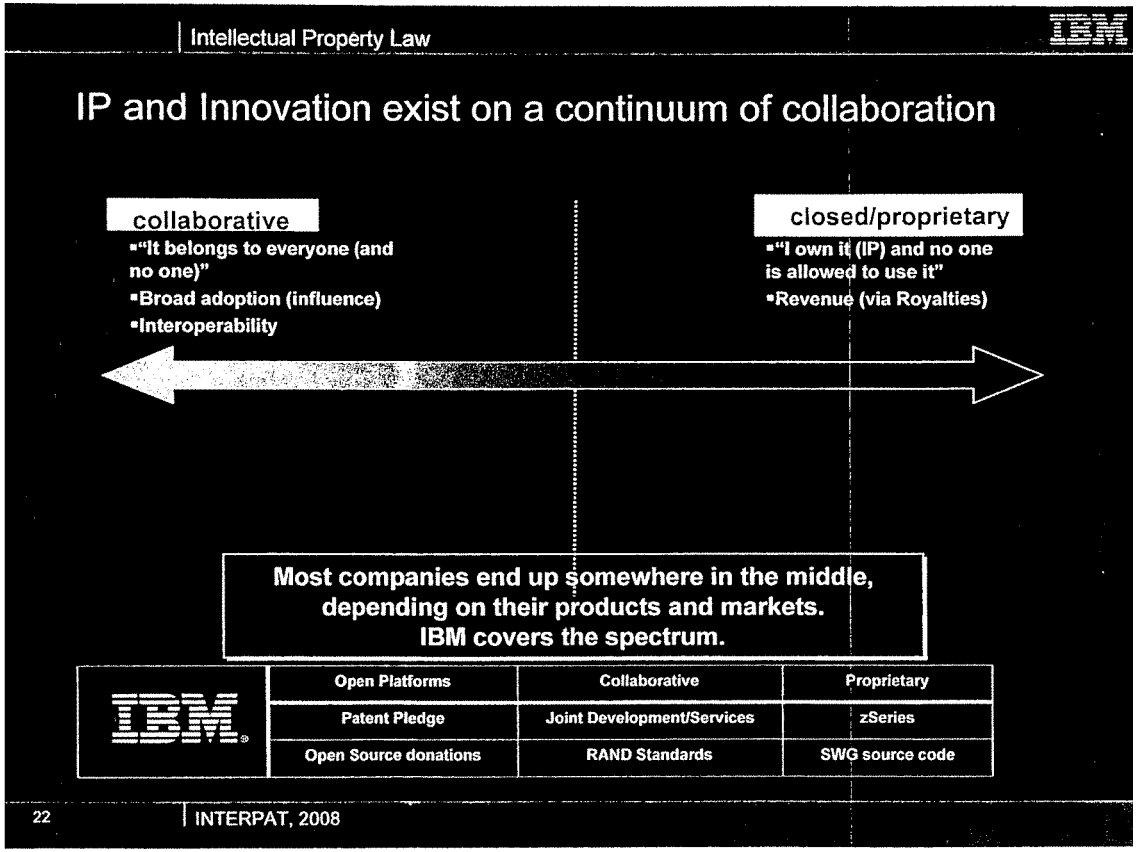

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IBM intellectual property value through open platforms

- **Leverage IP to Create Business Value**
  - Directly impact business bottom line vs. profit silo
  - Influence the direction of open platforms and…
  - Protect proprietary innovations built on open platforms
- **Why Open?**
  - Collaboration is key to innovation
  - Open platforms are key to collaboration
  - Proprietary and open solutions must compliment each other

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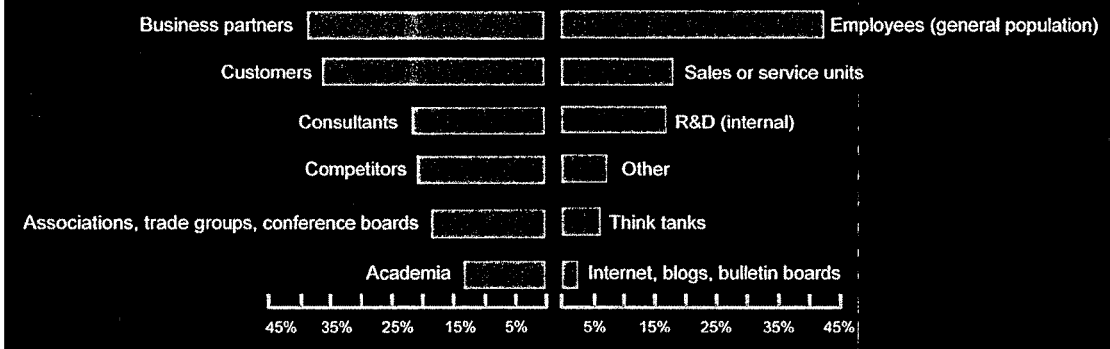
innovation: how?

* New Forms of Collaboration

CEOs: Sources of new ideas and innovation



"We have...today a lot more capability and innovation in the [competitive] marketplace...than we [could] try to create on our own."

Source: IBM Institute for Business Value, CEO Study 2006

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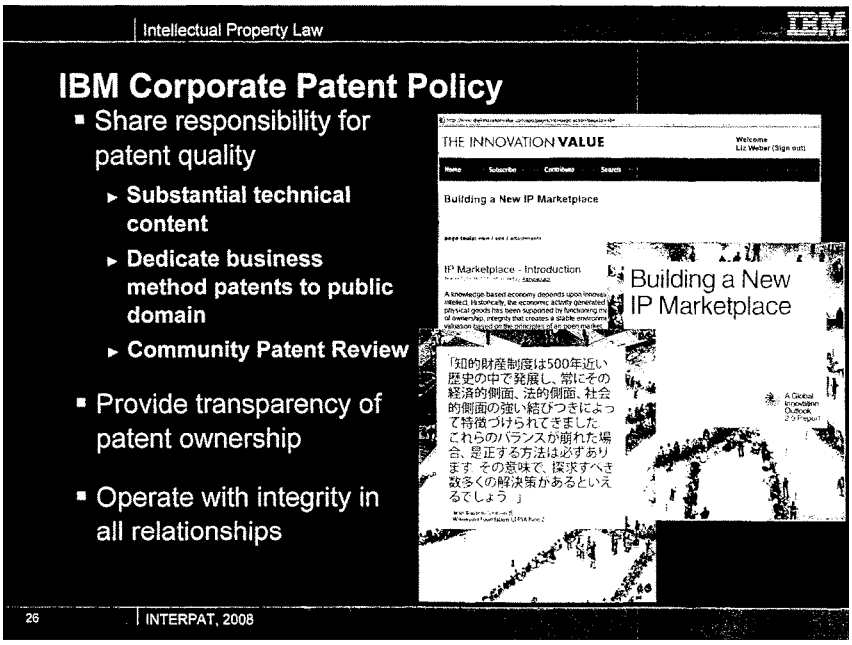
The Intersection of IP and Collaborative Innovation
Patent Policy
•Marketplace Wiki
•IBM Patent Policy
•Inventors Forum
Patent Quality
•Peer to Patent: Community Patent Review
•Open Sources as Prior Art
•Patent Quality Index
Standards
•Open standards
•Industry non-assert pledges
•Open Document Format
Collaboration
•Open Invention Network
•Patent pledges (Eco Patent Commons)
•University collaboration principles
INTERPAT 2008


Intellectual Property Law
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IBM Corporate Patent Policy
Share responsibility for patent quality
Substantial technical content
Dedicate business method patents to public domain
Community Patent Review
Provide transparency of patent ownership
Operate with integrity in all relationships
THE INNOVATION VALUE
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Liz Weber (Sign out)
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Contribute
Search
Building a New IP Marketplace
IP Marketplace - Introduction
Building a New IP Marketplace
「知的財産制度は500年近い歴史の中で発展し、常にその経済的側面、法的側面、社会的側面の強い結びつきによって特徴づけられてきました これらのバランスが崩れた場合、是正する方法は必ずあります その意味で、探求すべき数多くの解決策があるといえるでしょう」
26
INTERPAT, 2008

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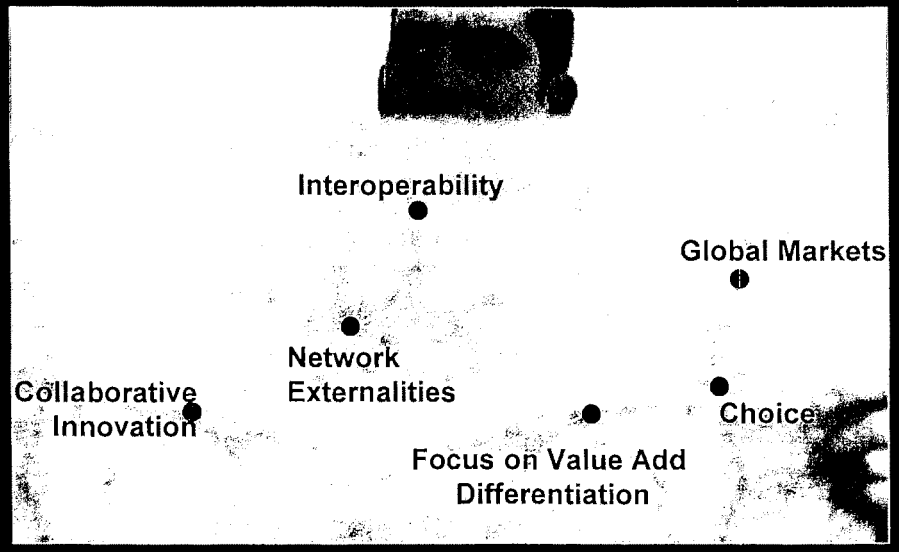
Standards translate to value for business



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IBM
Collaborative Innovation in IBM
✓ Community-driven
✓ People working across boundaries to confront today's most pressing challenges
✓ Enabled by open standards and new intellectual property practices
➢Innovation Jam
➢Global Innovation Outlook (GIO)
➢IP Market Wiki
➢Inventors' Forum
28
INTERPAT, 2008

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Collaborative Innovation: Proctor & Gamble

- "Connect & Develop"
- "It's our version of open innovation: the practice of accessing externally developed intellectual property in your own business and allowing your internally developed assets and know-how to be used by others." -- Gil Cloyd, CTO
  - ▸ Inbound and outbound
  - ▸ Over 1,000 active agreements:
    - Inbound: Olay® regenerist
    - Outbound: Calsura™ absorbable calcuim
    - Joint Venture: Inverness Medcial Innovations, Inc. – at home diagnostic testing
    - Commercial Partnership: sanofi-aventis to develop & market Actonel® (osteoporosis treatment)

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Collaborative Innovation -- Innocentive

- Created by Eli Lilly – site posts problem and pays "bounty" for solution.
- "Founded in 2001, InnoCentive connects companies, academic institutions, and non-profit organizations, all hungry for breakthrough innovation, with a global network of more than 125,000 of the world's brightest minds on the world's first Open Innovation Marketplace™."
  - "Seekers" include: Dow; P&G; BASF; Syngenta; Eli Lilly
  - At least 132 awards since June 2005.
- "The intent is to go out and see if there is somebody who can solve this problem for us today," says Mark Zettler, manager of new-product development at Dow AgroSciences, which became an InnoCentive poster a year ago. "The likelihood is that we will find somebody."

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Collaborative Innovation -- YourEncore

- **Founders: Eli Lilly, P&G, Boeing**
- **"YourEncore helps companies accelerate innovation by connecting them with retired scientists and engineers to leverage their expertise. "**
- ***"We saw an opportunity to enter the market place with a new product offering and identified a small company that was interested in working with us to manufacture the product. Unfortunately, the small company that had the capability we needed, had limited resources and their product did not meet our flavor, stability or quality requirements. We arranged for the company to leverage the*** *unique technical expertise* ***from a team of YourEncore Experts. YourEncore quickly resolved the issues and allowed us the opportunity to capture this new business opportunity." Peter Erickson, Sr. Vice President, Innovation, Technology, Quality General Mills, Inc.***

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Open Innovation: Cambia

- "creating new technologies, tools and paradigms to foster collaboration and life-sciences enabled innovation."
- International non-profit organization primarily devoted to public interest issues such as public health and natural resource management.
- BiOS – "open source" for biotechnology
  - Encourages collaboration by created a "protected commons" for research and development of ideas.
  - Leverages information technology to generate open access to capabilities for innovation
  - PatentLens: to improve transparency. Provides full-text patent search and analytics. Includes tutorials and patent landscape maps.

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Open Innovation – Science Commons

- "Our goal is to speed the translation of data into discovery — unlocking the value of research so more people can benefit from the work scientists are doing."
  - Inefficiencies in R&D caused by isolation and unavailable information
  - Enable "opening" and reuse of research; "one-click" access to research; and integrate fragmented research sources.
- Not necessarily free but subject to pre-negotiated terms and standardized data formats
- Projects include:
  - Neurocommons: beta open source knowledge management system for biomedical research
  - Healthcommons: virtual marketplace or ecosystem where participants share data, knowledge, materials and services to accelerate research to cure disease. (e.g. repositories of biological materials, computational models predicting drug efficacies).
  - The Biological Materials Transfer Agreement Project: develops and deploys standard, modular contracts to lower the costs of transferring physical biological materials such as DNA, cell lines, model animals, antibodies and more

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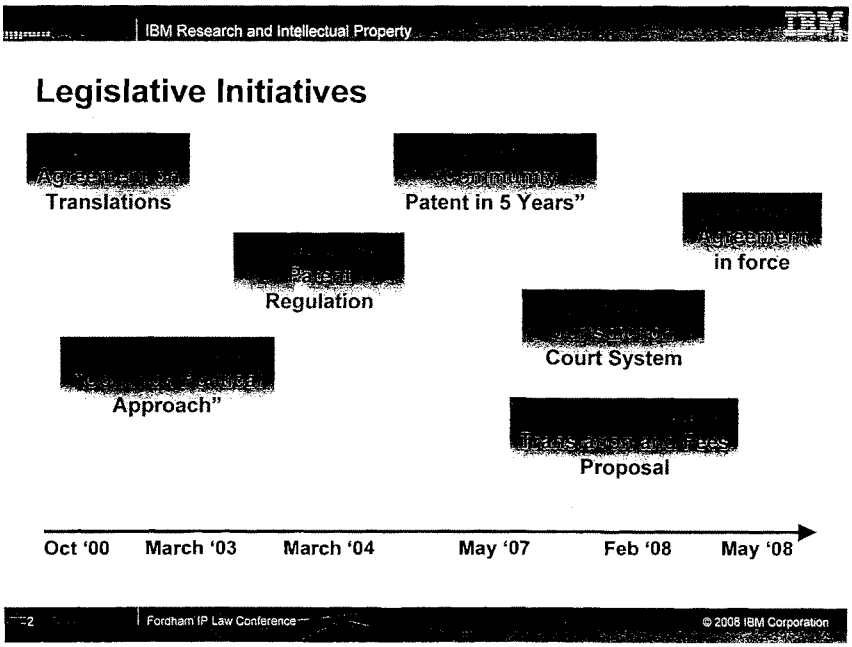
Fordham IP Law Institute
16th Annual Conference

David Kappos
VP and Assistant General Counsel
Intellectual Property Law, IBM

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in force
Regulation
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Approach"
Proposal
Oct '00
March '03
March '04
May '07
Feb '08
May '08
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European Community Patent

- Unitary patent covering all 27 EU countries
- Same scope in all countries
- Reliable litigation system
- Reasonable cost for applicant
- High quality patents
- Granted by EPO



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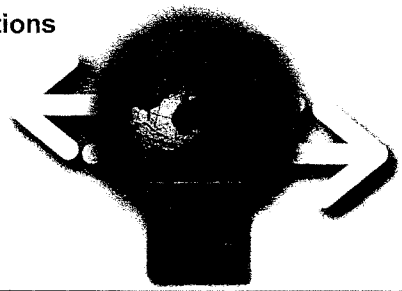
Language Challenge

- **Flexible community patent**
  - Geographic coverage
  - Translate for desired countries
- **Central translation service**
- **Alternatively, limited translations**
  - High patentee cost
  - Inadvertent infringement



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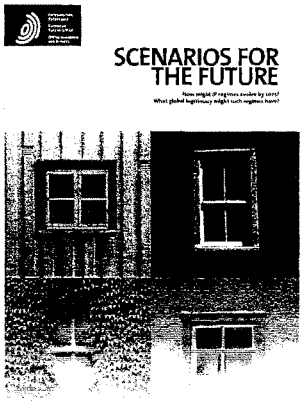
Soft IP

- **EPO 'Blue Skies' Scenarios: system with no injunctions**
  - Align with global shift to interoperability, open standards, collaborative development
  - Licenses of right
  - Patent pools
  - Corporate goodwill
  - US court injunctions discretion
  - EU Patent Jurisdiction injunctions discretion



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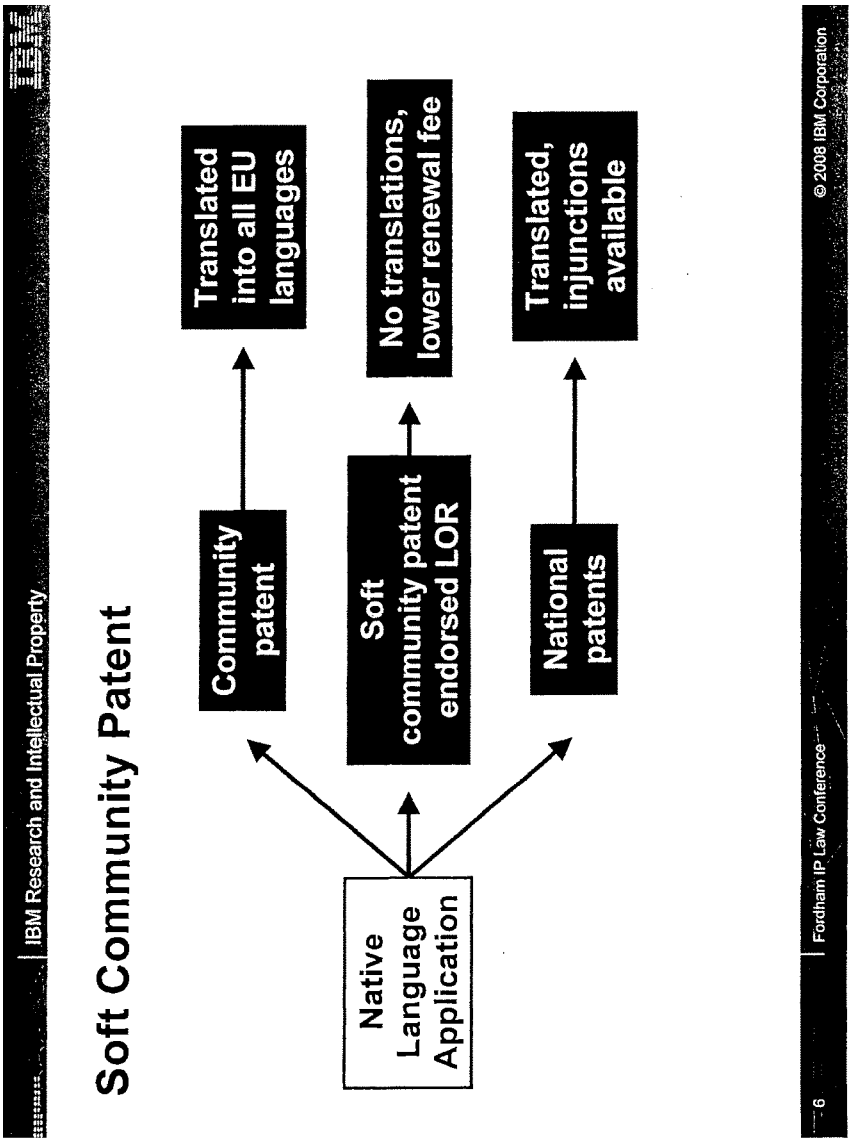
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Soft Community Patent
Native Language Application
Community patent
Soft community patent endorsed LOR
National patents
Translated into all EU languages
No translations, lower renewal fee
Translated, injunctions available
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Benefits of Soft European Community Patent

- Community-wide coverage from single filing and prosecution
- Reasonable costs
- Licenses available
- Standards-friendly
- Community patent and national patents still available



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Calling The Pitches: US Intellectual Property Laws in an Era of Legislative Deadlock and Supreme Court Activism

David Kappos, IBM
Vice President & Assistant General Counsel
Intellectual Property

Agenda

- America's Sport Goes Global
- A Patent System Wild in the Strike Zone
- The State of Play
- The Players
- The Umpire Steps In
- After the Seventh Inning Stretch: The Prospects for Reform in 2007

2

America's Sport Goes Global

- We're all in a global innovation game
- Competition
  - From all over the world
  - From all size of enterprises
- Technology widely available across globe
  - Accelerates transmission of ideas
  - Accelerates transformation of idea into commercial embodiment
- Product Life Cycles Shorter
  - New products brought to market more quickly than ever before

3

America's Sport Goes Global

- Globalization forces can also be destructive
- Delicate balance
- Loss of balance can discourage investment required for innovation



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America's Sport Goes Global

- How do we encourage investment in innovation in the face of increasing globalization?
- How do we level the playing field?

A strong but fair patent system



5

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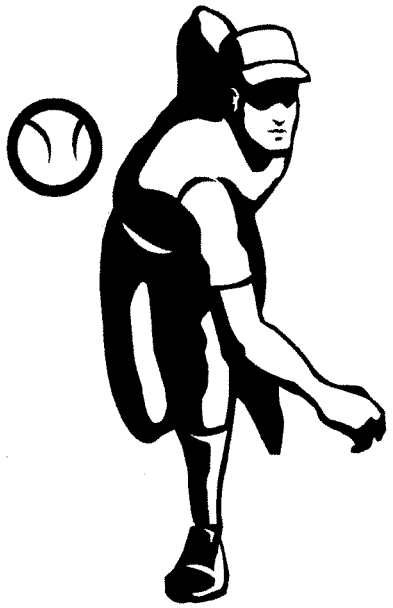
A Patent System Wild in the Strike Zone

- Erratic system
  - Obtaining patents
  - Enforcement
  - Additional problems



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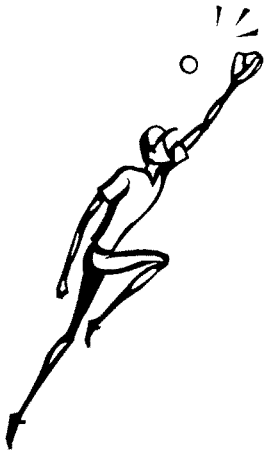
The State of Play

- Obtaining Patents
  - Over-protection
    - Subject matter over-extension
    - Erosion of patentability standard
    - Gaps in examination
      - No post-grant opposition
      - Limited prior art submission/explanation
  - Under-protection:
    - PTO pendency
    - Claim construction



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The State of Play

- Enforcement
  - Damages
  - Treble Damages
  - Lottery Mentality

8

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The State of Play

- Additional problems
  - Harmonization
  - Inequitable Conduct
  - Prior users

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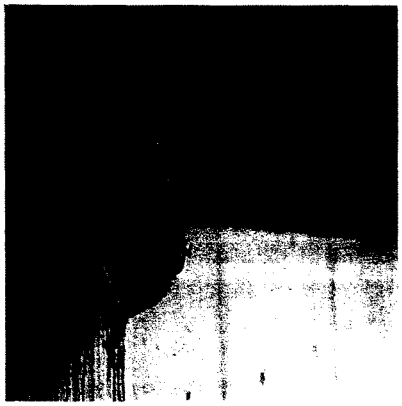
The State of Play

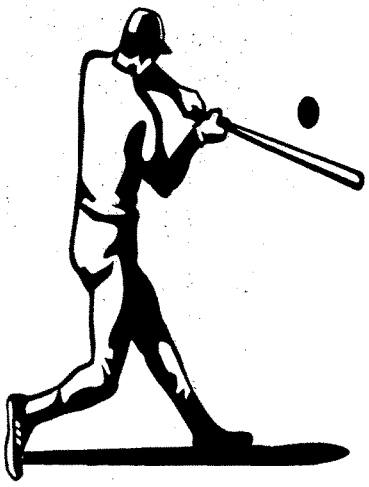
- Legislative response
  - Failure to act
  - Failure to build consensus
  - Failure to overcome partisan conflict



10

The Players

- Information Technology
- Financial Services
- Pharma
- Bio
- Industrial Chem Companies
- US PTO
- Inventors/IP Attorneys
- Courts
- Academic Commentators
- Congress



11

The Umpire Steps In

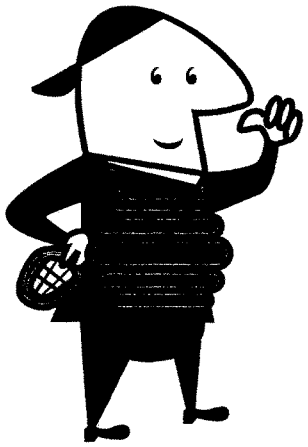
- Roberts Court Active:
  - MercExchange v. eBay (2006)
  - MedImmune v. Genentech (2007)
  - KSR International v. Teleflex
  - ATT v. Microsoft
  - Laboratory Corp of America Holdings v. Metabolite Laboratories, Inc. (2006, DIG)



12

The Umpire Steps In

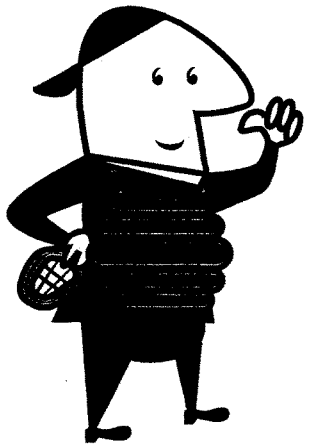
- MercExchange v. eBay
  - Decision overturned Federal Circuit
  - Holding: Upon reaching a finding of infringement, a court should consider equitable factors to determine whether an injunction is required, rather than automatically granting an injunction in the absence of "special circumstances".



13

The Umpire Steps In

- MedImmune v. Genentech
  - Decided 1/07
  - Decision overturned Federal Circuit
  - Holding: A patent licensee need not cease payment of royalties, thereby committing a breach of its license agreement, in order to meet the requirements for filing a Declaratory Judgment.



14

The Umpire Steps In

- KSR International v. Teleflex
  - Decision expected by March 2007
  - Obviousness: Must a "suggestion, teaching, or motivation" to combine be present to show obviousness?



15

The Umpire Steps In

- ATT v. Microsoft
  - Supreme Court argument Feb 21
  - Extraterritoriality: When are overseas sales subject to US patent statutes?



16

The Umpire Steps In

- Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc. (2006, DIG)
  - Impassioned Dissent
    - Dismissal inappropriate
    - Would have invalidated patent, reinforcing long standing precedent that natural phenomena are not patentable
    - Negative comments re: State Street Bank, the Federal Circuit decision holding that business methods are patentable



17

The Umpire Steps In

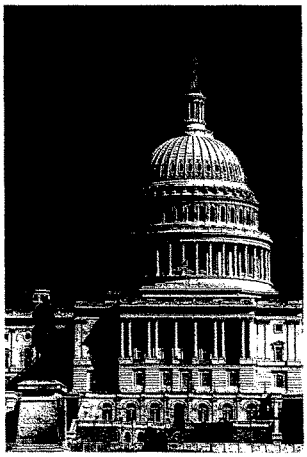
- Summary
  - Roberts Court stepped in early and continues to step in often
  - Taking on wide range of patent issues
    - Known problem areas



18

After the 7th Inning Stretch: Prospects for Reform in 2007

- 2007 Reform is a real possibility
  - Senate and House bills expected to emerge early this year
  - Opportunity to restore balance to the patent system and encourage real innovation



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After the 7th Inning Stretch: Key Legislative Issues

Harmonization
- First to file
- Filing in assignee name
- Publication 18 months after filing
- Elimination of best mode requirement
- Prior user rights

Patent Examination
- Post grant opposition
- Inter partes reexamination
- Third party submission of prior art
- Continuation applications
- USPTO fee diversion

Litigation
- Duty of candor/Inequitable conduct
- Apportionment of damages
- Willful infringement
- Extraterritoriality
- Venue
- Interlocutory appeals
- "Loser pays" costs/fees

20

After the 7th Inning Stretch: Let's Make Reform Happen

- Patent Community must work together
  - Taking a long-term view
  - Engaging all players to achieve a durable consensus



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A New Game in the Making

Batter Up!



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April 30, 2007 Monday 10:26 PM GMT

LENGTH: 874 words

HEADLINE: Court cases threaten weaker patents

BODY:

WASHINGTON (AP) - The Supreme Court on Monday delivered two decisions that experts say weaken the value of patents, fueling criticism that technological innovation, particularly in the biotech and pharmaceutical sectors, could be hindered.

In the more important of the two cases, the court made it simpler for companies to challenge patents on the grounds that they cover products that are obvious combinations of existing technologies. Under U.S. law, an invention must be new, useful and not obvious in order to merit a patent. The case involved Canada-based KSR International Inc. and Teleflex Inc., based in Limerick, Penn.

In the second case, the court curtailed the reach of U.S. patent laws overseas, ruling in favor of Microsoft Corp. in its dispute with AT&T Inc. over Microsoft's sale of Windows software outside the United States that allegedly infringed AT&T's patents. The decision will likely reduce damage awards in patent cases by excluding patent infringement overseas from consideration.

Boston University law professor Dennis Crouch wrote on a popular Supreme Court blog, Scotusblog, that 'because of KSR, patents will be more difficult to enforce and easier to invalidate.'

'The AT&T case,' he added, 'cuts in half the value of many of today's most valuable software patents.'

The Supreme Court's recent interest in patent law -- it has taken up a half-dozen cases in the field in the past two years, an unusually large number -- reflects the greater role patents play in the U.S. economy, as companies earn more revenue from licensing patents and patent litigation has increased by 50 percent in the last ten years.

IBM Corp., which regularly tops the annual list of top U.S. patent recipients, receives approximately $900 million in revenue from licensing its patents and other intellectual property to other companies. **David Kappos**, assistant general counsel at IBM, said that figure is an increase from the 'low millions' in the early 1990s.

Microsoft is a big winner in the two decisions today. The court's ruling in the AT&T case throws out the use of worldwide product sales as a basis for calculating damages in patent infringement suits, a formula that has resulted in large judgments against the company in other cases.

A jury hit Microsoft with $1.52 billion in damages earlier this year in a suit filed by Alcatel-Lucent, and a separate jury awarded Eolas Technologies Inc. and the University of California $521 million in damages from Microsoft. Both damage awards were calculated based on worldwide sales of Windows software.

In addition, Microsoft and many other high-tech companies, including Cisco Systems Inc. and Intel Corp., had filed friend of the court briefs in the KSR case, urging the court to ease the standard for demonstrating that a new product is obvious. The court largely decided as the companies had urged.

The companies wanted a more flexible 'obviousness' standard that would make it easier for patent examiners to reject applications for trivial innovations or obvious combinations of existing products. Spurious patents have contributed to the recent increase in patent litigation, they argued.

Kappos said that the court's decision means, 'if you want a patent, you actually have to invent something.'

The biotech and pharmaceutical industries, meanwhile, were on the losing end of the KSR case. Groups from both industries filed friend of the court briefs in support of the obviousness test that the court ruled was applied too narrowly.

Hans Sauer, associate general counsel at the Biotech Industry Organization, which represents companies such as Amgen Inc. and Gilead Sciences Inc., said that a weaker patent regime can make it harder for new biotech companies to attract venture capital or other investment.

That investment can be crucial when a small firm is seeking millions of dollars to bring a new drug to market, he said. The first question investors will ask, Sauer said in a March interview, is whether the patent will stand up in court.

Sauer said that the biotech industry has already been negatively affected by a decision the court made last year in a case involving eBay Inc. and a small, Virginia-based company known as MercExchange.

In that May 2006 case, the court said that if a company has been found to infringe a patent, an injunction barring production of the infringing good should be granted on a case-by-case basis, rather than automatically.

And in January 2007, the court said in a dispute between biotech firms MedImmune Inc. and Genentech Inc. that a company can challenge the validity of a patent in court, even if it continues to pay fees to license the patent. That could make patent challenges more likely, patent experts said, by enabling companies to seek to have a patent declared invalid without having to take the risk of violating the patent, which can result in triple damages if a company loses its case.

But Kappos argued last week that the eBay and MedImmune decisions have resulted in only modest changes to the patent system.

'I don't think the Supreme Court has overcorrected,' Kappos said, or 'diminished the value of patents.'

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LOAD-DATE: April 30, 2007

This article appeared on page E - 1 of the San Francisco Chronicle
Wired: We Are All Patent Reviewers
Wired: We Are All Patent Reviewers

http://blog.wired.com/business/2008/11/we-are-all-pate.html

By JeffPHowe November 20, 2008 | 10:24:17 AMCategories: All Things Digital

There are many areas of government over which Obama has pledged to wave the magic wand of reform. And given the severity of the current economic crisis, fixing the system by which the US awards patents and trademarks has presumably been placed on the back burner. If that's the case, it's a shame, because the patent system's problems have reached tragi-comic proportions. As of early 2008 (when I last researched the matter for my book) it took an average of 2.5 years for an application to work its way through the USPTO, which has a backlog of more than 1 million applications. The 5,500 examiners themselves are notoriously underpaid and overworked, and can only allot twenty hours to review even the most abstruse patents. Further hampering the process, reviewers rarely posses expertise in computer science and aren't allowed to consult the Internet in their research, relying instead on the USPTO's own database of prior art. The result? An increase in undeserving patents and a Gordian Knot of conflicting claims. Unsurprsingly, patent litigation has doubled since 1990, at an average cost of $2 million per lawsuit.

In my book I chronicled how Beth Noveck, a professor at New York Law School, was trying to harness the network—which is to say, all of us—to improve the process. She launched Peer-to-Patent in June of last year, in cooperation with the USPTO, as well as such companies as IBM and Microsoft, whose outsized patent portfolios exercise a magnetic force for frivolous litigation. How it works: Post applications to the public, and let interested parties submit prior art and comment on the claims. The wisdom of crowds will do a better job of determining validity, the logic goes, than a single reviewer. I'm a fan, as I make clear in my book, but to judge by the number of participants (2352 members have submitted 274 instances of prior art), it's failed to gain the level of traction that would—and I'm speculating here—persuade the USPTO to adopt Noveck's methodology across the board.

Now a new model has emerged: On Monday a company called Article One Partners hung up its shingle. It's like Peer-to-Patent, in that it relies on the collective intelligence of the public. It's unlike Peer-to-Patent in that it offers money—up to $50,000—for anyone that can provide documentation that an existing patent either is or isn't valid. My colleague Julian Sanchez at Ars Technica (now part of the Wired empire) notes that this isn't entirely original, and perhaps Article One—which has filed for patent protection—is guilty of patent infringement itself. That's not quite right—in fact, Article One is working with Noveck. It will pay Peer-to-Patent contributors if they submit prior art that is accepted by the non-profit.

No, my problem with Article One is that it would seem to create the prospect of freelance

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IP mercenaries, with a cash incentive to dig up material that would assist possible plantiffs in a suit, leading to a further, unwelcome increase in court dockets. I could be wrong (and if I am, I'm sure AOP will be the first to tell me), but my impression is that whereas Peer-to-Patent asks its community to review patent applications, Article One asks its contributors to review existing patents. This strikes me as a horse of a different color, and one that patent lawyers might consider with some relish, and judges with a sigh of exhaustion.

Now, I'm not entirely unaware of the contradiction in my complaint—part of the solution to aforementioned Gordian Knot it to invalidate patents that shouldn't have been granted in the first place. But the problem is that given the complexity of many of the patents in, say, computer sciences or biotechnology, originality is in the eye of the beholder—or, as it often happens, a judge.

At any rate, I'm excited to see Article One launch for one reason: It offers an unparalled window into what may be the most fascinating, and thorny, aspects of research in community production: What motivates the contributors? Will more people contribute to Article One than have participated in Peer-to-Patent? If so, what's the signal to noise ratio? Did the cash incentive bring out the idiots and the trolls? All interesting questions that time will surely answer.

National Public Radio - Talk of the Nation/Science Friday - Advice for Aspiring Inventors (David Kappos interview)

17 August 2007

Advice for Aspiring Inventors

IRA FLATOW, host:

This is TALK OF THE NATION: SCIENCE FRIDAY. I'm Ira Flatow.

August is National Inventors Month. So this hour, we're honoring inventions and inventors of all kinds. If you're an inventor or you want to be one, this hour could be life changing. Our guests include two inventors who are experts at helping you get your idea from your shop, or your basement or your PC to store shelves and, possibly, Internet sales.

One of the first roadblocks faced by new inventors is how to get their gizmo or their idea patented. With so many new patent applications being filed each month, the U.S. Patent and Trademark Office is flooded and overworked. There are not enough people to analyze and review those highly technical patents. So what to do? Why not do what scientists do? When they want to judge the merits of a research paper or experiment, they seek outside advice from other scientists – experts in their fields. Peer review is what it's called.

Well, the patent office has decided to give it a try, allowing the public to - allowing the public to review patent applications. That means, anyone who's interested, who is interested, you can apply. Thanks to a new approach to applying for patents called Peer-to-Patent. And this hour, an intellectual property lawyer from IBM who helped come up with the plan is here to tell us about that and how you might get involved in reviewing patents. .....

FLATOW: Speaking of invention, did you know that if you apply today to the U.S. Patent and Trademark Office, you won't hear back about your patent for as long as four years. The patent office is so short of people who can review your idea that it takes much too long to get any idea patented, no matter how good it is or how much we need it.

Enter our next guest, David Kappos, intellectual property lawyer for IBM. Working with a team of lawyers and law students, he is co-author of a new proposal called Peer-to-Patent. So now, anyone can apply online to review patent applications for the patent office, no special credentials required.

And as Mr. Kappos will tell us, thousands of people already have. David Kappos is vice president and assistant general counsel for intellectual property at **IBM**. He joins us today from his office in Armonk. Welcome to SCIENCE FRIDAY.

Mr. DAVID KAPPOS (Vice President; Assistant General Counsel, Intellectual Property Law, IBM Corporation): Well, thanks for having me on the show, Ira.

FLATOW: Well, you've (unintelligible), you've reinvented a wheel, so to speak.

Mr. KAPPOS: Well, that's right. You know, the patent system in the U.S. is just fundamentally important to our national excellence, to our place in the global stream of commerce. And it really deserves to have a way to evaluate all of those submissions that you mentioned – the hundreds of thousands that come into the U.S. Patent Office each year. And a way to do that that leverages the 21st century Internet infrastructure that's available, and the Peer-to-Patent review system that we put together in cooperation with New York Law School is just exactly that. It's simply the patent office meets the 21st century.

FLATOW: How can people apply to become patent reviewers?

Mr. KAPPOS: Well, it's actually very, very simple. You can go on to the Peer- to-Patent Web site, which is available on the World Wide Web. And there is a nice, very simple description. And I'm happy to describe briefly how the process works. You actually don't have to register if you don't want to. And you don't have to provide your name if you don't want to, although it's great if people do because it enables them to be part of the community.

Then you can view applications, patent applications that have been submitted into the process by a number of companies, including **IBM** and others. And you can place comments in the system on them. You can submit documents that you think may be relevant to them. You can comment on anything you might know about the invention. And you can also evaluate and essentially comment on the comments that other people have made about applications in the system. Then what happens is after a period of time, a neutral party takes a look at all the comments that have been made, the documents that have been submitted and essentially puts together the top comments, the top documents and forwards those to the U.S. Patent Office, so that the U.S. Patent Office Examining Corps can use that material to do a better, faster job of examining and issuing patents.

FLATOW: So, you know, you can see a patent - I can – well, one of the problems the patent office had, is it didn't have enough experts. You know, they were allowing some silly patents to go through.

Mr. KAPPOS: Yeah, that's exactly right. The patent office has got a wonderful corps of folks. But as you mentioned, they are just outgunned. They're overwhelmed with the hundreds of thousands of applications coming in, and they just do not have enough resource. Peer-to-Patent is just absolutely spot-on intended to help the patent office by

leveraging the millions and millions of expert people around the world who can very easily comment on pending patent applications, saving patent office examiners tremendous amount of time and getting better leverage out of their efforts.

FLATOW: What about people who are afraid that their ideas will be stolen now that they're on the Web and people are looking at them?

Mr. KAPPOS: Right. Well, that's an important concern and certainly nobody wants that to happen, whether you're a big company or a small company or an individual, we all very carefully want to preserve not having our information taken from us. So the way the system works is it evaluates only those applications that are already published by the U.S. Patent Office, so the applications that are already out there in the public domain, so there's no issue once you get into this system, Peer-to-Patent. There's no issue of your application somehow being compromised because it's already public. There are some other safeguards in the system, including, most principally, that the only applications that go into the system are ones where their author, the inventor, agrees to put the application in the system.

FLATOW: Right. Hang on, David, because I got to take a break. We're going to come back and take a short break. Stay with us. We'll talk more about, I think, talk with David and other patent experts for a few more minutes with David. So stay with us. We'll be right back after this break. I'm Ira Flatow. This is TALK OF THE NATION: SCIENCE FRIDAY from NPR News.

(Soundbite of music)

FLATOW: You're listening to TALK OF THE NATION: SCIENCE FRIDAY. I'm Ira Flatow. We're talking about patents and patenting this hour with my guest David Kappos, vice president and assistant general counsel for Intellectual Property Law at **IBM** in Armonk, who has created a new way to help out the patent office called the Peer-to-Patent which means that you can – David is this correct, even smalltime not the **IBM**'s and the Microsoft's people, or just plain citizens, folks, can review patent applications?

Mr. KAPPOS: Yeah, that's exactly right, Ira. And we would just love to see people from all over the world get on the system. To date, over 115,000 people from, I believe, over 100 countries so far have come and visited the system. There have been something like 18,000-plus unique people who've come in and registered on the site. And we've got thousands of comments coming in. So, literally, people from all over, large and small companies, individuals are both encouraged to visit the site and to get involved and are actually doing that now.

FLATOW: And you don't have – do you have to qualify with any kind of knowledge or all of your comments will be considered?

Mr. KAPPOS: There's no qualification requirement. All comments get considered. The system works a little bit like a wiki kind of an idea, where comments that are really good

ones get rated highly by other people, who are also looking at the comments. And comments that aren't so good get rated more lowly. And so, over time, people who are supplying value will have their comments considered more seriously, and those who are supplying less value likewise.

FLATOW: A patent wiki, very interesting idea. Yeah. And this is going to be running for how long? Or is it going to be running forever? Or are we in a test period, I guess I'm intending to say?

Mr. KAPPOS: Right. Well, we're currently in a pilot stage and it is clearly a test period. The U.S. Patent Office is helping out and New York Law School, a number of companies are helping out. And then, as I mentioned, everyone is invited to get on the site and join. The test period will be running for a period of over a year and the reason for that is it takes quite a bit of time to get applications in, get them commented on and find out what's working and what needs to be improved. After that period of time, we'll be trying to move from a pilot phase into a production phase where the USPTO hopefully will be able to roll the system out across very large numbers of applications.

FLATOW: Well, David Kappos, I wish you and your Peer-to-Patent folks good luck.

Mr. KAPPOS: Well, thank you very much, Ira.

FLATOW: Thank you. Have a good weekend.

Mr. KAPPOS: Yeah. Bye.

FLATOW: David Kappos is vice president and assistant general counsel for Intellectual Property Law at **IBM**. He was talking with us from **IBM** headquarters in Armonk.

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Wall Street Journal: Big companies set plan to share 'green' patents
http://online.wsj.com/article/SB120027151743287307.html

By WILLIAM M. BULKELEY
January 14, 2008; Page B2

Multinational companies including International Business Machines Corp., Sony Corp., Pitney Bowes Inc. and Nokia Corp. will unveil today what they call a patent-sharing plan for companies to donate intellectual property that improves the environment.

The project, dubbed the "Eco-Patent Commons," builds on the experience of the open-source software movement in which programmers around the world freely share their computer programs, said David Kappos, IBM's assistant general counsel for patent law, who helped design the system. He said that "the advantage of using this commons approach is efficiency, scale and visibility."

The commons will be administered by the World Business Council for Sustainable Development, a Geneva-based group that includes some 200 of the world's biggest companies.

Intellectual property rights to technology that solves environmental problems have been a contentious issue in negotiations over the Kyoto Protocol -- which attempts to combat global warming -- with U.S. negotiators resisting proposals to force companies to give away technology. John Coequyt, energy policy specialist with the Washington office of Greenpeace, an environmental group, said that the commons is "potentially a way to solve the problem by voluntary action."

The founders of the commons are donating about 30 patents to get it started. IBM -- which last year won 3,125 U.S. patents, more than any other company -- is donating several, including one for recyclable protective-packaging material for delicate electronic parts. Unlike commonly used foam peanuts, the material can be recycled in the same waste stream as the cardboard box that contains it.

Nokia is donating a patent for methods of recycling obsolete cellphones into oncommunicating calculators and personal digital assistants.

Some of the donated patents aren't directly environmental. Pitney Bowes, the mailing-systems maker, donated a 1996 patent for a design that protects electronic scales from being damaged when they are overloaded. Pitney Bowes says it got out of the scale-making business several years ago. Angelo Chaclas, deputy general counsel of Pitney Bowes, said the patent has environmental implications, because "if you have a technology that extends the life of electronics, you keep it out of the waste stream." He said that Pitney Bowes, which has a portfolio of 3,400 patents, was eager to support the commons in hopes of getting access to other companies' patents that it might be able to

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use.

Mr. Kappos of IBM said that any company can join the commons by contributing a patent. But all patents offered are available to anyone in the world on a Web site that will be maintained by the World Business Council.

Mr. Kappos said that while individual patents that are donated may not be bringing in licensing revenue, or be protecting actual products, donating them still represents a gift of value. "We're pledging that we won't assert the patents that are put into the commons against anyone who is using them in an environmentally friendly way."

Write to William M. Bulkeley at bill.bulkeley@wsj.com

Bloomberg: IBM Joins Sony, Nokia in Sharing Ecologically Friendly Patents
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IBM Joins Sony, Nokia in Sharing Ecologically Friendly Patents

By Matthew R. Miller

Jan. 14 (Bloomberg) -- International Business Machines Corp., the leading recipient of U.S. patents, is joining Sony Corp., Nokia Oyj and Pitney Bowes Inc. in offering the rights to environmentally friendly technologies for free.

The effort, called the Eco-Patent Commons, is designed to help companies save energy and water and curb pollution, Armonk, New York-based IBM said today in a joint statement with the World Business Council for Sustainable Development in Geneva.

Companies are taking steps to show they're fighting global warming and promoting sustainable development. The Eco-Patent Commons is the first forum for sharing intellectual property with environmental uses.

``There's no one industry, innovation or technology that provides a silver-bullet solution," said David Kappos, IBM's lead patent attorney. ``There's going to be a long series of development involving many industries."

The Eco-Patent Commons will start with 31 patents, 27 of which were contributed by IBM. The company has received more U.S. patents than any other for 15 years. The U.S. Patent and Trademark Office issued 3,125 to IBM last year, Kappos said.

IBM is contributing a patent for a catalytic reactor that uses low-radio frequency energy ions to help covert pollutants into stable gases. Another patent covers a packaging design for a five-sided, shock-absorbing tray that replaces the need for Styrofoam peanuts.

Sony, the world's second-largest consumer-electronics maker, is donating a patent for the use of a natural coagulant to purify wastewater. Nokia, the biggest maker of mobile phones, is giving the rights to a way of transforming old phones into new electronic devices, such as clocks and calculators.

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Persuading companies to turn over intellectual property is the project's biggest challenge, Kappos said. He argues that the sharing of patents may help companies make more money.

``The increased scale that occurs when someone adopts a piece of technology causes the costs for us to come down,'' Kappos said.

The patents will be made available today on the Web site for the World Business Council for Sustainable Development.

To contact the reporter on this story: Matthew R. Miller in Atlanta at mmiller31@bloomberg.net

Last Updated: January 14, 2008 00:14 EST
San Francisco Chronicle: 'Eco-Patent Commons' hopes to improve environmental innovation
'Eco-Patent Commons' hopes to improve environmental innovation
Tom Abate, Chronicle Staff Writer

Sunday, January 13, 2008

SFGate Technology: It's a high-tech world - - we just plug you into it...

What does it mean when four of the world's biggest companies put a few patented environmental technologies into the public domain for anyone to use?

Perhaps it means there's hope.

IBM Corp., Nokia, Sony and Pitney Bowes are expected to announce Monday that they have put 31 inventions into an "Eco-Patent Commons" designed to make these Earth-friendly manufacturing and waste-reduction processes more widely available.

"This is an open source effort along the lines of the Creative Commons," said IBM assistant general counsel David Kappos, who is responsible for the company's intellectual property.

The open source movement, symbolized by the free Linux operating system, believes that innovation occurs more quickly when new ideas and processes are open to the public for anyone to troubleshoot and improve.

The Creative Commons is a nonprofit organization devoted to the same idea of openness, but with a focus on copyrighted works like entertainment and literature.

Until now, patents have been the antithesis of these sorts of free-for-all philosophies, because a patent enables its holder to have exclusive control over the invention for a period of up to 20 years, the idea being to give the inventor a chance to recoup the effort during this period of exclusivity.

The Eco-Patent Commons adopts this activist tactic in certain fields - like waste reduction - where the participating firms have decided that the societal benefit of having every willing manufacturer adopt these cleaner processes outweighs any potential advantage they might gain by keeping the idea close to the vest.

"You don't have to ask permission, you don't have to pay a royalty," Kappos said.

One of the newly freed eco-patents is an IBM invention for using a specially folded piece of corrugated cardboard to cushion electronic components against shock during shipping - replacing the Styrofoam products that can easily become an environmental headache.

Likewise, Nokia is giving away a patent designed to help safely dispose of mobile phones by reusing their components in other gadgets such as digital cameras.

Kappos said the Eco-Patent Commons would be run by an independent, nonprofit group, the World Business Council for Sustainable Development, and expressed hope that other companies would follow the lead and add real clout to what is more a symbolic than substantive effort to make global business a little greener.

IBM announced its intention to create the Eco-Patent Commons at a March 2006 event in San Francisco, and Kappos said it has taken this long to get this modest down payment on what participants hope will be a groundswell of donations to this free bank of environmentally useful technologies.

This act of corporate altruism comes at a time when Congress is considering an overhaul of patent law. But that has proven to be a thorny problem, said Mark Lemley, an expert on patent law at Stanford University, because tech firms want the system to be a little looser, while biotech and drug companies want patent holders to keep their clout.

"Most of the proposals put the information technology industry on one side and the biomedical community on the other," he said.

Action on the legislation isn't expected for a few weeks.

Online resources
Eco-Patent Commons

www.wbcsd.org

Visit the Eco-Patent Commons at www.wbcsd.org.

E-mail Tom Abate at tabate@sfchronicle.com.

C/Net - Supreme Court loosens patent 'obviousness' test

C/Net - **Supreme Court loosens patent 'obviousness' test**
By Anne Broache, Apr 30, 2007
http://news.com.com/Supreme+Court+loosens+patent+obviousness+test/2100-1014_3-6180220.html

A unanimous U.S. Supreme Court ruling Monday backed away from a decades-old legal test that high-tech firms argue has sparked an abundance of obvious patents.

In a hotly anticipated decision that could make it easier to challenge patents of questionable quality, the justices called for loosening the current approach set by the nation's dedicated patent appeals court for deciding when a combination of existing elements deserves patent protection.

"Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility," the court wrote in a majority opinion (PDF) penned by Justice Anthony Kennedy.

The court heard oral arguments in November in the closely watched case, which is rooted in an obscure dispute between KSR International and Teleflex over vehicle gas pedal designs.

Technology companies were quick to praise the decision. Several Silicon Valley heavyweights, including Intel and Cisco Systems, had submitted supporting briefs urging the Supreme Court to revise the lower court ruling.

"There will be a better opportunity for examiners to weed out patents or applications that are not worthy of getting patents, and it will go a long way toward re-establishing patent quality," said Emery Simon, counselor to the Business Software Alliance, whose members include Adobe Systems, Cisco Systems and Microsoft.

"What we don't know is how far the judges want the decision to go. We don't know the answer to what the new rule is yet."

--Todd Goldstein, attorney

Others were wary of the decision's broader economic implications on patent holders and voiced concern that the decision will throw the patent system into a state of confusion.

"I think it's very fair to say that it's going to be harder, more costly and more time-consuming for inventors to obtain U.S. patents in all areas of technology, and particularly in areas with predictable art, as we call them, such as mechanical inventions and software and methods of doing business," Robert Greene Sterne, founding director of the patent law firm Sterne Kessler Goldstein & Fox, said in a conference call with reporters. He added that "existing patent portfolios will need to be looked at, and existing relationships will need to be evaluated."

Federal law dictates that an invention cannot be patented if a person of "ordinary skill" in the same field could have come up with it. But because it's easy to claim that an invention is obvious in hindsight, the U.S. Court of Appeals for the Federal Circuit in 1982 concocted a legal test designed to lead to a more objective conclusion.

That standard requires that for an invention to be declared obvious, some "teaching, suggestion or motivation" must exist to show that a person of ordinary skill would have thought to combine certain elements.

Critics have argued that in practice, written evidence is required to pass that test, which has made it harder to overturn allegedly obvious patents and rendered it easier to obtain them from the U.S. Patent and Trademark Office in the first place. Technology companies say that's especially hard for them to prove because of the speedy rate at which they tend to develop new products and ideas.

"It's not written down, it's not published, it's not the subject of scholarly discussion, and that's where the Federal Circuit was basically looking," Ed Black, president of the Computer and Communications Industry Association, whose members include Google, Oracle, Red Hat and Verizon, said in an interview with CNET News.com on Monday.

The justices were sympathetic to those criticisms. "The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way," they wrote. "In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends."

Hardware and software makers have also argued that they're especially threatened by the standard because they would like to be able to rearrange at will the thousands of pre-existing components that compose their products. Some say the lax rules have sparked a stampede of so-called patent "trolls" who make a living off predicting those incremental changes to existing high-tech inventions, landing patents, and then going after companies for infringement.

Supporters of the Federal Circuit's test had argued that any changes would dilute the value of their patents by erasing the "predictability" they currently expect of the system. A number of large, patent-reliant companies like General Electric, 3M, Johnson & Johnson and Procter & Gamble said they believed the current test has been working well and is critical for protecting and encouraging innovation.

Rather than throwing out the so-called "teaching, suggestion or motivation" test entirely, the justices said they expected a number of other factors to be considered as well, namely "the inferences and creative steps that a person of ordinary skill in the art would employ."

As a result of the ruling, "now I can just say, common sense, and a person who was skilled in the particular area, would have known that you could solve this problem using this technique," said Philip Swain, a patent attorney with the firm Foley Hoag in Boston. "You don't have to have a written suggestion or other evidence to suggest the combination; you can just say the person would have inherently known to use that solution."

But some attorneys watching the case argued that the court failed to give enough direction on how the obviousness test should now be met. Some also suggested that the decision paves the way for the validity of previously issued patents to be called into question, likely leading to more litigation--or at the very least, a lengthy transition period as the Patent Office and the courts try to make sense of the Supreme Court's opinion.

Todd Goldstein, the attorney who argued Teleflex's case before the high court, said the economic consequences of changing the obviousness requirement "run into the trillions of dollars" because of the uncertainty the decision has created. Although there's no doubt the court intended to tighten the standard for issuing and upholding patents, "what we don't know is how far the judges want the decision to go," he said in a conference call with reporters. "We don't know the answer to what the new rule is yet."

It's not the Supreme Court's job to prescribe a detailed new test, and the justices were right to leave that decision with the lower courts, said **David Kappos, IBM's assistant general counsel for intellectual property law.** He also argued that the patent system will not encounter new chaos and that just the opposite will occur.

"What we have had is an era of extreme uncertainty caused by the issuance of many trivial and marginal patents under the old test," he said in a telephone interview. "What we're going to see now is actually more certainty because those trivial and marginal patents aren't going to get issued."

The ruling marks the latest in a string of patent cases that have prompted the Supreme Court to scale back decisions made by the patent appeals court. By the tech industry's description, the high court has so far behaved in a manner that begins to restore some of the balance to a patent system that critics say has been too often tipped in the favor of patent holders.

In a high-profile case last year involving eBay, the high court sided with the auction giant in making it more difficult for patent holders to obtain injunctions against the use of their inventions when infringement has occurred.

Separately on Monday, the justices knocked down a different Federal Circuit decision involving an ongoing patent spat between Microsoft and AT&T. The court ruled 7-1 that

Microsoft is not liable for patent infringement that occurs when the "abstract software code" it supplies to foreign manufacturers is subsequently copied onto machines there.

The ruling also comes as Congress has begun a new foray into rewriting patent law. The latest bill attempts to prevent bad patents from being exploited by allowing third parties to submit evidence that a patent is not novel or is obvious, and by setting up a post-grant opposition process in which people could challenge just-issued patents outside of court.

Although technology companies were generally upbeat about the Supreme Court's latest ruling, its immediate effects aren't entirely clear.

"This may make the holders of some lousy patents a little less interested in going the litigation route because it may well be they realize that their chances of winning are lower," said CCIA's Black. "I have to mitigate that comment unfortunately a little bit by saying that an awful lot of litigation goes on here that isn't expected to go to trial; it's for extortion purposes."

The Wall Street Journal - Patent Holders' Grip Weakens

The Wall Street Journal - Patent Holders' Grip Weakens
High Court Curtails Power Amid Innovation Debate; More Disputes May Arise
By JESS BRAVIN, May 1, 2007; Page A3

WASHINGTON -- The Supreme Court made it harder to get new patents and to defend existing ones, giving new force to the law that denies patents to inventions deemed "obvious."

In a unanimous decision, the justices yesterday sided with critics who argue that lower-court rulings have given patent holders more power than Congress intended, potentially stifling innovation.

The ruling, the latest to roll back patent holders' clout, comes amid a sharp debate over how to maintain the nation's competitive edge while protecting those who labor to design cutting-edge inventions. Many of the developments that drive the economy are governed by patent law, an arcane field that has become a battleground in the larger debate about U.S. industrial strength.

The opinion could have especially big implications for technology companies, whose software programs typically are built through small improvements in prior designs. Also affected will be the growing and much-disputed field of "business method" patents, which are granted for abstract processes rather than specific devices.

In a separate, and less sweeping, decision also delivered yesterday, which involved **AT&T** Inc. and **Microsoft** Corp., the court limited the enforceability of U.S. patents for software installed overseas.

Yesterday's rulings are sure to influence pending patent cases while opening an unknown number of existing patents to challenges. Weaker patents that survived under lower-court precedents are more likely to be invalidated, putting their inventions in the public domain.

With challengers emboldened to resist infringement claims, more disputes could head to court. But patent holders, assessing their weakened position, could be inclined to settle disputes on more generous terms rather than risk a court judgment that could invalidate their patents outright. Investors that buy up patents with the aim of obtaining royalties from alleged infringers -- known as patent trolls -- are sure to find slimmer pickings.

In its ruling, the court said the U.S. Court of Appeals for the Federal Circuit, a specialized court overseeing patent law, had been too generous toward patent holders, allowing them to claim a patent monopoly for incremental advances. The decision swept aside the test used by the court to determine whether an invention was "obvious" -- and therefore ineligible for a patent.

Patent law aims to strike a balance that provides an incentive to inventors by guaranteeing a limited-time monopoly, currently 20 years, on an invention's use, while ensuring that intellectual-property rights are flexible enough to allow research and innovation based on prior discoveries.

While any federal district court can hear a patent suit, all patent appeals are funneled to the Federal Circuit, set up in 1982 to centralize legal doctrine in several specialized fields. In the first two decades that followed the Federal Circuit's creation, the Supreme Court took few patent cases.

In recent years, the high court has repeatedly stepped in to correct Federal Circuit rulings it found skewed the balance toward patent holders by failing to take into account the fluid nature of the modern economy.

"What they're starting to put together here is a model for a 21st-century patent system," said David Kappos, who oversees intellectual-property law at **International Business Machines** Corp., Armonk, N.Y. "Closed proprietary innovation remains important," he said, but the court seems to be saying that patent law "can also accommodate 21st-century models that are more open, more collaborative."

High-technology companies have been particularly aggressive in seeking to reduce what they regard as abuse of the patent system, which makes it more costly to design and sell new products. "What we have is a patent system that has evolved from a focus on protecting innovation to becoming a litigation lottery," said Mark Chandler, senior vice president and general counsel of **Cisco Systems** Inc., the San Jose, Calif., maker of networking equipment.

Patent laws came under widespread criticism following the huge windfall won by little-known patent-holding company NTP Inc. in March 2006 from **Research in Motion** Ltd., maker of the popular BlackBerry wireless email device. Faced with a court-ordered shutdown of its services in the U.S., RIM, of Waterloo, Ontario, agreed to pay $612 million to NTP, whose patents had never been applied to an actual product.

The most important of yesterday's cases involved an almost textbook example of old industry -- the design of an accelerator pedal built for **General Motors** Corp. trucks. KSR International Corp., Ridgetown, Ontario, designed the pedals by adding an electronic sensor to a previously developed system. Rival **Teleflex** Corp., Limerick, Pa., had made a similar device for **Ford Motor** Co. trucks and claimed that KSR infringed its patent. A federal district court dismissed Teleflex's suit on obviousness grounds, but the Federal Circuit reversed the decision.

In its cases, the Federal Circuit worried that in hindsight, any invention might seem obvious, particularly when combining previously existing designs. To guard against that, it fashioned a test in which something could be deemed obvious if it was foreshadowed by some prior "teaching, suggestion or motivation." Critics complained that some combinations were so obvious that no one would have thought, for instance, to publish an article on the topic.

Writing for the court and ruling for KSR, Justice Anthony Kennedy said combining a digital sensor with a mechanical pedal would have been obvious to a skilled engineer. The Federal Circuit was too narrow in its definition of "obvious," he wrote, saying it should be measured against such factors as changing marketplace pressures and the progressive increase in overall knowledge. "Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress," he wrote.

The other case concerned the classification of U.S.-designed software installed on computers assembled overseas. AT&T contended that Microsoft had infringed its patent for voice-compression software when it sold its Windows operating system to foreign computer makers. The Federal Circuit agreed, only to be overturned by the Supreme Court on narrow grounds relating to the difference between "supplying" and "copying, replicating or reproducing."

The same legal theory used by AT&T has been used by nearly all of the 45 patents suits pending against his company, said Brad Smith, Microsoft's general counsel.

"Simply by winning this decision today, we reduce the liability exposure in these various lawsuits by something close to 60%," Mr. Smith estimated.

IP Review: Managing IP the IBM Way

Managing IP the IBM way

David Kappos, IBM's vice-president and assistant general counsel for IP law, is at the centre of a global network of IP lawyers at a time when the rules of the IP game are being re-written. He explains to ***Edward Fennell*** *how he is remoulding IBM's IP strategy to meet these new challenges*

There used to be a much-quoted claim back in the 1970s and early 1980s that 'Nobody ever got fired for buying IBM'. It reflected, justifiably, IBM's dominant position in the then-computer industry in terms of reputation and innovation. Since that time, of course, plenty has happened – not least the rise of Microsoft, the creation of the World Wide Web and the dot com boom and collapse. But, while a myriad of names have flashed across the IT firmament, IBM remains steady as the North Star.

Now celebrating its 110th anniversary, the secret of IBM's survival has been its ability to reinvent itself. Over the last year or two, for example, it has undertaken a major transition process, shifting progressively away from Europe towards Asia. The result is that the company has reduced its selling costs by a quarter and generated a recent 11% jump in year-on-year second quarter net income.

The credit for this goes to chairman and chief executive Sam Palmisano who (in the tradition of IBM's leaders) has grasped the implications of radical changes in its market and reacted boldly and imaginatively. But the same applies, says David Kappos, to the company's worldwide patent policy. Right now, for example, IBM is embracing open systems and adopting a new,

groundbreaking corporate policy towards the creation and management of patents.

This is a step of huge importance. Moreover, it turns on its head much of the traditional IBM way of doing things. As David points out, IBM has been an IP-based company ever since 1896, when it put technology to work for the census-takers. 'Bluntly, if you are a technology company then you have to be an IP company – it's just incredibly important for your business,' he says. Historically, that meant battening down everything and sharing nothing. But that model is now changing.

A question of scale

IBM has a worldwide portfolio of 40,000 patents. About half are lodged in the USA and the remainder split between Europe and Asia (where, of course, China is increasingly featuring). So far this year, IBM has filed 3,000 patents and is on target, says David, to maintain its record for the past 14 years of consistently filing more patents than anyone else. At the front line of this massive endeavour are the 200 or so IBM patent attorneys around the world working closely with the R&D teams in the company's high-powered research laboratories in places like Zurich and Hursley, near Southampton, in the UK.

They become involved right from the gestation stage of new products. 'You want your IP lawyers to be where the action is,' says David. Decisions on patenting are taken ultimately by business managers, but the IP lawyers are a key influence. 'There is very strong support from the top of the company for the IP function and that makes it easier,' he says. 'Everyone becomes aligned with the policy and it makes it easier to get our work done.'

What's happening at the moment is that IBM's IP lawyers are being aligned along a new philosophical axis. Under the leadership of Palmisano and the direction of Dr John E Kelly III, IBM's senior vice-president for technology and intellectual property, the approach to patent protection is shifting. After years of strenuously protecting all its patents the company is now backing the movement towards open standards. And this is changing everything.

> If you're a technology company then you have to be an IP company – it's just incredibly important for your business

Getting technical

'We are now the biggest supporters of the open source development project,' explains David. 'Admittedly this policy is not easily reconcilable with our traditional IP strategy, but we are convinced that it is the way to go for the future.'

In a nutshell, the open source movement aims to encourage the sharing of systems so as to maximise the accessibility and use of information technology. By breaking down protective attitudes and encouraging people to drop the legal barriers around their intellectual property the open source movement believes that, in the long run, it will enable the technology to fulfil its potential and best serve its customers.

David is able to speak confidently about these issues because, like many IBM lawyers, he is a 'tekkie' by origin. 'IP lawyers at IBM need to have deep domain expertise – it's a must-have,' he explains. 'In my case I gained a degree in Electrical and computer Engineering before switching across to law. It would frankly be very difficult to do my job without a technical background. You have to be able to speak the language of the technical experts with whom you are dealing.'

As well as occupying a key role in IBM, David has also held various leadership positions in IP law associations in Asia and the US. Indeed it is the drive for industry leadership which has inspired the company's latest initiative, launched in autumn 2006, to introduce a new, groundbreaking corporate policy governing the creation and management of patents. Linked to IBM's support for open source, the policy aims to 'encourage others in the patent community to adopt similar policies and practices, more stringent than currently required by law'.

The purpose of this, as David explains, is to avoid using IP inappropriately and to manage its patents in a way that exceeds legal obligations. 'It's a fundamental strategic shift,' says David, 'meaning that we want patents to be used as a tool of inclusion. We want to show that patents can be used to facilitate the development of the open source environment.'

Being open

As a concrete demonstration of its commitment IBM has donated 500 specific patents to the Open Source Movement so that anyone can use them. 'This would have been unthinkable a decade ago,' says David, 'but it is the way forward. Our intention is to continue to donate and to build more on top of the open source platform.'

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The new tenets by which IBM intends to operate (see box, left) are designed, says the company, 'to foster integrity, a healthier environment for. Innovation, and mutual respect for IP Rights', and in terms of openness they go much further than the demands of US law. Indeed, David is largely critical of the American approach to patent policy.

'The inventive step standard has got out of hand in the US,' he says. 'Trivial patents are being granted. By contrast, the system is better in Europe. I'm particularly impressed by the good work done by the German and UK Patent Offices. Moreover, the European Patent Office's "inventive step" is the gold standard. It's where I believe that the US should be heading.'

Not that IBM is planning to give everything away. As David admits, specialist areas – such as software for the oil or airline industries, banking and finance – will never be opened up. Nonetheless, in the IBM tradition of the good corporate citizen, the company is fostering a common sense, socially responsible attitude while also ensuring that its business remains highly successful.

On that basis, what's the betting that it will still be here in another 110 years?

IBM'S NEW WORLDWIDE PATENT POLICY TO PROMOTE INNOVATION

The principles by which IBM will now manage its patent policy, wherever it does business, include:

Patent applicants are responsible for the quality and clarity of their patent applications.
Patent applications should be available for public examination.
Patent ownership should be transparent and easily discernable.
Pure business methods without technical merit should not be patentable.

For more information, visit www.ibm.com/gio/IP

This article first appeared in IP Review, *issue 17*
Back

-Stuart Weinberg, Dow Jones Newswires; 416-306-2026;
Investors Business Daily: Tech Companies And Legal Experts Lobby For U.S. Patent Law Reforms

Investors Business Daily: Tech Companies And Legal Experts Lobby For U.S. Patent Law Reforms

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BY SHEILA RILEY

FOR INVESTOR'S BUSINESS DAILY

Posted 2/27/2007

The U.S. patent system, considered fundamental to technological creativity, is overdue for a tuneup, say some tech and legal experts.

Though patents are so essential to progress that they're enshrined in the U.S. Constitution, critics say the application process is flawed and legal challenges too frequent.

The Coalition for Patent Fairness, a lobbying group of 30 companies, trade associations and financial services organizations, hopes Congress will pass legislation to change things this year.

"We think the patent system is essential for innovation," said Steve Elmendorf, coalition co-manager. "The last time it was completely revised was in 1952, and the world has changed a lot since then."

The organization, which includes Hewlett-Packard, (HPQ) Microsoft (MSFT) and Time Warner, (TWX) has four main goals.

First, it wants focus on specific patent value. A windshield wiper inventor suing a car maker for patent infringement, for example, shouldn't get damages tied to the total car value.

Issue: 'Willful Infringement'
Also, standards for "willful infringement" should change, Elmendorf says.

Current patent law makes it easy to say that defendants knew a similar invention existed when they submitted their application, he says. That can multiply damage awards for patent suit losers.

Some say the current standards result in weaker patents — that they actually discourage inventors from researching prior art, or similar ideas already in common usage.

The coalition also wants companies to not be held liable in U.S. courts for alleged infringement in other countries.

Finally, coalition members want to do away with "forum shopping" — when someone sues a company for patent infringement in a geographic area with jurors and courts more sympathetic to their claims.

Lawsuits should take place in the jurisdiction where the supposed infringement took place or where the company is based, Elmendorf says.

The U.S. Patent and Trademark Office doesn't take a stand on legislation. But does support changes to the application process.

One of those changes is for more public participation and comment after patent applications are filed, says Jon Dudas, USPTO director.

Under current law, only examiners at the patent office can determine whether inventions are new. But patents inevitably will be better if that changes, Dudas says.

"In order to get the highest quality patents, we want to make certain that the office gets the highest quality information from applicants and the public," he said.

That will result in fewer legal challenges to patents and more intelligence for businesses looking to invest research and development dollars, he says.

"The more information you have, the stronger your patent will be," Dudas said. "And the more it will provide certainty about exactly what the invention is, and what market that invention will hold."

Corporations naturally have a huge stake in the process.

Coalition member HP spends $3.6 billion annually in R&D. It holds 6,000 patents worldwide for its personal computers and servers, says Joe Beyers, vice president of intellectual property licensing.

It's dangerous to study what has previously been done because it sets a company up for liability, Beyers says. "That results in a slower rate of innovation in society in aggregate," he said.

IBM, (IBM) the top-ranking U.S. patent earner, with 3,600 granted in 2006, isn't a coalition member, but it too hopes for significant changes.

One change it supports is revising the requirement that inventors spell out how best to use their invention. Inventions have multiple uses, says David Kappos, IBM vice president and assistant general counsel for intellectual property law.

The requirement, he says, is like asking whether a Mercedes or a Volkswagen is better.

"It's very difficult to comply with because it's so subjective, and no patent office can assess compliance," Kappos said.

IEEE Champions Inventors

While few disagree with the need for reform, some want everyone — not just corporations — at the table.

The U.S. branch of the Institute of Electrical and Electronics Engineers, the largest engineering organization, wants to give smaller inventors a role in the process.

Corporate voices should be heard, but so should others, says Keith Grzelak, chairman of IEEE's intellectual property policy committee and a private attorney in Spokane, Wash. "IEEE believes the U.S. patent system should serve the entire spectrum of inventors and applicants, from entrepreneurs all the way to Fortune 500 technology leaders," he said.

Some corporations agree.

In January, IBM announced its Inventors' Forum, a Web site that encourages individuals and midsize businesses to discuss patent reform. "The constituency that hasn't been heard from is the small and medium-size businesses, which include large numbers of inventors," Kappos said.

Universities and drug companies also need to be in on the dialogue, Grzelak says. "IEEE wants to support electrical engineering job growth in the U.S., and it comes from that full spectrum," he said.

Patent reform would advance science, Grzelak says. "That doesn't mean helping a Fortune 500 company optimize its next three quarters of performance," he said. "It means promoting the progress of science in the short and long term."

BusinessWeek - A Higher Hurdle for Inventors, 5/14/07
BusinessWeek - A Higher Hurdle for Inventors, May 14, 2007

MAY 14, 2007

NEWS & INSIGHTS

A Higher Hurdle For Inventors
Has it become too easy to win and defend patents? The Supreme Court says yes

Last November, just as he was getting ready to preside over a trial in a patent lawsuit, Judge Joseph J. Farnan Jr. of the Federal District Court in Delaware hit the pause button. Because the U.S. Supreme Court was on the verge of deciding a big case that could influence the outcome of the dispute in his Wilmington (Del.) courtroom, Farnan ordered a delay to see how the high court would vote.

The Supreme Court case, *KSR International Co. v. Teleflex Inc.*, attracted a far broader audience than the parties before Farnan. Even though KSR involved the most mundane of products—car gas pedals—a broad swath of American business had lined up on both sides. More than a dozen hardware, software, pharmaceutical, biotech, e-commerce, and consumer-product companies filed briefs to try to sway the justices. The broad question holding everybody's attention: Has it become too easy to obtain and defend patents?

In a unanimous Apr. 30 opinion, the high court decided that it has. And the decision could be one of the most significant business cases of the last decade. The specifics in KSR involved a fundamental issue in patent law—how to determine when an invention is "obvious." This determination lies at the heart of whether many patents are granted, and if they are, whether they will stand up to challenge in court. If the U.S. Patent & Trademark Office or the courts find a claimed advance is obvious, it goes down in flames; if it is not obvious, it is eligible to win a 20-year monopoly via a patent. The patent asserted by Teleflex against KSR, the Supreme Court found, was invalid because it was an obvious combination of two preexisting inventions.

GAMESMANSHIP

Putting the abstruse analysis of patent proceedings aside, the underlying aim of the obviousness doctrine is to assure that only true inventions, not frivolous or

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incremental advances, are awarded protection. As Justice Anthony M. Kennedy wrote in the KSR opinion: "The results of ordinary innovation are not the subject of exclusive rights under the patent laws." With the U.S. now firmly rooted in a knowledge-based economy, there are few more important issues for many companies than intellectual-property rights. Disputes over patents—who has a right to fence whom out of particular products—have become vital strategic battles.

In the view of a number of critics, the rules of engagement prior to the KSR decision had become skewed in favor of granting weak patents. The result was litigation gamesmanship, with some entities known pejoratively as "patent trolls" wielding questionable patents to extract payouts from larger companies in court. Big companies, including Texas Instruments (**TXN**) Inc. and BellSouth Corp. (now AT&T (**T**)), also have mined their patent portfolios and sought riches by taking alleged infringers to court. Others, such as Cisco Systems Inc. (**CSCO**), began to amass patents by the thousands, in part to use defensively as bargaining chips in litigation. The strategy was called "mutually assured destruction"—if somebody sued them over one patent, they would countersue over five others.

The Supreme Court ruling appears to send a strong signal to lower courts to be more aggressive in rejecting incremental advances or simple combinations of preexisting inventions as obvious. Reverberations from the decision were immediate. On May 1, Internet phone company Vonage Holdings Corp. (**VG**) asked a federal appeals court to vacate an infringement verdict Verizon Communications Inc. (**VZ**) had won against it that could imperil Vonage's business.

In the case before Judge Farnan, Power Integrations Inc. (**POWI**) has already won a ruling that Fairchild Semiconductor International Corp. (**FCS**) infringed four of its patents on semiconductor devices used in power supplies for such things as cell phones and laptop computers. But in proceedings set for June 4, Fairchild will have an opportunity to argue that Power Integrations' patents are invalid, in part because they are obvious. Bas de Blank, one of Fairchild's attorneys in Menlo Park, Calif., sees the KSR decision as strengthening his client's hand. "It's certainly a very important decision for Fairchild and all defendants involved in patent litigation," de Blank says. Not surprisingly, Power Integrations' counsel sees it differently, saying KSR won't affect the outcome of the case.

The varying views companies have on the outcome in KSR have a lot to do with the kind of businesses they're in. IBM (**IBM**) and Cisco rushed to praise the verdict. "We think the court has gotten it right," says David J. Kappos, head of intellectual-property law for IBM. "We've seen a proliferation of very marginal or trivial patents in recent years." At times, Kappos said, when IBM has wanted to create a new product or service, "we would find ourselves blocked" by questionable claims.

Technology companies commonly deal in products that can each be covered by hundreds or even thousands of patents (a laptop, for example). That makes these companies vulnerable to being held hostage by someone who holds a patent on one tiny component and are thus likely to favor rules that make it easier to defeat patent claims. Cisco General Counsel Mark Chandler applauded the ruling: "The patent system needs to reflect true innovation, and when it's too easy to obtain patents...it tends to drive litigation without innovation."

Not everybody is cheering. For pharmaceutical companies, a single patent on a drug molecule can be the wellspring of billions of dollars in revenue. Drugmakers also like to tweak existing products to make longer-acting "new" ones and merge old drugs into combination pills, then patent these "inventions" as well. A ruling like KSR may make challenges to patents based on such enhancements easier to mount. Says Hans Sauer, intellectual-property counsel for the Biotechnology Industry Organization in Washington: "We're not totally thrilled."

By Michael Orey, with Arlene Weintraub in New York

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Dow Jones: Upcoming Supreme Court Case Could Redefine Patent Exhaustion
Dow Jones: Upcoming Supreme Court Case Could Redefine Patent Exhaustion

December 27, 2007: 02:45 PM EST

TORONTO -(Dow Jones)- When he bought a bunch of coffins from Lockhart & Seelye, Alpheus Burke probably didn't know he was helping set an important standard in intellectual-property law.

That standard, patent exhaustion, could be redefined by the U.S. Supreme Court in January when it hears a case that could change the way patent licenses are structured and negotiated.

The doctrine of patent exhaustion, also known as first-sale doctrine, is triggered when the first authorized, and unrestricted, sale of a patented article takes place.

The doctrine was forumulated following a patent dispute between Burke and James Adams, whose patented coffin lids were part of the coffins that Burke bought from Lockhart. Adams had granted Lockhart a license to sell the lids, but only within a 10-mile radius of the center of Boston. While Lockhart complied, Burke sold the coffins in Natick, Mass., about 17 miles from Boston center. So Adams sued Burke for infringement, and lost in Supreme Court on the grounds that his patent rights had been exhausted after Lockhart sold Burke the coffins within the required 10-mile radius. That was 134 years ago.

The case under review in January pits Quanta Computer Inc. (2382.TW) and several other Taiwanese computer makers against South Korea-based LG Electronics Inc. It's rooted in a patent-license agreement between LG and Intel Corp. (INTC) signed in 2000.

LG licensed several patents to Intel and required the computer-chip giant to notify its customers not to combine Intel chips with any non-Intel components. Intel complied, but some of its customers allegedly violated the condition, prompting LG to sue them for infringement. One of those customers was Quanta.

LG lost the case in district court, which ruled that LG's patents were exhausted because it had granted Intel an unrestricted license to sell LG's technology. But the Court of Appeals for the Federal Circuit reversed that decision, ruling that LG's patents weren't exhausted because of the notification that LG required Intel to send its customers.

27 Amicus Briefs Filed For Supreme Court Case

Since the Supreme Court agreed in September to hear the case, no fewer than 27 amicus briefs have been filed.

Some companies that generate the bulk of their revenue from patent licensing, such as Qualcomm Inc. (QCOM) and Wi-LAN Inc. (WIN.T), expressed concerns that a broad interpretation of exhaustion could usurp their patent rights and limit their ability to collect fair value for their intellectual property.

Other companies, including Hewlett Packard Co. (HPQ), Dell Inc. (DELL) and Cisco Systems Inc. (CSCO), fear that a narrow interpretation of exhaustion could lead to conditional license agreements that allow patent holders to collect royalties at multiple levels of the production chain. "Anybody who has a (patent) license...could conceivably be dragged into this," said Barry Cohen, intellectual-property lawyer at Reed & Armstrong LLP.

LG supporters argue that patentees should be able to divide the cost of a license among different levels of the the production chain because it helps minimize the burden on any one company, or group of companies, while allowing patentees to realize full value for their intellectual property. "Nothing in the patent laws requires a patentee to make an unconditional sale that enables it to recoup the value of its patent rights in a single transaction," wrote Papst Licensing GMBH & Co. Kg, a German-company that licenses disk-drive and electronic-motor technology, in its brief.

In many circumstances, Papst added, companies don't want to purchase the full value of a patent because either they can't afford to or they want to use the patent in only one specific way.

Jim Skippen, chief executive of Wi-LAN, an Ottawa firm that licenses wireless patents, said a broad view of exhaustion could force patent holders to target downstream product manufacturers with high royalty demands to compensate for the inability to license upstream companies, which include semiconductor and component makers. This could spark conflict between the downstream and upstream firms because the latter group typically indemnifies the former against patent- infringement liability, he said. "What will happen is you won't be able to license down the chain so you'll go after the highest-value guy, and guess what, the component guys have all given indemnities," he said, noting that not one upstream company has filed an amicus brief.

Big Tech Cos Don't Like Split-Royalty Concept

Dell, Hewlett-Packard, Cisco and eBay Inc. (EBAY) don't buy into the split-royalty concept. In a jointly filed amicus brief, they argue that the "first purchaser" of a patented technology ought to be willing and able to pay a full royalty, so long as the patent holder properly assesses the economic value of their invention. That's because the licensee can pass the cost of a license on to its

customers, the brief said. "In this way, the total royalty paid to the patent owner by the first purchaser is naturally and efficiently distributed, through normal market forces, across every party that owns and makes use of the invention...," the brief said.

While that sounds good on paper, it doesn't translate well into reality, said Jerold Schnayer, lawyer for Papst. If an upstream company hiked the cost of its products noticeably to factor in patent royalties, downstream firms would tell it to "get lost," he said. The end result of such a full-price, single-license scenario would be a lot more litigation, he said. "You'd have to sue everybody (to get paid)," he said.

David Kappos, vice-president and assistant general counsel at International Business Machines Corp. (IBM), said he hopes the Supreme Court takes a balanced view of exhaustion. While IBM, which generates about $1 billion a year from licensing its large patent portfolio, has no problem with anyone licensing and enforcing their patents, it doesn't believe any patent holder, including IBM, should have multiple bites at the apple, Kappos said. "We don't think anyone (should) be able to sell, or license someone to sell, a product and then go out and tell the (licensee's) innocent customers who buy that product, 'Gee, we got some more news for you, you need a patent license in order to do anything with that product,' " he said.

Having said that, Kappos added that an overly rigid view of exhaustion doesn't make sense either, as it prevents "sophisticated parties" from doing business with one another. "In our view, if two sophisticated parties agree and make an explicit form of contract that says 'we understand that this deal is not going to enforce patent rights in certain cases,' then we think it's okay," he said. " We're big boys and girls and we know what we're doing...."

The Supreme Court is scheduled to hear the Quanta-LG case on Jan. 16.

The Washington Post - Open Call From the Patent Office, 3/5/07

Open Call From the Patent Office

By Alan Sipress
Washington Post Staff Writer
Monday, March 5, 2007; 3:34 PM

The government is about to start opening up the process of reviewing patents to the modern font of wisdom: the Internet.

The Patent and Trademark Office is starting a pilot project that will not only post patent applications on the Web and invite comments but also use a community rating system designed to push the most respected comments to the top of the file, for serious consideration by the agency's examiners. A first for the federal government, the system resembles the one used by Wikipedia, the popular user-created online encyclopedia.

"For the first time in history, it allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts," said David J. Kappos, vice president and assistant general counsel at IBM.

It's quite a switch. For generations, the agency responsible for awarding patents, one of the cornerstones of innovation, has kept its distance from the very technological advances it has made possible. The project, scheduled to begin in the spring, evolved out of a meeting between IBM, the top recipient of U.S. patents for 14 years in a row, and New York Law School Professor Beth Simone Noveck. Noveck called the initiative "revolutionary" and said it will bring about "the first major change to our patent examination system since the 19th century."

Most federal agencies invite interested parties to weigh in on proceedings, and even the patent office allows some public comment, but never to the degree now suggested .

Until now, patent examiners rarely sought outside opinions, instead relying on scientific writings and archived records of previous patents. For security reasons -- in particular, out of concern that examiners could inadvertently reveal

proprietary information if their online searches were tracked -- patent officials have at times even been barred from using the Internet for research.

But their mission has grown increasingly unwieldy. Last year, the agency's 4,000 examiners, headquartered in Alexandria, completed a record 332,000 applications. The tremendous workload has often left examiners with little time to conduct thorough reviews, according to sympathetic critics.

Under the pilot project, some companies submitting patent applications will agree to have them reviewed via the Internet. The list of volunteers already contains some of the most prominent names in computing, including Microsoft, Intel, Hewlett-Packard and Oracle, as well as IBM, though other applicants are welcome.

Brigid Quinn, a spokeswoman for the patent office, said the program will begin with about 250 applications from the realm of software design, where it is especially difficult for examiners to find related documentation. Unlike specialists in many other fields, software designers often forgo publishing their innovations in technical journals and elsewhere.

Anyone who believes he knows of information relating to these proposed patents will be able to post this online and solicit comments from others. But this will suddenly make available reams of information, which could be from suspect sources, and so the program includes a "reputation system" for ranking the material and evaluating the expertise of those submitting it.

With so much money riding on patent decisions -- for instance, a federal jury ordered Microsoft last month to pay $1.52 billion for infringing two digital-music patents -- the program's designers acknowledge that the incentive to manipulate the system is immense.

"I'm sure there will be a degree of gaming. There always is," Kappos said.

Maintaining a reliable Web-based reputation has become an increasingly pressing concern for Web companies as they seek to reassure users that they can trust the strangers they do business with online. So the designers of the new patent-review system consulted some of the Internet's leading experts on reputation, Noveck recounted. These included specialists from eBay and Rob Malda, aka CmdrTaco, the founder of the popular technology Web site Slashdot.org.

EBay, for example, established its position as the Web's premier auctioneer after pioneering a public feedback system that has buyers and sellers rate one another based on customer service, the quality of the goods, and timeliness of delivery and payments. Amazon.com, the Web's leading bookseller, provides reviews of its offerings, then allows readers to rank its reviewers based on the usefulness of their evaluation.

The new patent system will try to help separate experts from posers by offering extensive details about the people sending information to the site. To help others evaluate the quality of this information, called prior art, each posting will include several measures gauging the quality of his other contributions to the site. Patent examiners, for instance, will award "gold stars" to people who previously submitted the most useful information for judging earlier applications, Noveck said.

Ultimately, those registered to participate in this online forum will vote on all the nominated information, and the top 10 items will be passed on to the examiner, who will serve as the final arbiter on whether to award a patent.

Noveck said the online program would not only produce better information for examiners to consider but also make the patent process more democratic. "The idea is to make something as important as decision-making about innovation more transparent to the public and more accountable to the public," she said.

During discussions about the patent review project, its developers initially considered limiting or weighting the votes to reflect the expertise of the participants. For the time being, they have instead decided to go with one person, one vote.

But Noveck and others involved in creating the online review system said it was likely to evolve. To assure that the outcome can be trusted, some of those involved in designing the program say some kind of weighted voting system may eventually be required.

"If voting is necessary, you'll have to have some rules about who gets to vote," said Paul Resnick, a professor of information at the University of Michigan

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Patently-O: Patent Law Blog

May 4, 2009 Monday 12:39 PM EST

LENGTH: 1268 words

HEADLINE: Dave Kappos as Next PTO Director?

BYLINE: Dennis Crouch

BODY:

May 4, 2009 (Patently-O: Patent Law Blog delivered by Newstex) --

Although the Obama administration has not directly asked my opinion, I would certainly support David Kappos as the nominee for the next PTO director. Kappos is a longtime IBM (NYSE:IBM) patent guru and currently holds the title of VP and Assistant General Counsel in charge of Intellectual Property.

Bottom line here is that it will be helpful to have a patent office director who understands patents and who has been fully involved with all aspects of the patent system for the past twenty years. I believe that Kappos will be a careful shepherd of the system - leaving it better off in six years than it is today.

Kappos believes in the underlying value of innovation. In his words, "the whole system of innovation is more important now than ... ever." Beyond that, he is dedicated to a strong patent system and a strong patent office as mechanisms for fostering innovation. Kappos has been ready to try innovative approaches to "catch the intellectual property system up to the twenty first century." However, he has always been clear that his ideas for innovation "should in no way be confused with denigration or devaluing intellectual property." In addition, his years at IBM have taught him the value of consistency and tradition.

Much of the job of PTO director involves employee relations, and Kappos continues to successfully lead one of the largest private patent departments in the world. His current and former employees are loyal to him as a leader and praise his creativity and genius. The IBM IP office is known for its spirited and open debates on policy and direction. In my view, this corporate management experience and patent prosecution experience are more relevant to running the PTO than - say - running litigation teams at a law firm, managing a congressional committee, or even teaching a group of law students. Before moving forward, I want to note here that former Director Todd Dickinson is also an excellent choice, and he continues to be strongly supported by both examiners and other patent law professionals. Dickinson would almost certainly do the better job of healing the growing rift between examiners and applicants.

In his recent testimony to the Senate, Kappos put IBM's support behind the compromise form of the Patent Reform Act. For IBM, it was important that the damages portion of the bill be revised: "we must nevertheless be mindful of the fundamental importance of ensuring that patentees are appropriately compensated or the patent system will fail to provide the incentive innovators require." However, the IBM proposal was that royalties should be based on the "essential features" of a patent. (Quoting Quanta). This proposal is problematic because it would create new-rule uncertainty and also

greatly favor holders of large patent portfolios (such as IBM). As director, Kappos should be careful to balance the "right" solution with the need for consistency and stability of rights. IBM also supported the post-grant review system (which I favor) and the venue changes (which I do not favor).

More than his alignment on specific provisions, we can hope that Kappos will bring an important amount of subject matter expertise - helping to ensure that any legislation does not inadvertently disrupt parts of the system that are already working well.

I do have other reservations. Patent pundit Greg Aharonian has oft complained about Kappos and his tendency to talk about patent quality and then charge forward with junky IBM patent applications. Those complaints have merit. The ill defined term 'patent quality' raises red flags in my mind. Here, Kappos has his benign and potentially helpful pet projects of dramatically improving examiner's access (and ease of access) to prior art; improving prior art and patent documents through more standard lexicons; and public collaboration in patent examination (IBM funded the peer to patent program). In the past, Kappos has talked about patent quality as a problem because it leads to a situation where "nobody has an earthly idea of what [a patent] is worth . . . creating a murky and unclear market." These are really proposals to make the prosecution system work more effieiently rather any fundamental changes to patent rights. IBM is good at systems, and Kappos may be as well.

If it is a benefit, it is also a fault that Kappos' blood is saturated with IBM knowledge and culture. Kappos joined IBM in 1983 right out of college (EE / UC Davis) and stayed with the company after law school (Berkeley). At IBM he spent time with the software legal division and also in the Asia/Pacific division. Unfortunately, in the past 25 years, Kappos may have forgotten that most of the world does not operate like IBM. Thus, when he says that "people no longer innovate individually" or that "many new innovations require investments of unprecedented size," I worry that his vision is skewed. Beyond the PTO, IBM has been able to use its large portfolio and market power to build a large licensing pool with very little litigation. Of course, there are few companies in a position to accomplish that result in today's market. It will be important for him to spend time understanding that - in fact - IBM is the atypical market player. On these point, I believe that Kappos will relax his views somewhat once he is no longer the AGC of IBM.

I am excited that Kappos will push the PTO toward a more open system - allowing access to data and information that has been hidden or limited and ready to cooperate on collaborative projects to streamline the system. Kappos has considerable experience with both European and Asian patent systems, and will likely expand cross-border examination collaboration.

On the software side, Kappos will continue to support the idea that software should be patentable - although he argues that patents should at least cover something "technological" and that business methods should be out. Kappos has also spent a lot of time thinking and working with overlapping intellectual property schemes and considering how those interplay with open source software. However, I have not seen any specific proposals.

In the Patently-O reader poll, Kappos earned only 5% of the vote, falling behind Todd Dickinson (36%), Prof Lemley (8%), and "other" (8%).

Other Sources:
Why Kappos is UnfitIP Watchdog on Kappos From Greg Aharonian: "One rumored candidate to be the next Director of the Patent and Trademark Office is **David Kappos,** one of the head patent lawyers at IBM. Given IBM's many abuses of the patent system and patent policy over the past few decades, I think it is inappropriate, nay, wrong, for anyone from IBM to be head of the PTO. Might as well as make Bernie Madoff head of the SEC as part of his upcoming jail-time work-release program. IBM patent lawyers for too long have abused the patent system." "Case in point. Last week IBM was issued its usual batch of patents, many of which are crap - crappy patents whose sole value is to clog the PTO's patent examination pipelines to the detriment of everyone else. A patent application policy actively embraced by **David Kappos.** If I was an IBM investor, I would applaud David for doing his best to help IBM. In fact, sometimes I recommend people to buy IBM stock because the company will do anything to maintain its market value. Kudos to David for his efforts in this regard. But the reward for abusing the patent system for the benefit of IBM should be a gold watch at retirement - and should not be the reward of being appointed head of the PTO."
Newstex ID: 34704335

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April 2, 2009 Thursday 9:48 AM EST

LENGTH: 670 words

HEADLINE: Patent Reform Act of 2009 back before Senate Judiciary Committee today to consider compromise

BODY:

Apr. 2, 2009 (Filewrapper.com delivered by Newstex) --

Today at 10:00 Eastern time the Senate Judiciary Committee will hold an executive business meeting to discuss the Patent Reform Act of 2009. The committee will consider some proposed amendments that represent a compromise on several key issues that have been points of contention over the course of the past several years when patent reform has been on the legislative agenda. Among these is the issues of damages, with the compromise version substantially softening the limits on infringement damages that have been dealbreakers in past versions of patent reform legislation.

A webcast of the meeting is available online at this link.

The original damages provision reads (section 4):

§ 284. Damages

(a) IN GENERAL."

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court, subject to the provisions of this section.

The "subject to the provisions of this section" language tied damages to one of (1) the entire market value of the product, but only if the patented feature was the predominant source of demand for the infringing product, (2) royalties previously agreed to by the patentee, or (3) the value of the contribution of the patented invention over the prior art.

The revised damages provision reads (starting on page 1, emphasis added):

§ 284. Damages

(a) IN GENERAL."

(1) COMPENSATORY DAMAGES AUTHORIZED."

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reason able royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court. In determining damages, the court will direct the jury to consider any relevant factors or methodologies, under applicable law, based on the evidence presented.

This modification should substantially remove most of the problems with the previous damages provisions, assuming that courts are free to consider the traditional Georgia-Pacific factors for calculation of a reasonable royalty.

The interlocutory appeal of claim construction orders section is also rewritten, and now provides for interlocutory appeal:

(3) of a final order or decree of a district court determining construction of a patent claim in a civil action for patent infringement under section 271 of title 35, if the district court finds that there is a sufficient evidentiary record and an immediate appeal from the order (A) may materially advance the ultimate termination of the litigation, or (B) will likely control the outcome of the case, unless such certification is clearly erroneous.

This will likely reduce the number of interlocutory appeals of claim construction that would be permitted.

Modifications are also proposed to reexaminations (removing public use and public sale from grounds for reexamination), best mode (removing it as a basis for invalidity), and venue (implementing a convenience test to determine whether a case should be transferred).

The committee previously held its first hearings on the Patent Reform Act on March 10, where it heard testimony from:

Steven R. Appleton (testimony)
Chairman and CEO
Micron Technology, Inc.
Boise, ID

Philip S. Johnson (testimony)
Chief Intellectual Property Counsel
Johnson & Johnson
New Brunswick, NJ

David J. Kappos (testimony)
Vice President and Assistant General Counsel
Intellectual Property Law and Strategy
International Business Machines Corporation
Armonk, NY

Taraneh Maghame (testimony)
Vice President
Tessera, Inc.
San Jose, CA

Herbert C. Wamsley (testimony)
Executive Director
Intellectual Property Owners Association
Washington, DC

Mark A. Lemley (testimony)
William H. Neukom Professor of Law
Stanford Law School
Stanford, CA

Patent Reform Act of 2009 back before Senate Judiciary Committee today to consider compromise Filewrapper.com
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CQ Congressional Testimony

March 10, 2009 Tuesday

SECTION: CAPITOL HILL HEARING TESTIMONY

LENGTH: 5869 words

HEADLINE: PATENT LAW OVERHAUL;
COMMITTEE: SENATE JUDICIARY

BODY:

TESTIMONY-BY: **DAVID J. KAPPOS,** VICE PRESIDENT AND ASSISTANT GENERAL COUNSEL

AFFILIATION: IBM CORPORATION

Statement of **David J. Kappos** Vice President and Assistant General Counsel, Intellectual Property Law and Strategy IBM Corporation

Committee on Senate Judiciary

March 10, 2009

Mr. Chairman, Ranking Member Specter, and members of the Committee. My name is **David J. Kappos** and I am Vice President and Assistant General Counsel for Intellectual Property Law and Strategy for the IBM Corporation. I appreciate the opportunity to offer IBM's views on patent law reform and the actions that this Committee should take to preserve America's innovation leadership and competitiveness in the world, and to encourage investment to produce economic growth and create jobs.

IBM supports S. 515, the Patent Reform Act of 2009, and urges the Committee to pass this important piece of legislation to create a contemporary U.S. patent system. The last half-century has been a time of unprecedented technological change. However, during this same period, the laws governing our U.S. patent system have not been significantly updated to reflect these changes. Innovation today is characterized by diverse forms of collaboration, multidisciplinary problem-solving, interconnected technologies, and complex products incorporating multiple inventions. The patent system must adapt to these changes.

SUMMARY

IBM is committed to ensuring that our patent system is robust and that the United States economy is strong. We have been the leading assignee of issued patents in the United States for 16 consecutive years, and we earn about $1 billion annually in intellectual property related-income. IBM also invests more than $6 billion a year in research and development, and earns about $100 billion annually providing products and services. IBM is therefore uniquely positioned to promote a balanced patent system that will benefit patentees, producers, and the public.

The patent system must balance the interests of all industries. IBM is not a member of any of the coalitions that have formed to advocate on behalf of particular industries. Rather, IBM believes that these interests are reconcilable and meaningful compromise can be achieved so that the patent system will meet the needs of innovators in all industries, and most importantly, serve the best interests of the American public.

The nature of innovation has changed. Today, we benefit from inventions made possible through highly collaborative and interconnected technologies. Many of the products that consumers demand are complex and include contribu-

tions from multiple innovators that incorporate hundreds if not thousands of patented inventions. At the same time, many new innovations require investments of unprecedented size to achieve a single new product protected by a single patent. For the United States to remain competitive our patent system must accommodate all of these innovation models. Yet our patent laws have not been significantly updated for over 50 years. IBM believes that enactment of S. 515 is necessary for our nation to remain intellectually and economically competitive.

While progress has been made in recent years through judicial reform in areas such as obviousness, injunctions, willfulness, and most recently venue in patent litigation, much remains to be done to restore balance to our patent system. The problem of poor quality patents persists. Uncertain patent rights create speculation and lead to excessive litigation.

IBM supports S. 515's approach to improving patent quality, including "first window" post grant review, enhanced inter partes reexamination, and pre-issuance submission of information. These reforms reduce the impact of poor quality patents by making it easier to promptly challenge the validity of a patent without resorting to litigation, and without subjecting patentees to an undue period of uncertainty.

A particular point of contention has been and remains the appropriate standard for reasonable royalty damages determinations. As with other issues with competing interests that have been resolved, IBM believes that this issue is reconcilable and a balanced solution can be achieved.

In IBM's experience, the current legal standard does not provide the certainty needed to enable modern business to operate effectively. As a result, the precious time of skilled scientists and engineers is too often spent defending gainst costly and time- consuming litigation, instead of creating innovations that drive economic growth.

In reforming the law in this area, we must nevertheless be mindful of the fundamental importance of ensuring that patentees are appropriately compensated, or the patent system will fail to provide the incentive innovators require.

IBM believes that the Supreme Court provided critical guidance in its recent, unanimous Quanta decision. In addressing the related issue of patent exhaustion, the Court focused on the essential features of the invention to determine if the patentee had received full compensation. An approach that uses the Quanta standard as a starting point will provide the guidance needed to properly compensate the inventor by focusing the damages inquiry appropriately.

IBM believes that by improving patent quality and reducing wasteful patent litigation, S. 515 will remove roadblocks to the development and implementation of new innovations, spurring economic growth. For the United States to maintain innovation leadership, our patent system must be in the future what it has been in the past - the best in the world. The need to act is urgent, the goal is achievable, and failure to act will harm our nation's economic interests. We urge enactment of the Patent Reform Act of 2009.

IBM IS A TECHNOLOGY LEADER

IBM is an innovation company and inventions are critical to our success. In 2008, for the l6d' consecutive year, IBM was the recipient of more U.S. patents than any other assignee. IBM received over 4,000 U.S. patents, the first company ever to do so in a single year. We have a deep appreciation of, and commitment to, technology development and scientific pursuits. During the company's nearly 100year history, its employees bave included five Nobel laureates, five National Medal of Science recipients, and seven winners of the National Medal of Technology. IBM has invented industries such as hard disk drives, relational databases, and RISC computers.

Over 6,000 IBM inventors were responsible for the 4,186 patents received by IBM in 2008. They reside in 44 different states and territories in the U.S. and 27 other countries globally. More than 40,000 patents in IBM's global patent portfolio.

IBM employs approximately 120,000 people in the U.S., located in each of the 50 states and the District of Columbia. Their jobs depend on IBM's success in the global economy. Most of these are high-skill, high-wage jobs, including thousands of technical positions in software engineering, hardware development, technical services, consulting, research and manufacturing. The majority of IBM's worldwide jobs in hardware development, software engineering and research are in the U.S.

In addition to developing, manufacturing and delivering information technology, we focus on delivering innovative solutions to IBM clients. Nearly half of IBM's U.S. employees work in our services business, including thousands of consultants and technical experts who serve clients operating around the world. Our clients want an innovation partner

who can help them apply and integrate technology in ways that deliver new and lasting value. IBM is at the forefront of innovation in new products and services, and entirely new business models.

The United States is IBM's largest market in terms of revenue, and IBM invests heavily here. For example, in 2007 over 75% of IBM's $6.2 billion in research and development (R&D) spending was invested in the U.S. Of the over 39,000 U.S. patents issued to IBM between 1993 and 2007, 90% were based on inventions made in the U.S. This R&D investment has made it possible for IBM to generate about $1 billion in IP-related income annually and has enabled IBM to operate a profitable global business with annual revenue exceeding $100 billion.

THE NATURE OF INNOVATION HAS CHANGED

IBM strives to maintain and foster an innovation culture not only to meet our clients' demands, but also to remain competitive and thereby benefit our shareholders, our employees, and the communities we serve. Demands on our business and the businesses of our clients, partners and competitors are driven by new global marketplace realities. If America is to remain competitive, create jobs, and continue to be one of the most innovative nations on earth, it must adapt to these new realities.

In the Industrial Age, innovation primarily was the result of work by individuals or small groups within an enterprise. Today, interconnected technologies have created an environment that allows groups of people to innovate together across enterprises and national boundaries. This rich environment enables the development of multifunction products and services, and creates efficiencies and synergies through the contributions of many different creative sources. Many of the products that consumers demand are complex, include contributions from multiple innovators, and incorporate hundreds if not thousands of patented inventions. We benefit from inventions that are made possible through this "collaborative" innovation.

Incorporating innovation from multiple sources is enabled by: (1) open innovation environments; (2) technology standards, where innovators work collaboratively to create a common platform for product-level competition; and (3) licensing and cross-licensing of technology to gain access to others' innovations. The diversity and interconnectedness of modern innovation models increases the need for predictability and clarity in determining the valid scope of patent rights, as well as valuing them for licensing purposes. For example, a licensing agreement that directly affects two parties is likely to indirectly affect many more. As a result, there is a heightened sensitivity to uncertainty. Such uncertainty in this context will increase transaction costs and make it increasingly difficult for innovators and implementers to trade the intellectual property (IP) rights needed to bring innovative products and services to consumers.

Collaborative innovation through open platforms and standards has blossomed across numerous industries in recent years. Such development occurs in diverse ways. It may be horizontal -- in which multifunction products such as computer systems incorporate innovative features from multiple sources -- or vertical, in which single function products such as pharmaceuticals reflect inventions from multiple "upstream" and "downstream" participants in the development "chain".

So, what role should U.S. patent policy play in making sure that we continue to be a nation of innovators? How should the patent system help us to capture these technological developments and translate them into differentiators for American prosperity and drivers of growth?

THE U.S. PATENT SYSTEM HAS NOT KEPT PACE WITH THE CHANGING NATURE OF INNOVATION

The U.S. patent system is widely acknowledged as underpinning America's leadership in innovation and IBM strongly shares this view.

Patents play as important a role for IBM as they do for any other U.S. company. They provide an incentive to innovate by protecting our inventions while providing us the freedom of action to bring new products and services to market and partner with our clients to meet their needs. Patents spur successive innovation because patentees must disclose their inventions to the public, enabling others to build upon these innovations. As America competes in a global economy, we must rely on innovation for competitive advantage. Ensuring that our patent system properly promotes innovation is therefore central to America's ability to compete and to produce economic growth and jobs.

Unfortunately, we continue to see developments that threaten the ability of the U.S. patent system to keep pace with and respond to changes in the nature of innovation. The U.S. patent system must be properly positioned to help our country maintain and grow its innovation leadership.

Two significant developments arise from the failure of our patent system to adapt: the granting of low quality patents, and the adverse effects of excessive patent litigation.

Low Quality Patents: High-quality patents that have been properly prepared and examined to ensure that they meet all of the legal and policy objectives of the patent system increase certainty around intellectual property rights, reduce contention and free resources to focus on innovation. We believe the quality of patents issued in the U.S. has diminished, and that the substantial improvements needed to address this quality crisis are not possible without Congressional action.

Patent professionals are concerned about patent quality and are not confident that matters will improve. In August 2005, the Intellectual Property Owners Association (IPO) conducted a survey of its member corporate patent professionals regarding their views on U.S. patent quality. The findings are revealing. Over half (51.3%) said they rate the quality of patents in the U.S. as poor or less than satisfactory. This conclusion did not significantly vary based on industry. When asked whether they thought patent quality would decline, improve, or stay the same over the next three years, 28.7% responded that they thought patent quality would worsen, and 51.2% thought things would stay the same. Responses varied some by industry, but the most noticeable differences were in responses by smaller companies (under $1 billion in revenue) and by companies in the computer, electronics, and software industry, where the percentage of respondents expecting a decline in patent quality was nearly twice the average. Forty-four percent of smaller company respondents thought that patent quality would get worse and 40% of the computer, electronics, and software industry respondents thought that quality would worsen.

The U.S. Patent and Trademark Office (USPTO) has not been able to keep pace with the avalanche of applications it has received in recent years. In fiscal year 2007, the USPTO received nearly 485,000 patent applications which represented a seven percent increase over the previous year. The backlog of applications is growing. The USPTO has been hiring more examiners to reduce the backlog. But with such a significant increase in the number and complexity of applications, it is difficult to assure high quality.

Excessive Patent Litigation: Patent litigation has increased significantly for more than a decade, in part driven by low patent quality that creates uncertainty around intellectual property rights, spawning increased speculation. This excessive litigation threatens to sap America's innovative capacity and its ability to compete in the world if left unaddressed.

The number of patent infringement suits filed annually in the U.S. nearly doubled in the ten years ending in 2004, going from 1,617 in 1994 to 3,075 in 2004.3 There were 2,830 cases filed in 2006.4 Patent litigation has remained at this elevated level with some fluctuations. The National Academy of Sciences reported in its 2004 study on improving the U.S. patent system that the number of patent infringement lawsuits settled or disposed of in federal court doubled between 1996 and 2002 from 1,200 to 2,400 cases per year. In 2007, nearly 2,800 U.S. district court patent cases were terminated, over 3,600 cases remained pending, and nearly 2,900 new cases were filed. From 2006 to 2007, the number 2007 Annual Report of the Director: Judicial Business of the United States Courts 207 (U.S. Government Printing Office, 2008). Data covers the 12-month period ending September 30, 2007.

Patent litigation, according to the Phoenix Center for Advanced Legal and Economic Public Policy Studies, costs the economy $4.5 billion annually.9 In a survey conducted in 2007, the American Intellectual Property Law Association found that the median cost to a parry in bringing a patent infringement case to trial verdict with less than $1 million at stake was about $600,000 and in a case with more than $25 million at stake, the median cost was $5 million for each side.Io These figures do not include private settlements in the form of negotiated license agreements to avoid litigation. In its August 2005 patent quality survey, IPO also asked its member company respondents if, in the next 3 years, they expect the resources spent on patent litigation to increase, decrease, or stay the same. Almost 74% said they expect to spend more resources on patent litigation.

This high level of patent litigation, particularly in the IT industry, shows that valuation issues are not being resolved in negotiation. IBM believes that this indicates both that patents of uncertain scope and validity are being enforced, and reasonable royalty damages determinations are not providing the needed guidance for the IP licensing market.

As a matter of patent policy, the requirements for patentability and patent validity should be clear and predictable. As the U.S. Supreme Court in Festo explained, "[t]he monopoly [conferred by a patent] is a property right; and like any property right, its boundaries should be clear." 12 Otherwise, the public cannot discern the scope of the patent until after all infringement litigation has concluded and will not invest in innovative products that might potentially fall within the patent's scope.

Court awarded reasonable royalty determinations provide the backdrop against which all patent settlements and patent licensing activities are measured. Collectively, these settlements and licenses define an IP market in which developers and implementers of IP come together to trade the rights necessary to provide goods and services. This market must function efficiently, minimizing market friction and transaction costs that are ultimately passed along to consumers. Thus, it is paramount that royalties fairly compensate the patentee and fairly charge the licensee. Damages awards that reflect the economic value of an innovation appropriately balance interests and act as essential references for IP market participants, since patentees and licensees are respectively neither overcompensated/overcharged nor under-compensated/undercharged. IBM believes that an efficient EP market is important for promoting innovation, including for the development of complex products incorporating multiple inventions 14 that have become commonplace; and that an efficient LP market rests heavily on the ability to predict with a high degree of certainty the legal remedies available for patent infringement.'

" While multi-function products tend to have high visibility in the IT sector, there is a similar issue in biotechnology due to the multiparty nature of research. Some entities such as universities perform fundamental or "upstream" innovation while other "downstream" entities productize.

To offer the products that consumers desire and to license the related IP, providers need an efficient market in which IP rights can be readily valued and exchanged. Whefe there is divergence between licensor's and licensee's views regarding fair and reasonable licensing fees, transaction costs rise and the market becomes inefficient. Multiple parties make the problem more complex and increase sensitivity since more parties must agree regarding IP valuation. Without certainty, there is also a heightened risk of speculation. For example, parties may be encouraged to enforce patents for purposes of extracting high royalties from the producers of goods and services, while producers may be encouraged to hold out against taking licenses for purposes of extracting access to innovations at low royalty rates. The inability to agree on a royalty fee prevents innovators from being compensated, prevents products and services from reaching the market, and increases the incidence of costly litigation.

As products have become increasingly complex and integrated, the licensing necessary for the IP market to function has become more complicated. Companies need to consider not only their own internally developed technology and IP, but also the technology and IP of others. 's The oft-cited example of the computer, or even the CPU itself, containing hundreds if not thousands of patented innovations is illustrative. Similarly, a pharmaceutical product may incorporate the "fundamental" research of a university combined with the targeted product development of a pharmaceutical firm. is The typical licensee/product-seller must consider all the fees to be paid to all patentees in order to make and sell its product. And the licensor/innovator must consider the role its innovation plays in the applicable product.

When a patented invention is included in a product of any kind, including in a complex multifunction product, its economic value should be determined based on the substance of the invention. Economic value should not be affected by the inclusion or omission of background or contextual elements added to the patent's claims. Nor as a general proposition should economic value be affected by the aggregate cost of a complex multifunction product in which the invention is incorporated. This substance-based approach is fair to both the licensor and the licensee, avoiding both under-compensation and over- compensation. It also enhances predictability and certainty by causing all parties to focus on the inherent value of the patented invention. The public benefits when innovators/licensors and producers/licensees are able to readily come to terms regarding an invention's economic value.

Market complexity creates significant challenges for determining royalty fees. As such, licensors and licensees will continue to be influenced in their negotiations by the legal standard for reasonable royalty damages and its application. This is not surprising - both parties understand that reasonable royalty damages is the metric by which the licensing fee should be judged since it is the measure for damages if they are forced to litigate. Given the challenging developments in the market and the resulting challenges in licensing, it is of paramount importance that the law of damages provides clear guidance.

As U.S. businesses, governments, and communities become increasingly interdependent, our nation's competitiveness will be even more susceptible to weaknesses in our country's patent system. The Congress must take action to reshape U.S. patent law to be responsive to the fundamental economic and technological shifts taking place. The goal of reforming U.S. patent law should be to preserve U.S. leadership in innovative capacity, enabling U.S. businesses to capitalize on developments in technology, infrastructure and business organization and making them differentiators for American prosperity.

THE PATENT REFORM LEGISLATION WILL BRING THE CHANGES NEEDED TO SPUR INNOVATION

IBM believes both patent quality problems and excessive litigation must be addressed, and S. 515 does that effectively. Although there are many provisions in the bill that enable a contemporary patent system, IBM's testimony focuses on the provisions in the legislation that address patent quality and reform reasonable royalty damages.

Improving Patent Quality: There are two crucial reforms in the legislation that should be implemented to improve patent quality. Both of these reforms are designed to open up agency patentability determinations to the public to encourage the public to come forward with relevant information not previously discovered or disclosed. First, the bill creates the opportunity for third parties to submit prior art to the USPTO during the patent prosecution process with commentary on how that prior art is relevant to the application under consideration. This important and broadly supported change will be highly effective in raising patent quality, particularly because it takes advantage of the fundamental shift toward collaborative innovation. More and more collaborative communities are thriving today and their collective knowledge can be harnessed to bring forward information, especially prior art, relevant to the examination process.

Second, IBM believes it is vitally important to have an administrative proceeding to allow the public to bring forward relevant information, post-issuance, about whether a patent was properly issued. This will increase the quality of patents and will provide a low cost alternative to litigation. The solution in the bill represents a reasonable compromise between the need to provide a meaningful way to bring forward relevant information and concerns that the administrative proceeding will be used to harass the patentee. The bill provides the ability to challenge the patent in a post-grant-review proceeding for one year following issuance based on a broad array of grounds related to patentability. After one year, the public can bring forward relevant information through an "improved" version of the existing inter partes reexamination administrative proceeding. The improved inter partes reexamination proceeding will no longer prevent a challenger from going to court at a later time on an issue that was not raised in the proceeding. Further, in addition to patents and printed publications, a challenger may submit evidence that the claimed invention was in public use or on sale in the U.S. more than one year prior to the application. This is evidence that the examiner could have used to reject the patent application during prosecution, but which a third party currently can only use to challenge the validity of an issued patent by going to court.

Maintaining a meaningful ability to challenge low quality patents administratively is important to strengthening and preserving the integrity of the U.S. patent system. For the IT industry especially, being able to bring forward relevant evidence more than a year after issuance of the patent is necessary because it is difficult, if not impossible, to watch for all the potentially applicable patents that the USPTO issues. There can be many hundreds if not thousands of patents in an IT product. It is not uncommon to be unaware of a patent until a letter is received claiming that payment is due because the patent covers the IT product.

Both of these proposed reforms will help to minimize patents being granted on inventions that are not new or are obvious.

Reforming "reasonable royalty" damages: The reasonable royalty damages provision in S. 515 balances the varying needs of U.S. industries and businesses and IBM views this provision as a compromise. This provision allows the court to accommodate varying business models by deciding which of three listed methods should be used by the court and the jury to determine damages for patent infringement. We recognize that this provision has generated concern in the past. As a result, we discuss below an alternative which we believe will adequately address the full range of how inventions are used in products and services across industries and will maximize the chance that a "reasonable" royalty is granted in every case.

As discussed above, IBM believes that IP market efficiency can be ensured by focusing the damages calculation on the economic value of the essential features of the subject invention. In particular, IBM recommends to the Committee that the legislation ensure this focus by: (1) incorporating Quanta's "essential features" concept into the damages determination; (2) ensuring district courts increase precision in Entire Market Value Rule ("EMVR") and Convoyed Sales determinations; and (3) requiring district courts to better exercise their gatekeeper powers to cause rigorous expert analysis and review of damages evidence and reasonable royalty determinations. IBM believes these recommendations are representative of best practices that are supported by Supreme Court and Federal Circuit law.

Incorporate Quanta "Essential Features" Standard into Damages Determination

Application by analogy of the Supreme Court's formulation of the "essential features" of a patented invention in the Quanta case to damages determinations will focus the damages determination on the value of what the inventor actually invented. In the unanimous Quanta decision, the Supreme Court held that if a patentee sells (or licenses another to sell) a product that includes all the essential features of a patented invention, 16 then the patent rights are "exhausted," mean-

ing that the patent can no longer be asserted against downstream buyers of that product. The underlying theory behind the patent exhaustion rule is that "in such a transaction, the patentee has bargained for, and received, an amount equal to the full value of the goods."17 In other words, the patentee received full compensation when the product was sold, and is not entitled to collect an additional royalty.'$ The connection between Quanta and the law of exhaustion on the one hand, and the determination of patent damages on the other, is the Court's renewed focus on the substance of the invention in determining the proper scope of patent protection.

For complex products incorporating many inventions and unpatented elements, focus on the "essential features" results in fair compensation for the patentee. It does not overcompensate by including the value contributed by others, nor does it under- compensate by excluding the value provided by the patented invention. The standard is flexible and applies fairly to all inventions. Where, for example, the invention is in a combination of elements itself, the Court in Quanta recognized that the elements of the combination could not be evaluatcd separately or the invention's "essential features" would be lost. 19

Focusing on the invention's essential features also assists fact- finders in determining equitable compensation. Inventors receive the same value whether or not background or contextual elements are added to their claims. An invention of significant scope and value should be entitled to a large royalty regardless of whether it is claimed precisely or includes additional elements that are not essential to the invention. Likewise, a minor improvement should be entitled to a limited royalty regardless of whether the claim includes elements that are unrelated to patentability.20 Basing reasonable royalty damages on the economic value of the essential features of the invention should thus properly compensate the inventor by focusing the inquiry on the invention itself. Furthermore, as the essential features are determined objectively through examination of the public record of the patent file history, this approach will increase the predictability and certainty necessary for the functioning of an efficient IP market.21

There Must Be More Precision in EMVR Analysis and Convoyed Sales

Due to the increasing complexity of products, including systems incorporating many individual and grouped components, application of the EMVR and the related Convoyed Sales doctrine have become widespread. In these situations, for convenience and simplicity, damages analysis tends to emphasize the product environment in which a "component of a component" within a component 22 is placed, rather than the more precise and relevant issue of whether the infringing product corresponds closely to the invention. In a recent case covering a product of this type, Federal Circuit Judge Rader, sitting by designation in the District Court, recognized the significant burden of proof that application of the EMVR should require:

Moreover, neither Cornell nor Dr. Stewart has offered sufficient economic proof that the component of a component of a part of the server and workstation systems drove demand for the entire server and workstation products and entitles Cornell to damages on sales of Hewlett-Packard's entire servers and workstations.

It is important to encourage widespread and vigorous application of this evidentiary threshold so that the "reach" of patent protection afforded an invention does not extend beyond the actual invention and onto unrelated components or features of a product incorporating the invention, unless the invention is in fact "the basis for customer demand" for the entire product that nevertheless includes other functions or features.

Finally, as IBM understands application of the EMVR, it may be based on demand driven by the claimed invention as expressed by all of its respective limitations. IBM suggests that, in an environment characterized by the proliferation of complex products incorporating multiple inventions, the fairest application of the law would require evaluating whether the demand is driven by the invention itself - i.e., by the essential features of the patented invention. This avoids giving weight to claim elements that may be unrelated to the invention in applying the EMVR.

Judicial Gatekeeping Needs to Be Strengthened

In the Cornell case mentioned above, the Court also excluded the testimony by the damages expert because the purported expert failed to "show a sound economic connection" between the claimed invention and the proffered royalty base. IBM believes that such strong gatekeeping is highly supportive of an efficient market in IP, and should be required of the courts. District courts that provide clear articulation of the logic and factors relied upon in their damages decisions provide a better foundation for review. Such articulation also would provide the clear guidance for negotiators that is critical for commereial entities and the public. Rigorous requirements for damages experts, coupled with clear articulation of the bases for damages determinations, creates certainty for licensors and licensees alike, improving the efficiency of IP markets.

CONCLUSION

The nature of innovation has changed. The drivers of growth today are quite different from those in previous eras. America must rely more than ever before on the ability of its citizens to innovate to create economic growth and maintain competitive advantage.

The patent reform debate thus far unfortunately has been characterized as adversarial, pitting one set of industries against another set of industries. To be sure, industries use the patent system in different ways and these differences affect how they view some reform proposals. However, we believe any differences are not insurmountable.

The Framers of our Constitution wisely gave Congress the express power "[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". Our patent system is facing real problems and urgent Congressional action is needed to address them. IBM urges you to enact S. 515 and reform our patent laws to remove the roadblocks to development of new innovations and seize new opportunities to spur economic growth.

Thank you again for the opportunity to present IBM's views.

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BusinessWeek - Supreme Court to Review "Business Method" Patents, 6/1/09

Intellectual Property June 1, 2009, 4:23PM EST text size: TT

Supreme Court to Review 'Business Method' Patents

The high court will decide if such things as financial products and Internet commerce systems deserve intellectual-property protection

By Michael Orey

The U.S. Supreme Court announced on Monday, June 1, that it would take up a major issue in intellectual-property law: whether patents should be granted for what are known as business methods. Many financial, accounting, and e-commerce firms have rushed to obtain patent protection for such things as ways to structure financial products, manage organizations, or transact business on the Internet.

The court said it would consider a case involving a method for hedging risk in commodities trading. A claimed patent on this process, filed in 1997 by inventors Bernard Bilski and Rand Warsaw, was rejected by the U.S. Patent & Trademark Office on the basis that it simply involved a mental process and did not need any technology to implement. That rejection has been upheld though various appeals.

By agreeing to weigh in on the case, the high court is venturing into controversial terrain. Critics of business-method patents say it was never the intent of the law to protect such things, which in their view are often far closer to abstract concepts or mathematical algorithms rather than physical inventions. Proponents say they are key to promoting innovation in today's knowledge- and service-based economy.

In reversal, IBM opposes the patents

Whichever side the Supreme Court takes on the issue is likely to be of major significance. "This case will...impact American innovation for at least a decade or more because what we're talking about is the outer bound of what is patentable," says Robert Sachs, a patent attorney at Fenwick & West in San Francisco.

Businesses come down on both sides of the issue. IBM (IBM), which has obtained a slew of business-method patents, filed an amicus brief in what is known as the Bilski case, stating that the company is now opposed to them. IBM maintains that the patents are not needed to promote innovation; businesses would come up with the products even without patent protection. "You're creating a new 20-year monopoly for no good reason," IBM's top in-house patent attorney, David Kappos, told *BusinessWeek* last year.

Accenture (ACN), the big consulting and technology services firm, vigorously supports business-method patents. "Why shouldn't new techniques for managing organizations be entitled to patent protection?" asks Wayne Sobon, Accenture's

intellectual-property director, in an interview. "It's exactly like any other engineering field," he says. "Instead of applying science to control electrons, [consultants] apply science and engineering principles to improve how people work better together."

The court's decision to review the Bilski case caught many observers by surprise. The Bilski patent claims are widely viewed as vulnerable to challenge on a number of grounds, and the sense among some experts was it would make a poor test case.

Halt to a 10-year patent flood

"This patent is a hard patent to defend on its merits as being a valuable advance," notes John Duffy, a professor at George Washington University Law School who is nonetheless a leading proponent of business-method patents. But Randy Lipsitz, an intellectual-property attorney at Kramer Levin Naftalis & Frankel in New York, says the court couldn't ignore it. "It's too big of an issue. Too many dollars were on the table," he says.

The Federal Circuit Court of Appeals, which hears all patent appeals, gave the green light to business-method patents in a 1998 ruling involving a technique for tracking investments in a portfolio of mutual funds. The Patent Office has since issued a flood of patents in this area. But last October, in what has come to be known as the Bilski case, the Federal Circuit affirmed the rejection of the Bilski patent claims. It issued a ruling that dials back significantly on what business-method inventions will be patent-eligible.

In the wake of that ruling, lower courts and patent examiners have increasingly been rejecting business-method patent claims, says Lipsitz. On May 27, for example, Florida Federal District Judge Paul Magnuson ruled that Bank of America's (BAC) "Keep the Change" program—which rounds consumer credit-card purchases up to the nearest dollar and transfers the difference to a bank account—didn't infringe the so-called "rounder" patent held by Every Day Counts, a Cape Coral (Fla.) company, on a system for distributing excess funds from spending transactions. The recent Bilski ruling had rendered that patent invalid, Judge Magnuson ruled.

The Supreme Court won't hear arguments in Bilski until its next term, which begins in October. A ruling is likely during the first half of 2010.

Orey covers corporations for BusinessWeek.

The Wall Street Journal - Why Technologists Want Fewer Patents, 6/15/09
The Wall Street Journal - Why Technologists Want Fewer Patents, 6/15/09

JUNE 15, 2009

Why Technologists Want Fewer Patents

We shouldn't grant monopolies on concepts.

By L. GORDON CROVITZ

The last time the Supreme Court heard a case on what kinds of innovations deserved patents was in 1981 -- the year IBM launched the first personal computer using a disk operating system from a young Microsoft. The Internet as we know it was still years in the future.

This month, the Supreme Court agreed to reconsider what can be patented. At stake are tens of thousands of existing patents and a rethinking of why we have patent protections in the first place.

One measure of how badly the patent system needs reform: IBM, for years the company that's been assigned the greatest number of patents now says too many patents are being granted. IBM is also the leader in "business method" patents that the court could now invalidate. Several justices have doubted that software can be protected by patents. Industries from high-tech to biotech and financial services are watching the case of *Bilski v. Doll* with intense interest.

More broadly, patent law is at the shifting tectonic plate between the fading Industrial Age and today's Information Age. Like other areas of intellectual property, patents regulate information about how inventions work and how this information can be used and shared.

According to the Constitution, the goal of patent law is "to promote the progress of science and useful arts." Until the digital era, patents were typically for new machines or improvements to existing machines. In recent years, courts have also upheld patents for new ideas about how to do things, loosely linked to any physical machine, other perhaps than a computer. These include patents for techniques in finance, accounting and insurance. As one Silicon Valley lawyer says, "Unlike in the Industrial Revolution, many of today's inventions would not hurt if you dropped them on your foot."

This cuts both ways in the debate over patents in an era when the best way to boost innovation may be more sharing and less protecting of information. The greatest innovations today are better methods rather than new machines. The patent application in the *Bilski* case is typical: It was for a method for hedging risks in the sale of commodities. This created real value, but that shouldn't be enough to justify a patent limiting the spread of information. The U.S. Court of Appeals for the Federal Circuit, after approving many such business process patents, tried to limit them to methods that are tied to a particular machine or that transform something into a different state.

The Patent Office now gets some 500 million applications a year, leading to litigation costs of over $10 billion a year to define who has what rights. As Judge Richard Posner has written, patents for ideas create the risk of "enormous

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monopoly power (imagine if the first person to think up the auction had been able to patent it)." Studies indicate that aside from the chemical and pharmaceutical industries, the cost of litigation now exceeds the profits companies generate from licensing patents.

The makers of almost every new product have to jump through hoops to make sure they haven't violated a patent, which is one reason that patent king IBM is willing to toss in its crown. "In the Industrial Age, innovation primarily was the result of work by individuals or small groups within an enterprise," explains IBM lawyer David Kappos. "The nature of innovation has changed. Today, we benefit from inventions made possible through highly collaborative and interconnected technologies. Many of the products that consumers demand are complex and include contributions from multiple innovators that incorporate hundreds if not thousands of patented inventions."

Mr. Kappos notes that this "increases the need for predictability and clarity in determining the valid scope of patent rights." As things now stand, the vagueness of patent law means the "precious time of skilled scientists and engineers is too often spent defending against costly and time-consuming litigation, instead of creating innovations that drive economic growth." Incentives still need to be available for individual inventors and start-up companies, giving venture capital a key role in funding businesses based on new ideas.

The Supreme Court may decide that more progress would be made with narrower definitions of what is patentable. A book on the U.S. approach to patents, "Jefferson vs. the Patent Trolls" by Jeffrey Matsuura, makes the key point that "intellectual property rights were not goals in and of themselves, but were instead a mechanism through which society attempted to facilitate creative collaboration." Thomas Jefferson, the nation's inventor-president, would support patent reform in an era when new information technologies build on themselves. An idea, he observed, is a rare thing whose value increases as it's shared. "No one possesses the less because everyone possesses the whole of it," he wrote. "He who receives an idea from me receives it without lessening me, as he who lights his candle at mine receives light without darkening me."

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The New York Times (blog): Patent King I.B.M. Will Give Away More Ideas
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By Ashlee Vance

While celebrating its role as patent kingpin, I.B.M. has pledged to open up more of its inventions than ever before to the public.

Last year, I.B.M. hauled in 4,186 patents from the United States government, making it the top patent holder for the sixteenth straight year. I.B.M., in a statement, was quick to note that its patent total outstripped that of Hewlett-Packard, Microsoft, Oracle, EMC, Apple and Google combined.

In the years to come, I.B.M. expects to maintain a similar patent grant pace. That said, it also now plans to publish details on 50 percent more inventions that I.B.M. does not plan to patent — about 3,000 items a year — via technical papers and the Internet. By making such inventions public, a practice known as defensive publishing, I.B.M. will prevent other companies and individuals from gaining patents on the ideas.

"We concluded that it's time for us to do something new and different," said David Kappos, vice president and assistant general counsel for intellectual property law at I.B.M. "We think defensive publication represents a mechanism whose time has come."

Historically, I.B.M. has generated massive profits from proprietary businesses such as those tied to mainframes and business software. At the same time, I.B.M. has been a consistent supporter of many key standards related to technology infrastructure and has been a major backer of open source software, where the innards of applications are shared freely.

I.B.M. now wants to promote similar, open ideas across a broad set of industries and endeavors, including energy, the environment, health care and education.

"We're putting an emphasis on areas that we think will be most beneficial to developing the open standards that world needs to address the problems that we face," Mr. Kappos said.

Inventions around the transmission of energy or the distribution of health care information could bring new levels of efficiency to these industries, I.B.M. says.

Examples I.B.M. pointed to of publicly available inventions include giving a computer insight into a person's calendar and e-mail settings to know when to power down an unused machine, placing RFID tags in devices to alert people of a possible theft when the device is taken out of a certain area, and creating smarter storage systems that can power themselves down.

Over the years, I.B.M. has endured some measure of ridicule for requesting patents on inventions well outside of its usual sphere of business such as systems for deciding whose turn it is to use the bathroom on an airplane. Eighteen months ago, however, I.B.M. decided not to pursue such business method patents.

While I.B.M. will continue to protect ideas considered potential technology breakthroughs, it says that the inventions released to the public will still be important, innovative ideas.

The company hopes the government can use the public inventions as guides when it judges the merits of applications from other companies and individuals, improving the often criticized Untied States patent system.

"This is about getting high-quality patents," Mr. Kappos said

The Wall Street Journal: Two Patent Paths for Tech Giants
The Wall Street Journal: Two Patent Paths for Tech Giants

By JUSTIN SCHECK

A report being released Wednesday shows that when it comes to intellectual property, two of the world's largest technology companies are on diverging paths.

In 2008, International Business Machines Corp. generated more U.S. patents than any other company, according to data from the U.S. Patent and Trademark Office compiled by research firm IFI Patent Intelligence. IBM was granted 4,186 patents last year, IFI said, up from 3,125 in 2007. It was the 16th consecutive year that IBM led the patent pack.

Hewlett-Packard Co., in contrast, produced 1,424 patents last year, down from 1,466 in 2007. That put H-P, which continues a strategy of limiting its patent activity, tenth on the 2008 list after finishing ninth in 2007.

H-P was once trying to compete with IBM as the most prolific patent producer. In 2005, for instance, H-P was the third-biggest producer of patents behind IBM's number one spot. But after Chief Executive Mark Hurd arrived at H-P in 2005, the Palo Alto, Calif., company spent less time and money filing new patents as the CEO strove to make the H-P more efficient, said Kevin Light, a deputy general counsel and vice president for intellectual property at H-P.

H-P has been focusing on "the quality of the patents that we seek, as opposed to the quantity," Mr. Light said. As a result, he added, H-P is seeking broad patents that relate directly to its main businesses, avoiding the costs of filing patents that may relate to more specific processes.

H-P's current strategy is a departure from the approach under former CEO Carly Fiorina, who tried to boost the company's profile as an innovator, said Rich Doherty, an analyst the The Envisioneering Group who follows patent filings. Mr. Hurd, in contrast, seems more focused on shorter-term financial results, he said. He also said H-P seems to be keeping secret certain innovations, especially in its services division, rather than filing patents. "They've turned the ratio of public patents to private proprietary advantage," he said.

Dave Kappos, IBM's vice president of intellectual property, said 70% of IBM's patents this year were related to services and software. "The majority of the innovation that goes on in the services industry is really technology," he said.

Meanwhile, Samsung Electronics Co. received the second-largest number of patents last year, and Canon Inc. was third. Software giant Microsoft Corp. was fourth and chipmaker Intel Inc. fifth. Matsushita Electric Industrial Co., Toshiba Corp., Fujitsu Ltd. and Sony Corp. were sixth, seventh, eight and ninth respectively.

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eWEEK: Patent Reform Debate Opens in Congress
eWEEK: Patent Reform Debate Opens in Congress
By Roy Mark
2009-03-10
http://www.eweek.com/c/a/IT-Management/Patent-Reform-Debate-Opens-in-Congress/

To no one's great surprise, the patent reform debate comes down to one thing: damages. Tech companies claim excessive infringement damages are killing innovation while large manufacturers and pharmaceutical firms contend large damage awards barely even cover the litigation costs of multi-year infringement.

Congress resumed its long running patent reform debate March 10 with the usual intractable foes lining up for and against the primary sticking point in legislation introduced March 3: damages. High tech companies want the damages formula in patent infringement lawsuits gutted; traditional manufacturing and pharmaceutical firms like it just the way it is.

Bills introduced in both the House and Senate would more narrowly define willful infringement, determining infringement damages in relation to the economic value of the patent's contribution to an overall product. Currently infringement damages are based on the entire value of the product.

Reducing damages rank as a top priority for many of the country's tech firms. As David J. Kappos, IBM's vice president and assistant general counsel, explained to the Senate Judiciary Committee, "Innovation today is characterized by diverse forms of collaboration, multi-disciplinary problem solving, interconnected technologies and complex products involving multiple inventions. The patent system must adapt to these changes."
Kappos told lawmakers patent litigation has significantly increased over the last decade and that it continues, "This excessive litigation threatens to sap America's innovative capacity and its ability to compete in the world if left unaddressed."

Kappos' claim of increasing litigation was challenged by Philip S. Johnson, chief intellectual property counsel at Johnson & Johnson. According to Johnson, of the approximately 2,700 patent lawsuits filed annually in the U.S., fewer than five result in verdicts of more than $100 million and most of those do not survive post-judgment review and appeal.

"A prime example is the Alcatel-Lucent v Microsoft verdict of $1.5 billion that was touted in the last Congress as the reason for patent damages reform, even though it was later promptly and finally vacated," Johnson said. "Critics from some large technology companies nonetheless contend that damages reform is needed because their fears that erratic or spurious awards will be granted cause them to settle their cases at higher amounts than are fair."

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Johnson added that tech's excessive damages claims are "hard to vet, as settlement terms are normally private, and entered at a fraction of the damages that would be assessed were the case to proceed to judgment."

Congress has heard all of this before. In the 110th Congress, the House approved patent reform but the legislation never gained traction in the Senate. The House vote came after six years of debate and more than 20 hearings, most of them covering the same material as the March 10 testimony before the Senate Judiciary Committee.

"Our bill is intended to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs, while making sure no party's access to court is denied," bill sponsor Sen. Patrick Leahy, the Vermont Democrat whjo heads the Judiciary panel, said in his opening remarks. "There is much work to do, but I am optimistic that by continuing to work together, we will find the right language. We may be closer to reaching consensus on language regarding damages and venue than ever before."

In addition to limiting damages, the bill would also create a post-grant review to challenge issued patents, calls for a first-to-file system and grants broader rulemaking authority to the USPTO (U.S. Patent and Trademark Office).

Sen. Orrin Hatch, R-Utah, co-sponsored the bill with Leahy. Hatch said he hoped the third time would be the charm for patent reform.

"Today's introduction signals the third and what I hope will be the final round. If we are to continue to lead the globe in innovation and production, we must have an efficient and streamlined patent system," Hatch said. "For those who might say nothing has changed, I can attest that it has. Just look at the bill. We have listened to many of the concerns raised by stakeholders and have changed the legislative text accordingly."

EE Times: Senate seeks compromise on patent reform
EE Times: Senate seeks compromise on patent reform

Rick Merritt
(03/10/2009 3:46 PM EDT)
URL: http://www.eetimes.com/showArticle.jhtml?articleID=215801625

SAN JOSE, Calif. — Opponents in the ongoing patent reform debate squared off in the U.S. Senate Tuesday (March 10) in a hearing that put a spotlight on their chief bone of contention—how to calculate damages in patent infringement cases. Senators pressed six witnesses--including representatives from IBM, Micron and Tessera--to come up with a compromise.

"I won't vote for a bill unless there can be reconciliation between the parties," said Sen. Dianne Feinstein (D-Calif.), recalling a contentious meeting on the issue in her office in April 2006.

"Everybody is so genteel here today, but they were like tigers coming out of a cage at that meeting," she said.

Sen. Arlen Specter (R-Penns.) pressed each witness to suggest compromise language about damages. "I think we can work out the other issues if we come to a correct formulation on damages," he said.

Witnesses suggested some alternatives, but they could not come to a consensus on the complex and controversial issue.

Big computer and communications companies want to limit the number of patent infringement cases and damages they face. They back the bill (S.515) introduced last week that calls for apportionment, a means of limiting damages to the proportion of an end product's value represented by an infringed patent.

Opponents say the bill would diminish the value of patents and invite more infringement. Both sides referenced competing studies showing their approaches would save jobs and bolster innovation in technology.

Without apportionment, companies could be forced to pay damages that "exceed the total amount of revenue on a product," said Steve Appleton, chief executive of Micron Technology and a member of the Coalition on Patent Fairness that backs the bill.

Micron spent $30 million defending against patent infringement suits last year, money that could have created 450 jobs at the company, Appleton said. He referenced a new study from the coalition that concludes the current bill could help create 100,000 jobs over five years.

Opponents noted that the U.S. has a leading position as an exporter of intellectual property rights, earning some $62 billion in licensing and royalties in 2008. The revenue, and the jobs behind it, would come under threat if Congress adopts apportionment, they said.

Instead of apportionment, representatives from Tessera and Johnson & Johnson called for letting a judge act as a gatekeeper, advising juries how to assess damages for a particular case. The judges could select from a set of so-called Georgia-Pacific factors determined in an earlier court case to guide juries on how

to make their decisions.

"Depending on the competitive situation, one or more of the Georgia-Pacific factors need to be considered and it's usually more than one," said Philip Johnson, chief intellectual property counsel at Johnson & Johnson, a member of the 21st Century Coalition on patent reform.

Patent law needs to do a better job of addressing damages, but the Georgia-Pacific guidelines are open to manipulation, said Mark Lemley, a professor at Stanford Law School and another witness at the hearing.

The gatekeeper concept "is a good one" but it doesn't go far enough, said David J. Kappos, assistant general counsel for intellectual property at IBM. "This is a multi-part problem and it needs a multi-part solution," said Kappos.

He recommended legislators borrow language about the "essential features" of a patent from the recent decision in the Quanta case on patent exhaustion handed down by the Supreme Court. The language could be used to help determine the value a patent contributes to an end product that infringes it.

Representatives from Tessera and Johnson & Johnson were quick to reject the IBM suggestion.

"I don't see the essential features language to be any different than past language--it causes all same problems," said Taraneh Maghame, head of government affairs at Tessera, a member of the Innovation Alliance that opposes the bill.

"I don't think [the] essential features [language] does violence to Georgia-Pacific factors," responded Kappos.

Senators turned to Herbert Wamsley, executive director of the Intellectual Property Owners Association for a compromise. The group includes a wide array of members including all four companies that testified.

"My members don't agree so I'm in kind of a bad place here," Wamsley said. "There is support from a lot of the industries on the gatekeeper concept, but when you get to [adding in the] essential factors [language], it's not clear

Senators left the door open for further negotiations. Feinstein asked industry participants to review and give feedback on patent reform language she drafted after her April 2006 meeting. Specter put out an even broader call.

"There are a lot of high-priced lawyers and specialists in this room, and if you have any suggestions on the right language this committee would be very appreciative," he said.

Sen. Patrick Leahy (D-Vt.) a co-sponsor of the bill expressed optimism industry participants will find a consensus and that President Barack Obama will sign a final bill. "There's much work to be done, but we may be closer to reaching consensus on language than ever before," he said in his opening remarks.

The hearing was the eight on patent reform since the Congress took up the issue about five years ago.

REUTERS ANALYSIS-Courts faster than Congress in patent law reform
REUTERS ANALYSIS-Courts faster than Congress in patent law reform

* Major elements of patent bill already in court rulings
* Reform supporters say bill still needed
* Damages could be addressed in coming appeals court case

By Diane Bartz

WASHINGTON, March 23 (Reuters) - High-tech companies facing pricey litigation to defend their patents are pressing Congress for patent reform, even though they have already won some important elements of that reform in court.

These rulings, little noticed outside the patent world, have made it less likely that the U.S. Patent and Trademark Office would issue a bad patent, or one that was nothing more than an obvious improvement on existing technology.

The court rulings also make it harder to take a bad patent to a friendly court and use it to shut down an entire company, or to use that bad patent to win a huge settlement.

"Has there been significant patent reform in the past five years? Yes. Are there still areas that need reform? Yes," said John Whealan, who teaches at George Washington University Law School and who worked on patent reform as a former Capitol Hill staffer.

Proposed patent reform bills are opposed by big pharmaceutical companies and some smaller tech companies, among others.

A 2007 Supreme Court ruling, KSR International v. Teleflex, reduced the likelihood that a bad patent would get granted by raising the bar on "obviousness." Patents are not supposed to be granted for small improvements on existing technology.

"Obviousness isn't in patent reform bills, but some of the driver is that there are too many bad patents out there," said Mark Lemley, who teaches at Stanford Law School.

By improving patent quality, the KSR ruling may have made moot a call for patents to be subject to outside review -- one of the elements of the proposed bills. "This takes a little pressure off the need for post-grant review," said Chad Landmon, with law firm Axinn, Veltrop and Harkrider LLP.

Major tech companies, which have seen their litigation costs soar because of patent lawsuits, have also pushed for a bill that would cut damages from

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potentially a product's entire market value to "a reasonable royalty," according to bills pending in the U.S. Senate and House of Representatives.

In a nod to the bills' critics, especially pharmaceuticals companies, the measures would allow damages to be based on the "entire market value" if the invention were "the predominant basis for market demand for an infringing product."

Some patent experts point to a pending appeal of a case involving Alcatel-Lucent <ALUA.PA> and Microsoft Corp <MSFT.O> that could address the damages issue. A lower court ordered Microsoft to pay $367 million for infringing technology in its Outlook software that consumers use to find a particular date.

Currently, damages could be tripled if the infringement were found to be willful. But the U.S. Court of Appeals for the Federal Circuit's 2007 Seagate decision changed the burden of proof from the accused company to the patent holder -- as would the patent legislation.

The price of infringing used to be even more devastating.

Courts had been allowed to order infringing technology stopped, bringing entire industries to a halt. This nearly ended in 2006 with the U.S. Supreme Court ruling in eBay v. MercExchange, which made it harder to get an injunction. It added tests, one of which was whether public interest would be harmed by a permanent injunction.

Copyright protections, in contrast, still include injunctions. Late last year, all Bratz dolls were ordered recalled because Mattel Inc <MAT.N> owned the copyright to them and because the creator was working for Mattel when he designed them. That injunction, however, has been stayed pending appeals.

YOU GOTTA SHOP AROUND!

Patent reform legislation also attacks "forum shopping," where plaintiffs file suit in courts likely to favor them.

But in Medimmune v. Genentech in 2007, the U.S. Supreme Court made it harder for companies to pick a friendly forum.

The Federal Circuit made it even tougher with a 2008 ruling. It ordered a case involving headrest assemblies in Honda Motor Co Ltd <7267.T> vehicles transferred from a plaintiff-friendly Texas court to an Ohio court.

In patent fights, defendants often accuse a patent holder of making errors or worse in the patent application, a practice known as "inequitable conduct." The price of inequitable conduct is loss of the patent. It has not been addressed in this year's patent legislation, although Republican Sen. Orrin Hatch, a co-sponsor, says it will be added.

International Business Machines Corp's <IBM.N> intellectual property chief, David Kappos, said reformers want to ensure that there are "strong consequences to behave with a high level of candor."

But a decision by the Federal Circuit in Star Scientific v. R.J. Reynolds has already made inequitable conduct harder to prove by requiring evidence that a patent holder intended to deceive the patent office. A simple error is no longer enough.

Despite these court rulings, patent experts say reform in Congress is still needed. "The patent reform goes further," said Axinn, Veltrop's Landmon. "And maybe more importantly, it's done by statute so the courts can't undo it later."

US Supreme Court hears LG-Quanta patent case

By Diane Bartz
584 words
16 January 2008
02:32 PM
Reuters News
English
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WASHINGTON, Jan 16 (Reuters) - The U.S. Supreme Court heard arguments in a dispute between LG Electronics Inc and Quanta on Wednesday that will either expand or contract the rights of a patent holder.

LG Electronics, which holds patents on microprocessor chips and chip sets, had an agreement with Intel Corp that allowed Intel to make the chips and chip sets but explicitly barred it from mixing the components with non- Intel parts.

Quanta Computer Inc , among others, bought the components from Intel and used them to make notebook computers. South Korea's LG Electronics sued, accusing Quanta of infringing the patents not of the components themselves but "systems and methods" of using them to make a functioning computer.

LG Electronics' attorney Carter Phillips told the high court that LG had allowed Intel to make the chips, but had placed restrictions on the companies that bought them to prevent them from infringing LG separate patents on how they were to be used.

"If the question is did Intel have the right to sell the system as a system, the answer is yes," Phillips said. "But it didn't sell the system as a system. It sold the components."

Quanta's attorney Maureen Mahoney argued that because LG Electronics collected its royalties from Intel, that Quanta owed it no further money.

"LGE did get its royalty from Intel, did give them authority to sell products which would otherwise contributorily infringe and now what it's seeking to do is to say ... we want to collect another royalty from the buyer of the product," she said.

Justices Stephen Breyer and David Souter both expressed concern that the fact that a computer chip has only one real use -- in a computer -- meant that it fell into a category of goods whose patents are exhausted. Chief Justice John Roberts seemed to agree. "You don't put them on your shelf," he said.

Roberts also seemed irritated with the parties' failure to create a solid license that would have prevented the court challenges.

"So the parties are unwilling to spell out exactly how this is going to work out in their contract," he said. "There's a lot of uncertainty that could be resolved.., rather than take their chances in the Supreme Court."

In a last hint of how the justices might rule, Justice John Paul Stevens said he was "puzzled" by the U.S. Court of Appeals for the Federal Circuit, which ruled in favor of LG.

Intel has not commented on the case publicly.

Both parties found support in the tech community.

"Some of the big computer makers, they like the idea of exhaustion. Where there are some other companies out there, that rely on patent licenses more, they tend to support LG," said Pavan Agarwal, a patent attorney with Foley and Lardner.

Robert Kovelman, a patent attorney with Steptoe and Johnson LLP, said a Supreme Court ruling in favor of LG would upend current understanding of how licenses should be written.

David Kappos, **International Business Machines** Corp's vice president for intellectual property, said: "This is really an important case. It's kind of a sleeper in a way... I say it's a sleeper because it can have a pretty substantial impact on commerce."

A Supreme Court ruling is expected by the end of June. (Editing by Dave Zimmerman)

Document LBA0000020080116e41g001tt

Les Echos: IBM's formula for making R&D profitable (translation)
Les Echos: IBM's formula for making R&D profitable (translation)

The US giant is investing almost USD 6 billion a year in R&D and wants closer collaboration between research and innovation

from our California correspondent

Are we talking about Big Blue, the unchallenged hub of world computer technology? It's not quite so simple. Last year, the giant New York corporation appointed John E. Kelly III, a veteran of twenty-eight years with the company, most of them in scientific research, as its new director of R&D. His task was simple - and not very different from the one facing his principal direct competitors Hewlett-Packard, Cisco and Microsoft: to make R&D more efficient. From the corporate point of view, the success of this assignment is measured in very concrete terms: the work of the laboratories must contribute directly to increasing the company's revenue. This approach is being applied on a scale commensurate with IBM's resources, which are considerable. John Kelley plans to reduce the number of projects the company finances and in exchange to invest more than 100 million dollars a year in the most important projects, each of which is expected - in the long run - to generate more than 1 billion dollars in new revenue.

That means taking risks. "If we don't fail a third of the time, we're not stretching enough," he explained. This culture of risk reflects an expanded vision of the range of possibilities open to IBM. Among the new areas selected, the US company has decided to launch a vast program of scientific cooperation with ... Saudi Arabia. Step one: assigning a team of scientists to a brand-new, ultramodern R&D center, the Nanotechnology Centre of Excellence in King Abdulaziz City for Science and Technology.

These researchers are working with their local counterparts in three principal areas: solar energy, petrochemical applications and the desalination of seawater. "This country has no shortage of sunlight, oil or seawater," Ari Fishkind explains. IBM has therefore decided to enter the renewable energy field and will work on improving the technology of the photovoltaic cells that are used in solar panels.

Nanotechnology as the common feature

The feature common to all these directions of scientific research is nanotechnology because, in the field of seawater desalination, the IBM scientists are continuing to develop nano-membranes that can be used for filtration. IBM has been working on these technologies for twenty years and recently demonstrated its ability to measure the force required to move atoms individually over a given surface. A decisive step in the design of the nano-devices of the future which will make possible the design and construction of storage components and equipment on the atomic scale. "We are using the know-how we have previously acquired in the field of nanotechnologies and applying it to sectors that are very different from those originally imagined in the laboratories," Fishkind also

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explained. For example, the nano-materials developed in IBM laboratories, which are to be the subject of advanced development in the new Saudi Arabian research center, come from the same technologies, both for the photovoltaic cells and for the nano-membranes used in the process of reverse osmosis for the desalination of seawater, as well as new technologies for recycling plastic materials.

This nano-technology research doesn't even take IBM too far from its home IT sector. In one of the group's New York laboratories, John Kelly recently described the early phases of a "self-assembly" process of nano-particles, which he predicts will be operational by 2009. "There is no doubt in our mind that it's going to work," he promised. This process, which is also being pursued by several generously financed Silicon Valley startups such as Zettacore, will open the path to the design of electronic components that are infinitely smaller than today's. Such developments could far outpace the famous Moore's Law (a doubling of the number of transistors on an integrated circuit of equal size and equal price every twelve months). Using this technology, scientists hope to develop nano-robots which can be integrated into everyday objects, or even into the human body. For example, they could permanently explore the organism to detect micro blood-clots, following which it would be a simple matter to stabilize and allow the body to break up the clot by administering minuscule doses of medicine locally.

Picking up the pace

Beyond its scientific research strictly speaking, IBM also wants to innovate in the promotion of scientific research and to equip itself with the tools necessary to come up with new technologies and commercial products more quickly. For example, Big Blue launched the Eco-Patent Commons Program, which consists of pooling patents linked to sustainable development and allowing the other participants in the program to use them freely without having to pay royalties. The organization of this free access to patents is managed by the World Business Council for Sustainable Development, based in Geneva. Sony and Nokia have already signed on to the initiative.

Although the sharing of intellectual property is a frequent occurrence in the field of IT, it is less common in other sectors such as energy or chemistry, for example, that are crucial for sustainable development. IBM, which has already launched an ambitious scientific program called Big Green Innovations, thereby hopes to make long-term profits in multiple industries which are committing to "clean tech" and could therefore have recourse to its technologies. "There is no reason why activities related to sustainable development shouldn't be profitable," thinks Dave Kappos, who directs IBM's Intellectual Property Law function and manages this program. If this project is a success, it offers a major opportunity to alter the approach to R&D in large companies. For example, it could also lead to the creation of multiple non-profit organizations that would be responsible for managing the use of patents from a wide range of sources.

The ultimate aim is to further accelerate the pace of innovation and thus to promote the even more rapid development of marketable products. For the analysts, this new approach will have a further advantage. It should make possible a rapprochement - or at least improved collaboration - between large companies and small ones. Large companies frequently need backup from smaller companies because they can react more quickly, but they hesitate to collaborate out of fear of legal complications linked to intellectual property rights. The concept of pooling patents could bring down some of these barriers.

by Michel Kittareff

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Reuters - US Supreme Court hears LG-Quanta patent case

16 January 2008 - 02:32 PM

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By Diane Bartz

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Reuters: INTERVIEW-IBM sees strong Africa growth despite downturn
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By Nick Tattersall
11 February 2009 -12:02 PM
LAGOS, Feb 11 (Reuters) - IBM, the world's top technology services firm, is expanding operations in West Africa and sees strong long-term opportunities on the continent despite the global economic downturn, a top executive said on Wednesday.
The global credit crisis has dampened appetite for risk, leading some foreign firms to scale back expansion plans in African frontier markets, but International Business Machines Corp said demand for new technology was growing.
"We are taking a very different approach," Dave Kappos, one of IBM's vice presidents, told Reuters in an interview in Nigeria's financial capital Lagos.
"Our customers are asking us to come in and increase our presence here in order to help them, in the financial services industry, banking, in the telecommunications industry," he said.
IBM, which launched operations in South Africa more than five decades ago, said it was setting up a fully-fledged subsidiary office in Lagos to serve the West African region.
But Kappos gave no details of the planned level of IBM's investment in the continent or specifics of where it would go.
Nigeria, Africa's most populous nation of more than 140 million people, is seen as one of the biggest frontier markets in the world for sectors including telecoms, financial services and retail.
Kappos said demand for IT services was coming both from Nigerian companies -- particularly banks -- seeking to expand across the region as well as from firms moving into Nigeria.
"As these businesses expand they need more robust infrastructure, they need things like back-up and disaster recovery and the things that mature businesses have in the banking and finance sector," he said.
Just as mobile phones reached many rural communities in Africa before they were connected to landline networks, Kappos said there was similar potential for a technology "leapfrog" in bringing cheap internet access to millions via mobile devices.
Nigeria's mobile phone market has grown from scratch to over 45 million subscribers in seven years, making it one of the fastest growing in the world. But its penetration rate is just 30 percent, compared with 76 percent in South Africa.
Kappos said IBM, which has invested some $120 million in sub-Saharan Africa over the past two years, was keen to help reverse the brain drain that has seen many highly-skilled Nigerians move abroad by developing a local IT industry.
(For full Reuters Africa coverage and to have your say on the top issues, visit: http://af.reuters.com/ [http://af.reuters.com/]) (Editing by Randy Fabi)

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Africa News

February 16, 2009 Monday

LENGTH: 310 words

HEADLINE: Nigeria;
IBM to Set Up Computer Plant in Country

BYLINE: Daily Trust

BODY:

A US-based International Business Machines (IBM), has concluded plans to build a production plant for software and hardware computers in Nigeria.

The company revealed last Thursday during a visit toNigeria's Minister of Science and Technology, Dr Alhassan Bako Zaku in Abuja that the plant will attract more Nigerians both at home and abroad to work.

The leader of IBM team, Vice President David J. Kappos said his company is prepared to invest in the sector to further help Nigeria to develop and produce software and hardware.

He sought Government's assistance to actualise the target.

Daily Trust recalled that IBM relocated from Nigeria to Ghana some three decades back as a result an Indigenisation policy by the then military administration.

The Minister commended the efforts of IBM in proposing a business plant in Nigeria saying that the plant would create job opportunities for Nigerians and enhance the wealth creation moves of the present administration.

"Those who are coming to work in the company are Nigerians and in the process you are going to create jobs" he said.

Dr. Zaku while assuring the visiting team of Federal Government's support in achieving their dream directed one of the parastatals under the Ministry - Sheda Science and Technology Complex (SHESTCO) to provide necessary facilities that would enhance the take off the plant.

He told the delogation that the proposed multi-million naira Science Parks to be built in the six geo-political zones by the Federal Ministry of Science and Technology will boost Information Communication Technology (ICT) infrastructure for increased knowledge-based economy.

Zaku said that the decision by Nigeria to enter into ICT was to join the rest of world in the revolution, maintaining that ICT has become part of nation's infrastructure that fast tracks developmental projects and knowledge based economy.

LOAD-DATE: February 16, 2009

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The Daily Trust (Nigeria) - AAGM

February 16, 2009 Monday

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LENGTH: 319 words

HEADLINE: IBM TO SET UP COMPUTER PLANT IN COUNTRY

BYLINE: Hamisu Muhammad

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The company revealed last Thursday during a visit toNigeria's Minister of Science and Technology, Dr Alhassan Bako Zaku in Abuja that the plant will attract more Nigerians both at home and abroad to work.

The leader of IBM team, Vice President **David J. Kappos** said his company is prepared to invest in the sector to further help Nigeria to develop and produce software and hardware.

He sought Government's assistance to actualise the target.

Daily Trust recalled that IBM relocated from Nigeria to Ghana some three decades back as a result an Indigenisation policy by the then military administration.

The Minister commended the efforts of IBM in proposing a business plant in Nigeria saying that the plant would create job opportunities for Nigerians and enhance the wealth creation moves of the present administration.

"Those who are coming to work in the company are Nigerians and in the process you are going to create jobs" he said.

Dr. Zaku while assuring the visiting team of Federal Government's support in achieving their dream directed one of the parastatals under the Ministry - Sheda Science and Technology Complex (SHESTCO) to provide necessary facilities that would enhance the take off the plant.

He told the delogation that the proposed multi-million naira Science Parks to be built in the six geo-political zones by the Federal Ministry of Science and Technology will boost Information Communication Technology (ICT) infrastructure for increased knowledge-based economy.

Zaku said that the decision by Nigeria to enter into ICT was to join the rest of world in the revolution, maintaining that ICT has become part of nation's infrastructure that fast tracks developmental projects and knowledge based economy.

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BYLINE: Dennis Crouch

BODY:

Jun. 21, 2009 (Patently-O: Patent Law Blog delivered by Newstex) --
From Hal Wegner:

A few weeks ago **Dave Kappos** was involved in a webinar with Jon Dudas which provides some perspectives on the new Directors views. It is available at http://www.foley.com/news/event_detail.aspx?eventid=2779. The webinar itself is available at http://www.foley.com/multimedia/multimedia_detail.aspx?multimediaid=58221724.

The May 8, 2009 webinar focuses on patent reform; technology issues; and reexamination.

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Associated Press: Program turns to online masses to improve patents
Associated Press: Program turns to online masses to improve patents

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WASHINGTON -- Some of the biggest players in the technology industry complain that the U.S. patent system is broken -- putting too many patents of dubious merit in the hands of people who can use them to drag companies and other inventors to court.

And Blaise Mouttet, a small inventor in Alexandria, Va., thinks he knows why. The problem, he said, is that "there are too many lawyers and not enough inventors involved with the patent system."

So Mouttet is taking part in an experimental program launched in June 2007 with the U.S. Patent and Trademark Office and backed by the technology industry that is intended to give the public -- including inventors -- more of a voice in the system.

The concept behind the program, called Peer-to-Patent, is straightforward: Publish patent applications on the Web for all to see and let anyone with relevant expertise -- academics, colleagues, even potential rivals -- offer input to be passed along to the Patent Office.

By using the power of the Internet to tap the wisdom of the masses, Peer-to-Patent aims to dig up hard-to-find "prior art" -- evidence that an invention already exists or is obvious and therefore doesn't deserve a patent.

The goal is to locate prior art that Patent Office examiners might not find on their own -- and to produce better patents by reducing ones granted on applications that aren't novel. The hope is that this will drive innovation by improving the patent process and reducing the patent infringement lawsuits clogging the courts.

"The Patent and Trademark Office is the agency of citizen creativity, and it needs more and better information to do its job of awarding patents to those citizens who are truly the most creative," said New York Law School professor Beth Noveck, who came up with the idea for Peer-to-Patent while teaching a patent law class. "A patent is a pretty significant monopoly, so we want to make sure we are giving it to the right people."

Peer-to-Patent has attracted financial support from a cross-section of the technology sector and foundations and is in its second pilot year. In the first year, the voluntary program focused on software, computer and information security patents -- drawing applications from industry heavyweights such as International Business Machines Corp., Hewlett-Packard Co., Microsoft Corp., General Electric Co. and open source software pioneer Red Hat Inc., as well as small inventors like Mouttet.

Mouttet, a former Patent Office examiner and now a graduate student in electrical engineering, submitted an application on electronic uses of nanomaterials. Although the Patent Office has rejected his claim -- in part because of prior art unearthed through Peer-

to-Patent -- he is appealing the decision and optimistic he will eventually get his patent. And he is confident it will be stronger for having gone through the process.

But it is the big technology companies that have the highest hopes for Peer-to-Patent since they are some of the most vocal critics of the existing system.

They warn that the Patent Office has been overwhelmed by a sharp increase in patent applications in recent years, particularly in computing. The agency has more than 5,800 examiners with specialized expertise in a range of areas, but they are sifting through a mountain of applications: 467,243 were submitted in fiscal 2007, up from 237,045 in fiscal 1997 and 137,173 in fiscal 1987.

As a result, said Dave Kappos, vice president of intellectual property law for IBM, it is taking big technology companies with huge patent portfolios longer and longer to get applications through the system. The Patent Office had a backlog of nearly 761,000 applications at the end of fiscal 2007, with applicants waiting an average of two years and eight months for a final decision.

That is tough for an industry built on rapid innovation, short product life cycles and technology that can become quickly outdated, Noveck said. Indeed, a key benefit of participating in the Peer-to-Patent program is the promise of an expedited review, with a preliminary Patent Office decision in as few as seven months.

Backlog is only part of the problem, however. Poor patent quality is just as big a concern.

There are plenty of examples of controversial patents in different industries, such as the one awarded to Amazon.com Inc. for its "1-click" online shopping feature or the one granted to J.M. Smucker Co. for a crustless peanut-butter-and-jelly sandwich.

But some of the most contentious patents have come out of the tech sector since software and other-cutting edge technologies are relatively new to the Patent Office and evolving quickly, explained Mark Webbink, director of New York Law School's Center for Patent Innovations, home to Peer-to-Patent, and former general counsel for Red Hat. That means that patent examiners don't have long-established databases of existing inventions to consult in reviewing these applications.

"With technology, the prior art often can't be found in existing patents or academic journal articles," Noveck said. "It could exist in a string of computer code posted online somewhere that isn't indexed."

The result of substandard patents, tech companies say, has been a sharp inerease in costly infringement lawsuits that eat up valuable resources and threaten to keep innovative products off the market. According to James Bessen and Michael J. Meurer of Boston University School of Law, 2,830 patent lawsuits were filed in U.S. district courts in 2006, up from 1,840 in 1996 and 1,129 in 1986.

Technology companies are particularly vulnerable to infringement litigation since their products can contain hundreds if not thousands of linked patented components critical to their basic operation. In one closely watched case, a protracted legal battle nearly forced the shutdown of the popular BlackBerry wireless e-mail service.

The BlackBerry has in fact become a rallying cry for technology lobbyists pressing Congress to overhaul the patent system. Among other things, the industry wants to streamline the patent approval process and limit damages and injunctions awarded to patent holders who win infringement cases. But with those proposals stalled in the Senate, Peer-to-Patent offers another way to improve the system, said Curtis Rose, director of patents for Hewlett-Packard.

Not everyone is sold on the concept of Peer-to-Patent. Stephen Key, an inventor in California who has patented everything from toys to container labels, worries that the program requires applicants to put their ideas out there on the Web for anyone to see -- and potentially steal.

Boston University's Meurer also questions how effective Peer-to-Patent will be since he believes the real factor driving the increase in patent litigation is not a lack of prior art, but rather the vague, overly broad scope of too many patent claims today.

"Applicants come in and ask for the sun, moon and stars and they say: 'Let the Patent Office tell me what is and isn't patentable,'" said John Doll, U.S. Commissioner for Patents. "It's a burden on the system."

Indeed, said Stanford Law School professor Mark Lemley, the challenge facing the Patent Office is to find a balance between awarding patents in order to encourage innovation without making it too easy to obtain a patent that can be used to abuse the system.

Noveck believes Peer-to-Patent will help strike that balance. The Patent Office reports that it has issued preliminary decisions on 40 of the 74 applications that have come through the program so far. Of those, six cited prior art submitted only through Peer-to-Patent, while another eight cited art found by both the examiner and peer reviewers.

The question now is whether the program can be scaled to review hundreds or even thousands of applications that extend far beyond the technology arena. So in its second year, Peer-to-Patent is being expanded to include claims covering electronic commerce and so-called "business methods," a controversial category of patents vital to the financial services sector.

Goldman Sachs Group Inc., for one, is submitting a number of applications, including one for an equities trading platform used to raise capital without a public offering. John Squires, Goldman's chief intellectual property counsel, has high hopes for the program.

"This is a way to harness the wisdom of the crowds," Squires said. "Why should the Patent Office have to operate without the benefit of all the information on the horizon?"

Intellectual Property Watch: Trilateral IP Offices Under New Pressure To Harmonise Patent Processing

Intellectual Property Watch: Trilateral IP Offices Under New Pressure To Harmonise Patent Processing

By Dugie Standeford for Intellectual Property Watch

THE HAGUE, NETHERLANDS - Patent offices are facing heat from industry to make good on promises to coordinate global processing of patent applications. Despite years of talk of streamlining the handling of applications, reducing duplication and creating more reliable international patents, agencies have failed to move ahead, Air Liquide Vice-President Thierry Sueur told top IP officials Thursday. He spoke at the 13 November Trilateral User Day in The Hague, Netherlands.

Trilateral Co-operation members are the European Patent Office (EPO), Japan Patent Office (JPO) and United States Patent and Trademark Office (USPTO). The trilateral group holds its annual conference here on Friday.

The existing patent system is not sustainable in its current form because it fails to process applications in a timely manner, produces work of uneven quality and is expensive, industry representatives said. They agreed with agency officials, however, that users share responsibility for making the regime work.

Patent office chiefs said they are working on the problems but acknowledged they must try harder. One unresolved issue is whether to work through the World Intellectual Property Organization Patent Cooperation Treaty (PCT), the Patent Prosecution Highway (PPH), a combination of the two, or some other route. Both provide a way to apply patent processes internationally.

The "IP5," which includes the EPO, USPTO, JPO, Korea Intellectual Property Office and the State IP Office of the People's Republic of China, recently agreed to cooperate on a sustainable global patent system, said EPO President Alison Brimelow. The trilateral group has tried for some time to make its work-sharing more cooperative, but has not "quite managed to hack it," she said. Nevertheless, she said, the "PCT remains the best game in town."

Trilateral agreements cannot replace the PCT, said Merck, Sharpe & Dohme Managing Counsel, European patents Tony Rollins. The patent system must operate globally and cooperatively, and bilateral treaties such as the PPH are inherently "subglobal and suboptimal," said David Kappos, vice-president of the Intellectual Property Owners Association and IBM vice-president and assistant general counsel for IP law and strategy.

Kappos urged patent offices to "embrace the PCT as the framework of choice," set patent quality standards, and encourage trust and confidence in the PCT. Agencies should use 21st century tools such as Wikis and blogs to examine applications in real time, he said.

The Japan Intellectual Property Association wants the "four sames," said President

Hirohiko Usui: Application formats, searches, examinations, and global patent grants. The PPH is an accelerated examination process. Japan, which has put the PPH fully in place, wants authorities to use it as a complementary means to enhance the PCT system, Usui said. He acknowledged, however, that it suffers "teething problems" that discourage other agencies from making active use of it.

The USPTO had only 810 PPH requests as of 1 October, said Director Jon Dudas, under secretary of commerce for IP. He stressed the need for patent offices to trust one another's work, saying the PPH is one of several ways to do that.

But former American Intellectual Property Law Association Executive Director Michael Kirk said that over 200,000 PCT applications were filed between Japan and the US in the last two years compared to around 1,000 PPH requests. Building trust is fine, he said, but the focus on PPH, which essentially just allows inventors to obtain a patent quickly in another country, is diverting attention from the PCT, he said. "Rome is burning" and it is unclear whether there is a way to bridge the PCT and the PPH to make the latter an effective work-sharing vehicle, he said.

Political Will Needed

Everyone agrees that the system is dysfunctional and that the cure calls for some form of transnational cooperation, said WIPO Director General Francis Gurry. The two main candidates are the PCT and PPH, he said. The PPH is a procedural arrangement similar to the PCT, but at the moment it is bilateral. It should be multilateral and include international work product under the PCT, he said.

The PPH has other problems, Gurry said. It does not produce "any systemic benefit" at this point, while many offices use the PCT's international work product, deficient as it may be. The PPH also lacks a common database, and the volume of PPH requests filed is "rather insignificant," he said.

The time for talk is ending and decisions are needed soon, Gurry said. The key question is whether the goal is to lighten the workload and speed applications or to create a functional, sustainable system that will not create the kind of backlog seen now, he said. The solution could be a single path or multiple routes, so long as everyone agrees on it, he said.

"Political resolve is necessary," Gurry said. He urged industry to lobby governments for action. In the short term, WIPO believes a focus on the quality of the international search product is key, he said. In the long run, there should be agreement on an international procedure under the PCT that includes common applications, searches and tools, Gurry added.

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HEADLINE: Off-Limits

BYLINE: Neil Munro

HIGHLIGHT:
In the battle over copyrights, patents, trademarks, and other intellectual-property rules, everyone is guided by self-interest.

BODY:

[Barbie] I'm a Barbie girl, in a Barbie world

Life in plastic, it's fantastic

You can brush my hair, undress me everywhere

Imagination, life is your creation

[Ken] Come on, Barbie, let's go party!

[Barbie] I'm a Barbie girl, in a Barbie world

It's a great tune. So great that Barbie's corporate parent, Mattel, sued the Danish disco group Aqua as soon as the song was marketed by MCA Records. After five years of litigation, a three-judge panel of the 9th Circuit Court of Appeals turned aside Mattel's claims that the song was a copyright violation and that it sullied the "Barbie" trademark with sexual innuendo. The court concluded that the song was exempt from copyright rules because it was a satirical parody. It also decided that Barbie had become such a household word that she had escaped the confines of Mattel's guardianship.

Victoria's Secret was much more successful in its lawsuit against the owners of a shop in Kentucky called "Victor's Little Secret." Lower courts agreed that the shop was diluting the value of the company's trademark and thus its critical brand. But the Supreme Court declared in 2003 that to win its case, the company has to prove damage. This ruling, however, turned out to be a good decision for future plaintiff companies, because the

Court allowed Victoria's Secret to cite circumstantial evidence, such as experts' predictions, said Christine Farley, a trademark-law professor at American University. For companies, "it is easy to win -- they're winning all the time" in other trademark cases, she said.

An India-based software firm, Tata Sons, won its victory in 2000 when it persuaded the World Intellectual Property Organization, based in Switzerland, to shut down an online business that duplicated the company's "Tata" trademark. The Web address of the online business was bodacious-tatas.com.

Intellectual property, of course, is more than a collection of stories. As a talking Barbie once said about math, IP is hard. But the concept of self-interest can serve as a guide through the IP maze. The broad debate over IP involves four groupings or factions: the access faction, the asset faction, the redistributionists, and the public.

* The access faction of professionals and entrepreneurs opposes too-stringent curbs on its access to other people's IP, just as industrial entrepreneurs oppose regulation of their labor, capital, raw materials, and physical property. This faction is led by university professionals and is championed by a variety of grant-funded advocacy groups.

* The asset faction regards IP as a wealth-generating asset. This faction includes the large movie and record companies, the big pharmaceutical firms, and many smaller corporations and entrepreneurs. They seek to guard copyrights, patents, trademarks and brands, databases, and business methods from piracy, theft, debasement, and insult.

* The redistributionists want to loosen IP protections so that products can be spread widely to end users, such as seriously ill people on low incomes. This camp is focused on medicines needed by developing countries rife with tuberculosis, AIDS, and other afflictions. The leading group in this faction is the Washington-based Consumer Project on Technology.

* The public wants what it wants. It wants to obtain new music and new movies as cheaply as possible, and it wants amenities such as the ability to cut and paste slices of IP onto DVDs or into e-mails for friends, book reports for school, business briefings for work, gardening newsletters for home, and much, much more. This faction is the most important, because it has the latent power to rebuff the asset camp, the professionals, and the redistributionists.

These factions are fighting for advantage on a shifting battleground, where new technology and new markets are creating opportunities and threats, alliances, and rivalries, and where foreign countries are pushing and pulling for their own industries' economic advantage

Each faction's advocates say that achieving their goals would provide the greatest good to the greatest number of people. This article will focus on the agenda promoted by the access faction, partly because it is gaining political influence in Washington, especially among Democrats.

The Access Faction

Loose copyright laws in decades past aided such new institutions as Hollywood's movie industry, according to the leading advocate in the access faction, Lawrence Lessig, a law professor at Stanford University. For example, Disney introduced Mickey Mouse in a sound-synchronized cartoon called Steamboat Willie. But that cartoon echoed an earlier silent movie titled Steamboat Bill Jr., starring Buster Keaton. Keaton's movie in turn was based on a popular vaudeville act.

Lessig argues in his new book, Free Culture, that good IP rules reward investors, but that overly restrictive rules retard innovation and the economy. For evidence, Lessig cites the rise and demise of MP3.com. This company offered a central database in which customers could store copies of songs they'd already bought. Customers could then use the Internet to listen to their stored songs at home or at work. But one copyright holder -- a record company -- sued on the grounds that MP3.com was storing unauthorized copies of its songs. MP3.com argued in defense that customers were entitled by the "fair-use" exemption in copyright law to make their own copies for their own personal use. The company's executives lost both the lawsuit and MP3.com, which became part of the record company. For good measure, the record company sued MP3.com's attorneys for giving poor advice to MP3.com.

The copyright rules also hinder people in the time-honored practice of reusing old and new content, said Lessig. With better laws, youths could "take [video] images and sounds and still images and mix them together into a political commentary, or a critical cultural commentary, or their own MTV video," Lessig said. Entrepreneurs, he continued, could restore old movies if a new law protected them from lawsuits in the event a copyright owner emerged to claim payments.

Much of the harm from today's copyright law, Lessig said, is caused by the combination of new laws and the technical design of the Internet.

A computer automatically creates a temporary copy of everything the user views on the World Wide Web, and this copying triggers copyright law. Moreover, the Internet makes it very easy for copyright holders to search for even trivial unauthorized uses of their copyrights. A quick search on Google, for example, can reveal any commercial or noncommercial use of "Barbie," "tata," or "Victoria," and "Secret."

New copyright laws passed since 1962 have extended copyright terms from 56 years to 95 years, ensuring that few

older works have been released into the public domain. For example, only one of the silent movies by Laurel and Hardy is in the public domain. Lessig argues that the repeated extension of copyright law clashes with the plain language of the power granted to Congress by the Constitution's Article I, Section 8: "To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

This combination of automatic copying, easy surveillance, and extended copyright terms chokes innovation, Lessig said. In response, he asked the courts to overturn the copyright extensions as unconstitutional, but the Supreme Court rebuffed him in a 7-2 vote in January 2003. The case was lost, said Lessig, simply because the justices failed to understand how copyright laws curb innovation.

Like Lessig, other access proponents complain about "patent thickets" that constrain entrepreneurial research. The thickets of patents are maintained by corporations, scientists, and inventors as they protect their software, medicines, and other technological inventions. These thickets deter some scientists from investigating subjects that are entangled in complex patents or that might be covered by other patents, said Stephen Hansen, an IP expert at the American Association for the Advancement of Science. They also force scientists to hire expensive lawyers to guide them through the tangle of property-rights law, Hansen said. This situation has spurred scientists and universities to tighten safeguards on their own property, he said. "The same [type of] information that was shared is now being kept very close to the chest, requiring one researcher at one institution to license research that was considered basic and free before the 1980s," Hansen said.

Just as "fair use" allows people to duplicate copyrighted works for minor personal use, the "research exemption" has allowed researchers to investigate other people's patented discoveries. This exemption does not allow commercial use of others' patented materials. The exemption emerged from a mix of case law, tradition, and self-interest, and it was intended to balance the private-property rights of patent owners against the public benefits that emerge from widespread research.

But over the past few years, the courts -- especially in the 2002 decision Madey v. Duke University, issued by the U.S. Court of Appeals for the Federal Circuit -- have narrowed this research exemption. Duke lost its claim that it had a right under the research exemption to use a patented technology. The Supreme Court declined to hear the appeal. The consternation that followed from this decision was muted among state universities, which already enjoyed a measure of "sovereign immunity" from patent lawsuits.

The two main wings of the access faction -- the copyright wing and the patent wing -- merge in Silicon Valley, where

executives complain frequently that today's IP rules dampen demand for new computer hardware, software, and Internet services. This sector's complaints have fueled much of the political opposition to tight copyright rules.

This economic argument provides a firm political foundation for a much broader critique of IP rules by Lessig and his ideological allies. "We're really concerned about monopolization of speech" as IP laws are expanded, said Farley.

For some in the access faction, the current expansion of IP laws into copyrights, patents, trademarks, and other areas is reminiscent of the enclosure of England's common agricultural land in earlier centuries. This movement denied farmland to peasants, forcing them to migrate to jobs being created by the Industrial Revolution. Other access advocates see environmental regulations as a better comparison, because they restrict the owners of real property for the benefit of the public at large. "We need a similar notion for [protecting] the intellectual environment ... out of which we make culture and the future," said James Boyle, a law professor at Duke University Law School. Such a "politics of intellectual property" could protect the users of intellectual property from the owners, he said. Moreover, intellectual property, when "properly applied," is "a force for cultural and economic progress," said Peter Jaszi, a law professor at American University and a spokesman for the Digital Future Coalition. The coalition includes many groups of academics and professionals, as well as the United States Catholic Conference.

This expansive argument is not championed by Silicon Valley, but it has won wide sympathy from professionals who use and create IP, and who dislike IP-owning corporations. "It's not just copyright," said William Sims Bainbridge, a senior science adviser at the federal National Science Foundation. "I want the power of the corporations broken. I detest the culture they promulgate, [and] ... there will be more of a livelihood for local good musicians playing to their local audiences." His Web-using children download music, and if the record companies "come after us ... they'll just make another group of enemies."

Lessig said, "We have to move beyond the Soviet era in culture production, where the few produce for the rest of us." The political debate over IP is not "Left versus Right... It is [about] enabling creativity rather than stifling it."

To advance his political cause, Lessig has formed his own group, called Creative Commons. It offers copyright creators the opportunity to license their work for broad public use. Lessig also works with a variety of other groups, such as the Electronic Frontier Foundation, Public Knowledge, and Jaszi's Digital Future Coalition, in seeking to roll back today's copyright protection laws.

These access-minded groups also share the willingness of

the redistributionist faction, led by Jamie Love of the Consumer Project on Technology, to reorder slices of the nation's intellectual-property business. For example, Lessig and others have suggested that songwriters and musicians be compensated by some new scheme other than copyright law, perhaps through a tax on Internet service or a levy on computer memory chips. In theory, a government-created "compulsory license" could allow consumers to freely copy, swap, distribute, and modify songs, while steering tax revenues to the songwriters and musicians.

Over the long run, Lessig also hopes for a rematch in the Supreme Court that would persuade the justices to greatly shorten copyright terms. To win that court fight, Lessig said, he and his allies in the creative and professional sectors have to show the Supreme Court justices how too-tight rules restrict innovation. That campaign of persuasion bas to be carried out in legal journals and in the media, and also by personal contacts with influential judges, he said. Such social influence, however, is curbed by the judges' practice of socializing with lawyers rather than with IP creators, Lessig complained.

In its fight, Lessig's faction is aided greatly by the economic and political clout of the high-tech sector. Some of the access faction's groups, such as the Alliance for Digital Progress, include large segments of the high-tech industry, and many companies are eager to lobby against legislation promoted by the movie and record industries. The alliance includes Intel, Microsoft, Motorola, and the National Association of Manufacturers. For example, the Consumer Electronics Association is opposing efforts by the movie industry to persuade state legislatures to pass additional copyright-protection laws. These pending bills are so vague that they could "criminalize the legitimate activities of consumers, innovators, and retailers," according to a CEA statement.

Lessig, his ideological allies, and many of these high-tech companies have rallied behind a draft bill introduced by Rep. Zoe Lofgren, D-Calif., whose district includes Silicon Valley. The act, carefully titled the "Benefit Authors Without Limiting Advancement or Net Consumer Expectations Act," would allow consumers the technology and the right to copy copyrighted products for personal use -- for example, to create multiple CDs of a song for use at home, in the car, or at the office. The bill would also allow consumers to give away copies of the works they buy, and to disable copyright-protection software. This legislation would help ensure that "the IT industry has the freedom to create new and exciting devices and services," said a statement from Lofgren's office.

The Asset Faction

Many of the companies that support Lofgren's bill own large quantities of intellectual property; Intel guards its patents vigorously, and Microsoft aggressively goes after copyright violators. But few of these companies have as overwhelming an incentive to protect IP as do the Motion Picture Association of

America and the Recording Industry Association of America.

Indeed, Silicon Valley's companies would likely profit in the short run if consumers bought new computers and software to download movies and songs for free, perhaps over Internet peer-to-peer computer networks. In some cases, companies' advertisements have encouraged that notion by urging consumers to buy new computers to "rip, mix, and burn" online songs. The slogan suggests that consumers should download, mix-and-match, and copy songs, whether or not they are illegally copied.

The record and movie industries have countered piracy by bringing lawsuits against consumers they suspect of violating copyright laws. The targets include teenagers, university students, parents who were ignorant of their kids' online copying, and people making money from illegal copying. On April 28, the RIAA filed another 477 lawsuits against individuals. The copyright owners have also mounted a PR campaign to stigmatize the copying celebrated by the "rip, mix, and burn" ads.

And the owners are lobbying federal and state legislators for additional copyright protections, including bills that would force Silicon Valley companies to include copyright-protection technology in their products, and a bill that would let the federal government launch civil lawsuits against copyright violators. The greatest legislative success, however, has been the Digital Millennium Copyright Act of 1998 and a companion treaty that internationalized copyright-protection laws.

The copyright owners' biggest political success may be the widespread public acceptance of the idea that intellectual property is equivalent to physical property, such as a car or a billfold. But they're not the same, as the Constitution makes clear with its assumption that physical property would be owned in perpetuity while ownership of intellectual property would have a time limit, "to promote the progress of science and useful arts."

The asset-faction advocates are so zealous in conflating the two forms of property that Fritz Attaway, general counsel of the MPAA, even opposes a Lessig proposal that copyright owners be required to pay a dollar to extend their copyright period beyond 50 years or so.

Attaway is scathing about Lessig's broader political goal. "Lessig is someone that is trying to create a populist movement against the idea that intellectual property should be treated like real property, ... [and his allies] believe that anything that stands in the way of their creative energy is an impediment and should be suppressed." Lessig's "criticisms are really an intellectual excuse for piracy," agreed Cary Sherman, president of the Recording Industry Association of America. "If you take [his] theory to its logical conclusion, all copyright works that can be digitized will be paid for by a government tax," and this taxation will deter investment in IP.

Attaway charged that Lessig and his allies are earning rewards from their advocacy. "He's making a living promoting himself as a cultural icon and collecting money from speeches." Lessig disputes that characterization, saying, "I don't have a financial dog in the fight." Still, he said, he's "not complaining" about the acclaim gained from his prominent role in the debate.

Although the copyright debate is rancorous, the fight over patents enjoys a degree of comity, largely because many companies and universities own, develop, and need new patents. Companies like IBM can accept some patent infringement if it helps technology advance, said **David Kappos,** IBM's assistant general counsel for intellectual property. "It is more wise to let the research go forward," he said, provided that the patent infringements don't continue into the commercial marketplace.

The comity has its limits. On April 19, a private group, the National Research Council, released a report declaring that the government should assume liability for patent infringements by federally funded scientists and their universities. Government agencies should also threaten to seize valuable patents "where access ... is not resolved in the marketplace by licensing on reasonable terms," said the report, titled "A Patent System for the 21st Century." The National Research Council is part of the National Academies, a private-sector group of scientists, university executives, and entrepreneurs.

The universities and companies are preparing a major report, to be released in 2005, that includes a variety of proposals for accelerating technological innovation. The pending report will be a compromise between university and industry priorities, and it will urge social changes, health care reform, and patent-law changes, Kappos said.

Negotiations among industry executives have already proved their worth, said F. Thomas Dunlap, general counsel for Intel. Industry deals -- sometimes cemented by regulations or narrow laws -- have helped developed copyright protection for DVD and for digital TVs, he said. These agreements, he said, can give protections to IP owners, fair use to consumers, and the opportunity for equipment-makers to sell products. But they can't give everything to everybody, so "there's going to be continuing tension," Dunlap said.

Amid lobbying from industries and universities, Congress will likely soon approve a reform of the U.S. Patent and Trademark Office. The new law will boost the office's annual budget to roughly $1.5 billion to help it process the growing wave of patent and trademark applications, said Jon Dudas, the acting undersecretary of Commerce for intellectual property. The extra employees will also speed up patent approvals, thus helping scientists and other researchers focus on their research, he said.

The Redistributionists

Jamie Love of the Consumer Project on Technology has had great success pressuring drugmakers to release AIDS medicines for use in the developing world. This success was made possible by public sympathy for the cause, plus lobbying from a plethora of advocacy groups and from many overseas governments.

To expand on these gains, Love and his allies are developing plans to reorder the medical research sector. One proposal would end the use of patents and instead reward inventors with shares from an annual multibillion-dollar fund. Without patents, many companies would be free to produce new medicines at competing prices, Love said. Such a new system, said Joshua Sarnoff, a Love ally and a law professor at American University, would also help refocus university scientists on research that benefits many people, even if it does not generate large profits. This vision has negligible political weight, but so did Love's cheap-drugs campaign when he began it.

The Public

In the tactical and strategic battles over IP, the critical constituency is the public. "The political future of this issue will be determined by the battle for the hearts and minds of people," many of whom copy, cut, and paste pieces of intellectual property for their use, Peter Jaszi said. In reaching out to this critical audience, the copyright owners have played their hand skillfully, he said, while those in the access faction are "trying very hard to speak to [the public] to make them care about this issue in the same way they care about the environment, or abortion, or foreign policy."

Fred von Lohman, an IP expert at the Electronic Frontier Foundation, said that his faction is "coming to realize that the typical American couch potato will get drawn into this fight because it will impact how their TVs work and how their home stereos work."

The solution "won't be Congress mandating anything," said Rep. Rick Boucher, D-Va., a supporter of Lessig and author of a bill that would roll back copyright rules. "The real decision will be based on market realities," which are already pushing the record companies to release more and more of their product over the Internet, he said.

But Attaway says he's confident that things are going their way. "The courts have uniformly confirmed the rights of content owners," and high-tech companies are increasingly adding copyright- protection technology to their products because it is to their advantage, he said. Yet "there will always be a balance between the people who want a free ride ... and people who are established and want to protect their property."

There's no permanent fix to these disputes. "A healthy

society understands the dilemma -- everyone wants to free-ride on everyone else," said James DeLong, an intellectual-property expert at the Progress & Freedom Foundation. IP law changes as new technology and new businesses emerge, he said, but the ever-shifting balance between asset value and shared access might be upset if Lessig's faction, and its allies in the professional class and the media, persuade the public and the courts to join their campaign. But if the courts remain independent of Lessig's professionals and Attaway's executives, they can play a valuable role in guiding the evolution of IP laws, DeLong said. Regardless of what happens over the next decade or two, there will be lots of speeches and billable hours, lots of drama and excitement.

[Barbie] Oh, I'm having so much fun!

[Ken] Well, Barbie, we're just getting started

[Barbie] Oh, I love you, Ken!

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Intellectual Property Today

October 2006

SECTION: WHAT'S NEW -- RESOURCE GUIDE; Pg. 24

LENGTH: 1808 words

BODY:

NEW PATENT CLAIMS SOFTWARE LAUNCHED BY COMPUTER PATENT ANNUITIES LIMITED

Computer Patent Annuities Limited (CPA), announced the launch of CPA Claimkey -- a ground-breaking software tool, enabling instantaneous access to claims information.

Created as a response to existing IP practitioners' needs, CPA Claimkey is the latest addition to CPA's IP support services, which focus on freeing up the IP professionals' time, so that it can be better spent on higher value work. By using CPA Claimkey, patent attorneys will be exposed to important strategic information, which will help to avoid inconsistencies or defects in claims or arguments that litigators may uncover.

The tool itself is accessed via an ASP (web-based) platform and operates as an intelligent database. CPA Claimkey loads pending and issued US patent prosecution histories, as well as prior art references into a recorded, structured database.

CPA Claimkey is the only comprehensive claims specific, fully searchable tool in the marketplace that enables the user to know, within seconds, how many patent claims he or she has pending or issued on a particular technology or product. It also shows the status of each claim and how many have been allowed, rejected more than once or limited by amendments.

Steve Lundberg, Managing Partner of Schwegman, Lundberg, Woessner and Kluth, who have been trialing the product comments: "We have been extremely impressed with CPA Claimkey -- within minutes you can click your way through numerous claim sets, amendments and arguments which enable you to identify key issues or deficits that require remedial action." He continues: "With that kind of instant access, not only does CPA Claimkey save time, it also enables you to access many times more information than is currently possible with traditional law firm or corporate resources."

CPA Claimkey is a critically important tool that patent practitioners can use to prevent them from being unwitting accomplices in the issuance of patents having poorly researched or misinformed claims.

LEADING TECHNOLOGY COMPANIES JOIN FORCES WITH UNITED STATES PATENT AND TRADEMARK OFFICE AND NEW YORK LAW SCHOOL'S INSTITUTE FOR INFORMATION LAW & POLICY TO LAUNCH NEW PATENT EXAMINATION PROCESS

GE, HP, IBM, Microsoft & Red Hat to Sponsor and Participate in First Ever Social Software Project Connected to Official, Legal Decision-Making Process

The Institute for Information Law & Policy at New York Law School announced that companies holding more than 6% of the total number of this year's patents will submit their patent applications for "open peer review" under a pilot project at the United States Patent and Trademark Office (USPTO). GE, HP, IBM, Microsoft and Red Hat, the Lead Sponsors of the "Community Patent Review" initiative, will allow some of their patent applications to be reviewed by

the public and consent to have public commentary submitted directly to the USPTO for official consideration. The pilot will launch in early 2007 and focus on published but not-yet-granted patent applications relating to computer software.

The Community Patent Review pilot is a project of the New York Law School Institute for Information Law & Policy in collaboration with the USPTO that aims to improve the quality of issued patents by giving the patent examiner access to better information by means of an open network for community peer review of patent applications.

Selected by the USPTO as one of its strategic initiatives, Community Patent Review will deploy an online system to allow the scientific community to submit "prior art" -- information relevant to assessing if an invention is patentable -- with commentary to the patent examiner. The project is developing a deliberation methodology and technology to allow community rating, ranking and processing of prior art and feedback from patent examiners.

The Institute for Information Law and Policy at New York Law School will be responsible for overall administration of the pilot in partnership with the USPTO. A Steering Committee made up of lead patent counsel for the Lead Sponsors and an Advisory Board, comprising a wide range of patent stakeholders, will oversee the initiative. All Community Patent review project documents and deliberations are open and available on the World Wide Web for public comment and participation.

The CPR project is actively seeking participants for the USPTO pilot willing to have their published patent applications publicly reviewed. As an incentive to participate in the pilot program, the USPTO will jump any patent application submitted for open review to the front of the queue for examination. Currently, applicants wait 3-4 years for a first response from the Patent Office. In addition to the Lead Sponsors, Intel, International Characters, Oracle and Out-of-the Box Computing Corporation have also signed on to allow some of their patent applications to be peer-reviewed.

IBM was the first corporation that committed to community peer review. "High-quality patents increase certainty around intellectual property rights, reducing contention and freeing resources to focus on innovation," said **David Kappos**, Vice President, Intellectual Property Law, IBM. "Our work with Professor Noveck and the USPTO strives to increase patent quality by bringing to bear the entire community of technology experts to help bring the most relevant information to the attention of the patent office for its use in evaluating applications."

In describing the problem, Adam Avrunin, Chief Patent Counsel for Red Hat, Inc., commented: "While examiners at the Patent Office have a duty to grant patents on only inventive technologies, they often have trouble finding references demonstrating that the subject matter of a patent application was already known, especially in the software field."

To address this problem, Community Patent Review will "enable examiners to have access to the best technical information experts to enhance the quality of issued patents," says, E.R. "Kaz" Kazenske, Senior Director, IP&L-Patent Group, Microsoft, and former Deputy Commissioner, USPTO.

Jeff Fromm, Vice President, Deputy General Counsel & Director of Intellectual Property for HP, added: "The community patent project takes advantage of today's community-based technology to improve the quality of U.S. patents in a manner that is aligned with the basic tenets of the patent system. This initiative does precisely what Thomas Jefferson intended the patent system to do by reaching out to the scientific community for information and access to prior art, and HP is pleased to be a partner in this effort."

Commenting on the impact on the country's economic future, Q. Todd Dickinson, GE's Vice President and Chief Intellectual Property Counsel and former Under Secretary for Intellectual Property and Director of the USPTO said, "If we as a country are going to increasingly focus on technology as an engine for economic growth, we have to have even better systems in place to continue to ensure and improve the quality of patents. GE is committed to ensuring patent quality and believes the Community Patent Review project is one of the most important initiatives underway today to reach this goal."

Community Patent Review's Steering Committee members currently include: Adam Avrunin, Chief Patent Counsel, Red Hat; Q.Todd Dickinson, Vice President and Chief Intellectual Property Counsel, GE (former Under-Secretary of State for Intellectual Property and Director, USPTO); Kaz Kazenske, Senior Director, IP&L-Patent Group, Microsoft (former Deputy Commissioner, USPTO); Curt Rose, Senior Counsel and Patent Development Manager, HP; and Manny Schecter, Associate General Counsel, Intellectual Property Law, IBM. The Advisory Board was named in October.

Eric Hestenes has been named Technical Project Leader for Community Patent Review Project. Hestenes is co-founder of ViKiwi, a technology and management consulting firm. Previously, he served as Vice President of Technology at Charles Schwab.

DAY, BERRY & HOWARD LLP AND PITNEY HARDIN LLP ANNOUNCE AGREEMENT TO MERGE

Day, Berry & Howard LLP and Pitney Hardin LLP announced an agreement to merge firms by year-end, with both firms voting unanimously on the merger. The resulting firm, which will be known as Day Pitney LLP, will extend both firms' geographic reach and regional strength throughout the Northeast, from Boston to Washington, D.C. Day Pitney will have approximately 400 attorneys, operating in nine offices located in New York, New Jersey, Connecticut, Boston and Washington, D.C.

"The merger of Pitney Hardin and Day, Berry & Howard will put us in a stronger position to serve our clients," said Dennis LaFiura, managing partner at Pitney Hardin. "As a joint entity, we will have a deeper legal expertise and broader geographic reach to work with our clients more efficiently and on a greater scale. At the same time, this opportunity will allow Day Pitney to attract new clients in different regional markets to gain increased traction in the Northeast."

This merger will bring together two firms that are established leaders in their respective markets. Day, Berry & Howard's strength in Boston, Connecticut, New York and Washington, D.C. will complement Pitney Hardin's status as a premier New Jersey and New York City law firm. As a joint entity, Day Pitney will combine both firms' traditional strengths in litigation and corporate law, while also offering clients deeper capabilities in areas such as government investigations, labor and employment, employee benefits, trust and estates, international estate planning, energy law, and intellectual property prosecution and litigation.

In addition, Day Pitney will offer individual clients a greater depth and breadth of service offerings, expanding on both firms' longstanding traditions and core values of client-focused thinking and satisfaction. Working as a team, the Individual Clients Department will have greater resources to foster Day Pitney's 100-plus years of experience advising individuals and their families.

"As we looked to increase our firm's service offerings, merging with Pitney Hardin was a natural choice. Our firms share a history of market leadership, we both embrace similar core values focused on client service, and most importantly, we share the goal of expanding our capabilities in the Northeast market, including New York," said Jim Sicilian, chair of the executive committee at Day, Berry & Howard. "The excitement is high and we look forward to combining our traditions to extend the reach of key firm practices, while still providing the personal focus on our clients' needs that has been at the heart of both firms' past success."

The merger is expected to be complete by the first of January.

A further press release will be issued upon the announcement of the completion of the merger.

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LENGTH: 1061 words

HEADLINE: Community Patent Review Project to Be Subject of May 12 USPTO Briefing

DATELINE: NEW YORK May 12, 2006

BODY:

The Community Patent Initiative at New York Law School (www.nyls.edu) announced today that its director, Professor Beth Noveck, along with representatives from IBM, will present an overview of the Community Patent Review pilot project at a briefing hosted by the U.S. Patent and Trademark Office (USPTO) on Friday, May 12, 2006, 9:00-12:00, at the Madison Auditorium, USPTO Headquarters in Alexandria, VA. (www.uspto.gov)

The Community Patent Review Pilot, currently under consideration by the USTPO, would provide an online peer review system for patent applications designed to ensure that patent examiners have access to the most pertinent information when determining if an invention is patentable.

The pilot project is an initiative of the USPTO with support from the private seetor, including the Community Patent Initiative at New York Law School and IBM.

Professor Beth Noveck, Director of the Institute for Information Law & Policy at New York Law School, commented: "The Community Patent Review pilot project would bolster USPTO's decision-making capabilities by allowing experts from around the globe to submit relevant information, known as prior art. The project would take advantage of collaborative, web-based technologies to build a peer review system. Reviewers would receive notification of patents in areas of their expertise and would collaboratively identify the patent application's most important claims, and then submit relevant information online. Peer reviewers would then rank these submissions so that patent examiners can review the prior art deemed most relevant by the community."

IBM announced in January patent quality initiatives it is undertaking with the USPTO, Open Source Development Labs (OSDL), members of the open source software community and academia that is focused on improving U.S. patent quality. The partnership between these parties to improve patent quality will help accelerate innovation in the United States. As one of the elements of the patent quality initiative, IBM is the first corporation that has committed to consent to community peer review of published patent applications owned by the company by allowing third parties to submit commentary explaining the relevance of the prior art they provide to the patent office.

"High-quality patents increase certainty around intellectual property rights, reducing contention and freeing resources to focus on innovation," said David Kappos, Vice President, Intellectual Property Law, IBM. "Our work with Professor Noveck and the USPTO strives to increase patent quality by bringing to bear the entire community of technology experts to help bring the most relevant information to the attention of the patent office for its use in evaluating applications."

Designed by dozens of experts in consultative workshops at Harvard, Stanford, New York Law School, University of Michigan and elsewhere, "the proposed pilot program would be unlike any other reform effort because it deals di-

rectly with the examination process, providing important information to examiners before the patents are even issued," added Professor Noveck.

"Knowing that peers will review their work will encourage patent filers to thoroughly research and meticulously present their applications, creating better quality patents," according to Professor Noveck. The current system tries to correct the problem of inappropriate patent applications after the fact through litigation. Like preventative health care, the peer system may discourage flawed applications from even getting to the filing point. The pilot program, says Noveck, will determine "if and how community peer review works."

About the Community Patent Review:

Developed by New York Law School's Institute for Information Law and Policy and sponsored by IBM, the Community Patent Review seeks to design and pilot an online system for peer review of patents that will enable innovation experts to inform the patent examination procedure. The Project will support a network of experts to advise the Patent Office on prior art and longer term to assist with patentability determinations. The goal of the Project is to help patent examiners find the right references and eventually to have access to those who can advise on how to combine them. This will help to improve the quality of those inventions awarded a patent, thereby making it easier to protect inventors' investments while safeguarding the marketplace of ideas. (http://dotank.nyls.edu/communitypatent)

About the Institute for Information Law and Policy:

The Institute for Information Law and Policy is New York Law School's home for the study of law, technology, and civil liberties. Participants in the Institute aim not only to understand the interplay of law and technology, but to influence its development. The Institute develops and applies theories of information and communication to analyze law and policy. It also seeks to design new technologies and systems that will best serve democratic values in the digital age. The Institute is, above all, a "do tank" where lawyers innovate, harnessing the new tools of information and communications to the goals of social justice. Taking full advantage of its New York location, the Institute convenes people across disciplines and institutions in pursuit of its goals and exposes students to the best of the legal, technology and design communities.

About New York Law School:

Founded in 1891, New York Law School is an independent law school located in lower Manhattan near the city's centers of law, government, and finance. New York Law School's renowned faculty of prolific scholars has built the school's strength in such areas as constitutional law, civil and human rights, labor and employment law, media and information law, urban legal studies, international and comparative law, and a number of interdisciplinary fields. The school is noted for its six academic centers: Justice Action Center, Center for New York City Law, Center for Professional Values and Practice, Center on Business Law & Policy, Institute for Information Law and Policy, and the Center for International Law. New York Law School has more than 13,000 graduates and enrolls some 1500 students in its full- and part-time J.D. program and its Master of Laws (LL.M.) in Taxation program.

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BusinessWeek online

Business Week Online

February 2, 2006 Thursday

SECTION: DAILY BRIEFING

LENGTH: 656 words

HEADLINE: A New Invention for Inventors;
It's an auction of patents -- and some big-name companies will be selling in "a marketplace where nobody knows what the asset is worth"

BYLINE: Michael Orey

BODY:

Last year, Dean Becker, an avid collector of classic cars, was thumbing through a catalog for an automobile auction. Why not sell patents the same way, he thought. This April, Ocean Tomo, a firm where Becker is a managing director, will do just that. It has lined up a British auctioneer to take the podium at The Ritz-Carlton San Francisco and sell off rights to everything from earth-imaging technology to shrink-wrap.

Think of what eBay (EBAY) did for the junk in people's garages, and you get an idea of what Becker's idea could mean for patents. "Right now what you've got is a marketplace where nobody knows what the asset is worth," says David Kappos, an assistant general counsel at IBM (IBM) who manages patents.

Chicago-based Ocean Tomo is part of a cottage industry of firms that want to cash in on patents. Traditionally, patent deals have been shrouded in secrecy and burdened by steep transaction costs. The primary method of extracting value, beyond selling a product based on an invention, has been licensing patent rights. But licensing negotiations are often arduous and need to be backed up by a willingness to litigate, which is expensive.

NEW EXPOSURE. Auctions could help foster "the emergence of a liquid market" for buying and selling patents, says Kappos. So far more than 1,200 patents have been submitted to Ocean Tomo for sale from such companies as AT&T (T), BellSouth (BLS), American Express (AXP), and Kimberly-Clark (KMB).

If auctions become a regular feature of the patent world, they would help establish prices and a marketplace. "I see this as a great opportunity [as] an independent inventor to really get exposure to a large base of companies that could commercialize my patents," says William L. Reber. Now on his own after working as an engineer for Walt Disney (DIS) and Motorola (MOT), Reber is the creator of 48 patents he's putting up for sale at the auction.

Kimberly-Clark will sell patents on a new shrink-wrap that it has decided not to commercialize, and BellSouth will auction off 20 patents in areas no longer part of its core business, such as search-engine technology. "We think this is a good avenue to explore," says Bill Hartselle, a managing director in BellSouth's patent marketing unit.

INVESTMENT ASSETS. Patents from each seller will be grouped into lots when they relate to a common area. Some lots will include additional material such as prototypes of products, inventor notebooks, and, in one case, 80 hours with the inventor to aid in transferring expertise. Ocean Tomo -- a name combining a legal acronym with the Japanese word for friend -- will get 25% of the sale price.

A New Invention for Inventors; It's an auction of patents -- and some big-name companies will be selling in "a marketplace where nobody knows what the asset is worth" Business Week Onli

It's the ambition of Ocean Tomo's cofounder and ceo, James E. Malackowski, to turn his firm into an "intellectual-capital merchant bank" offering a range of products and services, including strategic advice for mergers and acquisitions of patent-rich companies, patent appraisal, and insurance against infringement claims. The auction is integral to that vision.

It is, he says, the "foundation for establishing patents as an investment asset class." In his view, patents are in the same spot as real estate was decades ago, before it was connected to the Wall Street spigot by such things as real estate investment trusts and mortgage-backed securities.

"INVENTING THE FUTURE." Some see the upcoming auction as little more than a marketing stunt. And Malackowski certainly has a propensity for promotion. Two firms he was affiliated with before founding Ocean Tomo in 2003 raised questions about items in his Web site resume that describe investment work he had done with them. Malackowski says the resume was accurate, but modified it following questions from BusinessWeek.

Still, many see Malackowski as a visionary. "We've been talking about things like new ways of monetizing patents, new ways of leveraging [intellectual property]," says Kappos of IBM. "Ocean Tomo is right there inventing the future."

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October 30, 2006 Monday 12:05 AM GMT

LENGTH: 2403 words

HEADLINE: How To Avoid The Patent Trap

HIGHLIGHT:

IBM's lawsuit against Amazon highlights the need for patent reform and raises a question: Are big tech vendors using their massive patent portfolios to stifle innovation?

BODY:

Almost two years ago, IBM donated 500 software patents to the open source community, with a pledge that it would not enforce its license rights to the technologies. But the company remains fiercely protective of its vast portfolio of intellectual property, as Amazon.com learned last week when IBM filed a patent-infringement suit claiming the Internet retailer built its business using IBM-developed technology and processes.

Welcome to the tortuous world of technology patents and IP, where community-minded vendors share original ideas manifest as software code one day--then bring the hammer down on suspected scofflaws the next. Over the past two months, Microsoft has released three internally developed technologies--related to Web services, its virtual hard disk format, and its Sender ID--with promises that they can be used by others in perpetuity. At the same time, Microsoft is aggressively licensing--and protecting--other intellectual property.

IBM's top attorney for intellectual property rights acknowledges his company's position can seem contradictory and confusing. "We've referred to our patent policy as apparent schizophrenia," **David Kappos** says. Yet he maintains that "on a deeper level, our actions are consistent."

Problems with the U.S. patent process are well documented: It's a costly, multiyear undertaking to obtain a patent, involving overworked examiners who frequently grant patents for technologies and processes many think are too obvious or broad to deserve such protection. Lawsuits fly fast and furious. Last week, SGI sued ATI Technologies (just acquired by Advanced Micro Devices) for allegedly infringing on one of its computer-graphics patents. And earlier this month, chip designer Transmeta sued Intel, charging that the No. 1 chipmaker violated 10 of its microprocessor patents. Also last week, the U.S. Supreme Court agreed to hear an appeal in a patent dispute between AT&T and Microsoft. An appeals court had ruled that Microsoft was liable based on worldwide sales, not just U.S. sales, for infringing on a U.S. patent held by AT&T.

<table width="300" border="0" align="right" cellpadding="6" cellspacing="0"> <TR> <td width="10" bgcolor="#FFFFFF"> </td> <TD colspan="2" bgcolor="#000066"> Forces Of Reform
 Key players working to change the patent system </TD></TR> <tr> <td width="10" bgcolor="#FFFFFF"> </td> <td width="145" align="left" valign="top" bgcolor="#CC9966">

IBM
 Seeks community review of patent applications, abolition of business-method patents that don't include technical innovation, and increased transparency of patent ownership

U.S. Patent And Trademark Office
 Proposes limiting to 10 the number of times patent applicants can request a re-examination of their applications and the number of individual patent claims contained in any single application

To avoid getting snared in the patent trap, businesses must be careful about the technology they use. And intellectual property disputes can encompass more than just patents: SCO Group sued AutoZone and DaimlerChrysler in 2004 for copyright violations related to its ongoing Linux and Unix legal claims.

Tech vendors, IBM and Microsoft principal among them, are trying to change things they don't like about the patent process. In addition to giving away patents to the open source community, IBM wants all patent applications to be subject to public review. And it's urging Congress to do away with patents--including some of its own--based on so-called business methodologies that lack technical merit.

But in suing Amazon, IBM promised to "aggressively defend" its intellectual property and hunt down other companies it thinks are using its IP without permission. IBM says it tried unsuccessfully to negotiate a licensing deal with Amazon for four years before filing suit. Amazon declined to comment.

MICROSOFT'S AGENDA

Like IBM, Microsoft has released internally developed technology, some of it patented. In September, Microsoft said developers were free to use its Web services specifications, and earlier this month it did the same with its virtual hard drive image format. "Every individual and organization in the world" can use the technology, Microsoft declared generously, adding that the offer stands "forever."

Last week, Microsoft added its Sender ID technology, which helps identify the source of e-mail, to the components available under its so-called Open Specification Promise. "There are some technologies that we think are critical for broad industry adoption," says Jason Matusow, senior director of IP and licensing. OSP is "an irrevocable promise" that developers can use these Microsoft technologies without fear of being sued or being forced to pay license fees, he says. At the same time, Microsoft has set a goal to cut its intellectual property "deficit." It paid about $1 billion in licensing fees last year but brought in just $100 million.

Not everyone buys the patent-reform agenda of the big tech companies. Hans Hxu, founder of online gift registry Felicite.com, says the industry's large players are more interested in the appearance of IP openness than in practicing what they preach. "IBM patents almost everything they do, then they sit on it. That doesn't do much to encourage innovation," says Hxu, a McKinsey consultant before launching Felicite.

Other critics suggest the vendors' moves are aimed at cementing their advantages at a time when they face rising competition from startups. In an August essay, Harvard Law School professor and tech entrepreneur James Moore argued that the collaborative patent review process proposed by IBM, Microsoft, and others will result in fewer patents being issued because it will give examiners more ammunition to shoot down applications. "If fewer patents are issued, but existing patents are not revoked, IBM and Microsoft win because they already possess vast existing portfolios," Moore writes.

Some Web 2.0 companies dismiss IBM's argument that business-method patents protect obvious ideas. "Everything is obvious after someone has done it," says a spokesman for online movie renter Netflix, which has patents on its queue-ordering system--and is suing Blockbuster for allegedly copying the system.

Small tech companies are taking matters into their own hands, forming patent cooperatives through which IP is shared. Search company Wink participates in Creative Commons, a group that encourages sharing of copyrights and GNU open source licenses. But there's a line between sharing and protecting intellectual property that creates competitive advantage, says Wink CEO Michael Tanne. "When companies have invested in the development of technologies, they really ought to be able to protect it," Tanne says.

How these issues are resolved will influence how tech innovations are developed and commercialized in the years ahead. Too many lengthy and expensive legal battles will persuade IT departments to stick with familiar technology. That's something tech vendors should consider as they take one another to court.

<FONT SIZE="1">with Eric Chabrow</FONT>

<FONT SIZE="1">Illustration by Chris Windsor/Stone</FONT>

GOOD COP, BAD COP

IBM makes more than $1 billion a year licensing its IP. As the largest patent holder in the United States, IBM's good-cop, bad-cop approach reflects a broader debate within the tech industry about the role patents should play in a Web 2.0 ecosystem characterized by open source development, collaborative innovation, and fast product cycles. "There are some pathologies in the system that need to be dealt with," Harvard Business School professor Josh Lerner says. "Patents have become too powerful and too easy to get" for an economy that's increasingly information-based, Lerner says.

IBM's strategy is to be an IP benefactor to the tech industry when it's in IBM's interest, while staunchly defending its IP rights at other times. That's hardly reassuring to entrepreneurs and startups that risk a run-in with IBM as they develop new products. IBM holds about 40,000 patents worldwide for everything from how to display ads online to the creation of an Internet checkout system. IBM patents cover "most of, if not all, e-commerce," senior VP John Kelly told The Wall Street Journal last week.

Coincidentally, Amazon last week settled an e-commerce lawsuit filed in 2004 by Cendant that covered some of the same technology that IBM claims as its own. Amazon and Cendant agreed to mutual nonexclusive cross-licenses to the patents involved in the suit.

Meantime, the prospect of a more aggressive IBM has some tech companies worried. "We're looking at the patents that IBM is concerned about with Amazon and checking them out," says Daren Gill, VP of development at ChoiceStream, which created an online product-recommendation engine used by AOL, Yahoo, and, soon, a major Internet movie retailer.

IBM's suit against Amazon involves technology that underlies the Web retailer's recommendations generator, a popular feature that suggests books to shoppers based on books they previously bought on the site and similar purchases by other shoppers. IBM says it invented and patented the concept in the 1980s. The method uses a search and retrieval technique known as collaborative filtering that creates associations between objects in, say, an online product catalog, based on the number of times they're selected by a single buyer. IBM also is suing Amazon for violating four other patents it says are at the core of Amazon's business (see "IBM Vs. Amazon").

What's setting off alarms in some quarters is the fact that personalized recommendation systems are widely used, and they can be generated in a number of different ways. "These kind of lawsuits hurt our whole industry," says Mary Hodder, CEO of Dabble.com, an online video-sharing service. She thinks the patent process needs tightening to prevent what she considers a proliferation of nuisance suits. "Most of the patents they grant are really for simple and basic concepts and ideas, not complex and innovative processes, which is what they're supposed to be allowing," Hodder says.

<table width="300" border="0" align="right" cellpadding="6" cellspacing="0"> <tr> <td width="10" rowspan="7" align="left" valign="top"> </td> </tr> <tr> <td width="290" align="center" valign="middle" bgcolor="#000066"> IBM Vs. Amazon
 In dispute: </td> </tr> <tr> <td width="290" align="left" valign="top" bgcolor="#CC9966">An electronic requisition system that has catalogs of items offered by suppliers stored on a central catalog database system</td> </tr> <tr> <td width="290" align="left" valign="top" bgcolor="#66CCFF">A system that includes a means of storing at least one link profile associated with a specific set of one or more users, which can be used to make recommendations</td> </tr> <tr> <td width="290" align="left" valign="top" bgcolor="#CC9966">A system that lets users request applications during a session with a group of servers</td> </tr> <tr> <td width="290" align="left" valign="top" bgcolor="#66CCFF">A system in which the network presents the requested applications as one or more screens</td> </tr> <tr> <td width="290" align="left" valign="top" bgcolor="#CC9966">A method for storing and managing advertising on a Web server</td> </tr> </table>IBM officials insist the move against Amazon isn't a sign of a new and more aggressive IP legal campaign. "I don't anticipate any change in our basic policies," Kappos says. "Consensual licensing and working on a nonconfrontational basis is the best way to run an IP program." IBM's last major patent-infringement suit was six years ago against database vendor Informix, Kappos says, a company IBM has since acquired.

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IBM also sees itself at the vanguard of a movement to reform the patent system. Last month, IBM said it would register all patents in the name of the company, not the scientist who developed the technology, for the sake of transparency. IBM also is ceding 100 business-method patents to the public domain, though it would like to see such patents done away with unless they're based on substantial technical innovation. (The top patent official in Israel ruled last week that business-method patents aren't permitted in that country.)

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LOAD-DATE: October 31, 2006

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6 of 15 DOCUMENTS

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INFORMATIONWEEK

October 30, 2006

SECTION: NEWS & ANALYSIS; Pg. 23

LENGTH: 2181 words

HEADLINE: Patent Trap;
IBM's lawsuit against Amazon shows a patent system in need of reform and raises a question: Are big vendors using their patent portfolios to stifle innovation?

BYLINE: Paul McDougall

HIGHLIGHT:

Almost two years ago, IBM donated 500 software patents to the open source community, with a pledge that it would not enforce its license rights to the technologies. But the company remains fiercely protective of its vast portfolio of intellectual property, as Amazon.com learned last week when IBM filed a patent-infringement suit claiming the Internet retailer built its business using IBM-developed technology and processes.

BODY:

Welcome to the tortuous world of technology patents and IP, where community-minded vendors share original ideas manifest as software code one day-then bring the hammer down on suspected scofflaws the next. Over the past two months, Microsoft has released three internally developed technologies-related to Web services, its virtual hard disk format, and its Sender ID-with promises that they can be used by others in perpetuity. At the same time, Microsoft is aggressively licensing-and protecting-other intellectual property.

IBM's top attorney for intellectual property rights acknowledges his company's position can seem contradictory and confusing. "We've referred to our patent policy as apparent schizophrenia," David Kappos says. Yet he maintains that "on a deeper level, our actions are consistent."

Problems with the U.S. patent process are well documented: It's a costly, multiyear undertaking to obtain a patent, involving overworked examiners who frequently grant patents for technologies and processes many think are too obvious or broad to deserve such protection. Lawsuits fly fast and furious. Last week, SGI sued ATI Technologies (just acquired by Advanced Micro Devices) for allegedly infringing on one of its computer-graphics patents. And earlier this month, chip designer Transmeta sued Intel, charging that the No. 1 chipmaker violated 10 of its microprocessor patents. Also last week, the U.S. Supreme Court agreed to hear an appeal in a patent dispute between AT&T and Microsoft. An appeals court had ruled that Microsoft was liable based on worldwide sales, not just U.S. sales, for infringing on a U.S. patent held by AT&T.

The number of patent lawsuits continues to rise and so does the size of settlements and judgments, says the Coalition for Patent Fairness, a group supported by large tech companies. Before 1990, only one patent damage award larger than $100 million had been awarded; in the past five years there have been at least 10 judgments and settlements of that size and at least four that topped $500 million, the group says.

Patent Trap; IBM's lawsuit against Amazon shows a patent system in need of reform and raises a question: Are big vendors using their patent portfolios to stifle innovation? INFORMATIONWEEK Octobe

To avoid getting snared in the patent trap, businesses must be careful about the technology they use. And intellectual property disputes can encompass more than just patents: SCO Group sued AutoZone and DaimlerChrysler in 2004 for copyright violations related to its ongoing Linux and Unix legal claims.

Tech vendors, IBM and Microsoft principal among them, are trying to change things they don't like about the patent process. In addition to giving away patents to the open source community, IBM wants all patent applications to be subject to public review. And it's urging Congress to do away with patents-including some of its own-based on so-called business methodologies that lack technical merit.

But in suing Amazon, IBM promised to "aggressively defend" its intellectual property and hunt down other companies it thinks are using its IP without permission. IBM says it tried unsuccessfully to negotiate a licensing deal with Amazon for four years before filing suit. Amazon declined to comment.

GOOD COP, BAD COP

IBM makes more than $1 billion a year licensing its IP. As the largest patent holder in the United States, IBM's good-cop, bad-cop approach reflects a broader debate within the tech industry about the role patents should play in a Web 2.0 ecosystem characterized by open source development, collaborative innovation, and fast product cycles. "There are some pathologies in the system that need to be dealt with," Harvard Business School professor Josh Lerner says. "Patents have become too powerful and too easy to get" for an economy that's increasingly information-based, Lerner says.

IBM's strategy is to be an IP benefactor to the tech industry when it's in IBM's interest, while staunchly defending its IP rights at other times. That's hardly reassuring to entrepreneurs and startups that risk a run-in with IBM as they develop new products. IBM holds about 40,000 patents worldwide for everything from how to display ads online to the creation of an Internet checkout system. IBM patents cover "most of, if not all, e-commerce," senior VP John Kelly told The Wall Street Journal last week.

Coincidentally, Amazon last week settled an e-commerce lawsuit filed in 2004 by Cendant that covered some of the same technology that IBM claims as its own. Amazon and Cendant agreed to mutual nonexclusive cross-licenses to the patents involved in the suit.

Meantime, the prospect of a more aggressive IBM has some tech companies worried. "We're looking at the patents that IBM is concerned about with Amazon and checking them out," says Daren Gill, VP of development at ChoiceStream, which created an online product-recommendation engine used by AOL, Yahoo, and, soon, a major Internet movie retailer.

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MICROSOFT'S AGENDA

Like IBM, Microsoft has released internally developed technology, some of it patented. In September, Microsoft said developers were free to use its Web services specifications, and earlier this month it did the same with its virtual hard drive image format. "Every individual and organization in the world" can use the technology, Microsoft declared generously, adding that the offer stands "forever."

Last week, Microsoft added its Sender ID technology, which helps identify the source of e-mail, to the components available under its so-called Open Specification Promise. "There are some technologies that we think are critical for broad industry adoption," says Jason Matusow, senior director of IP and licensing. OSP is "an irrevocable promise" that developers can use these Microsoft technologies without fear of being sued or being forced to pay license fees, he says. At the same time, Microsoft has set a goal to cut its intellectual property "deficit." It paid about $1 billion in licensing fees last year but brought in just $100 million.

Not everyone buys the patent-reform agenda of the big tech companies. Hans Hxu, founder of online gift registry Felicite.com, says the industry's large players are more interested in tbe appearance of IP openness than in practicing what they preach. "IBM patents almost everything they do, then they sit on it. That doesn't do much to encourage innovation," says Hxu, a McKinsey consultant before launching Felicite.

Other critics suggest the vendors' moves are aimed at cementing their advantages at a time when they face rising competition from startups. In an August essay, Harvard Law School professor and tech entrepreneur James Moore argued that the collaborative patent review process proposed by IBM, Microsoft, and others will result in fewer patents being issued because it will give examiners more ammunition to shoot down applications. "If fewer patents are issued, but existing patents are not revoked, IBM and Microsoft win because they already possess vast existing portfolios," Moore writes.

Some Web 2.0 companies dismiss IBM's argument that business-method patents protect obvious ideas. "Everything is obvious after someone has done it," says a spokesman for online movie renter Netflix, which has patents on its queue-ordering system-and is suing Blockbuster for allegedly copying the system.

Small tech companies are taking matters into their own hands, forming patent cooperatives through which IP is shared. Search company Wink partieipates in Creative Commons, a group that encourages sharing of copyrights and GNU open source licenses. But there's a line between sharing and protecting intellectual property that creates competitive advantage, says Wink CEO Michael Tanne. "When companies have invested in the development of technologies, they really ought to be able to protect it," Tanne says.

How these issues are resolved will influence how tech innovations are developed and commercialized in the years ahead. Too many lengthy and expensive legal battles will persuade IT departments to stick with familiar technology. That's something tech vendors should consider as they take one another to court. -with Eric Chabrow

Write to Paul McDougall at paulmcd@cmp.com

Forces Of Reform

Key players working to change the patent system

Patent Trap; IBM's lawsuit against Amazon shows a patent system in need of reform and raises a question: Are big vendors using their patent portfolios to stifle innovation? INFORMATIONWEEK Octobe

IBM

Seeks community review of patent applications, abolition of business-method patents that don't include technical innovation, and increased transparency of patent ownership

Microsoft

Wants international harmonization of patent law, a crackdown

on questionable patent litigation, and the end of filing fees for small companies and individual inventors

U.S. Patent And Trademark Office

Proposes limiting to 10 the number of times patent applicants can request a re-examination of their applications and the number of individual patent claims contained in any single application

Sens. Orrin Hatch, R-Utah, and Patrick Leahy, D-Vt.

Sponsors of the Patent Reform Act of 2006, which would grant stronger protection to "first to file" patent holders, raise the bar for litigants who claim prior invention, and limit damage awards for patent holders

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IBM Vs. Amazon

In dispute:

An electronic requisition system that has catalogs of items offered by suppliers stored on a central catalog database system

A system that includes a means of storing at least one link profile associated with a specific set of one or more users, which can be used to make recommendations

A system that lets users request applications during a session with a group of servers

A system in which the network presents the requested applications as one or more screens

A method for storing and managing advertising on a Web server

http://informationweek.com/

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LOAD-DATE: October 30, 2006

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Fortune

August 21, 2006
U.S. Edition

SECTION: FIRST; Intellectual Property; Pg. 18 Vol. 154 No. 4

LENGTH: 1739 words

HEADLINE: PATENT REVIEW GOES WIKI

BYLINE: Nicholas Varchaver

BODY:

THE PROBLEM: an epidemic of shoddy patents.

The solution: Wikipedia?

That's the basic concept behind a pilot program sponsored by IBM and other companies, which the U.S. Patent and Trademark Office appears poised to green-light. The project would apply an advisory version of the wiki approach to the patent-approval process.

The issue is that patent applications have tripled in the past two decades, leaving examiners only 20 hours on average to comb through a complex application, research past inventions, and decide whether a patent should be granted. As a result, critics contend, quality has declined and lucrative patents have been granted for ideas that weren't actually new.

One solution is to let astute outsiders weigh in during the patent-review process, as online encyclopedia Wikipedia does, vastly increasing the information available to the patent examiner. New York Law School professor Beth Noveck floated the idea on her blog last July, inspiring an article in Wired News. That, in turn, attracted the attention of IBM, which got behind the idea. Says **Dave Kappos,** vice president for intellectual-property law at IBM: "It's a very powerful concept because it leverages the enormous capabilities of the entire world of technical talent."

Working with IBM and the Patent Office, Noveck developed a system that will not only permit, for example, an inventor to show that an allegedly new idea is already in practice but also lets reviewers rate one another's submissions, much as they do on eBay and Amazon. Patent examiners will be given only the ten highest-rated pieces of input, and attempts to sabotage a competitor's application by submitting phony material should theoretically be avoided.

Corporate sponsors including IBM, Microsoft, and Hewlett-Packard will make a total of 250 to 400 software patents available for the pilot. Says the commissioner for patents, John Doll: "We're just trying to put the finishing touches on the details before we roll it out to the [head of the Patent and Trademark Office] and get the final approval to move ahead." Noveck thinks the test could launch early in 2007. If successful, the approach could then be implemented throughout the patent office. "It seems fairly obvious," says Noveck, "to try to tie together some of the systems of peer production of information that we've seen in the private sector." And those who've complained about the patent process could take part in fixing it.

AN IDEA BORN ON A BLOG IS ENDORSED BY MICROSOFT AND IBM.

GRAPHIC: PHOTO: Noveck: Eric Johnson; THOUGHT LEADER New York Law School professor Beth Noveck hatched the plan.

LOAD-DATE: August 9, 2006

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TECHNOLOGY DAILY

March 5, 2007 Monday
AM EDITION

SECTION: Vol. 10 No. 9

LENGTH: 142 words

HEADLINE: E-GOVERNMENT;
PATENT EXAMINERS TO SEEK EXPERTS' ADVICE ONLINE PATENT OFFICE'S SITE SOLICITS EXPERTS

BODY:
The Patent and Trademark Office will test a program to use the Internet in the process of reviewing patents. The Washington Post reports that the PTO program will post patent applications online and use a community rating system to prioritize the most-respected comments so agency examiners can review those first. The system resembles the user-created online encyclopedia Wikipedia. **David Kappos,** vice president and assistant general counsel at IBM, said, "For the first time in history, it allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts." Patent examiners have rarely sought outside opinions, but as applications grow in record numbers, the workload limits examiners' time for thorough reviews. Volunteers to participate in the pilot project include Microsoft, Hewlett-Packard, IBM, Intel and Oracle.

LOAD-DATE: March 5, 2007

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Ottawa Citizen

January 15, 2008 Tuesday
Final Edition

SECTION: BUSINESS; Pg. D4

LENGTH: 226 words

HEADLINE: IBM joins corporate giants in sharing ecological patents

BYLINE: Bloomberg News

DATELINE: NEW YORK

BODY:

NEW YORK - International Business Machines Corp., the leading recipient of U.S. patents, is joining Sony Corp., Nokia Oyj and Pitney Bowes Inc. in offering the rights to environmentally friendly technologies for free.

The effort, called the Eco-Patent Commons, is designed to help companies save energy and water and curb pollution, IBM said yesterday in a joint statement with the World Business Council for Sustainable Development in Geneva.

Companies are taking steps to show they're fighting global warming and promoting sustainable development. The Eco-Patent Commons is the first forum for sharing intellectual property with environmental uses.

"There's no one industry, innovation or technology that provides a silver-bullet solution," said David Kappos, IBM's lead patent attorney. "There's going to be a long series of development involving many industries."

The Eco-Patent Commons will start with 31 patents, 27 of which were contributed by IBM. The company has received more U.S. patents than any other for 15 years. The U.S. Patent and Trademark Office issued 3,125 to IBM last year.

IBM is contributing a patent for a catalytic reactor that uses low-radio frequency energy ions to help convert pollutants into stable gases.

Another patent covers a packaging design for a five-sided, shock-absorbing tray that replaces the need for Styrofoam "peanuts."

LOAD-DATE: January 15, 2008



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The Calgary Herald (Alberta)

January 15, 2008 Tuesday
Final Edition

SECTION: CALGARY BUSINESS; World in Brief; Pg. C9

LENGTH: 145 words

HEADLINE: IBM offers free 'green' technologies

BYLINE: Compiled from Herald News Services

BODY:

International Business Machines Corp., the leading recipient of U.S. patents, is joining Sony Corp., Nokia Oyj and Pitney Bowes Inc. in offering the rights to environmentally friendly technologies for free. The effort, called the Eco-Patent Commons, is designed to help companies save energy and water and curb pollution, Armonk, New York-based IBM said Monday in a joint statement with the World Business Council for Sustainable Development in Geneva.

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LOAD-DATE: January 15, 2008

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UPI

March 5, 2007 Monday 5:35 PM EST

LENGTH: 194 words

HEADLINE: Patent process goes high-tech

DATELINE: ALEXANDRIA, Va., March 5

BODY:

The U.S. Patent and Trademark Office is going to try to find out if the Internet can help it do a better job reviewing patent applications.

Under a pilot project to begin this spring, the office will post applications and seek public comment, the Washington Post said Monday. The commentary cream theoretically will rise to the top through a community rating system.

"For the first time in history, it allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts," said IBM executive **David J. Kappos.**

The genesis of the project was a meeting between IBM, the nation's top patent generator, and Beth Noveck, a New York Law School professor who said it will trigger "the first major change to our patent examination system since the 19th century."

A record 332,000 applications were reviewed last year by the agency's 4,000 examiners, headquartered in Alexandria, Va.

Patent Office spokeswoman Brigid Quinn said the program will kick off with about 250 applications from the software sector. The review volunteers already include Microsoft, Intel, Hewlett-Packard, Oracle and IBM. Additional applicants will be allowed.

LOAD-DATE: March 6, 2007

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InformationWeek

February 20, 2006

SECTION: IN DEPTH/ PATENTS; Pg. 40

LENGTH: 178 words

HEADLINE: TECH-TALK TROUBLES

BYLINE: Eric Chabrow

HIGHLIGHT:
One problem with software patents, compared with those in other areas, is the language used. Patents granted for pharmaceuticals, for instance, use a chemistry lexicon to describe the specifics of what the invention accomplishes: compounds, bonds, and reactions. "The language of chemistry is hundreds of years old, and it's really clear," says Dave Kappos, senior intellectual property counsel at IBM.

BODY:

Juxtapose that with software, which has no such lexicon. "Software-related inventions typically are described processes, with very general functional language involving taking a first data entry and transporting it to a data location and taking it to a second data entry," Kappos says. "It's really difficult to understand what those mean. A lot of the problem boils down to the lexicon. That's not the fault of [the] Patent Office. It's not really the fault of anybody. It's just a problem that we have to live with."

Changes have been proposed to the patent examination process that would let third parties and rivals submit documentation about software during the application process and in reviews after patents are granted. These adjustments could help define the exact purpose of an invention, Kappos says. Beyond that, technospeak will continue to be a challenge.

http://informationweek.com/

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LOAD-DATE: February 20, 2006



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The Journal News

January 11, 2005 Tuesday

SECTION: BUSINESS; Pg. 1D

LENGTH: 853 words

HEADLINE: No. 1 IBM donates 500 patents

BYLINE: Julie Moran Alterio

BODY:

Big Blue makes gift that will benefit open source software community

Julie Moran Alterio

The Journal News

IBM Corp. is donating 500 of its patents to the open source software community today to make it easier for companies to link technology using shared standards.

The Armonk-based computer giant is making the gift on the same day that it's announcing that it has generated more U.S. patents than any other company for the 12th year in a row.

IBM had 3,248 patents last year, according to figures released today by the U.S. Patent and Trademark Office.

Dave Kappos, IBM's assistant general counsel for intellectual property law, said the patent donation signals a major shift in the way Big Blue deploys its intellectual property portfolio.

Traditionally, companies accrue patents to generate licensing revenue and to horsetrade technology with rivals. In 2003 IBM collected $900 million from licensing, royalty fees and sales of intellectual property.

"It came to us that we have an opportunity to demonstrate leadership here to use patents, not to exclude others but to provide a foundation for others to build on," Kappos said.

The patent donation reflects the combined work of tens of thousands of research hours. The donated patents were chosen to give a kickstart to industry efforts to link databases, operating systems, user interfaces and other Internet standards.

"When you have a world where everything intersects with information technology, everything has to work together. Refrigerators and toaster ovens have to work with computers. For vendors to get these products working together, you must have open standards," Kappos said.

The fundamental software that runs much of the Internet - the Web servers, mail programs and communications protocols - are open source.

The benefits of open source software are lower cost - no pricey licensing fees - and reliability because a community of programmers around the world is eradicating the bugs.

The donated patents include a set of voice recognition technologies that could help companies in such industries as travel, banking and retail create automated systems that better understand customers' telephone requests, Kappos said.

Any individual or company can tap the IBM patents if they agree to conform to terms of the Open Source Initiative, which stipulates freedom from royalties, among other conditions.

Eric Raymond, a celebrity in the Linux community and author of open source bible, "The Cathedral and the Bazaar," said IBM's gift is a "wonderful thing" that will be valued by software developers everywhere.

"IBM, the biggest beneficiary of the patent system, is acknowledging with this grant that the best thing it can do for progress in software is to waive its patent rights," Raymond said. "That ought to send a message to all the corporations who have been loudly proclaiming that software innovation depends on a restrictive intellectual-property system."

Larry M. Augustin, chairman of open source champion VA Software, said IBM's patent gift provides a pool of software that developers can tap to create standards everyone can use.

"One of the barriers to the adoption of standards is when the standards depend on somebody else's patent," Augustin said. "The method that IBM is putting in place bypasses all of that."

IBM, which spends $5 billion a year on research and employs 3,000 scientists around the world, hasn't given up on its passion to generate patents.

Last year was the fourth that IBM received more than 3,000 U.S. patents - a feat unmatched by any other company. About 580 of the patents were developed at IBM's Thomas J. Watson Research Center in Yorktown Heights.

Among the local patents that detailed new ways to build speedier microchips and improve Web commerce was an idea inspired by a researcher's four sons and their passion for video games.

Sara H. Basson, a White Plains mom as well as a researcher at IBM in Yorktown, said she and fellow researchers Peter Gustav Fairweather, Alexander Faisman and Dimitri Kanevsky all worried that their children played too many games.

"We all have kids with various levels of addiction to video games. We talked about how to convert this potentially unhealthy video game addiction into something positive," she said.

The answer was to turn a video game machine into a rehabilitation tool.

Children recovering from injuries who must perform physical therapy tasks would play the games, and their motions would be incorporated into the action.

A child recovering from a broken arm, for example, who had to perform a certain number of movements for healing, wouldn't be able to advance to the next level in the game world until he completed them.

"It would make the tasks more pleasurable and likely to be fulfilled," Basson said.

The idea is in the early stages, but since there are so many existing video games that could be employed, Basson said all that's needed to implement it is a partnership with a video game developer and rehabilitation professionals.

Reach Julie Moran Alterio at jalterio@thejournalnews.com or 914-694-5228.

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InformationWeek

Feb 20, 2006

SECTION: Pg. 36 No. 1077 ISSN: 8750-6874; CODEN: INFWE4

ACC-NO: 994797881

LENGTH: 2866 words

HEADLINE: Patently Absurd

BYLINE: Chabrow, Eric

BODY:

The long and growing list of tech-related patent cases reflects the US patent system's inability to keep up with changing times, particularly in IT. The number of patent applications filed with the Patent and Trademark Office mushroomed 73% in the last decade. Patent Commissioner John Doll thinks his office has some solutions. He has proposed hiring 1,000 examiners a year over the next five years to augment the 4,258 examiners the agency already employs. Few people outside the Patent Office think true reform will come from administrative rule changes alone. That is why debate over patent reform often returns to the power of injunction. But injunctions are only a symptom of the bigger problem -- bad patents lead to confusion, litigation, and a bad system. It may take 20 years to get rid of all the weak patents, but the overall effect on the patent system would be well worth the wait.

FULL TEXT:

The U.S. patent system is in disarray. Change requires not just a better system, but better Apatents, too.

"I don't know of any other agency ... that allows you to retry your case until you get the answer you'd like," Patent Commissioner Doll says.

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TOM WOOLSTON IS ABOUT TO HAVE HIS DAY IN COURT, AGAIN.

This time, it's the United States Supreme Court.

Vilified by some, a hero to others, Woolston is CEO of MercExchange, an online auction house that couldn't compete with eBay and dropped out of the auction business six years ago. Since then, MercExchange has exacted some $25 million in patent-infringement damages from eBay's hide, but Woolston wants more. He wants the Supreme Court, which will hear arguments next month, to force Virginia's Eastern District federal court to issue an injunction that would stop eBay from continuing to use the infringing "Buy It Now" technology.

"We want to compete, we want to go back into the market, we want to see our own site back up," Woolston says. "Money damages aren't going to make a difference against eBay."

MercExchange and eBay aren't the only ones duking it out over techrelated patents. Among the highest-profile cases: NTP's challenge of technology in Research In Motion's BlackBerry; mobile E-mail vendor Visto's suit against Good Technology over patents for synchronizing data with mobile devices; Broadcom's suit against Qualcomm over Bluetooth technology patents; Microsoft's loss to a Guatemalan inventor for technology in Office 2003 and XP; and Eolas' fight with Microsoft over use of browser technology in Internet Explorer. This long and growing list reflects the U.S. patent system's inability to keep up with changing times, particularly in IT.

We've moved toward this litigious point over the past two decades as the courts strengthened the rights of patent holders while the standards to grant patents were weakened. It's a "perfect storm, a complex and intensifying combination of factors that increasingly makes the patent system a hindrance rather than a spur to innovation," Harvard Business School professor Josh Lerner said before a House subcommittee last summer.

The number of patent applications filed with the Patent and Trademark Office mushroomed 73% in the last decade, from 236,679 in 1995 to 409,532 last year. About 10% of all patents issued are for software; more than 19,000 in 2003, up from 1,100 in 1981, the year the Supreme Court ruled that software could be patented, says Gregory Aharonian, editor of the Internet Patent News Service.

Patents are popular because they confer a competitive edge on their owners: 20 years of exclusive rights to profit from the use of the patented innovation. They're worth so much money that some companies-including Acacia Technologies Group, Forgent Networks, Intellectual Ventures, and NTP-make trafficking in them their primary business. Earlier this month, merchant bank Ocean Tomo launched an auction business to buy and sell patents-one more sign of just how hot this market is.

With the growing number of applications has come a huge backlog. The Patent Office started last year with more than 500,000 new applications in backlog and ended it with almost 600,000 waiting to be examined. "We'll add another 100,000 cases to the backlog this year," Patent Commissioner John Doll says, "so the two problems really are how to do the amount of work we have to do, and then how do we do it with as much quality as we possibly can."

CHANGE AFOOT

Doll thinks his office has some solutions. He's proposed hiring 1,000 examiners a year over the next five years to augment the 4,258 examiners the agency already employs. He wants to restructure training so new examiners are proficient at their jobs within a year, rather than the current two to three years. Beyond staffing, Doll wants limits on the amount of information applicants can provide examiners early in the application process and the number of appeals allowed when an application is turned down. He's also hoping to require applicants to share the costs involved with examining extensive documentation.

Most of Doll's proposals, which could take effect in a matter of months, are designed to speed patent approvals rather than ensure patent quality. Critics of the system are calling for more fundamental changes.

One such change proposed in legislation that Rep. Lamar Smith, R-Texas, introduced in June would let third-party experts furnish evidence-called "prior art"-during the examination process to demonstrate whether an invention is unique. Under current rules, only the patent applicant can provide such evidence. Outsiders can get involved after a patent is granted by requesting a review and submitting prior art that might discredit the patent. If third parties could participate in the process, examiners would have more relevant information to decide whether to grant a patent.

In addition to the legislation, another group is working to take prior art investigations online. The PeerTo-Patent Group, spearheaded by New York Law School associate law professor Beth Noveck and backed by IBM, proposes an online system where experts in a given field would submit prior art to be ranked by other experts using the same type of software tools that let people recommend books at Amazon.com. This collaborative filtering system would forward only highly ranked prior art to patent examiners.

Another proposed reform in Smith's legislation would expand the scope of challenges permitted after a patent is granted. Currently when a patent is challenged, the petitioner is only allowed to submit evidence to the reviewer. No testimony is given.

The proposed legislation would establish a minitrial, where parties would make legal arguments before three administrative law judges who'd determine the patent's legitimacy. Patents that successfully navigate such a review would be deemed higher quality and less likely to be overturned in court. That process should dissuade the opportunists from filing further legal challenges.

Expanding the scope of post-grant challenges isn't all that contentious. But there is disagreement over when such challenges should be allowed. The legislation proposes two points at which people could file for reviews: nine months after a patent award and, more controversial, years later, when a company starts to enforce its patents.

Many large tech companies support adding the opportunity for a later review. But emerging enterprises with businesses based on homegrown patented technologies and companies that generate revenue mostly from enforcing patents contend this second window would let big vendors string out the review process over many years. "It gives someone with a large budget the power to never have to respect someone's patent," says Brent Frei, executive VP at Intellectual Ventures, a company headed by former Microsoft CTO Nathan Myhrvold that generates much of its revenue from enforcing patents. Frei calls the provision in the legislation "the infringer's Bill of Rights."

But since most patents aren't enforced, having the opportunity for a later review makes sense to some. If challenges are allowed only right after a patent is granted, then companies and courts end up wasting a lot of resources "trying to validate a bunch of patents that will never get asserted," says Jason Schultz, staff attorney at the Electronic Frontier Foundation. The later window is aimed squarely at patent trolls, Schultz says, companies that "are notorious for finding old patents that no one has ever used, dusting them off, purchasing them, and going after people and asserting them. Without the second window, you have no effect on patent trolls, period."

A streamlined review process might have helped in the NTP-RIM case. The Patent Office appears to be slowly moving toward invalidating seven wireless patents that NTP holds; it has issued a preliminary ruling to that effect but may not have a final ruling for years. Concurrently a federal judge has ruled that RIM violated those possibly invalid patents, and the court could issue an injunction this week to shutter BlackBerry service in the United States. RIM is prepared for the worst with a software workaround that customers would download to continue using their BlackBerrys-all because one branch of government appears blind to what the other branch is doing.

NOT JUST A U.S. PROBLEM

It's not just U.S. patent law that gets people agitated. The European Union is more restrictive when it comes to granting software patents and doesn't grant patents for business processes at all. The open source community as well as those wanting to maintain national rights successfully opposed legislation last summer that would have brought Europe's software rules closer to the United States'.

Critics of the U.S. system say too many patents have been issued in the last decade for software and business processes that hardly deserved special treatment. Weak patents are the ones that get challenged, first as part of the Patent Office's review and then in the courts, and this diverts to legal battles money and resources that should be earmarked for innovation. "Good patents create a financial incentive for innovation; bad patents impose costs on the economy and on national competitiveness," says New York Law School's Noveck, who's also director of the school's Institute of Information Law and Policy.

Patent quality is an issue in nearly all of the most visible patent suits. And the stakes are high: a $521 million judgment, for instance, in the Eolas-Microsoft case. Vague or weak patents lead defendants to argue that the descriptions of the inventions in the patents don't apply to their use of a technology or that the patents should be invalidated because the innovations depicted were neither original nor nonobvious, two requisites of a patent.

QUALITY VS. SPEED

So why aren't patent examiners granting good patents? For one, they're overburdened. It takes an average of three years for the Patent Office to grant a patent, but examiners spend as little as 20 hours reviewing each application-not nearly enough time for a thorough examination, particularly when it comes to tech patents. "When the input exceeds the ability to deal with what comes in ... you get a big backlog," says **Dave Kappos,** IBM's senior intellectual property counsel. "You get all kinds of other problems. You get people who have to push things out till the end of the process so that patents don't get appropriately examined."

Patent Commissioner Doll's push to hire more examiners could help, as could some of his other proposals, such as limiting the number of claims -statements made about the unique properties of the invention-a patent applicant can submit. Under the existing rules, applicants can inundate examiners with scores of claims. Doll's proposal would limit them to submitting the 10 claims they think are most important. Examiners would use those initial claims to decide whether an invention is novel enough to proceed. Other claims could be added as the process progresses, and the more claims examiners accept, the stronger the patent. In addition, Doll says, applicants would be asked to help defray the

cost of reviewing the additional claims. "If an applicant wants us to examine a hundred claims, we're going to examine a hundred claims, but we're going to ask them to share the burden," he says.

Another proposal would cut back the number of times an applicant could refile a rejected application. The office now allows an unlimited number of refiles; the proposed rule would allow four. "I don't know of any other agency or court in the land that allows you to retry your case until you get the answer you'd like," Doll says.

INJUNCTIVE POWER

Few people outside the Patent Office think true reform will come from administrative rule changes alone. Legislative reforms are more likely to improve patent quality and reduce litigation, but getting a bill pushed through Congress is no sure thing, given the variety of interests lobbying for and against parts of Smith's legislation. And even if it did happen, those changes would have little impact on patents already in force. Tens of thousands of existing patents of questionable quality would remain valid for as long as 20 years.

That's why debate over patent reform often returns to the power of injunction. Injunctions have been the default remedy in patent cases for nearly a century requiring the court to bar an infringer from continuing to use the technology at issue. Major IT vendors would like to limit their use to cases where irreversible damage has been done to a company. Even with dramatic improvements in patent quality injunctions shouldn't be automatic, says Matt Tanielian, Cisco Systems' senior technology policy counsel. "It's inherently an imperfect science. It's never going to eliminate all bad patents," he says. "The entrepreneur and the opportunist in the system will find a bad patent, or find the patent they can exploit, and use it."

But opponents, including small tech companies, independent inventors, and companies with patents as their principal assets, argue that without the threat of an injunction, large infringing companies would have no motive to settle with patent holders. "You can wave a magic wand right now and get all these high-quality patents to be issued, and I'm telling you, the infringement problem won't go away," MercExchange's Woolston says. The big tech companies arrogantly disregard other companies' intellectual property rights, assuming that no one can stop them, he says. The more aggressive they are, the more Wall Street rewards them, "and they get paid handsomely" he adds. "They don't think the system is quick enough to stop them."

The threat of an injunction can force warring parties to negotiate. "A good reason to have an injunction remedy is because the courts won't do a very good job of determining what patent damages should be, or because we think the process of going through that is too expensive," says George Washington University Law School professor Mark Abramowicz.

In most areas of law, judges can weigh the pros and cons of various remedies that serve the public interest. Patent law however, all but mandates automatic injunctions for an infringing patent. But "this is what judges are good at... weighing what the appropriate remedy would be," says Electronic Frontier Foundation's Schultz. "If you have a good case... a judge will grant you an injunction in a minute. It's just giving the judge discretion to actually decide whether or not it's a good idea, as opposed to some automatic thing where even if you have a lousy case, and there'll be extreme public harm, you get it anyway"

But injunctions are only a symptom of the bigger problem: Bad patents lead to confusion, litigation, and a bad system. Strong patents would mean fewer challenges, fewer resources spent on interminable reviews and court battles, and more confidence in a system that underpins entrepreneurialism in America. It may take 20 years to get rid of all the weak patents, but the overall effect on the patent system would be well worth the wait.

Moments In Patent History

Data: Oyez.org, Wikipedia, M-Cam, Patent and Trademark Office

1449

King Henry VI issues first modern patent to John of Utynam for making stained glass

1646

Massachusetts issues first mechanical patent in North America to Joseph Jenkes for making scythes

1981

In Diamond v. Diehr, the Supreme Court holds that software is patentable

1998

Court upholds business process patents in State Street Bank v. Signature Financial Group

2001

NTP sues Research In Motion, charging the BlackBerry infringes on NTP's wireless patents

2005

Patent Reform Act of 2005 is introduced, proposing new ways to contest patents

2006

Supreme Court will hear MercExchange v. eBay and rule on whether injunctions should be mandatory

'Good patents create a financial incentive for innovation; bad patents impose costs on the economy and on national competitiveness.

Write to Eric Chabrow at echabrow@cmp.com. Read more about patent reform and listen to our podcast on patent enforcement as a business model at informationweek.com/1077/blog_patents.htm.

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Almost two years ago, IBM donated 500 software patents to the open source community, with a pledge that it would not enforce its license rights to the technologies. But the company remains fiercely protective of its vast portfolio of intellectual property (IP), as Amazon.com learned last week when IBM filed a patent-infringement suit claiming the Internet retailer built its business using IBM-developed technology and processes. As the largest patent holder in the US, IBM's good-cop, bad-cop approach reflects a broader debate within the tech industry about the role patents should play in a Web 2.0 ecosystem characterized by open source development, collaborative innovation, and fast product cycles. Consensual licensing and working on a nonconfrontational basis is the best way to run an IP program. Small tech companies are taking matters into their own hands, forming patent cooperatives through which IP is shared.

FULL TEXT:

IBM's lawsuit against Amazon shows a patent system in need of reform and raises a question: Are big vendors using their patent portfolios to stifle innovation?

ALMOST TWO YEARS AGO, IBM donated 500 software patents to the open source community, with a pledge that it would not enforce its license rights to the technologies. But the company remains fiercely protective of its vast portfolio of intellectual property, as Amazon.com learned last week when IBM filed a patent-infringement suit claiming the Internet retailer built its business using IBM-developed technology and processes.

Welcome to the tortuous world of technology patents and IP, where community-minded vendors share original ideas manifest as software code one day-then bring the hammer down on suspected scofflaws the next. Over the past two months. Microsoft has released three internally developed technologies -related to Web services, its virtual hard disk format, and its Sender ID-with promises that they can be used by others in perpetuity. At the same time, Microsoft is aggressively licensing -and protectingother intellectual property.

IBM's ton attorney for intellectual property rights acknowledges his company's position can seem contradictory and confusing. "We've referred to our patent policy as apparent schizophrenia," **David Kappos** says. Yet he maintains that "on a deeper level, our actions are consistent."

Problems with the U.S. patent process are well documented: It's a costly, multiyear undertaking to obtain a patent, involving overworked examiners who frequently grant patents for technologies and processes many think are too obvious or broad to deserve such protection. Lawsuits fly fast and furious. Last week, SGI sued ATI Technologies (just ac-

quired by Advanced Micro Devices) for allegedly infringing on one of its computer-graphics patents. And earlier this month, chip designer Transmeta sued Intel, charging that the No. 1 chipmaker violated 10 of its microprocessor patents. Also last week, the U.S. Supreme Court agreed to hear an appeal in a patent dispute between AT&T and Microsoft. An appeals court had ruled that Microsoft was liable based on worldwide sales, not just U.S. sales, for infringing on a U.S. patent held by AT&T.

The number of patent lawsuits continues to rise and so does the size of settlements and judgments, says the Coalition for Patent Fairness, a group supported by large tech companies. Before 1990, only one patent damage award larger than $100 million had been awarded; in the past five years there have been at least 10 judgments and settlements of that size and at least four that topped $500 million, the group says.

To avoid getting snared in the patent trap, businesses must be careful about the technology they use. And intellectual property disputes can encompass more than just patents: SCO Group sued AutoZone and DaimlerChrysler in 2004 for copyright violations related to its ongoing Linux and Unix legal claims.

Tech vendors, IBM and Microsoft principal among them, are trying to change things they don't like about the patent process. In addition to giving away patents to the open source community, IBM wants all patent applications to be subject to public review. And it's urging Congress to do away with patents-including some of its own-based on so-called business methodologies that lack technical merit.

But in suing Amazon, IBM promised to "aggressively defend" its intellectual property and hunt down other companies it thinks are using its IP without permission. IBM says it tried unsuccessfully to negotiate a licensing deal with Amazon for four years before filing suit. Amazon declined to comment.

GOOD COP, BAD COP

IBM makes more than $1 billion a year licensing its IP. As the largest patent holder in the United States, IBM's good-cop, bad-cop approach reflects a broader debate within the tech industry about the role patents should play in a Web 2.0 ecosystem characterized by open source development, collaborative innovation, and fast product cycles. "There are some pathologies in the system that need to be dealt with," Harvard Business School professor Josh Lerner says. "Patents have become too powerful and too easy to get" for an economy that's increasingly information-based, Lerner says.

IBM's strategy is to be an IP benefactor to the tech industry when it's in IBM's interest, while staunchly defending its IP rights at other times. That's hardly reassuring to entrepreneurs and startups that risk a run-in with IBM as they develop new products. IBM holds about 40,000 patents worldwide for everything from how to display ads online to the creation of an Internet checkout system. IBM patents cover "most of, if not all, e-commerce," senior VP John Kelly told The Wall Street Journal last week.

Coincidentally, Amazon last week settled an e-commerce lawsuit filed in 2004 by Cendant that covered some of the same technology that IBM claims as its own. Amazon and Cendant agreed to mutual nonexclusive cross-licenses to the patents involved in the suit.

Meantime, the prospect of a more aggressive IBM has some tech companies worried. "We're looking at the patents that IBM is concerned about with Amazon and checking them out," says Daren Gill, VP of development at ChoiceStream, which created an online product-recommendation engine used by AOL, Yahoo, and, soon, a major Internet movie retailer.

IBM's suit against Amazon involves technology that underlies the Web retailer's recommendations generator, a popular feature that suggests books to shoppers based on books they previously bought on the site and similar purchases by other shoppers. IBM says it invented and patented the concept in the 1980s. The method uses a search and retrieval technique known as collaborative filtering that creates associations between objects in, say an online product catalog, based on the number of times they're selected by a single buyer. IBM also is suing Amazon for violating four other patents it says are at the core of Amazon's business (see "IBM Vs. Amazon," p. 25).

What's setting off alarms in some quarters is the fact that personalized recommendation systems are widely used, and they can be generated in a number of different ways. "These kind of lawsuits hurt our whole industry," says Mary Hodder, CEO of Dabble.com, an online video-sharing service. She thinks the patent process needs tightening to prevent what she considers a proliferation of nuisance suits. "Most of the patents they grant are really for simple and basic concepts and ideas, not complex and innovative processes, which is what they're supposed to be allowing," Hodder says.

IBM officials insist the move against Amazon isn't a sign of a new and more aggressive IP legal campaign. "I don't anticipate any change in our basic policies," Kappos says. "Consensual licensing and working on a nonconfrontational basis is the best way to run an IP program." IBM's last major patent-infringement suit was six years ago against database vendor Informix, Kappos says, a company IBM has since acquired.

But IBM is under pressure to boost its top line, and CEO Sam Palmisano sees gold in the company's vast patent library. Last year, IBM hired Boston Consulting Group patent expert Kevin Rivette as VP for intellectual property. Rivette is author of Rembrandts In The Attic (Harvard Business School Press, 1999), a primer on how companies can profit from their IP assets. Palmisano created a technology and intellectual property unit within IBM under senior VP Kelly, dedicated to finding new markets for the fruits of its research.

IBM also sees itself at the vanguard of a movement to reform the patent system. Last month, IBM said it would register all patents in the name of the company, not the scientist who developed the technology, for the sake of transparency. IBM also is ceding 100 business-method patents to the public domain, though it would like to see such patents done away with unless they're based on substantial technical innovation. (The top patent official in Israel ruled last week that business-method patents aren't permitted in that country.)

General Electric, Hewlett-Packard, IBM, Microsoft, and Red Hat are participating in a "community review" pilot project sponsored by the U.S. Patent and Trademark Office. The program aims to open patent applications to public scrutiny, easing some of the pressure on inspectors and garnering input on a patent's validity from experts worldwide.

At the same time, the Patent Office is considering revising its rules to limit to 10 the number of times patent applicants can request a re-examination of applications and the number of claims contained in an application. Congress is considering changes, too. Sens. Orrin Hatch, R-Utah, and Patrick Leahy, D-Vt., are sponsoring legislation that would grant stronger protection to patent seekers who are first to file and make it more difficult for challengers.

MICROSOFT'S AGENDA

Like IBM, Microsoft has released internally developed technology, some of it patented. In September, Microsoft said developers were free to use its Web services specifications, and earlier this month it did the same with its virtual hard drive image format. "Every individual and organization in the world" can use the technology. Microsoft declared generously, adding that the offer stands "forever."

Last week, Microsoft added its Sender ID technology, which helps identify the source of e-mail, to the components available under its so-called Open Specification Promise. "There are some technologies that we think are critical for broad industry adoption," says Jason Matusow, senior director of IP and licensing. OSP is "an irrevocable promise" that developers can use these Microsoft technologies without fear of being sued or being forced to pay license fees, he says. At the same time, Microsoft has set a goal to cut its intellectual property "deficit." It paid about $1 billion in licensing fees last year but brought in just $100 million.

Not everyone buys the patent-reform agenda of the big tech companies. Hans Hxu, founder of online gift registry Felicite.com, says the industry's large players are more interested in the appearance of IP openness than in practicing what they preach. "IBM patents almost everything they do, then they sit on it. That doesn't do much to encourage innovation," says Hxu, a McKinsey consultant before launching Felicite.

Other critics suggest the vendors' moves are aimed at cementing their advantages at a time when they face rising competition from startups. In an August essay, Harvard Law School professor and tech entrepreneur James Moore argued that the collaborative patent review process proposed by IBM, Microsoft, and others will result in fewer patents being issued because it will give examiners more ammunition to shoot down applications. "If fewer patents are issued, but existing patents are not revoked, IBM and Microsoft win because they already possess vast existing portfolios," Moore writes.

Some Web 2.0 companies dismiss IBM's argument that business-method patents protect obvious ideas. "Everything is obvious after someone has done it," says a spokesman for online movie renter Netflix, which has patents on its queue-ordering system-and is suing Blockbuster for allegedly copying the system.

Small tech companies are taking matters into their own hands, forming patent cooperatives through which IP is shared. Search company Wink participates in Creative Commons, a group that encourages sharing of copyrights and GNU open source licenses. But there's a line between sharing and protecting intellectual property that creates competi-

tive advantage, says Wink CEO Michael Tanne. "When companies have invested in the development of technologies, they really ought to be able to protect it," Tanne says.

How these issues are resolved will influence how tech innovations are developed and commercialized in the years ahead. Too many lengthy and expensive legal battles will persuade IT departments to stick with familiar technology. That's something tech vendors should consider as they take one another to court. -WITH ERIC CHABROW

Forces Of Reform

Key players working to change the patent system

IBM Seeks community review of patent applications, abolition of businessmethod patents that don't include technical innovation, and increased transparency of patent ownership

U.S. Patent And Trademark Office Proposes limiting to 10 the number of times patent applicants can request a reexamination of their applications and the ' number of individual patent claims contained in any single application

Microsoft Wants international harmonization of patent law, a crackdown on questionable patent litigation, and the end of filing fees for small companies and individual inventors

Sens. Orrin Hatch, R-Utah, and Patrick Leahy, D-Vt. Sponsors of the Patent Reform Act of 2006, which would grant stronger protection to "first to file" patent holders, raise the bar for litigants who claim prior invention, and limit damage awards for patent holders

IBM Vs. Amazon

In dispute:

* An electronic requisition system that has catalogs of items offered by suppliers stored on a central catalog database system

* A system that includes a means of storing at least one link profile associated with a specific set of one or more users, which can be used to make recommendations

* A system that lets users request applications during a session with a group of servers

* A system in which the network presents the requested applications as one or more screens

* A method for storing and managing advertising on a Web server

Write to Paul McDougall at paulmcd@cmp.com

GRAPHIC: Illustrations
Photographs

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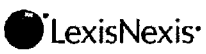

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HEADLINE: 41st World Intellectual Property Congress A Resounding Success;
Largest international meeting of patent lawyers discusses significant issues of harmonization of standards; IP issues in the environmental technology; comparisons of patent trial procedures; women in IP law; and others against the backdrop of Boston, a city of innovation

DATELINE: BOSTON

BODY:

The Association Internationale pour la Protection de la Propriété Intellectuelle (AIPPI), the oldest global intellectual property association, recently converged on Boston, MA for the 41stWorld Intellectual Property Congress for a resoundingly successful meeting.

The Congress, held in the United States for the first time in 33 years, attracted over 2,000 participants, including highly experienced and respected outside intellectual property counsel, corporate intellectual property counsel, academics and judges from around the world.

Participants from over 76 countries had the opportunity to learn the latest practice techniques, network with peers, and discuss many substantive and pressing issues facing IP lawyers today, from harmonization of standards to intellectual property issues in environmental technology and the role of women lawyers in the field.

"We were delighted to host the 41stWorld Congress in the U.S.," said Ronald Myrick (Finnegan, Henderson, Farabow, Garrett & Dunner, LLP; Cambridge, MA), President AIPPI. "Boston was a particularly appropriate venue for this meeting as the home of some of the world's premier universities and research institutions. The 2008 Congress merged the long and rich history of the international event with modern day technology to offer unprecedented access to up-to-the-minute information throughout the event."

Harmonization

A leading theme of the event was harmonization of intellectual property laws on a worldwide basis, so that companies operating globally would have one consistent set of rules to follow rather than having to keep track of disparate countries' IP standards. "This is of critical importance, as companies seek to compete globally, they are also protecting their intellectual property across the board," said Clark Lackert, President of AIPPI's United States Group (King & Spalding LLP, New York). "But the harmonization process is not easy, because it has to accommodate a wide range of viewpoints on how patent, trademark and copyright laws should be used to advance each country's economic and social goals. One of the themes that emerged from this most recent AIPPI World IP Congress is that, while all countries are seeking to implement the World Trade Organization agreement mandates to harmonize their intellectual property laws, in both statutory and enforcement areas, divergent results are occurring due to differences in local cultures, legal systems, and governments."

Environmental Technology: Corporate citizens can and should "do good" by their patents

In a workshop on intellectual property rights on environmental technologies, IBM, Nokia, and the World Business Council for Sustainable Development announced that severallarge corporations, including Bosch, DuPont, and Xerox

have joinedan initiative to pledgepatents that help the environment to the public domain. The initiative, called the Eco Patent Commons, launched in January 2008, originally included IBM, Nokia, Pitney Bowes and Sony. David J.Kappos, IBM's Vice President and Assistant General Counsel for IP Law and Strategy,explained that IBM had donated a patenton a packaging invention thatreplaced petroleum based Styrofoam with paper-based packaging material. Similarly, Donal O'Connell,Director of Intellectual Property forNokia in the United Kingdom, noted that Nokia has donated patents that cover the use of materials in discarded cell phones.

Cutting Edge Trial Techniques

Providing a look at trial techniques across five countries, the U.S., Japan, China, England and Germany, participants were treated to a mock trial concerning a patent on a hamburger with a hole for condiments. The results of the five trials were different, ranging from a jury verdict finding the patent infringed and valid in the United States trial, to a judgment of no infringement by the judge of the Shanghai, China High Court, to judgments of infringed and invalid in the Japan and England trials (with the losing side being ordered to pay costs to the winner in the England trial), and to a holding of infringement of an amended version of the patent in the German trial. Alan Smith (Fish & Richardson, P.C., Boston), Chair of the Program Committee for the Congress, said "This is the very first time a mock patent program was done on this scale, with five sitting judges from five leading jurisdictions, and lawyers from those countries conducting the trial under their respective legal system. The fact that the results were different shows that there is a great deal of strategy involved in selecting the forum to enforce your patents."

Women in IP

Over 200 women IP attorneys from all over the world attended a breakfast roundtable discussion. Speaker Jane Direnzo Pigott of R3 Group LLC in Chicago presented a detailed analysis of the progress of women in law. Ms. Pigott pointed out that 83% of partners in U.S. law firms are men; however, the number of women who serve as general counsel at Fortune 1000 companies is increasing significantly, and now stands at 20%. AIPPI United States Group President Elect Judy Saffer, Assistant General Counsel for BMI, Inc. in New York, initiated a motivating discussion encouraging women to network and cooperate with one another to increase the presence of women at all levels of law firms and industry.

Boston Perspectives

The Boston Organizing Committee, under the direction of Philip C. Swain (Foley Hoag LLP, Boston), developed a greatly expanded program of workshops, roundtable discussions, mock trials, panel discussions and unique social events, all designed to encourage learning, networking and interaction among the participants. "The Boston Congress offered a multi-faceted program designed to attract a wide spectrum of attendees with varied interests," said Swain. "From the enhanced program of workshops and roundtables to special events such as the "Women in IP Law" breakfast, attendees had a unique opportunity to meet with and learn from colleagues from around the world." The Boston Congress "also offered the intellectual property community an opportunity to attend special sessions with a timely message for all participants" said Swain. It included a panel discussion featuring the heads of the three main patent offices (European Patent Office; United States Patent and Trademark Office and the Japan Patent Office) and a judges' panel discussion featuring the top IP judges from seven major jurisdictions, who discussed topics of universal interest, such as the "inventive step" or "nonobviousness" requirement for patents. Attendees at the Boston Congress also enjoyed the opening ceremony at historic Faneuil Hall; an evening at the Boston Museum of Science; and a gala dinner with entertainment and dancing provided by the Boston Pops orchestra.

Destination Paris 2010

The 42nd World Intellectual Congress will be held in Paris, France on October 1-6, 2010. More information can be found at: www.aippi.org

About AIPPI

AIPPI is concerned with all types of intellectual property rights (including patents, trademarks, and copyrights). It is the oldest global intellectual property association, and has the respect and ear of governments and global organizations such as the World Intellectual Property Organization and the World Trade Organization. Since it was founded in 1897, AIPPI has been consulted (and still is) by decision makers worldwide on current intellectual property issues.

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SECTION: IP; Pg. 26

LENGTH: 1153 words

HEADLINE: Patent Giveaway;
Companies donate patents to promote ecologically friendly innovation

BYLINE: STEVEN SEIDENBERG

HIGHLIGHT:

QUICK READ

EPC collects patents with environmental benefits

Donors retain significant rights

Donations help the bottom line

BODY:

It's not the typical response to tough economic times. But last fall--as the stock market crashed, corporate profits plunged and the financial system teetered on collapse--Xerox, DuPont and Bosch gave away some valuable assets. And they didn't even get a tax deduction.

They may, however, be helping to save the world. These three companies joined IBM, Sony, Pitney Bowes and Nokia in donating some of their hard-earned patents to a new non-profit venture: the Eco-Patent Commons (EPC).

The EPC is a collection of donated patents, each of which offers a direct or indirect environmental benefit, such as energy conservation, recycling or pollution remediation. These patents are posted on a free, searchable Web site maintained by the World Business Council for Sustainable Development (www.wbcsd.org/web/epc/). The site makes it easy for anyone to find innovative green technology. And this patented technology can be used for free.

The goal is to promote innovation in ecologically friendly technologies, with businesses contributing patents, improving on one another's ideas and implementing green innovations without licensing hassles.

Companies that use donated patents can certainly benefit from the EPC. But donors--which retain significant rights in their donated inventions--can benefit, too. If they select the right patents to donate, donor businesses can get good PR, reduce their environmental impact and maybe even lower their own production costs. And, oh yes, create a healthier planet for everyone.

"In today's climate, it's a good business opportunity. It's win-win," says Joe Stulb, manager of environmental health and safety at Xerox, which has donated 22 patents to the EPC.

Interdisciplinary Innovation

Why bother with the EPC? The patent system--which grants exclusive rights to inventions--has been around a long time, and it's done a pretty good job of promoting innovation.

Green technology, however, isn't your typical branch of science.

"[It] is different from other fields in an important way," says Eric Lane, author of the Green Patent Blog and an associate at Luce, Forward, Hamilton & Scripps. "It is interdisciplinary and covers such a wide variety of technology--from biotech to business methods, from material science to physics, from mechanical engineering (wind power) to photovoltaics, geology (geothermal) and ocean science (tidal power)--that it creates some unique challenges."

Because the technologies are so varied, it's hard for companies to stay current with the panoply of green innovations--much less determine appropriate licensing terms.

"In a more discrete area, like pharmaceuticals or biotechnology, patent pools and patent licensing can be pretty effective, but where so many different areas are involved, there may not be the same kind of knowledge or familiarity with different fields," Lane says. "So the [EPC] serves a useful purpose of promoting interdisciplinary technology. It lets companies experiment."

Retained Rights

Many patents for green technology will never be donated to the EPC, and that's fine with EPC's backers. They expect businesses will hang on to patents that generate significant revenue.

Often, however, companies own green patents that they don't use, sell or license. "If we won't commercialize it, and it's within EPC guidelines, that makes it a really good candidate for donating to the Commons," says Julie Rakestraw, business manager at DuPont Central Research & Development.

Companies could even donate patents that they are monetizing, because donors to the EPC keep important rights in their donated patents.

"The EPC has a nice feature: It only applies to the ecological uses of patents that are donated," says **Dave Kappos,** IBM's vice president of Intellectual Property and Licensing. "Some inventions that have been donated have mainline uses, not just ecological uses. A donor can continue to have exclusive use of the patent for non-ecological purposes and still get the benefit of donating it. It's one of those rare times when you can have your cake and eat it too."

Donors also retain the right to assert their donated patents against anyone who sues them for infringement. So if a plaintiff uses a donated IBM patent in its green technology and subsequently files any patent infringement suit against IBM, Big Blue could countersue for infringing the donated patent.

There's a restriction, however, if both plaintiff and defendant have donated patents to the EPC. If the plaintiff in such an infringement action sues on a patent that has nothing to do with green technology--that falls *outside* the EPC's categories of green technology--the defendant cannot countersue the plaintiff for infringing a patent the defendant donated to the EPC. If the plaintiff is suing on a patent that falls *within* any of the EPC's categories of green technology, on the other hand, the defendant can countersue.

Bottom Line Benefits

Donating a patent to the EPC can be good for a company's bottom line by helping to lower costs for producing or disposing of its products. Consider, for instance, a patent that IBM donated last year.

IBM discovered a way to use cardboard packaging to protect sensitive semiconductor components while in transit. The packaging worked better than Styrofoam peanuts and was better for the environment.

IBM didn't want to exploit the patent itself because the company was not in the packaging business. And after some analysis, the company concluded it would be more profitable to donate the patent than to license it.

They reasoned that if packaging companies had to license the technology they would have to pay royalties, plus there would be significant transaction costs involved in obtaining the license. By giving the patent away, IBM makes it possible for the makers of cardboard containers to use the technology without this additional expense, thereby reducing the cost of the packaging IBM purchases.

"We are a consumer of this [packaging]," Kappos says. "By putting the patent in the Eco-Patent Commons, we are helping to drive down the manufacturing cost of this packaging, decreasing the cost to consumers. The money we would get from licensing the patent ... would be less than the amount we would save through lower consumer costs. And it's better for the environment."

The EPC has been in operation for little more than one year. So far seven companies have donated a total of 85 patents. Experts say it's not a bad start. "If you measure success by the number of donated patents, I would call it a moderate success," Lane says.

In the end, however, the EPC's success may depend not on the quantity of donated patents, but on their quality. "If the EPC receives fundamental patents on some technology that needs to be widely adopted, there is value here," says Barton Showalter, a partner at Baker Botts. "If everyone is just throwing in patents that are not particularly valuable or broad, [the EPC] may not be worthwhile."

GRAPHIC: Picture, no caption

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October 14, 2008

SECTION: EDITOR'S CHOICE; Pg. 11

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HEADLINE: AIPPI;
41st World Intellectual Property Congress A Resounding Success

BODY:

The Association Internationale pour la Protection de la Propriete Intellectuelle (AIPPI), the oldest global intellectual property association, recently converged on Boston, MA for the 41st World Intellectual Property Congress for a resoundingly successful meeting.

The Congress, held in the United States for the first time in 33 years, attracted over 2,000 participants, including highly experienced and respected outside intellectual property counsel, corporate intellectual property counsel, academics and judges from around the world.

Participants from over 76 countries had the opportunity to learn the latest practice techniques, network with peers, and discuss many substantive and pressing issues facing IP lawyers today, from harmonization of standards to intellectual property issues in environmental technology and the role of women lawyers in the field.

"We were delighted to host the 41st World Congress in the U.S.," said Ronald Myrick (Finnegan, Henderson, Farabow, Garrett & Dunner, LLP; Cambridge, MA), President AIPPI. "Boston was a particularly appropriate venue for this meeting as the home of some of the world's premier universities and research institutions. The 2008 Congress merged the long and rich history of the international event with modern day technology to offer unprecedented access to up-to-the-minute information throughout the event."

Harmonization

A leading theme of the event was harmonization of intellectual property laws on a worldwide basis, so that companies operating globally would have one consistent set of rules to follow rather than having to keep track of disparate countries' IP standards. "This is of critical importance, as companies seek to compete globally, they are also protecting their intellectual property across the board," said Clark Lackert, President of AIPPI's United States Group (King & Spalding LLP, New York). "But the harmonization process is not easy, because it has to accommodate a wide range of viewpoints on how patent, trademark and copyright laws should be used to advance each country's economic and social goals. One of the themes that emerged from this most recent AIPPI World IP Congress is that, while all countries are seeking to implement the World Trade Organization agreement mandates to harmonize their intellectual property laws, in both statutory and enforcement areas, divergent results are occurring due to differences in local cultures, legal systems, and governments."

Environmental Technology: Corporate citizens can and should "do good" by their patents

In a workshop on intellectual property rights on environmental technologies, IBM, Nokia, and the World Business Council for Sustainable Development announced that several large corporations, including Bosch, DuPont, and Xerox have joined an initiative to pledge patents that help the environment to the public domain. The initiative, called the Eco Patent Commons, launched in January 2008, originally included IBM, Nokia, Pitney Bowes and Sony. David J. Kappos, IBM's Vice President and Assistant General Counsel for IP Law and Strategy, explained that IBM had donated a

patent on a packaging invention that replaced petroleum based Styrofoam with paper-based packaging material. Similarly, Donal O'Connell, Director of Intellectual Property for Nokia in the United Kingdom, noted that Nokia has donated patents that cover the use of materials in discarded cell phones.

Cutting Edge Trial Techniques

Providing a look at trial techniques across five countries, the U.S., Japan, China, England and Germany, participants were treated to a mock trial concerning a patent on a hamburger with a hole for condiments. The results of the five trials were different, ranging from a jury verdict finding the patent infringed and valid in the United States trial, to a judgment of no infringement by the judge of the Shanghai, China High Court, to judgments of infringed and invalid in the Japan and England trials (with the losing side being ordered to pay costs to the winner in the England trial), and to a holding of infringement of an amended version of the patent in the German trial. Alan Smith (Fish & Richardson, P.C., Boston), Chair of the Program Committee for the Congress, said "This is the very first time a mock patent program was done on this scale, with five sitting judges from five leading jurisdictions, and lawyers from those countries conducting the trial under their respective legal system. The fact that the results were different shows that there is a great deal of strategy involved in selecting the forum to enforce your patents."

Women in IP

Over 200 women IP attorneys from all over the world attended a breakfast roundtable discussion. Speaker Jane Direnzo Pigott of R3 Group LLC in Chicago presented a detailed analysis of the progress of women in law. Ms. Pigott pointed out that 83% of partners in U.S. law firms are men; however, the number of women who serve as general counsel at Fortune 1000 companies is increasing significantly, and now stands at 20%. AIPPI United States Group President Elect Judy Saffer, Assistant General Counsel for BMI, Inc. in New York, initiated a motivating discussion encouraging women to network and cooperate with one another to increase the presence of women at all levels of law firms and industry.

Boston Perspectives

The Boston Organizing Committee, under the direction of Philip C. Swain (Foley Hoag LLP, Boston), developed a greatly expanded program of workshops, roundtable discussions, mock trials, panel discussions and unique social events, all designed to encourage learning, networking and interaction among the participants. "The Boston Congress offered a multi-faceted program designed to attract a wide spectrum of attendees with varied interests," said Swain. "From the enhanced program of workshops and roundtables to special events such as the "Women in IP Law" breakfast, attendees had a unique opportunity to meet with and learn from colleagues from around the world." The Boston Congress "also offered the intellectual property community an opportunity to attend special sessions with a timely message for all participants" said Swain. It included a panel discussion featuring the heads of the three main patent offices (European Patent Office; United States Patent and Trademark Office and the Japan Patent Office) and a judges' panel discussion featuring the top IP judges from seven major jurisdictions, who discussed topics of universal interest, such as the "inventive step" or "nonobviousness" requirement for patents. Attendees at the Boston Congress also enjoyed the opening ceremony at historic Faneuil Hall; an evening at the Boston Museum of Science; and a gala dinner with entertainment and dancing provided by the Boston Pops orchestra.

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HEADLINE: WIKIS for Reference, Enthusiasts, and Government Information

BYLINE: Bell, Suzanne

BODY:

Looking at wikis from a content perspective rather than a purely technological one, in this issue the author explores wikis created for basic reference, for enthusiasts, and for government information. The wiki format seems to help serve the purposes of the sites' creators. But they have heard all the objections to Wikipedia, and they are trying to fight that stigma. The Psychology Wiki turned up in the list of the largest Wikia wikis. Moving to the other end of the spectrum from the reference collection are information sources created by enthusiasts. Here, credibility and trustworthiness draw more from "the wisdom of the crowds" than from established academic credentials. This group of sites includes the sorts of topics you would expect to have engendered wikis, as they are quintessentially "by practitioners, for practitioners." Meanwhile, many of the government wikis are not publicly accessible. Other government wikis have been reported on.

FULL TEXT:

In the last issue of ONLINE, I investigated using wikis to research health topics and community information ("Wikis as Legitimate Research Sources," November/December 2008, pp. 34-37). I found that wikis can contain much valuable data, although some basic evaluative techniques should be applied when deciding to incorporate them into your research toolkit.

Again, looking at wikis from a content perspective rather than a purely technological one, in this issue I'm exploring wikis created for basic reference, for enthusiasts, and for government information.

REFERENCE WIKIS

I've dubbed this group of wiki sites "reference wikis" because they remind me of items one might find in a library's reference collection, by topic and by their very strong emphasis on authority and credibility. The wiki format seems to help serve the purposes of the sites' creators. But they have heard all the objections to Wikipedia, and they are trying to fight that stigma.

The Psychology Wiki (http://psychology.wikia.com/wiki/main_page) turned up in the list of the largest Wikia wikis. As described on its homepage, it is intended to be "A resource for psychologists with over 22,980 articles." The Psychology Wiki was set up in January 2006 by Dr. Ioe Kiff, a clinical psychologist in the West Midlands (U.K.) who found himself "some 10 miles from a university library" when he needed "to review the literature" on a topic in psychology.

From that simple inspiration, the Psychology Wiki has grown to a resource with close to 23,000 articles (as of August 2008). It received 660,955 page views in its first year of operation. It appears to have about 100 registered users, and things here are yeasty, as indicated by the "recent changes" page: In this wiki, it's not necessary to expand the default time span (which is 7 days) in order to see a list of the 50 most recent changes; there has been plenty of recent activity. Some areas, such as the Upcoming Conferences section, still seem to be nascent - there's not a whole lot there yet, but it is an excellent idea; a perfect category for a wiki. There is a lot of emphasis on tiustworthiness: The site is certified by the Health on the Net Foundation, and it bears the HONcode logo. The explanations for the site's rationale, aim, and funding are very earnest.

It seems like a trustworthy resource with good intentions and an appropriate guiding spirit. It would be interesting to test it head-to-head against a commercially published, online psychology encyclopedia.

TRUSTING THOMAS JEFFERSON

The Thomas Jefferson Encyclopedia (http://wiki.monticello.org) has been created on a wiki platform by the Thomas Jefferson Foundation. To safeguard the credibility of the information, like Elsevier's WiserWiki, this is not an entirely "open" wiki, as described on its bomepage:

Trustworthy information on Thomas Jefferson and his world by Monticello researchers and respected Jefferson scholars. Only Thomas Jefferson Encyclopedia community scholars can write and edit articles; however, public users are encouraged to submit commcnts on the discussion pages.

The desire to offer the site as an "authoritative online resource" is reiterated in the About page - this is obviously very important to the site's creators.

In looking around the Thomas Jefferson Encyclopedia wiki, a couple of intriguing aspects caught my eye. At the bottom of the homepage, the categories are presented as a tag cloud, giving a sense of the quantity of material assigned to the various topics. In the articles, footnotes can offer links to other sites, for example, to view digital images of original documents at the Library of Congress. It is an actively cared for and actively used site: The Recent changes page shows daily activity; the list of the 50 most Popular pages ranges from a high of close to 40,000 views for the homepage to a still-respectable 1,768 views for Wine. When I'm not that familiar with a subject, I find these lists of "popular" pages informative, in the sense that they reveal the content that people who (presumably) know what they're looking for actually look at.

Again, this seems to be a resource I can trust, and I would not hesitate to use it with patrons, just as I would a printed or commercially published encyclopedia-type work on Thomas Jefferson.

THE ENCYCLOPEDIA OF EARTH

There is one more resource I couldn't resist including, even though you may already be aware of it from the fine review that appeared in the August 2007 issue of D-Lib Magazine. The resource is called the Encyclopedia of Earth (EoE; www.eoearth.org). The EoE appears to be thriving and progressing toward its goal of becoming "the largest reliable information resource on the environment in history," which is freely available on the web. The emphasis on trustworthiness (and on distinguishing the EoE from Wikipedia) turns up repeatedly, from the word "credibility" in the site's subtitle to many of the entries in the FAQ. Experts and "content partners" write material, which goes through a review process. The project is supported by prestigious and respected institutions such as the National Council for Science and the Environment (NCSE) and the Center for Energy and Environmental Studies at Boston University, where the ultimate editing, compilation, and content control takes place.

As one would expect, the encyclopedia is keyword searchable and browseable by entry title, author, topic, and collection. Browsing by topic or collection would be an excellent way for a student to find an inspiring topic for a paper. And the EoE is ready to be referenced: Each page includes a Cite link that, when clicked, jumps to the bottom of the page where a full citation appears, ready to be copied and pasted into a bibliography.

ENTHUSIAST WIKIS

Moving to the other end of the spectrum from the reference collection are information sources created by enthusiasts. Here, credibility and trustworthiness draw more from "the wisdom of the crowds" than from established academic credentials. This group of sites includes the sorts of topics you would expect to have engendered wikis, as they are quintessentially "by practitioners, for practitioners." These sites are delightfully active, interesting, and, one presumes, helpful to those who care about the topic. Here's a quick selection.

The Bike Collective Wiki (www.bike collectives.org/wiki), a MediaWiki site, "is here to help bike collectives collaborate and share ideas. Whether you are an advocate, mechanic, or just someone who likes to ride - anyone can freely edit the content of this site." This is a healthy wiki. In the list of the 50 most popular pages, the number of views ranges from a high of nearly 12,000 views (for Community Bicycle Organizations) down to a still-respectable 638 views (for Shop Recycling), and people are editing as well as viewing. When I visited the site, two of the Hot Topics featured on the homepage were a List of Projects Shipping Bikes to Developing Countries and the Bike Collective Starter Kit, to show you how to start your own bike collective.

Seeing all the superheroes starring in this summer's blockbuster movies might make you want to consult the Marvel Database Project (http://en.marveldatabase.com/Main_Page), which includes 25,000-plus articles on Marvel comics and characters, or the DC Database Project (http://en.dcdatabaseproject.com/Main_Page), which includes 18,000-plus articles on DC comics and characters.

For school or community theater projects, Halloween, or just for a trip down memory lane (for those of you of a "certain age"), you might want to consult the Vintage Sewing Patterns Wiki (http://vintagepatterns.wikia.com). Here you can search (Peter Pan collars, anyone?) or browse categories such as Patterns by Decade (1920s to 1970s), Patterns by the Garment (blouses to bathing suits), Patterns by Pattern Company (Advance to Vogue), and Other fun categories, which includes Amusing Illustrations (my favorite is Vogue 7232). This wiki of more than 10,000 articles on out-of-print, pre1980 patterns is very active - when I visited, the latest activity was something edited "1 minute ago."

In addition to biking, reading comics, and sewing, other things you might enjoy doing in your time off are enjoying a nice glass of wine or beer, singing with friends, or traveling. In each case, there's a wiki to learn from or to share your knowledge. Depending on your interest, check out EncycloWine.org, the Beer WiM (http://beer.wikia.com), the Choral Public Domain Library (www.choralwiki.org), or Wikitravel.org. You may already know about the last two: Robert Terrio wrote an excellent, thorough review of ChoralWiki in the June 1, 2008, Notes: Quarterly Journal of the Music Library Association, and Wikitravel was No. 1 in Daniela Faris' 2007 blog post, "10 of the Best, Most Interesting Wiki Communities," on iCommons.org.

Finally, I'll mention one more of the largest Wikia wiMs, on the perennially hot topic of genealogy: "Familypedia" (http://genealogy.wiMa.com/wiki/Main_Page). This wiki, which is part of the WiMa hobbies series, has more than 22,500 articles, thousands of view counts, about 200 active users, edits within the last hour, and a really spiffy logo.

U.S. GOVERNMENT WIKIS

Now let's turn to the wiM applications that I found so intriguing, because they seem to represent the biggest "stretch" for their creators - wikis being used by the U.S. government. But when researching this area, I ran into an immediate roadblock: Many of the government wikis are not publicly accessible. Take the wiM that first inspired this article: Wiki - Afghan. From a Wall Street Journal article titled "In Afghanistan, Getting to Know the Neighbors Is Half the Battle," we learn that this wiM "looks just like Wikipedia, except it's all about Afghanistan and much of it is classified." The Army is using it to capture, store, and pass along sociological information about the local people (the "Neighbors" of the article title) that is vital to understanding relationships and key to the success of their mission in the country. Authorized servicemen can add and edit entries . . . but we can't go see it; the URL isn't given, and I had no luck trying to locate it.

The article obviously caught more than my attention, however. In Google search results, I found the article reposted at a number of sites (one wonders if Dow Jones is aware of that) and mentioned by many bloggers, including David Randall, a lawyer who teaches at Boston University's School of Management. As he says, "returning troops have developed a wealth of knowledge that incoming troops can use to minimize repetition of mistakes and improve the chances of their mission's success. A wiM is perfect for capturing and refining that Miowledge" (http://trudalane.net/2008/07/18/deploying-wikis). It's frustrating that we can't see it, but it is still very interesting to see the U.S. Army making astute use of an appropriate technology.

Other government wikis have also been reported on. In The Wall Street Journal (Information Age, "From WiMnomics to Government 2.0," May 12, 2008), L. Gordon Crovitz describes Intellipedia, which is used by U.S. intelligence agencies such as the CIA and the FBI; and Diplopedia, which is used by State Department staffers to share "sensitive but unclassified" information. But we can't visit either one. They're restricted to government employees.

In a follow-up letter to the editor, we hear the voice of an actual user within the government, and it is very positive indeed. Marcus C. Peacock, the deputy administrator of the U.S. Environmental Protection Agency, sings the praises of a blog he set up and the incredible efficiency provided by a wiM (http://pugetsound.epageo.org) that was used to collect

environmental information on the Puget Sound area. What would have taken weeks to collect was amassed in just days. His is the voice of a man utterly convinced of the usefulness of Web 2.0 technologies.

USPTO WIKI

In my research, however, I did find one wiki related to a government agency that is publicly accessible. The U.S. Patent and Trademark Office (USPTO), recognizing that something needed to be done to help with the backlog of patent reviews, worked with New York Law School (NYLS) to set up a "peerreviewed prior art pilot." The result was the Peer-to-Patent Project, a wiM developed by a software development unit known as the "Do Tank" at NYLS and launched in June 2007. (The USPTO spends a whole paragraph in its initial press release about the pilot, emphasizing that Peer-to-Patent is not in any way, shape, or form an "Office" website or agent. But it is definitely helping the USPTO, so I am including it as a "government" wiki.)

Peer-to-Patent (www.peertopatent.org) was established to test the idea of having experts in the community help in the patent review process by researching, providing, and discussing the "prior art" evidence provided with new patent applications. The pilot was restricted to patents in one area: Computer Architecture, Software and Information Security. Did it work? In a word, yes.

At the Peer to Patent Project: Community Patent Review website at NYLS (http://dotank.nyls.edu/communitypatent), statistics and descriptive materials attest to the success of the project. As of May 11, 2008, Peer-to-Patent had received the following:

* Page Views: 252,260

* Unique Visitors: 43,456

* Countries/Territories: 136

* Registered Users: 2,040

* User Submitted Prior Art References: 183

* Total Applications: 56

The scope of the project has been renewed to run for another year (to June 2009) and expanded to include another class of patents (Data Processing: Financial, Business Practice, Management, or Cost/Price Determination). In its 54-page "First Anniversary" report, the pilot is heralded as a great success, including remarks by **David Kappos,** vice president and assistant general counsel at IBM, that appeared in The Washington Post: "For the first time in history [peer patent review] allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts."

The interface to this wiki has some elegant aspects: As you mouse over the patent application titles, a pop-up box appears with the basic information about the patent: filing date, inventor's name, assignee name, USPTO classification, and an abstract of the patent. The list of Archived Applications is fascinating as a window into how the wiki approach is working for this process. The number of community members who were active in the project is indicated both with a number and a colored dot, sized according to the number of participants, allowing you to see the most "popular" projects. Discussion and Prior Art are similarly presented both numerically and with a visual chart of participation/ activity. Unfortunately, the bar charts (which show the "number of items per week for each of the sixteen weeks") don't open to provide more detailed information; that is, you can't find out that all the activity happened in exactly the 15th week of the process, but you certainly get an overall sense when activity happened and how much of it there was. (Many of the lines look very flat to me, I have to admit. These visuals belie the success of the site.) There are currently 12 videos available on the site, explaining the peer-to-patent process and other aspects of intellectual property and patent law.

The reason technologies such as wiMs or blogs represent such a change in governmental modus operandi is noted in the Crovitz article men- tioned earlier; they are a radical departure from "the traditional notion that 'all published infor- mation produced by a government agency be "accurate," ' and that 'any material a federal em- ployee publishes can be taken as establishing or implying the establish- ment of formal policy' " One applauds the gov- ernment for taking the plunge, being willing to recognize that such new techniques really work, and continuing to use them.

DEFINITELY NOT A GOVERNMENT SITE

Having considered government authorized sites, it seems only right to note a site from the far opposite end of the spectrum. My example here is a site called Wikileaks (http://wikileaks.org). As noted in "Calling All Deep Throats" in the Information Management Journal of March/April 2007, WiMleaks "has been launched to provide an outlet for individuals worldwide to anonymously leak confidential government information.... The bigger goal [of the site] is to promote democracy and stop corruption, particularly in oppressive foreign regimes. But visitors also can expose unethical behavior in democratic governments as well as in corporations."

Despite repeated attempts to shut it down, WiMleaks seems to be alive and well. Available in 14 languages, including English, it offers a Live Chat feature, a Media Kit and a Writer's Kit (not common elements in the wiMs I've looked at so far), and one of the longest About pages you're likely to find on a wiki -not surprising given the serious and controversial nature of its content.

WHY THIS IS IMPORTANT

So ends our tour through some groups of wikis - what does it all mean? We've seen some interesting, useful, and simply fun sites. We've seen some emerging trends, such as the use of the wiki format, while redefining the wiki functionality of "anyone can edit" in order to safeguard the credibility of the site. In the city wikis and "enthusiast" sites that retain the open editing facility, we've seen some very successful, actively used, and cared for sites that are obviously fulfilling their purpose. We've seen the U.S. Government breaking out of its comfort zone, using a technology that goes against some deeprooted, traditional values but fulfills a need so well that it can't be rejected.

From the reference sites to Wikileaks, there is a huge emphasis on credibility, the earnestness of devoted experts working in support of a cause. We have sites edited only by experts, as we traditionally define them, and other sites edited by individuals who are equally expert by dint of interest or experience.

To me, it all represents the infiltration of such sources into the realm of reliable, legitimate information sources (usually dominated by commercial or association publishers). They may not all be "peer reviewed," but for most of the wikis I've mentioned, they are written by experts on their related topics. They are very much communities of practice, written by practitioners for practitioners. And as such, I'm ready to let wiMs into my arsenal of research tools.

GRAPHIC: Illustrations

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The New Zealand Herald

September 16, 2008 Tuesday

SECTION: TECHNOLOGY; General

LENGTH: 1402 words

HEADLINE: Crowdsourcing could improve 'broken' patent system

BODY:

WASHINGTON - Some of the biggest players in the technology industry complain that the US patent system is broken - putting too many patents of dubious merit in the hands of people who can use them to drag companies and other inventors to court.

And Blaise Mouttet, a small inventor in Alexandria, Virginia, says he knows why. The problem, he said, is that "there are too many lawyers and not enough inventors involved with the patent system."

So Mouttet is taking part in an experimental program launched in June 2007 with the US Patent and Trademark Office and backed by the technology industry that is intended to give the public - including inventors - more of a voice in the system.

The concept behind the program, called Peer-to-Patent, is straightforward: Publish patent applications on the web for all to see and let anyone with relevant expertise - academics, colleagues, even potential rivals - offer input to be passed along to the Patent Office.

By using the power of the internet to tap the wisdom of the masses, Peer-to-Patent aims to dig up hard-to-find "prior art" - evidence that an invention already exists or is obvious and therefore doesn't deserve a patent.

The goal is to locate prior art that Patent Office examiners might not find on their own - and to produce better patents by reducing ones granted on applications that aren't novel. The hope is that this will drive innovation by improving the patent process and reducing the patent infringement lawsuits clogging the courts.

"The Patent and Trademark Office is the agency of citizen creativity, and it needs more and better information to do its job of awarding patents to those citizens who are truly the most creative," said New York Law School professor Beth Noveck, who came up with the idea for Peer-to-Patent while teaching a patent law class. "A patent is a pretty significant monopoly, so we want to make sure we are giving it to the right people."

Peer-to-Patent has attracted financial support from a cross-section of the technology sector and foundations and is in its second pilot year. In the first year, the voluntary program focused on software, computer and information security patents - drawing applications from industry heavyweights such as International Business Machines, Hewlett-Packard, Microsoft Corp, General Electric and open source software pioneer Red Hat, as well as small inventors like Mouttet.

Mouttet, a former Patent Office examiner and now a graduate student in electrical engineering, submitted an application on electronic uses of nanomaterials. Although the Patent Office has rejected his claim - in part because of prior art unearthed through Peer-to-Patent - he is appealing the decision and optimistic he will eventually get his patent. And he is confident it will be stronger for having gone through the process.

But it is the big technology companies that have the highest hopes for Peer-to-Patent since they are some of the most vocal critics of the existing system.

They warn that the Patent Office has been overwhelmed by a sharp increase in patent applications in recent years, particularly in computing. The agency has more than 5,800 examiners with specialised expertise in a range of areas, but they are sifting through a mountain of applications: 467,243 were submitted in fiscal 2007, up from 237,045 in fiscal 1997 and 137,173 in fiscal 1987.

As a result, said **Dave Kappos,** vice president of intellectual property law for IBM, it is taking big technology companies with huge patent portfolios longer and longer to get applications through the system. The Patent Office had a backlog of nearly 761,000 applications at the end of fiscal 2007, with applicants waiting an average of two years and eight months for a final decision.

That is tough for an industry built on rapid innovation, short product life cycles and technology that can become quickly outdated, Noveck said. Indeed, a key benefit of participating in the Peer-to-Patent program is the promise of an expedited review, with a preliminary Patent Office decision in as few as seven months.

Backlog is only part of the problem, however. Poor patent quality is just as big a concern.

There are plenty of examples of controversial patents in different industries, such as the one awarded to Amazon.com Inc. for its "1-click" online shopping feature or the one granted to J.M. Smucker Co. for a crustless peanut-butter-and-jelly sandwich.

But some of the most contentious patents have come out of the tech sector since software and other-cutting edge technologies are relatively new to the Patent Office and evolving quickly, explained Mark Webbink, director of New York Law School's Center for Patent Innovations, home to Peer-to-Patent, and former general counsel for Red Hat. That means that patent examiners don't have long-established databases of existing inventions to consult in reviewing these applications.

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The result of substandard patents, tech companies say, has been a sharp increase in costly infringement lawsuits that eat up valuable resources and threaten to keep innovative products off the market. According to James Bessen and Michael J. Meurer of Boston University School of Law, 2,830 patent lawsuits were filed in US district courts in 2006, up from 1,840 in 1996 and 1,129 in 1986.

Technology companies are particularly vulnerable to infringement litigation since their products can contain hundreds, if not thousands, of linked patented components critical to their basic operation. In one closely watched case, a protracted legal battle nearly forced the shutdown of the popular BlackBerry wireless email service.

The BlackBerry has in fact become a rallying cry for technology lobbyists pressing Congress to overhaul the patent system. Among other things, the industry wants to streamline the patent approval process and limit damages and injunctions awarded to patent holders who win infringement cases. But with those proposals stalled in the Senate, Peer-to-Patent offers another way to improve the system, said Curtis Rose, director of patents for Hewlett-Packard.

Not everyone is sold on the concept of Peer-to-Patent. Stephen Key, an inventor in California who has patented everything from toys to container labels, worries that the program requires applicants to put their ideas out there on the web for anyone to see - and potentially steal.

Boston University's Meurer also questions how effective Peer-to-Patent will be since he believes the real factor driving the increase in patent litigation is not a lack of prior art, but rather the vague, overly broad scope of too many patent claims today.

"Applicants come in and ask for the sun, moon and stars and they say: 'Let the Patent Office tell me what is and isn't patentable,'" said John Doll, US Commissioner for Patents. "It's a burden on the system."

Indeed, said Stanford Law School professor Mark Lemley, the challenge facing the Patent Office is to find a balance between awarding patents in order to encourage innovation without making it too easy to obtain a patent that can be used to abuse the system.

Noveck believes Peer-to-Patent will help strike that balance. The Patent Office reports that it has issued preliminary decisions on 40 of the 74 applications that have come through the program so far. Of those, six cited prior art submitted only through Peer-to-Patent, while another eight cited art found by both the examiner and peer reviewers.

Crowdsourcing could improve 'broken' patent system The New Zealand Herald September 16, 2008 Tuesday

The question now is whether the program can be scaled to review hundreds or even thousands of applications that extend far beyond the technology arena. So in its second year, Peer-to-Patent is being expanded to include claims covering electronic commerce and so-called "business methods," a controversial category of patents vital to the financial services sector.

Goldman Sachs Group, for one, is submitting a number of applications, including one for an equities trading platform used to raise capital without a public offering. John Squires, Goldman's chief intellectual property counsel, has high hopes for the program.

"This is a way to harness the wisdom of the crowds," Squires said. "Why should the Patent Office have to operate without the benefit of all the information on the horizon?"

- AP

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The Associated Press

September 15, 2008 Monday

SECTION: BUSINESS NEWS

LENGTH: 1401 words

HEADLINE: Program turns to online masses to improve patents

BYLINE: By JOELLE TESSLER, AP Technology Writer

DATELINE: WASHINGTON

BODY:

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Intellectual Property Today

November 2008

SECTION: DEPARTMENTS; Pg. 24

LENGTH: 2019 words

HEADLINE: LITIGATORS CORNER: Peer to Patent Review: Will it Work?

BYLINE: JOSEPH N. HOSTENY, OF NIRO, SCAVONE, HALLER & NIRO .

Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney with the Chicago law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at jhosteny@ hosteny.com, or by visiting his web site at http://www.hosteny.com.

BODY:

In his new book, *Crowdsourcing, Wired* editor Jeff Howe describes the advances achieved by loosely collaborative work that is performed by a number of contributing individuals. His first example is a very good one: Linux, the open-source operating system. Mr. Howe describes Linus Torvalds' decision to develop Linux as a free operating system, with thousands of people contributing to it. Linux is now a widely popular operating system which, Howe says, is used in "everything from supercomputers to digital video recorders such as TiVo, to say nothing of the millions of personal computers that run Linux."

Crowdsourcing says:

What makes open source so efficient? In the broadest of strokes it's the ability of a large number of people to contribute. The open source evangelist Eric S. Raymond famously summed up this fundamental truth when he wrote that "Given enough eyeballs, all bugs are shallow" -- which is to say that no problem is too thorny if enough people take a crack at it. Put another way, a large and diverse labor pool will consistently come up with better solutions than the most talented, specialized workforce.

Crowdsourcing then applies this same rationale to patent applications, but unfortunately succumbs to a few canards and misconceptions along the way. For example, Howe says that the PTO only accepted computer science as an appropriate background for an examiner as of 2005. My recollection is that the PTO began hiring examiners with computer science backgrounds in 1994. The Commissioner of Patents stated at a conference in 1994: "Toward this end, we have just changed our standards so that we will hire for the first time computer scientists as examiners." n1

1

Opening remarks of Bruce Lehman at the Public Hearing on Use of the Patent System to Protect Software-Related Inventions, February 10-11, 1994, posted at http://www.uspto.gov/web/offices/com/hearings/software/arlington/va_intro.html.

Second, the book suggests that some examining groups are prohibited from looking at the Internet. This is inconsistent with what I have seen, and with at least some statements by the PTO that say that "an electronic publication, includ-

ing an on-line database or Internet publication, is considered to be a 'printed publication' within the meaning of 35 U.S.C. § 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates." n2

2

See, for example, "When is an Electronic Document a Printed Publication for Prior Art Purposes?", a presentation to the AIPLA in 2002. The article is posted at http://www.uspto.gov/web/menu/pbmethod/aiplafall02paper.htm.

Third, *Crowdsourcing* is obviously relying on the inaccurate, second-hand, and rather hysterical media reaction to the *NTP* case, when it states that "NTP threatened to send executives around the world scrambling for pay phones when its suit against Research in Motion (RIM), the maker of the ubiquitous Blackbeery, nearly shut the service down." The real nature of the case is described in several of my columns: "Patent Trolls - Or Not?" (February, 2006), "Is IBM a Patent Troll?" (May, 2006), "Hysteria Lane" (July, 2006) and "People in Glass Houses" (February, 2008). The only reason RIM even approached an injunction was because it ignored the district judge's advice. Mr. Howe might consider studying the NTP inventors, Tom Campana, Michael Ponschke and Gary Thelen. I wish, again and again, that members of the media would spend some time learning about real inventors and their struggles.

I am not sure *Crowdsourcing* appreciates the right a patent grants. In commenting on the number of IBM's lawsuits, the author says that IBM owns twenty-six thousand patents and that the manager of IBM's patent portfolio therefore has "twenty-six thousand targets for rapacious, frivolous, skull-crushingly complex lawsuits." But patents do not grant any positive rights; they only grant the right to exclude. Nor does the existence of a patent mean that its owner is necessarily practicing the invention. Most universities, and companies like IBM, license but do not make or sell the subject matter of many of their patents. Thus, *Crowdsourcing* is incorrect if it means to suggest that every patent that has been issued is a target for a lawsuit. Patents aren't sued; infringers are.

Crowdsourcing relates how **David Kappos,** an attorney from IBM, and Beth Noveck, a professor at New York Law School, proposed extending the review of patent applications to the public, by posting applications on a website. Any interested person would then be able to comment. The result is the online Peer to Patent Project, developed by the Community Patent Review Project of the Institute for Information Law and Policy at New York Law School. n3 Supposedly thirty-three thousand people so far have submitted 192 prior art references on twenty-five patent applications. At present, it is a pilot project which has been extended for another year.

3

See http://www.uspto.gov/web/patents/peerpriorartpilot.

The focus of the project is certainly on the correct point in the process -- i.e., during the original application, so that the job can be done right in the first place. The problem with all the reforms proposed by the Patent Reform Act thus far is that they do not attack the problem at its root, in the original application process, where it can most readily be resolved. Instead, lobbyists (they may call themselves reformers) want things like post-grant oppositions, which cannot work for the reasons I have written about before, in my columns, "Post-Grant Opposition: Building on Sand" (August, 2004) and "What Now? Post-Grant Oppositions and the Proposed Budget" (March, 2005). The Peer to Patent Project rightly aims its work at the original application. Post-grant oppositions are efforts to repair a mistake, not prevent it in the first place.

The Peer to Patent Project does have some very promising features. For instance, only the ten best references are forwarded to an examiner. One of the problems in modern applications is the blizzard of references submitted by prosecuting attorneys, who feel they must pass the buck to the examiner for fear of being accused of inequitable conduct. Peer to Patent seems to recognize that a limited number of references is generally enough to show what the prior art is. As a submitter, you are not required to use your true name. I can't say I am crazy about this feature, nor am I a fan of other forms of online anonymity. (See "The Cowardice of Anonymous Bloggers," March, 2008.)

The Peer to Patent website has some teaching aids. n4 The tutorial actually says to read the patent application -- a refreshing suggestion. There is a short description of what a claim is. It says that the specification doesn't control the scope of the claims, but then recognizes that the specification can indeed influence the scope of the claims. This uncertainty is a problem that Peer to Patent cannot cure.

4

http://www.peertopatent.org/.

One of the problems of the Peer to Patent Project that is pointed out in *Crowdsourcing* is the "Gordian knot of conflicting claims." Peer to Patent cannot directly ameliorate any problem in the complexity of claims. The peers aren't writing claims, just making comments. Of course, citing more prior art can make the knot knottier; narrower claims have more limitations and could be more complex and harder to understand.

Peer to Patent is currently limited to computer and business method patents. n5 That's not bad; one has to start somewhere. But it does mean that the patenting process as a whole cannot benefit for now. If this works, it can be expanded to other technical areas.

5

See http://www.uspto.gov/web/offices/com/speeches/08-26.htm.

Unfortunately, the control of the PTO's schedule is something that Peer to Patent cannot improve upon. How long an application takes from filing to issuance is still largely up to the examiner. Like the horse who can be brought to water, some examiners could have prior art served up to them on a platter and would still take their time to read and act upon it.

To succeed, programs like Peer to Patent have to be neutral. One of the complaints on the site is from a person commenting on the shortcomings of software patents. She says that the examiners don't have access to "free and open-source software," called FOSS. Then, oddly, the example that is given of a "stupid" patent isn't of a software patent; it is a method for swinging on a swing. Many of the comments, some of which are cartoons, are stridently anti-patent, showing mobsters with machine guns and attaché cases labeled "software patents," confronting the innocent. If there are so many bad software patents out there, why not use one of them as an example? If there are so many small entrepreneurs, small businesses, or small developers being harassed, why not give us real examples, instead of cartoons? This kind of commentary does not lead one to think of the people who are contributing to Peer to Patent as open-minded. If such a system is to work, bias must not be a part of it.

Video clips from GE and HP on the website are more balanced. Todd Dickinson, speaking on behalf of GE, encourages inventors to participate in the Peer to Patent Project, so that any prior art is flushed out early on, and does not "come back to bite the inventor" later on. Peer to Patent, however, cannot prevent the same or similar references from being cited in a lawsuit. The typical plaintiff-inventor must defend the validity of his invention in the Patent Office, and again in each and every lawsuit brought regarding his patent. Neither Peer to Patent, nor any of the proposed patent reforms, do anything to simplify litigation in that respect.

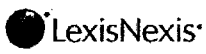
One of the patents on the Peer to Patent Project website belongs to Blaise Mouttet, an inventor who opted to consent to the review. According to *USA Today,* Mr. Mouttet felt that there were too many lawyers and not enough inventors involved with the patent system. n6 I understand his frustration with lawyers, but I do not agree completely with his view. The problems with patent prosecution and enforcement do not originate with attorneys. They originate with Congress, the PTO and appellate decisions.

6

"Peer-to-Patent Program Taps Wisdom of Masses," September 15, 2008, posted at http://www.usatoday.com/tech/news/techinnovations/2008-09-15-peer-to-patent-crowdsourcing_N.htm.

Mr. Mouttet's patent was filed in April, 2006. The case is on appeal two and one half years later; no one knows how much longer the process will take. The references relied upon by the examiner do not appear to include any of the eleven references cited in the review of this patent on Peer to Patent. One example isn't enough to determine the worth of Peer to Patent, but the time taken for this application does not appear to have been any shorter than the norm. Nor does the examiner appear to have found the peer-cited art to be as relevant as the art he located in his own search. The value of the peer review, at least in this case, may not be much. However, if Mr. Mouttet's patent application does issue, at least it will have more cited references. That helps in any suit.

On the whole, Peer to Patent is an interesting concept, and a worthwhile experiment. With fine-tuning, and more people participating, it will, I hope, improve the patent system. Much depends on how many people are willing to spend time reading applications and citing art. It can't solve all of the defects that so many people have noted in the Patent Office, but we have to start somewhere. In any case, those defects must be dealt with. Funding needs to be guaranteed, an adequate number of properly trained examiners must exist, and those examiners need to have access to both patent and non-patent literature. Nor can Peer to Patent solve the uncertainties created by appellate decisions that reverse so many claim constructions, and that treat the specification as the claim. But, having the public participate in the patent system is an idea that bears watching. It demonstrates more imagination than the Patent Reform Act.



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September 2007

SECTION: COVER STORY; Pg. 55

LENGTH: 5672 words

HEADLINE: IC 10

BODY:

IC 10 2007'S MOST INNOVATIVE LEGAL DEPARTMENTS

In each of the past three years *InsideCounsel's* editorial staff has wondered if it might be time to put the IC-10 to bed. After all, how many truly innovative ways are there for a legal department to do business? * It turns out there are a lot. In 2007--as in each of the past years in which we've published the IC-10--when we asked you to tell us about your creative best practices, you delivered a fascinating array of ideas. This year's submissions ranged from a patent-pending method for forcing law firms to lower their rates to a customized manual that explains the nuts and bolts of conducting e-discovery. * This year's IC-10 once again proves that with a little creative thinking and initiative, legal departments large and small can find inexpensive ways to be more effective, more efficient and more valuable to their clients.

IC 10 IBM

THE BOOMERS RETURN

BIG BLUE'S BREAD AND BUTTER IS ITS PATENT PORTFOLIO. The company has for the past 14 years been the world's largest recipient of U.S. patents. Protecting, grooming and growing that portfolio without breaking the bank is a tricky task--one that requires efficient, effective IP lawyers who intimately know IBM's existing technology and future strategy. In the mid-1990s IBM's legal department found itself struggling with a shortage of IP talent as many of the company's longtime patent counsel began to retire, taking with them decades of accumulated expertise. It's a predicament many companies face as baby boomers retire in droves.

But rather than just saying goodbye and shutting the door on IBM's most seasoned patent experts, Dave Kappos, IBM's chief IP counsel, had a better idea. What if IBM could find a flexible way to keep these retired attorneys in the loop?

Starting in 1997 Kappos reached out to recent retirees to gauge their interest in doing some work for IBM on a part-time or project basis. Many retirees jumped at the opportunity.

"It's a shame to make people work full-time or not at all," Kappos says. "We realized that to keep some of our best resources in the family, we had to create a new model that would let these people change their lifestyles."

Today 76 retired IBM attorneys are doing work for IBM on a wide range of sophisticated projects from patent preparation and prosecution to hashing out licensing agreements. In many cases these attorneys are serving the same groups of inventors they worked with when they were at IBM as full-time employees. The only major difference is that they're doing the work from their homes and on their own schedules.

"It's a win-win," says Robert Weber, senior vice president, legal and regulatory affairs and general counsel. "IBM's costs are substantially lower [than they would be for outside counsel] because these attorneys work from home and already have knowledge and experience working with IBM."

While the idea sounds like a no-brainer, creating this network of retired attorneys was not without its challenges. First, IBM needed to address the issues associated with malpractice insurance, conflicts, maintaining law licenses and preserving the privilege. IBM did this by partnering with one of its IP firms. Technically, the firm employs the retirees, who then work as contractors for IBM. That arrangement also allows the ex-IBM lawyers to work for other clients, which was a key perk that convinced many of them to sign on.

Kappos also stressed that the company had to ensure that contract attorneys worked seamlessly with active members of IBM's legal department to provide internal clients with the responsive service they need. Technology played a key role in making this possible. The retirees are connected to IBM through the department's intranet, which enables them to respond to client requests, download and upload documents and interact with other lawyers in real time.

"You need an administrative, technological and professional infrastructure to make this work," Weber says.

But although getting the "virtual firm" of IBM retirees up and running required some legwork and startup costs, for IBM it was well worth the effort.

"At IBM and in our law department, we are in the talent business," Weber says. "And any reasonable step you can take to continue to draw upon that talent is great."

--ADELE NICHOLAS

IC 10 VERIZON COMMUNICATIONS INC.

MANUAL LABOR

JOHN FRANTZ WAS TIRED OF REPEATing himself. As vice president, associate general counsel and head of litigation for Verizon Communications Inc., he is one of the few attorneys in the 172-lawyer department who knows the company's e-discovery practices and policies inside and out. This means that whenever litigation arose, he and Verizon's small e-discovery practice group, which he formed in 2005, would spend a large chunk of their time fielding questions from both outside and in-house counsel.

So in early 2006 Frantz and his team decided to create a comprehensive e-discovery manual that would guide the lawyers through the process from start to finish.

"We wanted the manual to be a road-map for when litigation gets going and production is necessary," Frantz says. "Basically, it's a game plan."

That game plan explains every aspect of Verizon's e-discovery practices and policies. It discusses data retention, vendor management, data review, document production and Verizon's approach to the amended Federal Rules of Civil Procedure.

To compile the 36-page guide, the e-discovery team enlisted the help of the internal and external lawyers, as well as the IT professionals. Frantz's team talked to Verizon's IT department to gain a better understanding of the company's retention capabilities and studied the amended Federal Rules to ensure the manual addressed every crucial issue.

After conducting all the necessary research and interviews, which Frantz estimates took him about 160 hours and cost less than $100,000 to complete, the e-discovery team divided up the task of writing the 16 chapters of the manual in June 2006. They finished it in March 2007. Because the manual contains legal advice, Verizon considers it privileged.

"We always try to be proactive in responding to changes in the law," says executive vice president and general counsel William Barr. "The manual keeps Verizon ahead of the curve in the dynamic legal environment that prevails in e-discovery today. It is an effective tool for helping Verizon to minimize risk, save time for both inside and outside counsel; and reduce our e-discovery expenses."

According to Frantz, the most important section of the manual offers guidance on when legal holds may be required, how to draft a hold notice and what legal considerations go into drafting a hold. It also offers detailed instructions about what needs to be done once it's determined a hold is necessary, and contains model litigation hold notices for attorneys to reference.

In addition to creating the manual, Frantz also developed training sessions to ensure in-house attorneys understood the manual's contents. And although it's too soon to tell how much money Verizon will save from this effort, Frantz is confident the company will see a good return on its investment.

"Because of the manual, the conversations we have with outside counsel don't have to begin at square one," he says. "They now pick up from a much further point of departure. So it'll be a real time and money saver on that score."

--KEITH ECKER

E-DISCOVERY EDUCATION

Verizon's e-discovery manual is only one of a handful of projects the company is undertaking to educate the legal community about e-discovery. Below are a couple other initiatives the company is in the process of executing.

* JUDICIAL POLICY AMICUS PROJECTS -- Judges are notorious for being behind the curve on comprehending the latest technology, such complex IT systems. This can have serious consequences for corporate defendants engaged in e-discovery. Verizon is currently in the process of changing this by educating courts through filing amicus briefs in cases it feels are important or that could jeopardize currently developed standards.

* ELECTRONIC DISCOVERY INSTITUTE--This year Verizon helped form the Electronic Discovery Institute, a non-profit corporation aimed at finding methods to help reduce the cost of the document review process during discovery. The institute brings together a varied array of professionals, including federal judges, outside counsel, in-house counsel, scientists, plaintiffs' lawyers and consultants. Currently, the non-profit is conducting a study analyzing different methods of computer assisted document review.

IC 10 PORT OF OAKLAND

PURSUING POLLUTERS

FACED WITH A MASSIVE ENVIRONMENTAL CLEANUP, MANY companies and public entities bite the bullet on cleanup costs rather than take on the expensive and time-consuming process of finding another party to pick up the bill. The Port Attorney's Office of the Port of Oakland, Calif., decided to take a risk on a different approach.

The Port's success in assigning responsibility for the clean up of 100 contaminated sites within the Port's 19 miles of shoreline along San Francisco Bay is a case study in how an aggressive cost-recovery program can pay off.

Over the years the property housed bulk fuel storage facilities, a coal gasification plant, a steam generating plant, chemical processing and warehousing, gas stations and pesticide manufacturers--some of which predate the Port, which was created in 1927.

Deputy Port Attorney Michele Heffes discovered that the Port vaults contained commercial general liability insurance policies that date to the 1920s.

"Some of the historic policies are a true treasure trove for coverage because they contain no pollution exclusion," Heffes says.

Once Heffes realized the insurance policies could cover cleanup costs for some of the contaminated sites, she filed a couple of cases to test that theory--and won.

Heffes then assembled a team of internal staff and external consultants for a massive research project. The project included examining property records and leases back to the 1800s, as well as decades-old aerial photographs and fire insurance maps to identify former occupants of contaminated sites that are potentially responsible parties (PRPs). Environmental consultants analyzed the contaminants to determine their souree.

Heffes created a database on the 100 sites including regulatory status, PRPs and possible insurance coverage. She prioritized the sites through cost-benefit and statute of limitations analyses to determine the best candidates for cost recovery litigation. She minimized outside legal costs by giving all the work to two firms to avoid reinventing the wheel on each case. One firm pursued insurance recoveries while the other handled PRP claims. So far, thc Port has recovered $50 million in cash and another $17 million in non-cash benefits for the cleanup of 30 sites. And about 15 other matters are pending.

Port Attorney David Alexander notes that it is unusual for public bodies to risk costly litigation.

"Public entities are generally risk-adverse, and these are plaintiffs' actions that can be expensive," he says. "When you are using public money, you have to be able to show recovery."

And Alexander can: The Port's return on its litigation investment is close to 400 percent.

"It's been a phenomenal success," Alexander says. "As a result, our law department is one of the few that operates at a profit."

--MARY SWANTON

IC 10 CSA GROUP

SAFETY POLICE

THE INTEGRITY OF ITS CERTIFICATION MARK IS TORONTO-based CSA Group's stock in trade. The seal, which appears on more than a billion products ranging from sports equipment to novelty holiday lights, informs retailers and consumers that the marked product has undergone a series of tests and meets rigorous standards for consumer safety.

At least that's what the mark is supposed to do. But the non-profit organization faced two major threats to its mission. The first was licensed users of the CSA mark who were applying the mark to modified products CSA hadn't certified. The second was manufacturers that were making counterfeit copies of the mark and displaying it on products CSA had never tested or certified.

"These counterfeit approval marks were enabling unsafe or deficient products to gain widespread access to the North American market," says RJ Falconi, vice president, general counsel and corporate secretary of CSA.

CSA's old approach to the problem had been to respond to counterfeiting on an ad hoc basis. But as imports of consumer products surged following NAFTA and an increasing number of dangerous products bearing counterfeit CSA marks found their way onto store shelves, Falconi knew it was time to do something drastic. While many general counsel would have just thrown money and outside lawyers at the problem, Falconi took a decidedly non-traditional tack. He enlisted the help of non-legal experts, government officials and CSA's own clients and employees to combat the problem.

Falconi's first step was to grow the department from two lawyers to an interdisciplinary team of 17 professionals, including ex-law enforcement officials, forensic engineers and technology experts. These experts investigate incidents of mark misuse, develop technology to make it harder for counterfeiters to copy the mark and work with law enforcement officials to take legal action against counterfeiters.

Second, Falconi began offering free training to retailers, customs officials and import-export agencies to alert those people to the problem and help them identify counterfeit marks. He also created strategic alliances with retailers that now know to alert CSA when consumers return or complain about products that bear CSA's mark.

The third step Falconi took was to launch the Counterfeit Busters Club, which rewards employees who report suspicious items that are found to bear counterfeit marks.

"Your employees are your best set of eyes," Falconi says. "They know your portfolio of marks and what programs you are involved in."

This initiative has led to several important recalls. For example, a CSA employee told Falconi about a flimsy-looking extension cord he had seen for sale that carried the CSA mark. Sure enough, the cord posed a risk of fire and electrical shock and the CSA mark was a phony. CSA contacted the manufacturer and got it to issue a warning to consumers and offer a refund on the cord.

As a result of Falconi's efforts, CSA has investigated and responded to more than 4,000 incidents involving products bearing CSA marks since 1999; issued more than 150 manufacturer recalls; and increased reporting of mark misuse or counterfeiting by 13.5 percent. As if those results didn't speak for themselves, Falconi also notes that the recoveries his team has obtained from counterfeiters in infringement actions has offset the program's internal costs.

--ADELE NICHOLAS

IC 10 MICROSOFT CORP.

CLASSIFICATION QUANDARY

SOME MIGHT ARGUE IT'S NOT EXACTLY an innovation for Microsoft's legal department to implement the software giant's homegrown technology. That might be a valid criticism if the technology had landed in the legal department's lap. It didn't. The lawyer in this story--Danielle Holmes--proactively sought out the technology, repurposed it and turned it into a program that has dramatically reduced the department's reliance on outside counsel.

About four years ago Microsoft's patent lawyers were overwhelmed with requests to classify and catalog the patent portfolios of other companies--a consequence of Microsoft's stepped up cross-licensing activities and its need to better understand the technologies its competitors were investing in.

But classifying patents was costly and time-consuming. The in-house lawyers would send each patent to outside counsel to review. After reading the patent, the outside lawyer would write a summary--often just a single sentence such as, "This patent relates to e-mail attachments." It could take an experienced attorney up to 30 minutes to classify a single patent. As a result, it was almost impossible to catalog a portfolio that contained more than a few hundred patents.

Because many of the portfolios Microsoft wanted the team to catalog contained thousands of patents, Holmes, a senior attorney in the patent group, knew she needed a more efficient way to manage the workload. At one point Holmes looked at third-party software that sorts patents based on keywords. The problem, though, was the nomenclature used in IT patents is notoriously inconsistent. For instance, one company might refer to a cell phone as a wireless phone whereas another might call it a mobile phone.

That's when Brian Haslam, a patent analyst, stepped in.

Haslam was a part of a team of Microsoft developers whom the legal department was grooming to become patent attorneys. After learning of Holmes' classification woes, Haslam convinced his friends in the research department to give him access to some auto-classification code they had written. Using the code and a $1,000 server Holmes purchased for the project, Haslam was able to create a patent classification program in just four months.

To make the program work, however, Holmes had to teach it how to classify IT patents. She did this by loading Microsoft's entire patent portfolio--some 7,100 patents--into the system. The program used these patents, which Holmes' team had manually classified over the years, to learn the difference between, say, a "wireless e-mail" patent and an "antivirus" patent.

When Holmes uploads a new patent into the system, it compares that patent to the training set and classifies it accordingly. It also spits out a probability score--basically how confident it is in the classification. If an outside patent relates to a technology for which Microsoft has no patents, that probability score will be low. So far Holmes has been impressed with the program's accuracy.

"I remember the first day I saw the results from the pool," she says. "I was blown away. I couldn't believe how good they were."

The system also is blisteringly fast. It can classify a portfolio of 10,000 patents in less than two minutes, essentially cutting out the need to involve outside counsel.

"Over the years we have easily saved half a million to a million dollars in outside counsel expenses," says Holmes, who said she would be happy to license the program to other companies. "More importantly, we can delve much deeper into these patent portfolios."

--ROBERT VOSPER

WORDY CONTRACTS

A few years ago Microsoft was receiving a lot of complaints from customers--mostly IT folks--that it was difficult to understand the licensing agreements that governed the use of the company's off-the-shelf software products.

By running the agreements through the Flesch Reading Ease and Flesch-Kincaid Grade Level tests in Word, Morris Kremen, associate general counsel at Microsoft, determined that most of the agreements were written at a post-graduate grade level. He set the new benchmark at a high-school level.

Using the Flesch tests as a guide, the lawyers responsible for writing these agreements had to learn how to write like lay people. That meant ditching the run-on sentences, dropping the legalese and using shorter words. Since Kremen instituted the new benchmark, customer complaints have dropped dramatically.

Kremen acknowledges that these simplified agreements might expose his client to greater legal risks, but argues it's a tolerable risk.

"We were more concerned that in the future our customers would seek alternative solutions because it was too difficult to do business with us," Morris says.

As a side note, according to the Flesch-Kincaid test in Word, this article is written at an 11th grade level.

IC 10 SCOTTS MIRACLE-GRO

INSOURCING GROWTH

WHILE FIGHTING A NUMBER OF ASBESTOS-RELATED LAWSUITS IN 2003, Marysville, Ohio-based Scotts Miracle-Gro's then-General Counsel David Aronowitz had literally millions of pages of documents to review. As most GCs in that situation would do, Aronowitz sent them to outside counsel. But somewhere along the line, he got fed up with the typical way of doing things.

"We found we were spending enormous amounts of money on associates we didn't know, and we had no idea if the documents were being reviewed quickly or slowly, accurately or inaccurately," says Aronowitz, who resigned from Scotts in July after nine years with the company.

Aronowitz began to insource the highest and lowest levels of legal work--defense strategy and document review, respectively. He hired a full time lawyer to serve on the asbestos cases in a strategic role, but rather than hiring permanent associates to take on the document review, he brought on about 20 contract attorneys and set them up in a separate building.

Pleased with the results of that initial experiment, Aronowitz next rented a floor in a Columbus office building and hired another full-time lawyer to help manage the group. As Aronowitz and the managing attorneys realized they had some bright, capable contract lawyers on their hands, the group began to take on work unrelated to the asbestos litigation. Almost accidentally, the legal department was now running a boutique law firm within Scotts.

"Now we have an office, [managing] partners and a bunch of associates, administrative staff, equipment and even a law library," Aronowitz says. "Boy, it sure looks a lot like a law firm. And it all belongs to Scotts."

Nearly three years after moving to Columbus, this "in-house law firm" now handles all of Scotts' litigation and significant strategic legal work, as well as about 90 percent of document review. Beyond giving control over the quality and efficiency of legal work back to the legal department, this has saved the company $2.5 million to $3 million a year in outside legal fees.

"It puts us closer to the actual work, which has enabled us to influence the quality of work much more closely," says Senior Director of Litigation Ivan Smith, who manages the group. "We have achieved excellent results in our cases and we've done it in a more cost-effective way."

Although Aronowitz has left the company and the future of his law firm model is unknown as of press time, the roots he left at Scotts should inspire other GCs battling the rising costs of outside firms.

"Law firms are on a death march to being less relevant," Aronowitz says. "I think you're going to see more of this. It is cost-efficient and fun, and that's a pretty cool combination for an in-house lawyer."

--MELISSA MALESKE

IC 10 AMERICAN EXPRESS

RATE REDUCER

SOMETIMES THE SIMPLEST IDEAS ARE the best. Take the American Express legal department's "Rate Increase Tool."

The "tool" is an Excel spreadsheet that calculates the impact of law firms' rate increases on the law department's budget for the coming year. The firms plug in the old and new hourly rates for partners, associates and paralegals and the number of hours each one billed in the current year on Amex matters.

The tool calculates the percentage increase for each legal professional, and how much more the company will pay in the coming year if the number of hours billed remains the same. In addition to showing the budget impact of rate hikes, the tool makes it easy to compare the rates with those charged by benchmark firms in the same geographic and size categories. All that information gives Managing Counsel Stuart Alderoty and his staff leverage in negotiations with their outside firms.

Alderoty created a team headed by Senior Litigation Counsel Mark LoSacco to attack rate increases last year after concluding that efforts to negotiate alternative fee, flat fee and discount arrangements weren't enough to keep outside counsel costs under control. Soaring hourly rates were colliding with corporate mandates to keep budgets flat.

"No matter how aggressive we get, if the firms want rate increases every year, all of that work is swallowed up and we are back to the starting point or two steps removed from the starting point," Alderoty says. "We decided to create a tool to bring uniformity to the way we evaluate rate increase requests and to provide transparency so the law firms gain an appreciation of the economic impact of what they are asking for."

LoSacco's team--Laura Bass Penn, a director in the litigation group; Todd Miller, vice president of operations for the general counsel's office (GCO); and Odalys Arbelaez, GCO administrator, developed the rate comparison spreadsheet and integrated it into a matter management billing system, making it easy for law firms to access and complete.

Once the law firms submit the information, Amex lawyers discuss the budget impact with their law firms. Alderoty says there is often a "voilà moment" when the law firm contact realizes the economic consequences of the planned rate increase.

"They are usually surprised by the effect of the rate increase on our budget," LoSacco says. "They understand our view and we work something out"--a reduction of the rate increase, a discount or an adjustment of staffing on a matter. Projected savings in outside counsel fees for 2007, the first full year of implementation, exceed $1 million.

Alderoty says that although they had questions, none of the company's 14 primary law firms resisted filling out the form. "But we don't necessarily give them a choice," he adds.

While the litigation team is the only group using the tool, Alderoty expects other law department units to adopt it.

"Experience has shown that we are the largest consumer of outside services and the first to come out with something innovative like this," Alderoty says. "Once we show results, my expectation is that it will be rolled out GCO-wide."

Realizing that most law departments are scrambling for ways to cut outside counsel costs, Amex also has applied for a patent with hopes of licensing the tool to an e-billing vendor.

"When we devised the tool, we looked at it and said. 'It's pretty simple, but that doesn't mean it isn't powerful,'" Alderoty says. "We also looked around and found there wasn't anything else like it out there. That's when we pulled in our patent folks and they agreed that although it is simple, it's unique."

--MARY SWANTON

IC 10 TRAVELOCITY.COM

ART COLLECTORS

TRAVELOCITY.COM WAS FED UP WITH FENDING OFF PATent trolls. The online travel agency was struggling to defend numerous suits from plaintiffs that claimed they owned the rights to technology on Travelocity's Web site. The legal department found itself duplicating its prior art searches each time a claim came through the door, costing the company millions of dollars annually.

That's why in the fall of 2006 Scott Roberts, associate general counsel, approached General Counsel Sterling Miller with a simple, but innovative, idea--a prior art database.

"We had been doing searches for prior art, which were very painful," Miller says. "We needed to figure out a way to capture the old stuff and capture the stuff that was currently being created. The faster you present this evidence, the faster these cases go away."

Roberts and Miller wanted to create this database with as little expense and disruption to the business as possible. So they decided to undertake most of the work themselves and relied on Travelocity's existing content-management system to store the relevant documents.

In January 2007 the two began interviewing employees to find out where those documents were located.

"We sat down with the interview subject, got information from them about their role within the company throughout their employment, talked about projects they've worked on and asked about what documents they have from the earlier timeframe," Roberts says.

Through their interviews, the pair was able to collect various notes, invention disclosure forms and doodles, including some depicting Travelocity's original Web site concept. They then scanned these documents into a computer and filed them into the searchable content-management system. Often, they indexed the hardcopies of these documents as well. Roberts and Miller used a video recorder to preserve the interviews with some of the veteran employees and uploaded them to the database in a digital format.

Once the database was up and running, the pair taught Travelocity's product development teams how to upload relevant notes, sketches and forms themselves so the database would keep growing without too much upkeep by the legal team.

"Once we finish conducting employee interviews to capture the really old stuff as best as we reasonably can, the project will have its own momentum going forward as people put information in the system themselves," Miller says. "Currently this process seems to be working well, and senior management is pretty excited about the value of the database, which is the faster you present this stuff, the faster the case goes away because you're someone plaintiffs don't want to pick a fight with."

Already the database is helping Travelocity fend off suits. In a recent patent infringement suit, Roberts and Miller sent seven binders of prior art information from the database to the plaintiff.

"We said if you want to pursue this, this is what you'll be going up against," Roberts says. "We ended up resolving that case very quickly. Finding that prior art wasn't something we did a year into the case after beginning discovery; we did it upfront."

--KEITH ECKER

IC 10 ABX AIR INC.

COMPLIANCE UNDER FIRE

JOE PAYNE HAD A LOT ON HIS PLATE IN 2003. AT THE TIME HE was a one-man legal department for Wilmington, Ohio-based ABX Air, a cargo airline whose parent company, Airborne Express, had just been bought out by DHL. The global shipping giant then spun off ABX, and the airline became an independent publicly traded company for the first time.

Suddenly, on top of handling myriad FAA regulations, Payne found himself dealing with the stock market and all it entails: shareholders, a board and the FTC.

"Our board wanted us to develop very robust corporate governance as quickly as we could and obviously stay compliant with NASDAQ and FTC requirements," says Payne, now general counsel of ABX's three-person legal team.

But in a company with 10,000 employees and more than 100 locations, the legal department couldn't do it alone.

"I needed to set up a process to have some monitoring and assistance throughout the company," Payne says. "I wanted to make everyone aware of legal risks and make them a resource and, in a sense, part of the legal team."

So Payne enlisted ABX's own employees to form a compliance committee--relieving some of the pressure on his tiny department's shoulders while organizing employees around a common goal. He appointed senior managers from each department to the committee so they could identify and prioritize the legal risks in their respective departments.

After vetting the lists with outside counsel, the compliance committee will monitor and audit the risks on an ongoing basis.

While deputizing your businesspeople to handle sensitive compliance issues sounds risky, Payne's program works because it sets up checks and balances and clear lines of reporting that help the compliance team stay abreast of what is going on in every corner of the company.

Although the program is not yet companywide, a pilot program in the HR department offered a hint of how it will work. For common pitfalls, such as I-9 forms, the committee created training plans for HR personnel. Now HR employees must pass a tutorial before they can handle such forms. New employees learn about the importance of compliance upon hire--the best time to educate them, Payne says. If all else fails, an anonymous whistleblower hotline has been set up so employees can bring their concerns to management.

That approach seems to have worked, as companywide reaction to the compliance plan has been extremely positive. While the program makes the legal department's job easier, it's also helped the business units work more efficiently.

"Nobody wants to be the one called into the legal office," says purchasing department director Bob Hanke, who heads the committee. "It's a lot easier on the employees and managers if they know they're doing things the right way."

--MELISSA MALESKE

IC 10 ROCKWELL AUTOMATION INC.

DEFINING PRIORITIES

TWO YEARS AGO DOUG HAGERMAN, senior vice president, general counsel and secretary of Rockwell Automation Inc., found his 18-lawyer department struggling to find ways to become more proactive and integrated into the business. He soon realized the answer might not be a revolutionary change in how the legal department does business, but rather taking a deep breath and refocusing on the department's core priorities.

During an off-site retreat Hagerman and his team sat down and hammered out eight operating principles to guide the department's goals for the future. What he came up with wasn't exactly earth shattering. In fact most in-house departments probably have discussed these goals (see "Eight Goals") around the water cooler or in meetings. The difference, though, is that Hagerman put them down on paper--an act that has helped the lawyers better set their priorities, measure their accomplishments and communicate their value to the business.

"What was interesting about the process was how quickly we got to a consensus on the operating principles," Hagerman says. "The notion that these were the right things for us to be doing was already inside of all of us and we just needed to bring it out and find the right words to express it."

--KATHERINE SESTERHENN

EIGHT GOALS

1. Know the company, its business strategies and its worldwide legal needs, through involvement in business planning.
2. Provide proactive advice on legal solutions to business objectives.
3. Solve problems creatively and identify practical alternatives to address legal obstacles and mitigate risk.
4. Communicate clear and decisive advice.
5. Educate employees about how to comply with laws, regulations, company policies and contracts.
6. Protect the company's reputation and model the highest standards of ethics.
7. Balance our role as independent counselor with our role as business partner.
8. Strive to provide quality service in a cost-effective way.

GRAPHIC: Illustration, no caption, Illustration By Maria Rendon

Picture 1, **Dave Kappos** and Robert Weber, Photograph By Jill Wachter
Picture 2, David Alexander and Michele Heffes, Photograph By David Toerge
Picture 3, R. J. Falconi, Photograph By Michael Yarascavitch
Picture 4, Danielle Holmes and Brian Haslam, Photograph By Stuart Isett
Picture 5, Sterling Miller and Scott Roberts, Photograph By Albert Porter
Picture 6, Joe Payne, VP of Compliance and Government Affairs Robert Gray, and Bob Hanke, Photograph By Mark Werle

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Agency Web Site Will Solicit Advice

BYLINE: By Alan Sipress, Washington Post Staff Writer

BODY:

The government is about to start opening up the process of reviewing patents to the modern font of wisdom: the Internet.

The Patent and Trademark Office is starting a pilot project that will not only post patent applications on the Web and invite comments but also use a community rating system designed to push the most respected comments to the top of the file, for serious consideration by the agency's examiners. A first for the federal government, the system resembles the one used by Wikipedia, the popular user-created online encyclopedia.

"For the first time in history, it allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts," said David J. Kappos, vice president and assistant general counsel at IBM.

It's quite a switch. For generations, the agency responsible for awarding patents, one of the cornerstones of innovation, has kept its distance from the very technological advances it has made possible. The project, scheduled to begin in the spring, evolved out of a meeting between IBM, the top recipient of U.S. patents for 14 years in a row, and New York Law School Professor Beth Noveck. Noveck called the initiative "revolutionary" and said it will bring about "the first major change to our patent examination system since the 19th century."

Most federal agencies invite interested parties to weigh in on proceedings, and even the patent office allows some public comment, but never to the degree now suggested .

Until now, patent examiners rarely sought outside opinions, instead relying on scientific writings and archived records of previous patents. For security reasons -- in particular, out of concern that examiners could inadvertently reveal proprietary information if their online searches were tracked -- patent officials have at times even been barred from using the Internet for research.

But their mission has grown increasingly unwieldy. Last year, the agency's 4,000 examiners, headquartered in Alexandria, completed a record 332,000 applications. The tremendous workload has often left examiners with little time to conduct thorough reviews, according to sympathetic critics.

Under the pilot project, some companies submitting patent applications will agree to have them reviewed via the Internet. The list of volunteers already contains some of the most prominent names in computing, including Microsoft, Intel, Hewlett-Packard and Oracle, as well as IBM, though other applicants are welcome.

Brigid Quinn, a spokeswoman for the patent office, said the program will begin with about 250 applications from the realm of software design, where it is especially difficult for examiners to find related documentation. Unlike special-

ists in many other fields, software designers often forgo publishing their innovations in technical journals and elsewhere.

Anyone who believes he knows of information relating to these proposed patents will be able to post this online and solicit comments from others. But this will suddenly make available reams of information, which could be from suspect sources, and so the program includes a "reputation system" for ranking the material and evaluating the expertise of those submitting it.

With so much money riding on patent decisions -- for instance, a federal jury ordered Microsoft last month to pay $1.52 billion for infringing two digital-music patents -- the program's designers acknowledge that the incentive to manipulate the system is immense.

"I'm sure there will be a degree of gaming. There always is," Kappos said.

Maintaining a reliable Web-based reputation has become an increasingly pressing concern for Web companies as they seek to reassure users that they can trust the strangers they do business with online. So the designers of the new patent-review system consulted some of the Internet's leading experts on reputation, Noveck recounted. These included specialists from eBay and Rob Malda, aka CmdrTaco, the founder of the popular technology Web site Slashdot.org.

EBay, for example, established its position as the Web's premier auctioneer after pioneering a public feedback system that has buyers and sellers rate one another based on customer service, the quality of the goods, and timeliness of delivery and payments. Amazon.com, the Web's leading bookseller, provides reviews of its offerings, then allows readers to rank its reviewers based on the usefulness of their evaluation.

The new patent system will try to help separate experts from posers by offering extensive details about the people sending information to the site. To help others evaluate the quality of this information, called prior art, each posting will include several measures gauging the quality of his other contributions to the site. Patent examiners, for instance, will award "gold stars" to people who previously submitted the most useful information for judging earlier applications, Noveck said.

Ultimately, those registered to participate in this online forum will vote on all the nominated information, and the top 10 items will be passed on to the examiner, who will serve as the final arbiter on whether to award a patent.

Noveck said the online program would not only produce better information for examiners to consider but also make the patent process more democratic. "The idea is to make something as important as decision-making about innovation more transparent to the public and more accountable to the public," she said.

During discussions about the patent review project, its developers initially considered limiting or weighting the votes to reflect the expertise of the participants. For the time being, they have instead decided to go with one person, one vote.

But Noveck and others involved in creating the online review system said it was likely to evolve. To assure that the outcome can be trusted, some of those involved in designing the program say some kind of weighted voting system may eventually be required.

"If voting is necessary, you'll have to have some rules about who gets to vote," said Paul Resnick, a professor of information at the University of Michigan.

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The Patent and Trademark Office is starting a pilot project that will not only post patent applications on the Web and invite comments but also use a community rating system designed to push the most respected comments to the top of the file, for serious consideration by the agency's examiners. A first for the federal government, the system resembles the one used by Wikipedia, the popular user-created online encyclopedia.

"For the first time in history, it allows the patent-office examiners to open up their cubicles and get access to a whole world of technical experts," said David J. Kappos, vice president and assistant general counsel at IBM.

It's quite a switch. For generations, the agency responsible for awarding patents, one of the cornerstones of innovation, has kept its distance from the very technological advances it has made possible. The project, scheduled to begin in the spring, evolved out of a meeting between IBM, the top recipient of U.S. patents for 14 years in a row, and New York Law School Professor Beth Noveck. Noveck called the initiative "revolutionary" and said it will bring about "the first major change to our patent examination system since the 19th century."

Most federal agencies invite interested parties to weigh in on proceedings, and even the patent office allows some public comment, but never to the degree now suggested.

Until now, patent examiners rarely sought outside opinions, instead relying on scientific writings and archived records of previous patents. For security reasons -- in particular, out of concern that examiners could inadvertently reveal proprietary information if their online searches were tracked -- patent officials have at times even been barred from using the Internet for research.

But their mission has grown increasingly unwieldy. Last year, the agency's 4,000 examiners, headquartered in Alexandria, completed a record 332,000 applications. The tremendous workload has often left examiners with little time to conduct thorough reviews, according to sympathetic critics.

Under the pilot project, some companies submitting patent applications will agree to have them reviewed via the Internet. The list of volunteers already contains some of the most prominent names in computing, including Microsoft, Intel, Hewlett-Packard and Oracle, as well as IBM, though other applicants are welcome.

Brigid Quinn, a spokeswoman for the patent office, said the program will begin with about 250 applications from the realm of software design, where it is especially difficult for examiners to find related documentation. Unlike specialists in many other fields, software designers often forgo publishing their innovations in technical journals and elsewhere.

Anyone who believes he knows of information relating to these proposed patents will be able to post this online and solicit comments from others. But this will suddenly make available reams of information, which could be from suspect sources, and so the program includes a "reputation system" for ranking the material and evaluating the expertise of those submitting it.

With so much money riding on patent decisions -- for instance, a federal jury ordered Microsoft last month to pay $1.52 billion for infringing two digital-music patents -- the program's designers acknowledge that the incentive to manipulate the system is immense.

"I'm sure there will be a degree of gaming. There always is," Kappos said.

Maintaining a reliable Web-based reputation has become an increasingly pressing concern for Web companies as they seek to reassure users that they can trust the strangers they do business with online. So the designers of the new patent-review system consulted some of the Internet's leading experts on reputation, Noveck recounted. These included specialists from eBay and Rob Malda, aka CmdrTaco, the founder of the popular technology Web site Slashdot.org.

EBay, for example, established its position as the Web's premier auctioneer after pioneering a public feedback system that has buyers and sellers rate one another based on customer service, the quality of the goods, and timeliness of delivery and payments. Amazon.com, the Web's leading bookseller, provides reviews of its offerings, then allows readers to rank its reviewers based on the usefulness of their evaluation.

The new patent system will try to help separate experts from posers by offering extensive details about the people sending information to the site. To help others evaluate the quality of this information, called prior art, each posting will include several measures gauging the quality of his other contributions to the site. Patent examiners, for instance, will award "gold stars" to people who previously submitted the most useful information for judging earlier applications, Noveck said.

Ultimately, those registered to participate in this online forum will vote on all the nominated information, and the top 10 items will be passed on to the examiner, who will serve as the final arbiter on whether to award a patent.

Noveck said the online program would not only produce better information for examiners to consider but also make the patent process more democratic. "The idea is to make something as important as decision-making about innovation more transparent to the public and more accountable to the public," she said.

During discussions about the patent review project, its developers initially considered limiting or weighting the votes to reflect the expertise of the participants. For the time being, they have instead decided to go with one person, one vote.

But Noveck and others involved in creating the online review system said it was likely to evolve. To assure that the outcome can be trusted, some of those involved in designing the program say some kind of weighted voting system may eventually be required.

"If voting is necessary, you'll have to have some rules about who gets to vote," said Paul Resnick, a professor of information at the University of Michigan.

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InformationWeek

May 7, 2007

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HEADLINE: Patents On Their Minds

BYLINE: Murphy, Chris

BODY:

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FULL TEXT:

The Supreme Court is remolding patent law to today's business realities. As of last week, that means making patents harder to get and defend.

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The case, KSR v Teleflex, addressed a core principle of patent law: whether an invention (in this case a type of adjustable brake pedal) is obvious and therefore not deserving of protection. In a unanimous decision, the Supreme Court rejected a "narrow, rigid" reading of what factors should be considered in deciding obviousness. Instead, the court said many factors-including market demand for a combination of technologies or whether it's common practice in an industry to look for such combinations could lead to a conclusion that an invention is obvious.

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Another case the Supreme Court could consider is Quanta Computer v. LG Electronics. LG has patents it says cover combinations of processors and chipsets with other components such as buses and memory. Intel licensed the technology. But LG wants royalties from Intel's computer maker customers as well, such as Quanta, which argues it's a question about how far up and down the supply chain a company can extract royalties for patented technology, The high court has asked the solicitor general for input on the case, a sign it may take it up.

The cases show the Supreme Court justices taking to heart public criticism of the U.S. patent system, and the attention's likely to continue, says Harold Wegner, a patent attorney with Foley & Lardner. The court is working to update the system, says IBM's Kappos, to accommodate forces such as globalization, greater collaboration, open source innovation, and changing business models. "The court is realizing it's not just about the patents, it's about how people work," he says. "The court realizes there's more incremental innovation occurring all the time."

There's also patent reform legislation pending in the House and Senate. Many independent inventors and small companies oppose that legislation, saying it would make it easier for big companies-IBM has received the largest number of patents, by far, for 13 straight years-to use their deep pockets to bully them out of the process. Kappos says IBM's starting a wiki this week, calling it an Innovator's Forum, to give small companies a platform on patent reform.

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So, is this a ruling that big and small inventors-two opposing camps on patent reforms-both can like? It seems so. That's the one thing everyone agrees on-that we need better, stronger patents. Because every inventor thinks his creation bears the mark of originality and genius.

InformationWeek.com

WHO NEEDS PATENTS? Startups, says Charles Babcock: informationweek.com/1134/blog _patents.htm

PATENT TRAPS IBM's "schizophrenic" patent policyenforce and reform: informationweek.com/1112/patenthtm

MICROSOFT'S PLEDGE No patent suits for Web services: informationweek.com/1106/webservices.htm

Write to Chris Murphy at cjmurphy@cmp.com

GRAPHIC: Photographs

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TECHWEB

May 5, 2007 Saturday 12:00 AM GMT

LENGTH: 1176 words

HEADLINE: Supreme Court Isn't Done Re-Shaping Patent Law

HIGHLIGHT:

It's updating the law to reflect today's business realities, from globalization to more collaborative, iterative innovation

BODY:

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NWC ANALYSIS:

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INFORMATIONWEEK

May 7, 2007

SECTION: NEWS & ANALYSIS; Pg. 25

LENGTH: 1145 words

HEADLINE: Patents On Their Minds;
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BYLINE: Chris Murphy

HIGHLIGHT:

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April 30, 2007 Monday 9:10 PM GMT

SECTION: BUSINESS NEWS

LENGTH: 848 words

HEADLINE: Court cases threaten weaker patents and, critics argue, could hinder technological innovation

BYLINE: By CHRISTOPHER S. RUGABER, AP Business Writer

DATELINE: WASHINGTON

BODY:

The Supreme Court on Monday delivered two decisions that experts say weaken the value of patents, fueling criticism that technological innovation, particularly in the biotech and pharmaceutical sectors, could be hindered.

In the more important of the two cases, the court made it simpler for companies to challenge patents on the grounds that they cover products that are obvious combinations of existing technologies. Under U.S. law, an invention must be new, useful and not obvious in order to merit a patent. The case involved Canada-based KSR International Inc. and Teleflex Inc., based in Limerick, Penn.

In the second case, the court curtailed the reach of U.S. patent laws overseas, ruling in favor of Microsoft Corp. in its dispute with AT&T Inc. over Microsoft's sale of Windows software outside the United States that allegedly infringed AT&T's patents. The decision will likely reduce damage awards in patent cases by excluding patent infringement overseas from consideration.

Boston University law professor Dennis Crouch wrote on a popular Supreme Court blog, Scotusblog, that "because of KSR, patents will be more difficult to enforce and easier to invalidate."

"The AT&T case," he added, "cuts in half the value of many of today's most valuable software patents."

The Supreme Court's recent interest in patent law it has taken up a half-dozen cases in the field in the past two years, an unusually large number reflects the greater role patents play in the U.S. economy, as companies earn more revenue from licensing patents and patent litigation has increased by 50 percent in the last ten years.

IBM Corp., which regularly tops the annual list of top U.S. patent recipients, receives approximately $900 million in revenue from licensing its patents and other intellectual property to other companies. David Kappos, assistant general counsel at IBM, said that figure is an increase from the "low millions" in the early 1990s.

Microsoft is a big winner in the two decisions today. The court's ruling in the AT&T case throws out the use of worldwide product sales as a basis for calculating damages in patent infringement suits, a formula that has resulted in large judgments against the company in other cases.

A jury hit Microsoft with $1.52 billion in damages earlier this year in a suit filed by Alcatel-Lucent, and a separate jury awarded Eolas Technologies Inc. and the University of California $521 million in damages from Microsoft. Both damage awards were calculated based on worldwide sales of Windows software.

In addition, Microsoft and many other high-tech companies, including Cisco Systems Inc. and Intel Corp., had filed friend of the court briefs in the KSR case, urging the court to ease the standard for demonstrating that a new product is obvious. The court largely decided as the companies had urged.

The companies wanted a more flexible "obviousness" standard that would make it easier for patent examiners to reject applications for trivial innovations or obvious combinations of existing products. Spurious patents have contributed to the recent increase in patent litigation, they argued.

Kappos said that the court's decision means, "if you want a patent, you actually have to invent something."

The biotech and pharmaceutical industries, meanwhile, were on the losing end of the KSR case. Groups from both industries filed friend of the court briefs in support of the obviousness test that the court ruled was applied too narrowly.

Hans Sauer, associate general counsel at the Biotech Industry Organization, which represents companies such as Amgen Inc. and Gilead Sciences Inc., said that a weaker patent regime can make it harder for new biotech companies to attract venture capital or other investment.

That investment can be crucial when a small firm is seeking millions of dollars to bring a new drug to market, he said. The first question investors will ask, Sauer said in a March interview, is whether the patent will stand up in court.

Sauer said that the biotech industry has already been negatively affected by a decision the court made last year in a case involving eBay Inc. and a small, Virginia-based company known as MercExchange.

In that May 2006 case, the court said that if a company has been found to infringe a patent, an injunction barring production of the infringing good should be granted on a case-by-case basis, rather than automatically.

And in January 2007, the court said in a dispute between biotech firms MedImmune Inc. and Genentech Inc. that a company can challenge the validity of a patent in court, even if it continues to pay fees to license the patent. That could make patent challenges more likely, patent experts said, by enabling companies to seek to have a patent declared invalid without having to take the risk of violating the patent, which can result in triple damages if a company loses its case.

But Kappos argued last week that the eBay and MedImmune decisions have resulted in only modest changes to the patent system.

"I don't think the Supreme Court has overcorrected," Kappos said, or "diminished the value of patents."

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October 25, 2007 Thursday 9:52 PM EST

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HEADLINE: USPTO Continuation and Claim Rules: AIPLA Request Injunction to Halt New Rules

BYLINE: Dennis Crouch

BODY:

Oct. 25, 2007 (Patently- Patent Law Blog delivered by Newstex) -- Feeling some pressure from its members, the AIPLA has now filed an amici brief in support of GSK's motion for a preliminary injunction to stop enforcement of the PTO's new rules on continuations and claim count. A preliminary injunction requires the moving party to satisfy a four factor test of equitable
Likelihood of success on the merits of the case; Irreparable harm that will persist without relief;
Balance of hardships weights in favor of relief; and The public interest supports relief.
In its brief, the AIPLA focused on how the new rules work to destroy established interests. The brief focuses on a trade-off between patents and trade-secrets -- indicating that the inventions embodied by many currently pending applications would have been kept as trade-secrets but for the longstanding "guarantee of a full and fair opportunity to seek a spectrum of patent protection." According to the AIPLA, the limitations on claims and and continuations severely inhibit that guarantee and thus create an irreparable harm to current applicants. David Kappos, Chief of IP at IBM (IBM), filed a declaration in support of the AIPLA brief. Kappos noted the incredible cost that it will incur to review its 25,000+ pending patent applications to ensure compliance. Writing on behalf of SanDisk (SNDK), two attorneys noted that the technology company will lose at least $200,000 in filing fees due to required consolidation. Writing as a paid expert for SKB, former PTO Director Harry Manbeck has filed a declaration explaining why, in his view, the new rules are
File AIPLA.PI.Motion.pdf (158 KB)>File Kappos.pdf (76 KB)>File Sandisk.pdf (376 KB)>
PatentDocs>Quinn>

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LOAD-DATE: October 26, 2007

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October 26, 2007 Friday 2:45 PM EST

LENGTH: 505 words

HEADLINE: Time Running Out to Block New Patent Rules

BYLINE: Stephen Albainy-Jenei

BODY:

Oct. 26, 2007 (Patent Baristas delivered by Newstex) -- Time is running short for actions to stop implementation of the USPTO's "Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications," 72 Fed. Reg. 161 at p. 46716 (Aug. 21, Motions are scheduled to be argued on October 31 in the U.S. District Court for the Eastern District of Virginia regarding a temporary restraining order and preliminary injunction enjoining the United States Patent and Trademark Office from implementing the PTO's new rules on continuations and claims. The rules go into effect November AIPLA has now filed an amicus brief in support of a pending motions. The filing addresses [T]he irreparable harm flowing from the retroactive application of the new Rules' restriction on claiming and continuation practice. Implementing the new Rules will, as a practical matter, compel IP owners to (1) abandon pending patent claims, (2) abandon entire patent applications, and (3)surrender currently existing claim scope without adequate opportunity for consideration by the The biggest issue, of course is that patent applicants frequently (knowingly or unknowingly) include a number of patentably distinct inventions in a single application. While applicants will be allowed to seek relief from the retroactive impact of the unexpected limitation of the number of claims using one of the two procedures alluded to by filing a Suggested Requirement for Restriction or by filing an Examination Support Document. By using the first option (SRR), patent application owners can request that the PTO carve out separate applications and allow them to be prosecuted in However, the PTO is not obligated to accept such requests. Thus, the PTO would have the right to block from substantive consideration future claims to previously-disclosed inventions that application owners have up until now been entitled to present and have reviewed. That change, as applied to existing applications, will cause irreparable harm to owners of patent applications. If an examiner chooses not to permit the filing of separate applications, the applicant's intellectual property -- unprotectable by secrecy if the application has been published -- will be effectively lost. Included with the AIPLA filing are declarations from IBM (IBM) and from patent practitioners who detail the effects of the rules on pending applications for which they are responsible. **David Kappos,** Chief of IP at IBM, filed a declaration in support of the AIPLA brief. Most noteworthy is that Kappos indicated that in order for IBM to comply with the retroactive requirements of Rule 78(f) and to review 30,000 related pairs of cases, IBM would incur over $10 million in legal fees and internal expenses -- not including any loss of intellectual property To read the AIPLA amicus brief, click here.>
To read the submitted declarations, click here.>
To read the SmithKline memorandum, click here.>>

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Deseret Morning News (Salt Lake City)

April 24, 2007 Tuesday

LENGTH: 1046 words

HEADLINE: Hatch, Cannon propose changes in patent law

BYLINE: Suzanne Struglinski Deseret Morning News

BODY:

WASHINGTON -- A laptop computer can have about 3,000 patents working at one time, yet the last time Congress approved changes to patent law, the laptops consumers use today did not exist.

Sen. Orrin Hatch and Rep. Chris Cannon, both R-Utah, are sponsoring identical bills in the House and Senate that aim to make the first overall changes to patent law in 50 years.

While not everyone is happy with the legislation, almost everyone agrees changes are needed.

Patents protect people's inventions. From the basic, such as a flip-top cap on a tube of toothpaste -- or the tube itself -- to more complex items such as specific separate components of a cell phone, the key pad, a battery or the contents of a pill, patent issues are involved. If an inventor applies for and receives a patent for something, no one else can claim credit -- or get money -- for that item.

Companies have complained that litigation and damage awards have actually hindered research and development of new and better inventions. Complicated cases take up money and time that could be better devoted to coming up with new ideas and putting them into the hands of consumers, they say.

Hatch said on the Senate floor last week that the bill is "designed to ensure that the United States remains at the forefront of developing and translating new ideas into tangible goods and services through an effective patent review and protection system. ... Patent law is vital to our nation's ability to compete in the global economy."

Cannon said this is one of the most important pieces of legislation Congress will tackle this year. Hatch and Cannon sit on their chambers' respective Judiciary Committees, which will take up the bills. Simplified process

Patent law is a complicated issue, but at its most basic level the bills seek to make patents better and more adaptable, compared to what other countries are doing, as well as cut back on abusive and costly lawsuits, according to the measures' sponsors.

"Now, more than ever, it is important to ensure efficiency and increased quality in the issuance of patents," Hatch said. "This in turn creates an environment that fosters entrepreneurship and the creation of jobs, two significant pillars in our economy."

In his floor speech, Hatch noted that there are more than 3,200 technology companies and 500 in the life sciences, and they are experiencing 8 percent year-over-year growth in Utah. All deal with the patent process, he said.

"Utah leads the Western states region in creating and sustaining these companies," Hatch said.

But the bill, which is similar to legislation Hatch co-sponsored in the last Congress, basically pits software and technology companies against biotech and pharmaceutical companies, which want different types of changes.

Cannon explained that a drug may involve up to five patents, while technology products such as a laptop, cell phone or MP3 player can have thousands of patented components. The drug companies want "great clarity" on the patents, while the technology companies want a simpler method of paying damages if they have to as a result of lawsuits, he said. Industry's reaction

David Kappos, IBM's vice president and assistant general counsel for intellectual property law, supports the bill, saying it is a "step in the right direction."

But Pharmaceutical Research and Manufacturers of America senior vice president Ken Johnson said he is disappointed that the proposal does not include all the reforms the National Academy of Sciences has recommended in the past. PhRMA would not go into detail yet about its concerns about the bill, saying it is too early in the process.

Among its several provisions, the bill creates a new option for people who want to challenge a patent. Currently, they either go through a re-examination by the U.S. Patent and Trade Office, which has been deemed ineffective, or go through federal district court, which can take a long time and become expensive, according to the bills' sponsors.

The proposal would allow a new Patent Trial and Appeal Board within the U.S. Patent and Trade Office to handle patent reviews that would normally go to federal court.

Kappos said this would be a good provision because it would be much less expensive and quicker and would avoid clogging up the federal district courts with patent cases.

The twin bills also would allow the public to submit information to the U.S. Patent and Trade Office regarding pending patent applications.

Kappos said there have been instances in which IBM has seen applications for inventions the company's own staff may have already come up with or were in the process of studying, but under current law there is no way for the company to tell the government.

The new process created in the bill would allow the public to advise the patent office whether a pending invention was different enough to earn its own patent or is too similar to something already invented.

With millions of patents, it is becoming more difficult to pinpoint what is already out there, Kappos said. Try to imagine being the employee that has to figure out whether a tiny electronic component has already been patented, he suggested. The bill allows others to help in the process. Infringement damages

The pending legislation also deals with damages awarded in court cases involving claims of patent infringement.

"Some claim that courts have allowed damages for infringement to be based on the market for an entire product when all that was infringed is a minor component of the product," Hatch said on the floor.

Kappos said judges and juries have awarded large damages on patent infringement cases, but the bill would give them a framework to determine how much economic value a component really adds to the product in which it is used.

"(The bill) really gets the damages right," Kappos said.

Cannon said he plans to work on an amendment that would allow for computer experts to be trained in aspects of infringement claims. In cases in which someone claims a smaller patented part of a larger patented device violates their patents, these experts would be able to sort out the claims.

"The bill will change somewhat over time," Cannon said.

The House Judiciary Committee is to take up the bill this week. Contributing: The Associated Press E-mail: suzanne@desnews.com

LOAD-DATE: April 24, 2007

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INVESTOR'S BUSINESS DAILY
Investor's Business Daily

February 28, 2007 Wednesday
NATIONAL EDITION

SECTION: INTERNET & TECHNOLOGY; Pg. A06

LENGTH: 870 words

HEADLINE: Tech Companies And Legal Experts Lobby For U.S. Patent Law Reforms; Goals include reducing lawsuits and easing the long application process

BYLINE: SHEILA RILEY

BODY:

The U.S. patent system, considered fundamental to technological creativity, is overdue for a tuneup, say some tech and legal experts.

Though patents are so essential to progress that they're enshrined in the U.S. Constitution, critics say the application process is flawed and legal challenges too frequent.

The Coalition for Patent Fairness, a lobbying group of 30 companies, trade associations and financial services organizations, hopes Congress will pass legislation to change things this year.

"We think the patent system is essential for innovation," said Steve Elmendorf, coalition co-manager. "The last time it was completely revised was in 1952, and the world has changed a lot since then."

The organization, which includes Hewlett-Packard, Microsoft and Time Warner, has four main goals.

First, it wants focus on specific patent value. A windshield wiper inventor suing a car maker for patent infringement, for example, shouldn't get damages tied to the total car value.

Issue: "Willful Infringement'

Also, standards for "willful infringement" should change, Elmendorf says.

Current patent law makes it easy to say that defendants knew a similar invention existed when they submitted their application, he says. That can multiply damage awards for patent suit losers.

Some say the current standards result in weaker patents -- that they actually discourage inventors from researching prior art, or similar ideas already in common usage.

The coalition also wants companies to not be held liable in U.S. courts for alleged infringement in other countries.

Finally, coalition members want to do away with "forum shopping" -- when someone sues a company for patent infringement in a geographic area with jurors and courts more sympathetic to their claims.

Lawsuits should take place in the jurisdiction where the supposed infringement took place or where the company is based, Elmendorf says.

Tech Companies And Legal Experts Lobby For U.S. Patent Law Reforms; Goals include reducing lawsuits and easing the long application process Investor's Business Daily February 28, 2007 Wednesday

The U.S. Patent and Trademark Office doesn't take a stand on legislation. But does support changes to the application process.

One of those changes is for more public participation and comment after patent applications are filed, says Jon Dudas, USPTO director.

Under current law, only examiners at the patent office can determine whether inventions are new. But patents inevitably will be better if that changes, Dudas says.

"In order to get the highest quality patents, we want to make certain that the office gets the highest quality information from applicants and the public," he said.

That will result in fewer legal challenges to patents and more intelligence for businesses looking to invest research and development dollars, he says.

"The more information you have, the stronger your patent will be," Dudas said. "And the more it will provide certainty about exactly what the invention is, and what market that invention will hold."

Corporations naturally have a huge stake in the process.

Coalition member HP spends $3.6 billion annually in R&D. It holds 6,000 patents worldwide for its personal computers and servers, says Joe Beyers, vice president of intellectual property licensing.

It's dangerous to study what has previously been done because it sets a company up for liability, Beyers says. "That results in a slower rate of innovation in society in aggregate," he said.

IBM, the top-ranking U.S. patent earner, with 3,600 granted in 2006, isn't a coalition member, but it too hopes for significant changes.

One change it supports is revising the requirement that inventors spell out how best to use their invention. Inventions have multiple uses, says David Kappos, IBM vice president and assistant general counsel for intellectual property law.

The requirement, he says, is like asking whether a Mercedes or a Volkswagen is better.

"It's very difficult to comply with because it's so subjective, and no patent office can assess compliance," Kappos said.

IEEE Champions Inventors

While few disagree with the need for reform, some want everyone -- not just corporations -- at the table.

The U.S. branch of the Institute of Electrical and Electronics Engineers, the largest engineering organization, wants to give smaller inventors a role in the process.

Corporate voices should be heard, but so should others, says Keith Grzelak, chairman of IEEE's intellectual property policy committee and a private attorney in Spokane, Wash. "IEEE believes the U.S. patent system should serve the entire spectrum of inventors and applicants, from entrepreneurs all the way to Fortune 500 technology leaders," he said.

Some corporations agree.

In January, IBM announced its Inventors' Forum, a Web site that encourages individuals and midsize businesses to discuss patent reform. "The constituency that hasn't been heard from is the small and medium-size businesses, which include large numbers of inventors," Kappos said.

Universities and drug companies also need to be in on the dialogue, Grzelak says. "IEEE wants to support electrical engineering job growth in the U.S., and it comes from that full spectrum," he said.

Patent reform would advance science, Grzelak says. "That doesn't mean helping a Fortune 500 company optimize its next three quarters of performance," he said. "It means promoting the progress of science in the short and long term."

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Business Daily Update

October 24, 2006 Tuesday

ACC-NO: A200610243A-12BCD-GNW

LENGTH: 1045 words

HEADLINE: SHARED WEALTH

BODY:

Author: sg For many multinational companies, intellectual property rights (IPR) protection is a good way for them to attack their counterparts so as to increase their global market share. But that is not the case with the IT giant IBM, which uses IPR not only to benefit itself but also other companies. Last month the company formalized a new corporate policy to manage the creation and management of patents. Under the new policy IBM will make its patent applications open to community review.

And it will promptly and publicly record, in its name, assignment of all the patents and publish patent applications it owns. "IBM will make available over 100 of its business-method patents - about 50 percent of IBM's total business method patents - to the public, where they can be used openly to stimulate innovation," says a company statement. IPR management As the world's largest IT and business solutions provider, IBM is also the top company in patents worldwide. To date, IBM has remained as the world's number one owner of technical patents listed by the United States Patent and Trademark Office for 13 years. It is among the top 10 foreign companies in the field of patent applications, and the only US company in the top 10 list, according to the State Intellectual Property Office (SIPO). The company has developed many technologies to make its proprietary management system for IPR, says Pryor Garnett, assistant general counsel, IBM World Trade Asia. Under the system it uses an internal worldwide patent tracking system for harvesting and patenting inventions made by its inventors. "All IBM employees worldwide, of which over 200,000 are technical experts in various fields have access to this world wide tracking system," he says. IBM also has a patent portfolio management group in its IPR department, which strategically shapes and sizes its patent portfolios country by country. "We have an award system for our inventors to let them share the benefits of submitting their inventions for patenting and to encourage them to submit and patent more," says Garnett. "And that award system is also worldwide, and is available to all the people in IBM." Patent Use As the largest holder of patents in the United States, IBM has used its patents for many purposes, says Garnett. "In some areas IBM shares its technologies in exchange for the right to use technologies developed by others, and that serves both us and our cross-licensees well," he says. Last year, IBM pledged 500 software patents to the public worldwide, including technologies on processor access memory and handwriting recognition. It was the largest grant of patents in US history. "IBM's practices reflect the reality of the IT industry," says Garnett, "In this industry most products, whether they are hardware or software, use many combinations of inventions in patents. It is very difficult for any company in the industry to use its own technology." In such a collaborative industry, which is different from some other industries such as the pharmaceutical industry and the chemical industry, IBM believes that openness and collaboration are key to rapid technology development and innovation in the industry. "Companies in the industry should keep a balance between IPR protection and open co-operation," says David J Kappos, vice president and assistant general counsel of Intellectual Property Law, IBM Corporation. "If a firm wishes to be successful in 10 years, it is really important for them to cooperate in innovation." "A company's view of IPR should be comprehensive, at one end of the spectrum, IBM rightfully defends its proprietary products, while at the other end, we lead the world in supporting the sharing of IPR when it can drive open standards and collaborative innovation." Strong environment As an observer, IBM has seen that since China joined the WTO, it has made signifi-

cant improvement in its laws and regulations governing IPR. "We believe China is making visible efforts, which we can also see, to improve its IPR regime, including its legal system, enforcement system, as well as public awareness of IPR," says Garnett. Although there still exists problems in the IPR enforcement process, Garnett and his staff appreciate the Chinese government's ongoing steps to solve its IPR enforcement problems. As a big patent applicator in China, IBM has worked well with the Chinese government to improve the IPR regime. "We now have a very good relationship with SIPO," says Garnett. "We feel that SIPO is doing a fine job in examining and granting patents." With a tremendous increase in the number of patent applications in China, IBM believes that advanced technology can help patent offices to improve their work. Recently the company was hired by the German patent office to create a fully electronic system for filing and registering patents and other intellectual property rights. "We hope this modern technology can help a patent office improve the work flow, to reduce the time spent on patent examination, therefore improving the quality of the Intellectual Property rights it grants," says Garnett. Patent quality As a world leader in the IT industry, IBM believes that every company in the industry must understand that IPR can no longer be just a side issue. "IPRs are increasingly become the centre of companies' business strategies," says Garnett. "For the Chinese IT companies it has become important to be active in the IPR area, to create and to maintain a patent portfolio with high quality." China has seen a big increase in patent applications during the past few years. However, among the three categories of patents, patents for inventions accounted for less than 20 percent of China's patent applications, while in foreign applications over 80 percent are inventions. "Patent quality should be a focus for Chinese IT companies," says Garnett. "The aim of patent protection is to encourage collaborative innovation," says **David Kappos,** "Patent quality has always been a concern for high-tech companies in the US." "Only patents with high quality can bring forth innovation and benefit the public. In our opinion, patents should only be granted to those ideas with real innovation."

LOAD-DATE: October 24, 2006

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January 14, 2006 Saturday
Chicago Final Edition

SECTION: BUSINESS ; ZONE C; INSIDE TECHNOLOGY ; Pg. 3

LENGTH: 590 words

HEADLINE: IBM leads effort to help patent examiners

BYLINE: JON VAN

BODY:

As the firm that consistently wins more patents each year than any other, IBM can appreciate the difficulties faced by the U.S. Patent and Trademark Office in evaluating stacks upon stacks of patent applications.

So Big Blue is leading an effort to give the patent office a hand.

Working with other tech firms, IBM's three-pronged approach seeks to help patent examiners learn when a patent application is sought for software that's already in the public domain. The computer companies are building a searchable database that includes open source software and the date of its creation to assist patent examiners.

They are also working with the patent office to create an interactive Internet service that would give people an easy way to look at patent applications so they can alert patent officials when an application covers something already in use.

Also, IBM is working with academic researchers in an effort to create an automated system to evaluate the quality of a patent application. This would be an objective, computer-driven system that would point out when a patent application uses terms, for example, that it doesn't define.

"This is an unprecedented effort," said David Kappos, IBM vice president and assistant general counsel for intellectual-property law.

Traditionally, people in the private sector who invent something hire an attorney, file a patent application and then leave the rest to the government. But technology's quickening pace is too much for any one agency to master, Kappos said, and people in the tech community realize they must do their part if the nation's patent system is to survive.

IBM's initiative aims at patentable software and products related to the Internet, Kappos said. As it begins to make a difference in patent application processing later this year and in 2007, he predicts, the use of interested outsiders who are technically able to help patent examiners will spread to areas of intellectual property outside of software.

Holland joins McLeod: A veteran of the telecom wars is jumping back into the fray for one more go at stealing customers from giants like AT&T Inc. and Verizon Communications Inc.

Royce Holland this week signed on as chief executive of McLeodUSA Inc., a Cedar Rapids, Iowa-based competitive local exchange carrier that just emerged from bankruptcy.

In 1988 Holland was a co-founder of Metropolitan Fiber Systems, a pioneering firm that laid optical fiber in downtown Chicago to give customers an alternative to Illinois Bell. After MFS was sold to WorldCom in 1996, Holland founded Allegiance Telecom Inc., which eventually was sold to XO Communications Inc.

Like other upstarts still standing, McLeod faces fierce competition from AT&T and Verizon, but Holland is confident his firm can win customers by offering more personalized service.

"A lot of customers would rather use a smaller carrier because we're more responsive," Holland said.

In terms of revenue, McLeod is third largest among competitive carriers, behind XO and Time-Warner, Holland said. He expects there will be more consolidation among the smaller players and that a large independent alternative carrier may emerge.

"It would be a company comparable to what MCI was when it stood against AT&T," he said. But the big boys probably aren't worried about McLeod and its peers, Holland acknowledged.

"I think the competitors they really fear are the Googles and the Microsofts," he said. "The Internet companies are innovative and have tons of money. We want to team with them whenever possible."

jvan@tribune.com

NOTES: TECHNOLOGY

LOAD-DATE: January 14, 2006

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BusinessWeek
Business Week

February 13, 2006

SECTION: News: Analysis & Commentary: MARKETS; Pg. 39 Vol. 3971

LENGTH: 706 words

HEADLINE: A SOTHEBY'S FOR FOR INVENTORS;
Patents are going up for auction -- and some big-name companies will be selling

BYLINE: By Michael Orey

BODY:

Last year, Dean Becker, an avid collector of classic cars, was thumbing through a catalog for an automobile auction. Why not sell patents the same way, he thought. This April, Ocean Tomo, a firm where Becker is a managing director, will do just that. It has lined up a British auctioneer to take the podium at The Ritz-Carlton San Francisco and sell off rights to everything from earth-imaging technology to shrink-wrap.

Think of what eBay Inc. did for the junk in people's garages, and you get an idea of what Becker's idea could mean for intellectual property. ``Right now what you've got is a marketplace where nobody knows what the asset is worth,'' says **David Kappos,** an assistant general counsel at IBM who manages patents.

Chicago-based Ocean Tomo is part of a cottage industry of firms that want to cash in on patents. Traditionally, patent deals have been shrouded in secrecy and burdened by steep transaction costs. The primary method of extracting value, beyond selling a product based on an invention, has been licensing patent rights. But licensing negotiations are often arduous and need to be backed up by a willingness to litigate, which is expensive.

Auctions could help foster ``the emergence of a liquid market'' for buying and selling patents, says Kappos. So far more than 1,200 patents have been submitted to Ocean Tomo for sale from such companies as AT&T, BellSouth, American Express, and Kimberly-Clark.

If auctions become a regular feature of the patent world, they would help establish prices and a marketplace. ``I see this as a great opportunity [as] an independent inventor to really get exposure to a large base of companies that could commercialize my patents,'' says William L. Reber. Now on his own after working as an engineer for Walt Disney Co. and Motorola Inc., Reber is the creator of 48 patents he's putting up for sale at the auction, which takes place on April 5 and 6.

Kimberly-Clark Corp. will sell patents on a new shrink-wrap that it has decided not to commercialize, and BellSouth Corp. will auction off 20 patents in areas no longer part of its core business, such as search-engine technology. ``We think this is a good avenue to explore,'' says Bill Hartselle, a managing director in BellSouth's patent marketing unit.

MARKETING STUNT?

Patents from each seller will be grouped into lots when they relate to a common area. Some lots will include additional material such as prototypes of products, inventor notebooks, and, in one case, 80 hours with the inventor to aid in

transferring expertise. Ocean Tomo -- a name combining a legal acronym with the Japanese word for friend -- will get 25% of the sale price.

It's the ambition of Ocean Tomo's cofounder and CEO, James E. Malackowski, to turn his firm into an ``intellectual-capital merchant bank'' offering a range of products and services, including strategic advice for mergers and acquisitions of patent-rich companies, patent appraisal, and insurance against infringement claims. The auction is integral to that vision. It is, he says, the ``foundation for establishing patents as an investment asset class.'' In his view, patents are in the same spot as real estate was decades ago, before it was connected to the Wall Street spigot by such things as real estate investment trusts and mortgage-backed securities.

Some see the upcoming auction as little more than a marketing stunt. And Malackowski certainly has a propensity for promotion. Two firms he was affiliated with before founding Ocean Tomo in 2003 raised questions about items in his Web site resume that describe investment work he had done with them. Malackowski says the resume was accurate, but modified it following questions from BusinessWeek.

Still, many see Malackowski as a visionary. ``We've been talking about things like new ways of monetizing patents, new ways of leveraging [intellectual property],'' says Kappos of IBM. ``Ocean Tomo is right there inventing the future.''

Going, Going...

Here's a look at some of the patents being put up for sale in the

Ocean Tomo auction

KIMBERLY-CLARK	BELLSOUTH	3COM
4	20	1
PATENTS	PATENTS	PAT-ENT
Lithium ion batteries, shrink-wrap, sterilization technology	Search engines, wireless services, voice messaging	Flash memory

LOAD-DATE: February 9, 2006

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Copyright 2006 The Deseret News Publishing Co.
Deseret Morning News (Salt Lake City)

January 17, 2006 Tuesday

LENGTH: 567 words

HEADLINE: IBM, Novell helping rework patent system

BYLINE: Susan Decker Bloomberg News

BODY:

International Business Machines Corp., Novell Inc. and other companies are working with the U.S. government to improve the system for granting patents for software distributed in the so-called open-source movement.

IBM, the world's biggest computer company, said a joint effort with the U.S. Patent and Trademark Office aims to make it easier for government examiners to decide whether software is truly new. The companies offered to store millions of lines of software code for patent office use in reviewing applications.

The patent office hopes to avoid criticism such as it received in the 1990s over patents for Internet software. Critics said applications weren't reviewed rigorously enough because the office was unprepared for the new technology.

"For years now, we have been hearing concerns from the software community about the patent system," patent office Director Jon Dudas said in a statement. "It is important that those in the open source community are joining USPTO to provide resources that are key to examining software-related applications."

Open-source software is based on the Linux operating system that competes with Microsoft Corp.'s Windows, which runs 95 percent of the world's computers. It is made available for free on the Internet and can be changed by developers of software. Companies including IBM and Red Hat want to expand the use of Linux systems to help boost sales of their own Linux-based products and services.

The patent office and the Open Source Development Labs, composed of companies and academics, plan a Feb. 16 meeting to discuss a three-part cooperative program suggested by the nonprofit organization. One part is the storing of software code.

A second proposal is that the patent office alert the public to newly published patent applications in selected fields and invite comments.

That part of the plan would "use the expertise of the entire world of interested experts who have access to many millions of documents that no patent examiner, no matter how good he or she is, can have," said David Kappos, vice president of intellectual property law with IBM, based in Armonk, N.Y.

Third, the group wants to establish a "patent quality index" to let experts outside government assign a numeric value to elements of a patent, such as its clarity and its reference to drawings and prior inventions. Kappos said the index could be used to evaluate the validity of any patent, not just those related to software.

The patent office, in announcing the new relationship with the open-source organization, said it will work "to explore developing additional criteria for measuring the quality of software patents."

"This isn't an easy problem to solve," Kappos said, referring to what he called the patent office's "cautious" reaction. "We're biting off a big chunk. We need to undertake a comprehensive set of reforms and improvements. These three are comprehensive, somewhat ambitious, but achievable."

IBM, Novell helping rework patent system Deseret Morning News (Salt Lake City) January 17, 2006 Tuesday

Patent office spokeswoman Brigid Quinn said the agreement to work together is similar to ones the agency has with other industry groups, including biotechnology, and said any changes "have to work within the confines of the law and make it work for us."

"We're willing to look at new ways of measuring quality, if they make sense with the way we run our operation," Quinn said in an interview. "We're not closing our minds to anything." Contributing: Rebecca Barr

LOAD-DATE: January 17, 2006

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National Journal's CongressDaily

March 10, 2009 Tuesday
PM Edition

LENGTH: 536 words

HEADLINE: Specter's 'Gatekeeper' Language Gets Backing

BYLINE: Andrew Noyes

BODY:

Witnesses and stakeholders appearing before the Senate Judiciary Committee today said including "gatekeeper" language in patent legislation sponsored by Senate Judiciary Chairman**Patrick Leahy**and Sen.**Orrin Hatch**, R-Utah, would be a solid first step in addressing the controversial issue of how damages are calculated in infringement lawsuits. Such language was backed by Judiciary ranking member**Arlen Specter**and Sen.**Dianne Feinstein**, D-Calif., when a similar bill was under consideration in the 110th Congress. The Specter-Feinstein proposal, which would provide courts with clearer requirements on handling evidence of infringement and determining damages, was not included in the current version or in the bill that passed Leahy's panel in July 2007. That legislation stalled and was shelved for reintroduction this year.

Micron Technology CEO Steven Appleton, IBM Vice President **David Kappos**, Tessera Vice President Taraneh Maghame, Stanford Law School professor Mark Lemley and Intellectual Property Owners Association Executive Director Herb Wamsley all praised the gatekeeper concept. However, Appleton, Kappos and Lemley want the bill to go further to address the value of an entity's contributions to a patent. Leahy called the Specter-Feinstein proposal "constructive," pledging to work with members and industry stakeholders to craft the right language. Feinstein vowed not to vote for any bill unless various interests could find middle ground. "High-tech seems to feel they'll get whatever they want," she said. "No one element ... should rule the roost."

Specter cautioned that a case slated to go before the U.S. Court of Appeals for the Federal Circuit later this year could shed new light on the scope of the "entire market value" standard, suggesting Leahy postpone a markup until that case is heard. "If it takes a little more time, we'll have to spend the time," Specter said. Meanwhile, Kappos said lawmakers should weigh the potential impact of a recent Supreme Court ruling that patent law cannot be used to control the subsequent use or disposition of a product "that substantially embodies a patent" once the product has been sold.

The witnesses painted vastly different pictures of how the legislation, as introduced, could affect the nation's economy, particularly the impact of damages language. Appleton said his firm spent $30 million in 2008 defending against what he said was unnecessary litigation. He also argued that in the tech sector alone, 100,000 jobs would be crated over five years if Leahy's bill passed. For its part, IBM's Kappos noted his company earns about $1 billion of intellectual property-related revenue annually and has been the leading assignee of U.S. patents for 16 years. "Failure to act [on patent reform] will harm the nation's economy at a time when we can ill afford it," Kappos said. But Maghame argued Leahy's language would diminish the value and enforceability of patents, particularly among small firms such as Tessera, and lead to a "massive and irreversible transfer of wealth" abroad. Johnson & Johnson Chief IP Counsel Philip Johnson, who opposes the damages text as written, called on Congress to "preserve and enhance the patent system's incentives."

LOAD-DATE: March 10, 2009

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National Journal's CongressDaily

June 19, 2009 Friday
AM Edition

LENGTH: 349 words

HEADLINE: IBM Executive Picked To Run Patent And Trademark Office

BYLINE: Andrew Noyes

BODY:

President Obama on Thursday nominated IBM Assistant General Counsel **David Kappos** to become director of the Patent and Trademark Office -- a role that will put him on the front lines of the debate over how and whether to overhaul the U.S. patent system.

Kappos testified this year in support of legislation sponsored by Senate Judiciary Chairman**Patrick Leahy**that would make sweeping changes to a regime he believes needs to be updated to accommodate 21st century business models.

At the hearing, Kappos went to bat for Leahy's proposal to drastically alter how courts award damages in patent infringement lawsuits, which was fought by pharmaceutical, biotechnology and manufacturing interests.

"The current legal standard does not provide the certainty needed to enable modern business to operate effectively," he told the committee, saying that engineers' time is too often spent defending against costly, time-consuming litigation. The provision was eventually watered down, and the bill passed the committee, 15-4, in April.

Leahy issued a statement calling Kappos, who joined IBM as an engineer in 1983, "exceptionally qualified" to lead the PTO, which faces serious challenges in the recession. The agency is battling a backlog of more than 750,000 applications. It also has cash flow problems, internal cutbacks and a slump in applications filed and patents granted.

"The need to act is urgent, the goal is achievable, and failure to act will harm our nation's economic interests," Kappos said in his testimony. IBM was the top U.S. patent grantee in 2008 with 4,186 patents, according to IFI Patent Intelligence.

Kappos has long been viewed as a top contender for the job, which carries the tile of undersecretary of Commerce for intellectual property.

A spokesman for Senate Judiciary ranking member**Jeff Sessions**said his boss believes Kappos' credentials and experience are impressive and looks forward to evaluating his nomination. Commerce Secretary Locke issued a statement saying Kappos "will be a strong voice for patent reform" and will be charged with drastically reducing the patent backlog.

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January 14, 2009 Wednesday 1:58 PM EST

LENGTH: 192 words

HEADLINE: IBM gives more ideas to the public

BODY:

Jan. 14, 2009 (Digital Journal delivered by Newstex) -- IBM, who has received thousands of patents from the government, plans to give out over 3,000 items per year to the public in what is known as defensive publishing.According to the New York Times, receiving 4,186 patents from the government in just the last year, IBM is planning to make some of the items it does not want to patent, to the public.In what is known as defensive publishing, IBM plans on giving out about 3,000 inventions per year. This will prevent other companies from being able to patent these ideas themselves. David Kappos of IBM states that it is the time for the company to try something new.Through defensive publication, IBM wants to promote topics such as health care, education and the environment. IBM plans to make public inventions such as allowing a computer to shut down when a computer is not being used, using RFID tags to alert when it has been removed from its location.Though IBM is now focusing on its more advanced technological inventions, it still believes that these publicly distributed items are still very important. Newstex ID: DIJO-0001-31051019

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BusinessWeek online

Business Week Online

June 2, 2009 Tuesday

SECTION: TOP NEWS

LENGTH: 762 words

HEADLINE: Supreme Court to Review 'Business Method' Patents;
The high court will decide if such things as financial products and Internet commerce systems deserve intellectual-property protection

BYLINE: Michael Orey

BODY:

The U.S. Supreme Court announced on Monday, June 1, that it would take up a major issue in intellectual-property law: whether patents should be granted for what are known as business methods. Many financial, accounting, and e-commerce firms have rushed to obtain patent protection for such things as ways to structure financial products, manage organizations, or transact business on the Internet.

The court said it would consider a case involving a method for hedging risk in commodities trading. A claimed patent on this process, filed in 1997 by inventors Bernard Bilski and Rand Warsaw, was rejected by the U.S. Patent & Trademark Office on the basis that it simply involved a mental process and did not need any technology to implement. That rejection has been upheld though various appeals.

By agreeing to weigh in on the case, the high court is venturing into controversial terrain. Critics of business-method patents say it was never the intent of the law to protect such things, which in their view are often far closer to abstract concepts or mathematical algorithms rather than physical inventions. Proponents say they are key to promoting innovation in today's knowledge- and service-based economy.

In reversal, IBM opposes the patents

Whichever side the Supreme Court takes on the issue is likely to be of major significance. "This case will impact American innovation for at least a decade or more because what we're talking about is the outer bound of what is patentable," says Robert Sachs, a patent attorney at Fenwick & West in San Francisco.

Businesses come down on both sides of the issue. IBM (IBM), which has obtained a slew of business-method patents, filed an amicus brief in what is known as the Bilski case, stating that the company is now opposed to them. IBM maintains that the patents are not needed to promote innovation; businesses would come up with the products even without patent protection. "You're creating a new 20-year monopoly for no good reason," IBM's top in-house patent attorney, David Kappos, told BusinessWeek last year.

Accenture (ACN), the big consulting and technology services firm, vigorously supports business-method patents. "Why shouldn't new techniques for managing organizations be entitled to patent protection?" asks Wayne Sobon, Accenture's intellectual-property director, in an interview. "It's exactly like any other engineering field," he says. "Instead

of applying science to control electrons, [consultants] apply science and engineering principles to improve how people work better together."

The court's decision to review the Bilski case caught many observers by surprise. The Bilski patent claims are widely viewed as vulnerable to challenge on a number of grounds, and the sense among some experts was it would make a poor test case.

Halt to a 10-year patent flood

"This patent is a hard patent to defend on its merits as being a valuable advance," notes John Duffy, a professor at George Washington University Law School who is nonetheless a leading proponent of business-method patents. But Randy Lipsitz, an intellectual-property attorney at Kramer Levin Naftalis & Frankel in New York, says the court couldn't ignore it. "It's too big of an issue. Too many dollars were on the table," he says.

The Federal Circuit Court of Appeals, which hears all patent appeals, gave the green light to business-method patents in a 1998 ruling involving a technique for tracking investments in a portfolio of mutual funds. The Patent Office has since issued a flood of patents in this area. But last October, in what has come to be known as the Bilski case, the Federal Circuit affirmed the rejection of the Bilski patent claims. It issued a ruling that dials back significantly on what business-method inventions will be patent-eligible.

In the wake of that ruling, lower courts and patent examiners have increasingly been rejecting business-method patent claims, says Lipsitz. On May 27, for example, Florida Federal District Judge Paul Magnuson ruled that Bank of America's (BAC) "Keep the Change" program -- which rounds consumer credit-card purchases up to the nearest dollar and transfers the difference to a bank account -- didn't infringe the so-called "rounder" patent held by Every Day Counts, a Cape Coral [Fla.] company, on a system for distributing excess funds from spending transactions. The recent Bilski ruling had rendered that patent invalid, Judge Magnuson ruled.

The Supreme Court won't hear arguments in Bilski until its next term, which begins in October. A ruling is likely during the first half of 2010.

URL: http://www.businessweek.com/technology/content/jun2009/tc20090601_905686.htm

LOAD-DATE: June 2, 2009

No. 04-1350

IN THE

Supreme Court of the United States

KSR INTERNATIONAL CO.,
Petitioner,

v.

TELEFLEX, INC., *et al.*,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* INTERNATIONAL BUSINESS MACHINES CORPORATION IN SUPPORT OF NEITHER PARTY

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QUESTION PRESENTED

Whether the Federal Circuit erred in holding that a claimed invention cannot be held "obvious," and thus unpatentable under 35 U.S.C. § 103(a), in the absence of some proven "'teaching, suggestion, or motivation' that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed."

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United States Patent & Trademark Office, USPTO RELEASES ANNUAL LIST OF TOP 10 ORGANIZATIONS RECEIVING MOST U.S. PATENTS (Jan. 10, 2006) 1

62345.458

International Business Machines Corporation ("IBM") respectfully submits this brief pursuant to Supreme Court Rule 37.3 in support of neither party.[1] IBM urges the Court to vacate the judgment of the United States Court of Appeals for the Federal Circuit and remand the case in light of the non-obviousness test proposed herein.

INTEREST OF *AMICUS CURIAE*

IBM is widely acknowledged as a leader in patent acquisition and exploitation. In the last decade alone, IBM has received tens of thousands of patents; it has been awarded more United States patents than any other assignee in each of the past thirteen years, and it earns hundreds of millions of dollars every year from licensing its intellectual property portfolio.[2] IBM is also a globally recognized leader in the field of information technology research, development, design, manufacturing, and services. IBM's business interests encompass a broad range of industries and fields that enable, and are enabled by, information technology, including electrical engineering, software and computer technology, life sciences, physical and organic chemistry, business consulting, computer services, and the mechanical arts.

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[1] Pursuant to Supreme Court Rule 37.6, IBM states that no counsel for a party authored this brief in whole or in part, and no person or entity other than IBM has made a monetary contribution to the preparation or submission of this brief. All parties have consented to the filing of this amicus brief, and their consent letters are on file with the Clerk's Office.

[2] The United States Patent and Trademark Office reported that in 2005, IBM received 2,941 patents, which is over 1,100 more United States patents than any other company. *See* United States Patent & Trademark Office, USPTO RELEASES ANNUAL LIST OF TOP 10 ORGANIZATIONS RECEIVING MOST U.S. PATENTS (Jan. 10, 2006), *available at* http://www.uspto.gov/web/offices/com/speeches/06-03.htm (last visited Aug. 17, 2006).

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In light of its large patent portfolio, diverse business, and innovative research and development, IBM has an interest in this case both as a patent holder and as a manufacturer subject to infringement claims. That is, as one of the most successful licensors of patented technology in the world, IBM relies on its patent rights to secure licenses. And, as a large corporation focused on offering innovative products and services in a broad range of fields, IBM is frequently forced to defend against charges of infringement.

IBM thus has a strong interest in maintaining a fair patent system that promotes innovation in all industries and properly balances the interests of the patent owner, the accused infringer, and the public, rather than favoring any particular party. IBM's interest is in establishing clear rules for a workable patent system that will provide increased certainty about the scope and validity of patent rights for patent owners, who rely on those rights to enforce their patents, and for members of the public, who rely on understanding a patent's exclusive scope to determine what is, and is not, in the public domain.

STATEMENT

This case presents one of the most fundamental and frequently recurring questions in patent law—how the requirement that an invention be "non-obvious" applies to a claimed invention where all of the invention's elements are found in the prior art, *e.g.*, previously published references.

1. The Patent Act of 1952, 35 U.S.C. §§ 100 *et seq.*, provides that an invention is patentable only if it satisfies three independent requirements. *See Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (observing that "patentability is dependent upon three explicit conditions: novelty and utility as articulated in § 101 and § 102, and non-obviousness . . . , as set out in § 103").

First, the claimed invention must be "useful"—the Act's "utility requirement." *See* 35 U.S.C. § 101. Second, the

claimed invention must not have been, among other things, previously "known or used by others in this country," or "patented or described in a printed publication in this or a foreign country"—the requirement of newness or "novelty." *Id.* § 102 (a), (b). And, third, the invention must not "have been obvious at the time the invention was made" to a person of "ordinary skill in the art"—the "non-obviousness" requirement at issue here. *Id.* § 103(a).

2. The question whether an invention satisfies the Patent Act's requirements is subject to consideration through two separate procedural vehicles established under the Patent Act.

Initially, a determination of patentability is made administratively as a result of the patent application process before the U.S. Patent and Trademark Office ("PTO"). As part of this process, the applicant seeking to patent an invention submits, among other things, a specification, *see* 35 U.S.C. § 111(a)(2)(A), which is a "clear" and "concise" written description of the invention, and may also submit a drawing. *Id.* §§ 112, 113. The applicant must conclude his specification with a claim or claims that "poin[t] out and distinctly clai[m] the subject matter which the applicant regards as his invention." *Id.* § 112. The specification and claims are examined by the PTO to determine the patentability of the claimed invention and define the scope of protection afforded by the patent. In addition, they are used in statutory proceedings for review of PTO decisions—before the Board of Patent Appeals and Interferences, the United States District Court for the District of Columbia, or the Court of Appeals for the Federal Circuit—if the PTO determines that an application is not patentable and review is sought. *See id.* §§ 134, 141, 145. Thus, the patent application process calls for the creation of the specification and claims, which are intended to provide notice to the public and reviewing bodies of the nature and scope of the invention covered by the patent. *See Warner-Jenkinson*

Corp. v. Hilton Davis Chem. Co., 520 U.S. 17, 29 (1997) (referring to "the definitional and public notice functions of the statutory claiming requirement").

The validity of a patent may also be reviewed by federal courts in patent infringement actions. *See generally* 35 U.S.C. § 271. That is, where a patent is allegedly infringed, the patentee may sue to enforce its right to exclude others and seek relief in an appropriate federal court. In response, the defendant may challenge the "validity . . . of the patent," including whether the claimed invention satisfies the requirements of utility, novelty and non-obviousness. *Id.* § 282.

As a matter of patent policy, the requirements for patentability and patent validity should be clear and predictable. As the Court has explained, "[t]he monopoly [conferred by a patent] is a property right; and like any property right, its boundaries should be clear." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 730 (2002). Otherwise, the public cannot discern the scope of the patent until after all infringement litigation has concluded and will not invest in innovative products that might potentially fall within the patent's scope. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989).

3. This case concerns the meaning and application of the non-obviousness requirement in cases where a claimed invention is a combination of elements found in two or more prior art references. In the proceedings below, the Federal Circuit held that an invention combining such elements is non-obvious unless the prior art teaches, suggests, or motivates their combination—the Federal Circuit's "teaching-suggestion-motivation test." *See* Pet. App. 1a-17a. To make this showing, the Federal Circuit requires evidence of the "*specific understanding* or principle within the knowledge of the skilled artisan that would have motivated

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one with no knowledge of [the] invention to make the combination", in "the particular manner claimed" in the patent. *Id.* at 11a-12a (internal quotation marks and citation omitted; emphasis added). Thus, according to the Federal Circuit, an invention combining elements in the prior art is non-obvious absent "specific findings as to a suggestion or motivation" to make the patented combination. *Id.* at 12a.

SUMMARY OF THE ARGUMENT

As a company that is both a patent holder relying on its patent rights to secure licenses and a global provider of diverse products and services subject to claims of infringement by others, IBM has a unique interest in establishing a balanced, clear, and practically-applicable test for non-obviousness. In its view, the approaches suggested to this Court to determine non-obviousness either overly-restrict or overly-broaden the non-obviousness requirement, or lack the clarity necessary to be practically applicable.

For example, the Federal Circuit's current application of the teaching-suggestion-motivation test renders far too many trivial inventions non-obvious and thereby results in the granting and successful enforcement of many meritless patents. By holding, as it did below, that a combination of references is obvious only where the prior art *specifically* teaches or motivates the combination, the Federal Circuit has raised the evidentiary bar so high that, to demonstrate obviousness, it effectively requires a complete *written* explanation in the prior art references to make the claimed combination. Trivial combinations, however, are rarely the subject of published material.

The alternate tests suggested by KSR and the Solicitor General, respectively, are too difficult to satisfy and too amorphous to provide a clear and workable rule. KSR would have this Court eliminate the Federal Circuit's longstanding teaching-suggestion-motivation test entirely and examine, instead, whether the combination of existing elements results

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in an invention with new "synergies" or "new functions." This test is unsupported by the language of § 103, is inconsistent with the weight of this Court's precedents, would lead to hindsight determinations that inventions are obvious, and would work too dramatic a shift in patent law. The Solicitor General, while properly recognizing a role for the teaching-suggestion-motivation test, argues that the test should not be the exclusive means to show obviousness but does not define what the other tests should be. The Solicitor General's recommendation thus lacks clarity, will effectively relegate determinations of non-obviousness to infringement litigation, and will deprive the public of effective notice of the scope of patent rights.

IBM proposes a different test for non-obviousness that is consistent with the Patent Act and existing precedents, is clear and workable, and strikes a balance between all of the various approaches heretofore suggested to the Court: retain the basic teaching-suggestion-motivation test, but apply a rebuttable presumption that elements found in multiple prior art references would be combined by the skilled artisan, when all of the elements are found in references within the "analogous art." Analogous art is a well-known and long-established concept in patent law referring to prior art derived from the field of the problem or invention; it already defines boundaries on the scope of prior art considered for non-obviousness determinations. *See infra* pp. 18-19. A patent applicant can narrow and focus the scope of the art to which the presumption applies, moreover, by narrowing and focusing the scope of the claimed invention during the patent application process. The applicant can also rebut the presumption with evidence that a skilled artisan would not have been motivated to combine the references. Secondary considerations of non-obviousness would remain probative of the ultimate determination of obviousness as under current law but would not be available to rebut the presumption unless those considerations are otherwise probative of the

skilled artisan's motivation to combine. By encouraging the patent applicant to define the scope of the invention more precisely in the application process in order to narrow the body of art from which presumptively combinable references will be drawn, the scope and validity of the issued patent will be better defined in the public record of the application process. Thus, the applicant and public will be better positioned to understand the patent's scope without resort to litigation, which will advance the intent of the patent system to promote innovation.

ARGUMENT

I. THE FEDERAL CIRCUIT'S CURRENT APPLICATION OF THE TEACHING-SUGGESTION-MOTIVATION TEST IS CONTRARY TO STATUTE AND SOUND PATENT POLICY.

The Federal Circuit currently requires that patent examiners and challengers provide *specific* evidence that a combination was taught or suggested in the prior art to show that an invention combining elements in the prior art is obvious. This formulation of the teaching-suggestion-motivation test is flawed, because it raises the bar for showing obviousness so high that it effectively collapses the novelty and non-obviousness tests for patentability and materially diminishes the quality of patents.

A. The Federal Circuit's Current Application Of The Teaching-Suggestion-Motivation Test Is Effectively Equivalent To The Test For Novelty.

It is well-established that the utility, novelty, and non-obviousness requirements are separate and independent. *See* 35 U.S.C. §§ 101-03. As this Court has recognized, "the structure of these three sections indicates that patentability is dependent upon *three* explicit conditions: "novelty and utility as articulated and defined in § 101 and § 102, and

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non-obviousness . . . as set out in § 103." *Graham*, 383 U.S. at 12.

With respect to novelty and non-obviousness, the former examines whether an express description of a claimed invention exists in a single prior art reference, while the latter examines whether a claimed invention can be deduced from a single or multiple references. Thus, "[t]he non-obviousness requirement *extends* the field of unpatentable material *beyond that which is known to the public* under § 102, to include that which could readily be *deduced* from publicly available material by a person of ordinary skill in the pertinent field of endeavor." *Bonito Boats*, 489 U.S. at 150 (emphasis added).

Contrary to Congress's intent to define three separate requirements for patentability, however, the Federal Circuit's current application of the teaching-suggestion-motivation test effectively equates novelty and non-obviousness where the patent at issue involves a combination of existing elements. To demonstrate obviousness, the court requires (as it did below) not only evidence that all the elements of the claimed invention are found in the prior art, but also evidence of the "*specific understanding* or principle within the knowledge of the skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination" in "the particular manner claimed" in the patent. Pet. App. 11a-12a (internal quotation marks and citation omitted; emphasis added). The Federal Circuit has typically applied this evidentiary requirement of a specific teaching or motivation so strictly that it is extremely difficult to prove obviousness without producing an explicit written statement in the prior art that teaches or suggests the combination. *See, e.g., In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some

concrete evidence in the record in support of these findings.").[3] Thus, as a practical matter, the only way to prove a specific teaching to combine elements is to ferret out prior art that *explicitly* teaches or motivates the combination.[4]

This is, for all intents and purposes, the test for novelty. The purpose of § 102's novelty requirement is "to exclude from consideration for patent protection knowledge that is already available to the public" in the prior art. *Bonito Boats*, 489 U.S. at 148. The purpose of § 103 is to exclude from patent protection knowledge that can be *deduced* from the prior art. *Id.* at 150. But, the Federal Circuit has raised the evidentiary requirement for the teaching-suggestion-motivation test so high that obviousness, like a lack of novelty, can effectively be demonstrated only when the claimed combination is *expressly* taught in the prior art.

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[3] *See In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (where the Board of Patent Appeals and Interferences "rejected the need for 'any specific hint or suggestion in a particular reference' to support the combination of . . . references" and relied instead on the common knowledge of those skilled in the art, the Federal Circuit held that the Board had omitted from its analysis "a relevant factor required by precedent [that caused it to commit] both legal error and arbitrary agency action"). *See also In re Kotzab*, 217 F.3d 1365, 1370-71 (Fed. Cir. 2000); *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed Cir. 2000).

[4] After this Court issued its order calling for the views of the Solicitor General on whether *certiorari* should be granted, the Federal Circuit suggested that "the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references." *See In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) (internal quotation marks omitted). The Federal Circuit, however, has not consistently endorsed a test for an "implied" teaching, suggestion or motivation. Moreover, the court's evidentiary requirements make satisfying any implied test extremely difficult.

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B. The Federal Circuit's Current Application Of The Teaching-Suggestion-Motivation Test Has Proven Unduly Burdensome And Has Resulted In The Issuance And Successful Enforcement Of Trivial Patents.

The Federal Circuit's approach to non-obviousness has undercut patent law and policy.

First, the court's current application of the teaching-suggestion-motivation test is inconsistent with the Patent Act and this Court's precedents. Section 103 of the Patent Act provides that non-obviousness is to be determined, not by express references in the prior art, but by the deductions of a "person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). In light of this language, this Court has long recognized that "the 'obviousness' test of § 103 is not one which turns on whether an invention is equivalent to some element in the prior art but rather whether the difference between the prior art and the subject matter in question is a difference sufficient to render the claimed subject matter unobvious *to one skilled in the applicable art*." *Dann v. Johnston*, 425 U.S. 219, 228 (1976) (internal quotation marks and citation omitted; emphasis added). Thus, "in assessing obviousness, the analysis should ascribe to the person having ordinary skill in the art an ability to combine or modify prior art references that is consistent with the creativity and problem solving skills that in fact are characteristic of those having ordinary skill in the art." Federal Trade Commission, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy*, Ch. 4, at 15 (Oct. 2003) ("FTC Report") *available at* www.ftc.gov/os/2003/10/innovationrpt.pdf (last visited Aug. 17, 2006). Because the effect of the Federal Circuit's approach is that the teaching must *explicitly* exist in the prior art, the Federal Circuit ascribes no deductive capability to the person having ordinary skill in the art and thus has effectively eliminated § 103's requirement that non-

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obviousness determinations be based on such a person's deductive skills.

Second, the Federal Circuit's application of the test has reduced patent quality. There can be no debate that "creative people generally speaking strive to publish non-obvious information. So if it is obvious to those of skill in the art to combine references, it is unlikely that they will publish such information." National Research Council of National Academics, *A Patent System for the 21st Century*, 59, 90 (2004), *available at* http://www.nap.edu/html/patentsystem/0309089107.pdf (last visited Aug. 17, 2006) ("NRC Study"). Because skilled artisans tend not to publish obvious combinations, the Federal Circuit's effective requirement of an express teaching-suggestion-motivation means that inventions whose elements are all found among a combination of prior art references are being judged non-obvious "when only a modicum of additional insight [by those skilled in the art] is needed." FTC Report, Ch. 4, at 14.

Reducing the standards for obtaining a patent to the point where inappropriate patents for trivial variations are granted is contrary to the public good. As this Court observed well over one-hundred years ago:

> It was never the object of [patent] laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the art. It embarrasses the honest pursuit of business with fears

> and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.

Atl. Works v. Brady, 107 U.S. (17 Otto) 192, 200 (1883).

Third, the Federal Circuit's application of the teaching-suggestion-motivation test has shifted determinations of non-obviousness from the patent application process to infringement litigation. Application of the Federal Circuit's test places undue burdens on patent examiners who, with limited time and resources, are unlikely to locate an explicit teaching to combine the prior art before them and thus cannot effectively require applicants to clearly delineate the proper scope of their inventions. Consequently, the bar for patentability is set too low; many broadly-claimed and ill-defined patents are granted with little or no guidance in the record of patent prosecution for the public to examine and evaluate non-obviousness. Issued patents thus lack the "clarity" of property rights that this Court has found "essential to promote progress, because it enables efficient investment in innovation." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 730-31 (2002). "A patent holder should know what he owns, and the public should know what he does not" to satisfy "the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." *Id.*; *Bonito Boats*, 489 U.S. at 150.

In the absence of such clarity, the public cannot tell whether an issued patent is obvious in light of prior art until the patent is litigated and cannot otherwise discern the proper scope of the patent. After commencing litigation, the defendant is typically forced under the Federal Circuit's test to locate an express reference in the prior art without any clear record of the patent's scope, leading to the current

imbalanced state in which patent applicants can easily satisfy the non-obviousness requirement during the application process but defendants seeking to prove obviousness must overcome extremely stringent evidentiary requirements. As a result, innovation is hampered, because the risk of costly infringement litigation is too high.

Given the state of the law as described above, the risk of infringement litigation is unreasonably high, trivial patents are allowed to stand, innovation is hampered, and the public pays the price of unwarranted monopolies. This Court should not uphold the Federal Circuit's current application of the teaching-suggestion-motivation test.

II. THE ALTERNATE TESTS OFFERED BY KSR AND THE SOLICITOR GENERAL ARE FLAWED.

A. KSR's Approach Sets The Patentability Bar Too High, Injects Uncertainty Into The Patent System, And Will Block The Patenting Of Truly Meritorious Inventions.

To avoid the problems of the Federal Circuit's current approach, KSR proposes that this Court eliminate the teaching-suggestion-motivation test and hold that an invention combining elements found in prior art references is obvious "unless the combination produces 'a new or different function' or demonstrates a 'synergistic result.'" Pet. 14 (quoting *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 60-61 (1969)). Thus, in KSR's view, a combination is obvious if it "unites old elements with no change in their respective functions unless the combination results in a new function." *Id.* at 16. KSR's complete abandonment of the teaching-suggestion-motivation test, however, is inconsistent with the weight of this Court's obviousness precedents, unworkable, and too dramatic a departure from the Federal Circuit's existing test.

This Court's precedents establish that obviousness is determined by "deduc[ing] from publicly available material" what would have been obvious to "a person of ordinary skill in the pertinent field of endeavor." *Bonito Boats*, 489 U.S. at 150. For over 40 years, since *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court has held that this deduction is made as follows: "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *Id.* at 17. Thus, the Court judges non-obviousness over the relevant prior art as a whole, through the eyes of one skilled in the relevant art. While the existence of a synergy might provide evidence of non-obviousness, KSR's claim that an invention combining prior art references is non-obvious *only* if it results in a new synergy or function is a fundamental break from this Court's long-standing approach toward non-obviousness.

KSR's reliance on *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 274 (1976), and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), to demonstrate the purported validity of its "synergy" test, moreover, is misplaced. Neither case abandons *Graham*'s non-obviousness test. And, to the extent they can be read to add a *requirement* of "synergy" or "function" to the *Graham* analysis, the cases have been criticized as an inconsistent departure from this Court's precedents, unclear and unworkable. *See, e.g.*, Martin J. Adelman, PATENT LAW PERSPECTIVES § 2.6, at 2-421 (2d ed. 2006) (*Sakraida*'s synergy test did not "clarify the law and provide thoughtful guidance for lower courts. It will not reduce uncertainty and

confusion nor promote the orderly administration of justice").[5] After all, when an invention can be found obvious based solely on a subjective determination of synergy, the tendency will be to find the prior art references obviously combinable, regardless of whether it would have actually been obvious to make the combination. Thus, application of KSR's synergy test would lead to impermissible hindsight determinations of obviousness—the determinations will be impacted by "the temptation to read into the prior art the teachings of the invention in issue." *Graham*, 383 U.S. at 36; Adelman, *supra*, § 2.6, at 2-421.

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[5] *See also* F. Scott Kieff & Troy A. Paredes, *The Basics Matter At the Periphery of Intellectual Property*, 73 GEO. WASH. L. REV. 174, 178 (2004) (observing that in *Sakraida* and *Anderson's-Black Rock* "the Court reinjected confusion into the nonobviousness doctrine by contriving new requirements for 'synergism' and 'combination' patents"); Giles S. Rich, *Escaping The Tyranny of Words—Is Evolution In Legal Thinking Impossible?*, 60 J. PAT. OFF. SOC'Y 271, 296 (1978) (observing that the mistake in *Sakraida* was the Court's "apparently unthinking adherence to the outworn and unhelpful [] requirement for invention, after telling the world in *Graham* that Congress has emphasized non-obviousness as the operative test, which is the new statutory formulation") (internal quotation marks and citation omitted); David E. Wigley, *Evolution of the Concept of Non-Obviousness of the Novel Invention: From a Flash of Genius to the Trilogy*, 42 ARIZ. L. REV. 581, 597 (2000) ("After the *Anderson's-Black Rock* and *Ag Pro* decisions, confusion prevailed among the district courts and various circuits in their applications and opinions on § 103."); Note, Jeffrey A. Simenauer, *Patentability of Computer-Related Inventions: A Criticism of the PTO's View on Algorithms*, 54 GEO. WASH. L. REV. 871, 898 n.158 (1986) (observing that the synergistic "standard of patentability was not widely accepted because it was viewed as having a chilling effect on the promotion of science and the useful arts, a result clearly contrary to Article I, § 8, cl. 8 of the Constitution. This standard is also considered unreasonable because every invention ultimately comprises a combination of old elements") (citation omitted).

Completely abandoning the teaching-suggestion-motivation test, as KSR proposes, would be undesirable from a patent policy perspective. As KSR acknowledges, "[t]he Federal Circuit's 'teaching-suggestion-motivation test' has been applied in *hundreds* of cases," Pet. 3 (emphasis added), and practitioners, inventors, and businesses, including IBM, have come to rely on it. When reviewing such a long-standing test, "courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community." *Festo Corp.*, 535 U.S. at 739.

B. The Solicitor General's Approach Will Drive Non-Obviousness Determinations Into Infringement Litigation And Reduce Certainty And Clarity In The Patent System.

In his amicus brief supporting a grant of *certiorari*, the Solicitor General argues that the Court should retain the teaching-suggestion-motivation test but hold that the Federal Circuit erred in treating it as "the *exclusive* means of showing obviousness." Br. of U.S. at 13 (filed May 25, 2006) (emphasis in original). The Solicitor General further suggests that this Court leave these other tests largely undefined, because in his view, non-obviousness should be judged on a "case-by-case" basis. *Id.* at 11. Thus, the Solicitor General would have the Court turn obviousness into a sort of "I'll know it when I see it" test. While the Solicitor General's approach is an improvement on KSR's because it retains some role for the well-established teaching-suggestion-motivation test, it should not be adopted because it is ultimately standard-less.

This Court has repeatedly stressed the need for clarity in patent laws. *See supra* pp. 12-13. Thus, it has moved away from tests that require subjective determinations by judges, to objective tests that are readily applicable by patent examiners and readily understood by patent applicants and

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challengers. *See Festo Corp.*, 535 U.S. at 739; *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 65-66 & n.11 (1998).

The Solicitor General's test, however, fails to provide any clear standard for determining non-obviousness, leaving the determination to the courts on a "case-by-case" basis. This approach is perhaps more flawed than the current test for non-obviousness from a practitioner's perspective, because no one, not patent owners, challengers, nor the public, will be able to meaningfully judge the valid scope of a patent until *all* judicial review of the patent—both the patent application process and infringement litigation—is complete. Leaving the non-obviousness test as a purely subjective review of each case means that there is an enhanced potential for any reviewing body to examine the facts and disagree with the conclusions of the prior reviewing body. As a result, there can be no predictability in the patent process until the last court has completed its review of the patent.

Leaving the test for non-obviousness largely undefined and subjective will also inevitably lead to decisions by hindsight. Indeed, the Solicitor General's suggestion that non-obviousness be left to an undefined, case-by-case determination is, in this respect, akin to this Court's pre-1952 tests for patentability, which required judges to examine the subject of the patent as a whole and determine whether it constituted an "invention." *Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 151 (1950). Like this pre-1952 approach, the Solicitor General's determination would be "the culmination of subjective hindsight-ridden and inconsistent judicial determination . . . on the part of judges having no day-to-day familiarity with what would be obvious or unobvious to a person of ordinary skill in the art" as required by § 103. Adelman, *supra*, § 2.6, at 2-415. Accordingly, to provide the clarity that is essential for the proper operation of the patent system, this Court should not adopt the Solicitor General's standard-less and ill-defined test for non-obviousness.

III. APPLYING A REBUTTABLE PRESUMPTION TO THE CURRENT TEACHING-SUGGESTION-MOTIVATION TEST WOULD SATISFY STATUTORY REQUIREMENTS, COMPLY WITH THIS COURT'S PRECEDENTS, AND ADVANCE SOUND PATENT POLICY.

A. IBM's Approach Would Apply A Rebuttable Presumption That A Person Having Ordinary Skill In The Art Would Be Motivated To Combine Existing Prior Art References Within The Analogous Art.

IBM's approach to non-obviousness would retain the long-standing teaching-suggestion-motivation test, but establish a clear rule permitting the application of a rebuttable presumption that prior art references would be combined by one of ordinary skill in the art in certain appropriate instances. When this presumption applies, a specific showing of motivation, teaching, or suggestion to combine would not be required.

In IBM's view, references should be *presumed* combinable by a person having ordinary skill in the art where the references are within the scope of the "analogous art." Analogous art is prior art "in the field of the applicant's endeavor or, if not, then . . . reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). The doctrine of analogous art is a well-established and familiar concept in patent law that has its origin in this Court's 1895 decision in *C & A Potts & Co. v. Creager*, 155 U.S. 597 (1895), and already serves to define boundaries on the scope of prior art considered in non-obviousness determinations. *See, e.g., In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) ("Although § 103 does not, by its terms, define the art to which the subject matter sought to be patented pertains, this

determination is frequently couched in terms of whether the art is analogous or not, *i.e.*, whether the art is too remote to be treated as prior art.") (internal quotation marks, alterations, and citation omitted). *See also* 2 Donald S. Chisum, CHISUM ON PATENTS § 5.03[1][a] (2006) (discussing the doctrine of analogous art and its over 100-year history).

Basing a presumption on the analogous art best captures the innovative process, because such art is the very subject matter that one of ordinary skill would consider and use as the basis for combinations when making an invention. Thus, the presumption "consider[s] 'the reality of the circumstances,'" and reflects the "common sense" way to "decid[e] in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." *Oetiker*, 977 F.2d at 1447 (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)).

The relevant analogous art is initially defined in the patent application and may subsequently be narrowed through the application process. Indeed, the patent examiner must determine the scope of the analogous art, because an obviousness rejection can be based only on references within the analogous art. *See* Manual of Patent Examining Procedures ("MPEP") § 2141.01(a) (2005). To this end, the PTO already advises applicants to include a statement of the field of art in the specification, which informs the examiner's determination of the analogous art. *See* MPEP § 608.01(c) (stating, in relevant part that "[t]he Background of the Invention ordinarily comprises two parts: (1) Field of the Invention: A statement of the field of art to which the invention pertains"). As it is today, the burden of demonstrating that prior art references fall within the relevant analogous art would be initially on the patent examiner in patent application proceedings and on the party challenging the patent's validity in infringement proceedings. *See In re Bell*, 991 F.2d 781, 783 (Fed. Cir.

1993) (initial burden on the patent examiner); *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998) (burden on patent challenger); MPEP § 2141.01(a).

Once established, the presumption may be rebutted by evidence showing that a person of ordinary skill would not have been motivated to make the combination. Thus, rebuttal evidence might include proof that the combination was technologically infeasible or impossible at the time, or evidence that the prior art was "teaching away" from the combination. *See, e.g., Tec Air Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) ("There is no suggestion to combine, however, if a reference teaches away from its combination with another source.").[6] Certain secondary considerations, such as "commercial success, long felt but unsolved needs, failure of others, etc.," *Graham*, 383 U.S. at 17, that may be probative of whether there was any motivation to combine would also serve as rebuttal evidence, while other secondary considerations unrelated to such motivation would continue to have the same role that they do today: they would be used to bolster the ultimate conclusion of non-obviousness.[7] *See id.*; *see also* 2 CHISUM, *supra*,

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[6] *See also Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 961 (Fed. Cir. 1983) (holding that the "prior art's teaching away . . . [is] highly probative, objective criteria fully capable of serving as a foundation for the legal conclusion of nonobviousness"); *In re Sponnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969) ("[W]e believe that the multi-reference rejection affirmed below is improper for reasons existing within the disclosures of the references themselves, namely, that the references themselves teach away from the combination.").

[7] Under *Graham*, the factors courts must consider in determining obviousness are as follows: "the scope and content of the prior art," "differences between the prior art and the claims at issue," and "the level

§ 5.06[1][b][i] (observing that secondary considerations are used to "rebu[t] prima facie obviousness"). Under this approach, the familiar and traditional framework of non-obviousness, including the basic test set forth in *Graham* and the teaching-suggestion-motivation test would remain, while the adverse impacts of the Federal Circuit's overly-burdensome evidentiary requirement would be remedied.

The rebuttable presumption test recommended by IBM would increase patent quality by reducing the issuance and successful enforcement of patents on trivial combinations that, on their face, would have been obvious to a person having ordinary skill in the art. In addition, the test is fundamentally fair to the patent applicant, because the applicant controls the scope of the art to which the presumption applies by defining in the original application and the subsequent application process the proper scope of its invention. The test also appropriately recognizes that the applicant is in the best position to balance its interest in obtaining broad patent coverage against the risk of a successful obviousness challenge resulting from an expansive definition of the relevant analogous art. If an applicant narrows the field of analogous art to avoid a presumption of combinability, the representation will bind the applicant and can be used to restrict the scope of the patent's claims. *See* 35 U.S.C. § 112. Thus, because the

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of ordinary skill in the pertinent art." 383 U.S. at 17. In addition, "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." *Id.* at 17-18.

applicant defines the boundaries of the presumption through the scope of its invention, the proposed test appropriately encourages the applicant to arrive at the proper claim scope for its invention and to do so as part of the public record of the patent application.

B. The Rebuttable Presumption Approach Is Consistent With § 103 And This Court's Precedents.

IBM's proposed application of the teaching-suggestion-motivation test is superior to the other approaches proposed to the Court because it both preserves the intent of § 103 and is consistent with this Court's precedents.

First, the rebuttable presumption test is consistent with the language and intent of § 103(a). By its terms, § 103(a) provides that non-obviousness is judged "at the time the invention was made" according to what would have been known to a person of "ordinary skill in the art." 35 U.S.C. § 103(a). Presuming that references in the analogous art are combinable gives content and meaning to § 103's reference to a person of "ordinary skill in the art," because analogous art is what such a person would review as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *See Oetiker*, 977 F.2d at 1447. Moreover, the person having ordinary skill in the art is presumed to be a "mythically omniscient worker" with "perfect knowledge of all the pertinent prior art—however obscure its source." 2 CHISUM, *supra*, § 5.04[1][b] (citing *Wood*, 599 F.2d 1032). Thus, a presumption that analogous art references would be combined reflects the reality of the thought process of one ordinarily skilled in the art in view of the existing presumption that a person skilled in the art has

knowledge of that art. *See Oetiker*, 977 F.2d at 1447; *Wood*, 599 F.2d at 1036.[8]

Applying a rebuttable presumption is also consistent with Congress's intent to distinguish between novelty and non-obviousness. *See supra* pp. 7-9. The presumption establishes a clear body of art in which there is no need to

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[8] Applying IBM's proposed rebuttable presumption in infringement litigation is consistent with the statutory presumption of validity that attaches to issued patents. *See* 35 U.S.C. § 282. The proposed presumption does *not* establish obviousness, and thus invalidity, for two reasons. First, the proponent of the combination would still have to show that the combination results in the claimed invention. Second, if it does, the presumption would establish a motivation to combine references, placing the burden of coming forward with rebuttal evidence on the patent holder. The requirement to show that every element of the claimed invention is found in the prior art references and ultimate burden of persuasion remains on the patent challenger. The presumption that references within the prior art are combinable is thus consistent with the establishment of a *prima facie* case of obviousness. *See, e.g.*, *Recombinant Products & Nonobviousness: A Typology*, 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1, 17-18 (Feb. 1997) ("*Recombinant Products*") (describing instances in which a presumption of obviousness has been applied in chemical compound cases, resulting in the establishment of a *prima facie* case of obviousness). It is well-established, moreover, that evidentiary burden-shifting in general is consistent with the presumption of validity. *See Apotex USA, Inc. v. Merck & Co.*, 254 F.3d 1031, 1037-38 (Fed. Cir. 2001) (explaining that rules allowing for a *prima facie* showing of invalidity are "in accordance with the statutory presumption in 35 U.S.C. § 282, [because] the ultimate burden of persuasion remains with the party challenging the validity of the patent"); *Innovative Scuba Concepts, Inc. v. Feder Indus., Inc.*, 26 F.3d 1112, 1115 (Fed. Cir. 1994) ("While a patentee may have the burden of going forward with rebuttal evidence once a challenger presented a *prima facie* case of invalidity, the presumption of validity remains intact and the ultimate burden of proving invalidity remains with the challenger throughout the litigation.").

prove a specific teaching or motivation to combine references, thus giving weight to "that which could readily be deduced from publicly available material by a person of ordinary skill in the pertinent field of endeavor." *Bonito Boats*, 489 U.S. at 150.

Second, the rebuttable presumption's focus on the patent application process is consistent with this Court's precedents. In *Graham*, this Court observed that § 103 analysis is based on "the pertinent art existing at the time the invention was made and [is] implicitly tied to advances in that art." 383 U.S. at 14. The Court paid particular attention to how the applicant identified (or failed to identify) the invention during the application process, and rejected the applicant's argument concerning a distinguishing feature of the claimed invention because the feature was not "hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus, it is strange that all mention of it was omitted." *Id.* at 25 (internal quotation marks and citation omitted). Thus, *Graham* illustrates that the identification of, or failure to identify, the distinguishing features of an invention during the application process is pertinent to the evaluation of obviousness. *See id.* at 33 ("It is, of course, well settled that an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office.").

By establishing a presumption based on the analogous art, the rebuttable presumption test encourages the applicant to provide a clear record for determining the scope of analogous art and to identify with specificity the distinguishing features of the invention in order to limit the application of the presumption during and after prosecution. And, by encouraging the patent applicant to refine the scope of the relevant analogous art through the patent application process, the rebuttable presumption approach results in the clear and objective development in the public record of the scope of art to which the presumption applies. Thus,

members of the public and reviewing courts can later judge the relevant analogous art with far greater certainty when evaluating whether the presumption of combinability should apply, determining obviousness generally, or establishing the scope and meaning of the claims.

The rebuttable presumption approach is also consistent with this Court's approach to presumptions in the patent context. In *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), this Court considered whether a patent owner is estopped from relying on the doctrine of equivalents when the owner purposefully narrows the scope of its claims during the patent application process but fails to explain why. The Court held that "[w]here no explanation is established . . . the court should *presume* that the patent applicant had a substantial reason related to patentability for including the limiting element added by amendment." *Id.* at 33 (emphasis added). Subsequently, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 740 (2002), the Court extended this rebuttable presumption to the scope and meaning of the amendment itself, holding that "[a] patentee's decision to narrow his claims through amendment may be *presumed* to be a general disclaimer of the territory between the original claim and the amended claim." *Id.* (emphasis added).

Thus, this Court has previously found the application of a presumption appropriate in patent jurisprudence for reasons that are particularly compelling here. The presumption IBM proposes will give "proper deference" to the importance of "providing public notice," and "to the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable in a proffered patent application." *Warner-Jenkinson*, 520 U.S. at 33-34. Under the proposed test, the patent applicant controls the scope of art to which the presumption applies and bears the burden of rebutting the presumption. The public record of the application process will more definitively reflect the valid scope of the claimed

invention, enabling the patent process to fulfill its important public notice function and shifting the focus of the non-obviousness test from the litigation process to the patent application process.

C. The Rebuttable Presumption Test Provides A Workable Alternative That Advances Sound Patent Policy.

Applying a rebuttable presumption of combinability where the elements of an invention are all disclosed in the analogous art is a practically-applicable test that will provide notice to the public of a patent's valid scope and promote fairness and certainty in the patent system, thus encouraging innovation.

The rebuttable presumption test can be easily applied. The rebuttable presumption IBM proposes can be easily applied by patent examiners, courts, practitioners, and the public, because it builds on familiar existing practices. As explained in the preceding section, the application of a rebuttable presumption is nothing new in patent practice, *see* 35 U.S.C. § 282 (establishing a statutory presumption of patent validity); *Warner-Jenkinson*, 520 U.S. at 33-34; *Festo Corp.*, 535 U.S. at 740-41; *see also Recombinant Products*, *supra*, pp. 17-18 (explaining historical application of rebuttable presumption of obviousness in cases involving chemical analogs). The concept of analogous art, the standard by which the presumption is measured, is similarly well established, *see supra* pp. 18-19. Finally, because IBM's test impacts only the evidentiary requirements of the teaching-suggestion-motivation test, it preserves the familiar and important legal concepts underlying that test, and thus preserves settled expectations of the law.

The test provides clarity in the patent process. In addition to its practical advantages, the rebuttable presumption test focuses on promoting the Patent Act's overarching goal of "clarity" in patent rights—a clear benefit

over the Solicitor General's test. *See Festo Corp.*, 535 U.S. at 730. Because the patent and its prosecution history are in the public record and define the analogous art from which any rebuttable presumption is drawn, the public will be well informed of the parameters of the non-obviousness analysis, and inventors and interested members of the public (including alleged infringers) will be able to concretely evaluate patent validity based on non-obviousness without resort to litigation, ultimately promoting efficient innovation. *See* NRC Study at 46-47. This is a tremendous benefit because, as this Court has observed, "[i]f competitors cannot be certain about a patent's extent, they may be deterred from engaging in legitimate manufactures outside its limits, or they may invest by mistake in competing products that the patent secures." *Festo Corp.*, 535 U.S. at 732.

Although the proposed test will reduce the number of meritless patents for trivial combinations, proper application of the proposed presumption will not cause meritorious inventions to become unpatentable. The presumption will simply require the applicant to explain in greater detail the scope of the invention and the reasons why the cited references would not be combined. One of the recognized shortcomings of the current patent system is that it does not result in well-described patents. FTC Report Ch. 4, at 8-9 Allocating burdens per the proposed presumption will lead to a more robust application process and better-quality, more definite patents.

IBM's test also avoids the problem of hindsight that plagues KSR's proposed "synergy" test. The rebuttable presumption applies to references within the relevant analogous art, the scope of which is controlled by the applicant during the application process. As such, the combination of art is not premised on a reconstruction based upon a subjective, post-hoc impression of "invention" by an examiner or judge. The reviewing entity cannot pick and choose among references to combine, but is limited to the

particular field defined by the applicant. A resulting determination of combinability can also be rebutted by evidence showing that the person of ordinary skill in the art would not have been motivated to make it.

The rebuttable presumption test is fair. Finally, IBM's test is fair to all parties and across the various fields of invention. The test is fair to patent applicants because they control the breadth of the analogous art through their representations to the PTO. The test is also fair to the interested public and alleged infringers, because it removes from patentability those developments fairly described in analogous prior art, balances the applicant's interest in obtaining broad patent rights against the risk of invalidity under § 103 and ensures that the applicant will strike that balance in the public record, thus more clearly defining valid claim scope and providing notice to the public.

With respect to fairness across fields, it is well recognized that innovators in different fields encounter different patent examination standards for non-obviousness. *See* Dan L. Burk & Mark A. Lemley, *Is Patent Law Technology-Specific?*, 17 BERKELEY TECH. L.J. 1155, 1160-85 (2002).[9] The objective of non-obviousness jurisprudence is to allow for flexibility in the application of the law by focusing on the person having ordinary skill in the art, a standard that will differ by field. A rebuttable presumption based on the

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[9] Thus, innovators in some fields, in particular, chemical manufacturers, are promoting a stricter test for obviousness, while others are promoting a more lenient test based on interests specific to their respective industries. *See, e.g.*, NRC Study at 90-93. For example, chemical manufacturers often support the Federal Circuit's stringent obviousness evidentiary requirement, because chemical elements are well known, and the industry's goal is to find new ways to combine them. *Id.* at 91.

analogous art will be fair to all industries and will retain the field-sensitivity objective of current jurisprudence. The concept of the relevant "field" of analogous art is sensitive to the particular industry in which the patented invention will be practiced. In the chemical area, for example, a patent applicant can provide a precisely detailed description of the claimed invention, including narrow claims, resulting in a narrow field of analogous art to limit the presumption of combinability for obviousness. Also, the rebuttable presumption test fixes the determination of the scope of analogous art during the patent application process and does not allow for examination of post-issuance developments in the field. As industries and innovations become increasingly cross-disciplinary in nature, the analogous field of art concept can change, but the field in any particular patent application will be fixed during the patent application process. This approach is consistent with the Court's admonition that:

> The [non-obviousness] standard has remained invariable in this Court. Technology, however, has advanced—and with remarkable rapidity in the last 50 years. Moreover, the ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an evenhanded application to require that those persons granted the benefit of a patent monopoly be charged with an awareness of these changed conditions. The same is true of the less technical, but still useful arts. He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office.

Graham, 383 U.S. at 19. Thus, IBM's test is flexible enough to apply fairly to all industries and over time.

****

The Federal Circuit's teaching-suggestion-motivation test is clearly broken. The difficult question is how to fix it, because any new test for non-obviousness must be clear,

certain, practically-applicable, and sensitive to the settled expectations of the law. IBM's approach provides that clarity in a test that builds upon existing precedents and practices in a manner consistent with the Patent Act.

CONCLUSION

The Federal Circuit's decision should be vacated and the case remanded for further proceedings.

Respectfully submitted,

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No. 2007-1130
(Serial No. 08/833,892)

United States Court of Appeals for the Federal Circuit

IN RE BERNARD L. BILSKI AND RAND A. WARSAW

Appeal from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences

BRIEF OF *AMICUS CURIAE* INTERNATIONAL BUSINESS MACHINES CORPORATION IN SUPPORT OF NEITHER PARTY

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Bernard L. Bilski and Rand A. Warsaw v. _____

No. 2007-1130

CERTIFICATE OF INTEREST

Counsel for the (petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

International Business Machines Corporation certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

International Business Machines Corporation

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

The party listed above is the real party in interest

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

Amicus curiae International Business Machines Corporation has no parent corporation and no publicly held company that owns 10 percent or more of its stock.

4. ☑ There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

KIRKLAND & ELLIS LLP, Gregory S. Arovas, P.C., Timothy K. Gilman, Christopher Landau, P.C.

Date

Signature of counsel

Printed name of counsel

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International Business Machines Corporation (IBM) respectfully submits this brief as *amicus curiae* in support of neither party.

INTEREST OF *AMICUS CURIAE*

IBM is a globally recognized leader in the field of information technology research, development, design, manufacturing, and related services. During the company's nearly 100-year history, its employees have included five Nobel laureates, five National Medal of Science recipients, and seven winners of the National Medal of Technology. The United States Patent and Trademark Office (USPTO) has granted IBM tens of thousands of patents, including more patents than any other assignee for the past fifteen years. IBM is also the top-ranked assignee for patents issued in the USPTO classification that includes business methods.

In light of its sizeable patent portfolio and diverse business interests, IBM has a compelling interest in the development of clear and consistent rules governing subject matter patentability. IBM has frequently been involved in patent litigation, both as a patentee seeking to enforce its patent rights and as an accused infringer seeking to defend itself, and thus believes that it can provide a balanced view on

these important issues. IBM is committed to maintaining the integrity of the United States patent system, and assuring that the statutory standard for patentability is defined in a manner consistent with established principles of law.

INTRODUCTION AND SUMMARY OF ARGUMENT

For well over a century, the Supreme Court has made it clear that the scope of patent eligible subject matter includes processes and methods. Congress formally codified that settled legal understanding in 1952 by incorporating the word "process" into § 101 of the patent statute, which defines the scope of patentable subject matter. The meaning of the word "process" in § 101, thus, is informed by judicial precedent from before and after the enactment of the 1952 statute.

IBM respectfully submits that the gravamen of that precedent, as informed by the constitutional objective of "promot[ing] the Progress of Science and useful Arts," is that a patentable "process" within the meaning of § 101 is one that involves a technological contribution—namely, a process that either (i) is tied to a particular machine or apparatus, or (ii) causes transformation or reduction of an article to a different state or thing, and in either instance produces technologically

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beneficial results. This test sets forth a reasonable and balanced standard for subject matter eligibility.

The foregoing synthesis of the relevant precedents, IBM further submits, is consistent with this Court's holdings on this issue, including those of *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Commc'ns, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999). Accordingly, this Court need not overrule either of those cases. However, *State Street* and *AT&T* should be clarified to limit the scope of patent eligible processes to those that involve technological contributions. Some have read isolated language in *State Street* to suggest the contrary, *i.e.*, that utility alone is the touchstone for patentable subject matter. That suggestion is incorrect. Accordingly, this Court can and should now repudiate that suggestion and clarify that inventions which do not involve technological contributions are outside the scope of patentable subject matter.

Finally, no sound patent policy supports patent protection for non-technological processes, including non-technological business methods. Patent-based incentives are simply not needed to spur business method innovation. To the contrary, allowing non-technological business

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methods to be patented would only stifle competition without promoting innovation.

STATEMENT OF THE ISSUES ADDRESSED BY *AMICUS CURIAE*

Amicus curiae IBM addresses the following questions presented by the Court in its February 15, 2008 order: [1]

"2. What standard should govern in determining whether a process is patent-eligible subject matter under section 101?

* * *

4. Whether a method or process must result in a physical transformation of an article or be tied to a machine to be patent-eligible subject matter under section 101?

5. Whether it is appropriate to reconsider *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352

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[1] As an *amicus* supporting neither party, IBM takes no position on Questions 1 and 3, which relate to the merits of this particular case. To the extent that Question 3 extends beyond the merits of this particular case, IBM submits that the answer to that Question is subsumed by the answer to Question 2.

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(Fed. Cir. 1999), in this case and, if so, whether those cases should be overruled in any respect?"

ARGUMENT

I. Patent Eligible Subject Matter For Processes Should Be Limited To Processes That Involve Technological Contributions. (Questions 2 & 4)

The United States Constitution specifically empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to ... Inventors the exclusive Right to their ... Discoveries," U.S. Const. art. I, § 8, cl. 8, and Congress responded by enacting a patent statute as early as 1790, *see, e.g., Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). Since the most recent general revision of the patent laws in 1952, the scope of patent eligible subject matter has extended to "any new and useful *process*, machine, manufacture, or composition of matter." 35 U.S.C. § 101 (emphasis added).

A. Supreme Court Cases Before 1952 Provide Context For Understanding The Meaning Of "Process" In § 101.

Congress incorporated the word "process" into the statute as part of the 1952 revision and defined that word simply as a "process, art, or method, ... includ[ing] a new use of a known process, machine,

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manufacture, composition of matter, or material." 35 U.S.C. § 100(b). However, Congress in 1952 was not writing on a blank slate. To the contrary, for a century before then, the Supreme Court had made it clear that patent protection could extend to processes. "Although the term 'process' was not added to 35 U.S.C. § 101 until 1952 a process has historically enjoyed patent protection because it was considered a form of 'art' as that term was used in the 1793 Act." *Diamond v. Diehr*, 450 U.S. 175, 182 (1981).[2]

The Supreme Court had made it clear long before 1952 that not *all* processes can be patented. Thus, in *O'Reilly v. Morse*, 56 U.S. (15 How.)

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[2] *See also Tilghman v. Proctor*, 102 U.S. 707, 722 (1881) ("A manufacturing process is clearly an art, within the meaning of the law."); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877) ("That a process may be patentable ... cannot be disputed. ... In the language of the patent law, it is an art."); *Corning v. Burden*, 56 U.S. (15 How.) 252, 267 (1854) ("A process, *eo nomine*, is not made the subject of a patent in our act of Congress. It is included under the general term 'useful art.'"); S. Rep. No. 82-1979, at 5 (1952), *reprinted in* 1952 U.S.C.C.A.N. 2394 ("Th[e] language [of the predecessor provision to § 101] has been preserved except that the word 'art' which appears in the present statute has been changed to the word 'process.'"); P.J. Frederico, *Commentary on the New Patent Act* (1954), reprinted in 75 J. Pat. & Trademark Off. Soc'y 161, 176 ("The word 'art' in the corresponding section of the old statute had been interpreted by the courts as being practically synonymous with process or method, ...").

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62 (1854), the Supreme Court revoked Samuel Morse's eighth claim, which sought to patent the process of transmitting messages using an electromagnetic current, untethered to any particular machine or practical application. *See id.* at 112. As the Court explained, that claim was "not warranted by law" because it would protect, and thereby prevent use of, all conceivable solutions to accomplish the recited result. *Id.* at 113. Thus, Morse was entitled to a patent only for the specific practical application of electromagnetism that he actually invented: "[H]e has not discovered that the electro-magnetic current, used as motive power, in any other method, and with any other combination, will do as well." *Id.* at 117; *see also Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("An idea of itself is not patentable, but a new device by which it may be made practically useful is."); *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.").[3]

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[3] The lower courts routinely applied these bedrock principles in the years preceding the enactment of the 1952 statute. *See, e.g., Joseph E.*

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When Congress incorporated the word "process" into § 101 in 1952, it was acting against the backdrop of these precedents that limited the kinds of processes subject to patent protection. Under these circumstances, the normal presumption is that Congress sought to ratify, rather than overturn, this prevailing legal understanding. *See,*

Seagram & Sons, Inc. v. Marzall, 180 F.2d 26, 27-28 (D.C. Cir. 1950) (methods of testing products to assess consumer reactions and preferences not patentable); *Loew's Drive-in Theatres, Inc. v. Park-In Theatres, Inc.*, 174 F.2d 547, 553 (1st Cir. 1949) (method of arranging automobiles at a drive-in theater not patentable); *In re Patton*, 127 F.2d 324, 327-28 (C.C.P.A. 1942) (method of fighting fires using standardized and interchangeable fire fighting equipment not patentable because "a system of transacting business, apart from the means for carrying out such system, is not within [the patent statute], nor is an abstract idea or theory, regardless of its importance or the ingenuity with which it was conceived, apart from the means for carrying such idea or theory into effect, patentable subject matter"); *In re Wait*, 73 F.2d 982, 982-83 (C.C.P.A. 1934) (method of buying and selling stocks, wherein one party advertised offer, another party accepted offer and such transaction was recorded, not patentable); *Hotel Sec. Checking Co. v. Lorraine Co.*, 160 F. 467, 469-72 (2d Cir. 1908) (method of "cash-registering and account-checking" not patentable as a "system of transacting business disconnected from the means for carrying out the system ...."); *Ex Parte Turner*, 1894 Dec. Comm'r Pat. 36, 36-37 (method of securing reading of advertisements not patentable because, *inter alia*, process carried no physical effect; "a plan or theory of action which, if carried into practice, could produce no physical results proceeding direct from the operation of the theory or plan itself is not an art within the meaning of the patent laws."); *Ex Parte Abraham*, 1869 Dec. Comm'r Pat. 59 (method of detecting and preventing tax evasion by employing stamps to be severed upon attachment to an article not patentable).

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e.g., *Nationwide Mut. Ins. Co. v. Darden*, 503 U.S. 318, 322 (1992); *Cottage Sav. Ass'n v. C.I.R.*, 499 U.S. 554, 562 (1991); *Davis v. Michigan Dep't of Treasury*, 489 U.S. 803, 813 (1989); *Shapiro v. United States*, 335 U.S. 1, 16 & n.21 (1948). Nothing in the text or history of the 1952 statute suggests that Congress intended to extend patent protection to any process that previously had not been subject to such protection. *See, e.g.*, *Diehr*, 450 U.S. at 184 ("Analysis of the eligibility of a claim of patent protection for a 'process' did not change with the addition of that term to § 101."); *In re Comiskey*, 499 F.3d 1365, 1375 (Fed. Cir. 2007) ("[T]he Supreme Court has made clear that the 1952 language change had no substantive effect.").

B. Supreme Court Cases After 1952 Reinforce The Traditional Meaning Of "Process."

The Supreme Court has further refined the meaning of "process" in the years since 1952. In *Gottschalk v. Benson*, 409 U.S. 63 (1972), the Court held that a claimed "method for converting binary-coded decimal (BCD) numerals into pure binary numerals" was not eligible for patenting. *Id.* at 64. As the Court explained, the claimed process was not "limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use," but rather

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"purported to cover any use of the claimed method in a general-purpose digital computer of any type." *Id.* Under these circumstances, the process was not patent eligible: "Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines." *Id.* at 70 (quoting *Cochrane v. Deener*, 94 U.S. 780, 788 (1977)); *see also Comiskey*, 499 F.3d at 1376 ("[T]he Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. 35 U.S.C. § 101.").

Similarly, in *Parker v. Flook*, 437 U.S. 584 (1978), the Court held that a claimed method for computing an "alarm limit" on any process variable involved in the catalytic chemical conversion of hydrocarbons was not patentable. *See id.* at 594-96. As the Court explained, the claimed process simply provided a formula for computing an updated alarm limit, but did not specify how to "select the appropriate margin of safety, the weighing factor, or any of the other variables ... [n]or [did] it

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... contain any disclosure relating to the chemical processes at work, the monitoring of process variables, or the means of setting off an alarm or adjusting an alarm system." *Id.* at 586. The Court noted that an inventive application of a mathematical formula, principle, or phenomenon of nature may be patented, but only if "there is some other inventive concept in its application." *Id.* at 594.

Finally, in *Diehr*, the Court held that a claimed "process for molding raw, uncured synthetic rubber into cured precision products" was patent eligible because the "claims were not directed to a mathematical algorithm or an improved method of calculation but rather recited an improved process for molding rubber articles by solving a practical problem which had risen in the molding of rubber products." *Id.* at 177, 181. As the Court explained, "when a claim containing a mathematical formula implements or applies that formula in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect (*e.g.*, transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of § 101." *Id.* at 192.

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As the foregoing precedents make clear, the issue before this Court is not the theoretical outer boundaries of the word "process." Rather, the issue is the meaning of the word "process" as used in § 101 and informed by precedent going back well over a century—both before and after the enactment of the 1952 statute. *See, e.g.*, *Diehr*, 450 U.S. at 181-84 (addressing meaning of word "process" in § 101 by reference to precedents dating back to *Morse* and even earlier); *Flook*, 437 U.S. at 588-89 (same); *Benson*, 409 U.S. at 64 (same); *see also Laboratory Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 126 S. Ct. 2921, 2922-23, 2926-28 (2006) (Breyer, J., joined by Stevens and Souter, JJ., dissenting) (same).

C. The Gravamen Of The Supreme Court's Precedent Is That Subject Matter Patentability Is Restricted To Inventions That Involve Technological Contributions.

IBM respectfully submits that the Supreme Court's precedents in this area can be synthesized (and Questions 2 and 4 presented by the *en banc* Court in this case can be answered) by recognizing that a patentable "process" under § 101 must involve a technological contribution. More specifically, such a process must either (i) be tied to a particular machine or apparatus, *see, e.g.*, *Benson*, 409 U.S. at 70-71,

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or (ii) cause transformation or reduction of an article to a different state or thing, *see, e.g., Diehr*, 450 U.S. at 182-84; *Tilghman v. Proctor*, 102 U.S. 707, 722 (1881); *Cochrane*, 94 U.S. at 787-88; *Corning v. Burden*, 56 U.S. (15 How.) 252, 267-68 (1854), and in either instance produce technologically beneficial results. Processes without such technological contributions are properly outside the scope of § 101.

The requirement that a patented process be one that produces technologically beneficial results ensures that the technological aspect of the process is not ancillary or incidental, and thus prevents clever drafters from seeking to patent a non-technological method through nominal or token recitations of structure in a method claim. *See, e.g., Diehr*, 450 U.S. at 191-92 ("[I]nsignificant post-solution activity will not transform an unpatentable principle into a patentable process."); *Comiskey*, 499 F.3d at 1380 ("[T]he mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter.").

This standard applies not only to processes, but more generally limits patentable subject matter to inventions that involve a technological contribution. *See, e.g.,* David J. Kappos *et al.*, *A*

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Technological Contribution Requirement for Patentable Subject Matter: Supreme Court Precedent and Policy, 6 Nw. J. Tech. & Intell. Prop. 152 (2008), *available at* http://www.law.northwestern.edu/journals/njtip/v6/n2/1/. The standard sets forth a reasonable and balanced test for subject matter eligibility, and comports with numerous cases referring to patents as properly directed toward "technology" and "technological growth and industrial innovation."[4]

In synthesizing the Supreme Court precedents, IBM recognizes that the Supreme Court has used language suggesting that the "technological contribution" standard may not be a rigid rule, but rather more akin to a presumption: "We do not hold that no process patent

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[4] *See, e.g., Benson*, 409 U.S. at 64 ("The claims were not limited to any particular art or *technology*, to any particular apparatus or machinery, or to any particular end use.") (emphasis added); *Diehr*, 450 U.S. at 184 ("*Industrial processes* ... have historically been eligible to receive the protection of our patent laws.") (emphasis added); *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998) ("[T]he patent system ... encourages both the creation and the public disclosure of new and useful advances in *technology* ....") (emphasis added); *Markman*, 517 U.S. at 390 ("Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases, ... observing that increased uniformity would 'strengthen the United States patent system in such a way as to foster *technological growth and industrial innovation*.'") (emphasis added; citation omitted).

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could ever qualify [for patent protection] if it did not meet the requirements of our prior precedents." *Benson*, 409 U.S. at 71. However, in the intervening years, no situation has been presented to the Supreme Court to justify overcoming this presumption. IBM believes that the "technological contribution" standard set forth above is sufficiently flexible to allow appropriate patent protection for new fields of scientific or technological discovery, while excluding those processes that the patent law was not designed to protect. In addition, this standard is subject to the well-settled principle that patentable subject matter does not include "laws of nature, natural phenomena, and abstract ideas." *Diehr*, 450 U.S. at 185; *see also Comiskey*, 499 F.3d at 1376 ("'Abstract ideas' are one type of subject matter that the Supreme Court has consistently held fall beyond the broad reaches of patentable subject matter under § 101.").

The "technological contribution" standard, moreover, brings the word "process" in § 101 squarely in line with the Constitution, and avoids the constitutional problems raised by a more open-ended interpretation of that word. The Constitution empowers Congress to enact patent laws "to promote the Progress of Science and useful Arts."

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U.S. Const. art. I, § 8, cl. 8. As this Court recently explained, the Constitution thereby "explicitly limited patentability to 'the national purpose of advancing the useful arts—the process today called technological innovation.'" *Comiskey*, 499 F.3d at 1375 (quoting *Paulik v. Rizkalla*, 760 F.2d 1270, 1276 (Fed. Cir. 1985) (*en banc*)); *In re Bergy*, 596 F.2d 952, 959 (C.C.P.A. 1979) ("We have previously pointed out that the present day equivalent of the term 'useful arts' employed by the Founding Fathers is 'technological arts.'") (citing *In re Musgrave*, 431 F.2d 882, 893 (C.C.P.A. 1970); *In re Waldbaum*, 457 F.2d 997, 1003-04 (C.C.P.A. 1972) (Rich, J., concurring)); Karl B. Lutz, *Patents & Science*, 18 Geo. Wash. L. Rev. 50, 54 (1949) ("The term 'useful arts,' as used in the Constitution ... is best represented in modern language by the word 'technology.'").[5]

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[5] *See also* Tench Coxe (Delegate to the 1787 Constitutional Convention from Pennsylvania), *An Address to an Assembly of the Friends of American Manufactures: Convened for the Purpose of Establishing a Society for the Encouragement of Manufactures and the Useful Arts*, 17-18 (R. Aitkin & Son 1787); Alexander Hamilton, *The Reports of Alexander Hamilton: Report On Manufactures* (Dec. 5, 1791) 115-16, 175-76 (Jacob E. Cooke ed., Harper & Row 1964) (praising the patent system as a way of encouraging manufacturing industries and "[inventions] which relate to machinery").

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By clarifying that the scope of patent eligible processes is limited to those processes that involve technological contributions, as opposed to processes that may be merely "useful" in some abstract sense, this Court can address the concerns raised by the Justices in *Metabolite* who dissented from the dismissal of the writ of certiorari as improvidently granted, and bring needed balance and clarity to the United States patent system.[6] Processes that do not involve technological contributions should be held outside the scope of § 101.

II. *State Street* And *AT&T* Should Be Clarified To Limit The Scope Of Patent Eligible Processes To Those That Involve Technological Contributions. (Question 5)

The gravamen of the foregoing precedents is that non-technological business methods, and other non-technological processes, are not patent eligible subject matter. That point has been called into question, however, by an overly expansive interpretation of language in this Court's *State Street* decision. The result has been an explosion of

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[6] The "technological contribution" standard described in this brief is a synthesis of the requirements for subject matter patentability under United States patent law, and is not drawn from the patentability standards of any non-United States jurisdiction, including the technicity, technological contribution, or technical effect requirements for patentable subject matter in other countries.

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business method patents of dubious validity. The time has come for this Court to clarify *State Street*, and to rein in the runaway issuance of non-technological process patents under § 101. *See, e.g.*, *Metabolite*, 126 S. Ct. at 2922-23, 2926-28 (Breyer, J., joined by Stevens and Souter, JJ., dissenting from dismissal of writ of certiorari as improvidently granted); *eBay Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837, 1842 (2006) (Kennedy, J., joined by Stevens, Souter, and Breyer, JJ., concurring) (noting with concern "the burgeoning number of patents over business methods").

This Court's holding in *State Street* can be justified as consistent with the principles discussed above. The patent at issue in that case involved a "machine," not a "process." *See* 149 F.3d at 1371 ("When independent claim 1 is properly construed ..., it is directed to a machine ...."); *id.* at 1372 ("[C]laim 1, properly construed, claims a machine ....). There is no doubt, the Court explained, that "[a] 'machine' is proper statutory subject matter under § 101." *Id.*[7] The *State Street* Court

[7] Whether the claim at issue in *State Street* would have been patentable if recited as a process rather than as specific machinery has not been addressed by this, or any other, Court.

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further explained that "certain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, i.e., 'a useful, concrete and tangible result.'" *Id.* at 1373 (quoting *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) (*en banc*) (Rich, J.)); *see also id.* ("[M]erely abstract ideas constituting disembodied concepts or truths ... are not 'useful.'"). In context, and in view of precedent, it is clear that the Court was using the term "useful" to mean having "some type of practical application," and thus contrasting "useful" with "abstract." *See also Alappat*, 33 F.3d at 1542 n.18 ("[A]bstract ideas constitute disembodied concepts or truths which are not 'useful' from a practical standpoint standing alone, i.e., they are not 'useful' until reduced to some practical application."). As in the statute itself, this utility requirement is separate from the question of the proper statutory category of the invention. *State Street*, 149 F.3d at 1372, 1375 (noting that the claim recited a machine which both included "specific structure" and *also* "produce[d] a 'useful, concrete and tangible result.'"); *see also Comiskey*, 499 F.3d at 1377 & n.14 (noting that this Court "ha[s] found processes involving mathematical algorithms used in computer technology patentable

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because they claimed practical applications and were tied to specific machines.").

Similarly, this Court's holding in *AT&T* is consistent with the foregoing principles. At issue in that case was a process for generating and using a message record for long-distance telephone calls that is enhanced by adding a primary interchange carrier ("PIC") indicator. 172 F.3d at 1353. The addition of the PIC indicator helped long-distance carriers to provide differential billing treatment for subscribers, depending upon whether a subscriber called someone with the same or a different long-distance carrier. *See id.* As this Court explained, the claimed process "employs subscribers' and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing purposes." *Id.* at 1358. The process was thus tied to a machine to achieve a technologically beneficial result, and the Court's holding was warranted by precedent.

Thus, in neither *State Street* nor *AT&T* did this Court hold that anything that is "useful" in any sense of that word—including the

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colloquial sense of having any utility whatsoever—is patentable. *See generally Comiskey*, 499 F.3d at 1377 & n.14 (noting that the inventions at issue in both *State Street* and *AT&T* were patentable precisely "because they claimed practical applications and were tied to specific machines").[8] Accordingly, the answer to Question 5 presented by the *en banc* Court in this case is that this Court need not overrule the holdings of either *State Street* or *AT&T*.

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[8] Indeed, none other than Judge Rich (the author of *State Street* and *Alappat*, and one of the principal drafters of the 1952 Patent Act) recognized in an oft-quoted comment that abstract ideas may be useful, but that does not mean that they are patentable:

> Invaluable though it may be to individuals, the public, and national defense, the invention of a more effective organization of the materials in, and the techniques of teaching a course in physics, chemistry, or Russian is not a patentable invention because it is outside of the enumerated [statutory] categories .... Also outside that group [of patentable inventions] is one of the greatest inventions of our times, the diaper service.

Giles S. Rich, *Principles of Patentability*, 28 Geo. Wash. L. Rev. 393, 393-94 (1960); *see also In re Yuan*, 188 F.2d 377, 380 (C.C.P.A. 1951) (explaining that the incorporation of the term "useful Arts" in the Constitution "doubtlessly was due to the fact that those who formulated the Constitution were familiar with the long struggle over monopolies so prominent in English history, where exclusive rights to engage even in ordinary business activities were granted so frequently by the Crown.").

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Some observers, however, have broadly read *State Street* to stand for the proposition that utility alone is the touchstone for patentability. That proposition is untenable. To the contrary, whether particular subject matter is patentable (*i.e.*, whether it is a "process, machine, manufacture, or composition of matter" under § 101) is a separate inquiry from whether the claimed invention is useful (*i.e.*, whether it meets the *separate* utility requirement of § 101). *See, e.g., Flook*, 437 U.S. at 584-88 (holding that "a novel and useful mathematical formula" could not be patented); *State Street*, 149 F.3d at 1375 n.9 ("Of course, the subject matter must fall into at least one category of statutory subject matter."). The broad reading of *State Street*, however, has led to an explosion of patents for non-technological methods. Issued patents from such diverse areas as architecture, athletics, painting, psychology, and the law itself, reveal just how far afield the patent system has gone in granting proprietary rights in virtually any area of human endeavor, such as teaching a golf putting stroke or a method for lifting a box.[9]

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[9] *See, e.g.*, U.S. Patents Nos. 5,498,162 ("Method For Demonstrating a Lifting Technique"), 6,447,403 ("Method and Apparatus for Improving Putting Skill"), 5,190,458 ("Character Assessment Method"), 5,809,484 ("Method and Apparatus For Funding Education By Acquiring Shares

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Indeed, the three Supreme Court Justices who dissented from the dismissal of the writ of certiorari as improvidently granted in *Metabolite* noted their disagreement with *State Street* to the extent it "say[s] that a process is patentable if it produces a 'useful, concrete, and tangible result.'" *Metabolite*, 126 S. Ct. at 2928 (Breyer, J., joined by Stevens and Souter, JJ., dissenting) (quoting *State Street*, 149 F.3d at 1373)). As these Justices explained, "if taken literally, the statement [in *State Street*] would cover instances where this Court has held the contrary." *Id.* (citing *Morse*, *Flook*, and *Benson*). As noted above, *State Street* did not hold that utility alone is the touchstone for patentability, and this Court can and should now clarify that non-technological processes (no matter how useful) are not patentable.

Such clarification is entirely consistent with a robust notion of patentable subject matter. Diverse industries have contributed numerous technological advances that are unquestionably suitable for patenting. The USPTO has, for example, appropriately awarded

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of Students Future Earnings"), 6,213,778 (method of painting a surface using the posterior of an infant), and 6,607,389 (method for making jury selection determinations).

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patents in the pharmaceutical, biotechnology, computer/electronics, biomedical, financial, mechanical, and other important fields and important technological advances in these fields have been recognized by this Court and the Supreme Court as patentable subject matter.[10] Thus, clarifying that *State Street* does not support the patentability of non-technological methods will reaffirm, not undermine, patent protection for technological innovations.

III. No Sound Innovation Policy Supports Patents On Non-Technological Business Methods. (Questions 2, 4 & 5)

Finally, no sound innovation policy supports extending patent protection to non-technological business methods or other non-

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[10] *See, e.g., Diamond v. Chakrabarty*, 447 U.S. 303, 310 (1980) (affirming the patentability of "a new bacterium with markedly different characteristics from any found in nature and one having the potential for significant utility"); *Alappat*, 33 F.3d at 1545 ("We have held that [software] creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software."); *see also AT&T*, 172 F.3d at 1360 ("[I]t is now clear that computer-based programming constitutes patentable subject matter so long as the basic requirements of § 101 are met."); *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1339 (Fed. Cir. 2005) ("[P]rocess and product—software and hardware—are practically interchangeable in the field of computer technology. On a functioning

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technological processes. As the Supreme Court has stated time and again, "the patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in technology, in return for an exclusive monopoly for a limited period of time." *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998); *see also id.* ("The balance between the interest in motivating innovation and enlightenment by rewarding invention with patent protection on the one hand, and the interest in avoiding monopolies that unnecessarily stifle competition on the other, has been a feature of the federal patent laws since their inception."). While the patent laws are socially beneficial, they are also vulnerable to abuse. *See, e.g., eBay*, 126 S. Ct. at 1842 (Kennedy, J., joined by Stevens, Souter, and Breyer, JJ., concurring) (noting that "an injunction ... can be employed as a bargaining tool to charge exorbitant fees to companies that seek to buy licenses to practice the patent").[11] Granting a monopoly on non-

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computer, software morphs into hardware and vice versa at the touch of a button.") (citations omitted).

[11] Limits on patentable subject matter provide an important requirement for patentability, beyond the other requirements of the patent laws such as §§ 102, 103, and 112. While robust application of (Continued...)

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technological methods, untethered to a particular practical application, would upset this "careful balance," *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989), and thereby "stifle, rather than promote, the progress of useful arts," *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1746 (2007) (citing U.S. Const., art. I, § 8, cl. 8); *see also Metabolite*, 126 S. Ct. at 2922 (Breyer, J., joined by Stevens and Souter, JJ., dissenting from dismissal of writ of certiorari as improvidently granted) ("[S]ometimes *too much* patent protection can impede rather than 'promote the Progress of Science and useful Arts.'") (emphasis in original); *id.* ("Patent law seeks to avoid the dangers of overprotection just as surely as it seeks to avoid the diminished incentive to invent that underprotection can threaten. One way in which patent law seeks to sail between these opposing and risky shoals is through rules that

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these other patentability requirements is important to prevent inventions without merit from receiving patent protection, it is equally important to apply the limitations of § 101 set forth by this Court and the Supreme Court as synthesized in the technological contribution standard described herein. This test excludes nontechnological business methods from patent protection even if they satisfy the other patentability requirements, which is necessary to balance the competing policy objectives of the patent system of fostering innovation without improperly impacting competition.

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bring certain types of invention and discovery within the scope of patentability while excluding others.").

There is a conspicuous absence of evidence of any sudden need for patent-based incentives to promote the development of non-technological business methods. "Nowhere in the substantial literature on innovation is there a statement that the United States economy suffers from a lack of innovation in methods of doing business. Compared with the business practices of comparable economies we seem to be innovators ...." Leo J. Raskind, *The State Street Bank Decision: The Bad Business of Unlimited Patent Protection for Methods of Doing Business*, 10 Fordham Intell. Prop., Media & Ent. L.J. 61, 92 (1999). President Coolidge's famous adage, that "the chief business of the American people is business," was coined seven decades before this Court's opinion in *State Street* set off a debate over the necessity for protecting business methods as patentable inventions. Claude M. Fuess, *Calvin Coolidge, The Man From Vermont* 358 (1940). Among the reasons for the persistent favorable record of commercial entrepreneurship in the United States are existing federal and state legal regimes, including unfair competition law, trade secrets,

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copyright, and the misappropriation doctrine, that have long policed free-riding and have allowed business pioneers to reap the rewards of their ideas. *See* Raskind, *State Street*, 10 Fordham Intell. Prop., Media & Ent. L.J. at 93. In conjunction with market-based incentives, including the desire to seize first-mover and learning-curve advantages, the current legal framework has resulted in a flourishing environment for business innovation in the United States. *See id.* at 92-93 ("There is ... substantial anecdotal evidence that competition alone serves as a sufficient spur to innovation in business methods."); *see also* Malla Pollack, *The Multiple Unconstitutionality Of Business Method Patents*, 28 Rutgers Computer & Tech. L.J. 61, 75-76 (2002) ("Since business methods are 'useful' when they directly earn revenue, they are inherently unlikely to be under-produced due to market failure—in contrast to more conventional patentable subject matter."). No plausible argument supports the view that patent protection of non-technological business methods is needed to solve a market failure problem, fill a legal void, or ultimately enhance social welfare.

To the contrary, issuing patents on non-technological business methods raises significant competitive concerns, and actually

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diminishes social welfare. *See, e.g.*, Pollack, *Multiple Unconstitutionality*, 28 Rutgers Computer & Tech. L.J. at 76 ("If we grant rights to exclude unnecessarily, we raise prices and limit competition with no quid pro quo."). Allowing such patents drives an "ends justifies the means" approach whereby patents are written to cover results, not the way those results are achieved. Since such patents are not restricted to any specific application or technology, they effectively appropriate all possible solutions to a problem, and discourage, rather than encourage, innovation aimed at actual technological implementations. Such patents provide a monopoly covering all technical solutions to a given business problem rather than the solution that was invented. In effect, this practice amounts to patenting the problem rather than the solution, which contradicts the principle that "'[i]t is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself.'" *Diehr*, 450 U.S. at 182 & n.7 (quoting *Corning*, 56 U.S. (15 How.), at 267-68).

Moreover, these broadly claimed abstract methods restrain the ability of competitors to develop alternatives to the patented invention,

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thus thwarting a principal aspiration of the patent system, which is to foster new alternatives. *See, e.g., Brenner v. Manson,* 383 U.S. 519, 534 (1966) ("Until [a] process claim has been reduced to production of a product shown to be useful, the metes and bounds of that monopoly are not capable of precise delineation. It may engross a vast, unknown, and perhaps unknowable area."); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991) ("Designing around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose."). Thus, the imbalance in incentives inherent in the patenting of non-technological business methods discourages rather than promotes technological innovation.

Consider, for example, the ubiquitous automated teller machine ("ATM"). A review of the patent rolls reveals numerous ATM patents concerning such mechanical, electrical, and computer-implemented inventions as card readers, touch screens, cash dispensers, statement printers, and antitheft mechanisms. As evidenced by the robust competition within the ATM industry, such patents have both preserved the incentives of industry participants to innovate and allowed their

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competitors to market alternative designs. However, to the extent that this Court's precedents have been read to endorse the patentability of abstract business methods, an inventor's claim to a process of performing teller-free transactions could be considered eligible for patenting under § 101. If such patent had been filed before the first ATM had been developed, it might have been upheld under a standard that allows patentability of nontechnological business methods. Much like claim 8 of Samuel Morse's telegraphy patent, *see Morse*, 56 U.S. at 113, such an abstract patent, untethered to a particular practical application, would discourage all others from designing alternative mechanisms for meeting the same marketplace needs. The potential adverse impact of this hypothetical abstract patent upon competition not just in the ATM industry, but within the banking industry itself, is apparent.

The lack of a plausible justification for patents on abstract business methods, coupled with the anticompetitive consequences of issuing these patents, counsels that this Court clarify that patentable subject matter is limited to inventions involving technological contributions. Modern society's dizzying pace of technological change,

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with its accompanying changes to marketplace conditions and commercial practices, should by no means lead to an alteration of these established principles.

Nor does the principle that the patent system should keep pace with unforeseeable fields of scientific or technological discovery, *see, e.g., Diamond v. Chakrabarty*, 447 U.S. 303, 315-16 (1980), compel a contrary result. Neither abstract nor non-technological business methods are an unforeseeable field. *See, e.g.*, John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. Rev. 1139, 1145-46 (1999). To the contrary, people have been creating new business methods since long before any patent system existed. Moreover, by definition, abstract or inchoate business methods are not scientific or technological. *See, e.g.*, Pollack, *Multiple Unconstitutionality*, 28 Rutgers Computer & Tech. L.J. at 77-78. "Jefferson saw clearly the difficulty in drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not." *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 9 (1966) (internal quotation omitted). This Court should now clarify the *State Street* and *AT&T* decisions to limit the ambit of patentable subject

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matter to that range of technological innovations which truly justifies tolerating the "embarrassment of an exclusive patent." *Id.* (internal quotation omitted).

CONCLUSION

For the foregoing reasons, the Court should clarify that the scope of patentable subject matter of processes under § 101 is limited to processes that involve technological contributions—namely, processes that either (1) are tied to a particular machine or apparatus, or (2) cause transformation or reduction of an article to a different state or thing, and in either instance produce technologically beneficial results.

April 7, 2008 Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that the brief is proportionately spaced, has a typeface of 14 points or more, and contains 6,800 words.

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CERTIFICATE OF SERVICE

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No. 06-937

IN THE

Supreme Court of the United States

QUANTA COMPUTER, INC., QUANTA COMPUTER USA, INC., Q-LITY COMPUTER, INC., COMPAL ELECTRONICS, INC., BIZCOM ELECTRONICS, INC., SCEPTRE TECHNOLOGIES, INC., FIRST INTERNATIONAL COMPUTER, INC. AND FIRST INTERNATIONAL COMPUTER OF AMERICA, INC.,
Petitioners,

v.

LG ELECTRONICS, INC.,
Respondent.

On Writ of Certiorari to the
United States Court of Appeals for the
Federal Circuit

BRIEF OF *AMICUS CURIAE* INTERNATIONAL BUSINESS MACHINES CORPORATION IN SUPPORT OF PETITIONERS

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QUESTION PRESENTED

Whether the Federal Circuit erred in holding that respondent's patent rights were not exhausted by Intel Corporation's sale of a product to petitioners, where Intel was authorized under a license to manufacture and sell the product, and the petitioners did not expressly consent to any restrictions on their use of the product.

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International Business Machines Corporation ("IBM") respectfully submits this brief pursuant to Supreme Court Rule 37.3 in support of petitioners.[1] IBM urges the Court to apply its longstanding precedents and reverse the judgment of the United States Court of Appeals for the Federal Circuit.

INTEREST OF *AMICUS CURIAE*

IBM has a strong interest in an evenhanded and fair interpretation of patent law, as it is both a patentee and a manufacturer. IBM is well known as a strong proponent of the U.S. patent system. It has received tens of thousands of patents, has been awarded more United States patents than any other assignee for fourteen consecutive years,[2] and earns about $1 billion every year from licensing its

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[1] Pursuant to Supreme Court Rule 37.6, IBM states that no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae*, its members, or its counsel made a monetary contribution to its preparation or submission. In addition, all parties have consented to the filing of this *amicus* brief, and their consent letters are on file with the Clerk's Office.

[2] For example, the United States Patent and Trademark Office reported that in 2006, IBM received 3,621 patents, which is over 1,170 more United States patents than any other company. *See* United States Patent & Trademark Office, PATENTING BY ORGANIZATIONS 2006 (March 2007), *available at* http://www.uspto.gov/go/taf/topo_06.pdf (last visited Nov. 9, 2007).

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intellectual property portfolio. But, IBM also earns over $90 billion from sales of information technology equipment and services annually and thus defends against many adverse patent accusations and lawsuits each year.

With respect to the specific question presented, IBM is unusually well-positioned to provide unbiased commentary on how the rule of exhaustion should justly limit patentees' exclusive rights without harming innovation or the public interest. IBM has no direct stake in the particular dispute between petitioners and respondent, because it is licensed to the patents at issue in this case. In addition, IBM is not inclined to favor licensees and purchasers over patent owners, or vice versa. As one of the most successful licensors of patented technology in the world, IBM relies on its ability to enforce its patents in order to advance its business interests. But, as a large corporation focused on offering innovative products and services in a broad range of fields, IBM is frequently forced to defend against charges of infringement.

IBM is also well aware of the exhaustion issues that arise not only in the information technology sector but also in a broad spectrum of different industries, all of which would be impacted by changes to the doctrine. IBM's business interests encompass a diverse range of industries and fields that enable, and are enabled by, information technology, including software and computer technology, electrical engineering, life sciences, physical and organic chemistry, business consulting, computer services, engineering services, and the mechanical arts.

IBM thus has a strong interest in maintaining a fair patent system, and in fashioning clear and evenhanded rules of exhaustion that promote innovation in all industries, while properly balancing the interests of the patent owner, the accused infringer, and the public, rather than favoring any particular party.

STATEMENT

1. Respondent owns a portfolio of U.S. and foreign patents relating to personal computers, including patents claiming systems and methods to increase the bandwidth efficiency of computer systems. Pet. App. 2a. Intel Corporation ("Intel") is authorized by respondent to manufacture and sell microprocessors and chipsets that otherwise would infringe respondent's patents. Pet. App. 2a-3a. Petitioners purchase chipsets and microprocessors from Intel and combine them with other equipment in accordance with exact specifications from Intel to make computers. *See id.*; Pet. 3. By necessity, microprocessors and chipsets must be combined with these other computer components to be of any use. *See* Opp. 9.

2. Two agreements between respondent and Intel govern Intel's ability to manufacture and sell the chipsets and microprocessors at issue here.

The first is a patent license (the "License Agreement") by which Intel agreed to pay respondent for the unrestricted right to "make, use, sell (directly or indirectly), offer to sell, import and otherwise dispose of" microprocessors and chipsets. Pet. App. 33a (citation omitted). The License Agreement also provides that "[n]otwithstanding anything to the contrary contained in this Agreement, the parties

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agree that nothing herein shall in any way limit or alter the effect of patent exhaustion that would otherwise apply when a party hereto sells any of [the licensed products]." Pet. at 3-4.

The second relevant agreement is the "Master Agreement." *Id.*; Opp. 3. It incorporates the License Agreement by reference and provides: "' [respondent] and Intel intend and acknowledge that [respondent's] grant of a license to Intel for Integrated Circuits . . . shall not create any express or implied license under [respondent's] patents to computer system makers [such as petitioners] that combine Intel Integrated Circuits with other non-Intel components to manufacture motherboards, computer subsystems, and desktop, notebook and server computers'." Opp. 6 (quoting Master Agreement § 2). The Master Agreement provides that Intel will send a notice to its customers stating, in pertinent part, that Intel has a "broad patent license" from respondent that "ensures that any Intel product that you purchase is licensed by [respondent] and thus does not infringe any patent held by [respondent]." Opp. 7 (internal quotation marks omitted). The notice further states: "Please note however that while the patent license that [respondent] granted to Intel covers Intel's products, it does not extend, expressly or by implication, to any product that you may make by combining an Intel product with any non-Intel product." *Id.* (citation omitted).

3. It is undisputed that petitioners received the required notice from Intel before purchasing some of the components at issue. *See id.*; Reply Br. 9. Petitioners thereafter simply combined the chips with other non-Intel products pursuant to Intel's

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exact specifications. Pet. 3. Petitioner's computers were then sold in the U.S. and around the world.

4. Between late 2000 and spring 2001, respondent brought separate suits against petitioners, alleging that they (and another company with whom respondent has since settled) had infringed six of respondent's patents. Specifically, respondent claimed that, while Intel's manufacture of the infringing chipsets was authorized under the License Agreement, petitioners' combination of those chipsets with non-Intel products was not. *See* Pet. App. 3a. On August 20, 2002, the district court granted petitioners' motion for partial summary judgment of non-infringement on the ground that respondent's unrestricted license to Intel and Intel's subsequent sale of the chipsets and microprocessors to petitioners exhausted respondent's rights to recover royalties with respect to those items. Pet. App. 32a-45a.

5. In the proceedings below, the Federal Circuit reversed. In its view, exhaustion occurs only where there is an "unconditional" sale such that "the patentee has bargained for, and received, an amount equal to the full value of the goods." Pet. App. 5a (internal quotation marks and citation omitted). But when a sale is "conditional," the Federal Circuit reasoned, "the parties negotiat[e] a price that reflects only the value" of those limited rights and thus the patent rights might not be fully exhausted. *Id.*

The Federal Circuit concluded that no exhaustion had occurred under this rule because the Master Agreement "expressly disclaims [Intel's right to] grant[] a license allowing computer system manufacturers to combine Intel's licensed parts with

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other non-Intel components. Moreover, this conditional agreement required Intel to notify its customers of the limited scope of the license, which it did. Although Intel was free to sell its microprocessors and chipsets, those sales were conditional, and Intel's customers were expressly prohibited from infringing [respondent's] combination patents." Pet. App. 6a. The unilateral notice was binding on petitioners and conditioned the sale, in the Federal Circuit's view, due to New York Uniform Commercial Code § 2-202, "the battle of the forms" provision, which provides that a contract may be "supplemented by consistent additional terms unless the writing is intended to be complete and exclusive." *Id.*

SUMMARY OF THE ARGUMENT

This case presents a unique challenge to maintaining balance and fairness in the patent exhaustion doctrine because the facts are so extreme. Respondent expressly authorized Intel to manufacture and sell chipsets and microprocessors that had only one purpose, to be combined with other components and made into computers. Respondent required only that Intel notify its customers—petitioners—that they were not authorized to combine the chipsets and microprocessors with non-Intel products. Intel gave this unilateral notice to petitioners but also provided detailed and exact specifications on how to make the infringing combination.

In light of these unique facts, it is tempting to reach an extreme result and conclude, like the Federal Circuit, that *any* condition on a sale, including a unilateral notice to a purchaser, can overcome exhaustion or conclude, like other *amici* are

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bound to suggest, that restrictions on downstream purchasers are *never* valid where a sale is authorized and the sold article has no substantial noninfringing use.

But, patent law and policy should not be defined to operate so starkly. Indeed, any pronouncements in the patent field must take into account the delicate balance between promoting innovation and promoting competition that is necessary for a functional patent system. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 156 (1989). In the exhaustion context, this balance means that the point at which patent rights terminate must be fairly and clearly defined. An overly-broad exhaustion doctrine, one that terminates patent rights too easily, would undercut the incentive to innovate. But an overly-narrow doctrine, one that entitles patentees to recover multiple royalties for the same infringement, would allow patentees to over-leverage their patents to the detriment of the public and undercut the incentive for follow-on innovation and commercialization. And, a doctrine that requires judicial resolution to determine whether exhaustion has occurred would fail to provide the certainty necessary for commerce to function efficiently.

As IBM explains, this Court's jurisprudence and the policies underlying exhaustion require a rule that lies between the extremes: while an authorized sale of a product with no substantial non-infringing use exhausts the patent right, the licensee or downstream purchaser can expressly agree to restrictions that would overcome exhaustion with respect to restricted activities, so long as those restrictions do not violate the federal antitrust laws,

misuse or expand the patent right, or otherwise constitute an invalid restraint. As this Court has recognized, exhaustion is a strong doctrine that terminates the patentee's rights via an authorized sale of a patented article with no substantial non-infringing use. But, just as a patentee can control its own sales of a patented article, it can restrict the authority of licensees through effective licensing agreements. It can also restrict the rights of purchasers through express agreements. Because purchasers are legally entitled to rely on the exhaustion effect of an authorized sale, however, the latter restrictions should be enforceable only if the purchaser expressly consents and agrees to them. Any alternative rule would upset the settled commercial expectations of those who purchase patented articles from patentees or their authorized sellers.

IBM's interpretation of the enforceability of restrictions on purchasers is a direct outgrowth of this Court's jurisprudence. The Court has repeatedly recognized that patentees may issue restrictive licenses limiting a licensee's authority and that a licensee's sale or other action outside the scope of its restricted license constitutes infringement, exposing the licensee and everyone downstream to strict liability for infringement. *See Mitchell v. Hawley*, 83 U.S. (16 Wall.) 544, 548 (1873); *United States v. Gen. Elec. Co.*, 272 U.S. 476, 490 (1926). Thus, the Court has held that a patentee can avoid exhaustion and restrict licensees and downstream purchasers by defining *unauthorized* conduct in a licensing agreement. *See Gen. Talking Pictures Corp. v. W. Elec. Co.*, 305 U.S. 124, 126 (1938).

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The same reasoning applies in the context of an *authorized* sale by a licensee or the patentee. Just as a patentee can place restrictions on a licensee selling patented products, it can place restrictions on a purchaser of such products through express agreements with the purchaser. Where those restrictions limit the purchaser's rights under the patent, they give rise to a claim of infringement liability for activities by the purchaser outside the restrictions. *See id.* Because such restrictions are contrary to the normal operation of patent exhaustion and the expectations of the purchaser, however, they must be the result of an agreement to which the purchaser has expressly consented. Otherwise, the restrictions are insufficiently clear to demonstrate that the bargained-for sale of the patented product was for less than the full rights under the patent.

IBM's interpretation of exhaustion is not only consistent with this Court's jurisprudence but necessary to effect the basic balance underlying the patent system. The fundamental point of exhaustion is that the patentee can be compensated only once for the same infringement; it gets one bite at the apple. But, this Court has long permitted the patentee to divide that bite into smaller nibbles. So long as a licensee or a purchaser expressly agrees that it is restricted to make, use or sell only the smaller nibble, enforcing the restriction is fair, allows the patentee to receive only partial compensation commensurate with the restricted rights granted, and promotes competition by allowing the patentee to offer an array of different rights under the patent at varying valuations. The purchaser benefits from this regime,

as it can obtain at a lower price only the rights it needs, certain of the rights it has purchased.

ARGUMENT

I. PATENTEES MUST OBTAIN EXPRESS AGREEMENT TO PRESERVE THEIR PATENT RIGHTS AGAINST THOSE WHO PURCHASE FROM AUTHORIZED SELLERS.

A. This Court's Precedents Establish A Strong Exhaustion Doctrine That Applies With The Authorized Sale Of A Good With No Substantial Non-Infringing Use.

It is well established that patent law grants to the patent holder the "right to exclude others from making, using, offering for sale, or selling the invention." 35 U.S.C. § 154(a). But, it is also well established that "when the patentee, or the person having his rights, sells a machine or instrument whose sole value is in its use, he receives the consideration for its use and he parts with the right to restrict that use. The article, in the language of the court, passes without the limit of the monopoly." *Adams v. Burke*, 84 U.S. 453, 456 (1873); *see United States v. Univis Lens Co.*, 316 U.S. 241, 249-50 (1942); *Keeler v. Standard Folding Bed Co.*, 157 U.S. 659, 664 (1895); *Bloomer v. Millinger*, 68 U.S. 340, 351-52 (1863). This rule of patent exhaustion was stated by the Court over one hundred years ago as follows:

> [T]he patentee or his assignee having in the act of sale received all the royalty or consideration which he claims for the use of his invention in that particular

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> machine or instrument, it is open to the use of the purchaser without further restriction on account of the monopoly of the patentees.

Adams v. Burke, 84 U.S. at 456; *see also* 1 Roger M. Milgrim, MILGRIM ON LICENSING § 2.30, at 2-64 n.161 (2007) ("[W]hen an authorized licensee exercises the licensed right to make, use and sell a patented product the patentee's patent rights in the product are exhausted upon that sale.").

Thus, in *Adams v. Burke*, the Court affirmed the dismissal of an infringement action against a downstream purchaser in a case involving a patent on improvements to coffin lids where the patentee had authorized the manufacture and sale of infringing coffins but only within a ten-mile radius of Boston. 84 U.S. at 456-57. The infringing coffin was sold, without restriction, within this geographic area but then used by the purchaser outside of the restricted area. *Id.* The Court reasoned that although the right "to manufacture, to sell, and to use these coffin-lids was limited to the circle of ten miles around Boston, . . . a purchaser . . . of a single coffin acquired the right to use that coffin for the purpose for which all coffins are used. That so far as the use of it was concerned, the patentee had received his consideration, and it was no longer within the monopoly of the patent." *Id.* at 456; *see also Hobbie v. Jennison*, 149 U.S. 355, 363 (1893) (holding licensee was not a contributory infringer in selling an item to one who made an infringing combination, "because he had a right, under the patent, to make, use, and vend the patented article in the state of Michigan, and the article was lawfully made and sold

there. The pipes in question were not sold by the Hartford Steam Company in Connecticut, but were merely used there, and necessarily perished in the using").

Similarly, in *Univis Lens*, a case involving patents on multifocal lenses, the Court invalidated under the Sherman Act a price maintenance program effected through a patentee's licensing program with wholesalers and finishing retailers that would purchase lens blanks from the patentee and grind them into a prescription. In doing so, the Court reasoned, "where one has sold an uncompleted article which, because it embodies the essential features of his patented invention, is within the protection of his patent, and has destined the article to be finished by the purchaser in conformity to the patent, he has sold his invention so far as it is or may be embodied in that particular article." 316 U.S. at 250-51; *see also* William P. Skladony, *Commentary on Select Patent Exhaustion Principles In Light of The LG Electronics Cases*, 47 IDEA 235, 236-40 (2007) (discussing this Court's exhaustion jurisprudence).

Because an article that "embodies the essential features" of a patented invention generally has no substantial alternative use that would be non-infringing, the rule of exhaustion has alternatively been described as "where a patented apparatus or product has no use other than an infringing use, its sale to a third party . . . exhausts the patent." MILGRIM, *supra*, § 2.30, at 2-64 n.161; *see Henry v. A.B. Dick Co.*, 224 U.S. 1, 48 (1912), *overruled on other grounds by Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 517 (1917) ("[A] sale of an article which, though adapted to an

infringing use, is also adapted to other and lawful uses, is not enough to make the seller a contributory infringer. Such a rule would block the wheels of commerce."). Although the essential features doctrine and the concept of substantial non-infringing use are distinct, the alternative descriptions of the exhaustion test are, for all intents and purposes, identical in effect.

The upshot of these precedents is a strong exhaustion doctrine—one that applies on the authorized sale of a patented item with no substantial non-infringing use.[3]

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[3] In the proceedings below, the Federal Circuit concluded that an authorized sale does not exhaust "method" patents—patents that disclose and claim a process, whether a technical process or a method of doing business. *See* Pet. App. 6a (holding that "the sale of a device does not exhaust a patentee's rights in its method claims"). In IBM's view, this conclusion is clearly contrary to the Court's decision in *Univis Lens*, in which the patent found to be exhausted by an authorized sale was a method patent. *See* 316 U.S. at 246-47 (describing the patents at issue). A contrary rule, moreover, would effectively eliminate the exhaustion doctrine because patentees would simply include method or process claims to avoid exhaustion. In the information technology context in particular, a contrary rule would harm the public interest, since it is often the unsuspecting end user or consumer who is practicing a method claim by simply using a computer.

B. An Exception To Exhaustion Exists Where Parties Agree To Limit The Purchaser's Rights Under The Patent Through Express Restrictions That Are Otherwise Valid Under Federal Law.

While the Court has recognized a strong exhaustion doctrine, it has also recognized, for over a century, an exception to exhaustion where there is an express agreement limiting the licensee's or purchaser's rights under a patent. In short, the Court has recognized the patentee's ability to grant less than the full patent right, and a licensee's or purchaser's freedom to contract for the purchase of a lesser right at a lower price.

1. This Court has repeatedly recognized the patentee's ability to restrict licensees and their downstream purchasers through valid licensing restrictions.

The law permits a patentee to "carve out of his entire monopoly such fractional interest therein, either as to absolute right, or as to territorial extent, or as to duration of right, as he may see fit" and transfer only that limited right. *Bloomer*, 68 U.S. at 346; *see also Providence Rubber Co. v. Goodyear*, 76 U.S. (9 Wall.) 788, 799-800 (1869) (upholding the validity of a restricted license). Indeed, as this Court has recognized, "[t]he practice of granting licenses for a restricted use is an old one. So far as appears, its legality has never been questioned." *Gen. Talking Pictures Corp.*, 305 U.S. at 127 (internal citations omitted).

Consistent with this Court's recognition of the patentee's ability to grant licenses of limited scope,

the Court has held that exhaustion does *not* apply when a licensee makes an unauthorized sale outside the scope of its patent license. Thus, in *United States v. General Electric Company*, the Court held that the owner of patents relating to tungsten incandescent lamps could validly impose conditions in a licensing agreement that restricted the licensee's ability to sell electric lamps covered by the patent. *See* 272 U.S. at 489. The Court reasoned that, while it was well settled that exhaustion occurs "where a patentee makes the patented article, and sells it" without restriction, "the question is a different one which arises when we consider what a patentee who grants a license to one to make and vend the patented article may do in limiting the licensee in the exercise of the right to sell." *Id.* at 489-90. In the licensing context, the Court continued, "[t]he patentee may make and grant a license to another to make and use the patented articles but withhold his right to sell them. The licensee in such a case acquires an interest in the articles made. He owns the material of them and may use them. But if he sells them he infringes the right of the patentee, and may be held for damages and enjoined." *Id.* at 490.

Similarly, in *General Talking Pictures Corp.*, 305 U.S. 124, the Court upheld an infringement action against a licensee and downstream purchaser where the licensee was authorized to sell the patented article (amplifiers) in only a certain "field of use" (for radio reception) but sold the patented article for a different use (for theater motion-picture machines). *Id.* at 125-26. The Court reasoned that the validity and legality of the restrictive license was "clear." *Id.* at 127. "As the restriction was legal and the amplifiers were made and sold outside the scope of

the license, the effect is precisely the same as if no license whatsoever had been granted to [the licensee]." *Id.*

Indeed, this Court has made clear that where a licensee has made an unauthorized sale outside the scope of its license, the downstream purchaser infringes even if it lacks notice that the licensee is acting in an unauthorized manner. The reason, in the Court's view, is that one "who buys goods from one not the owner, and who does not lawfully represent the owner, however innocent [he] may be, obtain[s] no property whatever in the goods, as no one can convey in such a case any better title than he owns, unless the sale is made in market overt, or under circumstances which show that the seller lawfully represented the owner." *Mitchell*, 83 U.S. at 550. "Notice to the purchaser in such a case is not required, as the law imposes the risk upon the purchaser, as against the real owner, whether the title of the seller is such that he can make a valid conveyance." *Id.* Any other rule would defeat the well-settled principle that "[r]estrictions on patent rights travel downstream." Katherine E. White, *A Rule for Determining When Patent Misuse Should Be Applied*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 671, 693 (2001).

To be sure, the Court has recognized numerous limits on the ability of the patentee to impose downstream restrictions. Most obvious, the patentee cannot impose any restrictions that would otherwise violate the federal antitrust laws. *See Int'l Salt Co. v. United States*, 332 U.S. 392 (1947) (invalidating restriction that would have violated anti-tying provisions of Sherman and Clayton Acts); *United*

States v. Line Material Co., 333 U.S. 287, 304 (1948) (holding that notwithstanding *General Electric*, it is unlawful to use patents "as a peg upon which to attach contracts with former or prospective competitors, touching business relations other than the making and vending of patented devices").

In addition, the patentee cannot misuse or expand its patent right. "The patent law simply protects [the patentee] in the monopoly of that which he has invented and described in the claims of his patent." *Motion Picture Patents Co. v. Universal Film Mf'g Co.*, 243 U.S. 502, 510 (1917). Thus, the Court has held that the patentee cannot lawfully negotiate to obtain "royalty payments beyond the life of the patent," because doing so "is analogous to an effort to enlarge the monopoly of the patent." *Brulotte v. Thys Co.*, 379 U.S. 29, 33 (1964); *see also Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100, 136 (1969) (observing that the patentee cannot "extend the monopoly of his patent to derive a benefit not attributable to use of the patent's teachings").

Apart from these limits imposed by antitrust and patent misuse principles, the authority of the patentee to impose downstream restrictions, such as field-of-use, geographical, and other such restrictions, through effective licensing is well established. *See, e.g.*, MILGRIM, *supra*, § 2.31; *see also Cont'l T.V., Inc. v. G.T.E. Sylvania, Inc.*, 433 U.S. 36 (1977) (holding that non-price, vertical resale restrictions are *not* per se violations of the Sherman Act and are judged under the rule of reason).

2. The Court's precedents compel the conclusion that patentees can restrict *purchasers*, but only through written agreements to which the purchasers expressly consent.

While *General Talking Pictures* arose in the context of the validity and downstream impact of restrictions in licensing agreements, it supports the principle that a patentee can validly impose restrictions on a purchaser's ability to use a patented article. That is, in *General Talking Pictures*, the Court held that field-of-use-restrictions are lawful and valid. And "[i]f the purchaser in *General Talking Pictures* is liable for infringement when he sells outside of the known limited field of the authority of his supplier, it would seem logical that an identical express license restriction on his rights made at the time of sale would be lawful." *See* 2 John W. Schlicher, PATENT LAW, LEGAL AND ECONOMIC PRINCIPLES § 8:61 (2d ed. 2006).

In other words, had the licensee in *General Talking Pictures* complied with the terms of the licensing agreement, the purchasers would have had only the limited right to use the amplifiers in radios; their use in a different field would have exceeded the scope of the right the licensee had to sell and thus the right the purchaser had to purchase. The decision thereby necessarily approved of the patentee's ability to impose field-of-use restrictions on purchasers. For this reason, treatises in the patent licensing arena warn that "not every purchase provides a free ticket to future use because certain countervailing doctrines may defeat exhaustion: notably, whether there are

still any valid field-of-use restrictions." MILGRIM, *supra*, § 2.31, at 2-66-2-67; *see also id.* §§ 2.31-2.36 (describing the various permissible restrictions).

While this Court has not directly considered the mechanisms by which a patentee can restrict purchasers involved in an *authorized* sale—a sale by the patentee or a licensee acting within the scope of its license—numerous of the Court's precedents, read as a body of law, make clear that field-of-use, geographical and other restrictions on such purchasers (i) are enforceable when the restrictions are contained in a written agreement to which the purchaser has expressly consented, and (ii) can be enforced against only those bound by the contractual agreement. In other words, the restrictions do not automatically carry downstream with an authorized sale. *See* White, *supra*, at 694. ("[A] patent owner may place conditions on a sale of a patented product through contract, but such restrictions should apply only to those in privity of contract. Generally, only those who are in privity of contract, with the exception of intended beneficiaries, may sue on a contract.") (footnotes omitted).

Specifically, the Court has recognized that the patentee can limit the purchaser "by special contracts brought home to the purchasers." *Keeler*, 157 U.S. at 666. Although the issue was not before the Court, it observed that "[i]t [was] obvious that such a question would arise as a question of contract, and not as one under the inherent meaning and effect of the patent laws." *Id.* Thus, a purchaser can contractually agree to restrictions on its rights under a patent that it would normally enjoy by virtue of an authorized sale. Having contractually agreed to restrictions that

modify the normal operation of exhaustion, the purchaser would be liable for infringement if it used the article outside the scope of its restricted right. Because the patentee's right to sue for infringement in this instance arises only as a result of a contract, however, the restriction would not travel downstream upon a subsequent authorized sale absent a further express agreement restricting the subsequent purchaser.

Where a patentee has attempted to control a direct purchaser engaged in an authorized sale through something less than an expressly agreed-to contractual arrangement, for example through a unilateral notice affixed to the side of the patented article, the attempt has been held invalid. *See, e.g.*, *Motion Picture Patents Co.*, 243 U.S. at 518-19. The Court has held that there is "no support in the patent laws for the proposition that a patentee may prescribe by notice attached to a patented machine the conditions of its use and the supplies which must be used in the operation of it, under pain of infringement of the patent," where there has been an authorized sale. *Ill. Tool Works Inc. v. Indep. Ink, Inc.*, 547 U.S. 28, 38 (2006) (internal quotation marks omitted).

In addition, the Court has previously invalidated *implied* restrictions on purchasers engaged in an *authorized* sale. It has held that, after an authorized sale, "there is no restriction on [the infringing article's] use to be *implied* for the benefit of the patentee or his assignees or licensees." *Adams v. Burke*, 84 U.S. at 457 (emphasis added). This rule makes sense given that any restriction on such a purchaser must overcome the strong presumption

that an authorized sale of a patented article exhausts the patent rights with respect to the purchaser. This strong presumption, moreover, is underpinned by common sense—in the absence of an agreement, a purchaser should not expect a charge of infringement from a patentee who has authorized the sale of a patented article. Indeed, given the need to preserve the settled expectations of buyers in the ordinary course of trade, it is axiomatic that any restriction purporting to limit the exhaustion doctrine's operation must be explicit and the burden to procure explicit restrictions must rest with the patentee.

Allowing a purchaser to waive exhaustion through express agreement is consistent with the Court's general jurisprudence concerning the waiver of federal rights. This Court has recognized that federal rights (even constitutional rights) are waivable, but an effective waiver requires the "intentional relinquishment or abandonment of a known right or privilege." *Johnson v. Zerbst*, 304 U.S. 458, 464 (1938); *see also Schneckloth v. Bustamonte*, 412 U.S. 218, 228 (1973), (observing that such waivers cannot be "coerced, by explicit or implicit means, by implied threat or covert force). Where the waiver is knowing and voluntary, moreover, the Court has enforced waivers of even the most fundamental constitutional rights. *See, e.g.*, *Patterson v. Illinois*, 487 U.S. 285, 292-93 (1988) (upholding validity of a waiver of the right to counsel). Applying those principles here means that where a patentee seeks to restrict the rights of a purchaser, the purchaser's waiver of rights under patent law should be express, knowing and voluntary, and should be enforced where those conditions are satisfied. *See Coll. Sav. Bank v. Fla.*

Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 682 (1999) (observing that waivers of state and federal sovereign immunity are "not [to be] implied" but that express and voluntary waivers are valid and enforceable).

The combined impact of the Court's precedents is thus that the patentee can limit the rights of purchasers in two ways. *First*, a patentee can expressly limit the authority of a *licensee* to manufacture, sell or use an article covered by the patent, such that an "unauthorized sale" to a downstream purchaser would fail to exhaust the patent right and give rise to a cause of action for infringement against either the licensee or the purchaser. This is precisely the result in *General Talking Pictures*, 305 U.S. at 127, *General Electric*, 272 U.S. at 489-90, and *Mitchell*, 83 U.S. at 550.

Second, the patentee and purchaser can expressly agree to limit the rights that the purchaser would normally have as a result of an authorized sale, such that a violation of those limitations would be actionable in an infringement action. However, the limitations would not flow downstream with a subsequent authorized sale absent an additional express agreement with a downstream purchaser. The written contractual arrangement can be with the patentee directly, for example where the patentee acts as seller, or through a licensee if the patentee requires such a contract in the licensing agreement with the licensee. In all instances, however, the restrictions must be valid under the federal antitrust laws and cannot expand or misuse the patent right. *See supra* at 16-17.

C. A Rule Permitting Express Restrictions On Purchasers Fulfills The Goals Of Patent Law And The Exhaustion Doctrine.

A strong exhaustion doctrine, but one that recognizes the patentee's ability to limit the authority of licensees through licensing agreements and restrict the rights of purchasers through express agreements where those restrictions are otherwise valid under federal law is not only the direct outgrowth of this Court's jurisprudence but also necessary to realize the policies and purposes of patent law.

First, a rule that preserves a strong exhaustion doctrine but permits parties to agree to restrictions within the scope of the patent grant that otherwise satisfy antitrust and patent misuse requirements (*see supra* pp. 16-17) strikes an appropriate balance.

One of the basic policies of patent law is to "balance between the need to encourage innovation and the [need to avoid] monopolies which stifle competition." *Bonito Boats*, 489 U.S. at 146. Congress sought to "defin[e] the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work . . . [and reach] a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand." *Sony Corp. of Am. v. Universal Studios, Inc.*, 464 U.S. 417, 429 (1984).

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The exhaustion doctrine is a powerful tool for achieving this balance, because it prevents the recovery of multiple royalties for the same infringement. Exhaustion permits the patentee "but one royalty for a patented machine, and consequently when . . . consideration has been paid to him for the [patented] right, he has then to that extent parted with his monopoly, and ceased to have any interest whatever in the machine so sold or so authorized to be constructed and operated." *Bloomer*, 68 U.S. at 351-52.

Permitting patentees to enforce otherwise valid restrictions through licenses and express agreements with purchasers serves these purposes. Such a rule would prevent the patentee from extracting multiple royalties for the same infringement, because all parties with an economic interest under the patent will have a seat at the negotiating table, and all parties will negotiate clear restrictions on the activities covered by the patent where such restrictions are the product of mutual agreement. That is, when the licensee or purchaser acting in a commercially reasonable manner clearly agrees to a grant of less than full rights under the patent, they will compensate the patentee accordingly. Absent an express restriction, the patentee will be legally held to have obtained a full royalty from the licensee or a purchaser for a fully authorized sale.

Second, a vigorous exhaustion doctrine that is excepted only where there are express restrictions on the rights under a patent will achieve much needed clarity in the law. As this Court has recognized, clarity is necessary to maintain the patent system's effectiveness. "A patent holder should know what he

owns, and the public should know what he does not" to satisfy "the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 731 (2002). The importance of providing notice to the public of the scope of patent rights cannot be overstated:

> [T]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. Otherwise, a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field.

Markman v. Westview Instruments Inc., 517 U.S. 370, 390 (1996) (internal quotation marks omitted). This is particularly true in the exhaustion context, because exhaustion defines the legal termination point of the patentee's exclusionary rights. *See Adams v. Burke*, 84 U.S. at 456. Thus, the circumstances by which a patentee can avoid this termination must be unmistakably clear to it and to purchasers.

Requiring an express agreement to overcome the normal operation of exhaustion would provide this clarity. A licensee that disregards clear restrictions

on its authority has long been understood to assume the risk of infringement because it has consented to those restrictions. Similarly, a purchaser will know whether it is subject to restrictions because it will have to expressly agree to the restrictions by written contract.

D. Applying These Principles Requires Reversal Of The Federal Circuit's Decision.

Applying these principles here requires reversal of the Federal Circuit's decision, because Intel's sales of the chipsets and microprocessors—articles with no substantial non-infringing uses—were authorized under the License Agreement, and petitioners did not expressly agree to restrictions on their use of these articles.

With respect to Intel's authority under the License Agreement, there is no dispute that its manufacture and sale of the chipsets and microprocessors were authorized. The License Agreement expressly authorizes Intel to "make, use, sell (directly or indirectly), offer to sell, import and otherwise dispose of all Intel Licensed Products" without restriction. Pet. App. 33a (internal quotation marks omitted). The Master Agreement further recognizes Intel's authority to sell the chipsets and microprocessors by allowing Intel to represent to potential purchasers that it has a "broad patent license" from respondent that "ensures that any Intel product that you purchase is licensed by [respondent] and thus does not infringe any patent held by [respondent]." Opp. 7 (internal quotation marks omitted). To be sure, the Master Agreement requires Intel to notify downstream purchasers of respondent's contention

that Intel's authority under the License Agreement "does not extend, expressly or by implication, to any product that you may make by combining an Intel product with any non-Intel product." *Id.* (internal quotation marks omitted). It is undisputed that Intel satisfied this requirement. *See id.*; Reply Br. 9. In addition, it is clear that the chipsets and microprocessors had only one substantial use—to be combined with other products and made into a computer. Opp. 9; Pet. App. 46a. Indeed, Intel provided purchasers with exact specifications instructing them how to make this combination. Pet. 3.

Having made an authorized sale of a product with no substantial non-infringing use, exhaustion must apply unless respondent and petitioners, or Intel and petitioners, expressly agreed that petitioners were purchasing restricted patent rights. Here, it is not contended that respondent and petitioners had such an express agreement between them. In the absence of an express, knowing and voluntary agreement to restrict petitioners' rights under respondent's patents, exhaustion attached with Intel's authorized sale.

The Federal Circuit's contrary conclusion—that Intel, an authorized seller, validly restricted petitioners by issuing a unilateral notice asserting that petitioners had no right to combine the chipsets with non-Intel components—is erroneous. Most obviously, the Federal Circuit's conclusion that a unilateral notice defeats the normal operation of the exhaustion doctrine is inconsistent with the Court's precedents holding that unilateral notices are not sufficient to restrict a purchaser's rights under a

patent that flow from an authorized sale. *See, e.g.*, *Motion Picture Patents Co.*, 243 U.S. at 518-19; *Ill. Tool Works*, 547 U.S. at 38.

In addition, the Federal Circuit ignored that the notice provided to the petitioners was so internally inconsistent and inconsistent with the fundamental purpose of the transaction as to render it unenforceable or hopelessly ambiguous. The sole function of the chipsets, and the sole use for which petitioners purchased them, was to be combined with non-Intel components and made into a computer. To this end, Intel provided detailed specifications describing how the combination should be made. It also provided notice that it was fully authorized to manufacture and sell the chipsets, but informed purchasers that they could not make the infringing combination, while telling them how to do so. In this context, the unilateral notice that the combination was impermissible, if enforced, was both confusing and materially inconsistent with the purpose of the transaction. *See* U.C.C. § 2-702(2) (disallowing supplemental "battle of the forms" terms that materially alter the underlying sales agreement).

E. The Federal Circuit's Decision Undermines The Doctrine Of Contributory Infringement.

Finally, the Federal Circuit's interpretation of exhaustion upsets the delicate balance of patent law by authorizing double recovery for both contributory and direct infringement. The doctrine of contributory infringement grants patentees an avenue of recourse against sellers and others who do not directly infringe the patent "where enforcement against direct infringers is impracticable," such as where the

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transaction costs of seeking recovery against the direct infringers (who are generally the product's end-users) are prohibitive. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 511 (1964) (internal quotation marks omitted). Exhaustion and contributory infringement are linked, moreover, by virtue of the statutory definition of contributory infringement, which excludes from its scope a sale of "a staple article or commodity of commerce suitable for *substantial noninfringing use*." 35 U.S.C. § 271(c) (emphasis added). Great care must be taken when making pronouncements about exhaustion that would impact contributory infringement liability, because the latter theory of liability is susceptible to abuse, namely windfall double recovery by patentees. Thus, the Court has cautioned that "after a patentee has collected from or on behalf of a direct infringer damages sufficient to put him in the position he would have occupied had there been no infringement, he cannot thereafter collect actual damages from a person liable only for contributing to the same infringement." *Aro Mfg. Co.*, 377 U.S. at 512.

The Federal Circuit's rule, however, creates an imbalance in the patent system that encourages the patentee to exceed its legitimate recovery by first pursuing the contributory infringer and then later pursuing the direct infringer. Here, despite the fact that respondent fully authorized, and was therefore fully compensated for, Intel's contributory infringement, it may still recover against petitioners for direct infringement. That is, the court is allowing respondent a full royalty in return for authorizing Intel's contributory infringement, and then allowing respondent to recover damages from petitioners for a

direct infringement that is nothing more than the inevitable consequences of what would have been, in the absence of the License Agreement, Intel's contributory infringement.

This result can be avoided by a rule that requires a purchaser's express agreement for restrictions on an article transferred in an authorized sale. Where parties act in a commercially reasonable manner, the bargaining process involved to reach express agreements will guarantee that the patentee is not overcompensated.

II. A CONTRARY RULE THAT WOULD ENFORCE NONE OR ALL PURPORTED RESTRICTIONS ON THOSE WHO PURCHASE FROM AUTHORIZED SELLERS WOULD DISRUPT THE PATENT SYSTEM'S CAREFUL BALANCE.

Any alternative rule of exhaustion—that is, one that would require something less than restrictions in a licensing agreement or expressly agreed to restrictions on the purchaser, or one that would prohibit agreements to overcome exhaustion where there is an authorized sale of a patented article with no substantial non-infringing use—would be either overly-permissive or overly-restrictive and impede commerce by disrupting the careful balance of the patent system.

A. Adopting The Federal Circuit's Rule Would Have Significant And Immediate Detrimental Economic Impacts.

At one extreme, adopting the Federal Circuit's ruling would have immediate, detrimental economic impacts. The economic impact of the Federal Circuit's decision in the information technology ("IT")

sector and on the consuming public, indeed, would be great. Modern IT is uniquely characterized by highly integrated products. Manufacturing a single computer, for example, requires the combination of literally thousands of components, manufactured by many different entities, brought together over a complex network of supply and manufacturing chains. Moreover, "[i]n IT . . . one product regularly involves the combination of 50, 100, even 1,000, or . . . 5,000 different patent rights" all of which "must be cleared in order to get the product to market." Mark A. Lemley, *Ten Things to do About Patent Holdup of Standards (And One Not To)*, 48 B.C. L. REV. 149, 151 (2007). And this phenomenon is not limited to the IT realm—chemical, biotechnological, hardware, and software inventions are just as complex and can involve many patents per product. *See* Mark A. Lemley & Carl Shapiro, *Patent Holdup and Royalty Stacking*, 85 U. TEX. L. REV. 1991, 1992 (2007).

If, as the Federal Circuit held, suspending exhaustion is as easy as requiring licensees to provide mere unilateral notice to purchasers, the rule of exhaustion would be too easily circumvented. A troubling regime, which has already begun to develop, would flourish wherein resourceful patentees will require insertion of restrictive "notices" at every possible point in the manufacturing and distribution channel. If the patentee could extract license fees for a single inventive contribution at every point in the distribution channel, its royalty base would increase dramatically and inappropriately because it would collect multiple royalties for the same infringement, thus destroying the efficiencies and benefits of our modern networked economy. Indeed, the ability to "hold up" product

distribution with unilateral restrictions on a single component could multiply into so many roadblocks that a product could never make it to market. And instead of being limited to the judicially mandated "one bite" of fair compensation, the patentee will now enjoy a smorgasbord of sequentially increasing royalty payments. The result: companies will be subject to increasing royalties at higher levels of integration in the manufacturing chain, and considering the number of patents that apply to complex IT products, the obvious outcome will be increased costs at each stage. Consumers would suffer from the higher cost of, and reduced access to, IT products, while manufacturers down the production chain would have fewer resources available to devote to follow-on innovations.

B. An Alternative Rule Precluding Restrictions On Purchasers Would Over-Expand The Exhaustion Doctrine To The Detriment Of Innovation.

At the other extreme, an alternative test that would require immutable exhaustion would be overly-restrictive and unnecessarily limit the pro-competitive effects of allowing patentees to grant, and purchasers to secure, restricted patent rights through express agreements of varying scope at correspondingly varying valuations.

Such a rule would be contrary to the longstanding principle that a patentee enjoys great freedom, albeit limited by antitrust laws and other legal principles such as the patent misuse doctrine, in granting rights under only portions of its patent right. *See supra* pp. 16-17. If exhaustion becomes immutable, the patentee cannot enjoy its traditional ability to

nonetheless restrict rights under the patent by field, geography or duration. *See, e.g.*, MILGRIM, *supra*, §§ 2.32-2.38 (describing these various restrictions).

The ability of patentees to grant a varying array of rights under the patent at correspondingly varying valuations, moreover, is extremely beneficial to the public. Permitting the patentee, licensee and purchaser to create and enforce restrictions through express agreements ultimately "serve[s] pro-competitive ends by allowing the licensor to exploit its property as efficiently and effectively as possible. These [limitations] can be used to give a licensee an incentive to invest in the commercialization and distribution of products . . . and to develop additional applications for the licensed property." U.S. Dep't of Justice and Federal Trade Comm'n, ANTITRUST GUIDELINES FOR THE LICENSING OF INTELLECTUAL PROPERTY 5 (1995), *reprinted in* 4 Trade Reg. Rep. (CCH) ¶ 13,132, at 20,736 (Apr. 6, 1995). Specifically, purchasers have the opportunity to pay a lower price for only those patent rights they need or desire, rather than pay a full royalty for more rights than they require. Because purchasers can negotiate for only those patent rights necessary for their purposes, restricted purchases are economically efficient.

In addition, any immutable exhaustion rule, while seemingly simple to apply, would greatly complicate exhaustion questions. Under IBM's proposed test, patentees, licensees and purchasers that wish to limit exhaustion have a clear path: write clear and express restricted licenses or purchase agreements. In contrast, a rule under which exhaustion cannot be overcome if a patented article has no substantial non-

infringing use would force many exhaustion questions into the courts, because determining whether such uses exist is a difficult and fact-intensive question that is often interpreted differently by patentee and purchaser. *See, e.g.*, *Bandag, Inc. v. Al Bolser's Tire Stores, Inc.*, 750 F.2d 903, 924 (Fed. Cir. 1984) (implied license case demonstrating the complexity of determining the existence of a substantial non-infringing use); *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1379 (Fed. Cir. 2001) (same). Indeed, the instant case shows the ambiguity inherent in the phrase "substantial non-infringing use." Here, respondent argued, unsuccessfully, that the chipsets and microprocessors had substantial non-infringing uses, because they could have been used in computers sold "outside the United States," Pet. App. 46a, or "used as replacement parts." Pet. App. 48a. As the district court pointed out, these purported alternative uses are so generic and insubstantial as to "eviscerate the defenses of exhaustion and implied license." Pet. App. 47a. But the arguments demonstrate the potential for disagreement between the patentee and purchaser regarding possible uses for a patented article. *See also Monsanto Co. v. McFarling*, 488 F.3d 973 (Fed. Cir. 2007) (involving protracted litigation over the issue of infringing uses for soybean seeds), *petition for cert. filed*, 76 U.S.L.W. 3081 (No. 07-241, Aug. 22, 2007). Thus, in practice, such a rule would obscure, rather than clarify, the patentee's, licensee's and purchaser's rights under the exhaustion doctrine, forcing exhaustion disputes into the courts.

In short, as in most cases involving the scope and application of patent law, the best rule, and the one

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required under this Court's jurisprudence, is a balanced one.

CONCLUSION

For these reasons, the decision of the Federal Circuit should be reversed.

Respectfully submitted,

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No. 04-607

IN THE

Supreme Court of the United States

LABORATORY CORPORATION OF AMERICA HOLDINGS, dba LabCorp,

Petitioner,

v.

METABOLITE LABORATORIES, INC., *et al.*,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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1

BRIEF OF INTERNATIONAL BUSINESS MACHINES CORPORATION AS AMICUS CURIAE IN SUPPORT OF NEITHER PARTY[1]

International Business Machines Corporation (IBM) respectfully submits this brief as *amicus curiae* in support of neither party.

INTEREST OF AMICUS CURIAE

IBM is a globally recognized leader in the field of information technology research, development, design, manufacturing, and related services. During IBM's nearly 100-year history, its employees have included five Nobel laureates, five National Medal of Science recipients, and eight winners of the National Medal of Technology. The United States Patent and Trademark Office (USPTO) has granted IBM tens of thousands of United States patents, including more patents than any other corporate assignee for the past twelve years. IBM is the proprietor of more patents claiming computer-related inventions than any other entity in the world. IBM is also ranked in the top two for patents issued on business methods, as classified by the USPTO.[2] IBM believes it can provide a balanced view on important issues implicated by this case — namely, the patentability standard under 35 U.S.C. § 101, and particularly as it relates to patenting of business methods.

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[1] In accordance with Supreme Court Rule 37.6, Amicus states that this brief was authored in its entirety by the counsel listed herein. No person or entity other than Amicus listed on the cover made a monetary contribution to the preparation or submission of this brief. Letters reflecting written consent of the parties to the submission of this brief have been filed with the Clerk of the Court.

[2] According to information available to IBM, it has been issued 308 patents on business methods as of December 13, 2005.

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As a leading recipient, licensee, and licensor of patents, amicus IBM is committed to maintaining the integrity of the United States patent laws. IBM is particularly interested in assuring that the statutory standard (35 U.S.C. § 101) for patent eligibility of business methods is addressed in a manner that is both rational and consistent with established principles of patent law.

INTRODUCTION AND SUMMARY OF ARGUMENT

Since this Court last interpreted section 101 of the patent statute, *see Diamond v. Diehr*, 450 U.S. 175, 191-93 (1981), certain decisions of the Federal Circuit Court of Appeals have broadened the scope of subject matter deemed eligible for patenting, particularly in the area of business methods. Under the standard currently followed by the Federal Circuit, an invention is eligible for patenting if "it merely achieves a useful, concrete, and tangible result." *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). Under this lenient standard, the section 101 inquiry has taken an "end-justifies-the-means" approach, which has resulted in patents arising from a diverse range of human behavior traditionally outside the realm of patent protection, including economic analyses, artistic techniques, athletic skills, and abstract methods of doing business. As one Federal Circuit jurist remarked, under that court's case law, "virtually anything is patentable." *Hughes Aircraft Co. v. United States*, 148 F.3d 1385, 1385 (Fed. Cir. 1998) (Clevenger, J., dissenting from denial of rehearing) (*citing State Street*, 149 F.3d 1368).

Despite the significance of the issues surrounding subject matter eligibility under section 101, particularly for business methods, IBM believes that the facts of this case do not present a suitable opportunity for analyzing and articulating the proper scope of subject matter for patent eligibility. The

present matter before the Court involves a medical diagnostic procedure, rather than an inchoate business method or other abstract technique. Moreover, the parties did not squarely address the section 101 issue below and the resulting record is thus not sufficiently developed with respect to the statutory subject matter inquiry. IBM therefore respectfully suggests that the Court not speak broadly to the issue of patentable subject matter, but rather await a more appropriate case to address this issue. Should, however, the Court decide to address the scope of subject matter eligibility for business methods, IBM wishes to provide its view on section 101 for the Court's consideration.

As a general matter, a robust notion of patentable subject matter best serves the United States in the twenty-first century. Within our innovation-driven economy, diverse industries have contributed numerous technical advances that are unquestionably suitable for patenting. The USPTO has, for example, appropriately awarded patents in the pharmaceutical, biotechnology, computer/electronics, biomedical, financial, mechanical and other important fields.

Unfortunately, decisions of the Federal Circuit (like *State Street*) have unduly expanded the scope of patent-eligible subject matter for business methods. This broad scope stands at odds with the Constitution and this Court's consistent statements that an invention must contribute to the "Progress of [the] . . . useful Arts" in order to be eligible for patenting. In that constitutional context, patentable advances must be tied to a particular machine or apparatus, or alternatively, must reside in the physical transformation of an article to a "different state or thing." *See Gottschalk v. Benson*, 409 U.S. 63, 70-71 (1972). The *State Street* standard overlooks this Court's precedent and fails to apply an important constraint upon the patent system without any doctrinal justification or alternative tempering principle.

In the absence of a compelling rationale to alter the understanding of "useful arts," IBM believes that this Court should reaffirm its existing standard for subject matter patentability which is restricted to inventions that involve technological contributions — namely, tangible products or processes that either (i) are tied to a particular machine or apparatus or (ii) cause transformation or reduction of an article to a different state or thing, and in either instance produce technologically beneficial results. IBM recognizes that the Court has previously used language suggesting that this standard may not be a rigid rule, but rather more akin to a presumption. In the intervening years, however, no situation has been presented to this Court which warrants any exception to this rule. This test sets forth a reasonable and balanced standard for subject matter eligibility.

The long-standing principles governing subject matter eligible for patenting should be maintained such that, for example, a method of painting a surface using the posterior of an infant (U.S. Pat. No. 6,213,778) and a method for making jury selection determinations (U.S. Pat. No. 6,607,389) are not patentable subject matter because they do not produce technologically beneficial results. IBM recognizes that some of its own business method patents may include claims that might not satisfy this standard.

The Federal Circuit accomplished its shift in patent policy without any evidence suggesting that incentives for innovation are currently needed with respect to abstract business methods and other non-technological innovations, and without due consideration of the impact that such a shift would have on the economy. Although no persuasive justification prompted the abrupt allowance — indeed explosion — of patents for abstract business methods, the breadth of coverage of such patents has raised significant concerns within the innovation community. Among them is concern that such patents, because they are not restricted to

a specific technological contribution, may effectively appropriate all conceivable solutions to a particular problem. Such an overbroad monopoly thwarts progress of the useful arts by precluding legitimate attempts to design around a patent and by providing unjustified rewards beyond the contribution of the inventor. As a result, should this Court speak to the issue of statutory subject matter beyond the facts of this case, IBM respectfully suggests that the Court should reaffirm, consistent with its precedent on section 101, that a technological contribution is required for subject matter patentability, thereby denying patents on abstract or non-technological business methods.

I. DIVERSE INDUSTRIES HAVE MADE TECHNICAL CONTRIBUTIONS THAT APPROPRIATELY FALL WITHIN THE SCOPE OF PATENTABLE SUBJECT MATTER

Throughout our history, the constitutional and statutory standard for patent-eligible subject matter has been sufficiently flexible to adapt to new technological innovations. For example, during the Industrial Revolution, the Court in *Cochrane v. Deener*, 94 U.S. 780, 781, 791 (1877), held that an improved method for manufacturing flour was patentable. More recently, in *Diamond v. Chakrabarty*, 447 U.S. 303, 318 (1980), the Court held that a new life form, a microbe capable of digesting petrochemicals, was patentable. At the dawn of the Information Age, the Court held that a claim directed to a chemical process which included a programmed digital computer was patentable. *Diehr*, 450 U.S. at 191-93. The USPTO has heeded the Court's direction, allowing patents on, *inter alia*, new pharmaceutical, biotechnology and financial services inventions.[3] IBM fully supports a robust scope of patentable subject matter for these

[3] *See, e.g.*, U.S. Patent Nos. 6,969,531 ("Sodium Hyaluronate Microsphere), 6,967,096 ("Thermostable Peptisade") and 6,606,606 ("Systems and Methods for Performing Integrated Financial Transaction").

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and other important innovations which are rooted in technological contributions. Further, IBM recognizes that the patent system's ability to adapt to new technologies is consistent with the constitutional requirement of promoting the useful arts and, in particular, that a measured evolution of the scope of patentable subject matter is an important incentive for pioneering innovations.

Turning to the recent burst of business method patents and the significance of the issues surrounding subject matter eligibility of business methods, IBM believes that the facts of this case do not present a suitable predicate for broadly analyzing and articulating the proper scope of subject matter patentability under section 101. First, while IBM expresses no view on the merits of this case, the present matter before the Court involves a medical diagnostic procedure,[4] rather than an inchoate business method or other abstract technique. Second, the petitioner failed to preserve the issue of patentable subject matter in the lower courts or develop a complete record for its review. The petitioner did not, either at trial or on appeal, challenge the validity of the patent as being directed to non-statutory subject matter.[5]

While the question on which certiorari was granted is narrower than that posed to the Government,[6] IBM submits

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[4] The patent is directed to methods for assaying samples of body tissues to determine total homocysteine levels and methods for diagnosing vitamin B deficiency based on the elevated homocysteine levels. U.S. Patent No. 4,940,658, col. 3, ll. 6-62.

[5] *See* Brief for the United States as Amicus Curiae at 9-12, *Metabolite Labs , Inc v. Lab. Corp. of Am.*, 370 F.3d 1354 (Fed. Cir. 2004), *cert. granted*, 126 S. Ct. 601 (U.S. Nov. 2, 2005) (No. 04-607).

[6] When the petition for certiorari was pending, this Court asked for the Government's views on the following question: "Is the patent invalid because one cannot patent 'laws of nature, natural phenomena, and abstract ideas'? *Diamond v. Diehr*, 450 U.S. 175, 185 (1981)." *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 125 Sup. Ct. 1413 (2005).

this brief to address the subject of patent eligibility under section 101, particularly for business methods, in the event the Court decides to undertake a broad review of subject matter patentability.

II. THE SCOPE OF PATENTABLE SUBJECT MATTER HAS BEEN EXPANDED BEYOND THE LIMITS ESTABLISHED BY THE CONSTITUTION AND THIS COURT'S PRECEDENT

A. The Constitution And This Court's Precedent Establish Limits Upon The Subject Matter Eligible For Patenting

Article I, Section 8 of the Constitution provides:

> The Congress shall have Power ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U.S. CONST. art. I, § 8, cl. 8. *See* THE FEDERALIST No. XLIII, at 294 (James Madison) (M. Walter Dunne 1901) ("The right to useful inventions . . . belong to the inventors."). Historical context confirms that the Constitution restricts the scope of patent eligible subject matter. For example, the English Statute of Monopolies of 1623, upon which the United States patent system is largely based, provided an exception to the general prohibition against monopolies by granting a "privilege for the term of fourteen years or under [for] the sole working or making any manner of new manufactures . . . to the . . . inventor . . . ." Statute of Monopolies, 1623, 21 Jac. 1, c.3 (Eng.), *reprinted in* 9 DONALD S. CHISUM, CHISUM ON PATENTS, App. 8-3 (2005). Notably, that Statute eliminated

commercial practices from the scope of patentable exclusivity:

> [T]hose who formulated the Constitution were familiar with the long struggle over monopolies so prominent in English history, where exclusive rights to engage even in *ordinary business activities* were granted so frequently by the Crown for the financial benefits accruing to the Crown only It was desired that in this country any Government grant of a monopoly for even a limited time should be *limited to those things which serve in the promotion of science and the useful arts.*

In re Yuan, 188 F.2d 377, 380 (C.C.P.A. 1951) (emphasis added). Contemporaneous use of the term "useful art" by the Founding Fathers further confirms that patent-eligible subject matter is limited to technological or industrial innovations. The term "useful arts" was used in the context of the production of goods and the industrial, mechanical and manual arts, days before the Constitutional Convention of 1787 by a delegate to that Convention.[7] Likewise,

[7] "Under all the disadvantages which have attended manufactures and *the useful arts*, it must afford the most comfortable reflection to every patriotic mind to observe their progress in the United States and particularly in Pennsylvania . . . Permit me however to mention them under their general heads: meal of all kinds, ships and boats, malt and distilled liquors, potash, gunpowder, cordage, loaf-sugar, pasteboard, cards and paper of every kind, books in various languages, snuff, tobacco, starch, cannon, musquets, anchors, nails, and very many other articles of iron, bricks, tiles, potters ware, mill-stones, and other stone work, cabinet work, trunks and Windsor chairs, carriages and harness of all kinds . . . ." Tench Coxe, Delegate to the 1787 Constitutional Convention from Pennsylvania, An Address to an Assembly of the Friends of American (Cont'd)

Alexander Hamilton praised the patent system as a way of encouraging manufacturing industries and "[inventions] which relate to machinery" in the United States. ALEXANDER HAMILTON, THE REPORTS OF ALEXANDER HAMILTON: REPORT ON MANUFACTURES (Dec. 5, 1791) 115-16, 175-76 (Jacob E. Cooke ed., Harper & Row 1964).

Consistent with the constitutional foundation, the current patent statute, 35 U.S.C. § 101, provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

This Court has long held that the first three categories enumerated in section 101 — machines, manufactures and compositions of matter — refer to physical products. The Court has defined the term "machine" in section 101 to mean "a concrete thing, consisting of parts, or of certain devices and combination of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1864). "'Manufacture'" in section 101 means "'the production of articles for use from raw or prepared materials by giving to these materials new forms,

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Manufactures: Convened for the Purpose of Establishing a Society for the Encouragement of Manufactures and the Useful Arts, Read in the University of Pennsylvania, on Thursday the 9th of August 1787, 17-18 (R. Aitkin & Son 1787) (emphasis added); *see also* Joseph Barnes, *Treatise on the Justice, Policy, and Utility of Establishing an Effectual System for Promoting the Progress of Useful Arts* 4 (Francis Bailey 1792) (Patentable invention "consists in discoveries in science, and in the useful arts; by means of which agriculture, navigation, manufactures, and manual labor are, not only facilitated, but much promoted; and, indeed, to these they owe their present state of perfection.").

qualities, properties, or combinations, whether by hand-labor or by machinery.'" *Chakrabarty*, 447 U.S. at 308. "[C]omposition of matter" has been defined as "all compositions of two or more substances and . . . all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids." *Id.*

The fourth section 101 category — "process" — is defined in the patent statute as:

> process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

35 U.S.C. § 100(b). Although the meaning of the terms "process, art or method" is broad on its face, this Court's precedent "forecloses a purely literal reading of § 101." *Parker v. Flook*, 437 U.S. 584, 589 (1978); *see also Diehr*, 450 U.S. at 183 ("A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing."). In particular, this Court has consistently distinguished between concrete, specific and technologically-grounded aspects of innovative contributions, which are protectable via the patent system, from underlying abstract or general principles, which are not.

In an early landmark decision regarding patentable subject matter, *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1854), the Court revoked Morse's eighth claim, which recited:

> *I do not* propose to *limit myself to* the *specific machinery* or parts of machinery described in the foregoing specification and claims; *the essence*

> *of my invention being the use of* the motive power of the electric or galvanic current, which I call *electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances*, being a new application of that power of which I claim to be the first inventor or discoverer.

Id at 112 (emphasis added). The Court reasoned that the claim was "not warranted by law" because it would protect, and thereby prevent use of, all conceivable solutions to accomplish the recited result. *Id.* at 113.

> *If this claim can be maintained, it matters not by what process or machinery the result is accomplished.* For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. . . . But yet if it is covered by this patent the inventor could not use it, nor the public have the benefit of it without the permission of this patentee.

Id. at 112-13 (emphasis added). The Court explained that Morse was only entitled to a patent for the method of using electro-magnetism to print marks or signs at a distance that he actually invented: "he has not discovered that the electro-magnetic current, used as a motive power, *in any other method, and with any other combination*, will do as well." *Id.* at 117 (emphasis added).

Twenty years later, in *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874), the Court invalidated a

claim reciting a rubber eraser having a hole to accept a pencil, explaining "an idea of itself is not patentable, but a new device by which it may be made practically useful is."

O'Reilly and *Rubber-Tip Pencil* are bedrock cases for determining the patent eligibility of subject matter. In the first instance, both cases confirm that the patent system does not protect all types of processes nor does it protect abstract ideas. These cases also reinforce the important policy goal of maintaining "basic tools of scientific and technological work" within the public domain. *See Gottschalk*, 409 U.S. at 67. *O'Reilly* in particular makes clear that process patents should not be allowed to appropriate all solutions to a problem. This Court has consistently applied the fundamental principles announced in *O'Reilly* and *Rubber-Tip Pencil* in the intervening years.

Notably, in a trilogy of cases decided at the dawn of the Information Age, the Court considered computer-related inventions and confirmed its early precedent as applied to new fields of endeavor. In *Gottschalk v. Benson*, 409 U.S. at 64, the patent claimed a "method for converting binary-coded decimal (BCD) numerals into pure binary numerals." "The claims were not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use." *Id.* The claims "purported to cover any use of the claimed method in a general-purpose digital computer of any type." *Id.*

The question presented to the Court in *Gottschalk* was "whether the method described and claimed was a 'process' within the meaning of the Patent Act." *Id.* After reviewing a number of early decisions, the Court held that the claimed method was not patentable. *Id.* at 71-73. Much as "one may not patent an idea," one may not patent the "formula for converting BCD numerals to pure binary numerals." *Id.* at

71. "[T]he mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgment below is affirmed, the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself." *Id.* at 71-72.

In reaching its decision, the Court acknowledged that the "[t]ransformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines." *Id.* at 70. *See, e.g., Expanded Metal Co. v. Bradford*, 214 U.S. 366, 385-86 (1909) (sustaining a patent on a process for expanding metal that involved mechanical operations).

Parker v. Flook, 437 U.S. at 585 involved claims drawn to a method for computing an "alarm limit" on any process variable involved in the catalytic chemical conversion of hydrocarbons. When a process variable, such as temperature, pressure, or flow rate, exceeded a predetermined "alarm limit," an alarm signaled "an abnormal condition indicating either inefficiency or perhaps danger." *Id.* The only difference between the claimed method and the previous conventional methods was the mathematical algorithm or formula used to calculate the alarm limit. *See id.* at 585-86.

The Court held that the claim was ineligible for patenting because it simply provided a formula for computing an updated alarm limit. *Id.* at 594-96. The application did not explain how to "select the appropriate margin of safety, the weighing factor, or any other variables, . . . [n]or [did] it . . . contain any disclosure relating to the chemical processes at work, the monitoring of process variables, or the means of setting off an alarm or adjusting an alarm system." *Id.* at 586.

Following the *Gottschalk* decision, the Court in *Parker* confirmed that a process does not automatically fall within the patentable subject matter of section 101 merely because a process implements a principle or mathematical formula in some specific fashion. *See Parker*, 437 U.S. at 593. To permit otherwise "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature." *Id.* "The rule that the discovery of a law of nature cannot be patented rests, not on the notion that natural phenomena are not processes, but rather on the more fundamental understanding that they are not the kind of 'discoveries' that the statute was enacted to protect." *Id.* An inventive application of a mathematical formula, principle or phenomenon of nature may be patented, but patentability cannot be supported "unless there is some other inventive concept in its application." *Id.* at 594.

Furthermore, the Court stated that "post-solution activity" — the adjustment of the alarm limit to the figure computed according to the formula — cannot "transform an unpatentable principle into a patentable process." *Id.* at 590. "A competent draftsman could attach some form of post-solution activity to almost any mathematical formula . . . [however, the] concept of patentable subject matter under § 101 is not 'like a nose of wax which may be turned and twisted in any direction . . . .'" *Id.* (*quoting White v. Dunbar*, 119 U.S. 47, 51 (1886)).

In *Diamond v. Diehr*, 450 U.S. at 177, the invention was "a process for molding raw, uncured synthetic rubber into cured precision products." According to the patent, the industry had been unable "to obtain uniformly accurate cures because the temperature of the molding press could not be precisely measured, thus making it difficult to . . . determine

cure time." *Id.* at 178. To overcome this problem, the method required, *inter alia*, constantly measuring the actual temperature inside the mold and then automatically feeding the temperature measurements into a computer which would repeatedly recalculate the cure time by use of a well-known equation. *See id.*

This Court held the claims to be patentable because "a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter." *Id.* at 184. Here, the "claims were not directed to a mathematical algorithm or an improved method of calculation but rather recited an improved process for molding rubber articles by solving a practical problem which had arisen in the molding of rubber products." *Id.* at 181. "[T]he transformation of an article, in this case raw, uncured synthetic rubber, into a different state or thing cannot be disputed." *Id.* at 184. In fact, "[i]ndustrial processes such as this are the types which have historically been eligible to receive the protection of our patent laws." *Id.*

The Court further stated, "[a] claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program, or digital computer." *Id.* at 187. Rather, "when a claim containing a mathematical formula implements or applies that formula in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect (*e.g.*, transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of § 101." *Id.* at 192.

On the other hand, "laws of nature, natural phenomena, and abstract ideas" are excluded from patent protection. *Id.* at 185. Scientific truths, or the mathematical expression

of them, are similarly outside the patent system, but "'a novel and useful structure created with the aid of knowledge of scientific truth may be [patentable].'" *Id.* at 188 (*quoting Mackay Radio & Telegraph Co. v. Radio Corp of Am.*, 306 U.S. 86, 94 (1939)).

In these and other relevant patent cases, the Court has developed several cogent principles that constrain subject matter patentability:

- "Excluded from . . . patent protection are laws of nature, natural phenomena, and abstract ideas." *Diehr*, 450 U.S. at 185.

- "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175 (1853).

- One may not patent an idea. *Gottschalk*, 409 U.S. at 71 (*citing Rubber-Tip Pencil*, 87 U.S. at 507).

- "Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Gottschalk*, 409 U.S. at 67.

- Mathematical algorithms are not patentable. *See Diehr*, 450 U.S. at 186; *Parker*, 437 U.S. at 586; *Gottschalk*, 450 U.S. at 71-72.

- One cannot patent all solutions to a problem. *See O'Reilly*, 56 U.S. at 113.

- "'It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself.'" *Diehr*, 450 U.S. at 182 n.7 (*quoting Corning v. Burden*, 55 U.S. (15 How.) 252, 267-68 (1854)).

- Insignificant post-solution activity or limiting an abstract idea to one technological environment will not render an abstract idea patentable. *See Diehr*, 450 U.S. at 191-92; *Parker*, 427 U.S. at 590.

- "A claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, but *never the function or result* of either, nor the scientific explanation of their operation." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (emphasis added).

B. The Gravamen Of This Court's Precedent Is That Subject Matter Patentability Is Restricted To Inventions That Involve Technological Contributions

IBM believes a comprehensive understanding of subject matter patentability can be deduced directly from this Court's precedent. More specifically, patentable subject matter is restricted to inventions that involve technological contributions — namely, tangible products or processes that either (i) are tied to a particular machine or apparatus or (ii) cause transformation or reduction of an article to a different state or thing, and in either instance produce technologically beneficial results. In summarizing this Court's existing standard, IBM recognizes that the Court has used language suggesting that it may not be a definitive rule,

but rather more akin to a presumption.[8] In the intervening years, however, no situation has been presented to this Court to justify an exception to this Court's standard. This test sets forth a reasonable and balanced standard for subject matter eligibility.

The requirement for technological contribution is also consistent with numerous cases of this Court, referring to patents as properly directed toward "technology" and "technological growth and industrial innovation." *See, e.g.*, *Gottschalk*, 409 U.S. at 64 ("The claims were not limited to any particular art or *technology*, to any particular apparatus or machinery, or to any particular end use.") (emphasis added); *Diehr*, 450 U.S. at 184 ("*Industrial processes* . . . have historically been eligible to receive the protection of our patent laws.") (emphasis added); *Pfaff v. Wells*, 525 U.S. 55, 63 (1998) ("the patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new and useful advances in *technology*, in return for an exclusive monopoly for a limited period of time.") (emphasis added); *Bonito Boats v Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989) (same); *Markman*, 517 U.S. at 390 ("Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases, H.R. Rep. No. 97-312, pp. 20-23 (1981), observing that increased uniformity would 'strengthen the United States patent system in such a way as to foster *technological growth and industrial innovation*.'") (emphasis added). IBM has been unable to find any cases from this Court that are inconsistent with the technological contribution requirement.

[8] The *Gottschalk* Court stated: "It is argued that a process patent *must* either be tied to a particular machine or apparatus or *must* operate to change articles or materials to a 'different state or thing.' We do not hold that no process could ever qualify if it did not meet the requirements of our prior precedents." *Gottschalk*, 409 U.S. at 71 (emphasis added). However, the Court has not undertaken to define circumstances where a process outside its precedent would qualify for patent protection

Until recent years, lower courts had also recognized that patenting was confined to the "technological arts," a modern term recognized as synonymous with the phrase "useful arts" as it appears in the Constitution. *In re Waldbaum*, 457 F.2d 997, 1003 (C.C.P.A. 1972); *In re Bergy*, 596 F.2d 952, 959 (C.C.P.A. 1979) ("We have previously pointed out that the present day equivalent of the term 'useful arts' employed by the Founding Fathers is '*technological arts.*'") (emphasis added), *aff'd sub nom*, *Diamond v. Chakrabarty*, 447 U.S. 303 (1980); *In re Musgrave*, 431 F.2d 882, 893 (C.C.P.A. 1970) ("All that is necessary, in our view, to make a sequence of operational steps a statutory 'process' within 35 U.S.C. § 101 is that it be in the *technological arts* so as to be in consonance with the Constitutional purpose to promote the progress of 'useful arts.'") (emphasis added).

This test is rooted in the constitutional requirement that patents are granted to promote the progress of useful arts. In historical context, the useful arts required a technological contribution. This Court's precedent reinforces the need for a technological contribution for patent eligibility. A fair reading of this Court's precedent in the aggregate provides the foundation for the standard that a claim to a process or method is not patentable unless it either (i) is tied to a particular machine or apparatus or (ii) causes transformation or reduction of an article to a different state or thing, and in either instance produces technologically beneficial results.

C. The Decisions Of The Federal Circuit Have Applied An Unjustifiably Expansive Standard For Patent Eligibility Of Business Methods

A specific, and particularly troubling, arena where Federal Circuit rulings diverge from this Court's precedent is the eligibility of business methods for patenting. IBM is concerned over patenting methods of doing business lacking a technical contribution.[9]

Historically, methods of doing business were not patentable subject matter,[10] and the 1952 Patent Act did not

[9] Examples of abstract business methods include U.S. Patent Nos. 5,947,526 (claim 1 reciting method for tracking personal expenditures) and 5,668,736 (claim 1 reciting method for remodeling an existing building).

[10] *See, e.g., Hotel Security Checking Co v Lorraine Co*, 160 F. 467, 469-72 (2d Cir. 1908) ("cash-registering and account-checking" unpatentable "system of transacting business disconnected from the means for carrying out the system . ."); *Ex Parte Turner*, 1894 Dec. Comm'r Pat. 36, 36-37 (method to secure reading of advertisements not patentable because, *inter alia*, process carried no physical effect; "a plan or theory of action which, if carried into practice, could produce no physical results proceeding direct from the operation of the theory or plan itself is not an art within the meaning of the patent laws."); *Ex Parte Abraham*, 1869 Dec. Comm'r Pat 59 (method for detecting and preventing tax evasion by employing stamps to be severed upon attachment to an article unpatentable; "[i]t is contrary . . . to the spirit of the law . . . to grant patents for methods of book-keeping . . . ."); *Loew's Drive-in Theatres, Inc. v. Park-In Theatres, Inc*, 174 F.2d 547, 553 (1st Cir. 1949) (patent claiming arranging automobiles such that occupants would have an unobstructed view of a screen or stage did "not involve an exercise of the faculty of invention"); *Seagram & Sons, Inc v. Marzall*, 180 F.2d 26, 27-28 (D.C. Cir. 1950) (method for testing beverages and like products to make advance determination of

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change this principle. "Although the term 'process' was not added to 35 U.S.C. § 101 until 1952, a process [as shaped by this Court's precedent] has historically enjoyed patent protection because it was considered a form of 'art' as that term was used in the 1793 Act." *Diehr*, 450 U.S. at 182 (*citing Corning*, 56 U.S. (How. 15) at 267-68). In an oft-quoted comment, Judge Rich explained that:

> Section 101, entitled "Inventions patentable," enumerates the categories of inventions subject to patenting. Of course, not every kind of an invention can be patented. Invaluable though it may be to individuals, the public, and national defense, the invention of a more effective organization of the materials in, and the techniques of teaching a course in physics, chemistry, or Russian is not a patentable invention because it is outside of the enumerated [statutory] categories.... Also outside that group is one of the greatest inventions of our times, the diaper service.

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consumer reactions and preferences not "new and useful art, machine, manufacture, or any new and useful improvements thereof"); *In re Patton*, 127 F.2d 324, 327-28 (C.C.P.A. 1942) (system of fighting fires using standardized and interchangeable fire fighting equipment not patentable subject matter; "a system of transacting business, apart from the means for carrying out such system, is not within . . . [the patent statute] . . . nor is an abstract idea or theory, regardless of its importance or the ingenuity with which it was conceived, apart from the means for carrying such idea or theory into effect, patentable subject matter."); *In re Wait*, 73 F.2d 982, 982-83 (C.C.P.A. 1934) (method of buying and selling stocks, wherein one party advertised offer, another party accepted offer and such transaction was recorded, constituted unpatentable method of doing business), *In re Sterling*, 70 F.2d 910, 911-12 (C.C.P.A. 1934) (patent application directed to a particular arrangement of printed matter on bank checks and stubs not patentable subject matter).

Giles S. Rich, *Principles of Patentability*, 28 GEO. WASH. UNIV. L. REV. 393, 393-94 (1960).[11]

The dicta in the Federal Circuit decision in *State Street*, however, created a dramatic sea-change in the patentability of inchoate business methods. *State Street* involved a patent generally directed to a data processing system for implementing an investment structure which was developed for use in Signature's business as an administrator and accounting agent for mutual funds. 149 F.3d at 1370.

The district court invalidated the patent for failure to claim statutory subject matter under section 101. *Id.* The Federal Circuit reversed the district court, ruling that the claims were directed to patentable subject matter because they produced a "useful, concrete and tangible result." *Id.* at 1375.

> [T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result" — a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

Id. at 1373.

While the Federal Circuit's holding in *State Street* regarding the claim at issue can be justified, IBM believes

[11] Judge Rich was one of the principle drafters of the 1952 Patent Act as well as a Judge of the Court of Customs and Patent Appeals and the Court of Appeals for the Federal Circuit from 1957 to 1999.

that dicta in the decision ignited the explosion of non-technological business method patents seen today. The Federal Circuit concluded that the claim was drawn to a system, not a method of doing business, and it included a number of structural elements as limitations — thus, the claimed invention was a machine that implemented a process. However, the expansive dicta in *State Street* are inconsistent with this Court's precedent. *See, e.g., id.* at 1375 ("We take this opportunity to lay this ill-conceived exception [i.e., that business methods are not patentable] to rest.").

In the context of business methods, the broad dicta in *State Street* have reduced the historically separate subject matter requirement of section 101 to a mere "practical utility" determination. *State Street*, 149 F.3d at 1375 ("The question of whether a claim encompasses *statutory subject matter should* not *focus on* which of the four categories of subject matter a claim is directed to — process, machine, manufacture, or composition of matter — but rather on the essential characteristics of the subject matter, in particular, its *practical utility*.") (emphasis added).

The contrast in approach is clearly evident from this Court's precedent. In *Parker v. Flook*, for example, the case turned "entirely on the proper construction of § 101 of the Patent Act, which describes the subject matter that is eligible for patent protection." 437 U.S. at 588. Whether subject matter is eligible for patenting is an entirely separate inquiry from whether the claimed invention provides some useful result, i.e., whether it meets the separate utility requirement of section 101. *See id.*

No decision of this Court supports the broad proposition that merely because a method yields a useful result it should *ipso facto* be eligible for patenting, as is the current standard applied by the Federal Circuit. Rather, this Court has

recognized that the utility requirement of 35 U.S.C. § 101 is a distinct and separate test from the eligibility requirement of section 101. A mere "useful result" standard is much too lenient to determine whether subject matter is eligible for patenting. As Judge Rich so aptly stated decades ago, the diaper service (prior to the advent of disposable diapers) was undoubtedly one of the greatest business creations in its day, invaluable to countless individuals. However, despite its usefulness, the diaper service does not fall within one of the four enumerated categories of section 101. *See* Giles S. Rich, *Principles of Patentability*, 28 GEO. WASH. UNIV. L. REV. 393, 39394 (1960).

The standard espoused in *State Street* merely addresses the usefulness of the outcome. *See State Street*, 149 F.3d at 1375. This standard is at odds with the principles of patentability established by the Constitution and this Court and the ambit of patentable subject matter as established in the 1952 Patent Act. Ignoring the enumerated categories of statutory subject matter as a threshold inquiry of patentability makes the categories mere drafting protocols. *See Parker*, 437 U.S. at 590 (cautioning that a competent draftsmen could attach some post-solution activity to "transform an unpatentable principle into a patentable process" within section 101).

Although *State Street* purported to quote from *Diehr* that "anything under the sun made by man is patentable," that quote was taken out of context. *State Street*, 149 F.3d at 1373. Congressional reports employed that phrase only with respect to machines and manufactures. *See* S. REP. NO. 82-1979, at 2399 (1952) ("A person may have 'invented' a machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled."); H. R. REP. NO. 82-1923 (1952) (same). Certainly, section 101 does not say "anything under the sun made by man" is patentable subject matter, but rather references four specific categories.

Acquiescing to the demands of patent applicants and the *State Street* dicta, the USPTO has now dramatically changed course as well. Thus, for example, the USPTO recently promulgated "interim guidelines" stating that an invention need not lie within the "technological arts" to be patented. *Official Gazette of the United States Patent and Trademark Office*, 1300 O.G. 142, No. 4 (Nov. 22, 2005).[12]

Issued patents from such diverse areas as architecture, athletics, insurance, painting, psychology, and the law itself, reveal just how far afield the patent system has gone in granting patents in virtually any area of human endeavor, such as teaching a golf putting stroke or a method for lifting a box.[13]

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[12] In reaction to the sweeping impact of *State Street*, Congress passed the First Inventor Defense Act of 1999, i.e., 35 U.S.C. § 273, to provide a defense to infringement of a business method patent if the accused infringer "had, acting in good faith, actually reduced the subject matter to practice at least 1 year before the effective filing date of such patent, and commercially used the subject matter before the effective filing date of such patent." First Inventor Defense Act of 1999, Pub. L. No. 106-113, 113 Stat. 1536 (codified as amended at 35 U.S.C. § 273 (2000)). Beyond that limited purpose, there is nothing in the legislative history to suggest Congress intended to make any other changes to the United States patent laws. Thus, this Court's precedent on section 101 patent eligibility for business methods — as articulated in the *Gottschalk-Parker-Diehr* trilogy — remains the controlling standard.

[13] *See, e.g.*, U.S. Patents Nos. 5,498,162 ("Method For Demonstrating a Lifting Technique"), 6,447,403 ("Method and Apparatus for Improving Putting Skill"), 6,912,510 ("Methods of Exchanging an Obligation"), 5,190,458 ("Character Assessment Method"), and 5,809,484 ("Method and Apparatus For Funding Education By Acquiring Shares of Students Future Earnings").

III. NO SOUND INNOVATION POLICY SUPPORTS PATENTS ON NON-TECHNOLOGICAL METHODS OF DOING BUSINESS

Not only is an unrestricted sense of patentable subject matter disfavored by sound innovation policy, it conflicts with the requirement, stipulated by the Constitution and consistently articulated by this Court's precedent, that patentable subject matter must fall within the "useful arts."

A. Patent-Based Incentives Are Not Needed To Spur Business Method Innovation

The decision to issue patents on particular subject matter involves, in the words of Thomas Jefferson, a determination of those "'things which are worth to the public the embarrassment of an exclusive patent . . . .'" *Graham v. John Deere Co.*, 383 U.S. 1, 9 (1966).

In this regard, the evidence suggesting a sudden need for patent-based incentives to promote the development of business concepts is conspicuous by its absence. "Nowhere in the substantial literature on innovation is there a statement that the United States economy suffers from a lack of innovation in methods of doing business. Compared with the business practices of comparable economies we seem to be innovators . . . ." Leo J Raskind, *The State Street Bank Decision: The Bad Business of Unlimited Patent Protection for Methods of Doing Business*, 10 FORDHAM INTELL. PROP., MEDIA & ENT. L.J. 61, 92 (1999). Among the reasons for the persistent favorable record of commercial entrepreneurship in the United States are existing federal and state regimes, including unfair competition law, trade secrets, copyright, and the misappropriation doctrine, that have long policed free riding and allowed business pioneers to reap the rewards of their ideas. *See id.* at 93. In conjunction with market-based

incentives, including the desire to seize first-mover and learning-curve advantages, the current legal framework has resulted in a flourishing environment for business innovation in the United States. No plausible argument supports the view that protecting non-technological business methods through our patent system is needed to solve a market failure problem, fill a legal void, or ultimately enhance social welfare.

B. Business Method Patenting Raises Significant Competitive Concerns

Although no convincing justification exists for allowing patents on non-technological methods of doing business and other abstract ideas, the breadth of coverage of such patents has raised significant competitive concerns. Among them is that such patents are not restricted by the Constitution and the precedent articulated by this Court. Rather, they may effectively appropriate all possible solutions to a particular problem. This direct restraint upon the ability of competitors to develop alternatives to the patented invention thwarts a principal aspiration of the patent system, fostering new alternatives. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991) ("Designing around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose."); *Brenner v. Manson*, 383 U.S. 519, 534 (1966) ("Until [a] process claim has been reduced to production of a product shown to be useful, the metes and bounds of that monopoly are not capable of precise delineation. It may engross a vast, unknown, and perhaps unknowable area.").

Consider, for example, the ubiquitous automated teller machine ("ATM"). A review of the patent rolls reveals numerous ATM patents concerning such mechanical, electrical, and computer-implemented inventions as card

readers, touch screens, cash dispensers, statement printers, and antitheft mechanisms. As evidenced by the robust competition within the contemporary ATM industry, such patents have both preserved the incentives of industry participants to innovate, yet allowed their competitors to market alternative designs. However, in view of the Federal Circuit's endorsement of patents on inchoate business methods, a contemporary inventor's claim to the very concept of an ATM would be considered eligible for patenting under section 101. Much like claim 8 of Morse's telegraphy patent, such a patent would effectively prevent all others from designing alternative mechanisms for meeting the same marketplace needs. The potential adverse impact of this hypothetical patent upon competition not just in the ATM industry, but within the banking industry itself, is apparent.

The lack of a plausible justification for patents on abstract business methods and human behavior, coupled with the anticompetitive consequences of issuing these patents, counsels that this Court continue to restrict patentable subject matter to instantiated products and processes. Modern society's dizzying pace of technological change, with its accompanying changes to marketplace conditions and commercial practices, should by no means lead to an alteration of these established principles.

Nor does this Court's recognition that the patent system should keep apace with unforeseeable fields of scientific or technological discovery, *see Chakrabarty*, 447 U.S. at 315-16, compel a contrary result. Abstract business concepts are not an unforeseeable field, and, in fact, they long predate the patent system. *See, e.g.*, John R. Thomas, *The Patenting of the Liberal Professions*, 40 B.C. L. REV. 1139, 1145-46 (1999). Moreover, by definition, abstract or inchoate business methods are not scientific or technological. *See* Malla Pollack, *The Multiple Unconstitutionality of Business Method*

Patents: Common Sense, Congressional Consideration, and Constitutional History, 28 RUTGERS COMP. & TECH. L.J. 61, 77-78 (2002).

In *State Street*, the Federal Circuit articulated broad-sweeping dicta without making an inquiry into whether the patenting of inchoate methods of doing business raises competitive concerns and whether traditional patent-based incentives were actually needed to spur methods of doing business. "Jefferson saw clearly the difficulty in 'drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.'" *Graham*, 383 U.S. at 9. This Court should return the ambit of patentable subject matter to that range of innovation which truly justifies tolerating the "embarrassment of an exclusive patent."

CONCLUSION

Should the Court decide to address the issues of subject matter eligibility for business methods, for all the foregoing reasons, the Court should hold that patentable subject matter under section 101 is restricted to inventions that involve technological contributions — namely, tangible products or processes that either (i) are tied to a particular machine or apparatus or (ii) cause transformation or reduction of an article to a different state or thing, and in either instance produce technologically beneficial results.

Respectfully submitted,

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December 23, 2005

No. 05-130

IN THE

Supreme Court of the United States

eBAY, INC. and HALF.COM, INC.,

Petitioners,

v.

MERCEXCHANGE, L.L.C.,

Respondent

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF INTERNATIONAL BUSINESS MACHINES CORPORATION AS AMICUS CURIAE IN SUPPORT OF NEITHER PARTY

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BRIEF OF INTERNATIONAL BUSINESS MACHINES CORPORATION AS AMICUS CURIAE IN SUPPORT OF NEITHER PARTY [1]

INTEREST OF AMICUS CURIAE

International Business Machines Corporation (IBM) is a globally recognized leader in the field of information technology research, development, design, manufacturing and related services. IBM has received tens of thousands of United States patents, including more patents than any other corporate assignee for the past thirteen years.[2] Many of IBM's patents are universally recognized as pioneering.

IBM has frequently been involved in patent infringement lawsuits, both as patentee seeking to enforce its patent rights and as accused-infringer defending itself against charges of patent infringement. IBM has thus experienced first-hand the importance of, and the threat posed by, the rights embodied in a United States Letters Patent. IBM therefore believes it can provide a balanced view on important issues implicated by this case — namely, the guidelines governing permanent injunctions in patent cases and, in particular, the application of equitable principles in granting and structuring patent injunctions.

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1. In accordance with Supreme Court Rule 37.6, Amicus states that this brief was authored in its entirety by the counsel listed herein No person or entity other than Amicus listed on the cover made a monetary contribution to the preparation or submission of this brief. A blanket consent to the filing of amicus briefs in support of either party has been filed with the Clerk of the Court by petitioners and respondent

2. The United States Patent and Trademark Office has reported that in 2005 IBM received 2,941 patents, which is over 1,100 more United States patents than any other company. *See* USPTO Releases Annual List of Top 10 Organizations Receiving Most U.S. Patents (Jan. 10, 2006), *available at* http://www.uspto.gov/web/offices/com/speeches/06-03.htm.

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INTRODUCTION AND SUMMARY OF ARGUMENT

In this case, the Federal Circuit repeated what it calls the "general rule" that a permanent injunction will issue in a patent case once infringement is found. The only exception to the "general rule" involves consideration of public interest in the form of public health concerns.

This so-called "general rule" is inconsistent with the patent statute which provides that entitlement to an injunction is not absolute and that principles of equity should be applied in adjudicating a patentee's request for an injunction. 35 U.S.C. § 283 (2005). The history and development of the patent statute confirms that the patentee's "right to exclude" does not require issuance of injunctions in patent cases. Under the original Patent Act of 1790, patentees had the "right to exclude" others from practicing the invention, but only had a remedy of monetary damages. The statutory provision for patent injunctions was not introduced until 1819. Thus, the "right to exclude" alone does not dictate grant of a patent injunction.

The "general rule" is also inconsistent with this Court's analysis of a broad spectrum of equitable considerations in *Continental Paper Bag Co v. Eastern Paper Bag Co.*, 210 U.S. 405, 422-24, 428-29 (1908) — the case specifically mentioned in the grant of certiorari. There, the Court affirmed the injunction and, in effect, addressed each of the four equitable factors traditionally evaluated in deciding whether to grant an injunction.

These considerations apply not only in deciding whether to grant an injunction but also in determining the scope of an injunction if granted. In the 98 years since *Continental Paper Bag*, the patent laws and their interpretation have adapted to changes in technology and business operations, but the Federal Circuit's approach in addressing patent injunctions has become rigid. The intervening century of continuous, multi-dimensional change only serves to reinforce the appropriateness of applying equitable principles to patent injunctions.

It is therefore appropriate to consult the traditional four-factor analysis used in injunctive relief determinations when addressing patent injunctions. Thus, for example, a court should consider whether the patentee has a legitimate economic interest to be protected by injunction in assessing the presence of irreparable harm. When the patentee and the infringer are competitors, such that an injunction will preserve the patentee's position in the marketplace, the patentee's legitimate economic interest will likely weigh in favor of an injunction. However, if the patentee has no substantial business, and no plan to launch a business, other than patent enforcement, that fact may weigh against grant of a broad injunction and perhaps any injunction at all.

Under the patent statute, a patentee must receive full compensation for damages suffered as a result of infringement. The patent damages law is highly developed, ensuring the patentee a full opportunity to prove its damages. Where the patentee is fully compensable in damages, a court could fairly conclude that the patentee has an adequate remedy at law, weighing against a broad injunction, and possibly any injunction.

The balance of hardships is important in determining whether an injunction will have a disproportionate impact on either party. If an injunction would cause the infringer to abandon a significant investment or incur significant additional costs unrelated to technological merits of the invention, that may weigh against a broad injunction. Similarly, where an infringing product contains many thousands of technological elements, an injunction against a minor, infringing element could have a disproportionate impact on the infringer by preventing the marketing of the entire product, an entire product line and/or interrelated products. The balance of hardship analysis is thus particularly relevant to the scope of an injunction.

The public interest broadly encompasses consideration of the potential impact of a patent injunction on the public.

In the case of patent claims covering industry standards, there is a public interest in maintaining the products embodying the standard in the marketplace, which may counsel in favor of denying an injunction or structuring an injunction in such a way that certain products embodying the standard remain available in the marketplace.

Finally, equitable factors traditionally considered with respect to the granting and structuring of injunctions should also be considered when determining whether to stay an injunction pending appeal in a patent case. The impact of an injunction, even if lifted on appeal, may force settlements on terms that are otherwise not justified. The high reversal rate at the Federal Circuit further counsels in favor of stays.

While expressing no view on the merits of the present case, IBM wishes to explain why courts should be encouraged to consider well-accepted principles of equity when granting and structuring patent injunctions.

ARGUMENT

I. THE "GENERAL RULE" CONCERNING PATENT INJUNCTIONS IS NOT FAITHFUL TO THE PATENT STATUTE

In this case, the Federal Circuit reiterated what it termed the "general rule" of granting permanent injunctions in patent cases — namely, "the general rule is that a permanent injunction will issue once infringement and validity have been adjudged."[3] *MercExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323, 1338 (Fed. Cir. 2005). This so-called "general rule," however, is at odds with the patent statute which provides that patent injunctions *may* be granted "in accordance with principles of equity." 35 U.S.C. § 283. The right to exclude others from practicing an

3. What the Federal Circuit describes as its "general rule" has been applied for over twenty years. *See Roche Prods., Inc v. Bolar Pharm. Co., Inc.*, 733 F.2d 858, 866 (Fed. Cir. 1984) (marking the last time the Federal Circuit explicitly recognized that an injunction does not automatically follow a finding of infringement).

invention, as is accorded by the patent grant under 35 U.S.C. § 154, does not command automatic grant of injunctions in patent cases. To the contrary, the history and development of the patent statute make clear that the right to exclude does not automatically result in issuance of an injunction.

Under the original United States Patent Statute, a patent grant gave inventors "the sole and exclusive right and liberty of making, constructing, using and vending" their inventions. Patent Act of 1790, ch. 7, § 1, 1 Stat. 109-12 (Apr. 10, 1790). This Court interpreted that statutory language as conferring "the right to exclude others from making, using or vending his invention." *Crown Die & Tool Co. v. Nye Tool & Mach. Works*, 261 U.S. 24, 35 (1923) (*citing Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 424 (1908)). But, under the original statute, the sole remedy for patent infringement, *i.e.*, violation of the "right to exclude," was an award of the patentee's damages. Patent Act of 1790; *Root v. Lake Shore & Mich. S. Ry. Co.*, 105 U.S. 189, 192 (1882); *Cochrane v. Deener*, 94 U.S. 780, 782 (1877). The original patent statute did not have a provision enabling patent injunctions.

The enabling provision for patent injunctions was introduced into the patent statute some thirty years later, with the Patent Act of 1819, and provided:

> that these courts should have "Original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, should have authority to grant injunctions, *according to the course and principles of courts of equity*."

Cochrane, 94 U.S. at 782 (*quoting* Patent Act of 1819, ch. 19, 3 Stat. 481 (Feb. 15, 1819)) (emphasis added). Before 1819, courts

did not have equity jurisdiction in patent cases. *Root*, 105 U.S. at 191-92. Thus, although this Court interpreted the original patent statute as providing a "right to exclude," before 1819 a patentee could only recover damages; it could not invoke equity jurisdiction to request an injunction.[4]

Since their separate introductions into the patent laws, the statutory provisions relating to the patentee's right to exclude and the remedy of injunctive relief have remained essentially unchanged in the subsequent patent statutes.[5] The current patent statute provides the patentee with the "right to exclude others from making, using or selling the invention throughout the United States." 35 U.S.C. § 154 (2005). The *remedy* of patent injunctions appears in another section — namely, section 283 which provides:

> The several courts having jurisdiction of cases under this title *may* grant injunctions in accordance with the *principles of equity* to prevent

4. Under the original Patent Act of 1790, the federal courts had no jurisdiction in equity to hear patent infringement cases. *Root*, 105 U.S. at 191-92. The courts "had cognizance of actions at law brought to recover damages for the infringement of patents." *Cochrane*, 94 U.S. at 782. The courts, therefore, could not grant injunctive relief in a case whose jurisdictional basis rested solely on the Patent Act. *Root*, 105 U.S. at 191-92; *Cochrane*, 94 U.S. at 782. If, however, there was another basis for federal jurisdiction (*i.e.*, diversity), a court could grant injunctive relief *Root*, 105 U.S. at 191-92; *Cochrane*, 94 U.S. at 782.

5. *See* Patent Act of 1819, ch. 19, 3 Stat. 481 (Feb. 15, 1819); Patent Act of 1836, ch. 357, 5 Stat. 117-25 (July 4, 1836); Patent Act of 1870, ch. 230, 16 Stat. 198-217 (July 8, 1870); Patent Act of 1897, ch. 391, 29 Stat. 692-94 (Mar. 3, 1897); 35 U.S.C. § 1 *et seq.* (1952); *see also* S. REP. No. 1979 (1952), *as reprinted in* 1952 U.S.C.C.A.N. 2394, 2417 ("The wording of the granting clause is changed to 'the right to exclude others from making, using, or selling', following language used by the Supreme Court, to render the meaning clearer.").

> the violation of any right secured by patent, on such terms as the court deems reasonable.

35 U.S.C. § 283 (emphasis added). Under section 283, the remedy of an injunction is not absolute; the statute provides that courts *may* grant injunctions by applying "principles of equity." Separate and apart from injunctive relief, the patentee is in all events entitled to recover damages adequate to compensate for the infringement. 35 U.S.C. § 284 (2005) ("the court *shall* award . . . damages. . . .") (emphasis added).

In sum, the history and development of the patent statute confirms that sections 154 and 283 are separate statutory provisions and that the right to exclude does not by itself confer a basis for granting patent injunctions.

II. THE "GENERAL RULE" CONCERNING PATENT INJUNCTIONS IGNORES THE FULL SCOPE OF EQUITABLE PRINCIPLES ANALYZED IN *CONTINENTAL PAPER BAG*

Under the so-called "general rule" reiterated in the present case, a permanent injunction will issue as a matter of course once there is a judgment of infringement of a valid patent. The only exception is limited to public interest needs, specifically public health concerns:

> "[C]ourts have in rare instances exercised their discretion to deny injunctive relief in order to protect the public interest." . . . Thus, we have stated that a court may decline to enter an injunction when "a patentee's failure to practice the patented invention frustrates an important public need for the invention," such as the need to use an invention to protect public health. . . . [T]he district court did not provide any persuasive reason to believe this case is sufficiently exceptional to justify the denial of a permanent injunction.

eBay, 401 F.3d at 1338-39 (citations omitted).

The failure to fully examine equitable considerations under this "general rule" stands in marked contrast with the scope of equitable considerations analyzed by this Court in *Continental Paper Bag*, 210 U.S. at 422-24, 428-29.

Although the *Continental Paper Bag* opinion did not explicitly enumerate the four factors commonly articulated in making injunction determinations,[6] the Court's analysis shows it did consider each of those four factors in affirming the patent injunction. For example, the Court considered the irreparable injury factor, noting that "[the] inventor could have kept his discovery to himself," "the monopoly he receives is only for a few years" and "even if the [patentee's] old machines could have been altered [in order to practice the patented approach], the expense would have been considerable." 210 U.S. at 424, 429. The Court also considered the adequacy of legal remedies, noting that "the [patentee's] remedy at law remains." 210 U.S. at 423. With respect to the public interest, the Court considered whether the "conduct of the patentee [contravened] the supposed public policy of the law" and the effect of an injunction on "diminished supply or [] an increase in prices." 210 U.S. at 422-24, 429. Finally, considering the balance of hardships, the Court noted: "the defendant's machine has been an assured commercial success for some years" and that the patentee "had for its motive the saving of the [considerable] expense that would have been involved by changing the equipment of a factory from one set of machines to another." 210 U.S. at 428-29.

In contrast to the robust equitable analysis performed in *Continental Paper Bag*, the so-called "general rule" followed

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6. The well-accepted equitable factors applied to injunction requests are: (1) irreparable injury to the plaintiff, (2) inadequacy of legal remedies, (3) any adverse effects on the public interest and (4) the balance of hardships to the parties. *Weinberger v Romero-Barcelo*, 456 U.S. 305, 312 (1982).

by the Federal Circuit ignores three of the four equitable principles applied in injunction determinations and considers a narrow range within the fourth equitable factor — only whether there is a public health concern.

Consistent with the patent statute and *Continental Paper Bag*, this Court should reaffirm that principles of equity must be fully considered by the district courts in deciding upon and fashioning patent injunctions.

III. DEVELOPMENTS IN TECHNOLOGY AND BUSINESS OPERATIONS REINFORCE THE WISDOM OF THE STATUTORY REQUIREMENT FOR APPLYING EQUITABLE PRINCIPLES WHEN CONSIDERING PATENT INJUNCTIONS

Aside from ignoring the statutory mandate and this Court's precedent, wooden application of the "general rule" of near-automatic patent injunctions divests district courts of their inherent discretion to apply principles of equity that may otherwise result in denial of a patent injunction in appropriate cases. It also prevents courts from considering factors that would aid in structuring or scoping an injunction, inevitably leading to overly broad patent injunctions. *See, e.g.*, *Metabolite Labs., Inc. v. Lab. Corp. of Am.*, 370 F.3d 1354, 1371-72 (Fed. Cir. 2004) (patent claim limited to homocysteine testing and correlating elevated homocysteine levels with a vitamin B deficiency, infringer enjoined from all homocysteine testing), *cert. granted*, 126 S. Ct. 601 (2005).

Patent laws exist to promote the progress of technology. U.S. CONST. art. I, § 8, cl. 8; *Pfaff v. Wells Elec., Inc.*, 525 U.S. 55, 63 (1998) (patent system "encourages both the creation and the public disclosure of new and useful advances in technology"). During the 98 years since *Continental Paper Bag*, technology has developed at a remarkable rate, literally transforming the way businesses operate. The substantive patent laws have, over this time, been amended and

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interpreted to keep pace with these advances in technology and business operations. As for injunctive relief, despite the statutory requirement to apply principles of equity, courts have instead enforced a rigid rule leading to nearly automatic, broadly-framed injunctions in all cases. This approach is counter-intuitive because the principles of equity provide the very flexibility that is needed to achieve just results in the face of change. Applicability of equitable principles to patent injunctions remains at least as important today as it was when *Continental Paper Bag* was decided.

A. Except For The Remedy Of Injunctions, The Patent Laws Have Adapted To Changes In Technology And Business Operations

The substantive patent laws have adapted to accommodate the dramatic changes in technology since *Continental Paper Bag*. For example, the scope of patentable subject matter has expanded and evolved both by statute and by court interpretation to keep pace with new discoveries. *See, e.g* , 35 U.S.C. § 161 (1954) (plant patents); 35 U.S.C. § 105 (1990) (inventions in outer space); *Diamond v. Chakrabarty*, 447 U.S. 303, 310 (1980) (patentability of new life form); *Diamond v. Diehr*, 450 U.S. 175, 191-92 (1981) (patentability of computer software). Complementary new laws and rules relating to patent infringement and validity have been enacted. *See, e.g.*, 35 U.S.C. § 271(e) (1988) (infringement of biotechnology inventions); 35 U.S.C. § 103(b) (1995) (validity of biotechnology inventions); 37 C.F.R. § 1.801 (1989) (biotechnology invention disclosures).

Business operations have changed dramatically in parallel with technological advances (*see infra* at pp. 11-15), and the manner in which innovation has occurred has changed as well. Modern innovation often involves collaborative efforts among otherwise independent entities, across national boundaries. The patent laws and their interpretations have adapted to accommodate these changes, with enactment of

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provisions covering foreign manufacturing and collaborative invention. 35 U.S.C. § 271(f) (1984) (supply of components of a patented invention from the United States for assembly abroad); 35 U.S.C. § 271(g) (1988) (process inventions performed abroad); 35 U.S.C. § 103(c) (1984 & 2004) (collaboration under joint research agreements).[7]

While the patent laws and their interpretation have responded flexibly to changes in technology, business and commerce, the Federal Circuit's approach to patent injunctions has become rigid. Equitable considerations have been supplanted by the so-called "general rule" of routinely granting patent injunctions, absent exceptional public health concerns. Consideration of the full complement of equitable principles when fashioning patent injunctions will restore flexibility to the process and allow that process to keep pace with evolving technologies and businesses.

B. The "General Rule" Ignores Modern Business Inter-dependency Whereby The Impact Of Patent Injunctions Extends Far Beyond Litigants

Technological developments of the last two decades have allowed and indeed forced separate business entities to become interoperable — they now can, must and do interact seamlessly across many points of contact as a means to remain competitive in the face of relentless global pressure.

7. Whether or not one agrees with the ultimate results, these laws are being interpreted to respond to the dynamic technological and business environments. *See, e.g., NTP, Inc. v Research in Motion, Ltd*, 418 F.3d 1282, 1322-23 (Fed. Cir. 2005) (whether a United States patent applies to a wireless email system including operations occurring abroad under Section 271(f)), *cert. denied*, ___ U.S. ___ (2006); *Eolas Techs Inc. v. Microsoft Corp*, 399 F.3d 1325, 1338-41 (Fed. Cir. 2005) (whether software is a component of a patented product within the meaning of section 271(f)); *AT&T Corp v. Microsoft Corp.*, 414 F.3d 1366, 1371 (Fed Cir. 2005) ("whether software is sent abroad via electronic transmission or shipped abroad on a 'golden master' disk is a distinction without a difference for the purposes of § 271(f) liability").

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See National Innovation Initiative, *Innovate America, National Innovation Initiative Report*, at 45 (Council on Competitiveness 2004), *available at* http://www.publicforum institute.org/nde/sources/NII_Final_Report.pdf [hereinafter "NII"] ("However, manufacturing no longer takes place in a single enterprise or location. Increasingly, the successful 21st century manufacturer is more of a system integrator, managing a supply chain or a virtual network of business process suppliers not controlled by the manufacturer itself."). This interoperability allows a business to rely on others to perform many functions that were previously managed within a single, vertically-integrated company. Thus, a business can focus on those operations that make it most competitive. *See* THOMAS L. FRIEDMAN, THE WORLD IS FLAT: A BRIEF HISTORY OF THE TWENTY-FIRST CENTURY, pp. 414 *et seq.* (Farrar, Straus & Giroux 2005) [hereinafter FRIEDMAN] (Dell realizes a competitive advantage from strategically outsourcing many aspects of its computer production).[8] As a result, the market is now characterized by networks of inter-dependent companies. *See* NII, at 45.

While these inter-dependent businesses are individually more efficient, they must rely on each other to an unprecedented level. As a result, an injunction against one company will likely have a substantial "ripple effect" through other inter-dependent businesses whether or not they infringe. Federal courts have considered this "ripple effect" in determining whether to grant a preliminary patent injunction. *See Litton Sys., Inc. v. Sundstrand Corp.*, 750 F.2d 952, 953-55 (Fed. Cir. 1984) (affirming denial of preliminary injunction that would prevent defendant from servicing

8. *See* ERIC VON HIPPEL, DEMOCRATIZING INNOVATION 163-64 (The MIT Press 2005) (advancements in tools allow businesses to design products independent of the manufacturing process). These advances have enabled the emergence of new business models, such as firms that design, but do not fabricate, semiconductor chips ("fabless semiconductor firms"). *See* http://www fsa.org/association/milestones.asp (last visited Jan. 26, 2006) (as of 2004, the Fabless Semiconductor Association (FSA) had 450 members).

potential and existing customers and communicating with suppliers); *Archive Corp v. Cipher Data Prods., Inc.*, 12 USPQ2d 1464, 1469 (C.D. Cal. 1988) (denying preliminary injunction that would leave third-party computer manufacturers without a source of supply, resulting in large financial losses). This Court recognized a potential "ripple effect" in *Continental Paper Bag*. 210 U.S. at 422-24, 429 (addressing effects of an injunction on "diminished supply or [] an increase in prices"). While the prospect of an injunction against one party affecting others is not new, the modern business and technology landscape makes it far more pronounced.[9]

The most fundamental technological developments enabling interoperability of businesses and their products have the advantages of being uniform, low-cost, widely adopted, geographically independent and available from many sources.[10] These advantages allow companies to maximize access to business partners without the expense of developing company-specific skills or tools.[11] In addition, these advantages make a company's products more attractive to customers by maximizing compatibility with complementary products.[12] To maximize access to business partners and achieve optimal product compatibility, companies collaborate to develop and adopt

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9. *See* ERIC MARKS & MARK WERRELL, EXECUTIVE'S GUIDE TO WEB SERVICES 181-82 (Wiley & Sons 2003) (describing seven categories of software and hardware vendors providing nine tools and applications residing in ten layers of system architecture, where multiple vendors control "critical elements of a web services value chain").

10. *See* ASTM Handbook of Standardization, *available at* http://www.astm.org/NEWS/handbook02/images/Handbook02.pdf (last visited Jan. 26, 2006) (American Society for Testing and Materials).

11. *See* FRIEDMAN, at 352-56.

12. *See* ASTM Handbook of Standardization.

industry standards.[13] Thus, our economy is characterized by networks of inter-dependent companies relying on such standards to work together and ensure product compatibility.

Broad reliance on a standard makes not only those implementing the standard vulnerable to a patent injunction but may also significantly affect other companies doing business with them.[14] The significant cumulative investment associated with broad adoption of a standard makes even the threat of an injunction against its practice particularly acute.[15] So profound is the impact of a patent injunction against the practice of a broadly-adopted standard that the mere possibility of patent coverage has led to the abandonment of some standards development efforts. *See* Anick Jesdanun, *Patent Spat Kills Anti-Spam Plan*,

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13. For example, each year in its Annual Book of ASTM Standards, ASTM International publishes more than 12,000 standards related to metals, paints, plastics, textiles, petroleum, construction, energy, the environment, consumer products, medical services and devices, electronics and many other areas. These standards and related information are broadly used worldwide as the basis for purchasing and other contracts, codes, laws and regulations. *ASTM International, 2004 ASTM International Annual Report, Focus 2004*, at 16 (2004), *available at* http://www.astm.org/NEWS/2004AnnualReport.pdf. *See* World Wide Web Consortium ("W3C"), *at* http://www.w3c.org (last visited Jan. 26, 2006) ("The World Wide Web Consortium (W3C) is an international consortium where Member organizations, a full-time staff, and the public work together to develop Web standards ")

14 Reliance on a standard is intensified when a standard is adopted by the government, or by formal industry mandate, *see, e.g.*, Institute of Electrical and Electronic Engineers, IEEE 802.11 (standard for wireless communications), *at* http://grouper.ieee.org/groups/802/11 (last visited Jan. 26, 2006), or informal industry mandate, *see, e.g., eBay*, 401 F.3d at 1325 (fixed-price purchasing feature allowing customers to purchase items for fixed, listed price).

15. *See* CARL SHAPIRO & HAL R. VARIAN, INFORMATION RULES 11-13 (Harvard Business School Press 1999) ("once you have chosen a technology . . . switching can be very expensive").

CBS NEWS, Sept. 28, 2004, *at* http://www.cbsnews.com/stories/2004/09/28/tech/main645915.shtml.

Application of the well-accepted equitable factors will enable courts to evaluate not only the circumstances pertaining to patentees but also those affecting the inter-dependent enterprises that could be affected by an injunction when addressing patent injunctions. As we describe hereafter, application of equitable principles will restore needed flexibility to the determination of injunctive relief in a highly inter-dependent economy.

IV. THE UNIQUE NATURE OF PATENT CASES WARRANTS CONSIDERATION OF EQUITABLE PRINCIPLES IN GRANTING AND STRUCTURING INJUNCTIONS

This Court has identified four factors relevant to injunctive relief inquiries — irreparable injury to the plaintiff, inadequacy of legal remedies, adverse effects on the public interest and the balance of hardships to the parties. *Weinberger*, 456 U.S. at 312. In a patent case, those factors can be summarized as the effects a patent injunction may have on the patentee, on the infringer and on the public.

The focus of any equitable analysis is "to do equity." *Hecht Co. v. Bowles*, 321 U.S. 321, 329 (1944). The command to do equity is especially relevant to injunctions where the court must consider not only whether to grant or deny an injunction but also how to structure the injunction properly. *Hecht*, 321 U.S. at 329 ("The essence of equity jurisdiction has been the power of the Chancellor to do equity and to mould each decree to the necessities of the particular case. Flexibility rather than rigidity has distinguished it."); *Friends of the Earth, Inc. v. Laidlaw Envtl. Servs., Inc.*, 528 U.S. 167, 193 (2000) ("federal courts should aim to ensure 'the framing of relief no broader than required by the precise facts.'").

Consistent with the command to do equity and within the purview of the traditional equitable principles, there are a variety of circumstances specific to patent cases, meriting consideration in granting and structuring injunctive relief.

A. Consideration Of Irreparable Injury To The Patentee Focuses On The Conduct And Needs Of The Patentee

The so-called "general rule" presumes irreparable harm to the patentee, and thus fails to apply the equitable principles required by the patent statute. When properly analyzed, the patentee's conduct and needs may tend to show lack of irreparable harm and may weigh against granting an injunction or, if granted, may warrant appropriate moderation of the injunction.

For example, a court should consider whether the patentee has a legitimate economic interest in seeking an injunction. Where a patentee is practicing the invention, the ability to exclude its competitors remains the ultimate statement of respect for the exclusive nature of the patent grant. In such instances, a complete examination of the well-accepted equitable principles will undoubtedly result in a broad injunction in favor of the patent holder. However, if a legitimate economic interest in an injunction cannot be shown beyond the motivation to maximize negotiating leverage in settlement negotiations, this may be a factor weighing against granting an injunction or in favor of limiting its scope.

In *Continental Paper Bag*, this Court did, in fact, consider the patentee's legitimate economic interests in relation to the patent injunction. 210 U.S. at 429. There, a dissenting judge on the court of appeals (Judge Aldrich) would have denied an injunction if the patent was "deliberately held in nonuse for a wrongful purpose." 210 U.S. at 428. In analyzing the pertinent equities, this Court looked beyond simple nonuse of the patent, and examined

whether or not the underlying reason for the nonuse was reasonable:

> [C]an it be said, as a matter of law, that a nonuse was unreasonable which had for its motive the saving of the [considerable] expense that would have been involved by changing the equipment of a factory from one set of machines to another?

210 U.S. at 429. In contrast, the Federal Circuit in *eBay* held that the circumstances of MercExchange's nonuse were irrelevant to the grant of an injunction:

> If the injunction gives the patentee additional leverage in licensing, that is a natural consequence of the right to exclude and not an inappropriate reward to a party that does not intend to compete in the marketplace with potential infringers.

eBay, 401 F.3d at 1339; *cf. Foster v. Am. Mach. & Foundry Co.*, 492 F.2d 1317, 1324 (2d Cir. 1974) ("An injunction to protect a patent against infringement, like any other injunction, is an equitable remedy to be determined by the circumstances. It is not intended as a club to be wielded by a patentee to enhance his negotiating stance.") (citations omitted).

Another indicia of legitimate economic interest is whether the patentee and infringer are competitors in the marketplace. *See Continental Paper Bag*, 210 U.S. at 428-29. Competition between the patentee and the infringer in the market for the patented product may indicate a need on the part of the patentee to protect the market for its product and consequently irreparable injury if that market is not protected by an injunction. The patentee's need to prevent dilution of its market for a non-patented product may also constitute a legitimate economic interest weighing in favor of granting an injunction. *See Continental Paper Bag*, 210 U.S. at 428-29. On the other hand, a lack of legitimate

economic interest in seeking an injunction may be evidenced by the patentee's lack of a substantial business, or absence of a plan to launch a business, other than patent enforcement.

Another pertinent factor is the patentee's delay in bringing suit, which may indicate a willingness to tolerate the market effects of infringement or allow an infringer as well as similarly-situated members of the public to become committed to an infringing course of conduct. This may weigh against a finding of irreparable injury. *See High Tech Med. Instrumentation, Inc. v. New Image Indus., Inc.*, 49 F.3d 1551, 1557 (Fed. Cir. 1995) (delay in seeking preliminary injunctive relief showing lack of irreparable injury).

The patentee's practices in the prosecution and management of its patent portfolio may also be relevant to the harm inquiry. For example, where the patentee engaged in continuation practice, *see* 35 U.S.C. § 120, filing the patent claim in suit after the defendant's infringing activities became public, it should be determined whether the claim was obtained to protect a product of the patentee or simply to strengthen its negotiating position with the infringer. The latter finding may suggest a lack of irreparable harm.

The patentee's grant of exclusive licenses to third parties may weigh in favor of a finding of irreparable harm. But, the patentee's grant of nonexclusive licenses to third parties or offering of a license to the infringer prior to commencing suit may weigh against such a finding. *See T.J. Smith & Nephew Ltd. v. Consolidated Med. Equip., Inc.*, 821 F.2d 646, 647-48 (Fed. Cir. 1987) (preliminary injunction denied in part because of prior licenses to third parties).

These same types of considerations should motivate an appropriate crafting of an injunction. For example, if the patentee and infringer do business in generally separate markets but compete in a specific product market, the injunction may be structured only to exclude the infringer from that market where they compete. Moreover, if the

patentee has only granted non-exclusive licenses in a particular field of use, reserving other fields for itself, an injunction may be structured to exclude the infringer from the fields reserved by the patentee.

B. The Adequacy Of The Patentee's Legal Remedies Includes Consideration Of Patentee's Damages

The adequacy of the patentee's legal remedies is closely related to the inquiry of irreparable injury. Where the patentee is fully compensable at law (*i.e.*, in money damages), it can be said there is no irreparable injury. *SmithKline Beecham Corp. v. Apotex Corp.*, 247 F. Supp. 2d 1011, 1045 (N.D. Ill. 2003) (Posner, J., sitting by designation) ("The grant of an injunction in the circumstances disclosed by the evidence in this [patent infringement] case would be a *travesty of equity*. An injunction is a substitute for an award of damages in situations in which damages are difficult to calculate or are otherwise inadequate as a remedy for the wrong done by the defendant to the plaintiff.") (emphasis added), *aff'd in part*, 403 F.3d 1313 (Fed. Cir. 2005).

By statute, the patentee must receive full compensation for damages it suffered as a result of infringement. 35 U.S.C. § 284; *Gen. Motors Corp. v. Devex Corp.*, 461 U.S. 648, 654-55 (1983) (in enacting section 284, "Congress sought to ensure that the patent owner would in fact receive full compensation for 'any damages' he suffered as a result of the infringement."). The Federal Circuit and the district courts have constructed a highly-developed body of damages law ensuring a patentee the full opportunity to establish its damages. A patentee can prove damages as lost profits, where the patentee and infringer are competitors. *See State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1577-80 (Fed. Cir. 1989). As part of a lost profits analysis, the patentee can rely on theories of market share liability, price erosion and convoyed sales to demonstrate the full scope of its damages. *See BIC Leisure Prods., Inc. v. Windsurfing Int'l, Inc.*, 1 F.3d

1214, 1219 (Fed. Cir. 1993) (market share liability); *Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369, 1378 (Fed. Cir. 2003) (price erosion); *Interactive Pictures, Corp. v. Infinite Pictures Inc.*, 274 F.3d 1371, 1385-86 (Fed. Cir. 2001) (convoyed sales). A patentee can also prove its damages as a "reasonable royalty." 35 U.S.C. § 284. *See Rite-Hite Corp. v. Kelley Co., Inc.*, 56 F.3d 1538, 1554-55 (Fed. Cir. 1995) (computation of reasonable royalty). The patentee can recover lost profits or a "reasonable royalty" based on "'the value of an entire apparatus containing several features, even though only one feature is patented.' . . . when the patented feature is the basis for customer demand." *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1552 (Fed. Cir. 1997) ("entire market value rule") (citation omitted). A patentee is also entitled to pre- and post-judgment interest to ensure full compensation. *Transmatic Inc. v. Gulton Indus. Inc.*, 180 F.3d 1343, 1347-49 (Fed. Cir. 1999) (pre- and post-judgment interest).

Evidence that the patentee's damages can be readily ascertained — whether a "reasonable royalty" or lost profits — may show that the patentee has an adequate legal remedy. For example, the patentee's grant of licenses to third parties or offering of a license to the infringer prior to commencing suit tend to show its damages can be fully ascertained by a reasonable royalty. *See, e.g., Riles v. Shell Exploration & Prod. Co.*, 298 F.3d 1302, 1312-13 (Fed. Cir. 2002) ("patentee's prior license agreements 'should carry considerable weight in calculating a reasonable royalty rate.'"). Likewise, the patentee's profit margins and lost sales to the infringer may constitute evidence of the patentee's damages calculated as lost profits. *See, e.g., King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 863-64 (Fed. Cir. 1985).

There are many well-defined and comprehensive damages theories upon which courts can draw to frame adequate relief for past and/or continuing infringement of a patent as part of the equitable analysis for determining whether to grant a broad patent injunction.

C. The Public Interest Encompasses Consideration Of The Overall Impact On The Public

The third well-accepted factor considered in granting injunctions, the public interest, allows courts to consider the effect of an injunction beyond the parties. *See United States v. Oakland Cannabis Buyers' Coop.*, 532 U.S. 483, 496 (2001) ("For 'several hundred years,' courts of equity have enjoyed 'sound discretion' to consider the 'necessities of the public interest' when fashioning injunctive relief."). However, consideration of the public interest encompasses more than those public health concerns which have characterized the Federal Circuit's limited analysis under its "general rule" over the past twenty years. *See supra* at p. 7.

Courts should be empowered and encouraged to consider whether the economic impact on the public weighs against granting a broad injunction. For example, as already explained *supra* at pp. 13-14, the Twentieth Century has seen the proliferation of industry standards which allow for significant efficiencies in the marketplace by enabling interoperability of many products and components. A patent may cover an industry standard so that, once the standard has been adopted and incorporated into a variety of interrelated products of various manufacturers, changing to a non-infringing design is essentially impossible. If businesses are forced to abandon a standard because of a threatened injunction, the impact on the public can be dramatic. *See* Paul Festa, *Eolas Suit May Spark HTML Changes*, CNET NEWS.COM, Sept. 19, 2003, *at* http://news.com.com/2100-1023-5079580.html.

Given the trend of increasing numbers of patent suits based on the practice of standards, an impact on the public may be expected to follow.[16] The impact of an injunction on

16. *See, e.g., Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263, 1266-67 (Fed. Cir. 2004) (Dynacore asserted patent (Cont'd)

implementation of a standard is felt broadly by companies practicing the standard as well as their suppliers and customers. *See supra* at pp. 12-14. Likewise, the practical effect of an injunction against one of many inter-dependent companies is ultimately borne by the public. *See supra* at pp. 12-13.

When pervasive impact on the public is likely to result from imposition of a broad injunction affecting an industry standard, a court should be empowered and encouraged to fashion an injunction to preserve implementation of the standard, such as by enjoining only those infringements that do not comply with the standard. *See Cook Inc. v. Boston Scientific Corp.*, 333 F.3d 737, 744 (7th Cir. 2003) (Posner, J.) ("in determining the appropriate scope of [a contract] injunction the judge must give due weight to the injunction's possible effect on innocent third parties."). A patent may include one claim which constitutes a "necessary claim" — namely, a patent claim which cannot be avoided when implementing the standard — and other claims which are not "necessary claims", but cover useful adaptations or improvements. In that situation, a court could deny an injunction as to the "necessary claim", while granting it as to the other claims.

In some cases, the patent may cover a product that is well-established in the marketplace. A court should exercise discretion in such cases in view of the public interest in maintaining the product's availability. It may be appropriate in such cases to consider structuring the injunction to enjoin only new generations of the infringing product. Moreover,

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(Cont'd)
against devices conforming to IEEE Standard 1394 for "High Performance Serial Bus"); Complaint, QUALCOMM Inc. v. Nokia Corp., No. 05-CV-2063 (S.D. Cal., Nov. 4, 2005) (QUALCOMM sued Nokia for infringement of eleven patents directed to GSM, GPRS and EDGE cellular standards and sought an injunction against Nokia's continuing sales of accused products).

the equities associated with such well-established products may be more compelling if the patentee does not produce its own products that will satisfy market demand in the absence of the enjoined product.[17]

D. The Balance Of Hardships To The Parties Includes Consideration Of Their Respective Business Models And Commercial Needs

The fourth equitable factor — the balance of hardships to the parties — enables courts to evaluate whether an injunction would have a disproportionate impact on either party. *See Harrisonville v. W.S. Dickey Clay Mfg. Co.*, 289 U.S. 334, 338 (1933) ("Where substantial redress can be afforded by the payment of money and issuance of an injunction would subject the defendant to grossly disproportionate hardship, equitable relief may be denied although the nuisance is indisputable.").

A disproportionate hardship may often be determined by considering the patentee's and infringer's legitimate economic interests in terms of their respective business models and commercial needs. *See supra* at p. 16. In certain cases, an injunction may result in a windfall for the patentee, out of balance with the economic contribution of the patented invention. For example, to comply with a broadly-drawn injunction, the infringer may have to abandon significant investment or incur significant additional costs by retooling a manufacturing plant that was designed before the patent issued, canceling purchase orders for raw materials destined for use in manufacturing infringing products, destroying existing products in inventory, remanufacturing previously sold products or recalling products for their eventual destruction or remanufacture. These transactional costs may have little or nothing to do with the merits of the patented invention or the infringement of the patent.

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17. *See* Kurt M. Saunders, *Patent Nonuse and the Role of Public Interest as a Deterrent to Technology Suppression*, 15 HARV. J.L. & TECH. 389, 392 (2002).

Similarly, the original decision of the infringer may have been made without knowledge that it would result in patent infringement, or without ascribing any particular advantage to the later-found infringing approach. Nevertheless, years later, with money, resources and facilities inalterably committed, an unforeseen injunction may not be an equitable solution. *Cf. Continental Paper Bag*, 210 U.S. at 428-29 (considering cost involved in "changing the equipment of a factory from one set of machines to another", albeit to patentee, as a factor in equitable analysis).

Judge Posner has recognized that in these types of circumstances, the balance of hardships should be considered in denying an injunction:

> We have several times seen property rights distinguished from other sorts of legal interest in terms of remedies, and the point has now to be generalized: In conflicting-use situations in which transaction costs are high, the allocation of resources to their most valuable uses is facilitated by denying owners of property injunctive remedy against invasions of their rights instead limiting them to a remedy of damages . . . .

RICHARD A. POSNER, ECONOMIC ANALYSIS OF LAW 77 (Aspen Law & Business, 5th ed. 1998). In situations involving high transaction costs such as those described above, an injunction should be denied or appropriately tailored to avoid a "hold-up" of the infringer and resulting windfall to the patentee. *Id.* at 81 (discussing *Boomer v. Atl. Cement Co.*, 26 N.Y.2d 219, 257 N.E.2d 870 (1970), where closing cement plant would cost $45 million and cost of nuisance to plaintiffs was only $185,000, denying injunction was appropriate because plaintiffs could be adequately compensated with damages: "The cost to the plaintiffs of the nuisance was only $185,000. So *any* price for dissolving the injunction between $185,000 and $45 million would have made both sides better than if

the injunction were enforced. That is an *enormous* bargaining range. . . ."); *Walgreen Co. v. Sara Creek Prop. Co.*, 966 F.2d 273, 276-78 (7th Cir. 1992) (Posner, J.) (same).

Where an enjoined product contains many thousands of technological elements, as is often the case in the information technology industry, an injunction against a single element can prevent the marketing of a much larger product, an entire product line and/or interrelated products. This problem is exacerbated by product inter-dependence and adoption of industry standards, *see supra* at pp. 13-14, resulting in a disproportionate impact on the infringer by imposing a penalty that is far out of balance with the economic value of the infringing element. In contrast, the patentee will receive a windfall in that the effect of the injunction is far greater than the value of the patented invention.

Certain acts by the patentee may show undue hardship on the infringer. For example, if the patentee engaged in continuation practice, *see* 35 U.S.C. § 120, simply to strengthen its negotiating position with the infringer, that may indicate disproportionate hardship on the infringer. *See supra* at p. 18. On the other hand, certain acts by the infringer may show lack of hardship, weighing in favor of a broad injunction to ensure preservation of the patentee's rights. For example, where the infringer has notice of the patent before commencing infringement, slavishly copies the patented invention or does not undertake a good faith effort to evaluate the issues of patent infringement or validity after being made aware of the patent, the infringer may not be able to establish a hardship. *See Monsanto Co. v. Scruggs*, 249 F. Supp. 2d 746, 759 (N.D. Miss. 2001) (preliminary injunction granted where defendants used patented technology with full knowledge and disregard of existence of plaintiff's patent rights).

E. Balancing Of Equitable Principles Will Ensure Flexibility In Considering Stays Of Patent Injunctions Pending Appeal

The equitable factors traditionally considered when granting and structuring injunctions should also be considered in determining whether to stay an injunction pending appeal in a patent case. *See Standard Havens Prods., Inc. v. Gencor Indus., Inc.* 897 F.2d 511, 512 (Fed. Cir. 1990); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Corp.*, 835 F.2d 277, 278 (Fed. Cir. 1987). For example, the economic harm resulting from enforcing an injunction pending appeal has been recognized:

> [T]he defendants [] had a large amount of money invested in boring machines constructed mainly under other patents but containing nevertheless the invention of the patent in suit. These machines were, and are, in various stages of completion. Their "construction, use or sale" is now enjoined, and, in consequence, they stand idle in the plant of the defendants awaiting the outcome of this appeal.
>
> * * *
>
> Not overlooking the complainant's rights in the monopoly which the law has given him, it should be observed that he is not manufacturing under this patent nor, so far as we have been informed, has he any licenses outstanding. In other words, he is not a competitor of the defendants, nor are the defendants competitors of his, in the manufacture of boring machines. Therefore it would seem that enforcement of the injunction would cause much greater injury to the defendants than benefit to the complainant.

Landis Tool Co. v. Ingle, 286 F. 5, 6-7 (3d Cir. 1923) (citations omitted). The threat of an injunction — even one that only lasts between the initial judgment of the district court and

final judgment subsequent to appeal — is sufficiently destructive to cause many infringers to undertake settlements that are not otherwise economically justified simply to avoid the costs associated with an interruption in business.

Considerations in addition to those set forth above, but still within the purview of the traditional equitable principles, may also bear on the determination of whether to stay an injunction pending appeal. For example, the validity of the asserted patent may be in question through reexamination, *see* 35 U.S.C. §§ 302-05,[18] or through a parallel proceeding in another district court. Also, the patentee may not be irreparably harmed until a particular event occurs, for example, until the patentee actually begins manufacturing the patented article. *See, e.g., Landis Tool*, 286 F. at 7; *Moxness Prods., Inc. v. Xomed, Inc.*, Civ. No. 86-100-CIV-J-14, 1988 U.S. Dist. LEXIS 16060, at *10-11 (M.D. Fla., May 10, 1988) (preliminary injunction denied, patentee not harmed because not currently practicing invention).

Denial of a stay pending appeal may serve little purpose where the infringer is a solvent commercial entity and the patentee has no compelling need for an immediate injunction. *See Barnard v. Gibson*, 48 U.S. (7 How.) 650, 658 (1849) ("unless the defendants below are in doubtful circumstances, and cannot give bond to respond in damages for the use of the machines, should the right of the plaintiff be finally established, we suppose that the injunction will be suspended. Such is a correct course of practice. . . .").

Finally, the high reversal rate of district court decisions by the Federal Circuit further counsels in favor of staying injunctions pending appeal. "The reversal rate (rate at which

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18. In 74% of reexamination proceedings filed from 1981-2003, the claims were either changed, *i.e.*, narrowed, or cancelled. *See* Paul Morgan & Bruce Stoner, *Reexamination vs. Litigation — Making Intelligent Decisions in Challenging Patent Validity*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 441, 460-63 (2004).

the Federal Circuit determined the claim construction was wrong) for appealed claim terms from 1996, after *Markman* was decided, through 2003 is 34.5%." Kimberly A. Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 9 LEWIS & CLARK L. REV. 231, 233, 239 (2005). More specifically, the Federal Circuit claim construction reversal rate in cases where the patentee won at the district court is 32.3%. *See id.* at 241. Claim construction is crucial to the ultimate determination of infringement and validity. Granting a stay of an injunction is warranted given the significant chance the infringer will prevail on appeal. A stay can easily be lifted post-appeal, yet the negative impact on the accused infringer of an ultimately inappropriate injunction may never be overcome.

CONCLUSION

For the foregoing reasons, IBM respectfully requests that this Court reaffirm its precedent in *Continental Paper Bag* that the granting and structuring of injunctions in patent cases requires consideration of the well-accepted equitable factors, in accordance with 35 U.S.C. § 283.

Respectfully submitted,

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Chairman LEAHY. Thank you very much. My mother's parents also emigrated to Vermont from Italy.

Judge Martin, the courts are—and they were set up this way by the founders of the country—they are the one undemocratic part of our government. So they have a special responsibility to Americans who have the least power and greatest need for protection.

Judges are protected in their own decisions by lifetime appointments. You certainly understand that, after 9 years on the Federal bench. But I also think there is a need to show sensitivity to people of different backgrounds, to show equal justice, whether you are coming before a court, whether you are rich, poor or no matter what your political background, no matter whether you are plaintiff or defendant, to show that they are going to be treated the same.

Can you describe any situation, either as a lawyer or as a judge, in which you have taken difficult positions on behalf of comparatively poor or powerless individuals or members of racial minorities against a large corporation or the government?

Ms. MARTIN. The first thing that comes to mind is criminal sentencing. That is probably the toughest day for any district judge. It is the worst day in the criminal defendant's life, but it is also the worst day in his or her family's life.

So that is a time when I think it is important really to the rehabilitative process for me to treat the criminal defendant, as well as his or her family, with respect.

In civil cases, a very large part of our docket in the Eleventh Circuit are employment discrimination cases. So I have had some exposure to providing trials to people claiming race discrimination. Again, I think it is my role to treat the parties and their counsel with respect and provide them with access to the courts.

Chairman LEAHY. Let me talk about a case, a recent Eleventh Circuit case I was reading about in Legal Times, *Williams* v. *Mohawk Industries*. That is a case where hourly wage employees brought a racketeering class action against the employer, Georgia Carpet, a flooring manufacturer.

They said that the manufacturer had violated Federal law for years by hiring illegal aliens to keep wages low. The district court denied class certification to the employees, and, normally, the Eleventh Circuit, as in most circuits, the circuit would accept what the district court had done in denying class certification.

In this case, somewhat rare, they reversed it. They remanded the decision to the lower court. Now, obviously, as a district court judge, I know you accept what the circuit has done, but how do you handle those kinds of decisions on class certifications? Is there any rule of thumb or is each one different? How do you handle those?

Ms. MARTIN. Each one is different, of course. I see a lot of securities class action cases. In those instances, every single member of the class really does have the same claim. So the class certification process for those cases is a little bit different than the one that Judge Murphy faced in the *Mohawk Industries* case.

I have read the case and the primary impression it made on me at the time was that great judges really do get reversed sometimes, because Harold Murphy is probably the most beloved judge in the Northern District of Georgia.

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I think it went up three different times, maybe. So beyond that, I am not familiar with the details of the case.

Chairman LEAHY. But how do you handle the issue? You have one come before you on a motion for class certification. Do you treat each one differently or do you have a matrix that applies?

Ms. MARTIN. Well, I have Rule 23. So I go through the Rule 23(a) factors and, as I said, with securities class action cases, that is fairly straightforward; then the 23(b) factors, which I think is where the Eleventh Circuit disagreed with what Judge Murphy had done, if I understand the decision correctly.

But I approach each one differently, but follow Rule 23. Of course, those decisions go up on an interlocutory appeal whether you certify the class or not.

Chairman LEAHY. But you certainly understand the precedent that a court of appeals may overrule.

Ms. MARTIN. I understand it very well.

Chairman LEAHY. Mr. Kappos—and I apologize to Senator Sessions. I am going somewhat over time here—but we have been working on a bipartisan basis in this Committee on comprehensive patent reform legislation. We have done this the past three Congresses.

If you are confirmed, as I fully expect you will be, will you work with us members, both Republicans and Democrats, work with us on trying to resolve the final issues in the patent reform legislation?

Mr. KAPPOS. Yes, absolutely, Chairman Leahy. That would be, I am tempted to say, the top priority, but there will be several very top priorities.

Chairman LEAHY. You also have a big backlog of patent cases.

Mr. KAPPOS. That is right.

Chairman LEAHY. I assume you are going to try to clear those up, too.

Mr. KAPPOS. That is right. That would be the second one, yes.

Chairman LEAHY. Mr. Viken, I notice you currently supervise 32 employees. You find time to initiate an annual law day program to teach local students about their constitutional rights and obligations. You did not have to do that. Why did you do that?

Mr. VIKEN. Mr. Chairman, in our districts, in North and South Dakota, as you know, it is very rural. We serve people on 13 Indian reservations. Law day programs are a wonderful thing, but they tend to focus on communities which are larger and public school systems.

My effort was designed to go out into the reservation communities, where kids just do not have access to lawyers to the same extent; someone to come into the classroom and really talk to them in a front line way about their constitutional rights and their obligations as American citizens.

So that was the motivation, sir, and we have touched about 1,000 children a year with our law day programs on the reservations in the Dakotas.

Chairman LEAHY. Thank you very much. Senator Sessions, I thank you for your forbearance. I went over time there.

Senator SESSIONS. That is fine.

Chairman LEAHY. Please go ahead.

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Senator SESSIONS. Thank you, Mr. Chairman. I was prepared to yield to Senator Hatch or Senator Coburn. Both I know have serious matters on their agenda. I am not sure who.

Senator HATCH. Maybe I could just ask one question of Judge Martin and then just maybe a little bit of comment for Mr. Kappos.

Senator SESSIONS. Please.

Senator HATCH. I want to congratulate all three of you. These are important jobs. I take them very seriously. Judge Martin, like I say, I was chairman when you first came up before the Committee.

Ms. MARTIN. I remember it very well. My father and I speak often of your kindness to both of us that day. It was a highlight for both of us.

Senator HATCH. Thank you. I hope you do not think this question is unkind.

Ms. MARTIN. All right.

Senator HATCH. But I have one question about one of your cases. That was *U.S.* v. *Farley*, which you decided last year. The reason I am concerned about this is I understand that this decision is currently on appeal to the Eleventh Circuit. So I just want to ask you about your decision and how you reached it.

In that case, you found a man guilty of crossing state lines with intent to engage in a sexual act with a child under the age of 12. You found the mandatory minimum 30-year sentence required by the Federal statute to be unconstitutional and a violation of the Eighth Amendment.

Now, I am interested in this decision for a number of reasons, one of which is that this mandatory sentence was established by the Adam Walsh Child Protection and Safety Act, which I introduced in the Senate. Now, you said that the mandatory minimum was grossly disproportionate to the crime, but I was surprised at your reasoning.

You said that no harm was suffered because the predator had not actually had sex with the child. You even observed that, quote, "It was not possible for a child to be harmed because the child was a creation of law enforcement and no real child exists," unquote.

Now, I have some difficulty seeing how either of those observations is relevant, since the crime for which the predator was convicted is defined in terms of the intent to have sex with a child.

Now, Congress made that a crime and imposed a hefty mandatory minimum, as you know, precisely because the consequences of a predator actually abusing a child are so horrific.

Now, with respect, it sounds like you were saying no harm, no foul. But that is certainly not what the Congress thought. Now, your decision suggests that you would have viewed the case differently if law enforcement had actually used real children as bait rather than setting up a sting.

Now, I have to say I was disturbed by the decision, but I have great confidence in you. I would just appreciate whatever insight you can give me about it.

Ms. MARTIN. Well, 18 United States Code Section 3553(a) requires that I look at the nature and the circumstances of the crime committed, and there was a challenge made to the 30-year mandatory minimum.

There is a presumption, as I well understand, that any act of Congress is constitutional. The United States Supreme Court has a test that judges are supposed to apply when there is a challenge, Eighth Amendment challenge made to a statute, and I set out to apply that test, which requires that I look at the punishment for similar crimes or more serious crimes in the same jurisdiction and how other jurisdictions punish similar crimes.

It is a pretty onerous test and I looked at how each of the 50 states treat that crime and what I ran into was the laws are—for example, the law for producing child pornography which involves the molestation of an actual child and then the continuing molestation of that child by the distribution of the photographs of the molestation that can go on for the child's whole life, and the sentence for that was a mandatory minimum 15 years, a cap of 30 years.

In my case, the defendant talked to an FBI agent who pretended to be the mother of a child and he was arrested on the plane. He never left the plane. He waived a jury trial. I convicted him of the 30-year count, which is what I refer to it as, and then there was the Federal statute that criminalizes crossing state lines with intent to murder somebody, murder for hire. There was a statutory cap on that of 10 years.

Senator HATCH. You basically thought the 30 years was excessive.

Ms. MARTIN. It wasn't about what I thought. My effort was to write an opinion applying the test and when I got to the proportionality analysis, as I said, I could not find the words to say that it was not disproportionate.

Senator HATCH. Mr. Chairman, let me just say, I am going to support you, but I did want to hear what your reasoning was. So I plan on supporting you. I plan on supporting you with respect.

Mr. Kappos, there is no question we are going to support you, as well. You have an eminent experience in this field and I just challenge you. I know that Senator Leahy and I and others on this Committee work very strongly together to try and help bring about the effective changes that we need to make to help you to do your job better and to help this country and to keep us at the forefront of innovation.

I think you are the type of person who can help us to do that and I am very proud of you for accepting this position, as I am of these two judgeship nominations. I had some questions for you, but I will submit those in writing and just know that I am very impressed that you are willing to do this, very impressed with you personally, and I am counting on you really helping us do a better job up here on Capitol Hill for the people, for innovators, for the Patent Office, and we will do everything we can to assist you.

I know that Senator Leahy feels exactly the way I do. We are together really on these issues. Thanks, Mr. Chairman.

Chairman LEAHY. Senator Hatch, I thank you for what you said, too, because one of the things we have found, all these patents, every single patent bill has been a bipartisan patent bill when it is passed and, actually, most of the good legislation on here has been bipartisan and I would like to keep it that way.

Senator Franken.

Senator FRANKEN. Thank you, Mr. Chairman. Thank you, Judge, Mr. Viken, Mr. Kappos. Just a few quick questions. Mr. Kappos, you talked about your experience in Asia and the importance of intellectual property in innovation and in the American economy.

I was wondering if you had any thoughts about intellectual property in terms of the entertainment industry, in terms of knock-offs of movies and those sorts of things, especially in China.

Mr. KAPPOS. Thank you, Senator Franken, for that question. There unquestionably is a significant problem with counterfeiting and piracy, the two areas that affect the entertainment industry, and that is movies we think of and that is also, of course, entertainment content in the form of music and, additionally, other content, software.

Senator FRANKEN. Books.

Mr. KAPPOS. And the high tech industry. Significant challenges. We have got some new capability in the administration that I would like to see and hope that will lead to more aggressive action in terms of working with our overseas counterparts.

I hope, if confirmed for this job, to be able to work with the new players in order to be able to engage with whatever countries are needed, in Asia, in some cases, in Eastern Europe, in some cases, in Africa, in order to be able to put a new emphasis on piracy and counterfeiting.

The special 301 process that USTR undertakes is clearly an important part of that equation, but there are other parts, too, including education, including working with our counterparts in these other countries to help them put in place new laws and win-win enforcement scenarios that will encourage them to take the aggressive enforcement actions we need.

Senator FRANKEN. Thank you. Mr. Viken, I am the newest member of the Indian Affairs Committee and I was particularly happy to see and hear about your significant work with the Native community.

Can you tell us a little bit about that? I understand you and your wife were adopted by a Lakota family.

Mr. VIKEN. We were, Senator. About 15 years ago, full blood families on Pine Ridge Indian Reservation in South Dakota gave us the honor of going through a hunka lo'api ceremony, which is a very ancient, traditional form of Lakota adoption, a making of relatives ceremony.

So we have functioned with families, traditional families on Pine Ridge for all of these years. It has been a wonderful experience personally, and, professionally, I think it brings a level of cultural competence that is very useful in the work that we do.

Senator FRANKEN. Judge Martin, I heard in your introduction by Senator Chambliss that you were involved in the weed-and-seed program.

Ms. MARTIN. You know the weed-and-seed program.

Senator FRANKEN. Yes. We have that in Minnesota and I have been to some weed-and-seed events, and they seem to be diminishing, the number of them. Is that the case and do you not think we should be encouraging those programs?

Ms. MARTIN. Well, of course, that is policy and judges do not make policy. But I was thrilled with my involvement in the pro-

gram and the effect it had on some neighborhoods that needed some help throughout my part of the state.

We had summer camps in our weed-and-seed program. Did you know about those?

Senator FRANKEN. They did all kinds of things in different weed-and-seed programs. Basically, it was a way of reducing crime in these neighborhoods and by doing various things like camps, but other stuff, too.

Ms. MARTIN. We have so many military reservations in Georgia that we could partner with the military reservations and have the children come to the military reservations and spend the night and so they were exposed to all sorts of things they would have otherwise not known about. It was a real highlight for me.

Senator FRANKEN. I am glad you took the initiative to do that. Thank you, Mr. Chairman.

Senator SESSIONS. Are you recognizing me?

Senator FRANKEN. Yes. Mr. Ranking Member Sessions, Senator, sir, from the great State of Alabama.

Senator SESSIONS. We are great.

Senator FRANKEN. I am sorry.

Senator SESSIONS. Mr. Kappos, Senator Coburn is in the middle of a markup he had to attend, but he wanted me to ask you this. He had talked to you previously, I think.

Do you think you can effectively manage the PTO through this difficult time, reduce the backlog, reduce patent pendency, if you constantly have the threat of fee diversion hanging over your head every year?

In other words, what Congress has done is we have allowed these fees to be assessed on the private companies and then we spent them on other things, looted the fund. So how do you answer that?

Mr. KAPPOS. Thank you for that question, Senator Sessions. I am already well on the record as being opposed to fee diversion and, certainly, speaking as a citizen and as a member of the intellectual property community, I know well that the community is strongly supportive of the U.S. Patent and Trademark Office and, in fact, will fully fund the Patent and Trademark Office, including even paying more fees than are currently paid.

So it is one of the few places where a user community will readily step up and say, "We do not mind paying whatever it costs." However, the challenge of fee diversion has been very costly in terms of user community confidence in the Patent and Trademark Office and that comes in the sense that the community is steadfast in that it does not want to pay additional fees just to have them diverted to other government uses, as worthy as those other government uses may be.

So one of the things that I would like to focus very substantial attention on, in addition to the backlog and some of the other things that we mentioned, S. 515, getting legislation through, is working with the Congress, as well as the administration to come up with a sustainable, long-term funding model for the U.S. PTO that includes the director's ability to set reasonable fees, and that provision is in S. 515; that includes some way to enable the PTO to have the fees that it collects 1 year in order to be able to spend them in a future year to conduct the work that the fees are paid

for in the first place; and then, finally, Senator Sessions, to your question and to Dr. Coburn's question, to work with the administration to put a sustainable system in place that makes fee diversion something that the user community does not have to worry about so that it will fund the patent.

Senator SESSIONS. Well, I would just say I think you are right about that. I think there is a concern about delays. Some of those delays are probably a lack of resources for you and your team and if the fees had not been diverted, we would not have a shortage of resources.

The same thing has happened with nuclear power, where we were going to tax the nuclear companies to create a storage place, and that money has been spent on other things and now they are suing the government because the government cannot take the nuclear waste that they have been paying billions of dollars for. So it is bad government and bad management on our side.

Ms. Martin, thank you. I hear great things about you. I have talked to a number of people who have known you. So I am very positively disposed about it. I have gotten a lot of calls to that effect.

But to follow-up on Senator Hatch's question, to me, there is a danger if a judge feels that a sentence is incorrect, and I can respect that. That is a pretty strong, heavy sentence, 30 years, in this kind of case, even though the man thought, by all bits of evidence, that he was going to have sex with a 12-year-old child. So I think people can disagree on what the right sentence there is.

I am a bit concerned about your leap to the fact that the Eighth Amendment would cover this. I would just ask, first, has there been any other case that you are aware of in which a court has held that a heavy sentence, even a life sentence, violates the Eighth Amendment, which prohibits the imposition of cruel and unusual punishment?

Ms. MARTIN. The test that applied in the case was a United States Supreme Court case, and I, frankly, cannot remember how they came out in applying that test. It sounds so terrible when we are sitting here. I want to be sure people understand.

Senator SESSIONS. Let me just say I know a lot of judges. We have had a previous one this year that has got a little bit of a problem, because he, I would say, was criticized, I will just say it that way, because he did not want to follow one of these sentences.

These child molestation cases have very heavy sentences and I think good judges could think that some of them may be more excessive. But Congress, we debated that at great length and we passed that and we take that very seriously. We want to end this problem. But go ahead.

Ms. MARTIN. And I do, as well. I bet, when you were a United States attorney, you prosecuted these folks when the Postal agent was the case agent in the case. I did, as well.

So I am delighted not to be the policymaker in this area, because I think it is a terrible problem and I have no idea how to solve it. As I said in the transcript, when I set out to apply the test, I had no idea it would turn out that way. But I think that is what judges have to do. You have to look at each case fresh and apply the test

that the Supreme Court has provided and it comes out how it comes out, and I understand.

My father is probably having a heart attack back there about what I did. This man, there was no evidence he ever touched a child.

Senator SESSIONS. I understand that.

Ms. MARTIN. And I sentenced him to 20 years.

Senator SESSIONS. I just want to raise the question with you, just basically—go ahead, if I am interrupting.

Ms. MARTIN. No. I just wanted to be sure my daddy knew I sentenced him to 20 years. I did not just let him go home.

[Laughter.]

Senator SESSIONS. Well said.

Chairman LEAHY. Before your father walked out of the room.

Ms. MARTIN. He is not going to vote for me now.

Senator SESSIONS. No, no. Twenty years without parole is a very serious, heavy sentence.

Ms. MARTIN. I am under oath. So it was 235 months, 5 months short of 20 years.

Senator SESSIONS. Very good. Well, I am just of the view that this was a pretty significant or a fairly unusual thing that former Chairman Sensenbrenner, ranking in the House Judiciary Committee, has filed a brief in the case, being concerned that it does violate the congressional authority in that area.

My time is up. I would just say to you that there is a siren call of temptation out there, always, "Well, this is not quite the way I would like it to come out and I would like to do it differently." The majority of your record is not that way. This is just one of the cases that jumps out at some people, especially since the House has filed a brief, members have filed a brief on it.

I would like your commitment that you understand that it will be your responsibility to serve under the Constitution and under the laws of the United States, as the oath says, and not above it.

Ms. MARTIN. Absolutely. Absolutely. I do impose mandatory minimums all the time, Senator Sessions. I wanted to be sure you knew that.

Senator SESSIONS. Yes. I know that is true and your record demonstrates that.

Ms. MARTIN. Thank you.

Chairman LEAHY. Thank you very much. Senator Specter.

Senator SPECTER. Thank you, Mr. Chairman. Mr. Kappos, you have been nominated for a very, very important job. This Committee has labored arduously on the issue of patent reform and we have heard many, many witnesses testify about the importance of patents and intellectual property as our place preeminent in the world and to stimulate inventions.

So it is a big responsibility. The Patent Act has allowed for petitions to make special, which is an accelerated procedure, and there had been a special opportunity for environmental patents to expedite the process. That was changed to put those applications in line very far back and there is great emphasis, as we all know, on the effort to develop environmentally safe approaches to the environment.

We are struggling mightily with cap-and-trade now. I would be interested in your views and interested in your assurances that you would do whatever is possible to expedite the patent applications for environmental issues.

Mr. KAPPOS. Thanks for that question, Senator Specter. That goes into the green tech area. I am very familiar with the accelerated prosecution rider, petition to make special process, that was formerly applicable in that area that has been somewhat cut back.

One thing that I think is very straightforward to do and very clearly positive for our country and our economy is to reinvigorate the right for an applicant to make her or his application special.

Senator SPECTER. You would put back the old system where environmental applications had precedence.

Mr. KAPPOS. Exactly, on account of the invention relating to the environment. I would like to do even more than that, though, because I believe there is a strong nexus between the patent system, the innovation capability behind the patent system and fueling sustainable innovation, like innovation that benefits the environment.

Senator SPECTER. Mr. Kappos, I have a couple of other questions. So would you supplement your answer in writing as to specifically what you would do?

Mr. KAPPOS. Sure, I would be happy to.

Senator SPECTER. That is a very weighty issue and I think there would be a lot of interest in going beyond the old rules which gave expedited attention to that issue.

You come to the position with an extensive background with IBM and IBM will have a great many issues before the Patent Office which you will be called upon to rule. Now, the government welcomes people of competence who have experience and there is inevitably an issue as to whether you may be faced with some matters which would have special benefit for IBM.

It is a matter of some delicacy and there is not a whole lot that you can do except to focus on it. But address that issue and tell us what special precautions you would take to be fair to IBM, but not to be biased to anybody one way or another, because there are so many competing interests and these rules are—some of them are favored by IBM and to the disadvantage of others. How will you handle that?

Mr. KAPPOS. Thanks, Senator Specter. This, to me, is a very clear situation involving conflicts, actual and apparent. To me, it is extraordinarily important that I have absolutely nothing to do with any particular decision that involves my former employer, if I am confirmed for this job, IBM. Therefore, I will have to recuse myself.

Senator SPECTER. But how do you avoid the issue beyond that? The Federal circuit has granted a request for en banc hearing in *Tafas* v. *Dudas*, and there has been a stay of proceedings to see what attitude you might have, and IBM would be benefited in one way and other companies would be benefited another way.

If there is some specific issue which IBM is the sole party to, that is one thing. But how do you handle a more subtle and sophisticated issue like the one I just mentioned?

Mr. KAPPOS. In the *Tafas* v. *Dudas* case, my current employer, IBM, has no stake in that case in the sense that it is not a party on either side.

Senator SPECTER. But is it not true that one interpretation of the rules or one application of the rules would benefit IBM and another would benefit many other smaller companies?

Mr. KAPPOS. I do not know that I see it that way. I think of my role, if I am confirmed for this job, is doing the right thing for the American people and the United States of America. Like other people who are in private industry and move to the government, I will put my previous role behind me and focus entirely on doing the right thing for the United States of America, in the *Tafas* case, in the *Bilski* case, and in everything else, on a policy level that faces the U.S.

Senator SPECTER. That is a very good answer and doing that will satisfy everybody.

Mr. KAPPOS. Thank you, Senator.

Senator SPECTER. Let me make one additional comment, if I may, Mr. Chairman, to the judicial nominees. When Senator Thurmond was chairman in here, he—Judge Martin, you are already a judge and, Mr. Viken, you are likely to become a judge.

Senator Thurmond used to say, "If you're confirmed, do you promise to be courteous," which translates from South Carolinaese, "If you are confirmed, do you promise to be courteous."

When I first heard him ask the question, I said, "That is not a very meaningful question. What is anybody going to say but yes?" The nominees dutifully answered "yes" and then he said, "Because the more power a person has, the more courteous a person should be." Translated, "More power a person has, the more courteous the person should be."

Sometimes there is a tendency, when you put on that black robe and have all that power, especially lifetime tenure, which Senators do not have, except for Senator Leahy——

[Laughter.]

Senator SPECTER. When you have all that power, bear Senator Thurmond's admonition in mind. Thank you, Mr. Chairman.

Chairman LEAHY. Thank you very much. I will resist the response to that. I do recognize Senator Klobuchar, but before the clock starts on her, having Senator Thurmond here was a very interesting thing. I once made a comment on something Senator Kennedy said and I said, "The problem with you guys from the southern states, meaning Massachusetts."

Senator Thurmond sat bolt upright and for 20 minutes, he said, "I'll tell you boys," you boys, "what southern is." And at the end of that 20-minute lecture, we realized Massachusetts may be south of Vermont, but it is not southern.

Senator Klobuchar.

Senator KLOBUCHAR. Thank you very much, Mr. Chairman. Congratulations to all of you. I would tell you, Judge Martin, that I have been watching your father back there and he is doing fine.

Ms. MARTIN. Good, good, good.

Senator KLOBUCHAR. He was laughing at the last jokes. He is doing Okay.

Ms. MARTIN. As long as he is still here.

Senator KLOBUCHAR. Yes, that is good. I will say I have appreciated your honest explanation about that case and I think Senator Sessions understands, as does everyone up here, that people may

not agree with every decision that you make, but it is looking at your record as a whole, which is very strong.

Also, your explanation here was very good. I would add, which I am sure was mentioned before, that you got the blue slips, which means the go-ahead from the two Republican Senators in Georgia, Senator Isakson and Senator Chambliss, both of whom are well respected here. But thank you for your answer.

Ms. MARTIN. It is a real honor.

Senator KLOBUCHAR. Mr. Viken, neighboring state of South Dakota, for Mr. Viken, congratulations on your nomination, as well.

Mr. VIKEN. Thank you, Senator.

Senator KLOBUCHAR. I am going to focus my questions on Mr. Kappos. We believe that your nomination is a good thing for this country. I appreciate your willingness to work with this Committee. I know I saw you before in your previous role.

As you know, we have 5,600 IBM employees in Minnesota, which I think you have pointed out to me, and we stand ready to work with you in your new position. I am very interested in this patent issue, because as you know, in my state, we have companies that have a lot of patents, from Medtronic to 3M. We gave the world everything from the Post-It Note to the pacemaker.

So we care very much about this issue. So I wanted to focus on the Patent and Trademark Office, how you think that we could improve the efficiency. I hear a lot of concerns about that, as well as improving the morale in the office.

Mr. KAPPOS. Thank you, Senator Klobuchar. Yes. The efficiency challenge in the U.S. PTO is a considerable one. There are so many things that need to be done, we will not be able to go into all of them this morning, but I would list just a few right off the top.

One of them that is critical and I believe is a major morale issue and productivity issue to the examining corps itself, especially on the patent side, is the so-called count system. This is a system that has been in place for more than a generation, since the 1970's, that governs how examiners are encouraged to do their work.

As I understand it, the examining corps hates the count system the way it is. The applicant community, the 3Ms and the Medtronics of the world, hate the count system the way it is, because it results in dysfunctional behavior.

One of the things that I commit to do, if confirmed for this job, is to work immediately with the unions that represent PTO employees, the examining corps, and completely remake the count system.

Secretary Locke has personally asked me to do that. That is going to be priority one, among a few other priority ones, like S. 515. So the count system needs to be fixed. That will help morale tremendously and it will help substantively to enable examiners and applicants to get to the issues that count in patent applications, that matter, and to get them to appropriate disposal much more quickly.

Senator KLOBUCHAR. Very good. When we had our hearing on the patent reform bill, we talked a little bit about the economy and the state of the economy and how that affects the issues of innovation in America and really the issue of patent reform.

Could you talk about your views, in general, on that and why it is important that we not only get the PTO as functional as possible, but also get something done with regard to patent reform?

I actually believe that it helped to forge some consensus. We know there is still some work to be done on the issue, but that the economy was a major factor. Do you want to comment on, in general, the effect of the economy on innovation and patents and things like that?

Mr. KAPPOS. Yes, sure. Thanks for that question, Senator Klobuchar. So I believe that at the top, first and foremost, the intellectual property system truly is the facilitator of innovation. It truly is the engine that encourages innovation for our country.

In a world in which, the way I put it, the distance between innovation and products is decreasing continuously, because of how easy it is to move from an idea to a finished product, the only thing that protects the innovation is intellectual property. It is the patent system, in the case of inventions.

So there is nothing more important to returning our country to economic health than getting the innovation system working again, and the Patent Office is right at the center of that.

So I would say, yes, clearly, there is a tremendous nexus. The Patent and Trademark Office can play an enormous role as part of the Department of Commerce.

The second thing I would say is that in terms of just the economics of managing and leading a large intellectual property granting authority, the U.S. Patent and Trademark Office, as you know from the legislation that recently had to be passed just a few weeks ago, there are some significant challenges with patent application filings being down, patent grants being down, renewal fees or maintenance fees being down, all of which is taking fee collections down in an era in which there is this tremendous backlog of over a million applications to examine.

So we clearly need to, in addition to refashioning the count system, we need to refashion the fee system of the U.S. PTO in order to be able to more accurately assess fees against the work that is being done. I believe that with that piece of work, which is part of S. 515, director fee-granting authority, plus fixing the issue of fee diversion that we spoke about before, we can make a tremendous amount of progress and get tremendous support from the intellectual property system.

Senator KLOBUCHAR. Thank you very much, and thank you for that practical answer.

Chairman LEAHY. Thank you. Any further questions? If no further questions, we will hold the record open for a week, as we normally do, for Senators who wish to submit questions.

I thank all three of the nominees. I applaud you on being nominated. I think it speaks well for the United States to have three people of the quality of the three of you being nominated, two for lifetime appointments on our Federal court. For those of us who spent years practicing before Federal courts at all levels, that means a lot.

Mr. Kappos, as I said, I have known you for years and, as we face increasingly worldwide economic competition, we need to have a strong Patent Office.

Senator Klobuchar, Senator Franken and I represent states that have had a lot of patents. It is what is going to create jobs, it is what is going to create the future in our country and it is important that we have the best as the head of the office.

So I thank you all. We stand in recess.

[Whereupon, at 11:15 a.m. the Committee was adjourned.]

[Questions and answers and submission for the record follow.]

QUESTIONS AND ANSWERS

The Honorable Orrin G. Hatch
Nominations Hearing
before the
Senate Judiciary Committee
July 29, 2009

Question for Mr. David J. Kappos, to be Director of the U.S. Patent and Trademark Office:

You mentioned in your testimony that there is a great need to address pendency concerns while *preserving* and *enhancing* patent quality. One major problem for examiners is the volume of prior art they have to review.

During the 110th Congress, former USPTO Director Jon Dudas testified before the Senate Judiciary Committee. He brought with him a box of materials to show the Committee what a patent examiner reviews when processing an Information Disclosure Statement. There were about 2,600 pages of material submitted in one box. And there were 27 other boxes that had the same amount of material for the one patent application.

Such a deluge of information is counterproductive and does not help produce high-quality patents. Yet, patent applicants must be extremely cautious under current law. They have to send the patent examiner anything that could be considered any way relevant.

This is caused by our current law on inequitable conduct. I've been working hard to find a way to release some of that pressure.

It seems to me if you get it right in the front end, a lot issues that come up later could be prevented, including costly litigation.

I believe we must provide a way for patent owners to send information they find out was not considered by the USPTO during original examination.

I've proposed a *modest* change to the reissue procedure to let patent owners do just that.

This type of procedure would offset some of the pressure to over-disclose information.

Would you not agree that if that type of procedure were available, we'd end up with higher quality patents?

Do you believe the current reissue procedure shields a patent from attack under inequitable conduct?

I agree that it is essential to develop reforms that encourage patent applicants to share all information relevant to their application on a timely and accurate basis. A properly crafted procedure involving reissue may certainly be a viable option. If confirmed, I would look forward to working with you, the Committee and stakeholders to develop a consensus-based approach that ensures that the most complete, accurate and timely information is placed before patent examiners without placing applicants at risk of abusive claims of inequitable conduct.

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The Honorable Orrin G. Hatch
Nominations Hearing
before the
Senate Judiciary Committee
July 29, 2009

Question for Mr. David J. Kappos, to be Director of the U.S. Patent and Trademark Office:
You mentioned in your testimony that the USPTO needs a stable and sustainable funding model. There is no doubt that the road to economic recovery begins with a high-functioning and well-funded USPTO.
I strongly believe that the practice of diverting funds needs to be stopped.
It seems to me there's got to be some financial flexibility for the agency to plan for infrastructure improvements, improve service to the public, and weather economic downturns.
Of course, we don't want to send our appropriator friends over the edge, but there's got to be a middle ground here.
What are your thoughts on the best way to achieve a viable funding model?
What form would it take?

The mission of the USPTO is critical and the agency should not have the effectiveness of its operations be subject to downturns in economic conditions or other factors that may cause uncertainty in revenues collected, while a processing backlog continues to exist. To ensure a sustainable operating model, I support continued full access to collected fees and, if confirmed, I will consider ways to enhance the USPTO's flexibilities to allow the agency to improve multi-year planning to adjust to changes in revenues and applicant demand. I have heard from numerous members of the patent community who would pay higher fees to USPTO, if those revenues stayed with the agency to improve services. If confirmed, I will also work with the Congress to explore additional measures or authorities that would ensure sufficient dependable funding, improve USPTO's day-to-day operations and place the agency on a sustainable path.

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The Honorable Orrin G. Hatch
Nominations Hearing
before the
Senate Judiciary Committee
July 29, 2009

Question for Mr. David J. Kappos, to be Director of the U.S. Patent and Trademark Office:
Earlier this year you testified before the Senate Judiciary Committee regarding the need for patent reform legislation. As you know, I've been working with Senator Leahy for years on how best to accomplish this goal.
On the issue of how monetary damages are calculated and awarded to successful litigants, you stated, "The current legal standard does not provide the certainty needed to enable modern business to operate effectively."
The damages compromise includes so-called *gatekeeper* language. It would provide courts with guidelines on handling evidence of infringement so they can determine monetary awards to patent holders who claim their inventions have been improperly taken.
Do you think the damages compromise provides the certainty that you said was needed?

While I do not believe that we can ever realistically achieve a perfect legislative formulation governing the assessment of damages in patent infringement cases, the compromise damages language in S. 515, as reported, focusing on a "gatekeeper" approach is certainly an improvement over current law. I look forward to the opportunity to work with the Administration as it weighs in on the patent reform debate in the 111th Congress.

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The Honorable Orrin G. Hatch
Nominations Hearing
before the
Senate Judiciary Committee
July 29, 2009

Question for Mr. David J. Kappos, to be Director of the U.S. Patent and Trademark Office:
As Director of the USPTO, you will have to deal with the agency's backlog. This is a major issue and will require significant attention.
The previous Director advocated for a series of rule packages that were strongly opposed by industry.
What steps are you going to take to listen to your patent applicants about USPTO's workload challenges?
Will you start fresh and seek new ideas from the patent community?

If confirmed, I fully intend to seek advice and input from all stakeholders. Over the last two decades I have spoken with many in the intellectual property stakeholder community and I will continue to have ongoing conversations. The USPTO will fully engage stakeholders through information notices requesting public comment, roundtables and other outreach efforts in developing and implementing initiatives that will effectively, efficiently and fairly address the USPTO's workload challenges.

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The Honorable Orrin G. Hatch
Nominations Hearing
before the
Senate Judiciary Committee
July 29, 2009

Question for Mr. David J. Kappos, to be Director of the U.S. Patent and Trademark Office:

I appreciated your comments about the need to protect the interest of American innovators in the global arena. Trademark counterfeiting is worldwide in scope and costs the U.S. economy billions of dollars every year.

Fostering strong intellectual property protection builds the economies of not only developed nations, like ours, but for any nation striving to achieve a vibrant and growing economy. Yet, it is vital that we provide those working on the front lines with the tools they need to ensure that our nation's IP rights are lawfully respected by foreign countries.

I believe that any solution must take an integrated approach with both domestic and international prongs which incorporate educational, judicial, and enforcement components to halt the attack on our intellectual property.

Do you have any additional suggestions on how we might combat and deter infringement and promote honest business practices in the use and development of intellectual property abroad?

I strongly agree that we must take a coordinated approach to deterring and fighting foreign and domestic infringement of the intellectual property of American's innovators. Counterfeiting and piracy cost the U.S. billions of dollars in revenue and hundreds of thousands of jobs. Commerce Secretary Locke recently called for a stronger effort to protect U.S. IPR worldwide. If confirmed, I look forward to working closely with the person who will serve as the Intellectual Property Enforcement Coordinator and all other Administration officials with intellectual property rights enforcement responsibilities to develop and implement new approaches as well as improve current approaches in fighting this scourge.

The Honorable Orrin G. Hatch
Nominations Hearing
before the
Senate Judiciary Committee
July 29, 2009

Question for Mr. David J. Kappos, to be Director of the U.S. Patent and Trademark Office:
If confirmed, you will be required to balance the interests of all innovators in this country. This will not be an easy task. You will be expected to advance sound public policy while considering all interested parties.
How do you plan to do this?

If confirmed, my decision-making and advocacy will be based on a careful analysis of the issues before me, the benefits to the entire innovation community, the impact on job creation, and the goal of securing the economic future of our country through innovation. I will not endorse or promote any initiative that has the effect of picking winners or losers or otherwise favoring any particular industry or area of technology over another. I will do only, and exclusively, what is right for the American people and American intellectual property system.

Questions for the Record to David Kappos
From Senator Charles E. Schumer
August 3, 2009

In June of 2009, the Bureau of National Affairs wrote that you are "known for a general opposition to business method patents," and noted that you recently argued that the Federal Circuit's 1998 State Street decision led to a 10-year "experiment" in these patents that has failed.

I share your concerns regarding business method patents. Would you please expand on your thoughts regarding this issue?

RESPONSE: I continue to have concerns regarding the patentability of some types of business methods. Certainly, there are business methods that fully meet the statutory requirements of current patent law. However, the U. S. Supreme Court's forthcoming decision in the Bilski v. Doll case may provide the USPTO and the user-community more guidance on the patentability standards for business method patent applications in the future. If confirmed by the US Senate, I will of course faithfully implement the decision of the Supreme Court in the US Patent and Trademark Office by developing appropriate guidelines and training to enable the examining corps to accurately apply the law in their patent examining work.

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David Kappos Responses to the Honorable Arlen Specter
August 5, 2009

Question 1

The Patent Act has allowed for "petitions to make special," which is an accelerating procedure. There had been a special opportunity to expedite the process for environmental applications. That was changed in 2006, when the USPTO changed its accelerated examination rules, requiring applicants requesting accelerated examination to follow many burdensome and expensive procedures, thereby discouraging applicants from requesting accelerated examination. There is great emphasis as we all know, on the effort to develop environmentally safe technologies. I would like your views and assurances to do whatever is possible to expedite patent applications on environmental issues in a manner that is not economically or logistically prohibitive for emerging green technologies.

Response 1

If confirmed, I will work promptly with stakeholders to review and, as necessary, make changes to assure a user-friendly, expedited examination option consistent with our international agreements. In particular, my team and I will explore changes needed to expedite processing of "green-tech" patent applications to the USPTO. I see this as part of the broader effort within the Administration to develop programs and procedures that promote and support innovation and job creation in this important field of technology.

Question 2

As you know, several members of the Committee were able to craft a compromise on the calculation of damages provisions in S. 515 that received broad support within the Committee. In the hearing, you stated that one of your top priorities would be to work for the enactment of patent reform legislation. Do you support the damages compromise included in S. 515 passed by the Committee?

Response 2

The compromise damages language is a constructive step forward relative to clarifying the law in regard to damages. If confirmed, I look forward to working with you to provide balance and flexibility when addressing this complex issue. The damages section is intended to strike such a balance, requiring courts to identify methodologies and factors relevant to the determination of damages while providing leeway in the application of those methodologies and factors.

Responses of Beverly Baldwin Martin
Nominee to the U.S. Court of Appeals for the Eleventh Circuit
to the Written Questions of Senator Tom Coburn, M.D.

1. **In your questionnaire submitted to the Committee for your 2000 district court nomination, you were asked for your views on judicial activism. You stated:**

"Once a case is properly before a court, a judge is obligated to follow the United States Constitution, statutory law, and the doctrine of stare decisis to adhere to legal precedent. This precept is paramount because it is necessary to the stability of our system for individuals and commercial concerns to find predictability in our judicial system and anticipate what actions are legally permissible. . . ."

a. Do you reaffirm your earlier statements?

Response: Yes. Although I have not reviewed this statement in quite some time, it is a good description of how I have decided cases over the last nine years as a federal trial judge. I will continue to follow this approach if confirmed for a position on the Eleventh Circuit Court of Appeals.

b. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: When interpreting the Constitution, a judge is bound by its words, which do not change or evolve. The text of the Constitution and the binding precedents of the United States Supreme Court and the Eleventh Circuit will control my decisions if I am confirmed.

c. In *Roper v. Simmons*, Justice Kennedy relied in part on the "evolving standards of decency" to hold that capital punishment for any murderer under age 18 was unconstitutional. Do you agree with Justice Kennedy's ruling? Do you agree with his reasoning?

Response: In *Roper v. Simmons*, Justice Kennedy wrote for five of the Justices of the United States Supreme Court. Therefore his ruling constitutes precedent that binds me as a judge on a lower court, and I will follow that precedent.

Justice Kennedy's reasoning in *Roper v. Simmons* resulted in a ruling that constitutes the law of the land, and I will respect and follow this precedent.

d. Do you think it is ever proper for judges to indulge their own values in determining what the law means?

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Response: No. If individual judges decided cases based upon their personal values, there would be no certainty or predictability in our judicial system, and our courts and system of justice could not maintain their legitimacy.

e. If so, under what circumstances.

Response: I do not think it is proper.

2. President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."

a. Do you agree with President Obama's quote?

Response: President Obama has provided this description of what is important to him in carrying out his constitutional role of selecting judges. As a judge, my constitutional role is quite different from that of the President. I decide individual cases that come before me based upon the facts presented by the parties, and the legal precedent that governs the dispute.

b. Do you believe that you fit President Obama's standard as described in his quote?

Response: I make every effort to treat all parties that appear before me with respect, and to carefully consider their legal arguments in the context of the facts of their cases. I do not, however, decide cases based upon my emotions, or sympathies for or against various groups or types of people.

c. What role do you believe that empathy should play in a judge's consideration of a case?

Response: I do not believe that cases should be decided based upon empathy or emotional responses. Rather, each individual case must be decided on its particular facts, as required by binding precedent. It is also true that as a trial judge, I have spent much of my time in the courtroom with the parties litigating cases before me. I believe that it is important to treat them, as well as their lawyers, with respect and consideration, and I try to do so.

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3. **In *United States v. Miranda*,[1] a jury convicted the defendant of conspiring to distribute methamphetamine and cocaine, possession with intent to distribute, and possession of firearms in relation to a drug trafficking crime. The police found the defendant at a home with guns, drugs, and drug paraphernalia. The defendant was present when the police raided the home and ran into a bedroom with two guns and the drug evidence. After the jury found the defendant guilty, you granted the defendant's acquittal motion.**

Likewise, in *United States v. Molina*,[2] the defendant was charged with knowingly participating in a drug trafficking conspiracy and possession of a firearm in furtherance of a drug trafficking crime. The police found the defendant and her common law husband in her bedroom, which contained cocaine and a digital scale. There was a second digital scale and cocaine in her bathroom, a gun and passports in her open nightstand, and a garbage bag and shoebox filled with nearly $300,000 cash in her closet. A jury convicted the defendant of conspiracy to traffic drugs and possession of a firearm in furtherance of drug trafficking. Again, the jury found the defendant guilty and you overturned the jury's finding.

In both cases the Eleventh Circuit reversed, finding there was sufficient evidence and the jury convictions should not have been overturned.

a. Do you still believe it was right to overturn the juries' verdicts in these cases?

Response: I fully accept the ruling of the Eleventh Circuit that there was sufficient evidence for the jury to convict both Mr. Miranda and Ms. Molina.

b. If you were given the chance to handle these cases again, would you have handled them differently? If so, how?

Response: Upon receiving the ruling of the Eleventh Circuit in these two cases, I realized that my understanding of the "mere presence" rule was too expansive. Neither of these two defendants had been identified by law enforcement as members of the conspiracy during a lengthy investigation prior to their arrests, and both were found for the first time when law enforcement executed search warrants where they were located. In other words, neither had been seen at the scene of any drug transaction, nor had they been heard on the wiretaps which were a part of the evidence in each case. In Mr. Miranda's case, I concluded (wrongly, as it turns out) that the evidence of his participation in the conspiracy was no greater than others who were also in the home at the time of his arrest and who were not ultimately prosecuted by the government. However, I fully accept, understand, and respect the Eleventh Circuit's reversal of my ruling in both cases.

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[1]425 F.3d 953 (11th Cir. 2005).
[2]443 F.3d 824 (11th Cir. 2006).

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Federal Rule of Criminal Procedure 29 allows judges to acquit defendants *before* submitting a case to the jury. I did not use this power given to me under the Rule. I submitted each case to the jury, which allowed the Eleventh Circuit to have available for review both the juries' findings, as well as my written Orders explaining my reasons for setting aside the jury verdict. Having the benefit of the juries' findings, the Eleventh Circuit rejected my reasoning.

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Responses of Jeffrey L. Viken
Nominee to the U.S. District Court for the District of South Dakota
to the Written Questions of Senator Tom Coburn, M.D.

1. **President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."**

   a. **Do you agree with President Obama's quote?**

      Response: President Obama's quote describes some of the characteristics he values in selecting judicial nominees. His constitutional function in nominating Article III judges is different from the function performed by a sitting judge. The constitutional role of a federal district judge is to assess the facts presented by the parties and to respect legal precedent in reaching a decision.

   b. **Do you believe that you fit President Obama's standard as described in his quote?**

      Response: Yes

   c. **What role do you believe that empathy should play in a judge's consideration of a case?**

      Response: A judge's consideration of a case must always be governed by impartiality, evenhandedness, attention to facts presented by the parties, and respect for established law. Empathy is a personal characteristic which may assist a judge in analyzing the human circumstances which bring people before the court. But the law and not the personal experiences of jurists is the path to justice in considering each case

2. **What in your view is the role of a judge?**

   Response: A federal district judge is a public servant. The role of a federal district judge encompasses diligent legal scholarship, a strong work ethic, impartial and dispassionate consideration of proven facts and reasoned legal arguments, fidelity to binding and persuasive precedent, and respect for all who appear before the court.

   a. **How would you define "judicial activism?"**

      Response: This term has been used and interpreted by many people in many contexts in recent political and policy discussions. From my perspective, "judicial activism" means a departure from settled law as established by

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statute or legal precedent for the purpose of reaching a selected outcome on social, political or policy issues.

b. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: The Constitution is interpreted by the United States Supreme Court in its decisions and by Congress through the enactment of legislation. The Constitution is "living" in the sense that it is applied to specific fact patterns presented to the lower courts. Those courts are bound by statutory provisions and by settled constitutional interpretation from the Supreme Court.

c. In *Roper v. Simmons*, Justice Kennedy relied in part on the "evolving standards of decency" to hold that capital punishment for any murderer under age 18 was unconstitutional. Do you agree with Justice Kennedy's ruling? Do you agree with his reasoning?

Response: Justice Kennedy's majority opinion in Roper is settled law. I have not studied the sources Justice Kennedy relied upon in reaching the majority ruling and so have no position on his reasoning.

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Responses of Beverly Baldwin Martin
Nominee to the U.S. Court of Appeals for the Eleventh Circuit
to the Written Questions of Senator Tom Coburn, M.D.

1. **In your questionnaire submitted to the Committee for your 2000 district court nomination, you were asked for your views on judicial activism. You stated:**

"Once a case is properly before a court, a judge is obligated to follow the United States Constitution, statutory law, and the doctrine of stare decisis to adhere to legal precedent. This precept is paramount because it is necessary to the stability of our system for individuals and commercial concerns to find predictability in our judicial system and anticipate what actions are legally permissible. . . ."

a. Do you reaffirm your earlier statements?

Response: Yes. Although I have not reviewed this statement in quite some time, it is a good description of how I have decided cases over the last nine years as a federal trial judge. I will continue to follow this approach if confirmed for a position on the Eleventh Circuit Court of Appeals.

b. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: When interpreting the Constitution, a judge is bound by its words, which do not change or evolve. The text of the Constitution and the binding precedents of the United States Supreme Court and the Eleventh Circuit will control my decisions if I am confirmed.

c. In *Roper v. Simmons*, Justice Kennedy relied in part on the "evolving standards of decency" to hold that capital punishment for any murderer under age 18 was unconstitutional. Do you agree with Justice Kennedy's ruling? Do you agree with his reasoning?

Response: In *Roper v. Simmons*, Justice Kennedy wrote for five of the Justices of the United States Supreme Court. Therefore his ruling constitutes precedent that binds me as a judge on a lower court, and I will follow that precedent.

Justice Kennedy's reasoning in *Roper v. Simmons* resulted in a ruling that constitutes the law of the land, and I will respect and follow this precedent.

d. Do you think it is ever proper for judges to indulge their own values in determining what the law means?

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Response: No. If individual judges decided cases based upon their personal values, there would be no certainty or predictability in our judicial system, and our courts and system of justice could not maintain their legitimacy.

e. If so, under what circumstances.

Response: I do not think it is proper.

2. President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."

a. Do you agree with President Obama's quote?

Response: President Obama has provided this description of what is important to him in carrying out his constitutional role of selecting judges. As a judge, my constitutional role is quite different from that of the President. I decide individual cases that come before me based upon the facts presented by the parties, and the legal precedent that governs the dispute.

b. Do you believe that you fit President Obama's standard as described in his quote?

Response: I make every effort to treat all parties that appear before me with respect, and to carefully consider their legal arguments in the context of the facts of their cases. I do not, however, decide cases based upon my emotions, or sympathies for or against various groups or types of people.

c. What role do you believe that empathy should play in a judge's consideration of a case?

Response: I do not believe that cases should be decided based upon empathy or emotional responses. Rather, each individual case must be decided on its particular facts, as required by binding precedent. It is also true that as a trial judge, I have spent much of my time in the courtroom with the parties litigating cases before me. I believe that it is important to treat them, as well as their lawyers, with respect and consideration, and I try to do so.

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3. **In *United States v. Miranda*,[1] a jury convicted the defendant of conspiring to distribute methamphetamine and cocaine, possession with intent to distribute, and possession of firearms in relation to a drug trafficking crime. The police found the defendant at a home with guns, drugs, and drug paraphernalia. The defendant was present when the police raided the home and ran into a bedroom with two guns and the drug evidence. After the jury found the defendant guilty, you granted the defendant's acquittal motion.**

Likewise, in *United States v. Molina*,[2] the defendant was charged with knowingly participating in a drug trafficking conspiracy and possession of a firearm in furtherance of a drug trafficking crime. The police found the defendant and her common law husband in her bedroom, which contained cocaine and a digital scale. There was a second digital scale and cocaine in her bathroom, a gun and passports in her open nightstand, and a garbage bag and shoebox filled with nearly $300,000 cash in her closet. A jury convicted the defendant of conspiracy to traffic drugs and possession of a firearm in furtherance of drug trafficking. Again, the jury found the defendant guilty and you overturned the jury's finding.

In both cases the Eleventh Circuit reversed, finding there was sufficient evidence and the jury convictions should not have been overturned.

a. Do you still believe it was right to overturn the juries' verdicts in these cases?

Response: I fully accept the ruling of the Eleventh Circuit that there was sufficient evidence for the jury to convict both Mr. Miranda and Ms. Molina.

b. If you were given the chance to handle these cases again, would you have handled them differently? If so, how?

Response: Upon receiving the ruling of the Eleventh Circuit in these two cases, I realized that my understanding of the "mere presence" rule was too expansive. Neither of these two defendants had been identified by law enforcement as members of the conspiracy during a lengthy investigation prior to their arrests, and both were found for the first time when law enforcement executed search warrants where they were located. In other words, neither had been seen at the scene of any drug transaction, nor had they been heard on the wiretaps which were a part of the evidence in each case. In Mr. Miranda's case, I concluded (wrongly, as it turns out) that the evidence of his participation in the conspiracy was no greater than others who were also in the home at the time of his arrest and who were not ultimately prosecuted by the government. However, I fully accept, understand, and respect the Eleventh Circuit's reversal of my ruling in both cases.

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[1]425 F.3d 953 (11th Cir. 2005).
[2]443 F.3d 824 (11th Cir. 2006).

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Federal Rule of Criminal Procedure 29 allows judges to acquit defendants *before* submitting a case to the jury. I did not use this power given to me under the Rule. I submitted each case to the jury, which allowed the Eleventh Circuit to have available for review both the juries' findings, as well as my written Orders explaining my reasons for setting aside the jury verdict. Having the benefit of the juries' findings, the Eleventh Circuit rejected my reasoning.

SUBMISSIONS FOR THE RECORD

AIPLA
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

July 16, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
U.S. Senate
Washington, D.C. 20510

The Honorable Jeff Session
Ranking Member
Committee on the Judiciary
U.S. Senate
Washington, D.C. 20510

Re: Nomination of David J. Kappos as Under Secretary of the Dept. of Commerce for Intellectual Property and Director of the USPTO

Dear Chairman Leahy and Ranking Member Session:

The American Intellectual Property Law Association ("AIPLA") is pleased to submit this letter in response to President Obama's nomination of David J. Kappos for the position of Under Secretary of the Department of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. In addition, AIPLA urges that the Judiciary Committee give this nomination expedited consideration in view of the many pressing domestic and international issues concerning intellectual property.

AIPLA is a national bar association of nearly 16,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

Mr. Kappos has been a member of AIPLA for nearly 20 years and has served as a member of the AIPLA Board of Directors for the last three years. Based on our own experience with him over this period, we know Mr. Kappos to have a rich and varied experience in intellectual property law and policy, and we believe him to be well qualified to serve in the position to which he has been nominated.

Following his graduation in 1983 in Electrical and Computer Engineering from the University of California Davis, Mr. Kappos worked as a Development Engineer at IBM, and has since continued with IBM for some 25 years. He brings an impressive understanding of IT, a skill that is well suited to helping the Patent and Trademark Office continue in its goal to fully electronically integrate all levels of its operation, as well as continuing to work towards better electronic integration of its operations with those of other major foreign IP offices. After several years of engineering experience, he continued his education graduating in 1990 with a law degree from the University of California Berkeley.

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Mr. Kappos is well versed in intellectual property law, and he understands both the prosecution and litigation aspects of patent law. He served at IBM as an intellectual property law attorney in IBM's Storage Division and Litigation Group, and is currently responsible for IBM's patent and trademark portfolios, including protecting and licensing patents, copyrights, trademarks, know-how and company technology throughout the world. Mr. Kappos is also well qualified from the perspective of having had significant administrative and organizational management experience. He has served as IP Law Counsel in IBM Software Group, as Assistant General Counsel in IBM Asia/Pacific, IBM Corporate Counsel and as Assistant General Counsel prior to his current position as Vice President and Assistant General Counsel for IBM Corporation.

AIPLA has conveyed to the Administration that selecting high quality leadership for the United States Patent and Trademark Office ("USPTO") is a critical decision for providing an effective incentive to innovation. We pointed out that a new USPTO Director must be an individual of the highest caliber who is experienced and is a highly respected leader in whom Congress and the community of intellectual property owners, businesses, and international communities can place their full confidence. We believe that Mr. Kappos' experience more than meets this standard.

Beyond obtaining and enforcing IP rights, Mr. Kappos has experience with the U.S. legislative process, with international intellectual property policy, and with the management of a large business with the attendant labor-management issues that inevitably arise. He has testified before Congress on patent reform issues, and has written and spoken widely in Asia, Europe and in the U.S. on a range of intellectual property topics. Mr. Kappos is active and is well regarded in many of the leading intellectual property law associations, and AIPLA has received favorable reports from those with whom we have been in contact in these and/or other organizations concerning his nomination.

For the reasons noted, we believe Mr. Kappos is well suited to serve as Under Secretary of the Department of Commerce for Intellectual Property and Director of the United States Patent Office. In all of our dealings with him, Mr. Kappos has demonstrated not only the depth of experience to be expected from his significant responsibilities in a large and important U.S. corporation, but also an objective appreciation and dedication to the U.S. intellectual property system as a whole.

Respectfully Submitted,



Teresa Stanek Rea
President

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July 27, 2009

The Honorable Harry Reid
Majority Leader
United States Senate
522 Hart Senate Office Building
Washington, DC 20510

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
433 Russell Senate Office Building
Washington, DC 20510

The Honorable Mitch McConnell
Minority Leader
United States Senate
361-A Russell Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
335 Russell Senate Office Building
Washington, DC 20510

Re: Open Letter in Support of the Nomination of Judge Beverly Baldwin Martin to the United States Court of Appeals for the Eleventh Circuit

Dear Majority Leader Reid, Minority Leader McConnell, Chairman Leahy, and Ranking Member Sessions:

We are former law clerks for Judge Beverly Baldwin Martin, and for the reasons highlighted below, we write to offer our wholehearted support for her nomination to the United States Court of Appeals for the Eleventh Circuit.

Judge Martin has been actively engaged with the law for more than 25 years. She has demonstrated her intellect and flexibility as both an attorney trying cases and jurist resolving disputes. Through her varied roles in private practice and public service, which include serving as Assistant Attorney General for the State of Georgia, Assistant United States Attorney and, subsequently, United States Attorney for the Middle District of Georgia, and United States District Judge for the Northern District of Georgia, Judge Martin has gained invaluable insight into the law and our legal system which specially qualifies her to be a federal appellate judge.

In her years of practice, and especially on the federal bench, Judge Martin has always remained faithful to the law. She is not motivated by politics or personal agenda. She never approaches a case with a preconceived outcome. She does not believe herself above precedent. Instead, she regards her role in the legal system with humility borne of her love of this country and the blessings and privileges we enjoy as a result of the integrity of our courts and the rule of

law. She employs her sharp mind to assimilate existing law and apply it to the facts of individual cases as they come before her. Of her law clerks, she asks questions about the law and expects informed answers. She appreciates that her decisions affect lives and businesses, and she strives to "get it right" based on precedent.

In the courtroom, Judge Martin is patient, fair, and firm. She engages litigants with an open mind to be sure that she fully understands their positions. She treats all parties before her with courtesy and respect. The individual *pro se* litigant receives the same time, thought, and effort as a large corporate party. She is an impartial arbiter who understands her role in resolving disputes based on the law.

Judge Martin is also distinctly dedicated to her role as a public servant. The depth of this commitment is difficult to understand until you have worked in Judge Martin's chambers. She works into the evenings and on weekends. She stays on top of her docket to ensure parties' disputes are resolved in a timely manner. She bends her schedule to accommodate litigants, attorneys, and others who appear before her. After a full day on the bench, she continues on the job to prepare for the days ahead. There can be no doubt that she will bring this same level of commitment to the Eleventh Circuit.

On a more personal level, Judge Martin is an individual of the highest integrity who seeks to influence those around her to be likewise. As only one example, in her daily interactions with her law clerks, she works to ensure that her clerks, as future practicing attorneys, understand the importance of honesty, collegiality, and hard work. She solicits her clerks' views and respects their opinions. She asks them to see all sides of a dispute. When the issues are complex, she challenges herself and those around her to learn more about the facts and the law. She leads by example.

Judge Martin also shares joy in the successes of others. She cares deeply about those who work with and for her. She serves as a mentor and community leader. She takes our calls, listens to our concerns, remembers our families, and gives us sound advice.

In sum, having seen the inner workings of Judge Martin's chambers, we believe she is eminently qualified to serve on the Eleventh Circuit Court of Appeals. She will bring to that position the intellect, integrity, compassion, and dignity it deserves.

Respectfully submitted,

/s/ Rebekah B. Kcehowski
Rebekah B. Kcehowski
Law Clerk for Judge Martin, 2002-2003

/s/ Rita Bolt Barker
Rita Bolt Barker
Law Clerk for Judge Martin, 2004-2005

/s/ Guinevere Christmann
Guinevere Christmann
Law Clerk for Judge Martin, 2002-2004

/s/ Walt Davis
Walt Davis
Law Clerk for Judge Martin, 2000-2001

/s/ Josh Dickman
Josh Dickman
Law Clerk for Judge Martin, 2004-2005

/s/ Susan Friedman
Susan Friedman
Law Clerk for Judge Martin, 2005-2006

/s/ Christine Harrington
Christine Harrington
Law Clerk for Judge Martin, 2003-2004

/s/ Christopher J. Kellner
Christopher J. Kellner
Law Clerk for Judge Martin, 2000-2001

/s/ Melissa Mortazavi
Melissa Mortazavi
Law Clerk for Judge Martin, 2006-2007

/s/ George Pence
George Pence
Law Clerk for Judge Martin, 2005-2006

/s/ Bonnie Puckett
Bonnie Puckett
Law Clerk for Judge Martin, 2007-2008

/s/ Alex Sponseller
Alex Sponseller
Law Clerk for Judge Martin, 2000-2002

/s/ Miranda H. Turner
Miranda H. Turner
Law Clerk for Judge Martin, 2007-2008

/s/ James Tysse
James Tysse
Law Clerk for Judge Martin, 2006-2007

cc: Senator Benjamin L. Cardin
Senator Robert P. Casey, Jr.
Senator Saxby Chambliss
Senator Tom Coburn
Senator John Cornyn
Senator Richard J. Durbin
Senator Russell D. Feingold
Senator Dianne Feinstein
Senator Al Franken
Senator Lindsey Graham
Senator Charles E. Grassley
Senator Orrin G. Hatch
Senator Johnny Isakson
Senator Edward E. Kaufman
Senator Amy Klobuchar
Senator Herb Kohl
Senator Jon Kyl
Senator Charles E. Schumer
Senator Arlen Specter
Senator Sheldon Whitehouse

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Statement of David J. Kappos

Nominee for Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

Nomination Hearing before the Senate Judiciary Committee

July 29, 2009

Chairman Leahy, Ranking Member Sessions and distinguished members of the Senate Judiciary Committee, thank you for the opportunity to appear before you today. I am grateful to President Obama and to Secretary Locke for the trust they have placed in me and to you for considering my nomination to serve as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

With me today are my wife, Leslie; my parents, James and Rose Kappos, who have traveled here from their home in California; my uncle and aunt Don and Elaine Bolognese, who have traveled from their home in Vermont; my brother Michael, sisters Joan and Susan, and their families, all of whom have traveled from California; my sister-in-law Lisa Kimball from Massachusetts; my cousins Jeanne Greco and Marisa Bolognese and their families from New York and New Jersey; and my cousin Annie Aft from California.

It is exceptional and humbling under any circumstance to have the chance to serve one's country. But it is particularly so for me as the son and grandson of immigrants -- my father came to this country from Greece and my mother's parents came to the US from Italy. So, the opportunity to be here today is particularly poignant for me, as it is for my family.

If recommended by this Committee and confirmed by the Senate, I look forward to joining Secretary Locke and his team at Commerce in their mission as stewards of American economic growth, job creation and innovation.

I have spent nearly my entire professional career in the field of intellectual property law, and indeed my entire career around technology and innovation. After receiving my education from the University of California system, first in electrical and computer engineering and subsequently in law, I went to work for IBM as an intellectual property law attorney.

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During my career at IBM, I have held intellectual property law positions in nearly all of its business units. I have written and prosecuted patent applications in many technical areas and I have searched the prior art files of the USPTO alongside other patent professionals, including examiners themselves. I have handled many trademark matters in the US and globally. I managed IBM's IP law interests across the Asia-Pacific region, and lived in Japan during that period. Currently and for the past six years, I have served as Vice President and Assistant General Counsel for intellectual property law at IBM's corporate headquarters. In that role, I am responsible for the management of intellectual property interests – patents, trademarks, trade secrets and copyrights – on a worldwide basis. Additionally, I have served in leadership positions in the major professional associations that represent the intellectual property law community in this country and globally, including the Intellectual Property Owners Association and the American Intellectual Property Law Association.

I care passionately about this field and the role intellectual property plays in advancing American innovation. So, it is particularly exciting for me to be considered for the position of Director of the USPTO, an organization that traces its roots to the founding fathers and their understanding that promoting and rewarding innovation is critical to our country's success.

The PTO faces many challenges. Most immediate are those resulting from the current economic downturn, the need for a stable and sustainable funding model, the need to address pendency concerns while preserving and enhancing patent quality, and the imperative to attract and retain skilled personnel at a time of fiscal constraint. Secretary Locke has personally asked me to make it my number one priority to refashion the patent examination process to meet these challenges. In carrying forward this direction, I will focus substantial personal attention within the USPTO. Additional challenges flow from a rapidly globalizing trade environment impacting trademark and patent interests, as well as respect for intellectual property and the consequences where IP is not respected.

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Longer term, the USPTO must keep abreast of the astounding pace of technological change across a broad range of scientific disciplines. It needs to understand new modes of innovation and their effect on its mission. And it will need to constantly rethink how to maintain and enhance the constitutional imperative to promote innovation and scientific advancement for the public good – both in terms of the technology confronting the Office and in terms of leveraging and applying the law to that technology.

I welcome this challenge and pledge to you all of my energy, creativity and intellect should I be confirmed. As I consider this challenge, I am mindful of several things.

I am mindful that the USPTO serves the interests of ALL innovators in this country, small and large, corporate and independent, academic and applied, and -- most importantly -- the public interest. While I have spent my career to date at a large corporate enterprise, I am familiar with the concerns and issues of all USPTO constituents – including small and independent inventors, the venture and start-up community, public interest groups, the patent bar and many others – and will reach out to all of them.

I am mindful of the incredible dedication of the thousands of USPTO employees, and the essential role they play to the success of the US innovation system. I will work every day with the USPTO employees and the unions that represent them to establish strong, positive relationships grounded in professional treatment for these workers producing work product based on professional judgment.

I am acutely mindful that innovation today is global and that IP policy is of paramount importance, not only in our country, but also in the EU and Japan, in China, India, Brazil and many other developing countries. I will use my international experience and my understanding of global IP trends to help this Administration represent , advance, and protect the interests of American innovators in the global arena and to lead the world in developing strong, balanced, inclusive intellectual property systems that advance the well-being of all participants.

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Finally, I am mindful that the office for which I am being considered, working as part of Secretary Locke's team and within the Administration's agenda, must be intensely focused on how to serve the American people at this time of economic uncertainty. I believe the USPTO can play a significant role in enhancing economic growth, creating jobs and advancing American innovation. I hope to play a part in this important mission.

Again, I am grateful for the opportunity to address you today. I am honored by the opportunity to serve and I look forward to joining this Administration and Secretary Locke's team should I be confirmed.

I am pleased to answer any questions.

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United States Senate Committee on the Judiciary

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Statement of

The Honorable Patrick Leahy

United States Senator
Vermont
July 29, 2009

Statement Of Senator Patrick Leahy (D-Vt.),
Chairman, Senate Judiciary Committee
Hearing On Judicial and Executive Nominations
July 29, 2009

Yesterday, the Committee reported the nomination of Judge Sonia Sotomayor to be a Justice on the United States Supreme Court. This morning, we hold our first confirmation hearing for lower court nominees since the Supreme Court vacancy arose in May.

The vacancies throughout the Federal courts have already risen to over 80. In addition, 27 upcoming vacancies have been announced. They will push Federal judicial vacancies over 100. We worked very hard to fill vacancies during the last presidency. When I chaired this Committee and we had a President of the other party in the White House, we were able to reduce overall vacancies by two-thirds, from over 100 down to 34, and to reduce circuit court vacancies to single digits. Despite having received Federal judicial nominees since March from President Obama and despite having held hearings and reported those nominees in June, not a single Federal judge has been confirmed by the Senate all year. The Senate must do better.

Both the judicial nominations we consider today come to us with bipartisan support. President Obama's nomination of Judge Beverly Martin, to be elevated from the U.S. District Court for the Northern District of Georgia to the 11th Circuit, has the support of Georgia's Senators, Senator Chambliss and Senator Isakson. Jeffrey Viken, nominated to serve on the U.S. District Court for the District of South Dakota, has the support of South Dakota's senior Senator, Senator Johnson, and Senator Thune.

Judge Martin is the fourth of President Obama's circuit court nominees to come before the Committee and the fourth with extensive experience as a well-respected Federal district court judge. When her nomination came before the Senate in 2000, it had the support of Senator Max Cleland, a Democrat, and Republican Senator Paul Coverdell, a Republican. Since her confirmation, she has managed a docket of 3,100 cases. Her nomination to the circuit court is rated unanimously "well qualified" by the ABA Standing Committee on the Federal Judiciary. Before becoming a Federal judge she had served as the U.S. Attorney for the Middle District of Georgia, as an Assistant U.S. Attorney in that office and as an Assistant Attorney General in the Office of the Attorney General of Georgia.

Jeffery Viken's wide-ranging experience makes him particularly qualified to serve as a judge on the U.S. District Court for the District of South Dakota. He is currently the Federal Defender for the combined districts of North Dakota and South Dakota. He spent more than two decades at a South Dakota law firm and, before that, he served the District of South Dakota as its Acting U.S. Attorney and as an Assistant U.S. Attorney.

I am also pleased to include in today's hearing the nomination of David Kappos to be Director of the U.S. Patent and Trademark Office and Under Secretary of Commerce for Intellectual Property. He is a nominee who is well respected on both sides of the aisle and in all parts of the intellectual property community.

Mr. Kappos is no stranger to the members of this Committee. He testified earlier this year with regard to patent reform legislation. Coalitions on all sides of that debate have applauded the nomination of Mr. Kappos.

The PTO needs strong and accountable leadership. It has a significant backlog of applications and faces

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serious challenges as a result of the difficult economic environment. All of us who have been deeply involved in the patent reform effort share an interest in improving patent quality and reducing the backlog.

I look forward to working with Mr. Kappos, once he is confirmed, on patent reform legislation that will improve and modernize the statutory framework for our patent system. Ultimately, patent quality begins at the PTO and requires effective leadership. I am pleased that the President has nominated someone for this position with strong qualifications and ability.

I hope the hearing today can mark a new start in cooperating to fill vacancies. Republican objections have prevented the Senate from confirming nominees reported by the Judiciary Committee for over two months, since May 12. There are currently 17 nominees reported by the Judiciary Committee pending on the Executive Calendar. A dozen have been stalled on the Senate Executive Calendar since before the July 4th recess. The pending nominations include five U. S. Attorneys, four Assistant Attorneys General and the Chairman of the United States Sentencing Commission. I would urge the Senate Republican leadership to work with us to clear those nominations for confirmation before the extended August recess.

I am pleased to welcome our nominees and their families to the Committee today and I look forward to our considering these nominations.

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Intellectual Property Owners Association

President
Steven W. Miller
Procter & Gamble Co.
Vice President
David J. Kappos
IBM Corp.
Treasurer
Douglas K. Norman
Eli Lilly and Co.

Directors
Marc S. Adler
Immediate Past President
Angelo N. Chaclas
Pitney Bowes Inc.
William J. Coughlin
Ford Global Technologies LLC
Timothy Crean
SAP AG
Robert DeBerardine
Sanofi-Aventis
Bart Eppenauer
Microsoft Corp.
Scott M. Frank
AT&T
Michael L. Glenn
Dow Chemical Co.
Roger Gobrogge
Dow Corning Corp.
Bernard J. Graves, Jr.
Eastman Chemical Co.
Krish Gupta
EMC Corporation
Jack E. Haken
Koninklijke Philips Electronics N.V.
Dennis R. Hoerner, Jr.
Monsanto Co.
Carl B. Horton
General Electric Co.
Soonhee Jang
Danisco U.S., Inc.
Philip S. Johnson
Johnson & Johnson
George William Johnston
Hoffmann-La Roche Inc.
Dean Kamen
DEKA Research & Development Corporation
Charles M. Kinzig
GlaxoSmithKline
David J. Kappos
Shell International B.V.
Noreen A. Krall
Sun Microsystems, Inc.
Michelle Lee
Google Inc.
William C. Lee, III
Coca-Cola Co.
Kevin Light
Hewlett-Packard Co.
Richard J. Lutton, Jr.
Apple, Inc.
Jonathan P. Meyer
Motorola, Inc.
Jeffrey L. Myers
Adobe Systems Inc.
Sean O'Brien
United Technologies, Corp.
Richard F. Phillips
Exxon Mobil Corp.
Kevin H. Rhodes
3M Innovative Properties Co.
Peter C. Richardson
Pfizer, Inc.
Mark L. Rodgers
Air Products & Chemicals, Inc.
Robert R. Schroeder
Mars Incorporated
Suzanne M. Sherma
ZymoGenetics, Inc.
David Simon
Intel Corp.
Dennis C. Skarven
Caterpillar, Inc.
Russ Slifer
Micron Technology, Inc.
Wayne Sobon
Accenture Ltd.
Daniel J. Staudt
Siemens Corp.
Brian K. Stierwalt
ConocoPhillips
Thierry Sueur
Air Liquide
James J. Trussell
BP America, Inc.
Michael Walker
DuPont
Stuart Watt
Amgen, Inc.
William D. Zahrt, II
Seagate Technology, LLC

General Counsel
Eve H. Davis
Kirkland and Ellis, LLP

Executive Director
Herbert C. Wamsley

July 8, 2009

The Honorable Patrick Leahy
Chairman
224 Dirksen Office Building
Committee on the Judiciary
United States Senate
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
152 Dirksen Office Building
Committee on the Judiciary
United States Senate
Washington, DC 20510

RE: Confirmation Hearing on Director of the USPTO

Dear Senators Leahy and Sessions:

We write to urge you to schedule a hearing as soon as possible on David J. Kappos, the President's nominee for Undersecretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office (USPTO). The USPTO continues to face record backlogs and many other challenges hindering effective processing of patent applications. It is critical for new management to be put in place as soon as possible to address these challenges.

IPO, established in 1972, is a trade association representing companies, individuals, law firms and others who own or are interested in patents, trademarks, copyrights and trade secrets. Our members include a broad spectrum of more than 150 large and mid-size companies in industries ranging from information technology to consumer products to pharmaceuticals and biotechnology. Our 50-member Board of Directors seeks to balance the views of these varied interests when expressing positions on legislative, judicial and agency issues.

Mr. Kappos has an exceptional record in intellectual property law and significant experience in industry as a manager. He has worked within IPO and other associations to improve IP practice and communications with the USPTO. He meets all the qualifications that IPO set out recently in letters to the Obama Administration for the position for which he has been nominated.

Thank you for your efforts to improve the USPTO and your swift action on this nominee.

Sincerely,

Steven W. Miller
President

1501 M Street, NW, Suite 1150 ◦ Washington, DC 20005
T: 202-507-4500 ◦ F: 202-507-4501 ◦ E: info@ipo.org ◦ W: www.ipo.org

TESSERA

Henry R. Nothhaft
President and Chief Executive Officer

June 22, 2009

Senator Patrick J. Leahy
Chairman
Committee on the Judiciary
SD-224
United States Senate
Washington, D.C. 20510

Senator Jeff Sessions
Ranking Member
Committee on the Judiciary
SD-152
United States Senate
Washington, D.C. 20510

Dear Chairman Leahy and Sen. Sessions

I am writing to share my support for President Obama's appointment of David Kappos as the new Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office and to offer some thoughts about the considerable challenges he faces.

Mr. Kappos brings to the position a wealth of experience and knowledge. We expect he will make a fine Director and we look forward to working with him to advance the interests of our nation's innovators by helping make the USPTO the agency it should be.

At Tessera, we invest in and develop technologies that enable new levels of innovation in electronics, optics and imaging. Accordingly, the effective leadership and management of the USPTO are of significant importance to us.

More importantly, the patent office is a vital cog in our nation's great economic engine. Its work is essential in protecting U.S. innovation across the globe. Yet the office is underfunded, overburdened, and faces huge hurdles in hiring and retention. We are hopeful that Mr. Kappos can quickly address these issues to further strengthen the USPTO. As Secretary of Commerce Gary Locke acknowledged in his statement announcing Mr. Kappos' nomination, "Kappos will take control of an office . . . [that] continues to deal with a patent application backlog of more than 770,000, long and uneven waiting periods for patent review, information technology systems that are regarded as outdated and an application process in need of reform."

These are significant problems that, we hope, the Committee will work with Mr. Kappos to address. Mr. Kappos and Congress need not look far for solutions. Congress created the Patent Public Advisory Committee (PPAC) to advise it on how to improve the USPTO. This group of very bright and talented people has spent considerable time and

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energy examining the office's strengths and weaknesses and has, for some time now, been pressing the USPTO to implement a number of administrative and technology initiatives. We believe PPAC's recommendations should be examined by the Committee and that Mr. Kappos, at his confirmation hearing, should be asked about his willingness to implement them.

We believe the following recommendations are essential to improving the office:

- Provide better funding. The patent office has a budget of approximately $1.9 billion, all of it obtained through fees from applicants. In the past, Congress has diverted money from the USPTO, and that lack of funding has continued to hamper operations. Congress needs to adequately ensure funding for the office and adopt rules that prevent fee diversion and incentivize the issuance of quality patents.

- Adopt a market-driven model. It currently takes an average of 32 months from the filing of a patent to issuance or abandonment. Something is amiss when it takes nearly three years to get a ruling on a patent. The USPTO needs to adopt a new fee structure – one that takes into account the increasing complexity of many patent applications, particularly those involving technology. Higher fees also could be charged for ruling more quickly on patents.

- Improve the technology infrastructure. The USPTO desperately needs better technology to enable patent examiners to do their jobs more efficiently. For example, an improved IT infrastructure would allow examiners to quickly search data from around the world.

- Re-evaluate guidelines for patent applications. Applications currently run the gamut, from trivial and sparse to dense and complicated. The USPTO can weed out frivolous patents by being more proactive in conducting interviews with applicants as part of the process. But it must protect all innovators, large and small alike, when revising rules. The USPTO should not create rules that unfairly benefit those entities with the deepest pockets.

- Attract and retain a high-quality workforce. Patent examiners have been, and need to continue to be, smart, with strong aptitudes in science and/or engineering. But there are innumerable challenges in attracting and retaining smart people to be patent examiners. Today, nearly all patent examiners work at or near the USPTO offices in Alexandria, Virginia, which severely limits the office's ability to attract talent. The USPTO needs to broaden its footprint to attract a more geographically dispersed and diverse workforce – for instance, by establishing virtual regional offices. The USPTO also needs to seek out older workers who may have retired from their respective fields, but retain more technology knowledge than recent college graduates. Also, the USPTO should work more closely with universities to train students to become patent examiners. We strongly support PPAC's

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proposal that the USPTO offer loans to engineering students that would be forgiven over time if the student goes to work at the patent office.

Although no one set of recommendations is exhaustive or undeserving of modification, we believe what I have outlined above serve as a sound starting point for discussion. We urge the Congress to do everything in its power to help Mr. Kappos, if confirmed, set clear goals for the office and provide him the support necessary to achieve them. Again, we support the appointment of Mr. Kappos to head the USPTO and appreciate your willingness to consider our views.

Sincerely,

Henry "Hank" Nothhaft
President and Chief Executive Officer
Tessera

NOMINATIONS OF JOSEPH A. GREENAWAY, NOMINEE TO BE U.S. CIRCUIT COURT JUDGE FOR THE THIRD CIRCUIT; ROBERTO A. LANGE, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE DISTRICT OF SOUTH DAKOTA; IRENE CORNELIA BERGER, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE SOUTHERN DISTRICT OF WEST VIRGINIA; CHARLENE EDWARDS HONEYWELL, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE MIDDLE DISTRICT OF FLORIDA; IGNACIA S. MORENO, NOMINEE TO BE ASSISTANT ATTORNEY GENERAL, ENVIRONMENT AND NATIONAL RESOURCES DIVISION, DEPARTMENT OF JUSTICE

WEDNESDAY, SEPTEMBER 9, 2009

U.S. SENATE,
COMMITTEE ON THE JUDICIARY,
Washington, DC

The Committee met, Pursuant to notice, at 2:34 p.m., Room 226, Dirksen Senate Office Building, Hon. Sheldon Whitehouse presiding.

Present: Senators Klobuchar, Franken, and Sessions.

OPENING STATEMENT OF HON. SHELDON WHITEHOUSE, A U.S. SENATOR FROM THE STATE OF RHODE ISLAND

Senator WHITEHOUSE. The hearing will come to order.

Today we will consider four nominations to the Federal bench. Judge Joseph Greenaway has been nominated to the United States Court of Appeals for the Third Circuit; Roberto Lange has been nominated to the United States District Court for the District of South Dakota; Judge Irene Berger has been nominated to the United States District Court for the Southern District of West Virginia; and Judge Charlene Honeywell has been nominated to the United States District Court for the Middle District of Florida. We also will consider the nomination of Ignacia S. Moreno, to be Assistant Attorney General for the Environment and Natural Resources Division at the Department of Justice.

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I understand that the Ranking Member, Senator Sessions, is on his way here and will be joining us shortly, but I would like to take this moment to welcome each of the nominees, and their families, and their friends to the U.S. Senate.

I also, of course, would like to welcome those of my colleagues who are here to introduce the nominees. This Committee is graced by the presence of such a distinguished array of my colleagues.

In the interest of efficiency, let me outline how this hearing will proceed. If the Ranking Member arrives and wishes to make remarks, we will accommodate him at this point. At the conclusion of my remarks, if he is not here, I will allow the introductions by the home State Senators to begin. Their introductions will proceed in order of seniority, and each will have the chance to introduce the nominees for their States.

We then will have two panels. The first panel will be Judge Greenaway, and the second will be all the remaining nominees. Senators on the Committee will have 5-minute rounds in which to question each panel.

Without the Ranking Member here, I ask unanimous consent that the remainder of my opening statement be put into the record so that I do not delay my colleagues any longer, and we will begin with the introduction of Judge Berger by the distinguished Senator from the State of West Virginia, the Honorable Jay Rockefeller.

Senator Rockefeller.

[The prepared statement of Senator Whitehouse appears as a submission for the record.]

PRESENTATION OF IRENE CORNELIA BERGER, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE SOUTHERN DISTRICT OF WEST VIRGINIA, BY HON. JOHN D. ROCKEFELLER, IV, A U.S. SENATOR FROM THE STATE OF WEST VIRGINIA

Senator ROCKEFELLER. Thank you, Mr. Chairman, very much. I would point out to Judge Berger, who I am about to talk about, that Senator Sheldon Whitehouse is one of the people that you need to know. He's brilliant. He's a wonderful lawyer, he's a wonderful person. He gives great advice on what books to read, and he's somebody you can trust.

And that, I would say to the distinguished Chairman, is what Judge Irene Berger is all about. Yes, she is being nominated to the—has been nominated to serve in the U.S. District Court of Southern West Virginia, but you can't leave that statement alone. She comes from a very large family, and her husband David and a lot of her relatives are here, scattered behind me. David is right here. She comes from a family, a large family, in one of the four poorest counties in the United States of America.

Rather than coming up, going through law school, serving for 30 years for the people of West Virginia in a calm, deliberate, marvelous way and being kind of proud about just everything she is and talking about a lot, no. She is the ultimately quiet, fair, dispassionate, rational judge.

I have to say that I had the honor to present Judge Pierre Lavalle, and that was one of the happiest days of my life. This is also one of the happiest days of my life because I think Judge Irene Berger is unmatched in her professionalism, in her experience.

And above all, in this question of temperament, I've never heard her—I've seen her—over many years I've known her, I've seen her in all kinds of situations. She's always the same. She's always smart. She has—all the Circuit Court judges from West Virginia who are on the Fourth Circuit and elsewhere, et cetera, rave about her. And she's been waiting, but she's not been promoting herself. She simply does her job in a classic, stoic, strong, heartfelt, and ultimately brilliant Southern West Virginia way.

It's not easy, always, to be from West Virginia. It's not always easy to be a judge from Southern West Virginia, or other parts of West Virginia. It's a very active, aggressive, sometimes angry State. But nothing seems to affect Judge Irene Berger except superb judgment, confidence in herself, pride in what she's done, but all quiet, all measured. She is a superb person.

Go to her for counsel on anything. She doesn't play like, I'm a judge, or I'm about to be a judge at a higher level. She doesn't play that at all. She's just who she is and who she's always been. And you don't run into that often. People in this business, when it comes to judgeships, often want them, grasp for them, work for them, plot for them, and often get them. That's not her way. She is thrilled to have this opportunity, and I just want her to know how happy I am to be able to be a part in helping her to become the judgeship that she seeks.

I thank the Chairman.

Senator WHITEHOUSE. Thank you, Mr. Chairman. We are honored to have you here. We very much appreciate your remarks on behalf of Judge Berger.

Senator ROCKEFELLER. Oh. Also, I want—Senator Byrd couldn't be here today and he has a very strong statement about Judge Berger, and I ask——

Senator WHITEHOUSE. It will be accepted into the record without objection. I thank the Senator.

[The prepared statement of Senator Byrd appears as a submission for the record.]

Senator WHITEHOUSE. Next in order of seniority is Senator Tim Johnson, who is here to speak on behalf of Roberto Lange.

Senator Johnson.

PRESENTATION OF ROBERTO A. LANGE, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE DISTRICT OF SOUTH DAKOTA, BY HON. TIM JOHNSON, A U.S. SENATOR FROM THE STATE OF SOUTH DAKOTA

Senator JOHNSON. Good afternoon. Thank you, Mr. Chairman and members of the Committee. It is my good pleasure to be here this afternoon to introduce Roberto Lange to the Committee. President Obama has nominated Bob to be a Federal judge for our home State of South Dakota.

Bob attended the University of South Dakota, my alma mater, and attended Northwestern University School of Law in Chicago. He was an editor of the Law Review and graduated Order of the Coif.

We are very fortunate to have such a distinguished member of the South Dakota legal community nominated to this post. After

more than 20 years of practicing law, Bob is well-qualified for the position of U.S. District Judge for South Dakota.

Ironically, Bob has clerked for the very same judgeship that he is now the nominee for. While there are many rewards for public service, there are also many challenges. Thus, I would like to thank Bob for his past and future service for the people of South Dakota. Thank you for your consideration of this nominee.

Senator WHITEHOUSE. Thank you, Senator Johnson. I appreciate very much that you have been here to speak on behalf of Mr. Lange.

Our next speaker is Senator Bill Nelson of Florida, speaking on behalf of Judge Honeywell.

Senator Nelson.

PRESENTATION OF CHARLENE EDWARDS HONEYWELL, NOMINEE TO BE U.S. DISTRICT JUDGE FOR THE MIDDLE DISTICT OF FLORIDA, BY HON. BILL NELSON, A U.S. SENATOR FROM THE STATE OF FLORIDA

Senator NELSON. You know, Mr. Chairman, this seniority thing is quite interesting because Senator Lautenberg retired for a little over a year and a half, and he gets bumped to the bottom. Now Senator Menendez is the senior Senator from New Jersey.

Senator WHITEHOUSE. The other way around.

Senator NELSON. I see.

Well, I'm here on behalf of Judge Charlene Honeywell of Tampa, and it's for a judgeship in the Middle District of Florida.

She graduated from Howard University and then from the University of Florida College of Law. Mr. Chairman, that's the University of Florida. They happen to be the national champion, Florida Gators.

Judge Honeywell has had a distinguished record. And it's obvious that we select our judges by going through a panel that Senator Martinez and I nominate, called a Judicial Nominating Commission, made up of very prominent people throughout Florida. They do all of the hard work, the investigation, receiving the applications and the interviews. For as many qualified candidates as we get, they boil it down to three and send those three to Senator Martinez and me, and we do our interviews in the process then. We consult with the White House. All of that process of winnowing, vetting, narrowing has produced the cream to the top, and that's Judge Honeywell.

After she had graduated from law school, she was first a public defender in two different judicial circuits in Florida. She's been an assistant city attorney. She's been in private practice with one of Tampa's most distinguished law firms and then she has kept all of that career with being one of our State court judges in what we call our Circuit Court in Florida.

So it is Senator Martinez and my privilege to be here, and I speak on his behalf. I don't know if he has actually officially resigned. He just gave his farewell speech. I think, as of this moment, he is still Senator. So I can tell you, he certainly speaks through me today and the two of us encourage the Committee to approve Judge Honeywell.

Thank you, Mr. Chairman.

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Senator WHITEHOUSE. Thank you very much, Senator Nelson.

And our last speakers, in order of seniority: Senator Lautenberg, and then Senator Menendez of New Jersey, speaking on behalf of Judge Greenaway.

Senator Lautenberg.

PRESENTATION OF JOSEPH A. GREENAWAY, NOMINEE TO BE U.S. CIRCUIT COURT JUDGE FOR THE THIRD CIRCUIT, BY HON. FRANK R. LAUTENBERG, A U.S. SENATOR FROM THE STATE OF NEW JERSEY

Senator LAUTENBERG. Thank you very much, Mr. Chairman and the Ranking Member of the Committee, Senator Sessions, members of the Committee, for the opportunity to be here today to present a fellow Columbia University graduate—obviously not in the same class year.

[Laughter.]

Senator LAUTENBERG. Why is there such a snicker going through?

[Laughter.]

Senator LAUTENBERG. One of New Jersey's most distinguished public servants, Judge Joseph Greenaway.

On the District Court in Newark, Judge Greenaway has demonstrated his core values of integrity and fairness, the same values that will make him a success on the Third Circuit Court of Appeals. Through his impressive career, I've been fortunate enough to watch Judge Greenaway at work for our State and our people.

Judge Greenaway became an Assistant U.S. Attorney in Newark in 1985. He first served in the Criminal Division, where he worked on bank fraud and white collar crime investigations. In 1989, he was promoted to head the division dedicated to prosecuting narcotics cases. From 1990 to 1996, Judge Greenaway served as an in-house counsel for Johnson & Johnson, a prominent pharmaceutical company in New Brunswick, one of New Jersey's great companies. Then in 1996, Judge Greenaway was appointed by President Clinton to the United States District Court for the District of New Jersey, where he has since served.

Now, I introduced him to this Committee at that time, as I am today, and I do it with great enthusiasm. The best thing about Judge Greenaway is that, despite his critical and time-consuming responsibilities in the court, he still finds time to give back to the community. He teaches criminal law, criminal trial practice classes at Cardozo Law School, where I sit now as an honorary board member, as I was on that board for some time. He helps train the next generation of legal thinkers and leaders.

Judge Greenaway also teaches a course about Supreme Court at both Cardozo Law School and Columbia University. He spent his career protecting New Jerseyans and their rights, and I know that we can depend on him to do the same for our Nation as an Appeals Court judge.

I am pleased that President Obama has selected Judge Greenaway for this post and I urge my colleagues to support his confirmation.

Before introducing his family, I want to say that I was honored to have a courthouse carry my name during my absence from the

Senate, and I authored something to be posted on the plaque that carries the name. I said on that plaque, "The full measure of a democracy is its dispensation of justice", and I can't think of anyone who fills that obligation better than Judge Joe Greenaway.

Now I want to recognize Judge Greenaway's wife, Veronica Blake Greenaway, his son Joseph, his daughter Samantha, and his parents as well. We all know that he would not be here today without your love and support.

Mr. Chairman, I thank you for the opportunity to testify at this time.

Senator WHITEHOUSE. Thank you, Senator Lautenberg.

Senator Menendez.

PRESENTATION OF JOSEPH A. GREENAWAY, NOMINEE TO BE U.S. CIRCUIT COURT JUDGE FOR THE THIRD CIRCUIT, BY HON. ROBERT MENENDEZ, A U.S. SENATOR FROM THE STATE OF NEW JERSEY

Senator MENENDEZ. Thank you, Mr. Chairman, to the distinguished Ranking Member, to all the distinguished members of the Committee. I am pleased to join my colleague in the Senate, Senator Lautenberg, and to have the pleasure and honor to come before the Committee today to introduce a man from New Jersey who fully embodies the qualities of respect for justice and the rule of law we demand of all of our judges.

At the age of 40, Judge Joseph Greenaway, Jr. was appointed by President Clinton to the Federal bench and he has served for over a dozen years with distinction. He earned a bachelor of arts from Columbia University, where he was honored in 1997 with the Columbia University Medal of Excellence and with the John Jay. Award in 2003.

He was an Earl Warren Legal Scholar at Harvard University, where he received his J.D. and served as a member of the Harvard Civil Rights and Civil Liberties Law Review. He clerked for the late Honorable Vincent L. Broderick in the U.S. District Court for the Southern District of New York before he became an Assistant U.S. Attorney in Newark and received a promotion to become chief of the Narcotics Bureau.

In the private sector, he was an associate with the firm of Kramer, Levin, Nessen, Kamin & Frankel, and served at Johnson & Johnson, as Senator Lautenberg said, as their in-house counsel.

He is chair emeritus of the Columbia College Black Alumni Council. He has been an adjunct professor at my alma mater, Rutgers Law School. He is an adjunct professor at the Cardozo School of Law, where he teaches a course on trial practice and a seminar on the Supreme Court. He is also an adjunct at Columbia College, where he teaches a seminar on the Supreme Court.

But that is Judge Greenaway's resume. It is a distinguished resume, to say the least. It also is one that I'm sure, through your questions, you will find a judge who has the demeanor, the intellect, the integrity, the deference to the rule of law as well as to precedent, and you'll get those from your questions. But it does not do justice to Judge Greenaway the man.

There is an inscription, Mr. Chairman, over the Tenth Street entrance to the U.S. Department of Justice, just a few blocks from

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here. That inscription says, "Justice in the life and conduct of the state is possible only as first it resides in the hearts and souls of men."

So, Mr. Chairman, I can tell you, those true qualities of justice do indeed reside in the heart and soul of Judge Greenaway. He was born in London, grew up in Harlem, in the northeast Bronx, not far from where Justice Sotomayor grew up, and just across the river from where I grew up.

He is accomplished and successful, but he's given a lot back. In 2006, when he spoke at the Benjamin Cardozo School of Law Yeshiva, Dean David Rudenstein said then, "Judge Greenaway has been a generous teacher and mentor to Cardozo students throughout the years and has touched many of their lives in meaningful ways. I'm delighted that our graduates will have the opportunity to hear his insights, witness his humaneness, and be inspired by his example."

Judge Greenaway, who long taught master classes at Yeshiva, has always been instrumental in mentoring students and graduates, often taking them under his wing as law clerks or fellows.

He has said, "I tell my students to work hard and work smart. Our profession requires a drive to search for perfection. Without that goal, mediocrity becomes the norm." Well, mediocrity has never, and never will be, the norm for Judge Greenaway. He has always strived for excellence and he's always taught young lawyers to do the same.

So in conclusion, Mr. Chairman, members of the Committee, when we look to our courts to dispense justice fairly, honorably, equally under the law, we look to those among us who have worked hard not only for themselves, but for the betterment of the community as a whole. We look to those who have achieved much, but whose humility allows them to take the long view, to see the whole board, and act accordingly. Judge Joseph Greenaway is that kind of judge, the kind of person we look to when we think of the notion of equal dispensation of justice under law.

It is my pleasure to join Senator Lautenberg in introducing him to the Committee and thank him for his service to New Jersey. I know that I join with all of you in wishing him and his wife Veronica, his son Joseph, and his daughter Samantha good luck and godspeed on this next journey in life.

Mr. Chairman, I appreciate your opportunity to make this presentation. I urge the Committee to recommend favorable action and a speedy confirmation to the Third Circuit Court of Appeals.

Senator WHITEHOUSE. I thank you, Senator Menendez. I thank all of my colleagues who have taken the trouble, from extremely busy schedules, to come here today and speak on behalf of these candidates. The constitutional prerogative of advice and consent and the Senate tradition requiring the approval of the home State Senators for judicial appointments, I think, lead to wonderful consequences for America in the caliber of the appointees who are brought forward and the requirement that they meet the confidence of their home State Senators in order to achieve these lifetime appointments. So in coming before us as you have, you are, I believe, acting in the finest traditions of the U.S. Senate, and I appreciate that you took the trouble to do so. The panel is excused.

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If the distinguished Ranking Member would like to make an opening statement, I would invite him to do so when the situation settles down in a moment. After that, we will call up Judge Greenaway first.

STATEMENT OF HON. JEFF SESSIONS, A U.S. SENATOR FROM THE STATE OF ALABAMA

Senator SESSIONS. Mr. Chairman, I thank you for this opportunity. It is a part of our congressional responsibility, a senatorial constitutional requirement that we examine nominees for the bench. We hope and look forward to a good group of nominations from this administration.

I think the Senators that just testified being strong in their support for these nominees is always most meaningful to me, and I think the other Senators—to the nominees, I think that will stand you in good stead to have their firm and vigorous support. I think it will definitely make a difference in how those confirmation hearings go.

We do have some disagreements, I think, about the role of courts and how they should conduct themselves in America today, sort of a national discussion about, to what extent judges are bound by the law and to what extent they feel that they are empowered to allow their personal feelings or approaches to law affect how they decide cases. So I think that's something that is very important to me and we'll ask about it, but all in all, I think the nominees that we're seeing here today that will be before us have good records, and I look forward to examining them.

Senator WHITEHOUSE. I thank the very distinguished Ranking Member.

I would now ask the Honorable Joseph Greenaway to come forward.

[Whereupon, the nominee was duly sworn.]

Senator WHITEHOUSE. Please be seated, and welcome.

Do you have an opening statement? If you would be good enough to turn on your microphone, that would help. You are most welcome to introduce your family who are here with you in addition to making some opening remarks, if you would care to do so.

STATEMENT OF HON. JOSEPH A. GREENAWAY, TO BE U.S. CIRCUIT COURT JUDGE FOR THE THIRD CIRCUIT

Judge GREENAWAY. Well, thank you so much, Mr. Chairman.

The first remark I'd like to make is to thank God for his grace and countenance that I'm here today. I'd like to thank President Obama for his confidence in me with regard to this nomination. I'd like to thank Senators Lautenberg and Menendez, Congressman Payne, and others. I'd like to thank my family and friends for being here today. I'd also like to thank you, Mr. Chairman, and the Ranking Member and the Committee members who are present as well.

I'd also like to take this opportunity to introduce my family. I'm not going to turn around, because I'm told that that would mean you can't hear me. So behind me is my father, Joseph Greenaway.

Senator WHITEHOUSE. Welcome, sir. We're glad to have you with us. Congratulations on your son's accomplishments.

Judge GREENAWAY. My wife, Veronica Greenaway.

Senator WHITEHOUSE. Wonderful to have you with us.

Judge GREENAWAY. My son, for his second visit. He was six the last time.

[Laughter.]

Judge GREENAWAY. He's a little older now.

Senator WHITEHOUSE. He has grown handsomely since then, Your Honor.

Judge GREENAWAY. Thank you, Mr. Chairman.

My daughter Samantha, who was not here the last time.

Senator WHITEHOUSE. Welcome.

Judge GREENAWAY. My two sisters, Rosemary and Sonia, my brother-in-law Rodney, and Charlotte Rosen, my son's special friend.

[Laughter.]

Judge GREENAWAY. And Mr. Chairman, I'm graced with the presence of many friends, lifelong friends, law clerks and interns who are here for today's proceedings.

Thank you so very much.

Senator WHITEHOUSE. You are most welcome, and we are delighted to have you here. I congratulate you on the quality and extent of your public service to date and hope that a speedy and uneventful confirmation awaits you here.

I would like to ask you the same question that I asked now-Justice Sotomayor when she was before our Committee for confirmation, and that is whether, in your role as an appellate judge, you will respect the role of Congress as representatives of the American people, decide cases based on the law and the facts, not prejudge any case, but listen to every party that comes before the court, respect precedent, and limit yourself to the issues that the court must decide?

Judge GREENAWAY. Let me give you my unequivocal assurance, Mr. Chairman, that with regard to each of those items, that that is exactly what I have been doing and what, if I am confirmed—fortunate enough to be confirmed, I intend to do in the future.

The role of stare decisis in our legal system is critical. I believe in it and I have adhered to it as a District Court judge. I believe that the only basis that cases can be decided on are the law and the facts and not some predetermined notion of what the outcome should be. Clearly, in my work as a District Judge, I have respected the role of Congress in our tripartheid system.

Senator WHITEHOUSE. In the context of your pledge to listen to every party that comes before the court, clearly not every party comes before the court with similar resources. Sometimes parties are represented by enormous law firms, sometimes they're represented by considerable numbers of enormous law firms. Sometimes a party comes before the court with a new lawyer, a solo practitioner, perhaps even a lawyer who is simply having a bad day. What is your view of the judge's role in ensuring that those differences of resources do not interfere with each party's right to a fair trial before the court?

Judge GREENAWAY. Thank you, Mr. Chairman. I believe that the role of the judge, when there's an inequity in resources, an inequity in legal talent, as you've alluded to in your question, is frankly con-

fined. I don't believe that the role of a district judge or a circuit judge is to sort of try to even things out. I've had cases where a solo practitioner is up against a massive law firm and, frankly, outdoes them quite nicely.

I know in our own district, some of our CJA counsel are among the best lawyers available in the State. I think that if a judge were to say, you know, I'm not sure things are evened out so I'm going to call this one this way to kind of even things out, I think that that kind of interference or intrusion into the system is one that is ill-advised.

I haven't followed that, and I would not want to in the future. I do believe that all people who appear before me, those with limited resources and those with unlimited resources, deserve fair treatment. I have done that. If confirmed, I would continue to do that. I believe that is the only role that a judge can play, to play it down the middle and call it as you see it.

Senator WHITEHOUSE. Finally, Your Honor, the Constitution embodies eternal principles that may be at odds with popular conventions or passions of the time and substantial societal expectations may have grown around those conventions or passions by the time a matter comes before the court.

You may find yourself in a situation in which you find that the eternal principles of the Constitution, if applied properly, are actually disruptive of certain expectations and certain settled practices, and perhaps even certain interests. Do you feel any hesitancy, when the facts and the law and the principles of the Constitution so direct, to disrupt those conventions or practices that have settled around those popular passions?

Judge GREENAWAY. Well, Mr. Chairman, I believe that the beauty of the Constitution is its enduring quality. I also believe that the prescience of the Founding Fathers was in giving Federal judges lifetime tenure so that in those instances that you've alluded to, those times when difficult decisions have to be made so that judges act in conformity with the Constitution rather than public opinion, those decisions can be made without fear of retribution.

I do believe that the Constitution of the United States is a wonderfully constructed document. It is one that I enjoy reading. I believe that it is important to apply. I think that public opinion on particular issues comes and goes, but I think that the fact that that endures and that it is difficult, under our constitutional system of government, for amendments to be made speaks to the fact that the Constitution, for whatever foibles people may have with or see in it, should be followed.

Senator WHITEHOUSE. I thank you. My time has expired.

I'd call on the distinguished Ranking Member.

Senator SESSIONS. Thank you, Mr. Chairman.

Judge Greenaway, it's a pleasure to be with you. I think you showed some admirable humility in your opening statement, thanking the President and God for your opportunity to serve in this august position. Some people get on the bench and they think they are anointed rather than appointed, as they say.

[Laughter.]

Judge GREENAWAY. Not I, sir.

Senator SESSIONS. A little humility doesn't hurt for somebody who's got a lifetime appointment and we can't vote you out of office. But you have a lot of good friends, a lot of firm recommendations, and both of your Senators are very supportive.

I remember, really before I came here, my staff has found a statement you made last time, when you were up for confirmation, that "judicial activism is a practice that goes beyond the bounds of permissible jurisprudence, as set forth in the Constitution. In my view, engaging in such activism requires a jurist to begin the journey down the proverbial slippery slope. Once down that path, stare decisis and the Constitution fall prey to that judge's perceptions, prejudices, and predilections. This approach is antithetical to the intent of the framers of the Constitution and results in haphazard decisionmaking."

You go on to say, "A Federal judge cannot impose his or her own views on what the law should be as if sitting as a super-legislature. In theory and practice, judicial opinions must be measured and guided by precedent and the Constitution. Judges must limit themselves to the parameters permissible within the larger constitutional scheme."

So I guess I like that.

Judge GREENAWAY. Thank you very much, Senator.

Senator SESSIONS. Do you still believe that?

Judge GREENAWAY. Absolutely, sir.

Senator SESSIONS. You made a speech, a lecture entitled, "Judicial Decision-Making in the External Environment". You said that "the external environment consists of the political, social, intellectual, and other forces that influence and affect our judiciary and its decisionmaking. Although the public may believe that judges make their ruling in a vacuum, they clearly do not. Not only does each member of the judiciary come to the bench with a different set of experiences, but our environment affects each judge differently as well."

Then you note that Justice Black, who ruled in the Japanese detention case, the *Koramatsu* case, was "undoubtedly influenced by several factors outside the record, such as his own military career, the fact that his sons were in World War II, and his friendship with General DeWitt." I guess I think, as I read those remarks, you seemed to criticize Black for allowing those things to cause him to not be sensitive to the constitutional rights of the people, the Japanese citizens, who were interned. Is that correct?

Judge GREENAWAY. Well, Senator, I think that—well, first of all, you quoted me absolutely accurately. I think that my point in that article was that, No. 1, we had suspect classifications involved. No. 2, we were talking about probably one of the most egregious violations of an entire subgroup of Americans in our Nation's history. No. 3, there was a real lack of evidence brought before the President before he acted, and the court before it acted.

In looking at Koramatsu critically, my view was, if we're going to—if we as a society, and the court in particular, is going to take that kind of action, that we'd better have a good reason to do it and there should be some evidence to support it. Now, I think what you quoted with regard to Justice Black and his background is part of it, certainly not the only thing. But I think that was my point.

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Senator SESSIONS. Well, sort of to follow up on Senator Whitehouse's question about taking clear stands sometimes on important issues, even if not popular, I think there is a danger—do you not agree, that in a judge allowing such things, extra-judicial matters that you've cited that possibly could have influenced Black, there is a danger in allowing that to happen and could indeed weaken certain constitutional protections?

Judge GREENAWAY. That is certainly possible, sir.

Senator SESSIONS. Some people seem to think that feelings and experiences are necessarily good and are always going to lead a judge in the right way. Sometimes feelings could lead you in the wrong way in your experiences.

Judge GREENAWAY. That is also certainly possible, sir.

Senator SESSIONS. President Obama described, once, the kind of judges he would look for on the bench as follows: "We need somebody who's got the heart, the empathy to recognize what it's like to be a young teenaged mom, the empathy to understand what it's like to be a poor African-American, or gay, or disabled, or old, and that's the criteria by which I'm going to be selecting my judges."

Now, Justice Sotomayor declined to endorse that as her philosophy of service on the bench. Do you have any comments about that and how you would approach the difficult task of judging?

Judge GREENAWAY. Well, Senator, I know a little bit about being African-American.

[Laughter.]

Judge GREENAWAY. I think we might not have had a lot of money growing up, but I didn't think we were poor. We were really rich in a lot of the more important things in life, my sisters and I. You know, I think my father and mother prepared us for life in the best way they could, and that is giving us the principles to be productive members of society.

I am not in the President's position with regard to what makes a good judge. The only thing I can tell you is that, in my years of experience, I've tried to be fair to folks, I've tried to treat them with the utmost respect and to deal with their—address their cases as best I could, applying the facts to the law.

Senator SESSIONS. Well, I thank you for saying that. We haven't done an exhaustive search of your record like what gets done for the Supreme Court nominees. Every word that they say gets researched. But it does appear that you have a good record and broad support in the community. Thank you.

Judge GREENAWAY. Thank you very much, Senator.

Senator WHITEHOUSE. Thank you, Senator Sessions.

As I said, Judge Greenaway, we hope very much for a speedy and uneventful confirmation. I thank you for your testimony here today. The record of the proceedings for you and for the other candidates will remain open for a week from the conclusion of this hearing, so if there are other comments anybody cares to make about your candidacy, they have that final week to make them before the record of these proceedings closes. But I welcome you here. I congratulate your family on this achievement and I wish you godspeed.

Judge GREENAWAY. Thank you so much, Senator. Both Senators. I appreciate it very much. Have a good day.

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[The biographical information of Joseph A. Greenaway follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Joseph Anthony Greenaway, Jr.

2. **Position**: State the position for which you have been nominated.

   United States Circuit Judge for the Third Circuit

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: United States Post Office and Federal Courthouse, Room 411
   Two Federal Square
   50 Walnut Street
   Newark, New Jersey 07101

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1957; London, England

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received

   1978-81, Harvard Law School; J.D. received 1981

   1980-81, Columbia Law School; cross matriculation with Harvard Law School

   1974-78, Columbia University; B.A. received 1978

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

1996 – present
United States District Court, District of New Jersey
United States Post Office and Federal Courthouse
Room 411
Two Federal Square
Newark, New Jersey 07101
United States District Judge

2007-present
Columbia College, Columbia University
2960 Broadway
New York, New York 10027-6902
Adjunct Professor

2006-present
Cardozo School Of Law
55 5th Avenue
New York, New York 10003
Adjunct Professor

2002-2006
Rutgers School of Law – Newark
123 Washington Street
Newark, New Jersey 07102
Adjunct Professor

1990-1996
Johnson & Johnson
1 Johnson & Johnson Plaza
New Brunswick, New Jersey 08933
Attorney-Legal Department

1985-1990
United States Attorney's Office
970 Broad Street
Newark, New Jersey 07102
Assistant United States Attorney
Chief – Narcotics Division (January 1989 to January 1990)
Criminal Division (April 1985 to January 1989)

1981-1982; 1983-1985
Kramer, Levin, Nessen, Kamin & Frankel
1177 Avenue of the Americas
New York, New York 10036
Litigation Associate

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1982-1983
Honorable Vincent L. Broderick
United States District Judge, Southern District of New York
500 Pearl Street
New York, New York 10007
Law Clerk

Summer 1980
Paul, Weiss, Rifkind, Wharton & Garrison
1285 Avenue of the Americas
New York, New York 10019
Summer Associate

Summer 1979
Heller, Ehrman, White & Mcauliffe
333 Bush Street
San Francisco, California 94104
Summer Associate

September 1979-May 1980
Professor David Rosenberg
Harvard Law School
1563 Massachusetts Ave.
Cambridge, Massachusetts 02138
Teaching Assistant

Summer 1978
Northwestern Mutual Life Insurance
875 Third Avenue
New York, New York 10022
College Agent

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

   I did not serve in the U.S. Military. I did not register for selective service because there was no registration requirement in effect for men my age.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

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Earl Warren Legal Scholar, 1979-1981
Thurgood Marshall College Fund Award of Excellence, 2007
Garden State Bar Association, Roger M. Yancey Award, 2007
Columbia College John Jay Award, 2003
Garden State Bar Association, Distinguished Jurist Award, 1999
Columbia University Medal of Excellence, 1997
New Jersey Corporate Counsel Association, Distinguished Service Award, 1996
Black Alumni Council, Columbia College, Heritage Award, 1996

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

American Bar Association (1985-present)
American Bar Association, Federal Practice Task Force, 2004-present
American Bar Association, Litigation Magazine, Associate Editor, 1997-present
American Bar Association, Task Force on the Independence of the Judiciary, 1997-1999
Garden State Bar Association (1996-present)
National Bar Association (past member)
American Corporate Counsel Association (past member)

10. **Bar and Court Admission**:

1. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

New York 1983 to present
Pursuant to Part 118.1(g) of the Rules of the Chief Administrator of the State of New York, Office of Court Administration, based on my position as a United States District Judge, I am retired from the practice of law.

2. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

Supreme Court of the United States 2007
New York Court of Appeals 1983
Southern District of New York 1983
Eastern District of New York 1983

There have been no lapses in membership in any of these admissions.

District of New Jersey, by designation while an Assistant U.S. Attorney April 1985 to January 1990

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11. **Memberships**:

1. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Columbia College Board of Visitors, member, 2007-present
Columbia College Black Alumni Council, Chair, 1997-2006
Columbia College Alumni Association, Secretary, 1993-1995
Columbia College M. Moran Weston/Black Alumni Council Professorship in African American Studies, Founder and Contributor
Columbia College Alumni of Color Mentoring Program, Mentor
Columbia University Alumni of Color Outreach Program, Advisor
Youth Baseball, Soccer, Basketball, Softball, Coach, 1996-present
Fox Hollow Golf Club, Member, 1994-present

2. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

None of the organizations listed in question 11a discriminates on the basis of race, sex, religion, or national origin.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

An Oath for the Profession: Are We Our Brother's Keeper?, LITIG., Fall 2008, at 3.

Judge Constance Baker Motley and the Struggle for Equal Justice, LITIG., Summer 2003, at 9.

Judicial Decision Making and the External Environment, 51 RUTGERS L. REV. 181 (1998).

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Diversity Training – When it Works and Why, in COUNCIL ON EDUCATION IN MANAGEMENT, PERSONNEL LAW UPDATE, October 13, 1995. (copy not available)

Appraising and Disciplining Protected Class Employees, in COUNCIL ON EDUCATION IN MANAGEMENT, PERSONNEL LAW UPDATE, November 1, 1993. (copy not available)

Controlling Employee Off-Duty Conduct: Business Necessity or Violation of Privacy?, in COUNCIL ON EDUCATION IN MANAGEMENT, PERSONNEL LAW UPDATE 1993, TEANECK, NEW JERSEY, NOVEMBER 17–18, 1992 B-1 (Borgman Associates 1992).

Drugs and Alcohol in the Workplace, in LORMAN BUSINESS CENTER, EMPLOYMENT & LABOR LAW IN THE NEW YORK METROPOLITAN AREA 291 (Lorman Education Services 1992).

Sexual Harassment and the "Reasonable Woman" Today, in COUNCIL ON EDUCATION IN MANAGEMENT, PERSONNEL LAW UPDATE 1992, MORRISTOWN, NEW JERSEY, APRIL 27–28, 1992 A-1 (Borgman Associates 1992).

Surveillance, Monitoring, Search and . . . Risk, in COUNCIL ON EDUCATION IN MANAGEMENT, PERSONNEL LAW UPDATE 1991, SHORT HILLS, NEW JERSEY, OCTOBER 7–8, 1991 G-1 (Borgman Associates 1991).

Surveillance, Monitoring, Search and . . . Risk, in COUNCIL ON EDUCATION IN MANAGEMENT, PERSONNEL LAW UPDATE 1991, CHERRY HILL, NEW JERSEY, APRIL 10–11, 1991 G-1 (Borgman Associates 1991).

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

To the best of my knowledge, I have not participated in any activity that would produce a report of this type.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

I testified before the United States Senate Judiciary Committee on February 28, 1996 in connection with my nomination to be United States District Judge for the District of New Jersey.

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d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

March 20, 1997	EOY Minority Achievers Business & Industry Awards Banquet
May 21, 1997	Columbia University, Alumni Federation Lunch, 99th Commencement Day Luncheon: An Historical Reflection of Judicial Independence
March 3, 1998	Rutgers School of Law, Weintraub Lecture
May 19, 1998	Columbia College, Commencement, Class Day Address
October 29, 1998	Westfield YMCA First Annual Black Achievers Banquet
December 14, 1998	Arthur T. Vanderbilt Inn of Court Graduation
February 22, 1999	Columbia College, 16th Annual Black Alumni Reception, Introduction of Eric Holder
June 23-24, 1999	ABA "National Conference for Minority Lawyers" faculty member for practical skills training seminar (New York, NY).
December 20, 1999	Mock trial for 4th grade class
January 28, 2000	Patterson Belknap Question and Answer Session
February 18, 2000	Black History Month remarks Johnson & Johnson
April 10, 2000	John C. Lifland American Inn of Court speech on opening statements
April 27-28, 2000	National Employment Law Conference in Houston, Panel: Views from the Bench
May 16, 2000	Rutgers University School of Law Minority Student Program Banquet, Keynote Address

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June 1, 2000	American Law Institute/American Bar Association program
June 27, 2000	Plainfield High School
July 10, 2000	Moderator for American Bar Association panel in New York, N.Y.
November 9, 2000	Judge for Rutgers School of Law Mock Trial competition
January 12, 2001	Pingry School Martin Luther King, Jr. Day Speech: Why Martin Luther King, Jr. deserves a Federal Holiday
February 22, 2001	Black History Month Speech at Johnson & Johnson
March 12, 2001	Fraternal Order of Police Mini-convention in Camden, N.J.: Supreme Court update
March 19, 2001	Mock trial for Tamaques School 5th Grade Class
May 2001	American Bar Association panel on Employment Law at Annual Litigation Meeting Panel on Trying Employment Cases
May 2, 2001	Association of the Bar of the City of New York City Speech on Judicial Independence, Pamela Jones Harbour
August 15, 2001	Upward Bound Students Question and Answer Session
November 30, 2001	American Law Institute/American Bar Association Mock Trial with Jury Videotape
March 11, 2002	Fraternal Order of Police Mini-convention Camden, N.J.: Supreme Court update
March 12-13, 2002	Tamaques School: Mock Trial for 5th Graders
March 26, 2002	Criminal Law Section, New Jersey State Bar Association, Question and Answer Session, Edna Ball Axelrod
May 22, 2002	Speech at Crossroads School for dedication of a new building
June 6, 2002	American Law Institute/American Bar Association panel discussion at Fordham University School of Law: Trying Employment Law Cases

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June 27, 2002	Summer Interns at Johnson & Johnson: Question and Answer Session
July 10, 2002	Minority Student Program at Rutgers School of Law-Newark: General talk on the future of the legal profession; question and answer session
October 30, 2002	Rutgers Association of Black Law Students panel discussion entitled "Men of Color: Breaking Down Barriers in the Legal Profession"
November 6, 2002	Seton Hall Law School panel discussion entitled "Judicial Clerkships from the Perspective of the Judges Who Hire Them"
December 6, 2002	American Law Institute/American Bar Association Mock Trial Employment Law Jury Deliberation Demonstration
December 11, 2002	Johnson & Johnson Question and Answer Session
January 7, 2003	Westfield Rotary Club Guest Speaker: Life on the Bench
March 5, 2003	Acceptance Speech for John Jay Award
March 26, 2003	Orientation for new district judges, District of New Jersey: Presentation on Settlement
April 9, 2003	The Children's Institute: What Is It Like to Be a Judge?
June 13, 2003	Heller Ehrman Question and Answer Session
July 10, 2003	Remarks at Swearing in of Peter Harvey as Attorney General for the State of New Jersey
March 4, 2004	Middlesex County Bar Association Minority-Issues Symposium panel discussion entitled "Brown v. Board of Education: Fifty Years After!"
May 4, 2004	All Stars program: What the Future Holds with Hard Work
August 4, 2004	Minority Student Program Orientation at Rutgers School of Law: Question and Answer Session for incoming law students

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December 8, 2004	Swearing in for newly admitted attorneys for Union County Bar Association at Union County Courthouse and Welcome to the Bar Remarks
March 7, 2005	Keys to Appellate Advocacy – Cardozo School of Law
April 7, 2005	New Jersey Federal Bench-Bar Annual Judicial Conference panel on prosecution of corporations
April 11, 2005	Computer Forensics Training Program Keynote Address: Role of the expert in courtroom proceedings and judging mock trials with defense counsel and prosecutors examining & cross examining computer forensic experts
October 27, 2005	Seton Hall School of Law Question and Answer Session
February 17, 2006	United States Attorney's Office for the District of New Jersey Black History Month Program – Panel discussion
March 20, 2006	Donita Judge's class at Rutgers University
March 22, 2006	Keys to Appellate Advocacy – Cardozo School of Law
May 18, 2006	Sills Cummis Diversity Breakfast: Life in the Law and Question and Answer Session
June 5, 2006	Cardozo School of Law, Commencement Address
August 7, 2006	Minority Student Program Orientation at Rutgers School of Law: Question and Answer Session for incoming law students
October 18, 2006	Appleseed Dinner: A Few Random Thoughts about the Confirmation Process
November 7, 2006	International Institute for Conflict Prevention and Resolution Dinner: The Future of ADR
January 31, 2007	Columbia College Black Alumni Council Heritage Celebration – Keynote Address
February 6, 2007	Westfield High School mock trial program
February 23, 2007	United States Attorney's Office for the Southern District of New York Black History Month program – "Has America Lived Up to Its Promise?"

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February 26, 2007	Kramer, Levin Black History Month Program
March 5, 2007	Newark Academy Panel for Black History Month
March 15, 2007	Acceptance of Thurgood Marshall College Fund Award of Excellence: Thank you
March 22, 2007	New Jersey Federal Bench-Bar Annual Judicial Conference: Panel on Civility
April 5, 2007	Donita Judge's class at Rutgers: Question and Answer Session
June 2, 2007	Acceptance of Garden State Bar Association Roger M. Yancey Award: Thank you
June 14, 2007	Johnson & Johnson, Patterson Belknap and Woodcock Washburn summer associates observing courtroom proceedings and question and answer session
July 18, 2007	Schulte Roth summer associates observing courtroom and question and answer session
August 9, 2007	Minority Student Program Orientation at Rutgers School of Law: Question and Answer Session for incoming law students
September 14, 2007	Cub Scout troop observing court and question and answer session
September 26, 2007	Welcome new law clerks
October 5, 2007	American Bar Association Antitrust Section: Trial Judge for mock trial in Philadelphia
October 15, 2007	Dean's Distinguished Scholars Dinner – Cardozo School of Law question and answer session
October 22, 2007	Westfield High School students observing court and question and answer
December 5, 2007	Columbia University panel "Negotiating Identity in the Workplace"
January 9-10, 2008	Cardozo School of Law Intensive Trial Advocacy Program

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62345.710

January 31, 2008	Nativity Mission School students (for Judge Barry)
February 16, 2008	American Bar Association Corporate Counsel and Minority Trial Lawyer subgroup of Litigation Section: panel "Ethical Dilemmas in Aggressive Litigation – Dealing with the Unethical Adversary and Difficult Client"
February 22, 2008	Columbia College Black Alumni Council Heritage Celebration – Announcement of Establishment of Chair in African-American Studies
February 25, 2008	University of Pennsylvania Black Law Students Association Question and Answer Session
February 28, 2008	Spoke to students performing at United States Attorney's Office for the District of New Jersey Black History Month program
February 29, 2008	Riker Danzig Black History Month program: "The Promise of America 1787-2028"
March 20, 2008	Keys to Appellate Advocacy – Cardozo School of Law
March 25, 2008	Edwards and Angell, Diversity Reception: Power of Preparation
March 28, 2008	Panel at New York Intellectual Property Lawyers Association Annual Meeting: Effect of Recent Supreme Court Decisions on Wilful Infringement
June 16, 2008	Norris McLaughlin summer associates observing courtroom proceedings and question and answer session
June 16, 2008	Keynote address for Scotch Plains-Fanwood Step Up Ceremony at Evergreen School Multipurpose Room: "Barack Obama and What is Possible Now"
June 26, 2008	Johnson & Johnson, Patterson Belknap and Woodcock Washburn summer associates observing courtroom proceedings and question and answer session
June 30, 2008	Mock Trial for Lowenstein Sandler
July 7, 2008	McCarter & English summer associates observing courtroom and question and answer session
September 9, 2008	Welcome for new law clerks

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October 23, 2008	Union County Bar Association panel on evidence with Robert Kirsch
October 24, 2008	Practising Law Institute 37th Annual Institute on Employment Law panel: Litigation Strategy: Views from the Bench
October 29, 2008	Columbia University Pre-Law Society Question and Answer Session
November 13, 2008	Remarks at FCI Fairton: Leadership
November 13, 2008	Videotaped remarks for Dean Austin Quigley's (Columbia College) farewell
November 18, 2008	IQPC Securities Litigation Conference Panel: Perspectives from the Bench
November 20, 2008	Franklin School 4th grade class mock trial
December 4, 2008	Swearing-in of new attorneys at Seton Hall Law School
January 7-8, 2009	Cardozo School of Law Intensive Trial Advocacy Program: Cross-Examination – 5 Keys to Preparation
January 28, 2009	Moderator of Panel for Middlesex County Bar Association: 100th Anniversary of NAACP – Contributions of the NAACP to the American Legal Landscape
February 4, 2009	Nativity Mission School students (for Judge Barry) – Life on the Bench
February 6, 2009	Welcome remarks for Pretrial Services Black History Month Program
February 13, 2009	ABA Corporate Counsel and Minority Trial Lawyer subgroup of Litigation Section, Panel: "Tips for Managing the Expedited Mega-Case"
February 20, 2009	Introduction of Corey Booker at Clerk's Office Black History Month Program
March 10, 2009	Johnson & Johnson Question and Answer Session
March 11, 2009	Keys to Appellate Advocacy – Cardozo School of Law

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March 26, 2009	New Jersey Federal Bench-Bar Annual Judicial Conference Luncheon Speaker "Mentoring – What is Our Message?"
March 30, 2009	Judge at Rutgers School of Law Moot Court Competition
April 2, 2009	Barringer High School: Pre-Law Group: Question and Answer Session
April 20, 2009	Swearing in of Yvette Gibbons as President of Essex County Bar (Welcome Remarks)
April 29, 2009	Future Lawyers Club at Seton Hall Prep School: Question and Answer Session
May 15, 2009	Rutgers School of Law Pharmaceutical Industry Forum, Judges' Panel

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

The Gumption to Sit on the Bench, Columbia College Today, Spring 1996
Judging Greenaway: An Interview, Sidebar, vol. 5, issue 1, May 1, 2002

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

I was appointed as a United States District Judge for the District of New Jersey on July 26, 1996 by President Clinton, following confirmation by the United States Senate.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? I have presided over approximately 65 trials (50 to verdict), and have handled between 4000 and 4500 cases through judgment or other resolution.

i. Of these, approximately what percent were:

jury trials? 92%; bench trials 8% [total 100%]

civil proceedings? 60%; criminal proceedings? 40% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

See attached list.

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c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature of the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (4) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

1. Miller v. Beneficial, Civ. No. 08-3039
This employment discrimination suit went to verdict. This was a difficult and complex case with multiple claims. The complaint addressed both state and federal law. The claims included gender discrimination, failure to promote, and age discrimination. The jury returned a verdict of no cause.

For Miller:
Aron M. Schwartz
Greenbaum, Rowe, Smith, and Davis
Metro Corporate Campus One
99 Wood Avenue South
Iselin, New Jersey 08830-2712
(732) 549-5600

For Beneficial:
Michael Furey
Riker, Danzig, Scherer, Hyland and Perretti LLP
One Speedwell Avenue
Morristown, New Jersey 07962
(973) 538-0800

Lynne Anderson
Sills, Cummis and Gross P.C.
One Riverfront Plaza
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(973) 643-7000

2. U.S. v. Charles Rodriguez, Crim. No. 98-547
This criminal case involved a multiple count indictment charging defendants with attempted armored car robbery and several bank robberies, some of which involved holding members of the public hostage. The trial was hotly contested. The jury found each of the defendants guilty. I sentenced two of the defendants to life without the possibility of parole. The other defendant received thirty-six years.

For Government:
Stuart Rabner
Chief Justice New Jersey Supreme Court
Hughes Justice Complex, 25 W. Market St.

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(856) 488-0004

For Joseph Rodriguez:
Martin Isenberg
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Gibbsboro, New Jersey 08026
(856) 782-8222

For Jose Soto:
David Holman
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(973) 645-6347

Lisa Lewis
Assistant Federal Public Defender
840 Cooper Avenue
Camden, New Jersey 08102
(856) 757-5341

3. U.S. v. Robert Spinello, Crim. No. 99-539
The United States Attorney for our district tried this unusual bank robbery case. Prior to trial, the defense made a novel Commerce Clause argument in an attempt to have the indictment dismissed. A police officer robbed a bank, on his beat, in broad daylight. The defense was mistaken identity. The defense produced extensive expert testimony on the unreliability of eyewitness testimony. The jury came back with a guilty verdict. Spinello received an eight-year sentence.

For Government:
Robert Cleary

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Matthew Queler
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For Spinello:
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(973) 596-4731

Mark Berman
Hartmann, Doherty, Rosa, Berman & Bulbulia
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4. Sika v. Mantex, Civ. No. 00-3617
This civil case involved a breach of contract between a manufacturer and a distributor. The unique quality of this case was an immense volume of testimony and exhibits tried by one experienced lawyer for each party. Plaintiff prevailed.

For Sika:
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For Mantex:
Joseph Fleischman
Norris, McLaughlin, and Marcus
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Somerville, New Jersey 08876
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5. U.S. v. Sara Bost, Crim. No. 02-265
This political corruption case charged the former mayor of Irvington with soliciting and taking bribes from contractors. Mayor Bost, a seeming untouchable, was open and notorious in her effort to pad her coffers. She pled guilty after the government presented videotape and audiotape evidence regarding her guilt.

For Government:
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(973) 645-2700

Paula Dow
Essex County Prosecutor's Office
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For Bost:
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Brown and Brown
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(973) 622-1846

Alan D. Bowman
Private Attorney
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(973) 622-2225

6. Hamme v. N.J. Institute of Technology, Civ. No. 00-2608
Plaintiff Hamme brought a discrimination case against the New Jersey Institute of Technology. The multiple count complaint focused, in large measure, on a claim of a widespread hostile work environment, and other forms of discrimination. Extensive motion practice prior to trial created interesting evidentiary issues for trial. The matter settled before a verdict was returned.

For Hamme:
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For N.J Institute of Technology:
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(973) 535-0500

Liza Walsh
Connell Foley LLP.
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Roseland, New Jersey 07068
(973) 535-0500

7. U.S. v. Rene Abreu, Crim. No. 02-337
The Government charged eight inter-related conspiracies in this complex fraud prosecution. Specifically, a real estate company, bank, mortgage company, and other corporate entities concocted a scheme to defraud. The ring leader of the conspiracy was a prominent, well-connected, and well-respected businessman. His co-conspirators were two employees, his banker, and a budding lawyer. The fraud adversely affected the public, several banks and other financial institutions. This case proved to be a harbinger of the nationwide mortgage fraud crisis. One of the conspiracies involved obtaining mortgages for people who could not sustain mortgage payments using false identities, fraudulent job histories, and faulty income verification. The scope of the fraud resulted in multi-million dollar damages. Abreu received the maximum sentence – 87 months.

For Government:
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Matthew Boxer
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For Martell:
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For Nieves:
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(201) 488-0544

8. U.S. v. Roger Duronio, Crim. No. 02-933
This government prosecution focused on the purposeful attempt by Roger Duronio, an intelligent professional, to "bring down" his employer, UBS, by infecting the computer system of that company with a logic bomb. Effectively, a logic bomb operates like a virus. Duronio failed to achieve the bonus (compensation) level he wanted and over several months planted the seeds for a logic bomb, set to infect UBS's computer system on a monthly basis for a sustained period of time. The challenge of the trial was ruling on complex

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scientific data and whether Daubert and its progeny precluded certain expert testimony. Despite the complexity, the jury grasped the relevant issues. The jury returned a guilty verdict and Duronio was sentenced to 97 months.

For Government:
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V. Grady O'Malley
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For Duronio:
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Walder Hayden & Brogan, P.A.
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(973) 992-5300

Kevin Buchan
Walder Hayden & Brogan, P.A.
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9. U.S. v. Emmanuel Deji, Crim. No. 03-253
This multi-layered, multi-defendant indictment charged a conspiracy and several substantive counts alleging large scale bank fraud, mail fraud, and wire fraud. The scheme involved defendants passing off counterfeit checks in large amounts, employing legitimate citizens and corporations as conduits for the ill-gotten gains. Millions of dollars in losses were proven at trial. The jury returned a guilty verdict against four out of five defendants.

For Government:
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For Deji:
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For McGowan:
James Murphy
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10. N.F.L. v. Vepuri, Civ. No. 01-5397
This civil action had a unique international flavor. NFL is the national fertilizer company in India. The company attempted, through this suit, to recover several million dollars it had lost to defendant Vepuri, based on Vepuri's fraudulent misrepresentations, subversion, and secretion of funds. The jury came back with a plaintiff's verdict for several million dollars.

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For N.F.L.:
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Philip Robben
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(212) 808-7726

For Vepuri:
Marc Klein
Deceased

Susheela Verma
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1 Woodbridge Center Drive, Suite 810
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d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

1. Eli Lilly and Co. v. Roussel Corp., et al., 23 F. Supp. 2d 460 (D.N.J. 1998) Issues raised included: RICO; Trademark Infringement; Fraud; Tortious Interference; Unjust Enrichment; Unfair Competition; Paris Convention; Standing; Proximate Cause; Conspiracy.

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Liza M. Walsh
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2. Elsa Iwanowa v. Ford Motor Co., 67 F. Supp. 2d 424 (D.N.J. 1999):
Class action complaint seeking reparations for persons forced into slave labor to assist Ford, and its German subsidiary, in manufacturing tanks and other vehicles for Nazi Germany's war effort. The opinion addressed motions to dismiss based on nonjusticiability, international treaties, choice of law, and other issues.

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Walter E. Dellinger
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Burt Neuborne
New York University School of Law
40 Washington Square S.
New York, New York 10012-1005
(212) 998-6172

3. U.S. v. Spinello, 95 F. Supp. 2d 242 (D.N.J. 2000):
I denied a motion to dismiss indictment; defendant argued that federal bank robbery statute impermissibly exceeds Congress's authority under the Commerce Clause. The opinion ruled that Congress had a rational basis to conclude that bank robberies affect interstate commerce and the statute, as applied, comported with the Commerce Clause.

Robert J. Cleary
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Lawrence S. Lustberg
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4. Carpet Group Int'l v. Oriental Rug Importers Ass'n, Inc., et al., 256 F. Supp. 2d 249 (D.N. J. 2003)
Summary judgment, opinion on complex antitrust matter.

Michael Ira Asen
Olonoff Asen & Serebro, LLP
500 Fifth Avenue
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(212) 768-3333

Andrew L. Schlafly
521 Fifth Avenue
17th Floor
New York, New York 10175
(212) 292-4510

5. Vital State Canada, Ltd. v. DreamPak, LLC, 303 F. Supp. 2d 516 (D.N.J. 2003): preliminary injunction motions

Steven M. Kaplan
Rosenfeld & Kaplan, L.L.P.
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(212) 682-1400

Daniel Kelly
Reinhart Boerner Van Deuren s.c.
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Milwaukee, Wisconsin 53202
(414) 298-8284

6. Aventis Pharm., Inc. v. Barr Lab., Inc., et al., 335 F. Supp. 2d 558 (D.N.J. 2004): In a pharmaceutical patent case, the opinion granted summary judgment with a ruling of non-infringement of three patents; denied summary judgment on one other patent non-infringement motion; and reserved judgment, pending a Markman hearing, on yet another patent non-infringement motion.

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7. U.S. v. David Santos, 340 F. Supp. 2d 527 (D.N.J. 2004):
I granted a motion to suppress evidence.

Lisa Rose
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Stephen Turano
Tacopina Seigel & Turano, P.C.
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8. Victor Zavala v. Wal-Mart Stores, Inc., 393 F. Supp. 2d 295 (D.N.J. 2005):
Motion to dismiss class action complaint of undocumented immigrant workers, who worked at Wal-Mart; denied as to Fair Labor Standards Act and common law claims and granted motion as to RICO and § 1985 claims.

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David P. Murray
Willkie Farr & Gallagher LLP

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9. Laura DePinto v. Bayonne Bd. of Educ., 514 F. Supp. 2d 633 (D.N.J. 2007):
I granted a preliminary injunction for plaintiffs, parents of two minors, who wore to school a button, depicting Hitler Youth, but showing no Nazi symbolism, with a red line drawn across the button and the words "No School Uniforms." Parents alleged violation of First Amendment free speech rights when the school officials threatened to suspend the fifth-graders. Opinion addressed First Amendment issues at length.

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Robert A. Vort
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10. Douglas Palmer v. University of Medicine and Dentistry of New Jersey, et al., 605 F. Supp. 2d 624 (D.N.J. 2009):
I decided the motion of plaintiff, Douglas Palmer, to remand only his claims against Defendants University of Medicine and Dentistry of New Jersey and University Hospital (collectively "UMDNJ") and Barry C. Esrig, M.D., to the Superior Court of New Jersey. The issue was whether UMDNJ, as a defendant to a cross-claim, has the right to remove the action, pursuant to 28 U.S.C. § 1441(b), based on co-defendant Esrig's federal cross-claim. I held that section 1441 does not allow a cross-claim to confer federal question jurisdiction on this Court, and thus, absent a basis to confer subject matter jurisdiction, UMDNJ improperly removed the case under §1441. Accordingly, I granted plaintiff's motion to remand only his claims, and remanded sua sponte the entire civil action.

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James E. Patterson, Jr.
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e. Provide a list of all cases in which certiorari was requested or granted.

Information on the number of cases where certiorari was requested is not currently available. At present, this information is not maintained in a form that is retrievable from the court's records. However, to the best of my knowledge, certiorari has never been granted in any of my cases.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

In Re United Healthcare System; 11/15/1998; Unreported, Civ. No. 97-2495 (Order adopting a report and recommendation from a magistrate judge.); 200 F.3d 170 (1999); Reversed and remanded.

Farrell v. Planters Lifesavers Co.; 10/5/1998; 22 F. Supp. 2d 372; 206 F.3d 271 (2000); Affirmed in part, reversed in part, and remanded.
Employee terminated from senior manager position sued employer, alleging sex discrimination in title, pay, and grade, quid pro quo sexual harassment, and retaliation in violation of Title VII, together with breach of contract claim. Employer moved for summary judgment. Motion granted.

Rose Art Indus. v. Swanson; 11/20/1998; 31 F. Supp. 2d 367; 235 F.3d 165 (2000); Reversed and remanded.
Distributor of crayon, marker, and colored pencil products brought trade dress infringement action against a competitor. Upon distributor's motion for preliminary injunction, I held that distributor was not entitled to trade dress protection for its line of crayon, marker and colored pencil products. Motion denied.

Sutter v. Munich Reinsurance; 7/30/1999; Unreported, Civ. No. 99-757 (Order adopting a report and recommendation from a magistrate judge.); 223 F.3d 150 (2000); Reversed and remanded.
Liquidator for insolvent reinsured brought state court action against reinsurer to recover on reinsurance treaties. Reinsurer removed case, and liquidator moved for remand. I remanded the case to state court.

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Carpet Group Int'l v. Oriental Rug Importers; 10/29/1999; Unreported, Civ. No. 95-5574 (Order adopting a report and recommendation from a magistrate judge.); 227 F.3d 62 (2000); Reversed and remanded.
Plaintiff brought suit against association of importer/wholesalers of oriental rugs, alleging conspiracy to restrain trade and to monopolize market for oriental rugs. I dismissed the suit.

United States v. Various Articles Of Merchandise Schedule No. 287; 2/22/2000; Unreported, Civ. No. 98-1559; 230 F.3d 649 (2000); Reversed.
Government brought action seeking forfeiture of French and German magazines devoted to nudists' lifestyles, which had been imported to United States, on ground that magazines were obscene. I ordered forfeiture of magazines, holding that each work, taken as a whole, lacked serious literary, artistic, political or scientific value.

S.H. v. Newark; 4/27/2001; Unreported, Civ. No. 00-2559; 336 F.3d 260 (2003); Reversed and remanded.
In Individuals with Disabilities Education Act (IDEA) case concerning continuing placement of hearing impaired child in out-of-district public school, ALJ concluded in due process hearing at state administrative level that school district failed to meet its burden in proving that change in placement would provide meaningful educational benefit. Child's mother sought attorney's fees, and school district counterclaimed challenging administrative decision. I reversed the ALJ's decision.

Board Of Trustees v. Kero Leasing Corp; 2/22/2003; Unreported, Civ. No. 98-1476; 377 F.3d 288 (2004); Affirmed in part and reversed in part.
Pension fund sued company's former sole shareholder to recover withdrawal liability. I granted defendant summary judgment on ground that action was time-barred, and awarded defendant interest.

Brennan v. Kulick; 3/1/2004; Unreported, Civ. No. 01-3837; 407 F.3d 603 (2005); Reversed and remanded.
Pro se § 1983 action was brought against city officials alleging violations of First, Fourth, and Fourteenth Amendments and various state laws. I denied plaintiff's motion to vacate previous order dismissing complaint with prejudice.

In Re United Healthcare System; 11/13/2003; Unreported, Civ. No. 03-1024 (Order adopting a report and recommendation from a magistrate judge.); 396 F.3d 247 (2005); Reversed and remanded.
Chapter 11 debtor objected to priority status given to New Jersey Department of Labor's (NJDOL) claims for reimbursement for unemployment compensation benefits paid to debtor's former employees. The United States Bankruptcy Court, Novalyn L. Winfield, J., 282 B.R. 330, concluded that the NJDOL's pre-petition and post-petition reimbursement claims were entitled to priority as excise taxes. I affirmed the decision of the Bankruptcy Court.

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East Hill Synagogue v. Englewood; 9/26/2005; Unreported, Civ. No. 03-5228 (Order not adopting a report and recommendation from a magistrate judge.); 240 F. App'x 938 (2007); Reversed and remanded.
Synagogue brought action against city, city planning board, and owners of property neighboring synagogue, alleging violation of First Amendment rights and Religious Land Use and Institutionalized Persons Act (RLUIPA). I invoked Rooker- Feldman doctrine and dismissed complaint for lack of subject matter jurisdiction.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

Over the course of my career, I have written approximately 850 opinions. Of the 850, approximately 60-65 were published. I believe only decisions that address novel legal issues, have broad public interest or impact or have institutional value should be published. As a result, I have published very few of my opinions. In my chambers, I maintain an index of all opinions, both published and unpublished. Additionally, the Clerk's Office maintains the official record of each case, including a copy of any opinions, whether published or unpublished.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

1. Higginson v. Twp. of Greenwich, Civ. No. 95-5525 (D.N.J. Mar. 31, 1998). Opinion Attached.

2. Iwanowa v. Ford Motor Co., 67 F. Supp. 2d 424 (D.N.J. 1999).

3. United States v. Spinello, 95 F. Supp. 2d 242 (D.N.J. 2000).
United States v. Spinello, 265 F.3d 150 (3d Cir. 2001).

4. Global Naps, Inc. v. Bell Atlantic-New Jersey, Inc., Civ. No. 99-4047 (D.N.J. Jan. 29, 2001). Opinion Attached.

5. United States v. Santos, 340 F. Supp. 2d 527 (D.N.J. 2004).

6. Rodriguez v. United States, Civ. No. 04-158, 2005 WL 2007033 (D.N.J. Aug. 22, 2005). Opinion Attached.

7. US v. Crandell, 509 F. Supp. 2d 435 (D.N.J. 2007).
US v. Crandell, 554 F.3d 79 (3d Cir. 2009).

8. DePinto v. Bayonne Bd. of Educ., 514 F. Supp. 2d 633 (D.N.J. 2007).

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9. United States v. Banks, Crim. No. 07-552, 2008 WL 177653 (D.N.J. Apr. 16, 2008). Opinion Attached.

10. Sasonov v. United States, 575 F. Supp. 2d 626 (D.N.J. 2008).

11. United States v. Baskerville, Crim. No. 07-553 (D.N.J. Nov. 12, 2008). Opinion Attached.

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

Dorsey Trailers, Inc. v. Nat'l Labor Relations Bd., 134 F.3d 125 (3d Cir. 1998) is an opinion I wrote while sitting by designation at the request of the Chief Judge of the Third Circuit; substantively, the opinion addressed whether Petitioner violated the National Labor Relations Act when it entered into a subcontracting agreement without first negotiating with its employees' union representatives.

Opinions in which I joined the majority:

United States v. Roman, 121 F.3d 136 (3d Cir. 1997).

In re Consol. Coal Co., 123 F.3d 126 (3d Cir. 1997).

In re TMI Litig., 193 F.3d 613 (3d Cir. 1999).

Orban v. Vaughn, 123 F.3d 727 (3d Cir. 1997).

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

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I am vigilant about ensuring that the administration of justice remains transparent. My goal is to make sure each litigant believes he or she is treated fairly. My recusal list, consisting of persons, entities, and corporations in which I have a familial interest, an unusually close personal relationship, or a financial interest, is updated frequently. Also, that list is kept with the Clerk's Office, which uses an automated recusal program. Additionally, my staff reviews complaints as they are assigned to me, as a safeguard to the automated recusal system maintained by the Clerk's Office. Any matches provide an immediate basis for recusal.

Over the course of my judicial career, there have been some instances in which I have become aware of facts, after a case is assigned to me, that then required recusal. On those occasions, I have not hesitated to recuse. There have also been occasions when a party has requested recusal. If requested, I look to 28 U.S.C. § 455, 28 U.S.C. § 144, the Code of Conduct for United States Judges, the advisory opinions and the compendium of opinions, for guidance. I have also sought advice from the General Counsel's Office in the Administrative Office of the United States Courts, as well as from the Third Circuit representative on the Committee on Codes of Conduct. In the end, after consultation with the statute and opinions, my focus is on fairness, the appearance of impropriety, and transparency.

Cases in which recusal was requested and granted:

Pitak v. Bell Atlantic, Civ. No. 95-3319: In this case, plaintiffs filed a complaint asserting various causes of action arising from their employment. The complaint asserted class action allegations. Plaintiffs' counsel argued informally, but on the record, that I should recuse based on my acquaintance with defense counsel, Frank Dee. While at Johnson & Johnson, Frank Dee served as outside counsel on employment law matters. We had worked together on several cases. I had disclosed this information on the record before plaintiffs' counsel's entreaty. Upon reflection, plaintiffs' counsel suggested that I recuse, which I agreed to do.

Schering Corp. v. Teva Pharmaceuticals, et al., Civ. No. 00-255 and Schering Corp. v. McNeil-PPC, Inc., Civ. No. 01-6175: The recusal motion in this matter arose sua sponte. Originally, I had been presiding over this multi-party, complex civil litigation for some period of time. It came to my attention that McNeil-PPC was to be added as a party to this litigation. McNeil-PPC is a wholly-owned subsidiary of Johnson & Johnson, my former employer. As soon as I learned of this information, I recused myself from the litigation.

Cases in which recusal was requested and denied:
First National Bank of Arizona v. Majestic Home Mortgage, LLC, et al., Civ. No. 02-2935: One of the defendants in this civil fraud case sought recusal based on his dissatisfaction with a prior court ruling. There was no legitimate basis for the grant of recusal. The motion was denied.

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Colida v. Panasonic Corp. of North America, Civ. No. 05-5527: After the case was closed for some time, the plaintiff in this case sought recusal based on an unsubstantiated and incorrect allegation that I have an interest in Panasonic Corporation of North America. Given the fact that I have no such interest, the motion was denied.

Vasilopoulos v. Superior Court of New Jersey, Civ. No. 08-5801: Plaintiff was dissatisfied with the progress of the case, which was unduly prolonged by plaintiff's continual amendments to his pleadings and submissions. I denied the recusal based on its lack of merit.

15. **Public Office, Political Activities and Affiliations**:

1. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

   None.

2. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

   None.

16. **Legal Career:** Answer each part separately.

1. Describe chronologically your law practice and legal experience after graduation from law school including:

   i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

   I served as a law clerk to the Honorable Vincent L. Broderick on the United States District Court for the Southern District of New York from 1982-1983.

   ii. whether you practiced alone, and if so, the addresses and dates;

   I never practiced alone.

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iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

January 1990 - September 1996
Johnson & Johnson
1 Johnson & Johnson Plaza
New Brunswick, New Jersey 08933
Attorney-Legal Department

April 1985 – January 1990
United States Attorney's Office
970 Broad Street
Newark, New Jersey 07102
Assistant United States Attorney
Chief – Narcotics Division January 1989 to January 1990
Criminal Division April 1985 to January 1989

1981-1982; 1983-1985
Kramer, Levin, Nessen, Kamin & Frankel
1177 Avenue of the Americas
New York, New York 10036
Litigation Associate

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

Other than mediating cases while I have been a United States District Judge, I have not served as a mediator or arbitrator in any alternative dispute resolution proceedings.

2. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

For almost seven years preceding my appointment to the District Court, I was an in-house general attorney at Johnson & Johnson. Although I was in the litigation group, the substantive areas of my practice went beyond strictly litigation, and included commercial litigation, criminal investigations, employment advice and litigation, corporate compliance, general corporate matters, and antitrust counseling.

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Johnson & Johnson at the time had thirty-five domestic subsidiaries. I rendered legal advice or litigated cases on behalf of almost all of those subsidiaries. On rare occasions, I performed legal services for some of Johnson & Johnson's international subsidiaries. My clients generally were the management groups or the particular subsidiary that needed my expertise.

My responsibilities as a general attorney in the litigation group fell into three categories – Board attorney, litigator, and legal advisor. As the Board attorney for one of Johnson & Johnson's domestic subsidiaries, I was a member of the management group for that subsidiary. I attended management board meetings and participated as a full member. Besides providing input on business issues, I rendered general legal advice in areas of my practice. For issues outside my expertise, I worked with one of my in-house colleagues or outside counsel.

My role as a litigator was very active. Most of my cases were civil matters. My role was to handle cases until resolution, often without involving outside counsel. If outside counsel was required, I appeared as co-counsel. I participated in all facets of the cases – editing briefs, preparing for, defending and taking depositions, and negotiating settlements. Most of these cases were in federal court, where I was admitted pro hac vice.

I provided legal advice in several practice areas, particularly employment advice, focusing primarily on preventive work. I often guided my clients through the complex maze of federal statutes to ensure that the corporation complied with the law and was fair to its employees.

Prior to joining Johnson & Johnson, I served as an Assistant United States Attorney for the District of New Jersey for five years. At the United States Attorney's Office, I worked in the criminal division. I had responsibility for the entire spectrum of duties required to prosecute a criminal case. I worked with federal agents from all major law enforcement agencies, including the Federal Bureau of Investigation, the Drug Enforcement Administration, the Alcohol, Tobacco and Firearms Bureau, the Secret Service, and the Customs Service. I conducted and supervised investigations, presented cases to the grand jury, researched and wrote motions and briefs, and tried cases.

I had a varied experience at the United States Attorney's Office. I worked on, among other things, bank fraud, hijacking, check kiting, sexual abuse, mail fraud, and narcotics prosecutions. Towards the latter part of my tenure, I focused on drug prosecutions. As Chief of the Narcotics Division, I had supervisory authority over the drug prosecutions brought into the Office. Additionally, I coordinated our prosecutorial efforts with

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both federal and state law enforcement agencies.

At the beginning of my career, I worked as a litigation associate at Kramer, Levin, Nessen, Kamin & Frankel, a New York law firm. The firm specialized in complex commercial litigation in federal and state courts. I spent the majority of my time conducting depositions, engaging in motion practice, counseling clients, and researching and drafting memoranda of law and briefs on commercial litigation matters.

In between my periods of employment with Kramer, Levin, I served as a law clerk to the Honorable Vincent L. Broderick. My duties focused on researching and drafting memoranda and opinions.

3. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

As in-house litigation counsel at Johnson & Johnson (1990-1996), I worked on more than fifty civil litigations around the country in both federal and state court. As an Assistant United States Attorney (1985-1990), I appeared in federal court on an almost daily basis. At Kramer, Levin, when I occasionally appeared in court as a young associate, it was generally in federal court.

i. Indicate the percentage of your practice in:
   1. federal courts: 90%
   2. state courts of record: 9%
   3. other courts: 0%
   4. administrative agencies 1%

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 50%;
   2. criminal proceedings: 50%

4. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I personally litigated fourteen federal criminal jury trials to verdict in the District of New Jersey while serving as an Assistant United States Attorney. The trials occurred between 1985 and 1990. In eleven of the fourteen trials, I served as sole counsel. In the remaining three, I was either associate or co-counsel. I handled approximately 150-200 cases to final judgment while an Assistant United States Attorney.

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While at Johnson & Johnson, in September 1995, I tried a Title VII employment suit to verdict in federal court in Little Rock, Arkansas, as co-counsel. I handled relatively few matters to judgment since most cases settled.

i. What percentage of these trials were:
   1. jury: 100%
   2. non-jury. 0%

5. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

   1. the date of representation;

   2. the name of the court and the name of the judge or judges before whom the case was litigated; and

   3. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

1. United States v. Pray, Cr. No. 88-175 (Judge John W. Bissell)
The Honorable John W. Bissell presided over this six-month, five-defendant trial beginning in April 1989. I served as lead counsel for the government. Alberto Rivas assisted me in the prosecution. This case was one of the first principal administrator prosecutions in the country. The indictment in this case charged Wayne Pray, a/k/a "Akbar", as a principal administrator (the most severe drug charge permissible under federal law at that time) in violation of 21 U.S.C. § 848. Pray masterminded a multi-million dollar drug ring in the Northern New Jersey area. He operated his ring with impunity for almost twenty years. In fact, the most damaging effect of Pray's criminal enterprise was that it gave him the recognition of a legitimate businessman. He then used this façade to recruit and corrupt young people.

The fifteen-month investigation that I led involved jurisdictions across the United States and culminated in his arrest. The successful effort required the cooperation of the DEA, FBI, Customs Service and ATF in New Jersey, Florida, Michigan, New York and Texas.

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In addition, local law enforcement in New Jersey, particularly the Newark police, played a key role.

The evidence adduced at trial proved that Pray's operation imported several one hundred plus kilogram shipments of cocaine directly from Colombia to Mexico and, thereafter, across the U.S. border. The final destination of the cocaine was New Jersey. Pray made direct contact with Colombian importers who were supplied by the Medellin cartel. Pray used purportedly legitimate businesses in New Jersey as fronts for his drug ring.

After the jury's guilty verdict, Judge Bissell sentenced Pray to life in prison without the possibility of parole. Three of Pray's co-conspirators received substantial prison terms.

Co-Counsel for Government:
Alberto Rivas
Lite DePalma Greenberg & Rivas LLC
Two Gateway Center, 12th Floor
Newark, New Jersey 07102
(973) 623-3000

Counsel for Defendants:
Miles Feinstein, P.A.
1135 Clifton Ave.
Suite 202
Clifton, New Jersey 07013-3642
(973) 779-1124

2. Meitzenheimer v. Janssen, (LR-C-94-677) (Judge Elsijane Trimble Roy)
I served as co-counsel for Janssen Pharmaceutica, a Johnson & Johnson subsidiary, in this federal case in Little Rock, Arkansas. Plaintiff Meitzenheimer alleged that he had been denied a promotion and subjected to disparate treatment. The jury returned a verdict for plaintiff and awarded damages and back pay.

Co-Counsel:
Arkie Byrd
Mays, Byrd & Associates, P.A.
415 Main Street
Little Rock, Arkansas 72201
(501) 372-6303 or 1-800-227-1529

Opposing Counsel:
Philip E. Kaplan
Williams & Anderson, PLC
Stephens Building
Twenty-Second Floor
111 Center Street

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Little Rock, Arkansas 72201
(501) 372-0800

3. United States v. Summey, Cr. No. 88-319 (Judge Nicholas H. Politan)
Defendant was charged with aggravated sexual abuse (rape) of another federal employee on federal government property. This case was of special significance to me because it afforded me the opportunity to help the victim through the most difficult event of her life and assist her in putting this event behind her. Defendant was convicted and sentenced to life without parole.

Defense Counsel:
Gerald E. Fusella
55 Washington Street
Bloomfield, New Jersey 07003-2483
(973) 680-1399

4. United States v. Carbone, Cr. No. 85-371 (Judge Anne E. Thompson)
I served as co-counsel with James Patton in this two-month, two-defendant trial, which involved a drug conspiracy operating between Florida and the New Jersey shore. After a two year investigation involving local law enforcement and the DEA, over twenty members of Carbone's organization eventually pled guilty. Carbone was convicted and sentenced to twenty years. Carbone's co-defendant, Jose Alvarez, was acquitted.

Co-Counsel for Government:
James Patton
209 South Livingston Avenue, Suite 9
Livingston, New Jersey 07039
(973) 992-3500

Defense Counsel:
Howard Brownstein
Brownstein, Booth & Associates
512 42nd Street
Union City, New Jersey 07087
(201) 866-4949

5. United States v. Rossmeyer, Cr. No. 85-373 (Judge Anne E. Thompson)
I served as associate counsel with the First Assistant United States Attorney, Thomas Roth, during this three-month, eight-defendant trial. Bruce Rossmeyer, the owner of a car dealership in Toms River, was charged with participating in a drug conspiracy with seven other members of his sales force and management. The trial ended in a hung jury, but most of the defendants later pled guilty to drug offenses.

Lead Counsel for Government:
Thomas Roth

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395 Pleasant Valley Way
West Orange, New Jersey 07052
(973) 736-9090

Defense Counsel
William J. Martini
United States District Court Judge
50 Walnut Street, Rm 5076
Newark, New Jersey 07202
(973) 645-6340

Jack Ford
Bakefield & Ford
One CNN Center
Atlanta, Georgia 30303
(404) 878-2276

6. United States v. Pelaez, Cr. No. 87-352 (Judge Anne E. Thompson)
I served as sole counsel in this case which charged Pelaez with both threatening to kill a witness to prevent that witness's testimony and operating a cross-country drug operation between California and the east coast. Despite Pelaez's threats against two witnesses, both witnesses testified. Pelaez was convicted and sentenced to twenty years.

Defense Counsel:
Noah Lipman
Law Offices of Noah Lipman
11 Broadway Rm 967
New York, New York 10004
(212) 363-6969

7. United States v. Sardina, Cr. No. 85-300 (Judge John W. Bissell)
This indictment charged two defendants – Roberto Sardina and Javier Fernandez – with operating a stolen car ring. The cars were stolen in New York, driven to New Jersey, and shipped from New Jersey to Puerto Rico, using phony invoices and the assistance of corrupt shipping companies. I was sole counsel for the government. Both defendants were convicted.

Defense Counsel:
Joel Rinsky (retired)
Home:
87 Sullivan Drive
West Orange, New Jersey 07052
(home) (973) 669-8687
(cell) (973) 568-4560

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8. United States v. Ortega, Cr. No. 87-381 (Judge Anne E. Thompson)
I was sole counsel for the government in this three-defendant trial. Ortega, whose base of operation was California, sought to expand to the east coast. All three defendants were convicted. Judge Thompson overturned one of the convictions.

Defense Counsel:
Jerome Ballarotto
143 Whitehorse Ave
Trenton, New Jersey 08610-2643
(609) 581-8555

9. United States v. Cadavio-Gomez, Cr. No. 86-318 (Judge H. Lee Sarokin)
I was sole counsel in this five-defendant trial. The DEA, working with the New Jersey State Police, uncovered a drug operation that moved substantial quantities of cocaine between New York and Florida by car courier. All five defendants were convicted and received substantial sentences.

Defense Counsel:
Howard Brownstein
Brownstein, Booth & Associates
512 42nd Street
Union City, New Jersey 07087
(201) 866-4949

10. United States v. Parra-Restrepo, Cr. No. 87-39 (Judge John W. Bissell)
The three co-defendants in this case were charged with operating a drug conspiracy between New York and New Jersey. Defendant Parra-Restrepo's distributors had entrenched themselves in the outskirts of Atlantic City. With the assistance of a cooperating witness, the DEA gathered evidence that demonstrated Parra-Restrepo's managerial role. Two of the defendants were convicted, and the third pled guilty. I was sole counsel.

Defense Counsel:
John C. Whipple
Arseneault, Whipple, Farmer, Fassett & Azzarello
560 Main Street
Chatham, New Jersey 07928-2119
(973) 635-3366 x217

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s).

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(Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

Based on prior responses, this section shall describe my most significant legal activities while serving as in-house counsel at Johnson & Johnson. I have never engaged in lobbying activities.

1. State of Florida v. Johnson & Johnson Vision Products, Inc., MDL Docket No. 1030, 94-619-CIV-J.20
This was a federal antitrust lawsuit in the United States District Court for the Middle District of Florida. As in-house counsel, I was part of the litigation team for Johnson & Johnson. I participated fully in all aspects of the case. Margaret Zwisler was lead counsel. The State of Florida's Attorney General's Office filed the suit in the summer of 1994. Subsequently, individuals purporting to represent a class of consumers filed cases, which were consolidated in the Middle District of Florida by the MultiDistrict Litigation Panel. The plaintiffs sued Johnson & Johnson Vision Products, Inc. (a subsidiary of Johnson & Johnson), Bausch & Lomb, The American Optometric Association, and eight individual optometrists. The plaintiffs alleged a conspiracy among optometrists and disposable contact lens manufacturers to prevent mail order companies and pharmacies from dispensing replacement disposable contact lenses. The conspiracy was alleged to be a vertical restraint of trade in violation of the Sherman and Clayton Acts.

2. United States v. Ortho Pharmaceutical Corp., Cr. No. 95-12 (WGB)
This criminal action began in January 1991. At first, the United States Attorney's Office, in conjunction with the Food and Drug Administration ("FDA"), initiated an investigation to determine whether Ortho Pharmaceutical, a Johnson & Johnson subsidiary, had promoted a prescription drug – Retin-A – for an unapproved use. The FDA had approved Retin-A for treating acne in the early 1970's. By the mid-1980's, several prominent dermatologists had concluded through empirical research that Retin-A proved effective in treating photodamage, i.e., the damage to the skin caused by overexposure to the sun. Ortho Pharmaceutical proceeded to disseminate scientific information to the medical community and lay media, as is permissible by the FDA's regulations, regarding the effectiveness of Retin-A in treating photodamage. Although the company's actions were in the public domain, the government sought to determine whether Ortho Pharmaceutical had overstepped its bounds and actually promoted (at that time undefined by federal regulation) Retin-A for photodamage, as opposed to disseminating scientific information.

On January 2, 1991, FDA agents went to the homes of two Ortho executives seeking interviews. The next day, the U.S. Attorney's Office served a grand jury subpoena duces tecum on Ortho Pharmaceutical and Johnson & Johnson. Russell C. Deyo, Associate General Counsel of Johnson & Johnson (a former Assistant U.S. Attorney) and the person to whom I reported, accepted service (we both worked on this matter together for over four years). The company cooperated with the investigation from the start and voluntarily produced documents. After over a year of investigation, the government had presented only a few witnesses before the grand jury. In November 1992, while

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interviewing a Johnson & Johnson employee prior to his grand jury testimony, Johnson & Johnson's attorneys (myself included) learned that at the time that the government served its grand jury subpoena, a small number of Ortho Pharmaceutical employees had destroyed some responsive documents.

Johnson & Johnson counsel immediately (a) advised the United States Attorney's Office that there was a problem; (b) adjourned the employee's appearance; and (c) advised the employee to retain outside counsel. Johnson & Johnson then conducted a full-scale investigation of the incident. Our office reported its findings about the destruction of documents to the U.S. Attorney's Office. Indeed, the government received a veritable road map of the document destruction, including names, times, and places. From that point forward, the government's investigation focused on the document destruction. The government presented dozens of witnesses before the grand jury to learn the full parameters of the document destruction. In fact, the government requested that Mr. Deyo and I appear voluntarily in the grand jury. Both Mr. Deyo and I appeared and responded to inquiries about the roles we played in the investigation. The prosecutors represented to our counsel that they (the prosecutors) were not alleging or making assertions that either of us engaged in any wrongdoing or unethical behavior.

Ortho Pharmaceutical pled guilty to a fifteen-count criminal information in January 1995, charging obstruction of justice.

3. Ms. X and Ms. Y v. R.W. Johnson Pharmaceutical Research Institute
This case involved a sexual harassment complaint by two female employees against their supervisor. The complaint originated internally in March of 1992. I worked with our Human Resources Department to address the issues raised. Specifically, the charges against the employees involved poor management style and inappropriate language and conduct. Despite remedial action by the company against the alleged harasser, some of the complained of activity persisted and resulted in a charge filed with the Equal Employment Opportunity Commission ("EEOC"). The claimants retained outside counsel. Over the course of the following sixteen months, I guided the company through the following: a full EEOC investigation, threatened civil litigation, and, finally, negotiations with both the EEOC and opposing counsel to arrive at a settlement. The settlement resulted in the separation from the company of the person accused of harassment and the consensual transfer of complainants.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

Columbia College, Columbia University
2960 Broadway
New York, New York 10027-6902
Adjunct Professor, 2007-present
The Supreme Court: Its Genesis and Progression

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Cardozo School Of Law
55 5th Avenue
New York, New York 10003
Adjunct Professor, 2006-present
Criminal Trial Practice; The Supreme Court: Its Genesis and Progression

Rutgers School of Law – Newark
123 Washington Street
Newark, New Jersey 07102
Adjunct Professor, 2002-2006
The Supreme Court: Its Genesis and Progression; Civil Trial Practice; Criminal Trial Practice; and Ethics

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

None.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

I plan on continuing to teach at Columbia College and Cardozo School of Law.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

See attached Financial Disclosure Report

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

    1. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest

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when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

I do not have any issues regarding family members and potential conflicts of interest.

2. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

Should an issue arise that requires a taut analysis of the applicable ethics rule and the Code of Conduct for United States Judges, I would not hesitate to recuse.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

During my tenure at Kramer Levin, a New York City law firm, I spent a considerable amount of time on two pro bono matters. First, I assisted a senior partner, Gary Naftalis, in an investigation of an allegation of child abuse at a home for special needs children. The Blueberry Home for Children was located in Brooklyn. My work required interviewing the children and preparing reports of the interviews. Second, I took on a criminal appeal under the auspices of the Legal Aid Society. It was an appeal on behalf of a convicted rapist. State v. Luis Mangual required that I file a brief and argue before the First Department (New York State's intermediate appellate court). While at the firm, I worked on other matters pro bono but those were not as time consuming or focused.

In my other legal jobs, pro bono legal work has been restricted by both time and ethical considerations. However, while serving as a district judge, I have found other ways of giving back to the community. For example, I have coached my children's soccer, basketball, baseball, and softball teams. Also, I frequently speak to student groups, ranging in age from 4th grade to law students. Additionally, I have served as a mentor to both undergraduate students at Columbia University and law students at Rutgers School of Law and Cardozo School of Law. Of course, I regularly speak to Bar groups and appear on panels to such groups.

26. **Selection Process**:

1. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or

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communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

My experience regarding the potential to be selected by President Obama as a nominee for the United States Court of Appeals for the Third Circuit is limited. Senators Lautenberg and Menendez each asked me to interview with them in their Washington, D.C. Senatorial offices. I interviewed with both of them in February 2009. Since there is no judicial selection committee in New Jersey there have not been any other steps to address. On March 30, 2009, and June 16, 2009, Cassandra Butts, Deputy Counsel to the President, telephoned me. On March 30, 2009, I was contacted by staff from the Department of Justice regarding the preparation of nomination paperwork. I have had subsequent conversations with Department staff regarding that paperwork and the nomination process. I had an interview with Department of Justice and White House Counsel staff on May 21, 2009. On June 19, 2009, I spoke with Matthew Lehrich from the White House Communications Office.

2. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

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AFFIDAVIT

I, _____, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

6/18/09
(DATE)

Camille Capaccio
(NAME)

CAMILLE CAPACCIO
NOTARY PUBLIC OF NEW JERSEY
My Commission Expires on Feb. 22, 2010

(NOTARY)

Senator WHITEHOUSE. We will take a 5-minute recess—and I do mean 5 minutes—while the table gets turned over for the next panel and people have a chance to assemble themselves.

[Whereupon, at 3:19 p.m. the hearing was recessed.]

AFTER RECESS [3:21 p.m.]

Senator WHITEHOUSE. The Committee will come back to order.

I would ask if the nominees would please stand to be sworn.

[Whereupon, the nominees were duly sworn.]

Senator WHITEHOUSE. Thank you very much. Please be seated.

I think I will proceed in the order of the introductions, which would put Judge Berger at the front of the line.

Welcome, Your Honor. Delighted to have you here.

Judge BERGER. Thank you.

Senator WHITEHOUSE. I call on you for any opening remarks or introductions that you would care to make. I understand that you have family and friends here on this day.

STATEMENT OF IRENE CORNELIA BERGER, TO BE U.S. DISTRICT JUDGE FOR THE SOUTHERN DISTRICT OF WEST VIRGINIA

Judge BERGER. I do. Thank you, Chairman.

First, I would like to extend my heartfelt thanks to President Obama for the honor of the nomination. I also would like to extend my gratitude and appreciation to Senators Byrd and Rockefeller for their recommendation, and also their comments here today.

I thank you and Senator Sessions for being here today and affording us this opportunity. I also would like to thank Senator Leahy for scheduling our hearing.

It is with great pleasure that I introduce to you my brother, Charles Berger, my sister-in-law, Janet Berger, my niece, Charlene Berger, my niece, Michelle Berger, my administrative assistant and best friend, Karen Sword, and her husband, David Sword.

Senator WHITEHOUSE. We are delighted that you're all here today and we welcome you to the Senate Judiciary Committee.

Judge BERGER. My family and I are honored to be here. Thank you.

[The biographical information of Irene Cornelia Berger follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Irene Cornelia Berger

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Southern District of West Virginia

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: Kanawha County Courthouse
   111 Court Street, 7th Floor
   Charleston, WV 25301

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1954; Richlands, Virginia

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   August 1976-May 1979, West Virginia University College of Law; Doctor of Jurisprudence, May 13, 1979

   August 1972-May 1976, West Virginia University; Bachelor of Arts, May 16, 1976

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

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Employment:

July 15, 1994 – Present
West Virginia Supreme Court of Appeals
State Capitol 1900 Kanawha Boulevard East
Charleston, WV 25305
Circuit Judge of Kanawha County

May 1, 1994 – July 15, 1994
Office of the United States Attorney for the Southern District of West Virginia
500 Virginia Street East
Charleston, WV 25301
Assistant United States Attorney

February 1, 1982 – May 1, 1994
Office of the Kanawha County Prosecuting Attorney
700 Washington Street East
Charleston, WV 25301
Assistant and First Assistant

June 1979 – January 31, 1982
Legal Aid Society of Charleston
922 Quarrier St Fl 4
Charleston, West Virginia 25301
Staff Attorney

May 1978 – August 1978
Legal Aid of Morgantown, WV
Summer Intern

Other Affiliations:

West Virginia University Foundation Board of Directors, 2008-present

University of Charleston Board of Trustees, 2000-2003 and 2006-present
(Secretary 2001-2003; 2006-present)

West Virginia University Alumni Association Board of Directors, 1999-2004
(Chair 2003-2004)

West Virginia University Institutional Board of Advisors, 1998-1999

The Mattie V. Lee Home Board of Directors, 1995-1997

Keep A Child In School, Inc. Board of Directors, 1996-1997

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The Legal Services Corporation Board of Directors, 1992-1994

Family and Children Together Board of Directors, Early 1980's

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I have not served in the military.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

2008 West Virginia University Eberly College of Arts and Sciences Departmental Alumni Award Mathematics

2007 Charleston, West Virginia Branch NAACP
NAACP Image Award for Leadership 2007

2006 Outstanding Alumna – West Virginia University Alumni Association

2004 Distinguished West Virginian Award

2004 Kanawha Institute for Social Research and Action
Community Champion Award

2003 Named American Bar Association Foundation Fellow

2003 Mountain State Bar Association Merit Award

2002 Named West Virginia State Bar Foundation Fellow

2002 West Virginia Women's Commission
West Virginia African American Woman of Distinction

2000 YWCA Woman of Achievement

2000 West Virginia University College of Law Women's Law
Caucus Outstanding Woman in the Law Award (Public Sector)

1997 West Virginia Women's Commission
West Virginia Celebrate Women Award in Government

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9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

West Virginia State Bar
Kanawha County Bar Association;
Mountain State Bar Association
West Virginia Judicial Association
Fourth Circuit Judicial Conference
American Bar Association
Chair, West Virginia State Bar Symposium for Legal Services for the Poor (1998-2004)
Chair, John A. Field Jr. Inn of Court (approx year 2000)
Member, Judicial Hearing Board (1996-December 2000 and 2006- Present)

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

West Virginia State Bar, May 1976
There has been no lapse in membership.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

Supreme Court of Appeals of West Virginia and the Courts of West Virginia, May 15, 1979

United States District Court for the Southern District of West Virginia, May 15 1979

Supreme Court of the United States, October 12, 2004

There have been no lapses in membership.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

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West Virginia University Foundation Board of Directors, 2008-present

University of Charleston Board of Trustees, 2000-2003 and 2006-present
(Secretary 2001-2003; 2006-present)

West Virginia University Student Affairs Visiting Committee, 2005-present

West Virginia University Alumni Association Board of Directors, 1999-2004
(Chair 2003-2004)

West Virginia University President's Office of Social Justice Visiting Committee, 2001-2004

West Virginia Supreme Court Child Health Care Commission, 2000

West Virginia University Institutional Board of Advisors, 1998-1999

West Virginia University College of Law Visiting Committee, 1995-1999

The Mattie V. Lee Home Board of Directors, 1995-1997

Keep A Child In School, Inc. Board of Directors, 1996-1997

The Legal Services Corporation Board of Directors, 1992-1994

Governor's Domestic Violence Advisory Committee, 1993-1994

Juvenile Justice Committee, 1990-1993

Family and Children Together Board of Directors, Early 1980's

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

None of the organizations listed in 11a currently discriminate or formerly discriminated on the basis of race, sex, religion, or national origin to the best of my knowledge. (This statement, of course, excludes the time period prior to Supreme Court opinions which prohibited institutions of higher learning from discriminating on the basis of race or national origin).

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12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

"From Classroom to Boardroom" West Virginia Alumni Magazine Fall 2003

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

SPEECHES:

May 16, 2003 ; West Virginia University Alumni Association Morgantown, WV

May 15, 2004; West Virginia University Alumni Association Morgantown, WV

October 27, 2006; Legal Services Corporation Luncheon Charleston, WV

December 10, 2006; West Virginia University Convocation Morgantown, WV

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January 15, 2007; Ecumenical Service Honoring Dr. Martin Luther King Charleston, WV

May 4, 2008; University of Charleston Commencement Charleston, WV

CONFERENCE/PANEL DISCUSSION MATERIALS:

March 25, 1995; Women Violence and the Law; Morgantown, WV

June 1, 1996; Criminal Offenses Involving Violence to Women; Charleston, WV

May 18, 1996; Update on West Virginia Criminal Law; Morgantown, WV

March 28, 1998; Ethics, Demeanor and Credibility in the Courtroom; White Sulphur Springs, West Virginia

May 1, 1998; Ten Ways to Effectively Persuade a Jury; Bluefield, WV

October 20, 1998; Significant Civil Decisions of the West Virginia Supreme Court of Appeals; Davis, WV

April 27, 1999; Authored Civil Decisions of the West Virginia Supreme Court of Appeals; Martinsburg, WV

October 27, 1999; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Pipestem, WV

May 18, 2000; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Wheeling, WV

July 27, 2000; Sixth Annual West Virginia Professional Women's Forum; Charleston, WV

December 5, 2000; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Charleston, WV

March 29, 2001; Significant Civil Opinions of the West Virginia Supreme Court of West Virginia; White Sulpher Springs, WV

May 15, 2001; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Daniels, WV

October 16, 2001; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Parkersburg, WV

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May 8, 2002; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Charleston, WV

October 22, 2002; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Roanoke, WV

January 24, 2003; Update on the Law of Damages in West Virginia; Charleston, WV

May 8, 2003; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Snowshoe, WV

May 9, 2003; Significant Civil Opinions of the West Virginia Supreme Court of Appeals; Snowshoe, WV

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

Charleston Daily Mail interview July 15, 1994
West Virginia State Bar Magazine interview October 1994
Charleston Gazette interview July 5, 1995
ABA Journal interview November 1996
Charleston Gazette interview December 3, 1997
Charleston Daily Mail interview January 19, 1998
Charleston Gazette interview July 20, 1998
Charleston Gazette interview February 9, 2000
West Virginia University Alumni News interview Summer 2003

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

a. Approximately how many cases have you presided over that have gone to verdict or judgment?

I have presided over approximately one hundred seventy seven (177) cases which have gone to verdict or judgment.

i. Of these, approximately what percent were:

jury trials:	97.2%
bench trials:	2.8%
civil proceedings:	55.4%
criminal proceedings:	44.6%

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b. Provide citations for all opinions you have written, including concurrences and dissents.

I have not written any published opinions.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

1. William D. Calfee, Jr. et.al. v. WV Parkways, Economic Development and Tourism (Civil action number 06-C-21)

The plaintiffs alleged that the defendant had unlawfully increased the toll on the West Virginia Turnpike without giving proper public notice and hearing as required by statute. The defendant claimed that proper notice had, in fact, been given and that the toll increases were lawful. After full hearing and a review of the exhibits, I determined that although notice of a "monthly meeting" had been published, no notice of the purpose of the meeting had been given as was required by the applicable statute and ordered the immediate rollback of the toll. The attorneys who litigated the case were: Anthony Veneri 1600 West Main Street, Princeton, WV 24740; James Crockett, Jr., c/o Spilman Thomas and Battle P.O. Box 273, Charleston, WV 25321-0273 and Alex Macia c/o Spilman Thomas P.O. Box 273, Charleston, WV 25321-0273.

2. Karen Fritz v. Tifney Terry et.al (Civil action number 07-MISC-148)

The plaintiff, a resident of Nitro, WV filed an action for injunctive and other relief, alleging that the Treasurer of the city of Nitro had not posted bond in keeping with applicable municipal code after her election to the position. The matter was presented to me for decision on the defendants' motions to dismiss and the plaintiff's motion for summary judgment. The motions to dismiss alleged mootness and no justiciable controversy inasmuch as the defendant, treasurer had posted a bond by the time the action was filed. The plaintiff's motion for summary judgment sought removal of the treasurer based on the language of the applicable code. I ordered the treasurer's removal based on the code language which indicated that the position "shall be deemed vacant" if the bond is not posted within the time prescribed by law. The attorneys who litigated the issues were Mike Clifford 723 Kanawha Blvd. E. Ste.300, Charleston, WV 25301, Troy Giatras c/o The Giatras Law Firm PLLC, 118 Capitol Street Ste.400, Charleston, WV 25301, Mark French c/o Criswell and French PLLC, 405 Capitol Street Ste. 1007, Charleston, WV 25301 and James R. Akers II c/o Akers Law Offices PLLC, P.O. Box 11206, Charleston, WV 25339.

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3. State ex rel City of Charleston v. Board of Public Works et.al.

(Civil action number 03-C-582) The Plaintiff, City of Charleston filed a declaratory judgment action seeking to prevent the West Virginia Lottery Commission, a state agency, from relocating outside of the city limits of Charleston, WV, the capital city and seat of government. The parties presented the issue on cross motions for summary judgment. Given the constitutional history and language, I ruled that the agency could not move outside of the city limits. The Supreme Court refused the case. The attorneys who litigated the case include G. Nicholas Casey, Jr. c/o Lewis Glasser Casey and Rollins, 300 Summers Street Ste. 700, Charleston, WV 25301, Robert B. Allen, c/o Allen Guthrie McHugh and Thomas LLC, P.O. Box 3394, Charleston, WV 25333-3394, Dolores A. Martin, P.O. Box 2749, Charleston, WV 25330, Kelli D. Talbott, State Capitol Complex, Building 1, Room E-26, Charleston, WV 25305, Steven E. Dragisish, State Capitol Complex, Building 1, Room W-435, Charleston, WV 25305, Jennifer D. Scragg, 3389 Winfield Road, Winfield, WV 25213 and Harvey D. Peyton, P.O. Box 216, Nitro, WV 25143.

4. Nancy K. Cartwright v. Herbert J. Thomas Memorial Hospital Assoc. (Civil Action 03-C-2040)

The nurse plaintiff alleged age discrimination and retaliatory discharge against her former employer, defendant hospital. She alleged that she was discharged primarily because of her many protests that the hospital was doing too many cesarean births and that they were being done for the convenience of the doctors. The evidence was that the percentage of these births at the defendant, hospital was higher than the local and national averages. After several days of testimony, jury returned a multimillion dollar verdict in favor of the plaintiff including punitive damages against the defendant, hospital. The amount of the verdict was significant in the hospital community and the evidence raised local awareness through the news media of the claim regarding hospitals increasing the number of cesarean births. Subsequent to the verdict there were significant issues of insurance coverage between the parties. These issues were presented on motion and cross motion for summary judgment. Attached is a letter opinion which addressed those issues. Final Orders are also attached. The attorneys involved in the case included Mark Atkinson c/o Atkinson and Polak PLLC, P.O. Box 549 Charleston, WV 25322, John Polak, c/o Atkinson and Polak PLLC, P.O. Box 549, Charleston, WV 25322 and John Tinney c/o Tinney Law Firm, Bank One Tower Ste 1202,707 Virginia Street East, Charleston, WV 25337.

5. Leo S. Appel et.al. v. Beazer East et.al. consolidated with John R. Parry et.al v. Beazer East (Civil action numbers 98-C-2847 and 98-C- 2872)

The Plaintiffs were former employees, family members of employees and residents of the town where the defendant, employer, Beazer East made creosote. The allegations were that there was a higher incidence of cancer among the

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residents of this town than there is nationally and that the cancer was caused by the unsafe use of creosote. The case presented novel claims for summary judgment consideration. I have attached a letter opinion. After weeks of trial, the jury returned a verdict in favor of the plaintiffs. The attorneys who litigated the case include Guy Bucci and J. Kristofer Cormany, c/o Bucci Bailey & Javins LC, P.O. Box 3712, Charleston, WV 25337, Alan Silko 707 Grant Street, Gulf Tower, Ste. 600, Pittsburgh, PA 15219, H. Blair Hahn P.O. Box 1792, Mount Pleasant, SC 29465, John H. Tinney Bank One Tower, Suite 1202, 707 Virginia Street East, Charleston, WV 25337-3752, Neva G. Lusk c/o Spilman Thomas & Battle, 300 Kanawha Blvd. East, Charleston, WV 25301 and Anthony G. Hopp 225 West Wacker Drive, Chicago, IL 60606-1229.

6. Sonie Petry et.al v. West Virginia University Board of Governors (Civil action number 07-MISC-272)

The plaintiffs, who were employees of West Virginia University Institute of Technology, brought an action seeking a mandamus to compel its governing body, the defendant, Board of Governors to develop a plan addressing faculty salary levels and capital improvement needs in keeping with the applicable statute. The defendant argued that it had previously developed the plan. After full hearing and a review of the exhibits, I found that the plan required by the statutory provisions, had not been developed and ordered the same to be developed within sixty (60) days of the entry of an order. The letter opinion and final order are attached. The attorneys who litigated the issue are Kevin Nelson P.O. Box 3786, Charleston, WV 25337-3786 and Jendonnae L. Houdyschell Senior Asst. Attorney General, Legal Division 8th Floor, 1018 Kanawha Blvd. East, Charleston, WV 25305.

7. State v. Robert Joseph Bradley (Criminal action number 01-F-291)

The defendant was charged with the murder of a man after an argument. Years prior to the incident charged in the indictment, the defendant had suffered a head injury. The defense was that the defendant's head injury caused him to be more impulsive and to act quicker than the average person would under the circumstances. I heard the testimony of the defendant's psychiatric expert in camera and since he did not testify that the defendant suffered from a disease or defect that rendered him incapable of forming the requisite intent, I ruled that the psychiatric testimony would be excluded. The jury convicted the defendant of murder. On appeal, the Supreme Court reversed the conviction finding reversible error in my excluding the psychiatric testimony. According to the opinion, the evidence was relevant to show the defendant's diminished capacity. The case was tried again. The psychiatric testimony was admitted and the defendant was convicted of murder. The West Virginia Supreme Court's opinion is attached. The attorneys who litigated the case are Donald P. Morris 700 Washington St. E. 4th Floor, Charleston, WV 25301, K. Michele Drummond 700 Washington St. E.

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Charleston, WV 25301 and John Mitchell Sr. 206 Berkeley Street, Charleston, WV 25302.

8. State ex rel Jessica A. Justice v. Monongalia County Board of Education et.al. (Civil action number 94-MISC-5000)

The plaintiff brought original jurisdiction mandamus before the Supreme Court of Appeals of West Virginia against her county board of education and the West Virginia Board of Education asking that the defendants be compelled to provide services to her disabled child as required by law under his individual educational plan (IEP). The Supreme Court appointed me special master to take evidence and submit a report regarding the implementation of the required IEP. After numerous hearings and expert submissions, the report was written and submitted to the Court. A copy is attached. The attorneys who litigated the case include Harry M. Rubenstein c/o Dinsmore & Shohl 215 Don Knotts Blvd. Ste. 310, Morgantown, WV 26501, Joseph Price c/o Robinson & McElwee PLLC, P.O. Box 1791, Charleston, WV 25326, Michael Carey c/o Carey Scott & Douglass PLLC, P.O. Box 913, Charleston, WV 25323, Clarke VanDervort P.O. Box 4190 Bluefield, WV 24701 and Dina Mohler c/o Charleston Area Medical Center, P.O. Box 3669 Charleston, WV 25326.

9. Coal River Mountain Watch v. Ellis et.al (Civil action number 06-C-257)

The plaintiffs claimed that legislation which permitted trucks hauling coal to exceed established weight limits in specified parts of the state violated the equal protection clause of the state constitution and also claimed that the legislative enactments violated the separation of powers doctrine in view of certain constitutional amendments. After full hearing and review of counsel's written submissions, I found no constitutional violations. The attorneys who litigated the issues include John H. Skaggs, 500 Randolph Street, Charleston, WV 25302, Albert Sebok c/o Jackson Kelly PLLC, P.O. Box 553, Charleston, WV 25322-0553, Jeffrey J. Miller c/o WVDOH Legal Division, 1900 Kanawha Blvd. E, Room A519-B-5, Charleston, WV 25305-0430, and Richard M. Allen c/o WV Public Service Commission 201 Brooks Street, Charleston, WV 25301-1827.

10. University of West Virginia Board of Trustees et.al. v. Jeffrey Jessen, et.al. (Civil action number 95-AA 290)

The petitioners appealed the decisions of an administrative law judge relative to reclassification of employees of West Virginia University which affected salaries and benefits. Both the University and certain affected employees filed appeals. The cases were consolidated and after lengthy review of the various records, briefs, exhibits and pertinent authority, I affirmed, in large part, the rulings of the administrative law judges. A copy of the order is attached. Attorneys involved in the cases include James Haviland P.O. 3465, Charleston, WV 25334, Robert M. Steptoe, Jr. c/o Steptoe & Johnson, P.O. Box 2190, Clarksburg, WV, James

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St.Clair 630 ½ 7th Ave. Huntington, WV 25701, Mary R. Brandt 135 Northwoods Drive, Morgantown, WV 26508 and Connie A. Bowling 237 Central Ave., South Charleston, WV 25303.

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

Generally, no formal "opinions" are issued. All orders relative to a specific case can be found in the office of the Circuit Clerk, the custodian of all court records. In some cases, I have issued letter opinions to counsel in an effort to guide them in the preparation of an Order.

e. Provide a list of all cases in which certiorari was requested or granted.

92-AA-73	Shawnee Bank v. Paige
93-C-3708	Riddle v. Housing Authority of Charleston
93-C-6021	Steele v. DOH, et al.
94-AA-17	McIntosh v. WV CPRB
94-AA-163	WVU Board of Trustees v. Graf
94-AA-225	Glass V. Dillon, et al.
94-C-1055	Jones v. Bundy, et al.
94-C-1276	Daigle v. WV Governor's Office
94-C-1530	Fernatt v. WV DOH
94-C-1693	Hoffman v. Yost, et al.
94-C-1707	McGraw v. American Tobacco Co., et al.
94-C-1732	Evans v. E.I. Dupont, et al.
94-C-2198	Brown v. Carvill
94-C-2389	Jain v. Ditrapano & Jackson, et al.
94-MISC-687	Webb v. WV Board of Medicine
95-AA-15	Hanlon v. Logan County BOE
95-AA-156	Hazlewood v. Mercer County BOE
95-AA-181	Conner v. Barbour County BOE
95-AA-285	Mahoodian v. WV Board of Medicine
95-AA-290	Board of Trustees/WVU v. Jessen, et al.
95-C-160	Hayes v. State Farm, et al.'
95-C-192	Blake v. CAMC
95-C-233	Connell, et al. v. Smith
95-C-2147	Fleming v. Ferrell
95-C-2878	McKemy v. City of Charleston
95-C-3022	Jeffrey v. WV DPS, et al.
95-C-3652	Hammond v. Bland, et al.
95-MISC-171	Boyd v. WV DNR, et al.
95-MISC-465	Kimberly Industries v. Riley
95-MISC-607	O'Daniels v. City of Charleston

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95-MISC-741	WVU Board of Trustees v. Brewer, et al.
96-AA-37	McVicker v. Kanawha County BOE
96-AA-115	Conner v. Barbour County BOE
96-C-537	Trump v. Long-Airdox
96-C-890	Brunetti v. Winans Sanitary Supply
96-C-964	Lamaar v. KVRTA
96-MISC-84	WV Board of Medicine v. Wang
96-MISC-180	Carey v. Regan, et al.
97-AA-7	Deavers v. Board of Trustees, et al.
97-AA-143	WVU Board of Trustees v. Hickman
97-C-2306	Carvey v. WV BOE, et al.
98-AA-79	Klandorf, et al. V. WVU Board of Trustees
98-AA-138	Bostic v. Kanawha County BOE
98-C-2262	Dunbar FOP v. City of Dunbar
98-MISC-331	Basham v. State of WV
99-AA-148	Cambers v. WV DMV, et al.
99-C-216	D.R., et al. v. Salvation Army, et al.
99-C-991	One Valley Bank v. Borromeo
99-C-1159	Huffman v. Gabbert
99-C-2225	C & H Consolidated Rail Corp.
99-C-2228	Pierce v. Pierce, et al.
99-C-2745	In Re: Kenna Homes
00-AA-3	Simons v. WV DOT, et al.
00-AA-35	WV DNR v. WV Human Rights Commission
00-AA-64	Midkiff v. Wayne County BOE
00-AA-69	Gray v. Kanawha County BOE
00-AA-74	Woods v. BOE of Monroe County
00-AA-85	Akers v. Mercer County BOE
00-AA-95	B B Enterprises v. Palmer, et al.
00-AA-96	JDA Management v. Palmer, et al.
00-AA-179	Haun v. Monongalia BOE
00-AA-194	Richards v. WV DHHR, et al.
00-C-95	Prichard v. Beneficial WV, et al.
00-C-374	Huffman v. Criner
00-C-1155	Dunlap v. Friedman's, et al.
00-C-1434	Ellison v. Doe, et al.
00-C-1593	Sanson v. Brandywine Homes, et al.
01-AA-22	PSC of WV v. Elswick
01-AA-50	Tri-State Concrete Plumbing v. Tax Commissioner of WV
01-AA-65	Body Shop v. WV HRC, et al.
01-AA-102	Hoss v. Pritt, et al.
01-C-955	Jarrell v. Cavender
01-C-2110	Cottrill v. Tucker, et al.
01-C-2740	Spencer v. McClure
01-C-2745	Shannon v. Rubenstein, et al.
01-C-2891	Charleston Radiation Therapy v. Carelink Health Plan

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01-C-3315	White v. Lucas, et al.
01-C-3328	King v. Heffernan, et al.
01-C-3776	Russell v. Verizon, et al.
02-C-1058	Hoover v. Moran
02-C-1334	National Fire Insurance v. MSB Leasing, et al.
02-C-1987	Dolan v. Desai
02-C-2234	Currey v. WV DPS, et al.
02-C-2770	Wilson v. Town of Pratt, et al.
02-C-2989	Givens v. Board of Risk & Insurance Mgmt., et al.
02-C-3107	Whittington v. Toad's Car Wash
02-MISC-8	Trozzi v. Board of Review, et al.
02-MISC-374	Chance v. Parry, et al.
03-AA-168	Berryman, et al. v. Division of Corrections
03-AA-183	International Industries v. Craig, et al.
03-C-90	Scible v. Dawson, et al.
03-C-136	Pruitt v. WV DPS, et al.
03-C-1651	Perdue, et al. v. Wise, et al.
03-C-1758	Aluise v. Nationwide
03-MISC-28	Isabell v. McBride
03-MISC-97	Burdette v. McBride
03-MISC-296	Jarvis v. WV DOC, et al.
04-AA-32	Summers v. WV CPRB
04-AA-39	Butler v. Gilmer County BOE
04-AA-40	Cobb v. Putnam County BOE
04-AA-109	Fraternal Order of the Owls v. Board of Zoning
04-AA-133	Mayflower Vehicle v. Lewis, et al.
04-C-1291	Fraternal Order of the Owls v. City of Charleston, et al.
04-C-2067	Coleman v. Tableting & Packaging Services, et al.
04-C-2197	McClure v. Manchin
04-C-2576	Blessing v. National Engineering, et al.
04-C-2670	Neal v. Marion, et al.
04-C-2728	Caruso v. Pearce, et al.
04-MISC-78	Daily v. Haines
04-MISC-212	Maynard v. Stump
04-MISC-273	Burton v. McBride
05-AA-89	Nelson v. Pocahontas BOE
05-C-645	France v. Heflin
05-C-2499	Sanson v. St. Paul Mercury Insurance Co., et al.
05-MISC-476	Willis v. McBride
06-AA-75	Redmond-Hager v. WV CPRB
06-AA-143	Alderman v. Pocahontas County BOE
06-AA-150	Putnam County BOE v. Sargent
06-AA-176	CAMC v. Shinn, et al.
06-C-257	Coal River Mountain Watch v. Ellis, et al.
06-C-859	McComas v. T & M General Contracting
06-C-1001	J.H. v. WV DRS

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06-MISC-157	Branham v. Seifert
06-MISC-212	Craig v. McBride
06-MISC-243	Barritt v. WV Parole Board
06-MISC-479	Joseph v. McBride
07-AA-153	Hardy County BOE v. Haukland
07-C-1441	Goodman v. Caldwell, et al.
07-MISC-310	McGraw v. Able Debt Settlement
95-F-180	State v. Luther Basham
95-F-258	State v. Charles Lamp, Jr.
95-F-339	State v. Carnes Brown
96-F-301	State v. Glenn Aaron
96-F-364	State v. Charles Guthrie
97-F-71	State v. Taz Allen Whitt
97-F-211	State v. James Isabell
97-F-343	State v. Robert Daily
98-F-413	State v. Elbie Thurman, Jr.
99-F-42	State v. Cory Brown
99-F-79	State v. Samuel Stone
99-F-121	State v. Jerome Williams
99-F-287	State v. James Marcum
00-F-337	State v. David Jeffrey
01-F-291	State v. Robert Joseph
02-F-426	State v. Tracey Brown
03-F-230	State v. Jesse Willis
03-F-416	State v. Myra Angell
04-F-162	State v. Robert Dickerson
04-F-360	State v. Robert Dickerson
04-F-394	State v. Earl Saxton
05-F-129	State v. Earl Saxton
05-F-272	State v. Adonis Thompson
06-F-141	State v. Joshua Slater
06-F-299	State v. Jonathan Lind
07-F-214	State v. Shelby Moore
08-F-125	State v. Marcus Jerdine

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

Isabell v. McBride --- The Supreme Court of Appeals remanded this case for full hearing on the petitioner's allegation of ineffective assistance of counsel made in his petition for habeas corpus. All habeas relief had previously been denied by

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this Court. (Supreme Court of Appeals of West Virginia #31651, 2004; No formal opinion issued)

Roth v. Connolly --- The Supreme Court of Appeals reversed and remanded the case for new trial finding that, given the facts of the case, this Court had erroneously failed to give an instruction on comparative negligence and had erroneously given an instruction on the doctrine of sudden emergency. (203 W.Va. 607, 509 S.E.2d 888, 1998)

Jeffrey v. West Virginia Department of Public Safety et. al. --- The plaintiff appealed the dismissal of his wrongful death claim against the West Virginia Division of Corrections based on the public duty doctrine. The Supreme Court of Appeals remanded the case to this Court for a determination as to whether this state agency had procured applicable insurance coverage. The Court found that the dismissal was premature until a determination about coverage had been made by this Court. (198 W.Va. 609, 482 S.E.2d 226, 1996)

Trozzi v. The Board of Review of the West Virginia Bureau of Employment Programs The Supreme Court reversed this Court's Order denying attorney's fees in a case in which the petitioner had successfully pursued a writ of mandamus against the respondent, Board of Review. (214 W.Va. 604, 591 S.E.2d 162, 2003)

Hoover v. Moran --- The Supreme Court reversed this Court's dismissal, pursuant to Rule 12(b)6 of the West Virginia Rules of Civil Procedure, of the plaintiff's complaint against the defendant, Moran, in his individual capacity. The Supreme Court found that the allegations of the complaint were sufficient to put the defendant, Moran, on notice that he was being sued in his individual capacity. (222 W.Va. 112, 662 S.E.2d 711, 2008)

Pruitt v. West Virginia Department of Public Safety et.al --- The Supreme Court reversed this Court's Order granting summary judgment in favor of the West Virginia Department of Public Safety finding that there were genuine issues of material fact regarding the plaintiff's claims that this defendant failed to adequately train a trooper involved in a shooting death and further finding deficiency in the findings and conclusions contained in this Court's Order. (222 W.Va. 290, 664 S.E.2d 175, 2008)

BB Enterprises, Inc. v. Palmer AND JDA Management Inc. v. Joseph Palmer The Supreme Court reversed this Court's Order affirming an administrative law judge's finding that taxes should be assessed against the taxpayers, who operated exotic show bars and adult entertainment establishments, for special drinks and private dances which could be purchased inside the establishments once the patron entered after paying the cover charge. (214 W.Va. 571, 591S.E.2d 129, 2003)

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Mayflower Vehicle Systems, Inc. v. Vincent Cheeks, et. al. --- The Supreme Court reversed this Court's Order awarding back pay to the appellee, Cheeks, and remanded the case for a factual determination as to the proper date on which discrimination against the appellee occurred thereby determining the date that back pay should began to accrue. (218 W.Va. 703, 629 S.E.2d 762, 2006)

Neal v. J. D. Marion et.al. --- The Supreme Court reversed this Court's Order granting summary judgment in favor of the defendant, Marion, having found that the claim against Marion was filed outside of the applicable ten-year statute of limitations. The Supreme Court found there was evidence of fraud and misrepresentation that fell within the statutory ten-year statute of limitations. (222 W.Va. 380, 664 S.E.2d 721, 2008)

State of West Virginia ex rel. Dunlap v. Berger et.al. --- The Supreme Court granted a Petition for Writ of Prohibition finding that this Court's entry of an Order, staying the petitioner's claims and finding that the petitioner was required by contractual language to arbitrate his claims, was erroneous. (211 W.Va. 549, 567 S.E.2d 265, 2002)

Dunbar Fraternal Order Of Police, Lodge #119 v. The City of Dunbar --- The Supreme Court reversed that portion of this Court's Order requiring the City of Dunbar to pay the full health care premiums for those members of the plaintiff Organization who were under a HMO health care plan. (218 W.Va. 239, 624 S.E.2d 586, 2005)

State of West Virginia v. Robert Bradley Joseph --- The Supreme Court reversed this Court's ruling to exclude certain psychiatric testimony in the defendant's trial for murder and expressly adopted diminished capacity as a defense in this State. (214 W.Va. 525, 590 S.E.2d 718, 2003)

McClung v. The Board of Education of the County of Nicholas --- The Supreme Court reversed this Court's Order affirming the decision of the West Virginia Education and State Employees Grievance Board that the petitioner was not entitled to a school bus operator position for the summer of 1999. The Supreme Court found, given the unique facts of this case, the petitioner was entitled to the position based on seniority. (213 W.Va. 606, 584 S.E.2d 240, 2003)

Herbert J. Thomas Memorial Hospital v. Board of Review of the West Virginia Bureau of Employment Programs et.al. --- The Supreme Court reversed the decision of this Court, which affirmed the ruling of the Board of Review, finding the acts of a former employee of the petitioner, who had stolen food from the cafeteria, did not rise to the level of gross misconduct thereby disqualifying the former employee from receiving unemployment benefits. The Supreme Court found the act was gross misconduct within the meaning of the statute and, therefore, found the employee was disqualified from receiving unemployment benefits. (218 W.Va. 29, 620 S.E.2d 169, 2005)

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Summers et.al. v. The West Virginia Consolidated Public Retirement Board
The Supreme Court reversed the Order of this Court which had denied the appellants' request to include lump-sum payment for accumulated vacation pay in the calculation of their final average salaries for the purpose of determining retirement benefits. (217 W.Va. 399, 618 S.E.2d 408, 2005)

The Honorable John D. Perdue et.al. v. The Honorable Bob Wise, et.al. --- The Supreme Court reversed the Order of this Court which found that the issuance of general revenue bonds pursuant to the Pension Liability Redemption Act did not violate the West Virginia Constitution. The Supreme Court found the issuance was, in fact, unconstitutional in that the Constitution prohibited the state, as a general rule, from incurring debt. (216 W.Va. 318, 607 S.E.2d 424, 2004)

Blessing v. National Engineering & Contracting Company --- The Supreme Court reversed an Order granting summary judgment in favor of the West Virginia Department of Transportation based on the doctrine of sovereign immunity, inasmuch as there was no insurance coverage for the acts complained of in the complaint. The Supreme Court reversed finding genuine issues of material fact existed relative to the issue of coverage. (222 W.Va. 267, 664 S.E.2d 152, 2008)

The University of West Virginia Board of Trustees v. Graf --- The Supreme Court reversed this Court's Order granting the appellee attorney's fees finding that the Order was erroneous because the appellee had previously recovered damages up to the limits of the insurance coverage of the appellant and that, therefore, any additional grant of attorney's fees would violate the doctrine of sovereign immunity. (205 W.Va. 118, 516 S.E.2d 741, 1998)

Glass v. Cathy s. Gatson, Clerk of the Circuit Court et.al --- The Supreme Court reversed an Order of this Court, which had affirmed the decision of the Board of Review, that held the Petitioner had voluntarily quit her employment without good cause involving fault on the part of the employer thereby rendering her ineligible to receive employment compensation benefits. (200 W.Va. 181, 488 S.E.2d 456, 1997)

Brown v. Carvill --- On petition for rehearing the Supreme Court, after initially affirming this Court's decision granting summary judgment, reversed the decision and found that there were genuine issues of material fact as to whether the appellee acted willfully or wantonly towards the petitioner, trespasser, and also found that there were genuine issues of material fact regarding whether the appellee had created a dangerous condition on his property. (206 W.Va. 605, 527 S.E.2d 149, 1998)

Blake v. Charleston Area Medical Center, Inc. (1997) The Supreme Court reversed an Order entered by this Court finding the claim to be barred by the doctrine of res judicata. (201 W.Va. 469, 498 S.E.2d 41, 1997)

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Clay Foodland v. State of West Virginia ex rel. WV Department of Health and Human Resources et.al. (2000) The Supreme Court reversed the Order of this Court upholding the decision of the Department of Health and Human Resources' sanction of the Petitioner for an overcharge violation in the WIC program. Here, the overcharge was the result of employee theft and although employers like the appellant can be held liable for the actions of its employees under the WIC regulations, the Supreme Court found sanctions were inappropriate where the overcharge was the result of theft of which the appellant had no knowledge or participation. (207 W.Va. 392, 532 S.E.2d 661, 2000)

O'Daniels v. City of Charleston (1996) The Supreme Court reversed the Order of this Court due to the failure to join an indispensable party and because of a failure to specifically define the boundaries of the municipal street at issue in the controversy. (200 W.Va. 711, 490 S.E.2d 800, 1997)

Alderman v. Pocahontas County Board of Education (2009) The Supreme Court reversed the Order of this Court which found that the petitioner below, a teacher, engaged in constitutionally protected speech when he criticized his local Board of Education. Further, this Court found that in the event the speech was not protected, mitigation of punishment less severe than termination should have been considered under applicable law. The Supreme Court reversed on both issues. (Supreme Court of Appeals of West Virginia slip opinion #33922, 2009)

Caruso V. Pearce and P&T Trucking, Inc. (2009) In a 3-2 decision, the Supreme Court reversed the Order of this Court which dismissed a complaint pursuant to Rule 41(b) of the West Virginia Rules of Civil Procedure due to the plaintiff's failure to prosecute. The majority opinion found that the inactivity on the part of the plaintiff was due, in part, to this Court not having entered a scheduling order in the case and, therefore, reversed the dismissal. Two justices entered a dissenting opinion and one of the justices who joined in the majority opinion issued a separate concurring opinion. (Supreme Court of Appeals of West Virginia slip opinion #34144)

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

Generally, no formal "opinions" are issued. All orders relative to a specific case can be found in the office of the Circuit Clerk, the custodian of all court records. In some cases, I have issued letter opinions to counsel in an effort to guide them in the preparation of an Order.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

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State ex rel City of Charleston v. Board of Public Works et.al
Civil action number 03-C-582 (The case involved a state constitutional issue of whether a state agency could be located outside of the city limits of the state capital or the seat of government)

Coal River Mountain Watch v. Ellis et.al.
Civil action number 06-C-257 (The case involved the issues of whether certain legislation which permitted trucks hauling coal to exceed established weight limits in certain parts of the state violated the equal protection clause of the state constitution and whether the legislature's enactment of the statutes violated the separation of powers doctrine in view of certain state constitutional amendments).

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have not sat on a federal court of appeals.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I have assessed the necessity or propriety of recusal in keeping with Canon 3E by first ascertaining if there is an actual conflict and secondly by ascertaining whether there is an appearance of conflict.

In instances where there could be an appearance of conflict, I resolve any doubt in favor of recusal. In instances where I had knowledge of a conflict or an appearance of conflict, I have notified counsel on the record in the courtroom or by letter, if no court proceeding

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was imminent. I voluntarily recuse myself from all cases involving parties with whom I have a close personal or professional relationship.

1. In Matter of Charles G. Brown (exact style of case cannot be located due to age)
A motion was made verbally in Court by Mr. Brown's counsel on the day trial was scheduled to begin. Mr. Brown was a public official who had been prosecuted by the office of the Kanawha County Prosecuting Attorney during my employment there. I was minimally involved in the investigation of the case but signed his plea agreement with the office. Although the motion was untimely, and although I thought I could be fair to Mr. Brown, I recused myself. I recused myself finding there to be, at least, a very strong appearance of conflict.

2. John A. Lane, M.D. v. Frank M. Armada (Civil action number 00-C-2372)
A written motion to recuse me was made by Counsel representing Mr. Armada. Mr. Armada had represented a plaintiff in a tort claim filed against my husband and me approximately ten or twelve years earlier. I gave consideration to the fact that Mr. Armada was a party in the lawsuit. I recused myself, finding there to be, at the very least, the appearance of a conflict.

3. Hornbeck v. Fahrenz, et.al. (Civil Action number 96-C-354)
Monty Preiser, one of the party defendants in this legal malpractice case, appeared on the morning of a scheduled hearing and filed a pro se motion to recuse. Prior to this date, Mr. Preiser had been represented by two different attorneys on two prior separate occasions and had never personally appeared. The motion alleged bias in favor of the plaintiff and/or plaintiff's counsel based on prior rulings in the case. I gave consideration to the claims made by Mr. Preiser and to the timing of the motion. Finding the allegations to be baseless and the motion to be untimely, for purposes of the hearing, I denied the motion and proceeded with the hearing. However, since the motion was made more than thirty (30) days before the scheduled trial, I forwarded the matter to the West Virginia Supreme Court pursuant to local trial rules, for its consideration. The Supreme Court denied the motion to recuse.

4. In the Matter of University of Charleston (Correct style of case cannot be located)
The parties and their counsel appeared for hearing and I advised them that I was a member of the Board of Directors of the University of Charleston. I also advised counsel that I thought recusal was appropriate. After a recess to discuss it with their clients, one of the lawyers made a verbal motion to recuse. I recused myself given my involvement as a member of the Board of Directors of the defendant institution.

5. Case involving pro se defendant's habeas who had filed an ethics complaint
Pro se defendant filed a Petition for Habeas Corpus. He subsequently filed a motion to recuse me. I was unaware of the motion to recuse and issued an order denying the petition. The defendant alleged that he had filed an ethics complaint against me and that, therefore, I should recuse myself. I was also unaware of the ethics complaint when I issued the Order denying the petition. Once I became aware of the filing of the ethics complaint, I recused myself finding there to be, at least, an appearance of a conflict.

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15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

I have held no public office other than judicial. I have had no unsuccessful candidacies for elective office or unsuccessful nominations for appointed office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

I am a member of the Democratic Party. I have held no office in any political party and have not been a member of an election committee. I have not held a position or played a role in a political campaign except, of course, as a candidate for the judicial position I now hold.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I did not clerk for a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I have never practiced law alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

July 15, 1994 – Present
West Virginia Supreme Court of Appeals
State Capitol 1900 Kanawha Boulevard East
Charleston, WV 25305
Circuit Judge of Kanawha County

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May 1, 1994 – July 15, 1994
Office of the United States Attorney, Southern District of West Virginia
500 Virginia Street East
Charleston, WV 25301
Assistant United States Attorney

February 1, 1982 – May 1, 1994
Office of the Kanawha County Prosecuting Attorney
700 Washington Street East
Charleston, WV 25301
Assistant and First Assistant

June 1979 – January 31, 1982
Legal Aid Society of Charleston
922 Quarrier St Fl 4
Charleston, West Virginia 25301
Staff Attorney

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator in alternative dispute resolution proceedings.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

During my tenure as a staff attorney with the Legal Aid Society, I primarily represented low income clients in matters involving domestic, consumer and landlord tenant disputes. As an assistant prosecuting attorney and an assistant United States attorney, I prosecuted violent and non-violent crimes representing the citizens of the State of West Virginia and the citizens of the United States of America.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

During my tenure as a staff attorney with the Legal Aid Society, I primarily represented low income clients. As an assistant prosecuting attorney and an assistant United States attorney, I represented the State of West Virginia and the United States of America.

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c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

During my career as an attorney, approximately 99 % of my time involved litigation. I appeared in court frequently.

i. Indicate the percentage of your practice in:
   1. federal courts: 1%
   2. state courts of record: 97%
   3. other courts: 2%
   4. administrative agencies:

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 2%
   2. criminal proceedings: 98%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

During twelve (12) years as an assistant prosecuting attorney I tried forty (40) felony cases and a much smaller number of misdemeanor cases in what was considered to be the court of record at the time. During my brief stint as an assistant United States attorney, I tried two (2) felony cases in the position of associate counsel. Of the forty (40) felony trials, I was sole counsel in eight (8), chief counsel in sixteen (16) and associate counsel in sixteen (16) cases.

i. What percentage of these trials were:
   1. jury: 100%
   2. non-jury.

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe

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in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

1. State of West Virginia v. Dale Shawnessy O'Neil
(Criminal action number 87-F-268)

The defendant was charged with first degree sexual assault, aggravated robbery and malicious wounding of a young woman who he met on the evening of the incident. He threatened her with a knife and made shallow lacerations on her neck during the assault. The defendant was found guilty by the jury. I tried the case during the fall of 1987 before the Honorable Margaret Workman, then Circuit Judge of Kanawha County. The defendant was represented by Robert Bland, now deceased. The defendant, O'Neil was paroled in the past five years and shortly after his release on parole was charged with a murder.

2. State of West Virginia v. Michael Cotton
(Criminal action number 86-M-AP-21)

The defendant was charged with involuntary manslaughter for driving past a stopped school bus and killing a young girl on the first day of school. He had been convicted in the Magistrate Court of Kanawha County and had a right to an automatic de novo appeal to Circuit Court. John Frail and I represented the State and tried the case before the Honorable Judge Robert Abbott, sitting by special assignment during the spring of 1987. The defendant was acquitted. He was represented by Joyce Ofsa c/o Spilman Thomas & Battle, P.O. Box 273, Charleston, West Virginia 25321, Phone: 304-340-3847 and Scott Long, P.O. Box 11070, Charleston, West Virginia 25339, Phone: 304-346-5500. John Frail's address is 500 Virginia Street, Charleston, West Virginia 25301, Phone: 304-345-2200.

3. State of West Virginia v. Francis Ramsey
(Criminal action number 85-F-396)

The defendant was charged with first degree murder of an African American Greyhound bus driver who was passing through Charleston, WV on his route. The driver had gone to the bar of a local hotel and had a dance with a local Caucasian woman. The defendant used racial slurs against the driver. An argument ensued and the defendant killed the driver. He pled guilty to first degree murder on the morning of trial. Charles E. King, Jr. and I represented the State. The defendant was represented by W. Dale Greene 633 Virginia Street W., Charleston, WV 25302, Phone: 304-343-3633. Judge Charles

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King can be contacted at 111 Court Street, 4th Floor, Charleston, WV 25301, Phone 304-357- 0367.

4. State of West Virginia v. Bobby Ray Dawson
(Criminal action number 91-F-87)

The defendant was charged with the first degree murder of his estranged wife and the man the defendant believed she was seeing. He saw them driving on the interstate, shot at them. When they stopped and got out of their car he pulled over, chased them and shot them. The incident was witnessed by numerous travelers on the interstate. William Forbes, (then Prosecuting Attorney of Kanawha County) and I represented the State. The defendant was represented by Fran Hughes. The case was tried before the Honorable Herman Canady, then Circuit Judge of Kanawha, in December 1991. The defense was heat of passion or that the defendant lacked the requisite intent. He was convicted of two counts of second degree murder. William Forbes can be contacted at 28 Ohio Ave., Charleston, West Virginia 25302, Phone: 304-343-4050. Ms. Hughes can be contacted at 734 Hess Drive, Charleston, WV 25311, Phone: 304-558-2021.

5. State of West Virginia v. Floyd Dewey Dolin
(Criminal action number 82-F-259)

This defendant was charged with numerous acts of sexual abuse and assault of his young daughter. The case was tried during the spring of 1984 before the Honorable Patrick Casey, then Circuit Judge of Kanawha County. During the trial Charles King and I, as prosecutors, offered evidence of acts which were not charged in the indictment to show the defendant's intent. The jury convicted the defendant. The Supreme Court reversed the conviction based on the admission of the Rule 404(b) evidence. He was represented by Greg Campbell, c/o Campbell Law Offices, 802 Virginia Street East, Suite 300, Charleston, WV 25301, Phone: 304-342-4815. Judge Charles E. King, Jr. can be contacted at 111 Court Street 4th Floor, Charleston, WV; Phone 304-357-0367.

6. State of West Virginia v. Carla Massey
(Criminal action number 84-F-69)

The defendant was charged with aggravated robbery of a convenience store employee. She was tried during the spring of 1985 before the Honorable Patrick Casey, then, Circuit Judge of Kanawha County. She was convicted and sentenced to the minimum term of ten (10) years. The trial court took the position that under the applicable statutes, the defendant was not eligible for probation. She appealed her sentence and the Supreme Court issued an opinion finding that such a conviction did not preclude probation in instances where no firearm was used. She was represented by Charles Walker (now deceased) and Harry Taylor who can be contacted at 1304 Hunters Ridge Road, Charleston, WV 25314, Phone:304-744-3098. My co-counsel was Michele Rusen c/o Rusen & Auvil PLLC, 1208 Market Street, Parkersburg, WV 26101, Phone: 304-485-6360.

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7. State of West Virginia v. Leroy Owens
(Criminal action number 92-F-214)

The defendant was charged with the sexual assault of his middle aged landlady. The case was tried in November 1993 before the Honorable Herman Canady, then Circuit Judge of Kanawha County. The defense was identification. The jury convicted Mr. Owens of sexual assault in the second degree. He was represented by Nathan A. Hicks, Jr., 803 Quarrier Street Ste. 310, Charleston, WV 25301, Phone: 304-343-1343 and Gregory M. Courtright c/o Collins and Courtright 179 Summers Street Suite 306, Charleston, WV 25301, Phone: 304-345-0589. My co-counsel was John J. Frail 500 Virginia Street E., Charleston, WV 25301, Phone: 304-345-2200.

8. State of West Virginia v. Donna Robinson
(Criminal action number 82-F-9; 82-F-10)

The defendant and her co-defendant were charged with the aggravated robbery of two men they picked up at a gas station. They went to the apartment of one of the men and robbed them. The case was tried during the spring of 1983 before the Honorable John Hey, then Circuit Judge of Kanawha County. The defendant was convicted. She was represented by Michael Mincer, now deceased and Charles Gage whose contact information is now unavailable. Lead counsel for the State and my co-counsel was Dina Mohler c/o CAMC, P.O. Box 3669, Charleston, WV 25326, Phone: 304-388-3762.

9. State of West Virginia v. Hillard Sugg
(Criminal case number 83-F-135)

The defendant was charged with first degree felony murder in the death of his niece. He and his friends were drinking; he set a fire, purportedly to give his sleeping friend a "hot foot". His niece died in the resulting house fire. The case was tried in the summer of 1983 before the Honorable Patrick Casey, then Judge of the Circuit Court of Kanawha County. The defendant was convicted of felony murder. In post trial motions, the Court set the verdict aside finding that the elements of the underlying felony of arson were not satisfied under the facts of the case. The defendant was represented by William C. Forbes 28 Ohio Ave., Charleston, WV 25302, Phone: 304-343-4050 and my co-counsel was James C. Stucky, 111 Court Street, 6th Floor, Charleston, WV 25301, Phone: 304-357-0364.

10. State of West Virginia v. Michael Lloyd
(Criminal action number 83-F-256)

The defendant was charged with first degree murder of a man with whom he had an altercation on the street. My recollection is that he stabbed the victim. The case was tried during the summer of 1984 before the Honorable Robert Harvey, then Circuit Judge of Kanawha County. He was acquitted by the jury on his theory of self defense. He was represented by Edward Rebrook, 723 Kanawha Blvd. East, Suite 300, Charleston, WV 25301, Phone: 304-720-7660 and Don Sensabaugh c/o Flaherty Sensabaugh & Bonasso PLLC, P.O. Box 3843, Charleston, WV 25338, Phone: 304-347-4212. My co-counsel was Neva G. Lusk c/o Spilman Thomas & Battle, P.O. Box 273, Charleston, WV 25321, Phone: 304-340-3866.

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18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

My most significant legal activities, as an attorney, included prosecution of criminal conduct and representation of low income clients who, except through agencies like the Legal Aid Society, would not have had legal representation in civil matters. Insuring that these clients had representation on their habitability claims and in cases of unlawful evictions and consumer protection issues was a substantial part of this representation. As a judge, I had the honor to chair the West Virginia State Bar Symposium for Legal Services for the Poor for approximately five (5) years. This Symposium worked diligently to enhance the quality and efficiency of services provided to low income litigants and to enhance access to courts for pro se litigants. Additionally, for a number of years, after taking the bench, I spoke on the topic of ethics, demeanor and credibility at an annual program presented by the West Virginia State Bar titled "Bridge the Gap". The program was mandatory for young lawyers who had graduated, passed the bar exam but had not yet taken the oath to practice law. This presented a unique opportunity to impress upon young lawyers, as they began their careers, the importance of ethics and the importance of guarding their credibility with the bench and with their fellow lawyers. Lastly, on several occasions I have had the opportunity to go into the community and speak to lay persons about various aspects of the civil and criminal justice system in an effort to enhance their knowledge but, most importantly, their confidence in the system. I have not performed any lobbying activities during my career.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have taught no courses.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

I have no deferred income/future benefits other than retirement benefits associated with current employment.

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21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    I have no plans, commitments, or agreements to pursue outside employment during my service with the court.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report.

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement.

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

       I have no family members or other persons, parties, categories of litigation and financial arrangements that are likely to present potential conflicts of interest.

    b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

       Currently, I guard my personal and business associations in an effort to minimize the potential for conflicts of interest. I avoid impropriety and the appearance of impropriety as required by the Code of Judicial Conduct. In practice, I review the names of the parties in cases assigned to me prior to conducting any proceedings or issuing any rulings to insure that I have no conflict. If I have knowledge of a party, I make the necessary determination as to whether I should preside in the case given the dictates of the Code of Judicial Conduct and I always make counsel and/or the parties aware of any potential conflict. It has been my practice and will continue to be my practice to err on the side of caution and recuse myself if there is even an appearance of impropriety. If appointed, I will continue these procedures and will follow the Code of Conduct for United States Judges as well as any and all associated statutes, policies and procedures.

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25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

My pro bono activities have included chairing the West Virginia State Bar Symposium for Legal Services for the Poor and speaking to community and legal groups regarding procedural and substantive areas of the law as referenced in question number eighteen (18) above. Additionally I have been a panelist/participant in segments taped for public television which were to be used to educate the public about the law. As an attorney, I served on the Juvenile Justice Committee which acted as an arm of the Supreme Court of Appeals of West Virginia and took steps to insure that juveniles involved in the juvenile justice system had appropriate representation and were not improperly incarcerated. Although salaried, I worked for the Legal Aid Society of Charleston providing representation to low income clients in civil matters for almost three (3) years. I have been on the bench for almost fifteen (15) years and have been unable to practice law. Immediately prior to that, I was an assistant prosecuting attorney and was prohibited from practicing law.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

There is no selection commission in West Virginia which recommends candidates for nomination to the federal courts.

Having previously contacted Senators Byrd and Rockefeller by letter to express my interest in a position on the United States District Court, I was honored to receive their recommendation in December of last year for the current vacancy. In March, 2009 I was contacted by the Department of Justice regarding pre-nomination paperwork. Since then, I have had a number of conversations with the Department of Justice and the White House regarding that paperwork and the nominations process. I interviewed with staff from the White House and Department of Justice on May 20, 2009. My nomination was submitted to the Senate on July 8, 2009.

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b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

Absolutely no one has discussed with me any cases, legal issues or questions in a manner that could be interpreted as seeking any express or implied assurances concerning my position on a case, legal issue or question.

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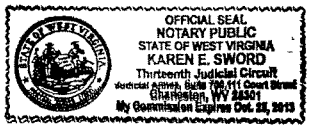
AFFIDAVIT

I, Irene C Berger, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

June 15, 2009
(DATE)

Irene C Berger
(NAME)

Karen E Sword
(NOTARY)



Senator WHITEHOUSE. We're delighted to have you, and congratulations to you on your nomination.

Next, is Bob Lange.

STATEMENT OF ROBERTO A. LANGE, TO BE U.S. DISTRICT JUDGE FOR THE DISTRICT OF SOUTH DAKOTA

Judge LANGE. Thank you very much, Mr. Chairman. I would like to join Judge Greenaway in thanking God. I feel very blessed in my life. Also, thank you to the Committee for the hearing, for Senator Johnson for his introduction of me, and to the President for the nomination.

I'm delighted to be joined here by my wife, Lisa Lange, my youngest sister, Heidi Logelin, and her nine-year-old twins, Madison and Alec Logelin, my dear friends from law school, Tom and Tish Pahl, and by surprise, a raft of my cousins who happened to work in Washington, DC, David Hubbuch, Eleanor Hubbuck, and Mary Lange.

Thank you, Mr. Chairman.

Senator WHITEHOUSE. We are delighted that they are all here, particularly Madison and Alec, who I think will probably find this a memorable day as they grow older as their uncle came to this great day. I applaud you on your nomination and welcome you here.

Judge LANGE. Thank you.

[The biographical information of Roberto A. Lange follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Roberto Antonio Lange.
   I generally am known as Bob Lange.

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the District of South Dakota.

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   206 West 14th Street, Sioux Falls, South Dakota, 57104.

4. **Birthplace**: State year and place of birth.

   1963; Pamplona, Spain.

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1985-1988, Northwestern University School of Law; Juris Doctorate *cum laude*; 1988

   1981-1985, The University of South Dakota; Bachelor of Arts *magna cum laude,* 1985

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

   1989 - present
   Davenport, Evans, Hurwitz & Smith, LLP
   206 W. 14th Street
   Sioux Falls, SD 57104
   partner-owner (1993 to present)
   associate attorney (1989 – 1992)

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1998 – 2002
Family Service, Inc.
2210 Brown Place
Sioux Falls, SD 57105
non-profit board member

1992 – 2002
Delta Gamma Chapter of Delta Tau Delta
114 N. Pine
Vermillion, SD 57069
non-profit board member

1988 - 1989
The Honorable Donald J. Porter
Chief Judge, U.S. District Court for the District of South Dakota
225 S. Pierre Street
Pierre, SD 57501
law clerk

May-Aug 1988
Faegre & Benson
2200 Wells Fargo
90 S. Seventh Street
Minneapolis, MN 55402
summer associate

May-Aug 1987
Davis, Polk & Wardwell
450 Lexington Avenue
New York, NY 10017
summer associate

May – Aug 1986
Bell, Boyd & Lloyd, LLP
70 W. Madison Street
Chicago, IL 60602
summer associate

May-Aug 1985
South Dakota Division of Insurance
445 E. Capitol Avenue
Pierre, SD 57501
intern

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7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

   I have no military service. I registered for the selective service.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

   I attended Northwestern University School of Law on a full tuition scholarship as a Wigmore Scholar. While at Northwestern University School of Law, I received the Shapiro Prize for academic excellence, was named to the Northwestern University Law Review, and was chosen to represent the school on the Jessup International Law Moot Court Team. I was on the Dean's List every graded semester. I graduated with a Juris Doctorate degree, cum laude, with the honor of Order of the Coif (top 10% graduate).

   I received various scholarships while at The University of South Dakota. I received the McGovern-Abourezk Human Rights Award one year. I had other honors such as Omicron Delta Kappa, Phi Beta Kappa, and dean's list every semester. I graduated with a Bachelor of Arts degree, magna cum laude with a University Scholar designation.

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

   American Bar Association
   South Dakota Bar Association
   Minnesota Bar Association
   South Dakota Trial Lawyers Association
   South Dakota Defense Lawyers Association
   South Dakota Civil Pattern Jury Instruction Committee (June 2006 to June 2008)
   South Dakota Continuing Legal Education Committee (2003 to 2005)
   South Dakota Negligence and Tort Law Committee (1996 to 2004, including as chairman from 1998 to 2001.)

10. **Bar and Court Admission**:

    a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

       State Bar of South Dakota; April 1989
       State Bar of Minnesota; January 1991

       There have been no lapses in membership.

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b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

Supreme Court of the Untied States, 2004
United States Court of Federal Claims, 1999
United States District Court for the District of Minnesota, 1995
United States Court of Appeals for the Eighth Circuit, 1991
United States District Court for the District of South Dakota, 1989

There have been no lapses in membership.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Family Service, Inc., 1998 – 2002, non-profit board member

Delta Gamma Chapter of Delta Tau Delta, 1992 – 2002, non-profit board member

Defense Research Institute, 1995 to present

Sioux Falls Area Running Club, 1997 to present

50 States and D.C. Marathon Group USA, 2003 to present

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

None of the above listed organizations invidiously discriminate on the basis of race, sex, or religion, or national origin.

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12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

October 2006, "Credit Card Update" published by my law firm in its *Financial Institution Bulletin.*

An article regarding my participation in a 100 mile race was published as a series in the Sioux Falls Area Running Club newsletter, *The 27th Mile.*

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

I was active in writing or re-writing pattern jury instructions "Owners and Occupiers of Land" in 2006

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

When I speak in or out of court, I typically use a short outline which I do not retain afterwards.

Banking Seminar of Davenport, Evans, Hurwitz & Smith, L.L.P.
April or May of 2009, 2008, 2007 and 2006;
Case law affecting South Dakota banks; I have no copy of notes or outline.

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South Dakota Law Seminar for Midwest Family Mutual Insurance Company March of 2009, South Dakota law summary. I have no copy of notes or outline.

"Preparing Young Leaders of Tomorrow" program of Briar Cliff University, Sioux City, IA; summer of 2007 and 2008; dispute resolution, trial and techniques, work of lawyers

Second Circuit Bar Association; February 2005; experience of appearing before Supreme Court the United States; I have no copy of notes or outline.

Trade Association of Insurance Agents of South Dakota; February 1999; South Dakota Law applicable to insurance agents; I have no copy of notes or outline.

"Law Day" Speeches at various Middle Schools in Sioux Falls; Various years in the 1990s. These were given to middle school children to acquaint them with how the legal system works; I have no copy of notes or outline.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following articles in which I was quoted:

Capital Journal, March 2, 2009, "Lange could be Pierre's next federal judge."

The Associated Press State & Local Wire; November 19, 2008; "Investors sue Daktronics."

Argus Leader (Sioux Falls, South Dakota); August 30, 2006; "3 other men sit on state's death row."

Aberdeen American News (South Dakota); May 24, 2006; "S.D. Supreme Court asked to reinstate lawsuit on hospital pricing Hospital pricing lawsuits resurface High court asked to review billing of uninsured ..."

The Associated Press State & Local Wire; June 14, 2005; "Wal-Mart wants employee suit shifted to federal court."

The Associated Press State & Local Wire; March 30, 2005; "Supreme Court sides with death row inmate, says filing deadline may sometimes be suspended."

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Argus Leader (Sioux Falls, SD); April 11, 1999; "Law should protect pregnant women, mom says."

The Bismarck Tribune; March 29, 1996; Untitled

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

I have not held a judicial office.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? _____

i. Of these, approximately what percent were:

jury trials? ___%; bench trials ___% [total 100%]

civil proceedings? ___%; criminal proceedings? ___% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

e. Provide a list of all cases in which certiorari was requested or granted.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

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h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I have not served as a judge.

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

I have held no public offices. I have had no unsuccessful candidacies for elective office or unsuccessful nominations for appointed office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

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I have never been formally employed by a candidate or campaign, and have never had a title or held office with a campaign. I have provided pro bono service as election counsel to explain election law and to be available to address issues on election day for the campaigns of the following candidates:

John Billion (governor candidate); November of 2006

Kerry-Edwards Campaign; November of 2004

Senator Thomas Daschle; October and November of 2004

Senator Tim Johnson; November of 2002

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I served as a law clerk for the Honorable Donald J. Porter, then Chief Judge of the U.S. District Court for the District of South Dakota, from September of 1988 to September of 1989.

ii. whether you practiced alone, and if so, the addresses and dates;

I have never practiced as a sole practitioner.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

Davenport, Evans, Hurwitz & Smith, LLP
206 W. 14th Street
Sioux Falls, SD 57104
partner-owner (1993 to present)
associate attorney (1989 – 1992)

May-Aug 1988
Faegre & Benson
2200 Wells Fargo
90 S. Seventh Street
Minneapolis, MN 55402
summer associate

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iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

I have focused my practice on civil litigation at administrative, trial and appellate levels. When an associate attorney from 1989 through 1992, I handled more research and briefing assignments, small criminal cases, second-chairing large cases, and first-chairing smaller cases. Once I became partner in the beginning of 1993, my practice gradually shifted toward more complicated commercial litigation and higher stakes civil litigation. My specialty is civil litigation, with a focus on commercial and complex litigation. I presently am the litigation section head of the law firm of Davenport, Evans, Hurwitz & Smith, L.L.P.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

I have specialized in civil litigation throughout my career in private practice. My clients are diverse. I have handled litigation for Sanford Health System and its affiliates in cases that are not routine collection matters or malpractice. I have represented many individuals in personal injury and other cases. I have done defense work for carriers including Acuity, a Mutual Insurance Company, Great West Casualty Company and Midwest Family Mutual Insurance Company. I have handled litigation for banks such as First Bank & Trust, CorTrust Bank, Richland State Bank, and Farmers & Merchants State Bank. I have represented product manufacturers like Daktronics, Inc. I have taken federal appointments, in habeas corpus cases and a drug conspiracy case. I have appeared in administrative matters before agencies like the South Dakota Banking Commission. I also have advised clients on contract matters, litigation avoidance and dispute resolution.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

My practice is nearly 100% litigation or advice on how to avoid litigation or resolve disputes, with frequent court appearances.

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i. Indicate the percentage of your practice in:

1. federal courts;	about 15%
2. state courts of record;	about 75%
3. other courts/tribunals;	roughly 5%
4. administrative agencies	roughly 5%

ii. Indicate the percentage of your practice in:

1. civil proceedings;	95% or more
2. criminal proceedings.	5% or less

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I believe that the number of cases that I have tried in various forums to verdict is in excess of fifty. Of those approximately 50 cases, I was lead counsel in all but six and sole counsel for the party I represented in the bulk of those cases.

i. What percentage of these trials were:

1. jury:	40-45%
2. non-jury:	55-60%

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have handled one case before the Supreme Court of the United States. Rhines v. Weber, 125 S.Ct. 1528 (U.S. 2005). I was the sole attorney of record before the Supreme Court of the United States in this case. I wrote the Petition For Writ of Certiorari, authored the Appellant's Brief and Reply Brief and argued the case for the petitioner. This case is described in detail below, in response to question 17.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. Dates of Representation:
b. Court and Judges Involved :
c. Opposing Counsel :

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i. Rhines v. Weber, 125 S.Ct. 1528 (U.S. 2005); U.S. District Court for the District of South Dakota (Judge Karen Schreier), U.S. Court of Appeals for the Eighth Circuit, Supreme Court of the United States; 2003-present

I was appointed in federal courts to represent Charles Russell Rhines in his federal habeas corpus proceeding to challenge his conviction and his sentence to death by lethal injection. I was the lone attorney of record before the Supreme Court of the United States in this case, although I had co-counsel at other levels.

Before District Judge Karen E. Schreier, the issue arose in the *Rhines* case as to what to do with a federal petition that included "mixed" claims, with some "exhausted" before state courts and other claims that had not been fully exhausted under the Anti-Terrorism and Effective Death Penalty Act ("AEDPA"). Judge Schreier chose to stay Rhines' federal petition, hold the petition in abeyance, and permit Rhines to return to state court in an effort to exhaust the claims that were not ripe for decision in federal court. The grant of "stay and abeyance" avoided a default under the one year statute of limitations enacted by the Anti-Terrorism and Effective Death Penalty Act ("AEDPA"), in the wake of the United States Supreme Court decision in *Duncan v. Walker*, 533 U.S. 167 (2001), which had deemed the statute of limitation in the AEDPA not to be tolled during the pendency of a federal habeas filing.

The United States Court of Appeals for the Eighth Circuit reversed Judge Schreier's decision following the pre-AEDPA United States Supreme Court case of *Rose v. Lundy*, 455 U.S. 509 (1982). *Rose v. Lundy* had decided that federal courts must dismiss habeas corpus cases filed under Section 2254 when there is a "mixed petition" of exhausted and unexhausted claims. Such a result would have forced Rhines to purge his petition of unexhausted claims, thereby sacrificing federal court review of those claims forever.

I wrote the Petition For Writ of Certiorari to the United States Supreme Court. I was the author of the Appellant's Brief and Reply Brief and argued the case for the petitioner. The U.S. Supreme Court's decision in *Rhines v. Weber* was unanimous in reversing the Eighth Circuit and approving of Judge Schreier's issuance of the "stay and abeyance" order.

Opposing Counsel: Attorney General Lawrence E. Long and Deputy Craig M. Eichstedt, 1302 E. Hwy. 14, #1 Pierre, SD 57504, (605) 773-3215.

ii. Nygaard v. Sioux Valley Hospitals and Health System, 2007 S.D. 34, 731 N.W.2d 184; Minnehaha County Circuit Court (Judge Gene Paul Kean) and Supreme Court of South Dakota; 2006-2007.

Sanford Health System, formerly Sioux Valley Hospitals and Health System, was one of the many hospitals sued by class action plaintiffs attorneys. The theory was that, by charging patients without insurance non-discounted charges for

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service, hospitals were engaging in unfair and deceptive trade practices, discriminatory pricing, breaching implied contracts about charging reasonable amounts, breaching implied covenants of good faith and fair dealing, attempting to enforce unconscionable contracts of adhesion, and so forth. The Plaintiffs' attorneys in the *Nygaard* case perceived South Dakota as a good state in which to create precedent that such causes of action could proceed. I argued that the class action claims should be dismissed and that no case should proceed. The Supreme Court of South Dakota agreed and affirmed dismissal of the class action lawsuit.

Opposing Local Counsel : Steven S. Siegel, P. O. Box 2700, Sioux Falls, SD 57101 (605) 332-5999.

Counsel for Other Defendant : Thomas J. Welk, P. O. Box 5015, Sioux Falls, SD 57117, (605) 336-2424

iii. Kalda v. Sioux Valley Physician Partners, Inc., 481 F.3rd 639 (8th Cir. 2007) and 394 F.Supp. 2nd 1107 (D.S.D. 2005); U.S. District Court for the District of South Dakota (Judge Lawrence L. Piersol) and U.S. Court of Appeals for the Eighth Circuit; 2004-2007

The *Kalda* case was an ERISA governed case brought against my client Sioux Valley Physician Partners, Inc. now known as Sanford Clinic. I was lead counsel for the defendants. The predecessor in interest to Sanford Clinic—Central Plains Clinic—had stopped funding retirement plans to its employees due to cash flow difficulties. Central Plains Clinic administration, however, had made some statements about its intent to later fund the plans that allegedly led Central Plains Clinic employees to remain employed in anticipation of having the benefits funded in future years. When the finances of Central Plains Clinic did not improve, a Sioux Valley entity acquired the clinic.

Primarily for tax but also for business reasons, the Sioux Valley entity, in lieu of funding plan contributions for years that had closed, offered retention bonuses in the amount of the foregone plan contributions to those physicians and employees who chose to remain at Sioux Valley for certain periods of time. The Plaintiff group represented individuals who did not become employed at Sioux Valley and purported to represent all Central Plains Clinic employees to seek funding of several years of the suspended plan benefits. The consequence of an adverse verdict to Sioux Valley could have been several million dollars. Ultimately, Judge Piersol granted summary judgment to Sioux Valley Physician Partners, and the Eighth Circuit affirmed.

Lead Opposing Counsel : Dean N. Nasser, Jr., 204 S. Main Avenue, Sioux Falls, SD 57104, (605) 335-0001

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iv. McGreevy v. Daktronics, Inc., 156 F.3rd 837 (8th Cir. 1998); U.S. District Court for the District of South Dakota (Judge Lawrence L. Piersol) and U.S. Court of Appeals for the Eighth Circuit; 1995-1998.

Daktronics, Inc., is a business started by two electrical engineering professors in a garage that has grown to become a worldwide leader in the manufacture of scoreboards and video displays. The *McGreevy* case involved claims of several million dollars against Daktronics, Inc., at a time when Daktronics was at a critical juncture in its business. I was lead counsel for Daktronics.

McGreevy had designed a product known as the "glow cube" which Daktronics used in growing from a regional business into an industry leader in scoreboards and displays. Daktronics had contracted to pay royalties to McGreevy on the numbers of glow cubes, but found itself producing far more than it sold because of the failure rates of and need to replace glow cubes periodically. Daktronics also had given McGreevy exclusive rights to market Daktronics' products in Australia and New Zealand, where McGreevy was from, at a time when Daktronics was just beginning to enter certain international markets. However, when the Summer Olympics were awarded to Sydney and McGreevy appeared not to be moving toward securing contracts for installation at Olympic venues, Daktronics made sales directly to facilities in Sydney, Australia.

McGreevy and Daktronics had different interpretations of the contract on royalties and exclusive marketing rights. McGreevy sued for millions of dollars plus punitive damages. I learned that Daktronics indeed had underpaid McGreevy on glow cubes, and argued to the jury that, while there should be a verdict against Daktronics, it should be of a limited amount. The jury awarded the exact amount that I had suggested, several million dollars less than what the plaintiff sought, after a trial lasting close to two weeks. The case was appealed, and the Eighth Circuit affirmed the judge's rulings and jury verdict in favor of Daktronics.

Lead Opposing Counsel : Charles "Rick" Johnson, now deceased.

v. City of Livonia Employees Retirement System, 239 F.R.D. 476 (D.S.D. 2006); U.S. District Court for the District of South Dakota (Judge Lawrence L. Piersol)

This was a case in which I was the sole counsel for NorthWestern Corporation. There was counsel that represented the other individually named defendants with whom I worked closely.

The city of Livonia, on behalf of all shareholders of NorthWestern Corporation sought to compel NorthWestern Corporation to sell itself. The plaintiffs sought initially to compel Northwestern to sell itself to an entity known as MMPI and subsequently to a Black Hills Corporation. Judge Piersol sided with NorthWestern Corporation and its board initially in refusing to compel the company to sell to either entity. Through forestalling a forced sale and defending

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the litigation, NorthWestern Corporation was able to more rationally evaluate strategic alternatives. Meanwhile, the stock price surpassed the offered prices for MMPI and Black Hills Corporation undercutting the issues that the plaintiffs had sought to address. There potentially was tens of millions of dollars at stake in the case.

Opposing Local Counsel : Timothy J. Dougherty, P. O. Box 2376, Sioux Falls, SD 57101, (605) 335-8586

vi. Hall v. North American Company of Health and Life Assurance, Civ. No. 00-1427; Minnehaha County (Judge W. J. Srstka); 2000-2002

There is no published decision in *Hall*, but the case was one involving a claim of in excess of a million dollars. I was lead counsel defending the North American Company of Health and Life Assurance ("Nacolah") and an agent who was accused of churning life insurance policies to the detriment of two elderly people. The case involved a large number of exhibits, an initial mistrial because of the conduct of a juror, and a very hard case. The plaintiffs' lawyer requested a jury award of several million dollars in compensatory and punitive damages. The jury, however, found for my clients and awarded nothing. The case was tried cleanly, resulting in no appeal of the case.

Opposing Counsel : Mark V. Meierhenry and Clint M. Sargent, 315 S. Phillips Avenue, Sioux Falls, SD, 57104 (605) 336-3075

vii. Yankton Sioux Tribe vs. Crowley & Vogel, P.C., no published opinion; Yankton Sioux Tribal Court (Special Judge John Simpson); 2003-2005.

The Yankton Sioux Tribe hired me to represent it in a plaintiff's case against an accounting firm that, in my view, had grossly over billed the Tribe for work over a period of several years. I agreed to represent the Tribe after being appalled at what I saw of the bills and work product of the accounting firm. I was lead counsel for the Tribe.

I venued the case in Yankton Sioux Tribal Court, and there were tussles regarding the propriety of that court's jurisdiction and venue. The case was hard fought and very difficult for a number of reasons. Shortly before trial, the case was settled contingent upon the consent of the Yankton Sioux Tribe. I addressed the entire Tribe at a general meeting about the merit of the settlement and defended the contingent fee agreement that my firm had entered into with the Tribal Council. After the better part of a day of debate, the members of the Tribe by an overwhelming vote approved of the settlement agreement.

Opposing Counsel : William C. Garry, P. O. Box 2498, Sioux Falls, SD, 57101, (605) 336-0828

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viii. Ashker v. Class, 152 F.3d 863 (8th Cir. 1998) and at 798 F.Supp. 590 (D.S.D. 1992), reversed by 5 F.3d 1178 (8th Cir. 1993), and at 534 N.W.2d 66 (S.D. 1995); U.S. District Court for the District of South Dakota (Judge John B. Jones), U.S. Court of Appeals for the Eighth Circuit, State Circuit Court (Judge Tim D. Tucker); 1994-1998.

District Judge John Jones appointed me to a habeas corpus case for a person convicted of murder. I was lone counsel. Upon reviewing the record, it struck me that there was a violation of Ashker's Confrontation Clause rights by the use of hearsay testimony that was very damning and, I thought, pivotal in securing the conviction.

Judge Jones agreed with my argument, granted habeas corpus relief, and required the retrial of the case. The United States Court of Appeals reversed, not because it did not believe a Confrontation Clause violation had occurred, but rather because the Confrontation Clause claim had not been properly exhausted in state court by previous counsel. I continued with representing Mr. Ashker through state and then subsequent federal proceedings, as a part of the ethical obligation to accept appointments from judges in areas where I am capable of doing the work.

Opposing Counsel: John Haak, P. O. Box 2638, Sioux Falls, SD, 57101, (605) 330-4400

ix. Richland State Bank v. Household Credit Services, Inc., 340 F.Supp. 2nd 1051 (D.S.D. 2004); U.S. District Court for the District of South Dakota (Judge Lawrence L. Piersol), 2002-2004

In this breach of contract case, I was lead counsel for the plaintiff bank in an action against a service provider that was to provide certain services on a credit card program and in collecting credit card debts. With a difficult plaintiffs' case, I survived a summary judgment motion and ended up with a very favorable settlement well into six figures close in time to the trial.

Opposing Lead Counsel: Steven Sanford, P. O. Box 2498, Sioux Falls, SD 57101, (605) 336-0828.

x. Russell D. Quinn v. Midwest Coast Transport, Inc., Civ. 06-409; Codington County Circuit Court (Judge Ronald Roehr); 2007-2008

I was lead defense counsel. Plaintiff Quinn sued my client Midwest Coast Transport, Inc. after a substantial motor vehicle accident on Interstate 29. This was a clear liability case, where, as lead counsel for defendant, my only defense was on proximate cause and damages. Plaintiff's counsel and I had very divergent views of the value of the case, with plaintiff's counsel seeking in excess of $300,000, and with my suggestion to the jury that an award of $30,000 would

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be generous. The jury awarded $25,000. The case was tried cleanly, and no appeal resulted.

Opposing Counsel: Lee A. Schoenbeck, P. O. Box 1325, Watertown, SD 57201 (605) 886-0010.

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

My practice has been litigation oriented. I have not counted how many cases and legal matters in which I have been involved, but suspect that the number likely approaches and perhaps surpasses one thousand. To the client, all such cases are significant. Part of my practice has been to assist clients to avoid the costs and risks of litigation. I have represented parents and spouses who have lost loved ones and helped them resolve their cases short of the stress of trial. I have helped businesses avoid trial and settle cases that threaten to have devastating consequences depending on the verdict. I have not performed lobbying work.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have not as a formal matter taught a course.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

None. When I leave Davenport, Evans, Hurwitz & Smith, LLP, the firm will purchase my partnership interest from me, and I will cease being entitled to further income from the firm.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

I have no such plans, commitments or agreements.

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22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

    My family members are not engaged in business or activities likely to present conflicts of interest, with the possible exception of my father Gerald F. Lange, who is a representative in the Soutb Dakota House of Representatives. I intend to recuse myself on any case involving the constitutionality of legislation passed during his legislative tenure. I have worked for nearly twenty years for Davenport, Evans, Hurwitz & Smith, L.L.P. I intend to recuse myself from cases that were filed by that firm during my affiliation with it, and on all cases involving that firm or clients I served at that firm for a period of two years after I am sworn in as a judge and sever my relationship with that firm.

    b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

    I intend to resolve issues of my potential conflict of interest by referring to any applicable case authority and judicial canons. I intend to err on the side of recusing myself when faced with any legitimate challenge to my impartiality. In all cases, I will follow the Code of Conduct for United States Judges and applicable statutes, polices and procedures.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

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To serve the disadvantaged, I have taken cases, such as *Cid v. S.D. Dept. of Social Services*, 598 N.W.2d 887 (S.D. 1999), where the representation was entirely without pay to a person who could not afford counsel. I also have taken federal habeas corpus and criminal appointments at reduced hourly rates well below what rate my firm charges for my hourly work. For example, the entire pay from my representation of Charles Rhines on appointment by the Supreme Court of the United States was $5,000, which was less than the amount that the printing firm charged to print what I assembled and wrote on the appeal. I have given talks free of charge to various organizations as listed in answer to question 12.d. above, including "law day" talks to middle school students. I have participated in the annual "Ask-A-Lawyer" program of the State Bar of South Dakota where lawyers answer questions anonymously from callers as a form of public service, among other things. I also served for years as counsel for Lutheran Social Services in its refugee resettlement program in Sioux Falls.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

I am not aware of any selection commission in this jurisdiction.

In December of 2008, federal district court judge Lawrence L. Piersol called me to encourage me to apply for the position opened by Judge Charles Kornmann taking senior status. Because I was interested in serving as a federal judge, I sent a letter dated December 19, 2008, with a curriculum vitae to Senator Tim Johnson. I received an e-mail message from the Chief of Staff for Senator Tim Johnson on January 28, 2009, posing a series of questions about my background and qualifications. I responded in detail to Senator Johnson's questionnaire on January 30, 2009. I later had a lengthy interview with Senator Johnson's Chief of Staff. After Senator Johnson recommended me for this position, I have worked with staff from the United States Department of Justice regarding completion of the nomination paperwork. I have had periodic conversations with Department of Justice staff regarding the nomination process. On May 13, 2009, I interviewed with staff from the White House Counsel's office and the Department of Justice. My nomination was submitted to the Senate on July 8, 2009.

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b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

AFFIDAVIT

I, Roberto A. Lange, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

June 15, 2009
(DATE)

Roberto A. Lange
(NAME)

CATHERINE A. MILLER
NOTARY PUBLIC SOUTH DAKOTA
SEAL

Catherine A. Miller
(NOTARY)
Commission Expires: 11-03-2011

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Senator WHITEHOUSE. Next, is Judge Honeywell.

STATEMENT OF CHARLENE EDWARDS HONEYWELL, TO BE U.S. DISTRICT JUDGE FOR THE MIDDLE DISTRICT OF FLORIDA

Judge HONEYWELL. Thank you, Mr. Chairman. I, too, must join Judge Greenaway in thanking God for making this possible.

I am delighted to have present with me at these proceedings a number of family members and friends, but I must first, in addition to thanking God, thank the President for nominating me, thank the members of the Federal Judicial Nominating Commission in our State for sending my name to Senators Martinez and Nelson, thanking them for their support of my nomination, and then thank the Senate Judiciary Committee, thank Senator Leahy for scheduling this, and thank you all for your presence in affording us the opportunity to address you this afternoon.

Traveling with me from Florida are my husband of 18 years, Major Gerald Honeywell.

Senator WHITEHOUSE. Welcome, Major. Glad to have you with us.

Judge HONEYWELL. My 16-year-old son, Brenton Honeywell, my 13-year-old daughter, Brianna Honeywell, and my mother, who is terrified of flying, but made the trip regardless.

[Laughter.]

Senator WHITEHOUSE. Good for her. Good for her.

Judge HONEYWELL. I also have some very dear friends who traveled with me from Florida: my good friend from law school, Willye Dent; a very dear friend, Bettye Johnson; two other very dear friends, Reverend Arthur T. Jones and Mrs. Doris Jones.

I also have present with me this afternoon members of my sorority and college friends from Howard University, many of whom live in the Washington, DC area. I'd just ask if they would stand. I won't introduce them individually, but I do have a number of friends present from college here in support of me today.

Senator WHITEHOUSE. There seems to be a color theme.

[Laughter.]

Judge HONEYWELL. It is: red. That was our sorority color, red and white.

[The biographical information of Charlene Honeywell follows.]

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UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Charlene Vanessa Edwards-Honeywell.

   I am also referred to as Charlene Edwards Honeywell. My former name is Charlene Vanessa Edwards

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Middle District of Florida

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: George Edgecomb Courthouse
   800 East Twiggs Street, Room 522
   Tampa, Florida 33602

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1957; Deerfield Beach, Florida

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1979 – 1981, University of Florida College of Law; Juris Doctor, Dec. 19, 1981

   1975 – 1979, Howard University; Bachelor of Arts, *cum laude,* May 12, 1979

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

Employment:

January 2, 2001 - Present
Thirteenth Judicial Circuit
State of Florida
George Edgecomb Courthouse
800 East Twiggs Street, Rm 522
Tampa, Florida 33602
Circuit Court Judge
Family Law Division - 2001 – 2004; Chief Judge, Family Law Division – 2002 – 2004; Civil Division – 2004 – present

Jan. 1995 - Dec. 2000
Hill, Ward & Henderson, P.A
101 East Kennedy Boulevard, Suite 3700
Tampa, Florida 33601
Senior Associate (litigation attorney), January 1995 – January 1997
Shareholder (litigation attorney), February 1997 – December 2000

July 1, 1994 – December 31, 1994
Thirteenth Judicial Circuit
State of Florida
800 East Kennedy Boulevard, 2nd Fl
Tampa, Florida 33602
County Court Judge

November, 1987 – June, 1994
City of Tampa Attorney's Office
315 East Kennedy Boulevard
Tampa, Florida 33601
Assistant City Attorney
Litigation Division 1987 – 1994; Litigation Division Chief 1988 – 1994

1985 – 1987
Hillsborough County Office of the Public Defender
700 East Twiggs Street, 5th Fl
Tampa, Florida 33602
Assistant Public Defender, Felony Crimes Division

1982 – 1985
Tallahassee Public Defender's Office
301 S. Monroe Street, Suite 401
Tallahassee, Florida 32301
Assistant Public Defender
Appellate Lawyer 1982 – 1984; Misdemeanor Crimes Division 1984 – 1985

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1982
Broward County Public Schools
600 S.E. 3rd Avenue
Fort Lauderdale, Florida 33601
Substitute Teacher

1981
Gainesville Public Defender's Office
35 North Main Street
Gainesville, Florida 32601
Student intern – Juvenile Delinquency Division

1979
Gray's Drug Store
Pompano Fashion Square
Pompano Beach, FL
Cashier

Other Affiliations:

Delta Sigma Theta, Inc., a public service sorority: Tampa Alumnae Vice President (1990 – 1994), Legal Advisor (1986 – 1988 and 1995 – 2000)

Delta, Inc.: Board of Directors (1996 – 2000)

Children's Cancer Center: Board of Directors (approx. 1998 -2000)

Child Abuse Council: Board of Directors (approx. 1997 – 2000)

Tampa Community Health Center: Board of Directors (1987 – 1990)

Tampa Educational Cable Consortium: Board of Directors (1989 -1992)

Jack and Jill of America, Greater Tampa Chapter, Assistant Recording Secretary (2006 – 2008)

I was president of my Inn of Court in 2002-2003. When I was president the name was Justice William Glenn Terrell Inn of Court. We changed the name of the Inn. It is now the J. Clifford Cheatwood Inn of Court.

Hillsborough Association for Women Lawyers: President (1999 – 2000), President-Elect (1998 – 1999), Vice President (Programs 1997 – 1998), Vice President (Membership 1995 – 1996)

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7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

   I have never served in the military.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.
   Legal Career

   Dedicated Service Award from the Tampa City Attorney's Office – 1994
   Dedicated Service Award from the Barristers Association – 1985
   Woman of Distinction Award presented by the Girl Scouts of Suncoast Council
   Living Legend Award presented by Bible-Based Fellowship Church
   Carrie Meek Public Service Award from Delta Sigma Theta Sorority

   Law School
   Appellate Advocacy Honors
   Dean's List
   Legal Research and Writing Honors
   Earl Warren Legal Training Fellowship
   Sadie T.M. Alexander Legal Scholarship
   University of Florida Graduate and Professional Opportunities Fellowship (full academic fellowship to attend law school)

   College
   Who's Who Among Students in American Colleges and Universities
   Pi Sigma Alpha National Political Science Honor Society
   Howard University National Competitive Scholarship (full 4 year academic scholarship)

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

   Florida Conference of Circuit Judges: Civil Section, Marital and Family Relations Section

   Thirteenth Judicial Circuit: Court Reporting Committee and JADS Committee (Computer Technology)

   Florida Federal Judicial Nominating Commission (State of Florida) 1997 – 2000

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Grievance Committee, United States District Court, Middle District of Florida (Tampa and Fort Myers Divisions)

The Florida Bar: Grievance Committee 13E (1990 – 1993), Trial Lawyers Section, Government Lawyers Section, Family Law Section

Hillsborough County Bar Association: Secretary (1998 – 2000), Treasurer (1995 – 1998), Government Law Section (Chair 1992 – 1993), Circuit Court Civil Rules Education and Liaison Committee, Gender, Racial and Ethnic Bias Committee, Professionalism Committee (Co-chair), Liberty Bell Award Committee

Hillsborough County Bar Foundation

George Edgecomb Bar Association: President (1990 – 1992), Second Vice President (1992 – 1993), Parliamentarian (1989 – 1990)

Hillsborough Association for Women Lawyers: President (1999 – 2000), President-Elect (1998 – 1999), Vice President (Programs 1997 – 1998), Vice President (Membership 1995 – 1996); member from approx. 1987 – 2003

J. Clifford Cheatwood Inn of Court: President (2002 – 2003), President-Elect (2001 – 2002), Master (1994 – present), Barrister (1992 – 1994)

Virgil Hawkins Florida Chapter, National Bar Association: President's Council (1990 – 1991)

Latimer Hawkins Judicial Council

Florida Association for Women Lawyers

American Bar Association

National Bar Association

National Bar Association, Judicial Council

Tallahassee Barristers Association: Secretary (1984)

Tallahassee Women Lawyers Association

10. **Bar and Court Admission**:

    a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

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Florida Bar; September 24, 1982
There has been no lapse in membership since my admission in 1982.
As a current member of the State judiciary, I am not eligible to practice law.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

Florida Supreme Court, 1982
Supreme Court of the United States, 1989
United States Court of Appeals for the Eleventh Circuit, 1987
United States District Court for the Middle District of Florida, 1988

There have been no lapses in membership.
As a current member of the State judiciary, I am not eligible to practice law.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

United Way Keel Club (1995 – 2000)

Suncoast Council Girl Scouts of America (2004 – 2008) now known as West Central Florida Girl Scouts of America

Leadership Tampa Alumni (1991)

Delta Sigma Theta, Inc., a public service sorority: initiated 1977, Tampa Alumnae Vice President (1990 – 1994), Legal Advisor (1986 – 1988 and 1995 – 2000)

Delta, Inc.: Board of Directors

University of South Florida President's Citizen Advisory Committee on Black Issues (1992)

Children's Cancer Center: Board of Directors

Child Abuse Council: Board of Directors

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Jack and Jill of America, Greater Tampa Chapter, Assistant Recording Secretary (2006 – 2008)

Tampa Community Health Center: Board of Directors

The Tampa Club (1995 – 2009)

Tampa Educational Cable Consortium: Board of Directors

School Advisory Council: Gorrie Elementary School (2004 – 2007)

Parent Teacher Student Association: Plant High School (2008- 2009), Wilson Middle School (2004 –present), Gorrie Elementary (1999 – 2007)

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

No, the organizations listed in 11a do not discriminate. To my knowledge, they have never discriminated.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

Edwards, Common Errors Made in Lawsuits Against the City, *THE HILLSBOROUGH COUNTY BAR ASSOCIATION LAWYER*, Vol.3, No.8 May 1993 at 6

Edwards, Certiorari Review of Quasi-Judicial Actions, *THE HILLSBOROUGH COUNTY BAR ASSOCIATION LAWYER*, Vol.3, No.7, April 1993 at 17

Edwards, Let the Sunshine In, *THE HILLSBOROUGH COUNTY BAR ASSOCIATION LAWYER*, Vol. 3, No. 3, November 1992 at 14

Edwards, The Public's Right to Know, *THE HILLSBOROUGH COUNTY BAR ASSOCIATION LAWYER*, Vol. 2, No. 5, February 1992 at 8

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b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None, other than legal opinions that I provided to the City of Tampa as part of my duties as an Assistant City Attorney.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

Florida Municipal Attorneys Association: "Employees and Officials – City's Responsibility for Attorney's Fees" - 1990

Judicial Nominating Commission Institute: "Equal Justice for All" – 1992

Mayor's Senior Managers Meeting: "Florida's Public Records Law" - 1992

Speech given at my investiture - February 22, 2001

The Florida Bar Family Law Section: "Temporary Relief" - 2003

George Edgecomb Bar Association: "The Road to the Judiciary" - 2009

Hillsborough Association for Women Lawyers: "So You Want To Be A Judge" 2002

Stetson University College of Law: "Survival of the Fittest" - 2006, 2007

Speech given at a rush for my sorority - January 2008

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George Edgcomb Bar Association: "Ethics Before the Bench, in Words, Speech and Actions" – 2008

Speech given to teenage girls at a career expo - March 14, 2009

Further, I have appeared on panel discussions for bar organizations on numerous topics, including The Florida Bar's Young Lawyers Division, Practicing With Professionalism Seminar, Hillsborough County Bar's Bench Bar Retreat and others.

Additionally, I speak frequently at schools throughout Hillsborough County on a regular basis to educate students about our system of justice and the legal profession. I also speak at forums, civic associations, churches and non-profit organizations on legal topics. Further, I speak at career expos and other events sponsored by Delta Sigma Theta Sorority.

I do not have a prepared text, outline or notes for any speeches other than the following:

February 22, 2001 – speech given at my investiture; January 2008 – speech given at a rush for my sorority; March 14, 2009 – speech given to teenage girls at a career expo.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

"Leaders: Judge Charlene Honeywell," *THE HILLSBOROUGH COUNTY BAR ASSOCIATION LAWYER*, Vol.18, No.9, June 2008.

"Defeat Became Blessing for Judge," the *St. Petersburg Times, Tampa & State* Editions, February 11, 2002.

"Race is close, Gomez moves toward bench," *St. Petersburg Times* (Florida), September 9, 1994

"Know Your Candidates," *St. Petersburg Times* (Florida), August 31, 1994

"Gun promoter sues for right to exhibit on public property," *St. Petersburg Times* (Florida), June 25, 1994

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13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

I served as a County Court Judge in the Thirteenth Judicial Circuit, Hillsborough County, Florida, from July 1, 1994 to January 1, 1995. I was appointed to this position by Governor Lawton Chiles. During this time I presided over civil cases where the amounts in controversy were less than $15,000, small claims cases, landlord tenant disputes, traffic infractions and criminal misdemeanor offenses. Additionally, while sitting as an Acting Circuit Court Judge, I handled simplified and uncontested dissolution of marriage actions. My pending case load averaged 1,500 cases a month in Tampa and 350 cases a month in Plant City.

Currently, I serve as a Circuit Judge for the Thirteenth Judicial Circuit, Hillsborough County, Florida. I was appointed to this position in October 2000 by Governor Jeb Bush. In May 2002, I was elected to this position without opposition. In May 2008, I was re-elected to this position without opposition.

The circuit court is a court of general jurisdiction. As a Circuit Judge, I spent over three years assigned to the Family Law Division. I handled cases involving divorces, child custody, child support, alimony, adoptions, name changes and others. For approximately two (2) years I was the chief judge for the family law division. For the past five years, I have served in the Circuit Civil Division presiding over personal injury cases (automobile, slip and fall, products liability, medical and legal malpractice), commercial disputes (breach of contract, covenants not to compete), mortgage foreclosures, real estate disputes, employment discrimination, petitions for writ of certiorari to review actions of governmental bodies, class actions, and others. I also sit as an appellate judge, on a three judge panel, to review appeals from county court cases. My pending case load averages 3,500 cases a month.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? 135 - 150

   i. Of these, approximately what percent were:

   jury trials? 25 %; bench trials 75 % [total 100%]

   civil proceedings? 100 %; criminal proceedings? ___% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

   As a circuit judge, I sit in an appellate capacity to hear Petitions for Writ of Certiorari seeking review of final orders entered by the Department of Highway Safety and Motor Vehicles. The following citations are for orders entered by me which denied the petitions for writ of certiorari. The initial draft of these opinions was prepared by my staff attorney. The final draft, including revisions,

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clarifications and corrections, was prepared by me. These opinions are reported in the *Florida Law Weekly*, www.floridalawweekly.com:

Hendry v. State of Florida Dept. of Highway Safety & Motor Vehicles, Fla. L. Weekly Supp. 164 HENDR, (Fla. 13th Cir. Ct. 2009)

Hoge v. State of Florida Dept. of Highway Safety & Motor Vehicles, 16 Fla. L. Weekly Supp. 29a (Fla. 13th Cir. Ct. 2008)

Marra v. State of Florida Dept. of Highway Safety & Motor Vehicles, 16 Fla. L. Weekly Supp. 27a (Fla. 13th Cir. Ct. 2008)

Brown v. State of Florida Dept. of Highway Safety & Motor Vehicles, 15 Fla. L. Weekly Supp. 970a (Fla. 13th Cir. Ct. 2008)

Jahnke v. State of Florida Dept. of Highway Safety & Motor Vehicles, 15 Fla. L. Weekly Supp. 968a (Fla. 13th Cir. Ct. 2008)

Hughes v. State of Florida Dept. of Highway Safety & Motor Vehicles, 15 Fla. L. Weekly Supp. 881a (Fla. 13th Cir. Ct. 2008)

Shultz v. State of Florida Dept. of Highway Safety & Motor Vehicles, 15 Fla. L. Weekly Supp. 879a (Fla. 13th Cir. Ct. 2008)

Cummins v. State of Florida Dept. of Highway Safety & Motor Vehicles, 15 Fla. L. Weekly Supp. 872a (Fla. 13th Cir. Ct. 2008)

Ceparano v. State of Florida Dept. of Highway Safety & Motor Vehicles, 14 Fla. L. Weekly Supp. 529b (Fla. 13th Cir. Ct. 2007)

Keiser v. State of Florida Dept. of Highway Safety & Motor Vehicles, 13 Fla. L. Weekly Supp. 324a (Fla. 13th Cir. Ct. 2005)

Millard v. State of Florida Dept. of Highway Safety & Motor Vehicles, 12 Fla. L. Weekly Supp. 636b (Fla. 13th Cir. Ct. 2005)

I concurred, without opinion, in the following cases:

Peachtree Casualty Ins. Co. v. Rucker, 2008 WL 4020186 (Fla. Cir. Ct. 2008)

Pete's Towing Co. v. Scotese, 2008 WL 4019434 (Fla. Cir. Ct. 2008)

Progressive Consumers Insurance Co. v. Newman, 15 Fla. L. Weekly Supp. 129a (Fla. Cir. Ct. 2007)

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Progressive Express Insurance Co. v. Physical Medicine Center, Inc., 13 Fla. L. Weekly Supp. 439a (Fla. Cir. Ct. 2005)

U.S. Security Insurance Co. v. Physical Therapy Walk-In Clinic, P.A., 13 Fla. L. Weekly Supp. 28b (Fla. Cir. Ct. 2005)

Simmons v. Carricato, 13 Fla. L. Weekly Supp. 863a (Fla. Cir. Ct. 2006)

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

I endeavor to make all litigants appearing before me believe that their cases are significant. The following cases have been identified because of their personal significance to me, amount of media attention generated, novelty of the theories advanced or to show the wide variety of cases I have handled:

(1) *Richardson v. State Farm Mutual Automobile Insurance Company*, Case No. 93-8962 (K), County Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. In this case, the Plaintiff sought a determination that the medical bills at issue were reasonable, necessary and related to her automobile accident on March 4, 1992. The case was tried in October of 1994. The attorneys involved were George C. Faugi, Jr., for the Plaintiff, and Karen A. Barnett, for the Defendant. This case has personal significance because it was the first jury trial over which I presided as a judge.

The current address for George C. Faugi is 8903 Regents Park Center, Suite 110, Tampa, Florida 33647. His telephone number is (813) 991-9333. The current address for Karen Barnett is 1000 North Ashley Drive, Suite 650, Tampa, Florida 33602. Her telephone number is (813) 224-9510.

(2) *The Estate of Rodney Riley v. Vantage Healthcare Corporation*, Case No. 99-000366(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. This was a wrongful death nursing home trial over which I presided from January 22 – 30, 2007. After two weeks of trial, the jury returned a verdict in excess of 1.5 million. However, post trial, I granted the defendants' motion for new trial based on juror misconduct. The jury foreperson failed to disclose her prior litigation history. This case is significant because it is the only time I have granted a new trial because of juror misconduct.

The plaintiff's attorney was Brian Thompson. His address is 500 E. Kennedy Blvd., Suite 101, Tampa, Florida 33602. His telephone number is (813) 908-4013. The defendants' attorneys were Kirsten Ullman, 3812 Coconut Palm Drive,

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Suite 200, Tampa, Florida 33619 (813) 739-1900 and James Ragano, Post Office Box 2379, Tampa, Florida 33601-2379 (813) 221-4529.

(3) *Open MRI of Pinellas, Inc., v. Illinois National Insurance Company,* Case No. 03-7103(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. The Plaintiffs brought this class action law suit against AIG and several of its affiliated companies. Four class action lawsuits were consolidated into one case. The lawsuits alleged that magnetic resonance imaging facilities did not receive payment in full in an amount adjusted annually by an additional amount equal to the Medical Consumer Price Index as required by Section 627.736(5)(b)5, Florida Statutes. The defendants vigorously contended that the case was not appropriate for certification as a class action. After an evidentiary hearing, I entered an order certifying a class. The defendants sought appellate review of this order. On June 7, 2006, the appellate court *affirmed, per curiam,* the order certifying a class. Subsequent to the appellate court's decision, the parties settled the litigation. This case is significant because it was the first class action case over which I presided.

The plaintiffs' attorneys were J. Daniel Clark, 3407 West Kennedy Boulevard, Tampa, Florida 33609 (813) 879-0700 and David M. Caldevilla, Post Office Box 2350, Tampa, Florida 33601 (813) 229-2775. The defendants' attorneys were Chris S. Coutroulis and D. Matthew Allen, 4221 West Boy Scout Boulevard, Suite 1000, Tampa, Florida 33607 (813) 229-4301.

(4) *Susanna Gonzalez v. Paul Revere Life Insurance Company,* Case No. 04-7087(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. This was a breach of contract claim brought by the Plaintiff, an attorney, against her insurance company for failure to pay disability income benefits. The trial was held during the week of February 20, 2006. After several days of trial testimony, I granted a mistrial based upon an expert offering previously undisclosed opinions at the trial of this case. The case settled just before the start of the second trial.

The plaintiff's attorneys were John Salter, 5636 US Highway 19, New Port Richey, Florida 34652 (757) 849-4840 and K. Michell Espat, 102 West Whiting Street, Suite 601, Tampa, Florida 33602 (813) 226-1835. The defendant's attorneys were Tim Sullivan and Richard Maselli, 113 South Armenia Avenue, Tampa, Florida 33609 (813) 223-5111.

(5) *Boggs v. City of Tampa*, Case No. 04-7516(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. This was a gender discrimination case brought by a female firefighter under the Florida Civil Rights Act. The plaintiff alleged that she was denied promotions because of her gender. The trial was held April 16, 2007 through April 18, 2007. The jury returned a verdict in favor of the City of Tampa.

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The plaintiff's attorney was Robert McKee, 1718 7th Avenue, Suite 301, Tampa, Florida 33675-0638 (813) 248-6400. The defendant's attorney was Thomas Gonzalez, Post Office Box 639, Tampa, Florida 33601 (813) 273-0050.

(6) *Estate of Rosa Papia v. Neighborcare.* Case No. 02-8097(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. Plaintiff claimed that the defendants negligently provided consultant pharmacy services to Rosa Papia while she was a resident at a nursing home. The plaintiff also sought punitive damages. The trial was held March 5, 2008 through March 12, 2008. At the conclusion of the trial, the jury returned a verdict in favor of the defendant, Neighborcare. This case is significant because the plaintiff alleged negligence against a consulting pharmacist in a nursing home utilizing a novel theory. This was one of the first cases to be tried in this Circuit against a consulting pharmacist.

The plaintiff's attorneys were James Freeman and James Wilkes. 1 North Dale Mabry Highway Suite 800, Tampa, Florida 33609 (813) 873-0026. The defendant's attorneys were Inguna Varslavane-Callahan and Daniel A. Martinez, 2935 1st Avenue North, 2nd Floor, St. Petersburg, Florida 33713 (727) 894-3535.

(7) *Beach v. WCI*, Case No. 04-659(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. This was a construction breach of contract case brought by homeowners against their contractor. The trial was held May 7, 2007 through May 15, 2007. At the conclusion of the trial, the jury returned a verdict in favor of the homeowners. The defendant appealed the jury's verdict alleging, among other things, judicial error. On March 20, 2009, the appellate court issued an affirmance, *per curiam*, of the jury's verdict.

The plaintiff's attorney was Daniel Saxe, 205 Chrystal Grove Boulevard, Suite 101, Lutz, Florida 33548 (813) 909-8855. The defendant's attorneys were Joseph Ianno, Post Office Box 150, West Palm Beach, Florida 33402 (561) 659-7070 and John Lamoureux, 4221 West Boy Scout Boulevard, Suite 1000, Tampa, Florida 33607.

(8) *Ivonne Bermudez v. Associate Primary Care Inc. and Mary Jo Sutherlin,* Case No. 00-3041(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. This was an action for medical negligence in which the plaintiff alleged that the defendant Sutherlin rendered inappropriate medical care to her causing injury. The plaintiff alleged that during the course of her examination by the defendant, Mary Jo Sutherlin, she was physically assaulted. The case was tried from February 19, 2007 through February 26, 2007. The jury returned a verdict in favor of the defendants. This case is significant because it was the first medical negligence case over which I presided.

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The plaintiff's attorney was T. Patton Youngblood, 106 South Tampania Avenue, Suite 100, Tampa, Florida 33609 (813) 258-58883. The defendants' attorney was Jeffrey Hunter, Post Office Box 172669, Tampa, Florida 33672 (813) 223-3951.

(9) *Herrera v. Ag-Mart*, Case No. 06-01725(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. The plaintiffs brought this personal injury claim against Ag-Mart, due to the birth of their baby without limbs. The mother worked in Ag-Mart's tomato fields while pregnant. The plaintiffs alleged that Ag-Mart sprayed pesticides on the fields while the pregnant mother worked in the fields or, alternatively, did not wait sufficient time after spraying the fields before sending the workers back to the fields. After exhaustive discovery, a confidential settlement was reached between the parties. This case is significant because it is one of the first in the state where migrant farm workers sued Ag-Mart Produce, Inc. The case received considerable media attention.

The plaintiffs' attorneys were Andrew Yaffa and Seth Miles, 2525 Ponce de Leon Boulevard, Suite 1150, Coral Gables, Florida 33134 (305) 442-8666. The defendant's attorneys were D. Keith Wickenden and Jeffrey Fridkin, 5551 Ridgewood Drive, Suite 501, Naples, Florida 34108 (239) 514-1000. The court appointed Guardian Ad Litem for the minor child was Anthony T. Martino, Esquire, 3407 West Kennedy Boulevard, Tampa, Florida 33609 (813) 879-0700.

(10) *Environmental Protection Commission v. CC Entertainment and Florida State Fair Authority*, Case No. 04-114049(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. The Hillsborough County Environmental Protection Commission (EPC) sued Clear Channel Entertainment and the Florida State Fair Authority for injunctive relief. The EPC sought to enjoin Clear Channel from having concerts at its Amphitheatre, located on the state fairgrounds, which violated the noise regulations of Hillsborough County. The Defendants sought to dismiss the amended complaint, alleging among other things, that they were entitled to sovereign immunity. I found that the Florida State Fair Authority was entitled to sovereign immunity, but not Clear Channel, as it was not an agent of the state. Clear Channel simply had a landlord tenant relationship with the Florida State Fair Authority. This case is significant because it drew enormous media attention. Every hearing was covered by local television stations and newspapers.

The plaintiff's attorneys were Clinton Paris, 10014 Water Works Lane, Riverview, Florida 33569 (813) 413-7924 and Mark Bentley, 201 North Franklin Street, Suite 1650, Tampa, Florida 33602 (813) 223-5050. The attorney for Clear Channel was G. Donovan Conwell, Jr., 2701 North Rocky Point Drive, Suite 1200, Tampa, Florida 33607 (813) 282-8000. The attorney for the Florida State Fair Authority was Gordon J. Schiff, 1211 North Westshore Boulevard, Suite 401, Tampa, Florida 33607 (813) 286-9777.

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d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

As a trial judge, I don't prepare many written opinions. Orders on motions are usually prepared by the attorneys and submitted to the court for entry.

I prepared a Final Judgment in *Geraci v. Geraci*, Case No. 04-CA-005257(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. The plaintiff's attorney was S. Cary Gaylord, 5001 West Cypress Street, Tampa, Florida 33607 (813) 221-9000. The defendant's attorney was Mark A. Linsky, 503 West Platt Street, Tampa, Florida 33606 (813) 251-5197.

The opinions which I entered, sitting in an appellate capacity, are listed in response to question 13(b) above.

e. Provide a list of all cases in which certiorari was requested or granted.

Bermudez v. Assoc. Primary Care, Inc., 933 So. 2d 528 (Fla. 2d DCA 2006); Per Curiam Denied (Petition for Writ of Certiorari)

Bulmer v. Van Strander, 995 So. 2d 961 (Fla. 2d DCA 2008); Per Curiam Denied (Petition for Writ of Certiorari)

Progressive Exp. Ins. Co. Inc. v. Somona, 972 So. 2d 185 (Fla. 2d DCA 2008); Per Curiam Denied (Petition for Writ of Certiorari)

Progressive Exp. Ins. Co. Inc. v. Somona, 975 So. 2d 461 (Fla. 2d DCA 2007); Petition granted (writ of certiorari) (application of the attorney client privilege in a bad faith action against an insurance company.)

Smith v. McIlwain, 976 So. 2d 1113 (Fla. 2d DCA 2007); Per Curiam Denied (Petition for writ of certiorari)

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

Ostman v. Ostman, 970 So. 2d 502 (Fla. 2d DCA 2007); Reversed and Remanded (evidence insufficient to support upward modification of alimony.)

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Amica Mutual Ins. Co. v. Drummond, 970 So. 2d 456 (Fla. 2d DCA 2007); Affirmed in part, Reversed in Part, and Remanded (insured's failure to submit to examinations under oath was a material breach of a condition precedent to insurer's duty to provide coverage.)

Griffin v. Griffin, 906 So. 2d 386 (Fla. 2d DCA 2005); Affirmed in part, Reversed in part (award of $3000 per month in permanent periodic alimony to ex-husband was erroneous and imputation of $40,000 income to ex-husband was not supported by substantial competent evidence.)

Kuttas v. Ritter, 879 So. 2d 3 (Fla. 2d DCA 2004); Affirmed in part, Reversed in Part, and Remanded (evidence insufficient to support amount of child support increase and ordering retroactive child support was abuse of discretion.)

Mitchell v. Coleman, 868 So. 2d 639 (Fla. 2d DCA 2004); Affirmed in part, Reversed in Part, and Remanded (charging lien should have been limited to property recovered by former husband as a result of attorney's efforts.)

Cone v. Gillson, 861 So. 2d 1210 (Fla. 2d DCA 2003); Reversed and Remanded (order issued to initiate indirect criminal contempt proceeding failed to comply with rule governing indirect criminal contempt.)

Areizaga v. Spicer, 841 So. 2d 494 (Fla. 2d DCA 2003); Affirmed in part, Reversed in part, and Writ of Probibition denied (temporary support order could not support finding that father was in contempt of court.)

Hoirup v. Hoirup, 862 So. 2d 780 (Fla. 2d DCA 2003); Affirmed in part, Reversed in Part, and Remanded (equitable distribution of marital assets was fundamentally erroneous on its face.)

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

I don't have any unpublished opinions. I have thousands of unpublished orders, many of which were not prepared by me. These orders are contained in the court file for each case.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

None.

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i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

None.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

In assessing the necessity or propriety of recusal, I have followed Rule 2.330, Florida Rules of Judicial Administration and Canon 3E, Code of Judicial Conduct. A copy of these provisions is attached. In accordance with these provisions, I have disqualified myself on cases where parties have presented legally sufficient motions. I have disqualified myself, *sua sponte*, on cases involving former clients, former law partners, and the City of Tampa Police Department, my husband's employer.

I don't keep a list of cases in which I have entered orders of disqualification. I have obtained some of this information from the clerk of court. I entered orders of disqualification in approximately 22 civil cases and 13 marital and family cases.

I denied motions for disqualification in the following civil cases:

Parthenon Inc. v. Surinder Joshi, Case No. 03-CA-3357(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida; and
Earnest B. Haire v. Bicoastal Holding Co., Case No. 07—CA-3842(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida.

I also denied motions for disqualification in marital and family cases. I don't recall the names of these cases and the clerk has been unable to create such a list.

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

I recused myself *sua sponte* in each of the 22 civil cases. I recused myself *sua sponte* in 10 of the marital and family cases. Motions for disqualification were filed by parties and granted in the following cases:

Efrain Areizaga v. Jody Spicer, Case No. 00-DR-4792(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida;

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Frances Herce v. Robert Herce, Case No. 02-DR-770(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida; and

Kathryn Tracy v. Patrick Tracy, Case No. 02-DR-9261(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida.

b. a brief description of the asserted conflict of interest or other ground for recusal;

In *Parthenon v. Joshi*, the motion was denied because it was legally insufficient. The plaintiff alleged a conflict because my son played football on the same team as the defense attorney's son. She further alleged a conflict because I threatened to initiate contempt proceedings against her for disobeying several orders of the court.

In *Haire v. Bicoastal Holding Co.*, the motion was denied because it was legally insufficient. The plaintiff alleged that he may not be treated fairly by me because his ex-wife told a bankruptcy judge (not me) that plaintiff called me a racial slur beginning with the letter N. Interestingly, I would not have known about the statement of the ex-wife, but for the plaintiff's motion.

I do not recall the basis for the motions for disqualification in the marital and family law cases. I have not been able to obtain this information from the clerk's office.

c. the procedure you followed in determining whether or not to recuse yourself;

The procedure is set forth in rule 2.330, Florida Rules of Judicial Administration and Canon 3E, Code of Judicial Conduct. Under Florida's "one free bite" policy, the litigant only needs to file a legally sufficient motion to have a judge disqualified.

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I recused myself in all cases where the party filed a legally sufficient motion.

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

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I was appointed by Senator Bob Graham in 1997 to the Florida Federal Judicial Nominating Commission. I served until 2000, when I was appointed a state court judge.

In early 1994, I was one of three (3) finalists for a county court judge. I was subsequently appointed in June 1994 by Governor Lawton Chiles. After being appointed in June 1994, I stood for election to this seat in September 1994. I lost the countywide election by less than 2% of the vote.
In the fall of 1994, I was one of five (5) finalists for a federal magistrate with the United States District Court, Middle District of Florida. I was not selected for this position.

In 1999, I was one of six (6) finalists for a circuit court judge. I was subsequently appointed in October 2000 by Governor Jeb Bush.

In December 2007, I was one of six finalists recommended by the Federal Judicial Nominating Commission for two (2) vacancies on the United States District Court, Middle District of Florida. One vacancy was filled. The other vacancy has not been filled.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

None.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I did not clerk for a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I never practiced alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

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1982 – 1985
Tallahassee Public Defender's Office
301 S. Monroe Street, Suite 401
Tallahassee, Florida 32301
Assistant Public Defender
Appellate Lawyer 1982 – 1984
Misdemeanor Crimes Division 1984 – 1985

1985 – 1987
Hillsborough County Office of the Public Defender
700 East Twiggs Street, 5th Fl
Tampa, Florida 33602
Assistant Public Defender, Felony Crimes Division

Nov. 1987 – June 1994
City of Tampa Attorney's Office
315 East Kennedy Boulevard
Tampa, Florida 33601
Assistant City Attorney
Litigation Division 1987 – 1994
Litigation Division Chief 1988 – 1994

Jan. 1995 - Dec. 2000
Hill, Ward & Henderson, P.A
101 East Kennedy Boulevard, Suite 3700
Tampa, Florida 33601
Senior Associate (litigation attorney), January 1995 – January 1997
Shareholder (litigation attorney), February 1997 – December 2000

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I was appointed by United States District Judges to arbitrate cases pending in the Middle District of Florida between 1995 and 2000. I have no records available to identify or describe these proceedings. I also served as a mediator between 1995 and 2000 on state and federal cases. I have no records available to identify or describe these proceedings.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

From 1982 until 1987, I served as an assistant public defender. In this practice, I represented indigent defendants who were charged with

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criminal violations. For two years, I handled criminal appeals before the First District Court of Appeal and the Florida Supreme Court. For the next three years, I handled trials for the Public Defender's Office: one year in the misdemeanor division in Tallahassee, Florida and two years in the felony division in Tampa, Florida. As a trial lawyer for the Public Defender's Office, I was in court almost every day.

From 1987 until 1994, I served as an assistant city attorney and the chief of litigation for the City of Tampa. In that position, I defended the City in lawsuits filed against it and I initiated lawsuits on the City's behalf. There, my practice was limited to civil cases in federal and state courts, at the trial and appellate level. The cases included personal injury, civil rights, eminent domain, contracts, injunctions, declaratory judgments, mortgage foreclosures, public records disputes, petitions for writ of mandamus, replevin, garnishment, quiet title, zoning and pension board actions. As chief of the department, I trained and supervised other assistant city attorneys assigned to the litigation division. In the absence of the City Attorney, I attended mediation hearings on behalf of the City, at which I had complete settlement authority, subject only to the City Council's approval. Additionally, I was responsible for all issues regarding public records and ethics violations. In this capacity, I drafted legal opinions regarding breaches of the state's ethics code and requests for public records. My experience with the City Attorney's Office was an invaluable learning experience from which I obtained a broad background in civil law

From 1995 until 2000, the general nature of my law practice was that of associate attorney and shareholder in the litigation practice group of the law firm of Hill, Ward & Henderson, P.A., a Martindale Hubbell AV rated firm. I handled, primarily, products liability, employment discrimination, securities, civil rights, police misconduct and commercial law cases in state and federal court. Additionally, I handled a few family law cases in state court. My practice was generally limited to complex civil litigation.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

I did not specialize or obtain board certification in any area of practice.

As an assistant public defender, I represented clients on cases ranging from disorderly intoxication and driving while intoxicated, to attempted first-degree murder, capital sexual battery and racketeering.

In private practice, my typical clients were corporations that had been sued by individuals for wrongful death, personal injury, discrimination and harassment, civil rights violations and contract disputes. In the area of family law, I represented individuals from all walks of life. Among my

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clients were: R. J. Reynolds Tobacco Company (products liability), Baxter Healthcare Corporation (products liability), Healthcare and Retirement Corporation (discrimination), Piccadilly Cafeteria (discrimination), and the City of Tampa (Section 1983 police misconduct).

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

From 1984 through 1987, while employed as an Assistant Public Defender, I appeared in court almost every day, approximately 20 times a month. From 1987 through 2000, as a civil trial attorney, the frequency of my appearances in court decreased. I appeared in court an average of 5 times a month. These court appearances included evidentiary hearings, such as motions for temporary injunctions, and non-evidentiary hearings, such as motions to dismiss and motions for summary judgment.

i. Indicate the percentage of your practice in:
   1. federal courts: 38%
   2. state courts of record: 58%
   3. other courts: 3%
   4. administrative agencies: 1%

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 68%
   2. criminal proceedings. 32%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I have tried approximately 22 jury trials and 12 non-jury trials. I was sole counsel in 19 of the jury trials and all of the non-jury trials. Of the remaining three (3) jury trials, I was lead counsel in one, co-counsel in one, and associate counsel in the other

i. What percentage of these trials were:
   1. jury: 65%
   2. non-jury: 35%

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

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I have not practiced before the Supreme Court of the United States other than in 1989, while employed as an assistant city attorney, I prepared a jurisdictional brief for respondent. The case was *Marzuq A. Al-Hakim, et. al, Petitioners v. Tampa City Council, Respondent*; Case No 88-7141.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

    a. the date of representation;

    b. the name of the court and the name of the judge or judges before whom the case was litigated; and

    c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

(1) *Robinson v. State*, 462 So.2d 471 (Fla.1st DCA 1984), *rev, denied*, 471 So.2d 44 (Fla.1985). I represented Victor Robinson on the appeal before the First District Court of Appeal. Mr. Robinson was a student at FAMU and a high school classmate of mine from Pompano Beach, Florida. This case received immense publicity in Tallahassee. The appellate decision was issued on December 3, 1984, and written by Judge Zehmer and concurred in by Judges Ervin and Booth. Wallace Allbritton, Assistant Attorney General, represented the State of Florida. Mr. Albritton's current address is unknown.

Victor Robinson was charged with and convicted of sexual battery and kidnapping. At the conclusion of the trial, Robinson's trial attorney requested an extension of time to file a motion for a new trial, which was granted by the court. The trial court also granted the motion for new trial, finding that the weight of the evidence was so tenuous as to require a new trial in the interests of justice. Because the trial court had no authority to extend the time for filing a motion for new trial, no new trial was held and Robinson was adjudicated guilty of the offenses.

The case is significant because the appellate court recognized the fundamental injustice which fell upon Robinson due to his attorney's failure to timely file a motion for new trial. This was only the second time that the First District Court of Appeal had granted a criminal defendant a new trial in the interests of justice. The appellate court opined that the foremost obligation and interest of the courts is seeing that justice is ultimately done.

(2) *State of Florida v. Herbert Bernard Holley*, Case No. 87-2107(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. The case was litigated before Judges John Griffin and William Graybill (presided over trial). This case was tried October 12 – 15, 1987. Assistant State Attorneys Karen Cox and Steve Crawford

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represented the State of Florida in the case. The Second District Court of Appeal's decision is reported at *Holley v. State*, 564 So.2d 595 (Fla. 2nd DCA 1990).

I represented the defendant, Herbert Holley, from arraignment to filing of the Notice of Appeal, at the conclusion of the trial. The defendant was charged with one count of racketeering, eighteen counts of robbery, and one count of attempted robbery. He was tried by jury and convicted of one count of racketeering and twelve counts of robbery with a deadly weapon. Mr. Holley was one of the first defendants in Hillsborough County to be charged with a violation of the then recently enacted Racketeering Statute, § 895.03(3), Florida Statues (1985).

At the time Mr. Holley was charged under the statute, there was no case law in the Second District interpreting the racketeering statute as it applied to individuals who were acting alone. In pretrial motions and memoranda, I argued that the court should dismiss the racketeering count because one person acting alone cannot be an enterprise absent proof that he used a business entity as a conduit for criminal activities. The trial court ruled in the defendant's favor, dismissed the racketeering count, but later changed the opinion at the urging of the State Attorney's Office. The appellate court agreed with my pretrial argument and reversed the trial court's decision. This case was significant because it provided an interpretation of the racketeering statute to guide the trial judge, state attorney and defense attorneys in future cases.

The current address for Karen Cox is Post Office Box 3913, Tampa, Florida 33601. Her telephone number is (813) 224-9255. The current address for Steve Crawford is 610 West Bay Street, Tampa, Florida 33606. His telephone number is (813) 251-2273.

(3) *Chavez v. City of Tampa*, 560 So.2d 1214 (Fla. 2nd DCA 1990), *rev. denied*, 576 So.2d 285 (Fla. 1990). I represented the City of Tampa on the appeal before the Second District Court of Appeal. The opinion was issued on March 16, 1990, by Judges Danahy, Frank and Schoonover. Guy M. Burns and Jacqueline W. Hubbard of Johnson, Blakely, Pope, Bokor, Ruppel and Burns, P.A., represented Helen Chavez.

Helen Chavez requested that the City of Tampa reimburse her for her legal expenses incurred in defending herself before the Florida Commission on Ethics on ethics charges. The City refused to pay her legal expenses. Prior to the refusal, Ms. Chavez had been advised by an Assistant City Attorney that her participation in a vote on her petition for alcoholic beverage zoning classification would be a conflict of interest. Despite the advice, she voted on the petition. This case is significant because it emphasizes that public officials are held to a high standard of conduct. They are to be independent, impartial and they are not to use the public office for private gain. The appellate court clearly defined the term public purpose, such that all public officials would be informed as to acceptable and unacceptable behavior.

The current address for Guy Burns is 403 East Madison Street, Suite 400, Tampa, Florida 33602. His telephone number is (813) 225-2500. The current address for Jacqueline

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Hubbard is 3301 Tamiami Trail, East, Naples, Florida 34112. Her telephone number is (239) 774-8400.

(4) *Scott P. Johnston v. City of Tampa*, Case No. 89-744-Civ-T-15B, United State District Court, Middle District of Florida, Tampa Division. Judge William J. Castagna issued an opinion on August 19, 1991. I served as co-counsel for the City of Tampa with Thomas Gonzalez, Esquire. I represented the City on count II of the complaint, negligence. Jeffery Stull and David Dee represented the Plaintiff. The court granted the City's Motion for Summary Judgment and entered a Final Judgment in favor of the City.

Johnston was a police officer for the City of Tampa for seven months. During that time he used deadly force, a firearm, to kill a robbery suspect. The Tampa Police Department determined that Johnston used deadly force contrary to department policy. Johnston resigned, under pressure, and sued the City for forced resignation and negligent training. On the negligent training issue, count II, the court found no duty by the City to train law enforcement officers who harm others in violation of local policy. This case is significant because if Plaintiff had prevailed on his negligence count, an employee who is fired because of failure to follow policies set by his employer would be able to sue his employer for failure to exercise due care in training him to comply with such policies.

The current address for my co-counsel, Thomas Gonzalez, is 201 North Franklin Street, Suite 1600, Tampa, Florida 33602. His telephone number is (813) 273-0050. The current address for Jeffrey Stull is 602 South Boulevard Avenue, Tampa, Florida 33606. His telephone number is (813) 251-3914. The current address for David Dee is 405 West Azeele Street, Tampa, Florida 33606. His telephone number is (813) 258-0406.

(5) *Community Blood & Plasma v. City of Tampa*, Case No. 89-383-Civ-T-22B, United States District Court, Middle District of Florida, Tampa Division. Judge Anne Conway issued an opinion on April 22, 1992. I represented the City of Tampa and Larry Stumpf, Esquire, represented the Plaintiff. The court granted the City's Motion for Summary Judgment and entered a Final Judgment in favor of the City. Plaintiff appealed this Final Judgment to the Eleventh Circuit Court of Appeals, which affirmed the District Judge's opinion. I also represented the City on the appeal.

Plaintiff operated a blood donor center on Kennedy Boulevard in Tampa, Florida. Pursuant to the City of Tampa zoning ordinances, blood donor centers could not be located within specified distances of residential areas and other blood donor centers. Plaintiff filed a seven-count complaint challenging the constitutionality of the pertinent zoning ordinances. The District Court upheld the constitutionality of the zoning ordinances. This case is significant because Plaintiff urged the court to adopt a new minimum standard of review when analyzing challenges to municipal ordinances. The District Court and the Eleventh Circuit rejected Plaintiff's argument and applied the rational basis test. Zoning ordinances are essential to protect residential areas and preserve the integrity of neighborhoods. Kennedy Boulevard is the main road leading into downtown Tampa.

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The current address for Larry Stumpf is 201 South Biscayne Boulevard, Suite 1300, Miami, Florida 33131. His telephone number is (305) 371-6421.

(6) *Ernest C. Sexton, Sr., et. al. v. City of Tampa, et. al.*, Case No. 94-1357-CIV-T-23-E, United States District Court, Middle District of Florida, Tampa Division. This case was litigated before Judge Steven Merryday and Magistrate Judge Thomas McCoun. Magistrate Judge Elizabeth Jenkins presided over the trial which was held February 6 – 10, 1997. The Plaintiffs were represented by Frederick R. Mann, Jr. and William M. Norris.

The Plaintiffs filed a seven count wrongful death action against the City of Tampa alleging, among other things, a violation of Ernest C. Sexton, Jr.'s constitutional rights under 42 U.S.C. Section 1983, negligent retention and supervision, negligent training and wrongful death. The allegations arose from the shooting of Ernest C. Sexton, Jr., after he was arrested, by Tampa Police Officer David Slatton. The case is significant because the Plaintiffs sought damages in the amount of $5 million dollars. Additionally, they challenged the validity of the City of Tampa Police Department's policies and procedures. On February 10, 1997, the jury returned a verdict in favor of the Defendant, City of Tampa. I represented the defendant, City of Tampa, along with co-counsel, Martin Garcia. I prepared the pre-trial motions, undertook the discovery, and tried the case with Martin Garcia.

The current address for Martin Garcia is 1700 South MacDill Avenue, Suite 260, Tampa, Florida 33629. His telephone number is (813) 253-3999. The current address for Dan Kirkwood, counsel for the police officer, is 1313 North Tampa Street, Suite 902, Tampa, Florida 33602. His telephone number is (813) 233-2985. The current address for Frederick Mann, Jr. is P.O. Box 580, Panama City, Florida 32402. His telephone number is (850) 784-6155. The current address for William Norris is 8870 S.W. 62nd Terrace, Miami, Florida 33173. His telephone number is (305) 279-9311.

(7) *Robert R. Jones v. R.J. Reynolds Tobacco Company*, Case No. 97-4966(B), Circuit Court for the Thirteenth Judicial Circuit, Hillsborough County, Florida. This case was litigated before Judges Gaspar Ficarrotta and Ralph Steinberg (presided over trial). It was tried August – October 12, 2000. On October 12, 2000, the jury returned a verdict in favor of the Plaintiff in the amount of $200,000. However, on December 28, 2000, the trial court granted the Defendant's motion for new trial. The Second District Court of Appeal affirmed the trial court's grant of a new trial in *Jones v. R.J. Reynolds Tobacco Co.*, 830 So.2d 854 (Fla. 2d DCA 2002). The Florida Supreme Court denied the Plaintiff's petition for review on August 31, 2005. Ultimately, the Plaintiff dismissed this case.

This case is significant because it was the first products liability tobacco case to be tried in Hillsborough County. I served, along with Ben Hill, as local counsel for R.J. Reynolds tobacco company. I was responsible for coordinating discovery, drafting and filing pleadings, and handling the day to day inquiries regarding this case. I was associate counsel at the trial of this case and I was responsible for the examination of lay witnesses and one expert witness.

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The current address for Howard Acosta, counsel for the Plaintiff, is 300 1st Avenue North, St. Petersburg, Florida 33701. His telephone number is (727) 894-4469. The current address for Stephanie E. Parker, counsel for R.J. Reynolds is Jones Day, 1420 Peachtree Street, NE, Suite 800, Atlanta, Georgia 30309. Her telephone number is (404) 581-8552.

(8) *Scott v. United States Department of Justice,* Case No. 94-622-CIV-T-23C, United States District Court, Middle District of Florida, Tampa Division. A three judge panel, Judges Gerald Tjoflat, Ralph Nimmons, Jr., and Steven D. Merryday, presided over this case. The plaintiffs sought a declaratory judgment that District 21 in the 1992 Senate redistricting plan for the State of Florida was racial gerrymandering in violation of the Equal Protection Clause of the Fourteenth Amendment of the U.S. Constitution. The plaintiffs also sought injunctive relief requiring that new Senate districts be drawn. After exhaustive discovery, the parties settled the case in mediation by redrawing the boundaries for Senate District 21.

I represented the Defendant-Intervenor, The Florida Senate, along with Ben Hill. Ben Hill's address is 101 East Kennedy Boulevard, Suite 3700, Post Office Box 2231, Tampa, Florida 33601-2231 (813) 221-3900. The plaintiffs were represented by James Landis, 1407 East Paris Street, Tampa, Florida 33604 (813)767-8282 and Terry Gillis Tucker, 9622 Moorfield Circle, Louisville, Kentucky 40241 (502) 426-7060.

The Department of Justice was represented by Steven Mulroy and Richard Jerome, U.S. Justice Department, Civil Rights Division-Voting Section, Post Office Box 66128, Washington, DC 20035 (202) 514-9821. I do not have a current address for Mr. Mulroy or Mr. Jerome.

(9) *Doris Farmer v. Health Care and Retirement Corp.*, Case No. 98-461-CIV-T-24E, United States District Court, Middle District of Florida, Tampa Division. This case was assigned to Judge Susan Bucklew.

The Plaintiff filed an action alleging, among other things, that the Defendant Health Care and Retirement violated the Family and Medical Leave Act, 29 U.S.C. §2601, *et. seq.* (FMLA). Specifically, the plaintiff alleged that upon returning to work from a medical leave of absence the defendant failed to reinstate her to the same position she held prior to taking leave. The case is significant because at this time no reported opinion specifically discussed the question of whether the FMLA required an employer to return an employee to the exact shift and work schedule as that held prior to commencing the leave. The case settled after the filing of cross motions for summary judgment.

I represented the defendant. The plaintiff was represented by Bradley M. Bole, 535 Central Avenue, St. Petersburg, Florida 33701 (727) 823-4191.

(10) *Jeffery* Gomez *v. City of Tampa* , Case No. 92-470-CIV-T-22B, United States District Court, Middle District of Florida, Tampa Division. This case was assigned to Judge Anne Conway.

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The plaintiff filed a class action complaint for injunctive and declaratory relief alleging a violation of the Fifth and Fourteenth Amendments of the United States Constitution and similar provisions of the Florida Constitution. Specifically, the plaintiff alleged that his property, accrued interest on utility deposits, had been taken without due process and without just compensation. The plaintiff sought certification on behalf of a plaintiff class and against a defendant class of municipal corporations. The case is significant because the putative class consisted of all present, past and future applicants for utilities from the City of Tampa who had paid or would pay a deposit to guarantee payment of their accounts. The class would have consisted of more than 100,000 persons and entities. The case settled before a class action was certified and after the filing of the City's motion to dismiss.

I represented the City of Tampa along with co-counsel, Assistant City Attorney Jerry M. Gewirtz. Mr. Gewirtz' address is 315 E. Kennedy Blvd., 5th Floor, Tampa, FL 33602. His telephone number is (813) 274-8996. The plaintiff was represented by Scott C. Ilgenfritz. The current address for Mr. Ilgenfritz is 403 E. Madison Street, Suite 400, Tampa, FL 33602. His telephone number is (813) 225-2500.

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

(1) *Oral Argument* – In 1984, while only 27 years of age, I had the opportunity to argue a case before the Florida Supreme Court, in *State v. S.L.W.*, 465 So.2d 1231 (Fla. 1985). Although I lost the appeal, the experience made me a better appellate attorney. I later had the opportunity to argue before the Eleventh Circuit Court of Appeals in *Community Blood & Plasma v. City of Tampa*. I won that appeal.

(2) *Article V Task Force, 1994 – 1995*. The Florida Legislature established a mini-constitutional revision commission to study the provisions of the Florida Constitution governing the judiciary. One area the Task Force focused on was judicial selection and tenure of Florida's judges. I testified before this Task Force and urged them to recommend changes to the requirement that newly appointed judges must stand for election in the next scheduled general election. My testimony was based on my personal experience of being appointed to the bench in June 2004, starting my term of office on July 1, 2004, and standing for election in September 2004. As a result of the Task Force's findings and recommendations, the law was changed. Florida judges are not required to stand for election until they have completed one year of service.

(3) *Mentoring Program* – In the early 1990's through my work with the George Edgecomb Bar Association, I, along with attorney Delano Stewart, started a mentoring program between minority lawyers and at-risk students at Sligh Middle School, an inner city middle school in Tampa. Lawyers and other professionals would meet with the

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students one to two times a month to discuss various topics, talk about careers and participate in field trips. The program is still operating at Sligh Middle School.

(4) *Arbitration and Mediation* – During the period of 1995 through 2000, I served as an arbitrator for the United States District Court, Middle District of Florida. I arbitrated cases on a regular basis. Additionally, I mediated cases in State and Federal court. These cases usually involved issues of racial discrimination or sexual harassment and contract disputes.

(5) *Mock Trial and Moot Court Competition* – I have judged Mock Trial and Moot Court Competitions for The Florida Bar and local middle schools and high schools, such as Jefferson High School and Academy Prep.

(6) *Florida Bar Referee in Grievance Proceedings* – I have been appointed by the Florida Supreme Court and the Chief Judge of my Circuit to serve as a referee in grievance cases against lawyers for alleged violations of the Florida Bar's Rules of Professional Conduct. The referee presides over the grievance hearing and makes a recommendation to the Florida Supreme Court regarding the lawyer's conduct.

(7) *City of Tampa Code Enforcement Board* – I served as the attorney for the City of Tampa Code Enforcement Board between 1998 – 2000. I provided legal advice to the Board at its monthly public hearings.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have not taught at a university or college. I have lectured on various legal topics at Florida Metropolitan University and the University of South Florida. Additionally, I am on the faculty of the Florida Bar's Trial Lawyers Section Advanced Trial Advocacy Seminar. This is a one week course which is taught at the University of Florida Levin College of Law in Gainesville, Florida.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

I currently defer a portion of my state compensation into a retirement account. I have no arrangement or expectation of any future payments for any previous business or financial relationship or work done.

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21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    No.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report.

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement.

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

       My husband is a Major with the Tampa Police Department. A potential conflict of interest might arise as to criminal cases in which the Tampa Police Department was involved. I would disqualify myself from presiding over these cases.

       Additionally, I represented R.J. Reynolds Tobacco Company in products liability litigation for almost four (4) years. I have personal knowledge of their confidential business information. I would disqualify myself from presiding over cases in which R.J. Reynolds Tobacco Company was a defendant to personal injury litigation arising from the use of tobacco products manufactured by R.J. Reynolds.

    b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

       I would disqualify myself from presiding over these cases. In all cases I will follow the Code of Conduct for United States Judges and applicable statues, policies, and procedures.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of

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professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

From 1983 to 1994, I performed pro bono legal work for family members and close friends in the areas of wills, real estate transactions and powers of attorney. As a government attorney, I was prohibited from performing any other pro bono legal work. I do not recall the amounts of time devoted to this pro bono work.
From 1995 to 2000, I performed pro bono legal work for poor and lower middle class individuals in the area of family law. I also performed pro bono legal work for non-profit charitable organizations of which I was affiliated. I have not performed any pro-bono legal work since my appointment to the circuit bench in 2000, as I am prohibited from doing so. I do not recall the amounts of time devoted to this pro bono work.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

My experience in the judicial selection process was very positive. On November 2, 2007, I submitted a written application to the 55 members of the Florida Federal Judicial Nominating Commission. The members of the state commission reviewed the applications and selected 12 individuals to be interviewed by the Middle District Conference of the Commission. On December 17, 2007 I was interviewed by the 21 members of the Middle District Conference. On December 17, I was advised that I, along with five (5) others, would be recommended to Senators Mel Martinez and Bill Nelson for nomination by the President to two (2) vacancies on the United States District Court, Middle District of Florida. On February 6, 2008, I was interviewed by Senators Martinez and Nelson, separately, in their senate offices in Washington, D.C. On March 3, 2008, I was interviewed by three (3) individuals from the White House and Department of Justice. In May 2008, I was advised that I had not been selected by President Bush.

On February 10, 2009, I received a copy of a joint letter from Senators Bill Nelson and Mel Martinez to Gregory Craig, White House Counsel, which advised me that my name, along with the name of 4 others, had been submitted to President Obama for nomination to the United States District Court, Middle District of Florida. On March 13, 2009, staff from the Department of Justice contacted me regarding pre-nomination paperwork. I had subsequent

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conversations with staff from the Department of Justice regarding that paperwork and the nomination process. On May 12, 2009, I was interviewed by staff from the Department of Justice and from the White House Counsel's Office. In mid June 2009, I was advised by Ms. Cassandra Butts, Deputy White House Counsel, that President Obama was going to nominate me for the District Court vacancy in the Middle District of Florida. My nomination was submitted to the Senate on June 25, 2009.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

AFFIDAVIT

I, CHARLENE EDWARDS HONEYWELL, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

July 31, 2009 (DATE)

Charlene Edwards Honeywell (NAME)

(NOTARY) BETTYE G. NEDD

Notary Public State of Florida
Bettye G Nedd
My Commission DD545139
Expires 06/20/2010

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Senator WHITEHOUSE. Well, I'm delighted that your lovely family and your friends are here, and I thank them for joining us.

The final member of our panel has not been introduced. She is not a candidate for a judgeship, but rather has been nominated to serve as Assistant Attorney General for the Environment and Natural Resources Division at the U.S. Department of Justice.

I have served in that Department as a U.S. Attorney. I am keenly sensitive to what an important role she will play. I am delighted that Ignacia Moreno is here. She, too, is a veteran of the Justice Department, having served during the Clinton administration as Special Assistant, and then as Counsel and Principal Counsel to the Assistant Attorney General for the Environment and Natural Resources Division. So, this will be something of a homecoming.

After serving at the Department of Justice, Ms. Moreno joined Spriggs & Hollingsworth in Washington, DC, where she became a partner, specializing in environmental and mass tort litigation, with an emphasis on science-based advocacy. She is currently counsel for corporate environmental programs at the General Electric Company and serves pro bono as general counsel to the Hispanic National Bar Association.

We welcome Ms. Moreno and invite her to make any statement she cares, or any introductions she cares.

STATEMENT OF IGNACIA S. MORENO, TO BE ASSISTANT ATTORNEY GENERAL, ENVIRONMENT AND NATURAL RESOURCES DIVISION, DEPARTMENT OF JUSTICE

Ms. MORENO. Thank you very much, Senator Whitehouse, for those kind remarks and the kind introduction. Thank you and Ranking Member Sessions for holding this hearing. I would also like to thank the President, as have my other panelists, for nominating me for this very important position. I am grateful to the President and to the Attorney General for their confidence in me.

I'd like to briefly introduce my family who is with me today: my mother, Zenith Morena.

Senator WHITEHOUSE. Welcome.

Ms. MORENO. Sisters, Patricia Moreno and Veronica Acosta; brother, Carlos Moreno; my niece and nephew, Francesca and Alexander Moreno; and it gives me special pleasure to introduce my husband and son, Robert and Nicholas Begotka. My father, Carlos Moreno, was unable to be here today, but is certainly with me in spirit. I wouldn't be here without my family's inspiration, their encouragement, and their support. In particular, I wish to thank my mother for her many and sustained sacrifices. She is my hero. Thank you again for the opportunity to appear before you, and I look forward to your questions.

[The biographical information of Ignacia Moreno follows.]

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UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR NON-JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Ignacia Soledad Moreno

   Former Names Used: Ignacia S. Bish
   Ignacia Moreno Bish

2. **Position**: State the position for which you have been nominated.

   Assistant Attorney General, Environment and Natural Resources Division, United States Department of Justice

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office Address: General Electric Company
   319 Great Oaks Boulevard
   Albany, NY 12203

   [redacted]

4. **Birthplace**: State date and place of birth.

   May 8, 1961; Cartagena, Colombia

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   Law School: New York University School of Law; 1987 to 1990
   Juris Doctor, May 1990

   College: New York University; 1978 to 1982 and 1985
   B.A, February 1986

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6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

BNA's *Environmental Due Diligence Guide*
1801 South Bell Street
Arlington, VA 22202
July 2008-Present; Advisory Board (*pro bono*)

Hispanic Forum Albany/Schenectady Hub
General Electric Company
1 River Road
Schenectady, New York 12345
December 2007-Present; Co-Leader Community Service Committee (*pro bono*)

General Electric Company
319 Great Oaks Boulevard
Albany, NY 12203
September 2006-Present;
Counsel, Northeast/Midwest Regions and International, Corporate Environmental Programs

Spriggs & Hollingsworth
1350 I Street, N.W.
Washington, DC 20005
October 2001-January 2004; Of Counsel
February 2004-September 2006; Partner

Washington Lawyers' Committee for Civil Rights and Urban Affairs
11 Dupont Circle, N W., Suite 400
Washington, DC 20036
2007-Present, Board of Trustees (*pro bono*)
2003-2006; Board of Directors (*pro bono*)

Center for International Environmental Law
1350 Connecticut Avenue, N.W.
Washington, DC 20036
2004-Present; Board of Advisors (*pro bono*)

Lawcorps
1819 L Street, N.W.
Washington, DC 20036
June 2001-August 2001; Lawyer

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United States Senate Committee on the Judiciary
Ignacia S. Moreno Response to Questionnaire

United States Department of Justice
Environment and Natural Resources Division
950 Pennsylvania Avenue, N.W
Washington, DC 20530
January 1994-January 1995; Special Assistant to the Assistant Attorney General
January 1995-January 2001; Counsel and then Principal Counsel to the Assistant Attorney General

Hogan & Hartson LLP
555 Thirteenth Street, N.W.
Washington, DC 20004
September 1990-January 1994; Associate

New York University School of Law, Professor Harvey Dale
40 Washington Square South
New York, NY 10012
October 1989-May 1990; Research Assistant

United States Attorney's Office, Southern District of New York
1 St. Andrew's Plaza
New York, NY 10013
January 1990-April 1990; Law Clerk/Legal Intern (law school clinic)

Kaye Scholer LLP
901 Fifteenth Street, N.W.
Washington, DC 20005
June 1989-August 1989; Summer Associate

New York University School of Law, Professor David Cohen
138 McDougal Street
New York, NY 10022
August 1988-May 1989; Teaching Assistant, Legal Research and Writing

United States Senate Committee on the Judiciary, Nominations Task Force
224 Dirksen Senate Office Building
Washington, DC 20510
June 1988-August 1988; Legal Intern for Senator Joseph Biden

Manhattan District Attorney's Office, Sex Crimes Prosecution Unit
1 Hogan Place
New York, NY 10013
August 1986-August 1987; Trial Preparation Assistant

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Berkley Publishing Group
200 Madison Avenue
New York, NY 10016
November 1983-August 1986; Assistant to the Editorial Director; Assistant to the Publisher
January 1987-August 1987; Freelance Reader (Charter Books)

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

None. Not required to register for selective service.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

Federal Hispanic Heritage Excellence Award for Partnership Building, 1999;

Special Commendation for Outstanding Service, awarded by the United States Department of Justice, Environment and Natural Resources Division, 1997;

Bronze Medal, awarded by the United States Environmental Protection Agency ("EPA") for Outstanding Service, Fourth International Conference on Environmental Enforcement and Compliance, Chiang Mai, Thailand, 1996;

Special Commendation for Outstanding Service, awarded by the United States Department of Justice, Environment and Natural Resources Division, 1996;

Latina Excellence Environment Award, awarded by *Hispanic Magazine*, 1996;

Bronze Medal, awarded by EPA for Outstanding Service in the development and implementation of a strategy to identify and mitigate transborder river pollution along the U.S.-Mexico border, 1995;

Selected as one of the 100 Most Influential Hispanics in the U.S. by *Hispanic Business Magazine*, 1995, based on accomplishments in environmental enforcement initiatives

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

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United States Senate Committee on the Judiciary
Ignacia S. Moreno Response to Questionnaire

American Bar Association

1991-Present; Member

2006-2007; Planning Committee and Moderator and Speaker, 36th Annual Conference on Environmental Law (Keystone Conference)

2004-2005; Vice-Chair for Technology, Superfund and Natural Resource Damages Litigation Committee

2002-2003; Vice-Chair, 2003 Annual Meeting Planning Committee

2001-2002; Vice-Chair for Programs, International Environmental Law Committee, Section of Environment, Energy and Resources

2000-2001; Vice-Chair, International Environmental Law Committee, Section of International Law and Practice

District of Columbia Bar

1992-Present; Member

2002-2004; Special Committee on Multi-Jurisdictional Practice

2001; Nominations Committee

Hispanic Bar Association of the District of Columbia

1994-2006; Member

2004-2006; Advisory Board

1995-2002; Board of Directors

2000-2001; President

Hispanic National Bar Association

Mid-1990s (est.)-Present; Member

2008-Present; General Counsel

New York State Bar Association

2008-Present; Member

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Virginia State Bar

1990-Present; Member

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

Commonwealth of Virginia, admitted October 1990 (Active)

District of Columbia, admitted October 1992 (Active)

State of New York, admitted March 2008 (Active)

No lapses in membership.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

United States Supreme Court, admitted March 1995

United States District Court for the District of Maryland, admitted June 1993

United States District Court for the District of Puerto Rico, admitted 1995

United States District Court for the District of Columbia, admitted December 2001

No lapses in membership.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Center for International Environmental Law
2004-Present; Board of Advisors (*pro bono*)

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Washington Lawyers' Committee for Civil Rights and Urban Affairs
2007-Present, Board of Trustees (*pro bono*)
2003-2006; Board of Directors (*pro bono*)

BNA's *Environmental Due Diligence Guide*
2008-Present; Advisory Board (*pro bono*)

Hispanic Forum Albany/Schenectady Hub
December 2007-Present; Co-Leader Community Service Committee (*pro bono*)

Pinebush Elementary School Parent Teacher Association
2007-Present

Forest Hollow Swim Club, a pool facility in Annandale, Virginia
2002-2006 (est.); Member

I am a member of the Environmental Law Institute and the Wildlife Conservation Society by virtue of contributions. I was a member of the American Civil Liberties Union during the 1990s by virtue of contributions. I have been a member of Friends of the National Zoo and possibly other charitable or civic organizations by virtue of contributions.

b. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

To the best of my knowledge, none of the organizations discriminate or have discriminated on the basis of race, sex, religion or national origin.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

Toward a Free Trade Area of the Americas: A Chapter in the Trade, Investment, and Environment Debate, 33 TRENDS, NO. 2, ABA SECTION OF ENVIRONMENT, ENERGY, AND RESOURCES (November/December 2001) (co-author);

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The Free Trade Area of the Americas Agreement and the Environment: Getting Beyond the Barricades, Tear Gas and Declarations, THE INTERNATIONAL ENVIRONMENTAL LAW COMMITTEE NEWSLETTER, ABA SECTION OF ENVIRONMENT, ENERGY, AND RESOURCES, Vol. 3, No. 4 (May 2001),

Free Trade and the Environment: The NAFTA, the NAAEC, and Implications for the Future, 12 TULANE ENVIRONMENTAL LAW JOURNAL 405 (Spring 1999) (co-author);

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following.

Hispanic National Bar Association, Memorandum from Ignacia S. Moreno, General Counsel and Chair of the Elections Board, dated May 12, 2009;

"Separate and Unequal: The State of the District of Columbia Public Schools Fifty Years After *Brown* and *Bolling*." A Parents United for the D.C. Public Schools Civic Leader Advisory Committee Report, March 2005. I reviewed the report and contributed revisions as part of *pro bono* work for the Washington Lawyers' Committee for Civil Rights and Urban Affairs;

District of Columbia Bar Special Committee on Multijurisdictional Practice ("Special Committee") issued a unanimous Interim Report on February 6, 2004 and a unanimous Final Report and Recommendations on September 30, 2004 to the Board of Governors on Disciplinary System Issues. I was a member of the Special Committee from 2002 to 2004;

Hispanic Bar Association of the District of Columbia, Ignacia S. Moreno, President, Washington, DC, letter dated January 19, 2001, submitted to the Senate Judiciary Committee on the nomination of John Ashcroft to be Attorney General of the United States;

Hispanic Bar Association of the District of Columbia, Ignacia S. Moreno, President, Annual Report, January 2000 to January 2001, Presented at the Annual Meeting on January 25, 2001, Washington, DC;

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"Language Barrier Problems in the Hispanic Community's Contacts with the Metropolitan Police Department and the District of Columbia's Court System," 1991, a report prepared by Hogan & Hartson on behalf of the American Civil Liberties Union of the National Capital Area (co-author under the name Ignacia Moreno Bish). The report analyzed the interaction of the District of Columbia Latino community with the District of Columbia courts and police department.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

Organization of American States, "Final Report of the Second Regular Meeting of the Inter-American Committee on Sustainable Development," Washington, DC, October 13-15, 1999, as a member of the United States delegation had significant involvement in the formulation and ultimate adoption of Inter-American Counsel for Integral Development (CIDI) Resolutions:

(1) CIDI/CIDS/RES.4 (II-O/99) Hemispheric Network of Officials and Experts on Environmental Law, Enforcement, and Compliance; and

(2) CIDI/CIDS/RES.6 (II-O/99) Inter-American Strategy for the Promotion of Public Participation in Decision-Making for Sustainable Development;

Statement on behalf of the United States at the Bi-national United States-Mexico Meeting, Mexico City, Mexico, June 3-4, 1999, regarding United States-Mexico commitments regarding cooperative environmental enforcement initiatives (no copy of statement found);

Report to the United States Senate Committee on the Judiciary titled "Redressing Impediments to Voting Facing Language Minorities: The Need to Reauthorize and Expand Section 203 of the Voting Rights Act," March 4, 1992 (co-author, under the name Ignacia Moreno Bish) with transmittal letter to Senator Paul Simon, dated March 4, 1992;

Testimony before the United States Commission on Civil Rights, Mount Pleasant Hearing, January 29-31, 1992, Police-Community Relations Panel, on behalf of the American Civil Liberties Union of the National Capital Area regarding findings in a report I co-authored titled "Language Barrier Problems in the Hispanic Community's Contacts with the Metropolitan Police Department and the District of Columbia's Court System," 1991 (under the name Ignacia Moreno Bish)

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d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

American Bar Association, 36th Annual Conference on Environmental Law Keystone, Colorado, March 8-11, 2007, moderated and co-presented panel discussion on "Ethical Performance Standards: Management of Electronic and Hard Copy Information":

(1) Presentation titled "Management of Electronic and Hard Copy Information;"

(2) Presentation titled "Expert and Information Management Strategies;"

General Electric Company, Corporate Environmental Programs Remedial Staff Meeting, Amelia Island, Florida, November 1, 2007, presenter on "Document and Information Management Strategies" (presentation is not available because it is proprietary, privileged and confidential; the topic is an overview of and advice on electronic discovery compliance);

Hispanic National Bar Association Convention, Washington, DC, October 17, 2005, panel discussion on "Environmental Law & Our Communities—Corporate Responsibility for Environmental Harm Abroad Under the Alien Tort Claims Act: Does *Sosa* Close the Door?"(no notes or prepared text available; discussion of United States Supreme Court ruling and litigation strategies);

Spriggs & Hollingsworth 17th Annual Private Seminar on Toxic Tort Litigation and Current Strategies for Toxics and Pharmaceutical Defense, Washington, DC, June 9-10, 2005, co-presenter on "Endocrine Disruptors Are Still Here, *Our Stolen Future* Marches On" (presentation is not available because it is proprietary, privileged and confidential; the topic is an overview of and advice on emerging scientific research and its implications for litigation);

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Spriggs & Hollingsworth 16th Annual Private Seminar on Toxic Tort Litigation and Current Strategies for Toxics and Pharmaceutical Defense, Washington, DC, May 18-19, 2004, ethics presentation "Managing Electronic Information – A Strategic Approach" (presentation is not available because it is proprietary, privileged and confidential; the topic is an overview of and ethics advice on electronic discovery compliance);

Inter-American Bar Association, 2003, panel discussion on "Corporate Environmental Responsibility and the Alien Tort Claims Act" (no notes or prepared text available; addressed application of the Alien Tort Claims Act to environmental claims);

2 Council for International Exchange of Scholars, Fulbright Visiting Scholar Conference, "The Global Environment: Challenges for the Future," speaker on panel discussion titled "Trade and the Environment," Washington, DC, March 25, 1999;

American Bar Association/Inter-American Bar Association Conference on Development, the Environment & Dispute Resolution in the Americas: New Directions for the Private Sector, Buenos Aires, Argentina, March 5-7, 1997 (no notes or prepared text available; panel presentation on new directions for the private sector in the areas of development, the environment, and dispute resolution in the Americas);

Introductory remarks for Consultation with Colombian Ministry of the Environment on the Design of a Compliance Strategy and Enforcement Program, Bogota, Colombia, October 1-3, 1997 (no notes or prepared text available; overview of the United States civil and criminal environmental enforcement programs);

As part of the United States delegation to the Fourth International Conference on Environmental Compliance and Enforcement in Chiang Mai, Thailand, April 22-26, 1996:

3 (1) Conducted a day-long workshop on principles of the United States federal environmental enforcement and compliance program, with a focus on designing management approaches, drafting enforceable requirements, designing an effective compliance and enforcement strategy, and developing a multi-stakeholder resolution to a complex enforcement problem based on a solid waste disposal case study (no notes or prepared text available; see workshop materials titled "Residential & Industrial (Solid) Waste Disposal, Technical Support Document" on Principles of Environmental Enforcement and Compliance);

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(2) Co-facilitator for Special Topic and Institution-Building Workshop on the "Montreal Protocol: Enforcement of Chlorofluorocarbons (CFC) and Related Requirements;"

National Conference for Society of Women Environmental Professionals, Washington, DC, on or about 1995, (no notes or prepared text available; panel presentation on work-life balance and Department of Justice work-life policies),

Fourth International Conference for Women Environmental Professionals, Washington, DC, September 8-9, 1994, (no notes or prepared text available; panel presentation on the application of EPA's environmental audits policy and penalty immunity)

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

I have done my best to identify all items called for in this question, including through a review of my personal files and searches of publicly available electronic databases. I have located the following:

Spanish-language talk radio show interview and question and answer session in 1987 regarding Manhattan District Attorney's Office, Sex Crimes Prosecution Unit services, as a part of public service outreach to Hispanic community in New York City (transcript not found);

Special Fox Broadcasting Company television news report regarding federal labor law and civil rights case brought on behalf of Mexican H2-B workers broadcast on August 14, 1992 (videotape not found);

Quoted in Las Cruces newspaper regarding United States Department of Justice investigation of safe drinking water issues at the Colonias in Las Cruces, New Mexico, 1995 (article not found)

13. **Public Office, Political Activities and Affiliations**.

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

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Appointed by President William J. Clinton to the United States Department of Justice, Environment and Natural Resources Division
January 1994-January 1995 - Special Assistant to the Assistant Attorney General
January 1995-January 2001 – Counsel and then Principal Counsel to the Assistant Attorney General

I have not been a candidate for elective office or been nominated previously for appointed office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

Mid-Manhattan New Democratic Club, New York, NY
1983-1988, Member;
1987-1988, Executive Secretary (volunteer);
1984, 1985, 1986, Member of Executive Committee (volunteer);
1985-1987, Member of Community Service Committee (volunteer)

New York County Democratic Committee, New York, NY
1985-1986, Member

14. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I did not serve as a clerk to a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I have not practiced as a solo practitioner.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

Hogan & Hartson LLP
555 Thirteenth Street, N.W.
Washington, DC 20004
September 1990-January 1994; Associate

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United States Department of Justice
Environment and Natural Resources Division
950 Pennsylvania Avenue, N.W.
Washington, DC 20530
Appointed by President Clinton:
January 1994-January 1995; Special Assistant to the Assistant Attorney General
January 1995-January 2001, Counsel and then Principal Counsel to the Assistant Attorney General

Lawcorps
1819 L Street, N.W.
Washington, DC 20036
June 2001-August 2001; Lawyer

Spriggs & Hollingsworth
1350 I Street, N.W.
Washington, DC 20005
October 2001-January 2004; Of Counsel
February 2004-September 2006; Partner

General Electric Company
Corporate Environmental Programs
319 Great Oaks Boulevard
Albany, NY 12203
September 2006-Present;
Counsel, Northeast/Midwest Regions and International

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator in alternative dispute resolution proceedings.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

From 1990 to 1994, I was an Associate in the Washington, DC office of Hogan & Hartson LLP where I practiced with the firm's Environmental and Litigation Practice Groups. My environmental practice was focused on counseling clients on regulatory compliance matters under federal environmental laws, agency rulemakings, and administrative enforcement proceedings. My litigation practice involved all aspects of civil litigation

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from pre-trial proceedings to trial. I also represented environmental organizations, civil liberties groups, and individuals on a *pro bono* basis on a variety of litigation and public policy matters.

From 1994 to 2001, I served as Special Assistant, Counsel and then Principal Counsel to the Assistant Attorney General for the Environment and Natural Resources Division ("Division"). In these positions I provided advice and counsel to the Assistant Attorney General on a wide variety of matters, participated in management of the Division, led significant environmental enforcement initiatives, expanded and managed the Division's international program, and represented the United States in international negotiations and litigation.

From 2001 to 2006, I was an Of Counsel and later Partner at the Washington, DC law firm of Spriggs & Hollingsworth, where I specialized in environmental and mass tort litigation with an emphasis on science-based advocacy

From September 2006 to the present, I have been Counsel for the Northeast/Midwest Regions and International at the General Electric Company ("GE"). In this position, I oversee GE's compliance with federal and state environmental laws and ensure that it meets its consent decree, consent order, environmental permit, and private party obligations at legacy and acquired sites within my regions. I work with federal and state regulators and private parties to negotiate agreements for the investigation, remediation, and/or other resolution of environmental site conditions. I manage complex litigation and oversee outside environmental and litigation counsel. I work closely with members of the in-house technical project team on all of these matters.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

At Hogan & Hartson LLP, I represented individuals, manufacturers, and other corporate clients. I also represented environmental organizations, civil liberties groups and individuals on a *pro bono* basis.

While I served at the United States Department of Justice, Environment and Natural Resources Division, I represented the United States of America in environmental enforcement and defensive matters, as well as in international negotiations and the development of bi-lateral and tri-lateral enforcement initiatives. Federal client agencies included EPA, the Department of the Interior, the Department of Commerce (National Marine Fisheries Service), the Department of Energy, and the Office of the United States Trade Representative, among others. I also served as the Division's liaison to the United States Attorneys.

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At Spriggs & Hollingsworth, I represented corporate clients in civil litigation matters, specializing in environmental and mass tort litigation.

Currently, I am in-house counsel and represent the General Electric Company in addressing environmental matters.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

Approximately 50% of my practice to date has involved litigation. While I was at Hogan & Hartson LLP (1990-1994), I appeared in court frequently. During my tenure at the United States Department of Justice (1994-2001), I appeared in court occasionally. At Spriggs & Hollingsworth (2001-2006), I appeared in court occasionally. At General Electric (2006-present), I appear in court rarely.

i. Indicate the percentage of your practice in:

1. federal courts; 95%
2. state courts of record; 5%
3. other courts; 0%
4. administrative agencies; 0%

ii. Indicate the percentage of your practice in:

1. civil proceedings; 99%
2. criminal proceedings; 1%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I was co-counsel in a seven-day bench trial to verdict. As in-house counsel, I entered an appearance and managed a week-long bench trial to verdict.

i. What percentage of these trials were:

1. jury; 0%
2. non-jury; 100%

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e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.
I am admitted to, but do not have a practice before the United States Supreme Court.

I contributed to an *amicus* brief filed before the United States Supreme Court in *Immigration and Naturalization Service v. National Center for Immigrants' Rights*, No. 90-1090 (July 12, 1991), on behalf of the American Bar Association.

15. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

(1) Allgood v. General Motors Corp., No. 1:02-cv-1077, 2006 U.S. Dist. LEXIS 70764 (S.D. Ind. Sept. 18, 2006). Co-counsel in representation of General Motors in a complex mass tort case brought by private parties seeking hundreds of millions of dollars in damages for an alternative clean-up to an ongoing EPA-approved clean-up under a Comprehensive Environmental Response, Compensation and Liability Act ("CERCLA") administrative order on consent and a Resource Conservation and Recovery Act corrective action agreement, as well as personal injury and property damage claims. In this multi-firm case, I was principally responsible for formulating and implementing all aspects of a successful science-based expert defense strategy, including identifying and retaining a nationally-renowned expert team, and developing expert testimony in the areas of environmental remediation, standard of care, toxicology, epidemiology, and medical monitoring/occupational health. I also took expert depositions, drafted *Daubert* and dispositive motions, and provided advice and counsel to General Motor's technical project managers and consultants on ongoing remediation issues related to the litigation. General Motor's summary judgment and *Daubert* motions were substantially granted.

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United States District Court for the Southern District of Indiana
United States District Court Judge David F. Hamilton

Co-counsel:

Martin C. Calhoun, Esq.
Frank Leone, Esq.
Katharine R. Latimer, Esq.
Spriggs & Hollingsworth
1350 I Street, N.W.
Washington, DC 20004
(202) 898-5800

Bruce A. Featherstone, Esq. (coordinating counsel)
Frank C. Porada, Esq.
Featherstone DeSisto LLP
600 17th Street, Suite 2400S
Denver, CO 80202
(303) 626-7125

W. Ray Persons, Esq.
Douglas W. Gilfillan, Esq.
King & Spalding LLP
1180 Peachtree Street, NE
Atlanta, GA 30309
(404) 572-4600

Lee B. McTurnan, Esq.
McTurnan & Turner
10 West Market Street
Indianapolis, IN 46204
(317) 464-8181

Counsel for Plaintiffs:

Jay P. Kennedy, Esq.
Kroger, Gardis & Regas LLP
111 Monument Circle, Suite 900
Indianapolis, IN 46204
(317) 692-9000

(2) Arias v. DynCorp, 517 F. Supp. 2d 221 (D.D.C. 2007). Co-counsel for DynCorp in a civil action brought by foreign nationals against DynCorp, a government contractor for the United States Department of State, under the Alien Tort Claims Act. other statutes, and federal and state common law. The complaint alleged personal injury and property damages

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resulting from the aerial spraying of an herbicide approved by EPA and the United States Department of Agriculture for eradication of coca in fields in southern Colombia. Co-counsel and I worked closely with the Department of State in formulating a defense and filing a motion to dismiss on jurisdictional grounds in 2001, which was supported by a declaration of an Assistant Secretary of State. Thereafter, we filed a motion that stayed discovery pending a ruling on the motion to dismiss, which ensured the protection of then-sensitive and classified information relating to the implementation of the congressionally-approved Plan Colombia. DynCorp's motion to dismiss was denied after I left Spriggs & Hollingsworth in 2006.

United States District Court for the District of Columbia
United States District Court Judge Richard W. Roberts

Co-counsel:

Joe G. Hollingsworth, Esq.
Katharine R. Latimer, Esq.
Eric G. Lasker, Esq.
Spriggs & Hollingsworth
1350 I Street, N.W.
Washington, DC 20004
(202) 898-5800

Counsel for Plaintiffs:

Terry Collingsworth, Esq.
Conrad & Scherer
731 8th Street, S.E.
Washington, DC 20003
(202) 543-4001

(3) Arreola, et al. v. Philip J. Harrington & Son, et al., C.A. No. L-91-1934 (bench trial on July 6-14, 1992). In this case, co-counsel and I represented 15 Mexican nationals in a civil action brought against their employer, a Maryland seafood processing plant, and North Carolina labor contractors. After a seven-day trial, the court ruled that the defendants had violated the minimum wage, overtime wage, and retaliatory discharge provisions of the Fair Labor Standards Act. The court also ruled that the plaintiffs' working conditions and wages were significantly worse than those of other workers at the same plant, that this disparity was due to the plaintiffs' ethnicity, and that this constituted a violation of plaintiffs' civil rights under 42 U.S.C. § 1981. The defendants were held liable for more than $400,000 in damages, attorneys' fees and costs. I was involved in all aspects of the case from drafting initial pleadings, examining and cross-examining witnesses at trial, and filing post-trial briefs.

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United States District Court for the District of Maryland
United States District Court Judge Benson E. Legg

Co-counsel:

John C. Keeney, Jr., Esq.
L. Anthony Sutin, Esq. (deceased)
Hogan & Hartson LLP
555 Thirteenth Street, N.W.
Washington, DC 20004
(202) 637-5750

Counsel for Defendants:

Jane A. Canter, Esq.
Charles E Chlan & Associates
109 Federal Street
Easton, MD 21601
(410) 820-0200

(4) Brower v. Daley, 93 F. Supp. 2d 1071 (N.D. Cal. 2000), *aff'd*, Brower v. Evans, 257 F.3d 1058 (9th Cir. 2001). Co-counsel for the Department of Commerce and the National Marine Fisheries Service in defense of an Initial Finding on the impact on dolphin stocks of the purse seine tuna fishery in the Eastern Tropical Pacific Ocean. I handled case management issues, filed the Administrative record, and drafted the government's cross-motion for summary judgment with co-counsel. Summary judgment was granted to plaintiffs on their Administrative Procedure Act claim. The United States was granted summary judgment on plaintiffs' National Environmental Policy Act claim. Plaintiffs' motion for preliminary injunction denied as moot. I did not participate in the subsequent appeal, which was decided after I had left the Division at the conclusion of the Clinton Administration.

United States District Court for the Northern District of California
United States District Court Judge Thelton E. Henderson

Co-counsel:

Charles R. Shockey, Esq.
United States Department of Justice,
Environment and Natural Resources Division
501 I Street
Sacramento, CA 95814
(916) 930-2203

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Counsel for Plaintiffs.

Joshua R. Floum, Esq.
(Formerly with Legal Strategies Group)
General Counsel and Corporate Secretary
Visa Inc.
P.O. Box 8999
San Francisco, CA 94128
(415) 932-2100

(5) McKoy, et al. v. Wilson, CA No. 91-0702-LFO (1992-1993). Co-counsel in employment discrimination case against the National Archives on behalf of three African-American female employees. Following discovery and submittal of pre-trial filings, we achieved a very favorable settlement on behalf of the plaintiffs, including the payment of back pay, reinstatement of two of the plaintiffs, and reimbursement of legal fees At the time, this was one of the highest settlements for individuals in a discrimination claim against the federal government.

United States District Court for the District of Columbia
United States District Court Judge Louis Oberdorfer

Co-counsel:

Robert B. Cave, Esq.
Martha R. Moffett, Esq. (no longer with firm)
Hogan & Hartson LLP
555 Thirteenth Street, N.W.
Washington, DC 20004
(202) 637-5692

Counsel for Don W. Wilson, United States Archivist:

Jeffrey T. Sprung, Esq.
Assistant United States Attorney
United States Attorney's Office for the District of Columbia
555 4th Street, N.W.
Washington, DC 20530
(202) 514-7566

(6) Public Citizen v. Kantor, 864 F. Supp. 208 (D.D.C. 1994). Co-counsel in successful defense of a civil action to compel the Office of the United States Trade Representative to prepare an environmental impact statement for the Uruguay Round Agreement concluded by President William Clinton under the auspices of the General Agreement on Tariffs and Trade. Co-counsel and I drafted the government's motion for summary judgment, which the court granted.

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United States District Court for the District of Columbia
United States District Court Judge John H. Pratt

Co-counsel:

Bradley M. Campbell, Esq.
(Formerly with United States Department of Justice
Environment and Natural Resources Division)
Bradley M. Campbell LLC
50 West State Street, Suite 1100
Trenton, NJ 08608
(609) 392-4500

Counsel for Public Citizen.

Alan B. Morrison, Esq.
(Formerly with Public Citizen Litigation Group)
The George Washington University Law School
2000 H Street, N.W.
Washington, DC 20052
(202) 994-6261

(7) South Carolina Department of Health and Environmental Control v. Carolina Steel & Wire Corp., et al., C.A. No. 3-00-1759 ("South Lake"); South Carolina Department of Health and Environmental Control v. Western Atlas, Inc., et al., ("Hollis Road"), C.A. No. 3-00-1760 (2001 to 2003). Co-counsel in successful defense and settlement of two separate CERCLA cost recovery and natural resource damages actions and pendent claims under state law for alleged chlorinated solvent groundwater contamination brought by the South Carolina Department of Health and Environmental Control ("DHEC"). I conducted discovery, took and defended depositions, drafted *Daubert* and dispositive motions, argued pretrial motions, and drafted consent decrees. One case settled favorably a after we established a divisibility defense. Following the filing of *Daubert* and dispositive motions, the second case settled favorably shortly before trial.

South Lake Case:

United States District Court for District of South Carolina
United States District Court Judge Margaret Seymour

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United States Senate Committee on the Judiciary
Ignacia S. Moreno Response to Questionnaire

Co-counsel:

Frank Leone, Esq.
Spriggs & Hollingsworth
1350 I Street, N.W.
Washington, DC 20004
(202) 898-5825

Counsel for Plaintiff DHEC:

Jessica J.O. King, Esq.
(Formerly with DHEC)
Ellis Lawhorne & Simms
1501 Main Street, 5th Floor
Columbia, SC 29201
(803) 212-4967

Counsel for Carolina Steel & Wire:

Joseph A. Rhodes, Jr., Esq.
Ogletree, Deakins, Nash, Smoak & Stewart, P.C.
300 North Main Street
Greenville, SC 29602
(864) 271-1300

Counsel for Monroe Systems for Business, Inc.:

Robert E. Stepp, Esq.
Sowell, Gray, Stepp & Laffitte, L.L.C.
1310 Gadsden Street
Columbia, South Carolina 29201-3002
(803) 231-7836

Counsel for Icon Identity Solutions (f/k/a Acme-Wiley, Inc.)

Elizabeth B. Partlow, Esq.
Ogletree, Deakins, Nash, Smoak & Stewart, P.C.
1320 Main Street, Suite 600
Columbia, South Carolina 29201-2881
(803) 252-1300

Hollis Road Case:

United States District Court for District of South Carolina
United States District Court Judge Matthew Perry

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Co-counsel:

Frank Leone, Esq.
Spriggs & Hollingsworth
1350 I Street, N.W.
Washington, DC 20004
(202) 898-5825

Counsel for Plaintiff DHEC:

Jessica J.O. King, Esq.
(Formerly with DHEC)
Ellis Lawhorne & Simms
1501 Main Street, 5th Floor
Columbia, SC 29201
(803) 212-4967

Counsel for Defendant Safety Kleen:

Scott K. Ames, Esq.
Fennermore Craig, P.C.
3003 North Central Avenue, Suite 2600
Phoenix, AZ 85012-2913
(602) 916-5339

Counsel for Defendant Hoover:

John E. Cheatham, Esq
Law Offices of John E. Cheatham, P.A.
P.O. Box 1345
Lexington, SC 29071
(803) 359-2828

(8) United States v. General Electric Co., Case No. 06-CV-00354-PB (2006 to 2009). I managed the day-to-day defense of a cost-recovery action under CERCLA brought by the United States against the General Electric Company for the recovery of response costs under CERCLA in connection with the Fletcher Paintworks Superfund Site in Milford, New Hampshire. The court denied both parties' cross-motions for summary judgment and the case proceeded to trial in 2008. With co-counsel, I managed the phase I liability trial in which General Electric asserted the useful product defense. I oversaw all aspects of the litigation, including discovery, development of expert testimony, preparation of summary judgment filings, and a week-long trial in which I appeared. The court ruled in favor of the United States.

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United States District Court for the District of New Hampshire
United States District Court Judge Paul J. Barbadoro

Co-Counsel:

Tom H. Hill, Esq.
General Electric Company
3135 Easton Turnpike
Fairfield, CT 06828
(203) 373-2685

Outside Counsel:

Peter A. Biagetti, Esq.
William ("Mo") Cowan, Esq
Colin Van Dyke, Esq.
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111
(617) 542-6000

Counsel for the United States:

Catherine Adams Fiske, Esq.
Environmental Enforcement Section
United States Department of Justice
One Gateway Center, Suite 616
Newton, MA 02458
(617) 450-0444

Peter Flynn, Esq.
Laura J. Rowley, Esq.
Environmental Enforcement Section
United States Department of Justice
P.O. Box 7611
Washington, DC 20044
(202) 514-2000

(9) United States of America v. Pedro Rivera, et al., Criminal No. 95-84 (HL) (1995 to1996), criminal prosecution under the Clean Water Act of three corporate defendants and three individuals, who were responsible for causing an oil spill in Puerto Rico. I handled and litigated issues relating to the disposition and seizure of the assets of a highly integrated enterprise consisting of over 50 corporate entities that were wholly or partly owned by defendants. In consultation with co-counsel, I reviewed and made recommendations to the court on requests for disposition of assets

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by defendants. I successfully opposed a motion to vacate the court's order under the All Writs Act and to transfer venue, which allowed the court to retain and exercise meaningful jurisdiction over the defendants' assets and avoid frustration of the court's ability to enter a judgment and impose penalties. I also participated in discovery and plea negotiations.

United States District Court for the District of Puerto Rico
United States District Court Judge Hector M. Laffitte

Co-counsel:

Charles A. De Monaco
(Formerly with United States Department of Justice,
Environment and Natural Resources Division)
Dickie, McCamey & Chilcote
Two PPG Place, Suite 400
Pittsburg, PA 15222
(412) 392-5328

Counsel for Defendants:

Jared B. Stamell, Esq.
Stamell & Schager, L.L.P
One Liberty Plaza, 35th Floor
New York, NY 10006
(212) 566-4047

Joseph C. Laws, Jr. Esq.
Federal Public Defender's Office
241 Franklin D. Roosevelt Avenue
Hato Rey, PR 00918
(787) 281-4922
Counsel for Pedro Rivera

Ramon Garcia, Esq.
P.O. Box 6113
San Juan, PR 00902
Do not have access to phone number for counsel
Counsel for Bunker Group Puerto Rico

Yolanda Collazo, Esq.
P.O. Box 6113
San Juan, PR 00902
Do not have access to phone number for counsel
Counsel for Bunker Group, Inc.

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Jorge L. Arroyo, Esq. (Deceased)
Counsel for New England Marine Services

(10) United States v. Rio Bravo Farms, Ltd., et al., EP 97 CA 146 (1995 to 1997). While in the Environment and Natural Resources Division, I coordinated a Federal-state interagency Safe Drinking Water Act ("SDWA") enforcement initiative to address contaminated drinking water sources at undeveloped sub-divisions along the U.S.-Mexico border. With the interagency team, I investigated and developed the legal and technical case and worked with Division lawyers who negotiated a consent decree that required El Paso developers to provide potable drinking water to the Colonias residents and pay certain costs associated with connecting residences to water lines. This was a precedent-setting action on which the Division relied in addressing subsequent SDWA matters.

United States District Court for the Western District of Texas
United States District Court Judge David Briones

Co-counsel:

James MacAyeal, Esq.
United States Department of Justice,
Environment and Natural Resources Division
700 D Street, N.W.
Washington, DC 20004
(202) 616-8777

Counsel for Rio Bravo Farms, Ltd., Pecotos Corp., Arthur H. Ivey, Jr.

Sanford Cox, Esq.
Sandford Cox Law Office
6006 N. Mesa, Suite 220
El Paso, TX 79902
(915) 581-3477

Counsel for Arthur H. Ivey, CDV Investments, Inc., Cuna Del Valle, Ltd.

Guy N. Fields, III, Esq.
Fields, Healy and Bagley, P.C.
601 Montana Avenue
El Paso, TX 79902
(915) 351-4000

16. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe

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the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

a. Federal Implementation Plan to Address Visibility Impairment at the Grand Canyon National Park. While at Hogan & Hartson, I played an instrumental role in negotiating a Final Rule with EPA and industry representatives, on behalf of the Grand Canyon Trust, Environmental Defense Fund, and the Sierra Club, among others, whom we represented *pro bono*. The Final Rule recommended a 90% reduction in sulfur dioxide emissions at the Navajo Generating Station, which we negotiated as part of a memorandum of understanding. The final rule was more protective and cost-effective than EPA's original 70% emissions reduction proposal. EPA's rulemaking was upheld in a subsequent litigation brought by several Arizona irrigation districts in which I did not participate.

b. I participated in each of the significant legal activities described below when I served at the Environment and Natural Resources Division of the United States Department of Justice:

(1) I worked with EPA to develop and implement a strategy to identify and mitigate pollution sources into the New River in California from American companies doing business in Mexico. I counseled EPA on its issuance of subpoenas to 100 companies and defended the issuance of the subpoenas in meetings with company representatives and counsel, resulting in near full compliance. I received a Bronze Medal from EPA for these efforts.

(2) I coordinated the development of the Environment and Natural Resources Division's guidance on and strategy for implementing President Clinton's Executive Order on environmental justice, and worked with the Department of Justice's environmental justice team regarding the same

(3) As a member of an interagency team led by the Office of the United States Trade Representative and the Council on Environmental Quality, I participated in the drafting of Executive Order 13141 on Environmental Reviews of Trade Agreements and Implementing Guidelines. I represented the Department of Justice at principals' meetings to resolve significant policy issues, and participated with the Department's Office of Legal Counsel in the final Office of Management and Budget review of the Executive Order. I also participated in the drafting and adoption of Guidelines for the implementation of the Order.

(4) With colleagues from EPA and other affected agencies, I formulated United States Government defenses to citizen submissions made under the Article 14 and 15 Citizen Submission Process Under the NAFTA Environment Side Agreement (NAAEC) relating to NEPA and the Endangered Species Act.

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(5) As a member of the U.S. Delegation, I negotiated the terms of a proposed North American Transboundary Environmental Impact Assessment Agreement with Mexico and Canada before the North American Commission for Environmental Cooperation.

(6) Declaration and Plan of Action for the Summit of the Americas on Sustainable Development in Santa Cruz, Bolivia ("Declaration and Plan of Action for the Bolivia Summit"). I was a member of the U.S. Delegation to the negotiations at the Organization of American States in Washington, D.C. of the Declaration and Plan of Action for the Bolivia Summit and a delegation member to the Presidential Summit in Santa Cruz, Bolivia in 1996. I negotiated commitments to (a) establish a hemispheric network of officials and experts in environmental enforcement to strengthen environmental laws, regulations and enforcement and (b) promote public participation in decision-making for sustainable development.

(7) In order to abate pollution entering the United States from Mexico, I formulated cooperative enforcement initiatives that were implemented through negotiated annual work plans with enforcement officials from the Government of Mexico

c. I have never engaged in lobbying activities on behalf of any client.

17. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee

Taught "U.S. and International Environmental Law," Fundamentals of U.S. and International Corporate Law Certificate Program, Universidad Autónoma de Guadalajara and Georgetown University School of Law in 1997 in Guadalajara, Mexico;

New York University School of Law, Legal Research and Writing Program, Teaching Assistant, 1988-1989

18. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

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Upon my resignation from General Electric ("GE"), I will forfeit my unvested GE Regular and Guaranteed Pension benefits, I will receive a lump sum payment of the amounts in my GE Personal Pension Account and Voluntary Pension Account, and I will receive a lump sum distribution of my investment in the GE Savings and Security Program. I also have unvested GE stock options and unvested GE restricted stock units ("RSUs") which begin to vest on July 24, 2009, if I am still employed at GE. The stock options and RSUs will be cancelled upon my resignation from GE.

19. **Outside Commitments During Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service? If so, explain.

    No.

20. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    Please see responses to SF 278 Form.

21. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached financial net worth statement.

22. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, affiliations, pending and categories of litigation, financial arrangements or other factors that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

       If confirmed as Assistant Attorney General, I will resign from my position as Counsel for the General Electric Company ("GE"). I have been granted unvested GE stock options and unvested GE restricted stock units which begin to vest on July 24, 2009. These unvested stock options and restricted stock units will be cancelled if I resign from GE prior to July 24, 2009. I also own stock in GE, but will ensure that the value of the stock does not exceed the amount of the *de minimis* exemption for matters affecting nonparties at 5 C.F.R. § 2640.202(b). Accordingly, I will not participate personally and substantially in any particular matter that has a direct and predictable effect on the financial interests of GE, unless I first obtain a written waiver, pursuant to 18 U.S.C. § 208(b)(1), or qualify for a regulatory exemption, pursuant to 18 U.S.C. § 208(b)(2). For a period of

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two years after my resignation from my position with GE, I will not participate personally and substantially in any particular matter involving specific parties in which GE is a party or represents a party unless I am first authorized to participate.

I will resign from my positions with the following organizations: the Hispanic National Bar Association, the Bureau of National Affairs, the Washington Lawyers' Committee for Civil Rights and Urban Affairs, and the Center for International Environmental Law. For a period of two years after my resignation from each of these organizations, I will not participate personally and substantially in any particular matter involving specific parties in which that organization is a party or represents a party, unless I am first authorized to participate.

I have been advised that because of the standard of conduct on impartiality at 5 C.F.R. § 2635.501, that I should seek advice before participating in any particular matter involving specific parties in which a member of my household has a financial interest or in which someone with whom I have a covered relationship is or represents a party.

In connection with the nomination process, I have consulted with the Office of Government Ethics and Department of Justice ethics officials to identify potential conflicts of interest. Any potential conflicts of interest will be resolved in accordance with the terms of an ethics agreement that I have entered into with the Department's designated agency ethics official.

b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

In connection with the nomination process, I have consulted with the Office of Government Ethics and Department of Justice ethics officials to identify potential conflicts of interest. Any potential conflicts of interest will be resolved in accordance with the terms of an ethics agreement that I have entered into with the Department's designated agency ethics official.

23. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each. If you are not an attorney, please use this opportunity to report significant charitable and volunteer work you may have done.

I am committed to public service and have performed a minimum of 50 hours of *pro bono* work every year since I graduated from law school. Representative charitable, volunteer, and *pro bono* work includes:

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General Counsel, Hispanic National Bar Association, 2008-Present

Board of Advisors, Center for International Environmental Law, 2004-Present

Community Service Co-Leader, Hispanic Forum Schenectady Hub, General Electric Company, 2007- Present (community service projects include work with Junior Achievement at the Mont Pleasant Middle School, YMCA Black and Latino Youth Program, building housing with Habitat for Humanity, as well as organizing voter registration and Food Bank drives)

Co-Leader for Honduras Safe Water and Education Project, Hispanic Forum National Community Service Team, General Electric Company, 2008-Present

Board of Trustees, Washington Lawyers' Committee for Civil Rights and Urban Affairs, ("WLC"), 2007-Present, Board of Directors, WLC, 2003-2006 (Among other projects with the WLC, I led the "adoption" of middle schools in Washington, DC by my then-firm Spriggs & Hollingsworth and developed tutoring and mentoring programs in which more than 20 firm attorneys and staff participated.)

American Bar Association. Planning Committee and Moderator and Speaker, 36th Annual Conference on Environmental Law (Keystone Conference), 2006-2007; Vice-Chair for Technology, Superfund and Natural Resource Damages Litigation Committee, 2004-2005; Vice-Chair, 2003 Annual Meeting Planning Committee, 2002-2003; Vice-Chair for Programs, International Environmental Law Committee, Section of Environment, Energy and Resources, 2001-2002; Vice-Chair, International Environmental Law Committee, Section of International Law and Practice, 2000-2001

President, Hispanic Bar Association of the District of Columbia ("HBA-DC"), 2000-2001; Advisory Board, HBA-DC, 2004-2006; Board of Directors, HBA-DC, 1995-2002

District of Columbia Bar: Special Committee on Multi-Jurisdictional Practice, 2002-2004; Nominations Committee, 2001

Federal Implementation Plan to Address Visibility Impairment at the Grand Canyon National Park. While at Hogan & Hartson, I played an instrumental role in negotiating a final rule with EPA and industry representatives on behalf of the Grand Canyon Trust, Environmental Defense, and the Sierra Club, among others, whom we represented *pro bono*. The final rule recommended a 90% reduction in sulfur dioxide emissions at the Navajo Generating Station, which we negotiated as part of a memorandum of understanding. The final rule was more protective and cost-effective than EPA's original 70% emissions reduction proposal. EPA's rulemaking was upheld in a subsequent litigation by several Arizona irrigation districts in which I did not participate.

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United States Senate Committee on the Judiciary
Ignacia S. Moreno Response to Questionnaire

Contributed to the preparation of the report "Separate and Unequal: The State of the District of Columbia Public Schools Fifty Years After *Brown* and *Bolling*," A Parents United for the D.C. Public Schools Civic Leader Advisory Committee Report, March 2005

Co-authored Report to the United States Senate Committee on the Judiciary titled "Redressing Impediments to Voting Facing Language Minorities: The Need to Reauthorize and Expand Section 203 of the Voting Rights Act," March 4, 1992, on behalf of the Mexican-American Legal Defense and Educational Fund

Co-authored a report on "Language Barrier Problems in the Hispanic Community's Contacts with the Metropolitan Police Department and the District of Columbia's Court System," 1991, and testified before the United States Commission on Civil Rights regarding the findings in the report

Participated in the preparation of an *amicus* brief filed before the United States Supreme Court in *Immigration and Naturalization Service v. National Center for Immigrants' Rights*, No. 90-1090 (July 12, 1991), on behalf of the American Bar Association

Represented individual political asylum clients *pro bono*

Represented the Bankruptcy Trustee for the Latin American Investment Corporation and assisted in the recovery of assets belonging to Latinos in the District of Columbia metropolitan area

Co-drafted proposed licensing regulations for District of Columbia youth residential facilities

Coordinated and conducted "Street Law" programs at District of Columbia high schools and a middle school, and

Mentor youth through Junior Achievement and YMCA programs

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FINANCIAL STATEMENT

NET WORTH

Provide a complete, current financial net worth statement which itemizes in detail all assets (including bank accounts, real estate, securities, trusts, investments, and other financial holdings) all liabilities (including debts, mortgages, loans, and other financial obligations) of yourself, your spouse, and other immediate members of your household.

ASSETS				LIABILITIES			
Cash on hand and in banks		112	000	Notes payable to banks-secured			0
U.S. Government securities-add schedule			0	Notes payable to banks-unsecured			0
Listed securities-add schedule		393	000	Notes payable to relatives			0
Unlisted securities--add schedule			0	Notes payable to others			0
Accounts and notes receivable:				Accounts and bills due			0
Due from relatives and friends		75	000	Unpaid income tax			0
Due from others			0	Other unpaid income and interest			0
Doubtful			0	Real estate mortgages payable-add schedule		332	000
Real estate owned-add schedule		625	000	Chattel mortgages and other liens payable			0
Real estate mortgages receivable			0	Other debts-itemize:			0
Autos and other personal property		18	000				
Cash value-life insurance			0				
Other assets itemize:			0				
Retirement Accounts-see schedule		206	000				
				Total liabilities		332	000
				Net Worth	1	097	000
Total Assets	1	429	000	Total liabilities and net worth	1	429	000
CONTINGENT LIABILITIES				GENERAL INFORMATION			
As endorser, comaker or guarantor			0	Are any assets pledged? (Add schedule)			No

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United States Senate Committee on the Judiciary
Ignacia S. Moreno Response to Questionnaire

On leases or contracts			0	Are you defendant in any suits or legal actions?			No
Legal Claims			0	Have you ever taken bankruptcy?			No
Provision for Federal Income Tax			0				
Other special debt			0				

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ADDED SCHEDULE OF ASSETS AND LIABILITIES FOR IGNACIA S. MORENO

Listed Securities

American High Income Trust Class F	$ 10,000
Columbia Small Cap Value Fund I Class Z	$ 8,000
Dodge & Cox International Fund	$ 15,000
Eagle Capital Appreciation Trust Class A	$ 31,000
Fidelity Advisor Leveraged Company Stock Fund Class I	$ 17,000
Fidelity Advisor Municipal Fund Class I	$ 19,000
General Electric Common	$ 22,000
Harbor International Fund	$ 47,000
J.P. Morgan U.S. Real Estate Fund Class A	$ 19,000
Keeley Small Cap Value Fund Class A	$ 7,000
Lazard Emerging Markets Equity Open (LZOEX)	$ 15,000
Loomis Sayles Global Bond Fund Retail Class	$ 10,000
MFS Research International Fund Class W	$ 14,000
Prudential Financial, Inc. Common	$ 1,000
T Rowe Price Dividend Growth	$ 28,000
Vanguard Developed Markets Index Fund	$ 33,000
Vanguard Inflation Protected Securities Fund	$ 16,000
Vanguard 500 Index Fund Investor Shares	$ 30,000
Vanguard Growth Index Fund Investor Shares	$ 25,000
Vanguard Mid-Cap Stock Index Fund	$ 16,000
The Cash Management Trust of America – Class A	$ 10,000
Total	$393,000

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ADDED SCHEDULE OF ASSETS AND LIABILITIES FOR IGNACIA S. MORENO (Cont'd)

Retirement Accounts	
Thrift Savings Plan—C Fund	$ 63,000
Spriggs & Hollingsworth 401(k)	$ 29,000
Hogan & Hartson 401(k)	$ 34,000
General Electric Savings & Security Program	$ 52,000
General Electric Pension Plan	$ 17,000
IRA: Dreyfus General Money Market Fund	$ 11,000
Total	$206,000
Real Estate Owned	
House in Guilderland, NY	$350,000
Condominium in Alexandria, VA	$275,000
Real Estate Mortgages Payable	
Trustco Bank (Guilderland, NY property)	$258,000
Astoria Federal Savings (Alexandria, VA property)	$ 74,000

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United States Senate Committee on the Judiciary
Ignacia S. Moreno Response to Questionnaire

AFFIDAVIT

I, Ignacia S. Moreno, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

6/10/09
(DATE)

Ignacia S. Moreno
(NAME)

Maureen Young
(NOTARY)

MAUREEN YOUNG
Notary Public in the State of New York
Qualified in Saratoga County No. 01YO4[illegible]
My Commission Expires Dec. 10, 20[illegible]

Senator WHITEHOUSE. Thank you very much, and welcome.

I would begin by asking each of the judicial nominees the same question that I asked Judge Greenaway, which is whether you are prepared, in embarking on these judicial duties, to respect the role of Congress as the representatives of the American people, to decide cases based on the law and the facts, to not prejudge any case, but listen to every party that comes before the court, to respect the precedent of law that has been established in your district, and to limit yourself to the issues that your court must decide.

Are you prepared to undertake your duties under that set of strictures?

Judge LANGE. Mr. Chairman, my answer is, unequivocally, yes.

Judge BERGER. Mr. Chairman, my answer to all facets of your question is an unequivocal yes.

Senator WHITEHOUSE. Judge Honeywell?

Judge HONEYWELL. And Mr. Chairman, I join with the other panelists. My response is also an unequivocal yes. I have endeavored to do that for the eight and a half years that I've already served as a judge in Florida, although not Congress as much as the Florida legislature. So, I absolutely agree and give you an unequivocal yes.

Senator WHITEHOUSE. I appreciate that.

The other question I asked is also one that is important to me. There may very well come a time when the requirements of the law or the requirements of the Constitution, as you with your very best conscience and judgment read it to say, may very well cross either expectations or conventions of society. In those circumstances, can we be assured that you will follow the law and the Constitution, even if the consequences may be disruptive for settled interests?

Judge LANGE. My answer, Mr. Chairman, is yes. The Constitution is the supreme law of the land that must be followed, even if it is a difficult result.

Judge BERGER. I agree with Mr. Lange. In all instances, the Constitution and the law controls, given the particular factual scenario, without giving consideration to the other issues which might come to bear at the time.

Senator WHITEHOUSE. Thank you.

Judge HONEYWELL. And Mr. Chairman, I, too, agree with the responses of my colleagues. I absolutely agree that the Constitution and the controlling law are to be followed by the judge in rendering decisions without giving attention to any other extraneous matters. It is my responsibility as a judicial officer to be faithful to the law.

Senator WHITEHOUSE. I thank you all.

Ms. Moreno, you have been on both sides of the aisle, so to speak. You have served before in the Environment and Natural Resources Division and been an enforcer of our environmental laws. You have also represented the private sector in matters of compliance with those environmental laws. Can you assure me that you are prepared to pursue full and fair enforcement of our environmental laws, and elaborate a little bit on what your experience on the defense side has taught you that you would bring to your duties, should you be confirmed?

Ms. MORENO. Thank you, Senator Whitehouse, for that question. I'm being advised to turn the mike on. Thank you, Senator.

Senator WHITEHOUSE. Always wise to obey a judge.

[Laughter.]

Ms. MORENO. Absolutely. Thank you, Senator, for giving me the opportunity to answer that question. I am—I can tell you, unequivocally, the answer is: yes, I will absolutely be a defender of the Nation's environmental law. I am fully committed to the core mission of the Environment and Natural Resources Division, which includes a strong enforcement of laws enacted by Congress to protect human health and the environment, and to ensure clean air, clean water, and clean land for all Americans. That core mission also includes the defense of the laws enacted by Congress in the defense of agency programs and actions, as well as stewardship responsibilities and mindful management of our trust obligations to Native American tribes.

My experience in the Division will serve me well if I am confirmed to be Assistant Attorney General for the Environment Division. I both work on affirmative enforcement matters, on criminal prosecutions, as well as in defense of the Nation's laws and programs. My private sector experience will only serve to make me a more effective Assistant Attorney General, if I should be confirmed, because I have, as you said, seen how it all works on both sides and would be mindful of our obligations.

Senator WHITEHOUSE. Thank you very much.

My time has expired and I call on our distinguished Ranking Member.

Senator SESSIONS. Thank you. I will just ask one thing of all of you, which is it's pretty obvious to me, having spent a good number of years practicing before Federal judges, that it's a challenge and a difficult task and requires a lot of work.

So I guess I would ask you, Mr. Lange, are you committed to managing your courtroom, to reaching—doing justice as best you're able, but also managing the courtroom, disposing of cases in a timely fashion and not causing unnecessary expense to the litigants?

Judge LANGE. I certainly am, Senator Sessions. I'm from a family farm background. I've worked very hard throughout my life and I intend to commit myself to diligent and timely handling of the cases that come before me in a fair and impartial manner.

Senator SESSIONS. Thank you.

And do you agree?

Judge BERGER. Yes, Senator, I absolutely agree. I think it's exactly what I've made an effort to do over the course of the last 15 years as a State court judge, to employ whatever tools necessary in keeping with trying to ensure that every party was heard fairly and equally to try to be responsive in a timely manner.

Senator SESSIONS. Thank you.

Judge Honeywell.

Judge HONEYWELL. Yes, Senator Sessions. I, too, agree. I first learned a little bit about managing a heavy caseload as an assistant public defender. That experience has kept me well in my experience now as a State court judge, where I preside over a docket of approximately 4,300 cases.

Senator SESSIONS. Well, I think it is important. I hear, on occasion, lawyers and litigants complain about unnecessary delays. It

can be very costly to them in terms of lawyers and business decisions that are in limbo, and that kind of thing.

Mr. Lange, I like the fact that you're an active practitioner in your State for a number of years, and I like the fact that you've been active politically. I think that's a good thing. You've been active in a number of campaigns for Democratic nominees, as the Governor's race, Senator Daschle and Senator Johnson, both of which are honorable things to do.

Are you confident that you can make the transition to a judge who puts aside those political views and can decide the case objectively, even though the person before you might be of a different political party?

Judge LANGE. Certainly, Senator Sessions. Many of my friends are of a different political party; I'm from South Dakota, after all.

[Laughter.]

Judge LANGE. Many of my partners are from a different political party. I have no question about my ability to treat people fairly, regardless of what background they come from or what their political affiliation may be. My role in those campaigns was to make sure that the candidate was well-represented and the campaign laws were followed, and those proved to be campaigns that went fairly smoothly in terms of no great issues arising. That's the way it should be. Elections should be fair and square. That was what my responsibility, I felt, was in those settings.

Senator SESSIONS. Well, I remember when President Bush chose Ted Olson to be his Solicitor General and some were unhappy because he had defended him in Florida. But I figured that proved that he thought highly of him, if he chose to defend him out of the whole—of all the lawyers in the United States of America, he told Ted Olson to be the one that defended his campaign.

So, no. I think that's very true. I believe, particularly in smaller States where you deal on a regular basis with judges of different parties, you've practiced before them with lawyers of different political views, I think you can move past that. Some people can't, but most people who have actually been good practicing lawyers have no difficulty in that.

Let's see. Judge Berger, 3 years ago, in a speech to the Legal Services Corporation in Charleston, West Virginia, you closed with the following quote from a former Canadian Attorney General: "Substantive and procedural law benefits and protects landlords over tenants, creditors over debtors, lenders over borrowers, and the poor are seldom among the favored parties." Now, I think those were remarks made some 40 years ago by a Canadian.

The oath that you take says that you will do equal justice to the poor and the rich alike. Are you committed to that oath, and does this suggest that you feel that contracts and mortgages shouldn't be enforced as written? Would that not impact the willingness of, let's say, a bank to loan somebody $100,000 to pay it back over 30 years at 6 percent if they felt like the terms of the contract wouldn't be honored if the borrower got into default?

Judge BERGER. Thank you, Senator, for an opportunity to clarify that comment. First of all, I want to say very strongly that I will, if confirmed, ensure that all parties are treated fairly and equally. They will be heard equally, be they rich or be they poor. In making

that speech and quoting that, I simply wanted to impress upon the Legal Services Board that there was work to do in terms of equaling, from their perspective, the playing field among various constituencies.

As a judge in a courtroom, I do not have that luxury. I think the Legal Services Board, however, does have the luxury for working to trying to see that people have access to the courts, and that was my intention in adding that to that particular speech.

Senator SESSIONS. I think there is a danger that poor people with less education have difficulties understanding the full ramifications of a contract. But I do believe that the entire economic system and the ability of a poor person to get a loan could be reduced if the fundamental principles of the contract are not enforced.

With regard to sentencing, you made a comment in 2000 that you never knew prison to improve a person, and that in borderline cases you would prefer 2 or 3 years probation. As you know, the sentencing guidelines in Federal court are pretty restrictive on a judge. State judges often chafe at that narrow window of ability to sentence. People who have gone straight on the Federal bench, I don't think, have any trouble. They find it pretty—somewhat relieving to be able to say, well, this objective panel has said this is the kind of range I should utilize when I sentence. But a judge who allows their personal views to impact sentencing can cause quite a bit of turmoil, appeals, and uncertainty in the system.

So I guess I would ask you, are you generally familiar with the requirements of the sentencing guideline, and are you willing to follow them even if that would not be your choice for an appropriate sentence in a case?

Judge BERGER. Thank you, Senator. The answer to your question is yes. I am familiar with the sentencing guidelines. I would agree with you that oftentimes in State court there is discretion that is not presented by the operation of those sentencing guidelines. There are also, however, in State court, some mandatory sentences where judges don't have any leeway and I have, over the course of the 15 years that I have sat as a State court judge, applied those when it was appropriate. If confirmed by this body, I will continue to do that. I see it no differently than applying the law in any other area, which I am very committed to do, if confirmed.

Senator SESSIONS. Thank you. It's a remarkable thing, what the Federal Government did with regard to the sentencing guidelines.

Judge Honeywell, a number of years ago you were representing the City of Ft. Lauderdale. St. Petersburg. No, Ft. Lauderdale.

Judge HONEYWELL. Tampa. city of Tampa.

Senator SESSIONS. Tampa. OK. A Ft. Lauderdale gun show—reported in the St. Petersburg Times about Tampa. I guess that's right, Tampa. They had banned gun show sales. You were the attorney for the city, correct?

Judge HONEYWELL. That's correct. I was, Senator.

Senator SESSIONS. Which is your duty to defend the city's statutes.

Judge HONEYWELL. Absolutely.

Senator SESSIONS. And you stated, "Our position is that if speech is involved it's commercial speech, which is not entitled to the same protection under the law as political speech." I guess, have you had

any thoughts about that statement in light of more recent Supreme Court authority, and even the Heller case in the District of Columbia?

Judge HONEYWELL. Thank you, Senator. I have not had any additional thought with regard to that statement because that statement occurred, gosh, over 12 years ago. I can assure you that as a judge, though, I would be required to, and absolutely would, follow the law of our land. So as the law has changed and evolved since that statement was made, I, as a judge, would follow that law based upon precedent and the doctrine of stare decisis.

Senator SESSIONS. I think there has been some recognition that there's not much difference between commercial speech and personal speech, but at one time there was some case authority that went along that way.

Likewise, on the sentencing guidelines, are you committed to following those?

Judge HONEYWELL. I am committed to following the sentencing guidelines. I believe that establishing the guidelines is the role of Congress. It would be my job, if confirmed by this body, to apply that law to the facts of the cases before me, but Congress certainly has the authority and has acted by establishing the sentencing guidelines. I am also familiar with the sentencing guidelines because in Florida we do have sentencing guidelines, too.

Senator SESSIONS. I think it was a major step that the Congress took before I came here. I think Senator Kennedy and Senator Thurmond both supported it and it brought some objectivity to sentencing. We had this spectacle in the same courthouse, two people being convicted of the same crime, and one judge giving probation and another 20 years, and it was difficult to justify that. So it does bring some consistency and gives you a range within which to sentence. But people who are not that familiar with guidelines often feel some of our State judges who become Federal judges get anxious about it, I'll just say it that way. They're used to doing it the way they've done it.

Ms. Moreno, yours is an important position. You've had a position with an environmental group, the Environment and Natural Resources Division, before. They have to take some tough cases. Some of them are quite technical. Some of them have been criticized as being unnecessary, unnecessary enforcement actions that don't make sense. But the Department has been proud of its strict enforcement of the law, which I don't disagree with.

So I guess, you've been in the Department, you've been in the private sector. Do you think you can enforce the law fairly and adequately based on the law and the facts as you make the final decision on what cases to bring and recommend for prosecution?

Ms. MORENO. Absolutely, Senator. You have my commitment to that.

Senator SESSIONS. Well, I think there's nothing wrong with you having been with a major corporation and you have the other side experience, too, in the Department. So, I thank you.

Mr. Chairman, each one of these nominees has strong support and we'll be continuing to look at their records, but I'm impressed with them.

Senator WHITEHOUSE. I thank the very distinguished Ranking Member.

I want to thank all of you for your presence here today. This is a very distinguished panel. Each one of you is an extraordinarily accomplished individual. The process that has led to today of FBI background checks and innumerable forms to fill out, and so forth, has been—I know from firsthand experience—a long ordeal, but it is essentially concluded at this point. I think you have both of our hopes for a speedy and uneventful confirmation.

But as you think back on this day, I want you to be aware that both the Ranking Member and I are aware that you bring extraordinary life experience, talent, and dedication to this day. Two of you bring substantial judicial experience as well, Judge Berger and Judge Honeywell. You bring before us the confidence of your communities, you bring before us the confidence of your home State Senators, and you carry with you the confidence of the President of the United States of America that you will do well as you assume the responsibilities that, upon confirmation, will be yours.

You are embarking, each of you, in somewhat different ways on a career of public service that will entail a lot of hard work, a lot of late hours. Nothing particularly great in the way of pay, but a lot of great moments, a lot of great opportunities, and the greatest opportunity of all, which is to serve your country, the United States of America.

So I salute you on being here today. I hope that you and your families enjoy this day and I wish you godspeed.

Do you have anything else you'd like to add?

Senator SESSIONS. Just briefly.

Congratulations to each of you for your nomination. I'm happy for you and your families. This should, indeed, be a special occasion. I may submit some questions for the record that I hope that you would respond to. I know you understand fully that a Federal judge is given a lifetime appointment. Even though the salary may not be the greatest compared to what some private lawyers make, you don't have to worry about maintaining your position in the law firm and you don't have to keep a time sheet.

So, it's a fabulous job and most judges that I've known have thoroughly enjoyed it. It's a great honor that you've been given to be nominated and I expect things should go forward in a timely manner. I don't believe that any of you need to be held up based on what I know at this time. So, we'd like to see you get your vote as soon as reasonably possible.

Senator WHITEHOUSE. I thank the Ranking Member very much for that. We have already, without objection, put my complete opening statement into the record. We have already, without objection, put the remarks by Senator Robert C. Byrd in favor of the nomination of Judge Berger, at the request of Senator Rockefeller, into the record.

I would also ask unanimous consent that the statement of the distinguished Chairman of the Senate Judiciary, Patrick Leahy, be added to the record.

[The prepared statement of Chairman Leahy appears as a submission for the record.]

Senator WHITEHOUSE. The full statement of Ignacia Moreno. I appreciate very much that she shortened her statement, but we would like to have her full statement be a matter of record in these proceedings.

[The prepared statement of Ms. Moreno appears as a submission for the record.]

Senator WHITEHOUSE. And finally, we have a file folder full of letters of support for Ms. Moreno from a great number of people. I will not read them all off, but they include: Lois Schiffer, who was a previous occupant of that position; Steven Solau, who's the former Chief of the Environment Crimes section at the NRD; and the Center for International and Environmental Law; OCEANA, Protecting the World's Oceans; the Hispanic National Bar Association; the National Hispanic Leadership Agenda; the National Council of La Raza; the current and past chairs of the American Bar Association, Section of Environment, Energy and Resources; and I promised I would not read them all so I will not.

[Laughter.]

Senator WHITEHOUSE. But there is a hefty file of support. Without objection, they will be made a part of the record.

[The letters appear as a submission for the record.]

Senator WHITEHOUSE. As I said earlier, the hearing will remain open for an additional week for the responses and for any other materials that anybody should seek to add to the record, and then we will proceed through the remainder of the nomination process. But I wish you all well. I congratulate you on the achievements that have brought you here today.

The hearing is adjourned.

[Whereupon, at 3:55 p.m. the Committee was adjourned.]

[Questions and answers and submission for the record follow.]

QUESTIONS AND ANSWERS

Responses of Irene Cornelia Berger
Nominee to the U.S. District Court for the Southern District of West Virginia
to the Written Questions of Senator Jeff Sessions

1. **President Obama has described the types of judges he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."**

   a. **Do you agree with President Obama's quote?**

      Response: I am not certain that I understand what the President intended by the quote. However, in terms of judges, it is my opinion that we need people who will work within ethical guidelines to apply the law, treat all parties respectfully, fairly and equally and issue timely rulings.

   b. **Do you believe that you fit President Obama's standard as described in his quote?**

      Response: As noted, I'm not sure I understand the intent of the quote. If it is intended as a standard, I think President Obama would be in a better position to answer this question. However, I do believe that selecting judges and judging are two very distinct issues.

   c. **What role do you believe that empathy should play in a judge's consideration of a case?**

      Response: I do not believe that empathy should play a role in a judge's consideration of a case. The judge should apply the law to the facts of the case without being influenced by sympathy or empathy.

   d. **Do you think that it is ever proper for judges to indulge their own subjective sense of empathy in determining what the law means?**

      Response: No.

      i. **If so, under what circumstances?**

         Response: Not applicable given the answer above.

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ii. Please identify any cases in which you have done so.

Response: Not applicable given the answer above.

iii. If not, please discuss an example of a case where you have had to set aside your own subjective sense of empathy and rule based solely on the law.

Response: I have no empathy that is inconsistent with applying the law. Therefore, I am unaware of any case in which I have had to set aside my own subjective sense of empathy.
I have, however, had the occasion to set aside sympathy and rule based solely on the law. Early on in my career as a judge, I presided over a case in which parents sued a property owner for the wrongful death of their son. Their son was decapitated as he rode a motorcycle and ran into a wire which was strung along the property line to keep trespassers off of the property. These parents had lost a child and wanted someone to be held responsible. As most people would, I felt sympathy for the parents but given our case law relative to trespass, at the time, I granted summary judgment in favor of the property owners.

2. What in your view is the role of a judge?

Response: The role of a judge is to ascertain the relevant facts, apply the applicable law to the facts, without outside influence, in a timely manner and in keeping with ethical standards.

a. Do you think it is ever proper for judges to indulge their own values in determining what the law means?

Response: Yes

i. If so, under what circumstances?

Response: Values such as honesty, integrity, strength and commitment serve a judge well in determining what the law means. Being honest about the status of existing law and having the integrity, strength and commitment to make the determination and apply it, within ethical parameters, without succumbing to outside influence, are assets for a judge.

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ii. Please identify any cases in which you have done so.

Response: I use these values in every case.

iii. If not, please discuss an example of a case where you have had to set aside your own values and rule based solely on the law.

Response: I have no values which are inconsistent with applying the law and, therefore, have not had a case where I have had to set aside my own values and rule based solely on the law.

b. Do you think it is ever proper for judges to indulge their own policy preferences in determining what the law means?

Response: No.

i. If so, under what circumstances?

Response: Not applicable given the answer above.

ii. Please identify any cases in which you have done so.

Response: Not applicable given the answer above.

iii. If not, please discuss an example of a case where you have had to set aside your own policy preferences and rule based solely on the law.

Response: I presided over a case involving a young adult defendant convicted of robbery. Having given consideration to the sentencing factors, such as a lack of prior criminal record, his age, educational background, employment, psychological and other factors, and believing (based on these objective factors) that he could possibly be rehabilitated, it was my policy preference to impose an alternative sentence. However, by statute, a minimum sentence of ten (10) years in the penitentiary was required. I imposed the applicable sentence despite my policy preference.

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3. How would you define "judicial activism?"

Response: This is not a term that I use. However, when I have seen it used and given consideration to the context in which it was used, I have interpreted it to mean ignoring existing statutory, case or other law and/or the reasonable interpretation of the same, to reach a predetermined result in a case.

a. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: The Constitution is not constantly evolving but the body of constitutional law is ever evolving because the terms of the Constitution must be interpreted and applied in light of new factual scenarios (not previously decided) when the same are presented.

4. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: Yes.

b. How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision or your own best judgment of the merits?

Response: My opinion or belief that the Supreme Court or the Court of Appeals had erred would not be relevant. I would apply the law as rendered by the Supreme Court or the Court of Appeals, if applicable to the facts of the case which I had under consideration.

5. Do you believe that a federal district court has the institutional expertise to set rules for and oversee the administration of the prisons, schools, or state agencies?

Response: I believe that these are functions of the other branches of government as opposed to the judicial branch.

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Responses of Joseph A. Greenaway, Jr.
Nominee to the U.S. Court of Appeals for the Third Circuit
to the Written Questions of Senator Jeff Sessions

1. **Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?**

   Response: I do not have a view as to whether the Constitution is a "living" document. In my judgment, there are varying interpretations of what the term "living" document entails. I have not applied any of the various iterations of this phrase or doctrine in any of my opinions which addressed constitutional issues. I believe that in any question of constitutional interpretation that arises for resolution, I must begin my analysis with the text. In certain cases, I believe it may be appropriate to discern what the Framers and later Congress contemplated and discussed in their consideration of a particular constitutional provision.

2. **Do you think it is ever proper for judges to indulge their own values in determining what the law means?**

   Response: In employing the term "values," I interpret the question to be asking whether I, as a sitting federal district court judge, apply my own morality, i.e., my own sense of right and wrong, in deciding what the law is. This premise does not describe my judicial decision-making. I interpret the law based on a detailed and thorough analysis of the facts and law, applying the principle of stare decisis. My values or morality cannot inform my decision-making. I cannot allow myself to rule based on my values.

   a. If so, under what circumstances?

   Response: See above.

   b. Please identify any cases in which you have done so.

   Response: I have not indulged my values in determining what the law is or what the law means in any cases that I have ruled upon while sitting as a federal district court judge.

   c. If not, please discuss an example of a case where you have had to set aside your own values and rule based solely on the law.

   Response: If I were to indulge in decision-making based on my values or morality, I surely would have come to a different set of decisions in Iwanowa v. Ford, 67 F. Supp. 2d 424 (D.N.J. 1999). In that case, persons (both Jewish and non-Jewish) who

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were forced to engage in slave labor to aid the Nazis' cause in World War II sued Ford Motor Company and Ford Werke (Ford's German subsidiary). Based on several theories of recovery, Plaintiffs sought damages for the forced labor demanded by the Third Reich under horrific conditions. If I were to apply my own sense of morality or values to this case, I would have concluded that some recovery was warranted for Plaintiffs. However, the law controlled my analysis and the lengthy opinion I penned allowed no recovery and dismissed all claims.

3. Do you think that it is ever proper for judges to indulge their own policy preferences in determining what the law means?

Response: I do not believe it is ever proper for judges to indulge their own policy preferences in determining what the law means. Frankly, I cannot think of an instance when employing that method of analysis is appropriate for a federal judge.

a. If so, under what circumstances?

Response: See above.

b. Please identify any cases in which you have done so.

Response: There are no cases that I can identify in which I indulged my own policy preferences in determining what the law means.

c. If not, please discuss an example of a case where you have had to set aside your own values and rule based solely on the law.

Response: The best example of setting aside my values and ruling based on the law appears in section 2.c. above.

4. At your hearing, I asked for your views on President Obama's statement regarding the types of judges that he will nominate to the federal bench: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges." You answered:

> **"I'm not in the President's position with regard to what makes a good judge. The only thing I can tell you is that in my years of experience I've tried to be fair to folks. I've tried to treat them with the utmost respect and to . . . address their cases as best I could, applying the facts to the law."**

I appreciate your answer and have a few more questions with regard to President Obama's statement.

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a. Do you agree with President Obama's quote?

Response: I view President Obama's quote as alluding to a desire to populate the bench with judges from diverse backgrounds and experiences. I agree with such a sentiment. All Americans benefit from seeing and experiencing the unbiased administration of law and justice by individuals of different religious, socioeconomic, ethnic, gender, and racial backgrounds. I do not interpret the President's quote to mean that heart and empathy are express values or qualities to be employed by judges in their judicial decision-making.

b. Do you believe that you fit President Obama's criteria for federal judges, as described in his quote?

Response: As I have interpreted President Obama's quote, I believe I do. I am an immigrant. I came to this country at 2 years of age with my parents and my then-infant sister. We immigrated to become Americans. We have embraced the American dream. Our family worked hard. We earned degrees from excellent schools and we are productive contributors to society. We are proud to be African-Americans.

Our family's story is not unique; indeed, it exemplifies the American dream. To the extent that the President seeks to appoint to the federal bench, among others, those who appreciate coming from modest means, who understand struggle, and who know the plight of those less fortunate, I believe I fall into that category.

c. What role do you believe that empathy should play in a judge's consideration of a case?

Response: Empathy cannot play a role in a judge's consideration of a case or in determining what the law means. I have told lawyers who appear before me that as a human being, I may have empathy for their client, but as a judge I have none because that is not my job. The pure exercise of empathy in decision-making would lead to unsound and inconsistent decisions.

d. Do you think that it is ever proper for judges to indulge their own subjective sense of empathy in determining what the law means?

Response: No, I do not believe that my own subjective sense of empathy may be used in determining what the law means.

i. If so, under what circumstances?

Response: See above.

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ii. Please identify any cases in which you have done so.

Response: I have not employed this manner of decision-making in any of my cases.

iii. If not, please discuss an example of a case where you have had to set aside your own subjective sense of empathy and rule based solely on the law.

Response: In addition to my response to 2.c. above, I, like most judges, have experienced at some point in time a sense of empathy at sentencing. There are times that a victim, the victim's family, a defendant, the defendant's family, or the facts of the case induce a sense of empathy. Of course, when a sentence of incarceration is meted out, there is no room for a subjective sense of empathy. The sentencing guidelines, albeit advisory, do not permit the unfettered exercise of discretion based on a subjective sense of empathy. I have not, and would not, use this paradigm as a basis for my decision-making. My job requires me to rule dispassionately and that is what I have done.

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Responses of Charlene Edwards Honeywell
Nominee to the U.S. District Court for the Middle District of Florida
to the Written Questions of Senator Jeff Sessions

Gun Rights

1. **According to a June 24, 1994 article in the *St. Petersburg Times*, a Fort Lauderdale gun show promoter, Atlantic Show Promotions, filed suit in federal court alleging that Tampa's ban on gun shows and sales at the Tampa Convention Center was an unconstitutional attempt to regulate political and commercial speech about guns. The city had refused the request despite the fact that Tampa had permitted Atlantic to operate a gun show in 1993. As Assistant City Attorney, you were quoted as saying: "Our position is that if speech is involved, it's commercial speech, which is not entitled to the same protection under the law as political speech."**

   a. **Do you stand by your statement indicating that you believe that the City of Tampa's ban on gun shows and sales at the convention center was constitutional?**

Response: In June of 1994, I served as an Assistant City Attorney for the City of Tampa and chief of the City's litigation division. In that capacity, I advocated the City's position with regard to a prohibition of gun shows on city owned property. The mayor of Tampa, then, Sandra Freedman, and her staff decided in March of 1994 to prohibit gun shows on city owned property. The statement that I made to the reporter from the *St. Petersburg Times* was made in my capacity as a zealous advocate for my client, the City of Tampa. Given the status of the law in 1994, the position advanced by the City was honestly debatable. If confirmed by the Senate to serve as a District Court Judge, I will follow legal precedent, pursuant to the doctrine of stare decisis, on this issue.

   b. **Does the Supreme Court's opinion in *District of Columbia v. Heller*, holding that the right to bear arms is an individual right affect your analysis of the constitutionality of the ban?**

Response: *District of Columbia v Heller*, 128 S.Ct. 2783 (2008) had not been decided when the City of Tampa announced its ban prohibiting gun shows on city owned property. *Heller* was decided by the Supreme Court of the United States on June 26, 2008. If confirmed by the Senate to serve as a District Court Judge, I will follow legal precedent, including *District of Columbia v. Heller*, supra.

   c. **In *Nordyke v. King*, the Ninth Circuit evaluated whether a county ordinance prohibiting the possession of firearms on county property, and thereby prohibiting a gun show on county property, was**

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constitutional. In its opinion, the Court held that the Second Amendment had heen incorporated against the states through the Due Process Clause of the Fourteenth Amendment. The Supreme Court has not yet addressed this question. Do you agree that the Fourteenth Amendment makes the Second Amendment applicable against state and county governments?

Response: In *Nordyke v King*, 563 F.3d 439 (9th Cir. 2009), the Ninth Circuit did find that the due process clause of the Fourteenth Amendment incorporates the Second Amendment and applies it against states and local governments. However, a few weeks ago, on July 29, 2009, in *Nordyke v King*, 575 F.3d 890 (9th Cir. 2009), the Ninth Circuit decided to rehear the previous *Nordyke v King* decision en banc and indicated that the previous three judge panel opinion should not be cited as precedent by or to any other court of the Ninth Circuit. Therefore, it appears that the issue of the application of the Second Amendment to the states via the Fourteenth Amendment is still an unsettled area of the law. Until the U.S. Supreme Court or the Eleventh Circuit Court of Appeals rules on this issue, it would be inappropriate for me, a district court nominee, to opine on this matter. If confirmed by the Senate to serve as a District Court Judge, I will follow legal precedent pursuant to the doctrine of *stare decisis*.

2. **Following your statement, the U.S. District Court for the Middle District of Florida, granted a preliminary injunction in favor of Atlantic against the City of Tampa. The District Court held that the State of Florida had pre-empted the field of gun regulation which prevented Tampa from arguing successfully that its refusal to allow the gun show advanced a strong municipal interest. The Court further rejected Tampa's alternative argument that a gun show would put the Convention Center in a bad light. The District Court noted Supreme Court precedent holding that commercial speech is entitled to some First Amendment Protection, and that "[t]he loss of First Amendment freedoms, even for minimal periods of time, unquestionably constitutes irreparable injury." *Elrod v. Burns*, 427 U.S. 347, 373 (1976). Do you agree with the district court's ruling?**

Response: I agree with the district court's ruling.

Empathy

1. **President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."**

   a. **Do you believe that you fit the President's criteria for federal judges, as described in his quote?**

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Response: To the extent that I am an African American woman, I fit one of President Obama's criteria for federal judges.

b. What role do you believe that empathy should play in a judge's consideration of a case?

Response: Empathy does not play a role in my consideration of cases. Presently, I decide cases by applying the law to the facts of the cases pending before me. If confirmed by the Senate to serve as a District Court Judge, I will decide cases in the same manner.

Public Defender

1. Early in your career you spent several years as a public defender.

a. How will this experience impact your judging?

Response: My experience as an Assistant Public Defender will not have any particular impact on my judging. In addition to serving as an Assistant Public Defender for five years, I served as an Assistant City Attorney representing a governmental body, a municipal corporation, for seven years. Further, as a shareholder with a major Tampa law firm, I represented many corporate defendants for six years. I am the product of all of these experiences. However, I don't decide cases based upon my experiences. Presently, as a state court judge, and if confirmed by the Senate to serve as a District Court Judge, I will decide cases by applying the law to the facts of the cases pending before me.

b. Do you have any legal or moral beliefs which would inhibit or prevent you from imposing or upholding a death sentence in any criminal case that might come before you as a federal judge?

Response: No, I do not have any legal or moral beliefs which will inhibit or prevent me from imposing or upholding a death sentence in any criminal case that might come before me as a federal judge. If confirmed by the Senate as a District Court Judge, I will take an oath and follow that oath to uphold the Constitution of the United States of America and the laws of this country.

c. Do you believe that 10, 15, or even 20-year delays between conviction of a capital offender and execution is too long?

Response: The reasons for delays between conviction of a capital offender and execution are numerous and varied. The reasons for delays depend upon the particular facts of each case. Therefore, I am unable to address this

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question specifically. Additionally, as a state court judge, I am prohibited from rendering an opinion on a matter that may come before me.

d. Do you believe that once Congress or a state legislature has made the policy decision that capital punishment is appropriate that the federal courts should focus their resources on resolving capital cases expeditiously?

Response: Federal courts have the responsibility of applying the law to the facts of cases before them and of doing so in a timely manner.

Precedent

1. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: I am committed to following the precedents of higher courts faithfully and giving them full force and effect. As part of my training after becoming a state court judge, I was taught that, as a judge, I have no personal opinions, i.e., my personal opinions don't matter. That advice has served me well over the past eight and one-half years. My role is simply to apply the law to the facts of the cases before me in an impartial and unbiased manner.

b. How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision of your own best judgment of the merits?

Response: If confirmed by the Senate to serve as a District Court Judge, it would not be my role to question the opinions of courts of appeal or of the United States Supreme Court. Rather, I would be required to follow legal precedent, pursuant to the doctrine of *stare decisis*. Therefore, I would apply decisions of the Supreme Court or the Eleventh Circuit Court of Appeals.

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The Role of a Judge

1. **What in your view is the role of a judge?**

Response: The role of a judge is to apply the law to the facts of the case pending before the judge, and to do so in an impartial, unbiased and timely fashion.

a. How would you define "judicial activism?"

Response: I don't use the term "judicial activism" because of the confusion surrounding its meaning. Judicial activism is usually used to criticize judicial rulings that are viewed as unreasonable interpretations of laws and or cases which are tantamount to legislating from the bench.

b. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: There are numerous meanings and conflicting contentions surrounding the idea of a "living" constitution. As such, I am unable to agree with any broad or general classifications of the Constitution. The Constitution represents the supreme law of this land. If confirmed by the Senate to serve as a District Court Judge, I will uphold the Constitution and follow legal precedent which has interpreted its provisions.

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Reponses of Roberto A. Lange
Nominee to the U.S. District Court for the District of South Dakota
to the Written Questions of Senator Jeff Sessions

1. **President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."**

   a. **Do you agree with President Obama's quote?**

   Response: I am not in a position to agree or disagree with President Obama's quote. The criteria that President Obama applies to nominate federal judges are different than the criteria that I, if confirmed, would apply in deciding cases.

   b. **Do you believe that you fit President Obama's criteria for federal judges, as described in his quote?**

   Response: I am interested in becoming a federal district judge because I see it as a form of public service that befits me. My hope is that I and indeed all human beings, particularly those who are in public service positions, have the trait of empathy. I have never been a young teenage mom, African American, gay, disabled or old, but have not been immune from struggles in life and have worked very hard to achieve, with God's grace, what I have accomplished in life.

   c. **What role do you believe that empathy should play in a judge's consideration of a case?**

   Response: Generally, empathy should play no role in a judge's consideration of a case.

   d. **Do you think that it is every proper for judges to indulge their own subjective sense of empathy in determining what the law means? If so, under what circumstances?**

   Response: No.

2. **What in your view is the role of a judge?**

   Response: Typically, the role of a judge is to apply the law to the facts in a fair and impartial manner.

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a. Do you think that it is ever proper for judges to indulge their own values in determining what the law means? If so, under what circumstances?

Response: No.

b. Do you think it is ever proper for judges to indulge their own policy preferences in determining what the law means? If so under what circumstances?

Response: No.

3. How would you define "judicial activism?"

Response: When I hear someone refer to "judicial activism," I understand the term to mean a judge having exceeded his or her authority by conduct deemed legislating from the bench, failing to follow settled precedent, or elevating the judge's personal views or policy considerations above settled law. A judge of course is not to engage in such conduct, but is to apply the Constitution, statutes, and settled precedent in a fair and impartial manner to the facts and case presented.

a. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: I certainly do not view the Constitution as dead. However, I do not view the Constitution as "evolving as society interprets it." The Constitution remains the primary governing document of the United States and the supreme law of the land. As a district judge in the United States District Court for the District of South Dakota, if confirmed, my responsibility would be to follow the language of the Constitution as interpreted by the Supreme Court of the United States and Eighth Circuit cases.

4. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: Yes.

b. **How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision of your own best judgment of the merits?**

Response: If confirmed as a district judge, I would apply the settled precedent.

5. **Do you believe that a federal district court has the institutional expertise to set rules for and oversee the administration of the prisons, schools, or state agencies?**

Response: No, although in cases where such entities are subject to federal jurisdiction, a district court must apply the Constitution, congressional enactments and precedent.

United States Senate Committee on the Judiciary
Hearing on "Nominations"
Wednesday, September 9, 2009

Responses of Ignacia S. Moreno to Written Questions
Submitted by United States Senator Russell D. Feingold

(1) The Administration has called for legislation to overturn two recent U.S. Supreme Court decisions and restore the historic, broad protections for "waters of the United States" under the Clean Water Act. Do you agree that such legislation is needed?

I agree with the sentiments expressed in a recent letter from Administration officials that such legislation would "go a long way toward addressing the substantial confusion and uncertainty arising from . . . recent Supreme Court decisions." (Letter of May 20, 2009 from the Chair of the White House Council on Environmental Quality, the Administrator of the Environmental Protection Agency, the Secretary of the Department of the Interior, the Secretary of the Department of Agriculture, and the Acting Assistant Secretary of the Army (Civil Works) to Congressional leaders, articulating four core principles and stating: "Enactment of legislation amending the Clean Water Act – based on these principles – would go a long way toward addressing the substantial confusion and uncertainty arising from the recent Supreme Court decisions [*Rapanos v. United States*, 547 U.S. 715 (2006) and *Solid Waste Agency of Northern Cook County v. United States Army Corps of Engineers*, 531 U.S. 159 (2001)]).

(2) Do you think the goal of the Clean Water Act of 1972 can be achieved if the Act is allowed to be reduced in scope and waters protected prior to the SWANCC and Rapanos Supreme Court decisions are allowed to remain unprotected?

I believe that the authors of the May 20, 2009 letter referenced above speak to the goals of the Clean Water Act of 1972, and I agree with their statement that "[i]t is essential that the Clean Water Act provide broad protection of the Nation's waters, consistent with full Congressional authority under the Constitution. All of the environmental and economic benefits that these aquatic ecosystems provide are at risk if some elements are protected and others are not."

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Responses to Questions for the Record
Submitted by Senator Jeff Sessions
To Ignacia Soledad Moreno

1. **Your nomination has been criticized by some environmental groups because of your current position as Counsel for General Electric Company. Last month, the Vice Chairman of General Electric, John Rice, sent an email to colleagues stating in part:**

> **"The interseetion between GE's interests and government action is clearer than ever... On climate change, we were able to work closely with key authors of the Waxman-Markey climate and energy bill, recently passed by the House of Representatives. If this bill is enacted into law, it would benefit many General Electric businesses. We are continuing our efforts to make certain that a final bill includes provisions to ensure the United States maintains its leading position in renewable energy industry which is an industry sector of vital importance to the future of GE."**

Statements like this and others suggest that General Electric has a significant interest in seeing that legislation passes regarding climate change, and numerous other environmental issues. It also suggests that General Electric has a significant interest in a number of environmental litigation cases that the Environment and Natural Resources Division (ENRD) may be handling.

a. **What steps do you plan to take to ensure that no conflicts arise between your prior work for General Electric and any positions ENRD may take on behalf of the Department of Justice?**

If confirmed as Assistant Attorney General, I will abide by the terms of my May 12, 2009 agreement with the Office of Government Ethics (OGE), the requirements of the Ethics Pledge (Executive Order No. 13490), and my ethical obligations as an official of the Department of Justice and a member of the Virginia State Bar, District of Columbia Bar, and New York State Bar. I will consult with ethics officials at the Department of Justice regarding any conflicts issues arising from my prior work for General Electric, and I will take all necessary steps to comply with their guidance. I will not hesitate to recuse myself when ethical obligations require my recusal. I understand that a copy of my agreement with OGE has been provided to the Committee.

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b. Will you commit to recuse yourself from Division decisions related to litigation or legal advice for the Administration or client agencies on cases or issues that may affect the interests of General Electric, including issues related to climate change?

If I am confirmed, I will represent the United States as my client and will abide by all applicable ethics commitments and rules. I will consult with ethics officials at the Department of Justice regarding any conflicts issues, and I will take all necessary steps to comply with their guidance. I will not hesitate to recuse myself when ethical obligations require my recusal.

2. The Interior Department under the Bush Administration listed the polar bear as a threatened species. The Administration also adopted regulations to clarify that not all CO2 emissions would necessarily cause a reduction in polar sea ice and therefore affect the critical habitat of the polar bear. The Interior Department under the Obama Administration has reaffirmed the basic principle that CO2 emissions outside of the immediate action area affecting the polar sea ice do not have any causal effect on the polar bear. Do you believe that the Endangered Species Act is an appropriate vehicle to address global climate change through litigation?

I am aware that the Department of Justice is in litigation on the polar bear matter and that the Department is defending the Administration on the decisions made by the Department of the Interior. If I am confirmed, I will ask to be briefed immediately on this important matter. I will work with the Department of the Interior concerning the applicability of the Endangered Species Act to global climate change should the issue arise in future cases.

3. The EPA has traditionally viewed itself as the primary agency policy maker on climate change issues, even though many of the studies produced by the agency and positions taken by specific EPA officials lack an objective view of the issue. What roles do you believe each client agency will have in addressing global climate change and do you agree with EPA's assessment that it should be the primary agency responsible for addressing climate change?

I am not at the Department and have not been involved in any of the agency discussions on climate change, so I do not know the positions of the respective agencies. If I am confirmed, I will ask to be briefed immediately on this important matter and will work with all client agencies on their responses to legal challenges associated with global climate change issues.

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4. **In *Rapanos v. United States*, 547 U.S. 715 (2006), the Supreme Court significantly restricted federal jurisdiction over wetlands. In the wake of *Rapanos*, the Department of Justice, other federal agencies, and even the lower federal courts have struggled with how to interpret the extent of federal jurisdiction over wetlands. Even within the federal government, there may be conflicting views as to how far federal jurisdiction should extend over wetlands.**

   a. **Do you believe that the Division should attempt to extend federal jurisdiction over wetlands through litigation to protect as much wetlands as possible?**

   From my previous tenure in the Department of Justice, I am aware that one of the responsibilities of the Division is to file affirmative cases under Section 404 of the Clean Water Act against corporations or individuals who violate Section 404, which encompasses protection for wetlands. I consider that an important responsibility of the Environment and Natural Resources Division and, if I am confirmed, will ensure that positions taken by the Division on behalf of the United States are strictly in accordance with applicable law and regulations.

   b. **If confirmed, how would you reconcile potentially conflicting opinions within the Division, or amongst various client agencies, regarding the extent of federal jurisdiction over wetlands?**

   One of the important roles of the Assistant Attorney General for the Environment and Natural Resources Division is to reconcile the views of applicable federal agencies so that the United States speaks consistently when it files legal briefs. I have had a substantial amount of experience in gaining consensus in such situations, and am confident that I can do so again. When I served in the Division previously, my practice was to listen to all views before making a decision. If I am confirmed, I plan to continue that practice.

5. **In *Coeur Alaska, Inc. v. Southeast Alaska Conservation Council*, 129 S. Ct. 2458 (2009), the Ninth Circuit invalidated a gold mining company's permit to discharge slurry into a lake under the Clean Water Act. Although the Ninth Circuit ruled against the United States and the federal permittee sought review before the Supreme Court, the United States asked the Supreme Court not to grant *certiorari*. Over the United States' objection, the Supreme Court granted *certiorari* to review the Ninth Circuit's decision and reversed by a vote of 6-3. This is just one of a number of examples in the last few years where the Supreme Court has granted *certiorari* to review an environmental case over the United State's objection. If confirmed, you would be responsible for Division recommendations on whether to appeal adverse decisions from district courts or courts of appeals.**

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a. Do you believe that in making those appeal recommendations, the Division has a responsibility, particularly in close cases, to defend agency decisions, or that the Division should make an independent determination of what it believes the correct legal interpretation of a statute should be?

Although I have read the Supreme Court's decision in *Coeur Alaska, Inc. v. Southeast Alaska Conservation Council*, I was not involved in any of the events that led to that decision. Accordingly, I do not know what appeal recommendation the Environment and Natural Resources Division made regarding that case. I am aware from my prior experience at the Department of Justice that the Division does make recommendations to the Solicitor General on a variety of issues, including positions to be taken by the United States before the Supreme Court. The Supreme Court has well-established criteria defining what types of cases are suitable for its consideration, which include factors such as the existence of disagreement between the United States Courts of Appeals and the importance of the case to the United States. My understanding is that the United States seeks the Supreme Court's review fairly infrequently because the criteria for Supreme Court review are quite stringent.

If confirmed, in making appeal recommendations, I would give great weight to the recommendations of client agencies and the legal analysis of my staff in deciding whether the Division should recommend that the United States appeal or seek *certiorari* in a specific case. Certainly, it also would be my obligation to make an independent legal judgment as to whether the case was an appropriate one for Courts of Appeals or Supreme Court review. Ultimately, the Solicitor General makes the final decision on whether the United States will seek Supreme Court review and each case is decided on its own merit.

b. What role should a federal permittee's reliance on a government decision have in the Department of Justice's decision to seek further review?

The decision of whether to seek appellate or Supreme Court review turns on the recommendations of federal agencies and the application of law to the facts of each case. The fact that a federal permittee has relied on a government decision is relevant to that consideration and would be part of an analysis of the interests that counsel for or against seeking further review.

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6. Former Assistant Attorney General Schiffer has argued that the Bush Administration forced ENRD career lawyers to take "untenable" legal positions.

a. One example of a purported "untenable legal position" was the argument made in *Riverkeeper v. EPA*, 475 F.3d 83 (2d Cir. 2007), in which the Second Circuit, in an opinion authored by then-Judge Sonia Sotomayor, struck down aspects of EPA's "best technology available" for cooling water intake structures. The Supreme Court granted *certiorari* in that case and earlier this year reversed the Second Circuit in a 6-3 decision in *Entergy Corp. v. EPA*, 129 S. Ct. 1498 (2009). Do you believe that a legal argument that ultimately garners six votes from the Supreme Court, including a vote from Justice Breyer, should be considered "legally untenable" or that such a legal position caused "damage to the Division's reputation"?

Although I have read the Supreme Court's decision in *Entergy Corp. v. Riverkeeper, Inc.*, I was not involved in any way in that litigation and do not know the position of career lawyers in that case. The Supreme Court has decided the *Entergy Corp* case, and that decision is now binding precedent. As discussed in my response to Question 5.a., there is an established procedure for deciding the position of the United States before the United States Courts of Appeals and the Supreme Court. Whether a particular agency rule is legally defensible will depend on the specific facts of the case and the applicable law.

b. Another purported example of an "untenable" legal position that Division attorneys were forced to take was in *South Coast Air Quality Management District v. EPA*, 472 F.3d 882 (D.C. Cir. 2006), in which the D.C. Circuit partially vacated the 2004 rule at issue, but did not strike down the entire rule. Do you believe that an agency rule is legally indefensible when only a specific part of the rule may ultimately be vacated but the rest of the rule is left in place by the courts?

Although I have reviewed the District of Columbia Circuit's decision in *South Coast Air Quality Management District v. EPA*, I was not involved in any way in that litigation and do not know the position of career lawyers in that case. As discussed in my response to Question 5.a., there is an established procedure for deciding the position of the United States before the United States Courts of Appeals and the Supreme Court. Whether a particular agency rule is legally defensible will depend on the specific facts of the case and the applicable law. Although a court may partially vacate a rulemaking, the remainder of the rulemaking may remain valid and operable.

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c. As a general matter, do you believe that the ENRD took "untenable legal positions" under the Bush Administration that were rejected by courts more often than legal positions taken under prior administrations?

Although I have reviewed many court decisions in which the Environment and Natural Resources Division has represented the United States, I have not reviewed all such decisions nor am I aware of the bases for the positions taken by the Division during the Bush Administration. I do not know whether courts have more often rejected the legal positions taken by the Division on behalf of the United States during the Bush Administration as compared to prior administrations.

7. Former Assistant Attorney General Schiffer has suggested that the ENRD Appellate Section should not be "singled out for special political oversight" and that the new Assistant Attorney General for ENRD should "reinvigorat[e] the Appellate Section by returning the staffing to appropriate levels." The Deputy Assistant Attorney General overseeing the Appellate Section for the ENRD has for a number of years been a political appointee, similar to other litigating Divisions at the Department of Justice.

a. Do you agree that Appellate Section staffing should be reduced?

As I have not been in the Department of Justice for over eight years, I do not know the rationale for the current staffing of the Environment and Natural Resources Division's Appellate Section. If I am confirmed, I expect to evaluate the entire Division's workload, resources and budget. Based on this review, I will determine whether the Division's Appellate Section has the staffing needed to represent the interests of the United States.

b. Since the Clinton Administration, the ENRD has had 2 out of 4, or 50 percent, of its Deputy positions filled by career lawyers. By contrast, the Civil Division has just 1 out of 5 Deputy positions filled by career lawyers. Do you believe that ENRD should have a significantly higher percentage of career Deputy positions than any other litigating Division at the Department?

As I have not been in the Department of Justice for over eight years, I am not familiar with the rationale for the current staffing of Deputy positions at the Department of Justice. If I am confirmed, I expect to evaluate the Division's staffing as a whole. As a part of this process, I will give careful consideration to the matter that you raise in this question.

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June 12, 2009

The Honorable Patrick J. Leaby
Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Dear Chairman Leahy and Ranking Member Sessions:

The undersigned current and five past Chairs of the American Bar Association Section of Environment, Energy, and Resources congratulate our colleague and friend, Ignacia S. Moreno, on being nominated for the position of Assistant Attorney General, Environment and Natural Resources Division, U.S. Department of Justice. Ms. Moreno's deep understanding of environment and resources law and impeccable credentials make her a stellar choice to lead the Environment and Natural Resources Division. Ms. Moreno's appointment is good for the environment, as her personal and professional integrity and command of the law equip Ms. Moreno well to lead this critically important Division of the Department of Justice.

We are thrilled for Ms. Moreno, and enthusiastically support her confirmation as Assistant Attorney General.

Sincerely

Lauren J. Caster
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WASHINGTON LAWYERS' COMMITTEE
FOR CIVIL RIGHTS AND URBAN AFFAIRS

August 7, 2009

Senator Patrick Leahy
Chairman
Committee on the Judiciary
SD-224 Dirksen Senate Office Building
Washington, DC 20510-6275

Dear Senator Leahy:

I would like to submit this letter of endorsement in support of the nomination of Ignacia S. Moreno for Assistant Attorney General for the Department of Justice's Environment and Natural Resources Division. My knowledge of Ms. Moreno comes primarily from her excellent work on the Board of the Washington Lawyers' Committee for Civil Rights and Urban Affairs, an organization for which I serve as Executive Director. Ignacia joined the Lawyers' Committee Board in May 2003 while working as an attorney at the firm of Spriggs & Hollingsworth, and remained active in this position until assuming her new post at the General Electric Company in February 2008.

Throughout her Board service with the Committee, Ignacia distinguished herself as a particularly active and thoughtful participant in the Committee's work. Among other things, she was a leader in our organization's efforts to establish partnerships linking area law firm and corporate legal offices with DC public schools and as part of this work she helped to build an especially effective partnership between her firm and a local elementary school. Her advice on the recruitment of new law firms to participate in this program and in the Committee's outreach to new law firms for engagement on pro bono work was particularly notable and much appreciated.

From my conversations with many of Ignacia's former colleagues at Hogan & Hartson and Spriggs & Hollingsworth and with lawyers with whom she served during her prior government service, I am aware of her fine reputation as a practicing attorney. It is clear that she enjoys a truly excellent reputation in the Washington legal community. In light of her well-earned reputation for hard work, excellent judgment and an exceptional ability to work with other lawyers, I am fully confident that Ignacia will make an outstanding contribution in her new position. I am pleased to have this opportunity to recommend her without qualification.

Sincerely yours,

Roderic V.O. Boggs

Roderic V.O. Boggs
Executive Director

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Robert B. Cave
Of Counsel
[redacted]

June 23, 2009

The Honorable Patrick J. Leahy
Chairman
United States Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D. C. 20510

The Honorable Jeff Sessions
Ranking Member
United States Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D. C. 20510

Re: Ignacia S. Moreno

Dear Chairman Leahy and Ranking Member Sessions:

I am pleased to add my unqualified endorsement of Ignacia S. Moreno for Assistant Attorney General for the Department of Justice's Environment and Natural Resources Division. As a senior litigation partner at the law firm of Hogan & Hartson, I worked closely with Ignacia for several years on a number of matters for both plaintiffs and defendants. Ignacia was assigned to my team of approximately six lawyers, which gave me the opportunity to work with her on a daily basis. She was one of the brightest, most devoted, conscientious, and personable attorneys I have ever worked with.

I was also quite impressed by Ignacia's personal background and believe it underlies her aforementioned good qualities. She apparently came from a strong family, albeit of very modest circumstances, both of which, I believe, contributed to her sensitivity to all segments of society and her strong sense of public service. Ignacia demonstrated these qualities in her work on a court-appointed employment discrimination case in which we achieved a significant victory on behalf of the African-American plaintiff we represented.

For these and similar reasons, I strongly support Ignacia's nomination for Assistant Attorney General for the Environment and Natural Resources Division. I am sure she would be a credit to the Congress and the Administration if approved for that important position.

Sincerely yours,

RobBCave

Robert B. Cave



CENTER FOR INTERNATIONAL ENVIRONMENTAL LAW

June 12, 2009

The Honorable Patrick J. Leahy
Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Re: Letter of Support for Ignacia S. Moreno for Assistant Attorney General, Environment and Natural Resources Division

Dear Chairman Leahy and Ranking Member Sessions:

I am writing in my capacity as President for the Center for International Environmental Law (CIEL) to support Ms. Ignacia S. Moreno for the position of Assistant Attorney General for the Environment and Natural Resources Division (ENRD) in the U.S. Department of Justice. CIEL is a non-for-profit public interest law organization that seeks to use international law and institutions to protect the environment and human health, with offices in Washington, DC, and Geneva, Switzerland. I have known Ms. Moreno for almost two decades, starting when she was working for the ENRD at the Department of Justice when I was also in the United States government (Environmental Protection Agency and the White House), and continuing in her role as a member of the Board of Advisors of CIEL. I thus know her work and character well.

Ms. Moreno has a wide variety of pertinent experience to bring to this position. During her seven years in the ENRD at the U.S. Department of Justice, she worked on a myriad of domestic and international environmental issues. These issues involved all of the federal agencies with environmental responsibilities, and they required her to work with political and non-political staff at all levels. Throughout that work she demonstrated great knowledge, creativity, and tenacity, as well as the ability to listen to other points of view and to compromise in order to achieve practical results. Ms. Moreno

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has the valuable combination of being both a team player and being able to lead and take initiative when that is appropriate.

Ms. Moreno's experiences in private practice and in the industry also qualify her for this position, because they provide additional insights into the application of environmental laws and to industry responses to them. In all of this work, just as in her government work, she performed with absolute professionalism and complete integrity.

Finally, her experience on the CIEL Board of Advisors demonstrates Ms. Moreno's ability to work with, and her understanding of the perspectives of, environmental non-governmental organizations. The ability to work with civil society is essential to the ENRD position, and Ms. Moreno is an expert at this.

In sum, Ms. Moreno is highly qualified for the position of Assistant Attorney General for ENRD, and she has CIEL's full support. If you would like any further information, please do not hesitate to contact me.

Yours sincerely,

Daniel B. Magraw

Daniel Barstow Magraw
President

Cc: Ignacia S. Moreno (via e-mail)

62345.898

July 16, 2009

Via E-Mail and First Class Mail

Honorable Patrick J. Leahy, Chairman
Committee on the Judiciary
United States Senate
SD-224 Dirksen Senate Office Building
Washington, DC 20510-6275

Via Fax (202) 224-9102 and First Class Mail

Honorable Jeff Sessions, Ranking Minority Member
Committee on the Judiciary
United States Senate
SD-224 Dirksen Senate Office Building
Washington, DC 20510-6275

Re: Nomination of Ignacia S. Moreno as Assistant Attorney General for the Environment and Natural Resources Division, U.S. Department of Justice

Dear Chairman Leahy and Ranking Minority Member Sessions:

The undersigned, former Assistant Attorneys General for the Environment and Natural Resources Division at the United States Department of Justice, are writing in support of the nomination of Ignacia S. Moreno for the position of assistant Attorney General for the Environment and Natural Resources Division. Through our combined years of experience in leading and directing the Environment and Natural Resources Division, we fully understand the importance of the office to the protection of the environment and the public health and welfare of United States citizens.

Ms. Moreno served with distinction for seven years in the Environment and Natural Resources Division, has experience in private practice representing parties before the United States Department of Justice and various federal and state environmental agencies, has led the environmental compliance efforts of a major U.S. corporation, and has been a leader in the Hispanic Bar Association and the American Bar Association. We believe Ms. Moreno has the character, knowledge and abilities necessary to effectively lead the Environment and Natural Resources Division.

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For this reason, we support her nomination and believe that, if confirmed, she will capably serve the Division, the Department of Justice, and the public as Assistant Attorney General.

Sincerely,

James W. Moorman

Tom Sansonetti

August 7, 2009

The Honorable Patrick J. Leahy
Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510

The Honorable Jeff Sessions
Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510

Re: Ignacia S. Moreno

Dear Chairman Leahy and Ranking Member Sessions:

I write in my capacity as former President of the Environmental Law Institute (ELI), a position I held from 1980 until 2003. Since 1969, the Institute has played a pivotal role in shaping environmental law, policy, and management worldwide. Today, ELI serves people on the front lines of environmental decision making and dispute resolution by providing the best thinking on legal and policy solutions and experienced advice on implementation. Prior to my position at ELI I served as an officer and director of the Sierra Club, and served as President of the Club in 1977 and 1978.

It has come to my attention that Ms. Ignacia Moreno, current Counsel for the Northeast/Midwest Regions and International for the General Electric Company, has been nominated for the position of Assistant Attorney General for the Environment and Natural Resources Division. Ms. Moreno's experience and background make her an ideal candidate to serve in this role. I strongly endorse her confirmation.

During my tenure as President, ELI played a major role educating judges and enforcement officials in Latin America and throughout the world. Our judicial education program specifically has trained judges in Bolivia, Brazil, Chile, Colombia, Costa Rica, Ecuador, Honduras, and Peru, and this work continues under my successor, Leslie Carothers.

I have been well-acquainted with Ms. Moreno and her work, and recall specifically an in-depth meeting we held at the Institute shortly after she became a Partner at Spriggs & Hollingsworth in 2002 during which we discussed a wide range of concerns about environmental enforcement in Latin America.

Ms. Moreno's depth of knowledge and experience in enforcement are indeed impressive, and it is no wonder, because it was she who helped develop and negotiate cooperative enforcement initiatives under agreements in North and Latin America during her time as Principal Counsel to the Assistant Attorney General in the Clinton Administration. Ms. Moreno did government-to-government consultations involving

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multiple U.S. Government agencies with the Ministry of the Environment in Bogota, Colombia.

I am also acquainted with the strong and high visibility role she has played in the International Network for Environmental Compliance and Enforcement (INECE). Ms. Moreno co-chaired panels for INECE meetings in Mexico City and Chaing Mai, Thailand on a host of environmental enforcement issues, such as on environmental crimes, and also on important cooperative efforts such as on climate change/Montreal Protocol enforcement. I am also an active participant in INECE, which is the only global network of environmental compliance and enforcement practitioners, and is dedicated to raising awareness of compliance and enforcement; developing networks for enforcement cooperation; and strengthening capacity to implement and enforce environmental requirements.

Today's environmental challenges are greater than ever. Over the past 40 years world population has almost doubled to 6.7 billion. Resource consumption has skyrocketed both in the industrialized world and in the developing world. We now recognize that human activity is causing climate change that impacts natural systems and people worldwide. We are on the verge of taking the next big steps needed both domestically and globally to combat climate change.

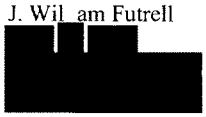
Given the increasing complexity and global interconnection of our environmental challenges, it is vital that U.S. environmental enforcement leaders have not only depth, breadth and knowledge of the law, but facility in engaging their colleagues and counterparts in international fora and in nations around the world, and Ms. Moreno has a strong and proven track record.

She has outstanding credentials, and has earned the high regard of her colleagues in the American Bar Association Section of Environment, Energy and Natural Resources and elsewhere. I strongly support her confirmation for this important position.

Please contact me if you have any questions.

Sincerely,

J. Wil am Futrell



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June 23, 2009

The Honorable Patrick J. Leahy
Chairman
United States Senate
Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
United States Senate
Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Re: Ignacia Moreno

Dear Chairman Leahy and Ranking Member Sessions:

I am pleased to support Ignacia Moreno's nomination as Assistant Attorney General of the Environmental and Natural Resources Division of the Department of Justice. As a fellow environmental lawyer, I have known Ms. Moreno for almost 15 years. I have always had the utmost respect for Ms. Moreno's intelligence, personal integrity, and commitment to our nation's environmental laws. Ms. Moreno has broad experience addressing environmental issues in a number of capacities, as a high-level deputy within the Environmental and Natural Resources Division, as a lawyer in private practice, and also as an in-house lawyer. This broad experience will enable her to enforce the nation's environmental laws firmly and fairly, with a deep understanding of the underlying technical, societal, and human issues that frequently are at stake in environmental matters. Above all, Ms. Moreno has the wisdom and judgment to make good decisions after searching inquiry. She would be an excellent steward of our environment and of the rule of law. I recommend her without hesitation.

Very truly yours,

Jeffrey B. Gracer

Steven A. Herman
1350 I Street, N.W.
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Washington, D.C. 20005-3311
Direct: [redacted]
Fax: [redacted]
[redacted]n

July 21, 2009

The Honorable Patrick Leahy
Chairman
United States Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
United States Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Re: **Ignacia S. Moreno**

Dear Chairman Leahy and Ranking Member Sessions:

I am writing to support the nomination of Ignacia S. Moreno as Assistant Attorney General for the Environment and Natural Resources Division at the United States Department of Justice.

I first met Ms. Moreno in 1994 when I was Assistant Administrator for Enforcement and Compliance Assurance at the Environmental Protection Agency, a position I served in for eight years. Ms. Moreno was the Special Assistant and then Principle Counsel to the Assistant Attorney General of the Environment and Natural Resources Division, my primary contact at the Department of Justice. During this time I attended numerous meetings at which Ms Moreno participated. Members of my staff worked closely with her on specific projects. I was always impressed by her intelligenee, careful preparation, judgment, integrity and good humor. She knew how to stay focused and keep her eye on the problem that we were trying to solve. She also knew how to listen and work constructively with others, regardless of whether or not they agreed with her on a particular matter. She showed that she could be a leader and a good team player at the same time.

Ms. Moreno's varied experience at the Department of Justice and, subsequently, in the private sector, gives her a unique and valuable perspective on the very complex legal, natural resources, and environmental issues that will come before her. I have no doubt that Ms. Moreno is well qualified for the position of Assistant Attorney General and will do an excellent job if she is confirmed by the Senate.

Sincerely yours,

Steven A. Herman

62345.904



RAMONA E. ROMERO
NATIONAL PRESIDENT

July 1, 2009

VIA FACSIMILE AND FIRST CLASS MAIL

Senator Patrick Leahy
Chairman
U.S. Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510-6275

Senator Jeff Sessions
Ranking Member
U.S. Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510-6275

Re: *HNBA Endorsement of Ignacia S. Moreno for Assistant Attorney General, Environment and Natural Resources Division, Department of Justice*

Dear Senator Leahy and Senator Sessions:

On behalf of the Hispanic National Bar Association ("HNBA"), we urge the immediate confirmation of Ignacia S. Moreno as the Assistant Attorney General for the Environment and Natural Resources Division of the Department of Justice ("Division"). Ms. Moreno possesses the character, intellectual ability, leadership and managerial skills, and substantive expertise to lead the Division with great distinction.

The HNBA is a non-profit, non-partisan organization that represents the interests of the more than 100,000 Hispanic attorneys, judges, law professors, law students and paralegals in the United States and Puerto Rico. As required by its *Policies and Procedures Governing Executive Endorsements* (2008), the HNBA has conducted appropriate due diligence and carefully reviewed Ms. Moreno's background and qualifications in the context of the requirements of the position of Assistant Attorney General for the Division. In Ms. Moreno's case, we have had the additional benefit of seeing her work first-hand in her role as the HNBA's General Counsel and member of the Executive Committee. It is the HNBA's considered opinion that Ms. Moreno is extremely well-qualified and well-suited to serve as Assistant Attorney General.

During the past eighteen years, Ms. Moreno has become a leading practitioner in the field of environmental and natural resources law. Most notably, she served with distinction in the Division during the Clinton Administration from 1994 to 2001. During her tenure there, she participated in the management of the Division, led significant domestic and international

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62345.905

environmental enforcement initiatives, expanded and managed the Division's international program, handled litigation, and provided advice and counsel to the Assistant Attorney General on a wide variety of matters. Her prior experience with the Division will allow her to be an informed and integral part of the Department of Justice from day one.

Ms. Moreno's private sector experience is also noteworthy. She practiced at the law firm of Hogan & Hartson LLP in Washington, DC as an associate from 1990 to 1994, where she distinguished herself in the firm's environmental, litigation and community service practice groups. From 2001 to 2006, she was Of Counsel and then a Partner with the law firm of Spriggs & Hollingsworth where she specialized in environmental and mass tort litigation with an emphasis on science-based defenses. In 2006, she was recruited by the General Electric Company where she currently serves as Counsel, Northeast/Midwest Regions and International and manages a large caseload of environmental remediation and litigation matters.

Ms. Moreno has been deeply dedicated to community service for many years. She currently serves *pro bono* as General Counsel to the HNBA, where she is well-regarded for her legal expertise, sound judgment and integrity. She is a past President of the Hispanic Bar Association of the District of Columbia (HBA-DC) and has held leadership positions with the American Bar Association, the District of Columbia Bar, the Washington Lawyers' Committee for Civil Rights and Urban Affairs, and the Center for International Environmental Law. She also has done significant *pro bono* work in the areas of environmental protection, education and mentoring. Because we have interacted with Ms. Moreno extensively both during her years as a leader of the HBA-DC and during her service to the HNBA, we know from first-hand experience that she brings to her *pro bono* endeavors an extraordinary commitment to excellence, integrity, dedication and professionalism.

Ms. Moreno's professional qualifications, integrity, leadership skills and dedication to public service render her extraordinarily well-qualified to serve as Assistant Attorney General for the Division. We stand ready to assist in your deliberations should there be any questions. Please feel free to contact Ms. Romero at (302) 992-4213 or Ms. Castillo at (202) 271-7011.

Sincerely,

Ramona Romero

Ramona E. Romero
National President

Alejandra J. Castillo

Alejandra Castillo
Co-Chair, Executive Endorsements Committee

cc: Mr. Eric H. Holder, Jr., United States Attorney General
Mr. Gregory Craig, White House Counsel
Ms. Cassandra Butts, Deputy White House Counsel
Ignacia S. Moreno, Esq.
Mr. Román D. Hernández, HNBA President-Elect
Ms. M. Lucero Ortiz, Director of Programs and Policy

BINGHAM

William D. Kissinger
Direct Phone: [redacted]
Direct Fax: [redacted]

July 16, 2009

By Fax and Electronic Mail

The Honorable Senator Jeff Sessions
Ranking Member, United States Senate Judiciary Committee
224 Senate Dirksen Building
Washington, DC 20510

Dear Senator Sessions:

I am writing this letter on behalf of Ms. Ignacia Moreno who has been nominated by President Obama to serve as Assistant Attorney General for the Justice Department's Environment and Natural Resources Division.

I had the pleasure of serving with Ms. Moreno during the Clinton administration. At the time, I was Senior Advisor for International Economic Policy at the National Economic Council at the White House. Ms. Moreno was serving as Counsel to Lois Schiffer, who then held the position for which Ms. Moreno has been nominated. Based on my interactions with Ms. Moreno, I cannot think of a better choice than Ms. Moreno to fill this position. She is diligent, intelligent, serious-minded and will be a great addition to an already strong team at the Justice Department. You or your staff should feel free to contact me with any questions about her qualifications. I would be extremely pleased if she were confirmed.

Sincerely yours,

William D. Kissinger

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United States Senate
Committee on the Judiciary

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Statement of

The Honorable Patrick Leahy

United States Senator
Vermont
September 9, 2009

Statement Of Senator Patrick Leahy (D-Vt.),
Chairman, Senate Judiciary Committee,
Hearing On Judicial And Executive Nominations
September 9, 2009

Today, the Judiciary Committee holds only the third confirmation hearing for nominations to the lower Federal courts since Justice Souter's May announcement that he intended to retire at the conclusion of the Court's term. We will hear today from four nominees for lifetime appointments to the Federal bench and thereby double the number of judicial nominees who have had hearings since April. The President is doing better and has begun sending more nominations to the Senate. This Committee needs to do better in considering the nominees. And the Senate has to do much better: Other than Supreme Court Justice Sotomayor, not a single judicial nominee has been considered by the Senate all year.

I thank Senator Whitehouse for chairing this hearing, and Senators Menendez, Lautenberg, Johnson, Nelson and Rockefeller for introducing the nominees. I also thank the Committee's Ranking Member, Senator Sessions, for his cooperation in preparing for this hearing. We will need to continue to work together to break the backlog of nominations that are pending before this Committee and the logjam of nominations that have been reported out of this Committee but have been stalled without Senate approval.
We did make some progress before the August recess after nearly three months of inaction. Before adjourning, the Senate confirmed 10 nominations reported by the Committee, many of which had been pending on the Senate's executive calendar since before the July Fourth recess. In fact, those nominations were the first to be confirmed since May 12 from among more than a score of nominees reported by the Senate Judiciary Committee. Even so, Senate Republicans would not consent to consider another 10 nominations, which remain on the Senate Executive Calendar. They include three judicial nominees, four nominees to head important divisions at the Justice Department, additional United States Attorneys, and the Chairman of the Sentencing Commission.
We must do better. As I have noted, with respect to judicial nominations, the Senate has not confirmed a single one of President Obama's 16 nominations for lifetime appointments to lower Federal courts -- even though the first of those nominations, that of Judge David Hamilton to the Seventh Circuit, was made in March, reported out of Committee in early June, and has the support of the Senate's senior Republican. Two other judicial nominations have been pending on the Senate's Executive Calendar since early June, despite strong bipartisan support. Judge Andre Davis's nomination to the Fourth Circuit was reported by the Committee on June 4 by a vote of 16-3, and Judge Gerard Lynch's nomination to the Second Circuit was reported by the Committee on June 11 by voice vote. We should not further delay Senate consideration of these three well-respected, mainstream Federal judges.
Today we will hear from four more outstanding nominees for lifetime appointments to the Federal bench: Joseph A. Greenaway for the Third Circuit, Roberto A. Lange for the District of South Dakota, Irene Cornelia Berger for the Southern District of West Virginia, and Charlene Edwards Honeywell for the Middle District of Florida. All four nominees have been rated unanimously well qualified by the ABA's Standing Committee on the Federal Judiciary, the highest rating they could receive. All four should receive prompt consideration from the Committee and the full Senate.

Judge Joseph A. Greenaway has served for 13 years as a Federal judge for the District of New Jersey. A former Federal prosecutor, he also has worked as in-house counsel at a large corporation and as an attorney in private practice. These varied experiences should serve Judge Greenaway well once he is elevated to the Third Circuit.

The three district court nominees we will hear from today also have deep and varied experience. Roberto A.

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Lange has spent most of his career at a South Dakota law firm, where he is now a partner. As the head of the firm's litigation section, he specializes in complex commercial litigation. Over the years, he has worked with a wide variety of clients – from individuals to large corporations to a Native American tribe. Charlene Edwards Honeywell has served for the last eight years as a circuit judge in Tampa. Before that, she gained expertise in a wide variety of areas as a litigation attorney, a city attorney, and an assistant public defender. For the last 15 years, Irene Berger has served as a circuit judge in county court. Before that, she spent more than a decade as a prosecutor at both the State and Federal levels. If confirmed, Judge Berger will be the first African American on the Federal bench in West Virginia.

It is imperative that we move to fill the growing number of vacancies throughout the Federal courts. These vacancies have already risen to over 90, including 21 on the circuit courts. This alarming spike is only further fueled by the delays and inaction. In addition, 23 future vacancies have been announced. They will push Federal judicial vacancies close to 120 unless we begin to act on judicial nominations.

We worked very hard to fill vacancies during the last presidency. When I chaired this Committee and we had a President of the other party in the White House, we were able to reduce overall vacancies by two-thirds, from over 100 down to 34, and to reduce circuit court vacancies to single digits. Today, those vacancies have nearly tripled.

In the 17 months I served as Chairman during President Bush's first term with a Democratic majority, the Senate confirmed 100 of the President's judicial nominations. Indeed, despite the fact that President Bush did not make his first judicial nomination until May 9, nearly two months later than President Obama's first nomination, and despite the subsequent changeover in the majority in the Senate, we had confirmed four judicial nominations to lower courts before the August recess in 2001, including two circuit court nominations. Thus far this year, we have confirmed none.

I hope that Republican Senators do not seek to return to the practices of the 1990's, when they more than doubled circuit court vacancies through pocket filibusters of moderate and qualified Clinton nominees. The crisis they created by refusing to consider many circuit nominees led to public criticism of their actions by Chief Justice Rehnquist during those years.

I hope, instead, that both sides of the aisle will join together to treat the nominees of President Obama fairly. I made sure that we treated President Bush's nominees more fairly than President Clinton's nominees had been treated. We should continue that progress rather than ratcheting down our productivity and increasing the partisanship attendant judicial nominations.

In addition to the nominations of Judge Hamilton, Judge Davis, and Judge Lynch, seven nominations to important Executive Branch positions reported by this Committee remain pending on the Executive Calendar. All of these nominees -- Dawn Johnsen to be the Assistant Attorney General for the Office of Legal Counsel, Judge William K. Sessions to chair the U.S. Sentencing Commission, Tom Perez to be the Assistant Attorney General for the Civil Rights Division, Mary Smith to be the Assistant Attorney General for the Tax Division, Christopher Schroeder to be the Assistant Attorney General for the Office of Legal Policy, Steven M. Dettelbach to be the U.S. Attorney for the Northern District of Ohio, and Carter Mitchell Stewart to be the U.S. Attorney for the Southern District of Ohio – are well qualified and deserve prompt consideration by the full Senate.

The President needs nominees in place to run key divisions of the Department of Justice. Today we will hear from another of those nominees, Ignacia Moreno, whose nomination to head the Justice Department's Environment and Natural Resources Division comes with widespread support.

Ms. Moreno currently works for General Electric, where she oversees that corporation's compliance with state and Federal laws. Prior to that, she spent seven years in the Environment and Natural Resources Division, where she ultimately served as a Principal Counsel. I am confident that Ms. Moreno's significant experience will be put to good use if she is confirmed to return to the Justice Department.

I look forward to hearing from the nominees today and welcome them and their families to the Judiciary Committee.

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STATEMENT OF
IGNACIA S. MORENO
NOMINEE FOR ASSISTANT ATTORNEY GENERAL
FOR THE ENVIRONMENT AND NATURAL RESOURCES DIVISION
OF THE UNITED STATES DEPARTMENT OF JUSTICE

BEFORE THE
COMMITTEE ON THE JUDICIARY
UNITED STATES SENATE

PRESENTED
SEPTEMBER 9, 2009

Good afternoon. Thank you very much Chairman Leahy, Ranking Member Sessions and members of the Judiciary Committee for allowing me the opportunity to present my testimony today. I also wish to thank Senator Whitehouse for chairing this hearing.

I am deeply honored that President Obama has nominated me for the important post of Assistant Attorney General for the Environment and Natural Resources Division at the United States Department of Justice. I am grateful to the President and Attorney General Holder for their confidence in me. If I am confirmed, I will do my very best to demonstrate that I am worthy of their trust and yours.

Thank you for the opportunity to introduce my family. With us today are my mother Zenith Moreno, sisters Patricia Moreno and Veronica Acosta, brother Carlos Moreno, and niece and nephew Francesca and Alexander Moreno. My father Carlos Moreno was unable to travel here today, but is with us in spirit. It also gives me great pleasure to introduce my husband and son, Robert and Nicholas Begotka. Today is Nicholas's first day of fourth grade, but instead we thought he would experience an important civics lesson on the advice and consent role of the Senate. My family is my rock. I would not be here today, but for their unfailing encouragement and support. I especially wish to thank my mother for her many and sustained sacrifices. She is my hero. Finally, I wish to acknowledge and thank my friends, mentors, colleagues and supporters, some of whom have joined us today.

Mr. Chairman, I am committed to the Division's core mission: strong enforcement of the federal civil and criminal environmental laws to ensure clean air, water and land for all Americans; vigorous defense of environmental laws and agency actions and protection of the public fisc; effective stewardship of our public lands and natural resources; and mindful management of the United States' trust obligations to Native Americans.

During my tenure in the Division, I saw first-hand the importance of the Division's work to the American people. I traveled extensively in Texas, New Mexico and California and

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witnessed the devastation of pollution in the New River and the Rio Grande River. I met with residents in some of our most impoverished communities, who lacked basic necessities such as a safe source of drinking water for themselves and their children. To address this significant and unacceptable threat to human health, I assembled and coordinated a team from the Department of Justice, United States Attorney offices in Texas and New Mexico, State Attorney General offices in Texas and New Mexico, the Environmental Protection Agency, and other key federal agencies. I was gratified when our efforts led to tangible results—a source of safe drinking water for a Colonias community in Texas, which along with other commitments were memorialized in a precedent-setting consent decree upon which the Division relied in addressing subsequent Safe Drinking Water Act matters.

I was honored to serve the Division for seven years as Special Assistant, Counsel, and then Principal Counsel to the Assistant Attorney General, and was honored when my work was recognized with special commendations from the Division and two Bronze Medals from EPA for outstanding service, including in connection with efforts to identify and mitigate pollution sources into the New River.

In addition to my government service, I have significant private sector experience with the law firms of Hogan & Hartson and Spriggs & Hollingsworth, as well as in my current position as a counsel in Corporate Environmental Programs at General Electric. My private sector experience has added to the knowledge, insight and skills that I would bring to the job of enforcing environmental laws and defending challenges to government programs and actions.

During my time in the private sector, I remained committed to protecting the environment and serving the public in a *pro bono* capacity. For example, I successfully represented several environmental organizations *pro bono* in advocating for a 90% reduction in sulfur dioxide emissions from an uncontrolled coal-fired power plant that were impairing visibility at the Grand Canyon. Our team's work will help preserve the Grand Canyon's magnificent vistas for years to come. I have held several leadership posts with the American Bar Association's Section on Environment, Energy and Resources and have been a long-time member of the Board of Advisors for the Center for International Environmental Law. I also have served as General Counsel for the Hispanic National Bar Association, President of the Hispanic Bar Association of the District of Columbia, on committees of the District of Columbia Bar, and on the Board of Directors of the Washington Lawyers' Committee for Civil Rights and Urban Affairs. My other public service includes advocacy on issues affecting the Hispanic community and work with disadvantaged public school children in the District of Columbia and upstate New York.

As an immigrant to the United States from Colombia, I have been grateful for the opportunities that this country has offered me. Due to my parents' inspiration and hard work, we have accomplished much beyond our greatest expectations. For this reason, I have always asked: "What can I give back for all that I have received?"

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This is why public service is so meaningful to me. If I should be so fortunate as to be confirmed, I would cherish the opportunity to work again with the Division's talented and dedicated professionals to realize the Division's important mission. For me, it would be like going back home.

Thank you for the opportunity to appear before you today.

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NCLR
NATIONAL COUNCIL OF LA RAZA

Headquarters
Raul Yzaguirre Building
1126 16th Street, NW
Washington, DC 20036

TEL 202.785.1670
FAX 202.776.1792
www.nclr.org

September 4, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

Dear Chairman Leahy:

On behalf of the National Council of La Raza (NCLR), the largest national Hispanic civil rights and advocacy organization in the United States, I write in strong support for the confirmation of Ignacia Moreno to be the next Assistant Attorney General of the Environment and Natural Resources Division at the U.S. Department of Justice.

While NCLR has not historically worked on environmental policy issues, we do know that Latinos are often disproportionately affected by pollution. For example, recent studies by University of Southern California Professor Manuel Pastor show that Latinos and Blacks nationwide are more likely to live in areas with higher exposure to air pollution from industrial and automobile sources. In addition, there are well-known examples of water pollution in the border communities of Texas where many Latinos reside. Accordingly, the Latino community has a large stake in how our national environmental laws are enforced.

NCLR supports the nomination of Ms. Moreno for many reasons. First, she is eminently qualified for the role as demonstrated by the strength of her track record as a leading environmental and natural resources lawyer. Ms. Moreno began her career almost 20 years ago as an attorney at Hogan & Hartson, specializing in environmental litigation with a focus on regulatory compliance matters on many key environmental laws. She was then appointed by President Clinton to the position of Counsel and Principal Counsel to the Assistant Attorney General in the Environment and Natural Resources Division. During her eight years on the management team of the Division, Ms. Moreno was responsible for environmental enforcement policy initiatives, including regional agreements in North and Latin America. Her outstanding work at the Division was recognized by special commendations from the Division and bronze medals from the Environmental Protection Agency for outstanding service. Ms. Moreno then returned to private practice and now serves as Counsel, Corporate Environmental Programs, at the General Electric Company. This breadth of experience in both business and government gives her a broader lens for developing effective strategies to protect the environment.

Second, Ms. Moreno has an excellent record of advocacy at the Department of Justice for strong governmental and citizen processes to protect the environment, with particular concern for the effects of environmental pollution on poor communities. In particular, NCLR is deeply impressed with Ms. Moreno's work to address pollution in the Colonia communities along the

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U.S.-Mexican border in Texas, including leading efforts to improve access to safe drinking water. In addition, Ms. Moreno was instrumental in devising the Department of Justice strategy for implementing President Clinton's executive order on environmental justice. We know that Ms. Moreno will continue to be an advocate for strong enforcement of our environmental protection laws wherever they apply.

Third, we note that Ms. Moreno has taken on many leadership and volunteer commitments that contribute to the Hispanic community. For example, she is the General Counsel of the Hispanic National Bar Association, as well as former president of her local chapter. She has also worked on important pro bono activities supporting language assistance in the Voting Rights Act with leading civil rights groups such as the Mexican American Legal Defense and Educational Fund. In addition, Ms. Moreno has donated her time to representing migrant workers in her pro bono legal practice.

In short, we believe that Ignacia Moreno's legal work, leadership experience, and commitment to protecting the environment make her extremely qualified to assume the top leadership role in the Environment and Natural Resources Division at the Department of Justice. Her leadership will be a great asset to the Department of Justice as well as to the advancement of environmental protections for our nation. We hope you will give Ms. Moreno every consideration for this critical post.

Sincerely,



Janet Murguía
President and CEO



August 18, 2009

FACSIMILE AND FIRST CLASS MAIL

Senator Patrick Leahy
Chairman
U.S Senate Judiciary Committee
SD-Dirksen Senate Office Building
Washington, DC 20510 -6275

Senator Jeff Sessions
Ranking Member
U.S Senate Judiciary Committee
SD-Dirksen Senate Office Building
Washington, DC 20510 -6275

Re: *Endorsement of Ignacia S. Moreno for Assistant Attorney General, Environment and Natural Resources Division*

Dear Senator Leahy and Senator Sessions:

On behalf of the National Hispanic Leadership Agenda (NHLA), I write to express our strong support for the confirmation of Ignacia S. Moreno as the Assistant Attorney General for the Environment and Natural Resources Division of the Department of Justice (Division). NHLA is a non-partisan non-profit coalition composed of 29 of the leading national and regional Hispanic civil rights and public policy organizations, elected officials and other prominent Hispanic Americans. NHLA coalition members represent the diversity of the Latino community – Mexican Americans, Puerto Ricans, Cubans, Dominicans and other Hispanic Americans.

The depth and breadth of Ms. Moreno's experience, acquired during more than eighteen years as an environmental lawyer in government and in private and corporate practice, render her extraordinarily well-qualified to serve as the Assistant Attorney General for the Division. She is a leading practitioner in the field of environmental and natural resources law. Significantly, she served with distinction as Special Assistant (1994-1995) and then Principal Counsel to the Assistant Attorney General for the Division during the Clinton Administration (1996-2001). In those roles, she participated in the management of the Division, led significant domestic and international environmental enforcement initiatives, expanded and managed the Division's international program, handled litigation, and provided advice and counsel to the Assistant Attorney General on a wide variety of matters. Her prior experience with the Division will allow her to be an informed and integral part of the Department of Justice from the outset of her tenure.

Ms. Moreno's private sector experience is also noteworthy. She practiced at the law firm of Hogan & Hartson LLP in Washington, DC as an associate from 1990 to 1994, where she distinguished herself in the firm's environmental, litigation and community service practice groups. From 2001 to 2006, she was Of Counsel and then a Partner with the law firm of Spriggs &

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Hollingsworth where she specialized in environmental and tort litigation with an emphasis on science-based approaches. In 2006, she was recruited by the General Electric Company, where she currently serves as Counsel, Northeast/Midwest Regions and International and manages environmental remediation and litigation matters.

Ms. Moreno has demonstrated a strong commitment to community service. Currently, she serves *pro bono* as General Counsel to the Hispanic National Bar Association (a member of the NHLA). At the HNBA, she is well-regarded for her legal expertise, sound judgment and integrity. She is a past President of the Hispanic Bar Association of the District of Columbia, and has held leadership positions with the American Bar Association, the District of Columbia Bar, the Washington Lawyers' Committee for Civil Rights and Urban Affairs, and the Center for International Environmental Law. She also has done significant *pro bono* work in the areas of environmental protection, education and mentoring.

Ms. Moreno has earned the support of a broad range of stakeholders in the environmental and Hispanic communities, as well as the American Bar Association Section on Environment, Energy and Resources, and former environmental enforcement officials. Ms. Moreno's professional qualifications, expertise, integrity, intelligence, commitment to the environment, and dedication to public service make her an outstanding candidate for the position of Assistant Attorney General for the Environment and Natural Resources Division. We urge her immediate confirmation.

Sincerely,

Lillian Rodriguez-Lopez
Chair, NHLA

On behalf of the following:

Cuban American National Council
Hispanic Federation
Hispanic National Bar Association
Labor Council for Latin American Advancement
League of United Latin American Citizens
MANA, A National Latina Organization
National Association of Hispanic Federal Executives
National Association of Hispanic Publications
National Conference of Puerto Rican Woman
National Council of La Raza
National Hispana Leadership Institute
National Hispanic Caucus of State Legislators
National Hispanic Environmental Council
National Hispanic Medical Association
National Puerto Rican Coalition
Self-Reliance Foundation
SER-Jobs for Progress
Southwest Voter Registration and Education Project

National
Native American
Bar Association

August 24, 2009

Senator Patrick J. Leahy
Chairman, Senate Judiciary Committee
224 Dirksen Senate Office Building
Washington, DC 20510

Senator Jeff Sessions
Ranking Member, Senate Judiciary Committee
224 Dirksen Senate Office Building
Washington, DC 20510

Re: Ignacia Moreno - Assistant Attorney General for the Environmental and Natural Resources Division of the U.S. Department of Justice.

Dear Chairman Leahy and Ranking Member Sessions:

We are writing to express the National Native American Bar Association's support for the confirmation of Ignacia Moreno as Assistant Attorney General for the Environmental and Natural Resources Division of the U.S. Department of Justice.

Ms. Moreno is an outstanding attorney, and we are delighted with her nomination.

The National Native American Bar Association (NNABA) serves as the national association for Native American attorneys, judges, law professors and law students, and attorneys who practice Indian law. NNABA strives to be a leader on social, cultural, political and legal issues affecting Native Americans (American Indians, Alaska Natives, and Native Hawaiians.)

A number of Native related issues fall under the jurisdiction on DOJ-ENRD. In fact, there is an entire division in ENRD dedicated to Indian issues; many of the cases affect our most sacred places. As such, the AAG of the ENRD, and their appointees, are very important positions to Native community.

NNABA appreciates that Ms. Moreno already has some experience at ENRD working on Indian issues. We also appreciate the outreach Ms. Moreno has made to NNABA and the Native community. We believe Ms. Moreno will take time to reach out to and consult with Tribes and Native communities as issues of importance arise within ENRD.

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The Honorable Patrick J. Leahy
The Honorable Jeff Sessions
August 24, 2009

As such, the National Native American Bar Association strongly supports the nomination of Ignacia Moreno to be the Assistant Attorney General for the Environmental and Natural Resources Division of the U.S. Department of Justice, and respectfully urges her swift confirmation.

Very truly yours,

Heather Dawn Thompson, President
National Native American Bar Association
Cheyenne River Sioux

July 28, 2009
VIA FAX and First Class Mail

The Honorable Patrick J. Leahy, Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510

The Honorable Jeff Sessions, Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510

Re: Endorsement of Ignacia S. Moreno for Assistant Attorney General, Environment and Natural Resources Division

Dear Chairman Leahy and Ranking Member Sessions:

I am writing in my capacity as Chairman of the Board of the National Conservation System Foundation and as Founding President and Trustee Emeritus of the Grand Canyon Trust to recommend the appointment of Ms. Ignacia S. Moreno to the position of Assistant Attorney General for the Environment and Natural Resources Division of the United States Department of Justice.

The National Conservation System Foundation's mission is to protect, restore, and expand the Bureau of Land Management's National Landscape Conservation System through education, advocacy, and partnerships.

The Grand Canyon Trust is a regional non-profit conservation organization, working to protect and restore the Colorado Plateau. The Trust advocates collaborative, common sense solutions to the significant problems affecting the Colorado Plateau's natural resources. Our work is focused in the greater Grand Canyon region of northern Arizona, and in the forests and red rock country of central and southern Utah.

I am also writing this endorsement of Ms. Moreno from my perspective as a former Assistant United States Attorney with extensive experience in working with the Environment and Natural Resources Division.

I have known Ignacia Moreno for almost 20 years. I first worked closely with her when her law firm, Hogan & Hartson, represented the Grand Canyon Trust in negotiations with the U.S. Environmental Protection Agency, the Bureau of Reclamation, the State of Arizona, and the five public and private owners of the Navajo Generating Station in Page, Arizona. Those negotiations resulted in an agreement, signed at the Grand Canyon by President George H.W. Bush and all the parties, requiring the owners of the Navajo Generating Station to reduce air pollution in the Grand Canyon region by installing scrubbers to reduce SO2 emissions by 90%.

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Endorsement of Ms. Ignacia S. Moreno

July 28, 2009

Page Two

Ms. Moreno played a central role in these negotiations, and she made a significant contribution to the successful outcome. She is a superb lawyer, always completely prepared with full command of the law and the facts. Even more important, she demonstrated an ability to work effectively with all of the parties to these complex negotiations. She was a strategic thinker, she anticipated problems, she had the peripheral vision to help find solutions, and she was tough, tenacious, and gracious. All of us involved in the negotiations developed great confidence in her.

I know from discussions with Ms. Moreno and from following her subsequent career in the Environmental and Natural Resources Division at the Department of Justice that she is deeply committed to public service. From my own experience as a lawyer in private practice, an Assistant United States Attorney, and a representative of environmental organizations, I know the importance of the position of Assistant Attorney General, Environment and Natural Resources Division and how vital it is that the United States and our environment and natural resources have an advocate with depth and breadth of knowledge, skills, and the capacity to manage complex issues and lead the Division. I have every confidence that Ms. Moreno will serve with great distinction, and I recommend her with high enthusiasm.

If you have any further questions, please contact me.

Edward M. Norton

Edward M. Norton,
Chairman, National Conservation System Foundation Founding President
Trustee Emeritus, Grand Canyon Trust

[redacted]

New York University
A private university in the public service

School of Law

40 Washington Square South, Room 406
New York, New York 10012-1099
Telephone: [redacted]
Fax:
Email: [redacted]

Richard L. Revesz
Dean and Lawrence King Professor of Law

August 31, 2009

The Honorable Senator Patrick J. Leahy
Chairman, Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Senator Jeff Sessions
Ranking Member, Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Dear Chairman Leahy and Ranking Member Sessions:

I am writing to express my enthusiastic support for the nomination of Ignacia Moreno to the position of Assistant Attorney General for the Environment and Natural Resources Division in the Department of Justice. Ms. Moreno is a highly accomplished attorney, and I am absolutely confident that she would perform a great service to our nation in this role.

I am the Dean and Lawrence King Professor of Law at New York University School of Law, where I have taught environmental and administrative law for 24 years. I am also the faculty co-director of the NYU Frank Guarini Center on Environmental and Land Use Law. Ignacia was a student of mine during law school, first in my Environmental Law class and again in my seminar on the Regulations of Toxic Hazards. I remember her as a bright, highly motivated and intellectually engaged student. She assembled a strong record during her time at the Law School, and has since built an extraordinarily successful career that has spanned positions in industry, government, private practice, and public service.

Ignacia started her career in environmental and litigation practice at Hogan & Hartson where she not only represented private and industry clients, but worked with environmental groups to protect the quality of our nation's valuable natural resources. She later went on to serve as principal counsel to former Assistant Attorney General Lois Schiffer at the Environment and Natural Resources Division during the Clinton administration. In that role, Ignacia worked with officials from agencies across the executive branch to protect the environment, public health and welfare of U.S. citizens. She was responsible for both

domestic and international policy matters, representing the United States in civil and criminal litigation and providing counsel on environmental and trade policy issues. She also skillfully represented the U.S. in negotiations with governments in Mexico and Central and South America on cooperative environmental enforcement initiatives.

After returning to private practice for several years, Ignacia went to work as counsel for corporate environmental programs at General Electric. Her industry experience only adds to the depth of knowledge and insight that she would bring to the enforcement of environmental and health-and-safety regulations and serving the public interest.

Ignacia has also assumed important leadership roles at the Hispanic Bar Association, the American Bar Association, the Washington Lawyers' Committee for Civil Rights and Urban Affairs, and the Center for International Environmental Law. She has done significant pro bono work during her time in private practice, and her strong record of service demonstrates a deep commitment to protecting the environment and our natural resources.

President Obama has emphasized the importance of building an administration that incorporates a range of perspectives. Ignacia's experience across a variety of sectors will add significant value to the important environmental issues that face our nation. She has proven herself to be a balanced and reflective lawyer who is capable of seeing all sides of the most difficult problems and finding common ground among differing parties and interest groups.

Throughout her career, Ignacia has consistently looked for balanced, viable solutions to vexing environmental problems. She has the credentials, the intellectual ability, and the personal and professional integrity to be an effective leader. I am confident that she will make a public servant of the highest caliber and work hard to uphold the law and protect the public good.

I urge the Senate to confirm her nomination.

Sincerely,

Richard L. Revesz

cc: Members of the Senate Judiciary Committee

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4640 Brandywine Street, N.W.
Washington, D.C. 20016
June 15, 2009

Senator Patrick Leahy
Chairman
Committee on the Judiciary
SD-224 Dirksen Senate Office Building
Washington, DC. 20510-6275
Sent by Fax: [redacted]

Dear Senator Leahy:

I write to support the nomination of Ignacia Moreno as Assistant Attorney General for the Environment and Natural Resources Division at the United States Department of Justice. As a former office holder in that position, I know well the importance of the office to protection of the environment and the American public consistent with a sustainable economy, and the skills and commitment necessary for effectively carrying it out. Ignacia Moreno has the character, knowledge, and abilities necessary to the task. If confirmed, she will serve the Division, the Department of Justice, and the American public well as Assistant Attorney General.

I was Assistant Attorney General for the Environment and Natural Resources Division through most of the Clinton Administration (Acting AAG, 1993-1994; and AAG from 1994-2001); I also served in the Division from 1978-1984 as first a Section Chief and then a Special Litigation Counsel. Thus for a span of over twenty years I saw the Division's work and role, and know well the Division and its effective operation.

Ignacia Moreno served as Special Assistant, Counsel, then Principal Counsel, to me for seven years. Based on that direct experience with her work, I know that Ignacia brings to this important job many essential qualities, including: she is an excellent attorney with a sound record of intelligence and hard work; she has strength of character and strong commitment to environmental protection consistent with a sustainable economy; and she has worked with a wide range of people, including people throughout federal agencies, in U.S. Attorneys' offices, and in state offices. These qualities will serve the American public well.

In the Division, Ignacia worked on a wide range of cases and matters. In each of these she exhibited leadership, an approach of strong and effective enforcement of our nation's environmental protection laws, a tough but fair application of the law, and a meticulous regard for finding the law, finding the facts, and handling cases and programs based on the law and the facts. She is smart, and has sound legal judgment. She works well with people at all levels of the government, in private companies and non-profit groups, and can bridge divides.

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Finally, and important to the position, Ignacia is a leader. She identifies and sets a course, and motivates and mobilizes people to reach the goal. She will be an excellent successor, and I commend her to you.

Sincerely,

Lois J. Schiffer
Former Assistant Attorney General
Environment and Natural Resources Division
U.S. Department of Justice

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July 22, 2009

The Honorable Patrick J. Leahy
Chairman
United States Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
United States Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Re: Confirmation of Ignacia S. Moreno as Assistant Attorney General, Environment and Natural Resources Division, United States Department of Justice

Dear Chairman Leahy and Ranking Member Sessions:

If the Committee seeks intellect, experience, passion and judgment in the Assistant Attorney General, it makes a superb choice in Ignacia Moreno. I am a Judge on the Environmental Appeals Board, Environmental Protection Agency, and speak only in my personal capacity. I do not represent official Agency views.

I well know the demands on the Assistant Attorney General and Ms. Moreno's fitness to carry them. During much of her Clinton Administration tenure in the Environment and Natural Resources Division, I was a career attorney and worked closely with Ms. Moreno on initiatives and projects. I early saw in her striking aptitudes. Her energy was boundless, her legal mind restless and probing. She absorbed and fused vast amounts of information, nimbly explored legal options, ever welcomed wide and fresh perspectives. Even then, hers was a considerable legal talent.

To these abilities, however, was added another which emerged with her rising prominence in Division and Department affairs -- leadership. One high-visibility showcase was the Division "colonias" initiative. Launched on the heels of President Clinton's environmental justice executive order, and spurred by growing NAFTA-era awareness of severe environmental stress and poverty in southwestern border communities, the Assistant Attorney General designated Ms. Moreno to spearhead Division efforts to seeks ways to bring relief to colonias. Ms. Moreno could merely have treated this as a matter of legal research. She did not. Instead, she ventured far beyond Division doors and into entirely new arenas.

First, from within the Department, she recruited and led a team of Environment and Civil Division attorneys and coordinated with U.S. Attorneys (New Mexico, S.D. California and S.D. Texas). Then she engaged high-level officials at other agencies (EPA and ATSDR) and built alliances with State Attorneys General (Texas and New Mexico) and numerous city, county and nonprofit leaders throughout the border. After marshaling this legal and technical force and navigating political and institutional shoals, she steered the team in obtaining appropriate relief in Safe Drinking Water Act cases.

There is no quality of talent or experience required for the Assistant Attorney General position lacking in Ms. Moreno. Her private sector endeavors only enrich her qualifications. I strongly recommend her as Assistant Attorney General.

Sincerely,

Charles J. Sheehan

Judge Charles J. Sheehan

OCEANA | Protecting the World's Oceans
1350 Connecticut Ave. NW, 5th Floor +1 202.833.3900
Washington, DC 20036 USA oceana.org

21 July 2009

The Honorable Patrick J. Leahy
Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Re: Letter of Support for Ignacia Moreno

Dear Chairman Leahy and Ranking Member Sessions:

I write in support of your committee's confirmation of Ignacia Moreno as Assistant Attorney General for the Environment and Natural Resources Division of the U.S. Department of Justice. I speak on behalf of Oceana and on the basis of my personal experience working with Ms. Moreno.

Oceana is an international marine conservation organization that advocates for policies to protect and improve ocean life in this country and throughout the world. The Environment and Natural Resources Division is at the center of many issues crucial for marine conservation, including federal environmental enforcement (both civil and criminal), defense of government positions and rulemakings, legislation, and international negotiations. Thus, Oceana is keenly interested in the selection of someone like Ms. Moreno who can provide clear, far-sighted leadership for the Division.

I had the pleasure of working with Ms. Moreno from 1994 until January 2001, when I was fortunate to serve as Deputy Assistant Attorney General in the Division. My portfolio during this time included policy and legislation, criminal enforcement of environmental laws, and appellate advocacy. In that capacity, I had the opportunity to work with her on many issues related to international environmental enforcement; legal and policy issues in negotiation of international treaties; and the international implications of domestic regulations and policy initiatives. In addition, Ms. Moreno was a close advisor to Lois Schiffer, the Assistant Attorney General in charge of the Division, and so she participated in senior management discussions about the overall direction of the Division.

Some of the issues that we worked on were complex and contentious. These included enforcement to address cross-border environmental impacts in the U.S., application of the National Environmental Policy Act in an international context, and negotiation of trade agreement provisions to protect the environment and natural resources. In all of these issues, Ms. Moreno was able to dissect the key legal issues with clarity. She was even-handed in giving due consideration to all affected parties. She demonstrated that she was dedicated to taking a

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position well justified by a fair and balanced application of the law to the facts. Moreover, she was always committed to strict adherence to ethical rules and guidelines.

Based on this personal experience, I am confident that Ms. Moreno will, if confirmed by the Senate, serve ably and with high distinction as Assistant Attorney General. On behalf of myself and of Oceana, I urge your committee to approve her confirmation. I would be pleased to provide any additional information that may be helpful to you.

Sincerely,

James F. Simon
Acting Chief Executive Officer

STEVEN P. SOLOW
[redacted]

July 27, 2009

The Honorable Patrick J. Leahy
Chairman
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Senate Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Dear Chairman Leahy and Ranking Member Sessions:

I am writing this letter on behalf of Ignacia Moreno, the Administration's nominee for Assistant Attorney General ("AAG") of the U.S. Department of Justice's Environment and Natural Resources Division ("Division").

I had the pleasure and privilege to serve in the Division from 1994 to 2000, as an Assistant Section Chief, then Chief, of the Environmental Crimes Section. During this period, I had regular contact with members of the Division's senior management, including with Ms. Moreno. Based on these experiences, I believe Ms. Moreno is a dedicated environmental lawyer with sound legal judgment and high ethical standards. If confirmed, she will make an effective leader for the Division and will be a strong advocate for environmental protection. I urge you to support her confirmation.

Ms. Moreno was a trusted member of the Division's management team. She had a particularly close working relationship with AAG Lois Schiffer and her deputies, as well as with section leaders like myself. Although much of her work was at the highest level of policy and strategic concerns, Ms. Moreno delved into the day-to-day mechanics of the Division's cases, and she had firsthand experiences with most of the litigating sections within the Division. Ms. Moreno served as a key Division liaison to the United States Attorneys, the White House Council for Environmental Quality ("CEQ"), and the National Security Council, as well as with those agencies with whom the Division works more routinely, including the U.S. Environmental Protection Agency, the National Oceanic and Atmospheric Administration, and the U.S. Department of the Interior. Ms. Moreno collaborated on international environmental matters with officials from the U.S. Department of State, the U.S. Agency for International Development, the U.S. Trade Representative ("USTR"), the U.S. International Trade Administration, and the U.S. Department of Treasury. In all of these and other capacities, Ms.

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Moreno helped the Division operate more effectively within the broader framework of the Executive branch.

Ms. Moreno also provided counsel regarding the development of U.S. policy on trade and environment, where she focused on the need to raise environmental standards and protections in other countries. For example, I know that she worked closely with the CEQ and the USTR to develop an executive order on environmental reviews of trade agreements.

Ms. Moreno has been an outspoken advocate for improving environmental protection throughout the Western Hemisphere and around the world. She represented the U.S. Department of Justice at a number of high-level international meetings, including the World Trade Organization, the Summit of the Americas, the Commission of Environmental Cooperation, U.S.-Mexico bi-national summits, and other border enforcement cooperative initiatives. She advocated for free trade agreements that supported strong governmental and citizen processes to protect the environment, and she displayed particular concern for the effects of environmental pollution on poor and underserved communities. In this regard, Ms. Moreno spearheaded the Division's efforts to address pollution in substandard Colonias communities along the U.S.-Mexican border.

In all of my interactions with her, Ms. Moreno has exhibited a personal and profound commitment to environmental protection and to equality and integrity in the administration of national environmental protection initiatives. Her commitment to the environment remains sincere and strong, and those in search of environmental protection and justice will find in Ms. Moreno an ardent and committed advocate.

Finally, I believe that if she is confirmed, Ms. Moreno will seek to meet the most important standard for a U.S. Department of Justice attorney, that is, to be a lawyer whose interest is in serving the public, and whose highest obligation is to the just administration of the law.

I would be happy to provide additional information if you so request.

Sincerely,



Steven P. Solow

62345.929

GERALD TORRES

September 3, 2009

[redacted]

Honorable Senator Patrick Leahy
Chairman
Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510-6275

Honorable Senator Jeff Sessions
Ranking Member
Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510-6275

Re: Endorsement of Ignacia S. Moreno for Assistant Attorney General, Environment and Natural Resources Division, US Department of Justice

Dear Senator Leahy and Senator Sessions:

I write to support the nomination of Ignacia Moreno to the position of Assistant Attorney General. I write as a Professor of environmental and Indian law for over twenty-five years and as someone who has served on boards as diverse as the National Petroleum Council, The Environmental Law Institute, Earth Day Network, and the Natural Resources Defense Council. I have also practiced law in the private sector as well as in the Department of Justice.

Ignacia Moreno is particularly well suited to lead the Environment and Natural Resources Division at the United Stated Department of Justice. It is true that for every position that is filled in the government there are many people who could do a credible job, but there are times and circumstances that make a particular person the absolute right one for the job. These are the times and these are the circumstances that make Ignacia the perfect fit for this position. Let me tell you why.

First, I have known Ignacia since 1993 when I served in DOJ and I have followed her subsequent career. I know that she is a lawyer who exhibits not just sound legal judgment, but wise legal judgment. It is the kind of judgment that can only come from having to deal with a wide variety of challenges and trying to achieve difficult and sometimes cross cutting objectives. Her early work in the private sector prepared her for her later work in the Justice Department where she served for seven years. After her service in the Department she returned to private practice at the law firm of Spriggs & Hollingsworth, and more recently joined GE as a counsel in its corporate environmental program.

2504 Bridle Path
Austin, TX 78703

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One of the advantages she brings to the position is that her earlier work in the Department has enabled her to learn the ways that agencies work and thus she will be well situated to make the necessary interagency cooperation more efficient and more effective. Additionally, people in the Division already know who she is and they will trust her judgments and her instincts. A large number of them (including some who have now moved up into leadership positions in the sections) know that she is an effective leader who understands that her fundamental obligation is to enforce the laws that Congress has passed and that the agencies are attempting to implement. Because she is a known quantity and is widely respected in the Division, I suspect that her appointment will generally raise the morale of the career lawyers who are among the most dedicated public servants I have ever had the opportunity to work with.

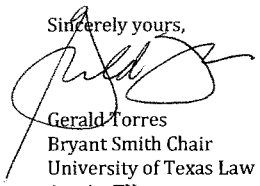
Because of the appropriate focus on its environmental work, there is a side of the Division that gets little attention in the general or environmental media and that is the role the Division plays in relation to the federally recognized Indian tribes. For many tribes the initial point of contact outside of the Department of the Interior is ENRD at the USDOJ. Ignacia will bring to the job a level of trust from the tribes she must deal with and represent as well as an understanding of the complex issues facing Indians and Indian resources and that is something of value that we ought not to take lightly. The appointment is of some importance to people in Indian country.

I also believe that her time at General Electric enables her to bring a valuable perspective on the balance that has to be struck in order to achieve both our environmental and our economic goals. She is well positioned to be taken seriously by both sides in that serious debate.

Finally, I have known her as friend and as a mother who appreciates the complexity of the environment we all face and the importance of working hard, but fairly for a cleaner future knowing that it is her obligation to enforce the law and give policy makers the best advice she can when she is called upon to do so.

Thus I end where I began. These are those special times and circumstances that make Ignacia just the right person for this position. I urge her speedy confirmation.

Sincerely yours,



Gerald Torres
Bryant Smith Chair
University of Texas Law School
Austin, TX

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IGSD Institute for Governance & Sustainable Development

June 16, 2009

The Honorable Patrick J. Leahy
Chairman
United States Senate
Committee on the Judiciary
224 Senate Dirksen Building
Washington, DC 20510

Re: Endorsement of Ignacia S. Moreno for Assistant Attorney General, Environment and Natural Resources Division, Department of Justice

Dear Senator Leahy:

As President of the Institute for Governance & Sustainable Development based in Washington, DC and Geneva, and Director of the International Network for Environmental Compliance and Enforcement, I am writing to highly recommend Ms. Ignacia S. Moreno for Assistant Attorney General of the Environment and Natural Resources Division at the Department of Justice. IGSD works to advance the understanding, development and implementation of effective, accountable and democratic systems of governance for sustainable development; INECE is the only global network of environmental compliance and enforcement practitioners dedicated to raising awareness of compliance and enforcement; developing networks for enforcement cooperation; and strengthening capacity to implement and enforce environmental requirements.

I have known Ignacia Moreno throughout her distinguished career and she would be a superb choice for this position. She has the talent and temperament to be a great Assistant Attorney General, providing thoughtful and inspired leadership for one of the most important environmental offices in the U.S. government.

The Assistant Attorney General position requires a leader who knows and values the environmental mission she is called upon to protect. It requires a leader who can be tough on environmental crime, and who can help maintain environmental law and order. It also requires a leader who appreciates the emerging environmental issues, including first and foremost, climate change. Most of all perhaps, it requires a leader who appreciates the tremendous talent that exists within the Environment Division, and throughout the client agencies, and who has the leadership skills and diplomatic skills to expand on past success, while charting a new course for the future.

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ph: 202 338 1300 fax: 202 338 1810 email: info@igsd.org

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Ignacia Moreno possesses all of these skills, as well as an impressive range of environmental law and policy experiences spanning almost 19 years. The positions she has held and the variety of issues she has been exposed to further strengthen her case for the position of Assistant Attorney General.

Environmental issues, climate change in particular, are now in the policy spotlight, and for good reason: how the U.S. handles the energy and climate crisis will largely determine our course on many national and international issues for years to come. The individual who takes this position must be someone with a strong record of upholding environmental values and who can be counted on to use their sound judgment to make the right decisions in the months and years ahead. I am fully confident that Ignacia S. Moreno has the expertise, the leadership, and the integrity to succeed as Assistant Attorney General of the Environment and Natural Resources and I give her my highest recommendation.

Thank you for your consideration and please do not hesitate to contact me if you have any questions: (202) 498-2457 or dzaelke@igsd.org.

Sincerely,



Durwood Zaelke
President, IGSD
Director, INECE Secretariat

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NOMINATION OF JACQUELINE H. NGUYEN, OF CALIFORNIA, TO BE DISTRICT JUDGE FOR THE CENTRAL DISTRICT OF CALIFORNIA; EDWARD MILTON CHEN, OF CALIFORNIA, TO BE DISTRICT JUDGE FOR THE NORTHERN DISTRICT OF CALIFORNIA; DOLLY M. GEE, OF CALIFORNIA, TO BE DISTRICT JUDGE FOR THE CENTRAL DISTRICT OF CALIFORNIA; AND RICHARD SEEBORG, OF CALIFORNIA, TO BE DISTRICT JUDGE FOR THE NORTHERN DISTRICT OF CALIFORNIA

WEDNESDAY, SEPTEMBER 23, 2009

U.S. SENATE,
COMMITTEE ON THE JUDICIARY,
Washington, DC.

The Committee met, Pursuant to notice, at 2:34 p.m., in room SD–226, Dirksen Senate Office Building, Hon. Al Franken, presiding.

Present: Senators Franken, Feinstein, and Sessions.

OPENING STATEMENT OF HON. AL FRANKEN, A U.S. SENATOR FROM THE STATE OF MINNESOTA

Senator FRANKEN. Good afternoon. The hearing will come to order.

I want to welcome everyone to today's hearing of the Senate Judiciary Committee. Today we will hear from four nominees. All four nominees are for the Federal district courts in California, so I would like to extend a special welcome to my distinguished colleague Senator Boxer, who I believe will be here in just a few moments to introduce each of our nominees, and perhaps Senator Feinstein will also be able to make it. Unfortunately, she is on the floor right now managing the interior appropriations bill, and if she cannot make it, she sends her apologies.

The nominees being considered are: California Superior Court Judge Jacqueline Nguyen to sit on the U.S. District Court in Los Angeles; U.S. Magistrate Judge Edward Chen to sit on the U.S. District Court in San Francisco; Dolly Gee to sit on the U.S. District Court in Los Angeles; and U.S. Magistrate Judge Richard Seeborg to sit on the U.S. District Court in San Francisco.

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Although I have only been here a short time—there is Senator Boxer. Welcome.

Senator BOXER. Thank you.

Senator FRANKEN. Although I have only been here a short time, I was able to participate in the historic nomination of the first Latina appointed to the Supreme Court. Today's hearing is also a historic one both for the Federal courts and for the Asian American Community. As the Congressional Asian-Pacific American Caucus recently pointed out in a letter to the Committee, Asian Americans and Pacific Islanders are among the fastest-growing racial groups in the United States. Yet of the Nation's 875 active Article III judges, only eight are Asian American or Pacific Islander. Should today's nominees be confirmed, that number would rise to 11.

In addition, we would be confirming the first Asian American judge ever to sit on the U.S. District Court for the Northern District of California, which includes San Francisco and the Bay Area, the first Vietnamese American woman to serve as a U.S. district judge and the first Chinese American to sit as a U.S. district judge. So this is an important hearing, and I want to thank representatives from the National Asian and Pacific American Bar Association, the Asian Pacific Bar of California, and the Asian American Justice Center for being in attendance today.

I would also like to briefly point out something about two of the nominees today. Both Judge Seeborg and Judge Nguyen have experience in prosecuting cases of fraud—in particular, Ponzi schemes. These corrupt business practices have recently come to light across the country. Unfortunately, in my home State of Minnesota, with the case of Tom Petters and his alleged $3.5 billion scheme, it is extremely important that we have judges equipped with the financial experience to handle these cases, and I look forward to hearing from both of them on their experience with these cases.

In closing, I would like to outline how the hearing will proceed. After the Ranking Member Senator Sessions makes his introductory remarks, the Senator from California, Senator Boxer, will introduce the nominees and I believe also will Senator Feinstein, who is now here sitting to my left. And then each Senator on the Committee will have a 5-minute round with the panel.

Now I will turn it over to my distinguished Ranking Member Senator Sessions.

STATEMENT OF HON. JEFF SESSIONS, A U.S. SENATOR FROM THE STATE OF ALABAMA

Senator SESSIONS. Thank you, Mr. Chairman, and I think we should note the meteoric rise you have achieved here.

[Laughter.]

Senator FRANKEN. Thank you.

Senator SESSIONS. It gives new meaning to the words "meteoric rise." Thank you. You are an active, participating member of this Committee, and I hope you enjoy it. And I think you are from our conversations.

We welcome these nominees and look forward to hearing from—I see Senator Boxer. I know she is ready to talk. Each has an impressive resume and fine credentials, and I look forward to participating in the discussion.

Senator FRANKEN. Thank you, Senator Sessions.

Senator Feinstein, would you like me to go to Senator Boxer.

Senator FEINSTEIN. Yes, please.

Senator FRANKEN. Senator Boxer, I would like to welcome you again.

Senator BOXER. I think it would be wonderful if Senator Feinstein went first. She has so many more to introduce, and I would defer to her since she is on the Committee. And, by the way, I just want to say thanks for her hard work on the floor.

Senator FRANKEN. Well, in that case, since I am the Chairman, I will make the decision. Let me see.

[Laughter.]

Well, I will defer to Senator Boxer's judgment and recognize Senator Feinstein.

STATEMENT OF HON. DIANNE FEINSTEIN, A U.S. SENATOR FROM THE STATE OF CALIFORNIA

Senator FEINSTEIN. Thank you very much, Mr. Chairman, and to my colleague, I would only say so far, so good down on the floor. But thank you very much, and thank you for being here.

I would like to begin by introducing Judge Jacqueline Nguyen. She has been a judge of the California Superior Court in Los Angeles County since 2002 when she was appointed by Governor Gray Davis. Before becoming a judge, she served as a Federal prosecutor in the Los Angeles United States Attorney's Office for 7 years. She began in the Public Corruption and Government Fraud Section and was promoted to be Deputy Chief for General Crime in 2000.

During her time as a prosecutor, Judge Nguyen led a 2–3 year undercover investigation into the filing of false applications for United States visas. In this case, Judge Nguyen secured the first ever conviction of a defendant for providing material support to a designated foreign terrorist group.

Judge Nguyen also handled an important wiretap investigation of a Russian organized crime group that was smuggling sex slaves into the United States from the Ukraine. She received an impressive list of accolades for her work as a prosecutor. In 2002, she was awarded the Director's Award for Superior Performance as an Assistant U.S. Attorney. In 2000, she received a special commendation from FBI Director Louis Freeh for her work on the material support of terrorism case. And in 1996 and 1997, she received two commendations for sustained superior performance as an Assistant U.S. Attorney. Judge Nguyen has also experienced working 2 years on commercial cases at a private law firm.

I want to mention one other thing. Judge Nguyen's personal story is one that to me, and I believe to Senator Boxer, really shows how fortunate we all are to live in the United States. Judge Nguyen and her family came to California in 1975 from South Vietnam. They lived initially at Camp Pendleton before moving to Los Angeles where her parents worked in and later owned a series of doughnut shops. Judge Nguyen helped her parents in their shop during her high school years, and she continued working with them while she went on to graduate from Occidental College and the University of California Los Angeles School of Law.

Judge Nguyen will be the first Vietnamese American woman to serve as a United States district judge. My selection Committee in California highly recommended Judge Nguyen to me for the district court, and I was proud to recommend her to the President. She has been rated well qualified by the American Bar Association.

So I would just like to recognize that and say how welcome she is here today.

Senator FRANKEN. Thank you, Senator Feinstein.

Senator Boxer.

PRESENTATION OF DOLLY M. GEE, NOMINEE TO BE DISTRICT JUDGE FOR THE CENTRAL DISTRICT OF CALIFORNIA, BY HON. BARBARA BOXER, A UNITED STATES SENATOR FROM THE STATE OF CALIFORNIA

Senator BOXER. Mr. Chairman, thank you so much. I am honored to be here today to introduce Dolly Gee and welcome all of our California nominees and their families, and I want to add my congratulations to them all. Each of them comes to you so well qualified and well suited for the responsibilities that we hope they will take on.

Senator Feinstein and I share the responsibility in California for providing advice and consent to the President on judicial nominations. I am very proud of the way we do it. Our bipartisan judicial advisory committees have vetted all of these nominees, and they have given them their highest recommendation. We are united in our admiration for the nominees, all of whom are respected by their colleagues in the California legal community, and they will all make outstanding additions to the Federal bench.

I do want to say a few words about the nominee whom I had the pleasure of recommending to the President, Dolly Gee. And, Dolly, would you stand, please?

Dolly is the daughter of parents who came to the United States from a small farming village in southern China. Her father was a World War II veteran, and he worked as an aerospace engineer on projects such as the Space Shuttle and the Apollo mission. Dolly's mother, who is with us today—and I would ask, Mr. Chairman, if it is OK with you and Senator Sessions, if I may ask her to stand, Dolly's mother. Is that all right?

Senator FRANKEN. Absolutely.

Senator BOXER. Where is she? She will just show you who she is.

Senator FRANKEN. Welcome.

Senator BOXER. And she was a garment worker who never taught Dolly to sew because she did not want her daughter to have to stitch clothes for a living. And this touches us all, I think. Her mom's experience as a seamstress helped inspire Dolly to pursue a career in employment law, to seek equal and fair treatment for workers.

Dolly graduated summa cum laude from UCLA in 1981, and then she received her law degree from the same university in 1984. After a Federal clerkship in the Eastern District of California, she began her career in private practice at the firm of Schwartz & Steinsapir in Los Angeles. In 1994, President Clinton appointed Dolly to a 5-year term on the Federal Service Impasses Panel, act-

ing as a mediator and arbitrator in hundreds of disputes between Federal agencies and the workers. She has also served as an arbitrator for Kaiser Permanente, helping to resolve medical and contract claims.

In these roles—and I think this is so important—she has learned to listen to all sides and dispassionately apply the law to the facts, skills that are so essential as a judge.

Dolly has been widely praised for her work promoting racial tolerance in Los Angeles by building diverse coalitions among various bar associations. She is a co-founder of the Asian Pacific American Bar Association of Los Angeles county and the Multicultural Bar Alliance and served as president of the Southern California Chinese Lawyers Association.

As with Ms. Nguyen, Dolly's nomination is historic. If confirmed, she would be the very first Chinese American woman in U.S. history to serve as a Federal district court judge. Her nomination is a source of pride to so many people, not just to her family—to her Mom, who is here today, and to the Asian American Community—but to everyone who believes that our Federal courts should reflect the diversity of this, the greatest country in the world.

And I have to say it is such an extraordinary moment, and I would say to our Chairman, Senator Franken, it is a great day to be sitting in that chair because here is who is making history today. We heard of the two women. If confirmed, Judge Edward Chen, a respected former civil rights lawyer and the first Asian American magistrate judge in the Northern District, would take another historic step as the first ever Asian American district court judge for the Northern District.

So we have all of this making history today, and here is the important thing. Senator Feinstein and I have one direction to our committees: Send us the best. That is all we want. Send us the best. It is not partisan. I, frankly, have never known one person that I have recommended. It just so happens I never have known them personally. They have come through this wonderful system that we have created here. And so, clearly, I am very proud today. And I am so hopeful that the Committee will act to confirm these nominees quickly.

Federal judges across the country, and particularly in California, are carrying a large caseload, backlogs, due to the fact that we have not updated the number of Federal judgeships in 20 years. And I know Senator Feinstein has been working long and hard on this. One of our districts, the Eastern District of California, carries the highest number of case filings per judge in this country, an astounding 1,106 per judge. And I say to Senator Sessions, who knows what that kind of a caseload is, this is quite an extraordinary number of cases to be carrying-1,106 in the Eastern District of California. And two more districts, I say to my friends, the Central and the Northern Districts, are also among the top ten in the country in terms of these caseloads.

Our courts need help now. This is a momentous day, and I am very happy to be with you, and I am looking forward to your swift action. And thank you very much for your allowing me to speak today.

Senator FRANKEN. Thank you, Senator.

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Senator Feinstein, would you also introduce Judge Chen and Judge Seeborg.

Senator FEINSTEIN. I would be happy to, and let me thank my friend and colleague for being here, and let me also thank you for bringing to the attention of both Senator Franken and Ranking Member of the Judiciary Committee, Senator Sessions, the fact that we are really under-judged in California, and particularly in the Eastern District. So I very much appreciate your comments. Thank you.

I would like to now introduce Judge Edward Chen. Judge, would you stand, please? Right there. And, Judge Nguyen, would you stand, please? I did not do that. Thank you very much.

Judge Chen has served as a United States magistrate judge in the Northern District of California for the last 8 years. He was appointed to that position by a merit-based selection Committee and was recently reappointed to serve a second 8-year term after a thorough review of his work, detailed confidential feedback from litigants, and insights from district judges.

Before he was appointed to the Federal magistrate bench, Judge Chen worked as a staff attorney at the American Civil Liberties Union Foundation of Northern California and as a litigation associate at the law firm of Coblentz, Cahen, McCabe & Breyer. Judge Chen was part of the legal team that successfully represented Fred Korematsu in a suit to have his conviction removed for failing to report to an internment camp during World War II. Judge Chen worked as a law clerk to United States District Judge Charles Renfrew and to Judge James R. Browning on the United States Court of Appeals for the Ninth Circuit, and he is an Order of the Coif graduate of the University of California-Berkeley Boalt School of Law.

Judge Chen has served as a master of the Edward J. McFetridge American Inn of Court, which is a new association for me, and as Chair of the Federal Courts Committee of the California Commission on Access to Justice and as an appointee to various Ninth Circuit committees. In 2007, he was named the Judge of the Year by the Barristers Club of San Francisco.

Judge Chen was unanimously recommended to me by my bipartisan selection Committee in California, and I recommended him to the President. He has been rated well qualified by the American Bar Association. Judge Chen was the first Asian American appointed to be a magistrate judge in Northern California, and as has been said about others, he would be the first to sit—Asian male, that is, to sit as a United States district judge in the district, if confirmed.

I would also like to introduce Judge Richard Seeborg. Would you stand, please? Thank you very much. Like Judge Chen, Judge Seeborg has been a United States magistrate judge in the Northern District of California since 2001. He was recently reappointed to a second term after a lengthy review process. He sits in San Jose, California, where he has presided over many intellectual property cases coming out of Silicon Valley. He has a special expertise in this area and has made speeches in places as far away as Chile and India about intellectual property rights enforcement.

Before stepping onto the Federal bench, Judge Seeborg worked as a Federal prosecutor and as a partner at a private law firm. From 1991 to 1998, he prosecuted white-collar crime cases as Assistant U.S. Attorney in San Jose. He brought charges of wire fraud, high-tech crime, tax evasion, and money laundering, and he was co-lead counsel in a case involving money swindling by a mortgage loan company. He also successfully prosecuted a manufacturer of GPS devices for exporting goods from the UAE to Iran without a valid customs license.

For 12 years, Judge Seeborg litigated complex civil cases as an associate and then a partner at the law firm of Morrison and Foerster. His work at the law firm gave him experience ranging from contract law to intellectual property law to antitrust. He is a summa cum laude graduate of Yale and a Harlan Fiske Stone Scholar at Columbia University School of Law. He was also unanimously recommended to me by my judicial screening Committee in California, and I have subsequently recommended him to the President, and he finds himself here today.

So welcome, Judge Seeborg, and thank you very much, Mr. Chairman.

Senator FRANKEN. Thank you, Senator Feinstein, and thank you coming from the floor where I know you are busy managing the interior appropriations bill.

Now I would like all the nominees to please stand and take the oath. Raise your right hand. Do you confirm that the testimony you are about to give the Committee will be the truth, the whole truth, and nothing but the truth, so help you God?

Judge NGUYEN. I do.

Judge CHEN. I do.

Ms. GEE. I do.

Judge SEEBORG. I do.

Senator FRANKEN. Well, thank you and please be seated.

Judge Nguyen—do I have the pronunciation right? Because I said "Noo-in."

Judge NGUYEN. I pronounce it "nwin." Thank you, Mr. Chairman.

Senator FRANKEN. Sorry. You are now free to give any opening remarks and also to introduce any family members who might be here today.

STATEMENT OF HON. JACQUELINE H. NGUYEN, TO BE DISTRICT JUDGE FOR THE CENTRAL DISTRICT OF CALIFORNIA

Judge NGUYEN. Thank you, Mr. Chairman. It is my honor and privilege to appear before you this afternoon. I would like to thank President Obama for nominating me. I would like to thank Senator Feinstein for recommending me and for that very kind introduction, and Senator Boxer for her support as well. I thank you, Mr. Chairman, for presiding over the hearing today and Senator Leahy for scheduling this hearing. I also would like to thank the Ranking Member, Senator Sessions, and the other Committee members as well.

I am very proud to introduce my family members who are present to support me this afternoon: my husband, Pio Kim; my children, 10-year-old Nolan and 7-year-old Avery; my mother-in-

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law, Hyo Soon Kim; and my mother, Hoa Nguyen. I also have other supporters——

Senator FRANKEN. I would just like to say welcome to your family.

Judge NGUYEN. Thank you. I have other supporters present, and I would like to acknowledge and thank them as well.

At home, I have many, many family members and friends watching the live webcast, and I want to acknowledge them and, in particular, acknowledge my father-in-law, Mr. Suh Chang Kim, and my other father, Binh Nguyen.

Thank you, Mr. Chairman.

[The prepared statement of Judge Nguyen appears as a submission for the record.]

[The biographical information of Judge Nguyen follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Jacqueline Hong-Ngoc Nguyen

   Hong-Ngoc Thi Nguyen 1965-1984 (birth name)

   Nita (unofficial nickname used from 1976-1983)

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Central District of California

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   State of California, Los Angeles Superior Court
   Alhambra Courthouse, Department 1
   150 West Commonwealth Avenue
   Alhambra, Los Angeles County, CA 91801

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1965; Dalat, Vietnam

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1988-1991, UCLA School of Law; J.D., May 1991

   1983-1987, Occidental College; A.B., June 1987

   1985-1986, Waseda University (Tokyo, Japan); No degree (study abroad program)

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises,

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partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

2002-present
State of California, Superior Court of the County of Los Angeles
Alhambra Courthouse
150 W. Commonwealth Avenue
Alhambra, CA 91801
Judge of the Superior Court
Site (supervising) Judge, Alhambra Courthouse, October 2008-present.

1995-2002
United States Attorney's Office
312 N. Spring Street
Los Angeles, CA 90012
Deputy Chief, General Crimes Section (2000-2002)
Assistant United States Attorney (1995-2000)

1991-1994
Musick, Peeler & Garrett
One Wilshire Blvd.
Los Angeles, CA 90017
Associate Attorney

Summer 1990
Rosen, Wachtell & Gilbert
[now defunct]
Century City, CA
Summer Associate

Spring 1990
Public Advocates
131 Steuart Street, Suite 300
San Francisco, CA 94105
Law Student Intern

Summer 1989
The Honorable Richard A. Gadbois, Jr.
United States District Court, Central District of California
312 North Spring Street
Los Angeles, CA 90012
Judicial Extern

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August 1987-March 1988
Los Angeles Unified School District
333 S. Beaudry Avenue
Los Angeles, CA 90017
Substitute Teacher (K-5)

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

None

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

Keynote Speaker, Annual Dinner of the Vietnamese American Employees Association of Los Angeles County, 2009

Keynote Speaker, Installation Dinner of the Vietnamese American Bar Association of Southern California, 2008

Panel speaker, Annual National Conference of Vietnamese American Attorneys, 2006 and 2008

Occidental College, Alumni Award, 2007

Lecturer, "State of the Courts in Los Angeles County," Occidental College, 2007

Keynote Speaker, Installation Dinner of the Vietnamese American Bar Association of Northern California, 2007

Keynote Speaker, Annual Vietnamese American Youth Excellence Award Luncheon, Houston, Texas, 2003

Trailblazer Award, National Asian Pacific American Bar Association, 2006

Various state and U.S. congressional certificates and recognition as the first Vietnamese American woman judge in the State of California, 2002

Special Recognition Award, Asian Pacific American Legal Center, 2002

"Best Lawyer Under 40," National Asian Pacific American Bar Association, 2002

Award from the Federal Law Enforcement Officers Association for outstanding contribution in the field of law enforcement, 2002

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Director's Award from the Department of Justice for "Superior Performance as an Assistant United States Attorney," 2000

Special Award in the prosecution of Operation Permit to Smuggle, the "largest commercial smuggling case in the history of the U.S. Customs Service," 2000

Commendation from U.S. Attorney Alejandro N. Mayorkas, for Efforts in Prosecution of Health Care Fraud, 2000

Award from the U.S. Department of State, Bureau of Diplomatic Security, for the prosecution of Operation Eastern Approach, 2000

Special Commendation from FBI Director Louis J. Freeh, for securing first conviction ever in the U.S. for providing support to a designated foreign terrorist organization, 2000

Certificates of Appreciation, Public Counsel, Children's Rights Project, 2000 and 2001.

Award from the Asian Pacific American Bar Association, in recognition of leadership as President, 2000

Special Achievement Award for Sustained Superior Performance as an Assistant United States Attorney, 1996

Special Achievement Award for Sustained Superior Performance as an Assistant United States Attorney, 1997

United States Attorney's Office "On-the-Spot" Award, 1997

Commendation from United States Attorney, assistance in Out of District Prosecution of Corrupt Customs Employee, 1996.

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

The Asian Pacific American Bar Association
President (1999-2000); Board Member (1998, 2001); Founding Member (1998)

The Japanese American Bar Association - Board of Governors (1995-1997)

The Women Lawyers Association of Los Angeles County
Board of Governors (2001-2002); Co-Chair, Appointive Office Committee (2000-2001); Co-Chair, Criminal Justice Section (2001-2002).

The Asian Concerns Committee - Co-Chair (1994-1995)

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At various times over the past 18 years, I have also been a member of the following organizations:

The Korean American Bar Association

The Southern California Chinese Lawyers' Association

The Vietnamese American Bar Association of Orange County

The Los Angeles County Bar Association

The National Asian Pacific American Bar Association

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

State of California: November 1991.

There has been no lapse in membership from the date I was admitted to the date I was appointed as a judge to the Superior Court of Los Angeles County. Under the Constitution of California, a person serving as a judge of a court of record is not considered to be a member of the State Bar while in office. See California Constitution Article 6, § 9.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

All state courts in the State of California, 1991

United States District Court for the Central District of California, 1991

United States Court of Appeals for the Ninth Circuit, 1995

There has been no lapse in membership from the date I was admitted to the date I was appointed as a judge to the Superior Court of Los Angeles County. Under the Constitution of California, a person serving as a judge of a court of record is not considered to be a member of the State Bar while in office. See California Constitution Article 6, § 9.

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11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Parent Teacher Association for South Pasadena Unified School District.

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

No.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

I wrote a short article, "A Flight from Saigon to America", for *Gavel to Gavel*, a magazine of the Los Angeles Superior Court, published in the spring of 2006.

As President of the Asian Pacific American Bar Association ("APABA") from 1999-2000, I wrote short summaries of the organization's activities for APABA's newsletter. I have provided copies of the only one that can be located. I have no recollection of the content of any other articles or summaries that I may have written for the newsletter.

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None.

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c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

The Asian Pacific Islander Law Students Association of Southwestern Law School, January 2009.

Annual Dinner of the Vietnamese American Employees Association of Los Angeles County, February 2009.

Installation Dinner of the Vietnamese American Bar Association of Southern California, 2003 and 2008. I have included partial notes of the 2003 remarks. I do not have copies of the rest of those notes, nor the notes for the 2008 remarks. I do not recall the specifics of these speeches, but my goal was to share my own experiences and encourage participation in public service. The association's current address is 10517 Garden Grove Blvd., Garden Grove, CA 92843.

Panel Speaker, Annual National Conference of Vietnamese American Attorneys, 2006 and 2008. I did not speak from any prepared text or notes. The panel discussion concerned advice from judges regarding effective courtroom presentation.

Installation Dinner of the Vietnamese American Bar Association of Northern California, 2007. I no longer have the notes I used to deliver this speech, but some of it was similar to the speech given to the Vietnamese American Employees Association of Los Angeles County.

Lecturer, "State of the Courts in Los Angeles County", Occidental College, 2007.

The UCLA Asian Pacific Islander Law Students Association, 2004.

Annual Vietnamese American Youth Excellence Award Luncheon, Vietnamese Culture and Science Association, Houston Texas, 2003. I do not have notes from

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this keynote speech. This luncheon was to honor Vietnamese American high school students who graduated as valedictorians of their high schools. The organization's current address is 4615 Belle Park Drive, Houston, Texas 77072. My remarks were designed to celebrate these students' achievements and encourage Vietnamese American students to strive and achieve their dreams, regardless of the barriers they may face.

In connection with bar association activities for the past 18 years, I have also participated in numerous other discussions or "question and answer" type sessions on issues such as work/life balance and my experiences as a Vietnamese American attorney and judge. I do not have a recollection of when or where these informal talks occurred.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

The APABA Reporter – August 2000 (Volume II, Issue 3)

Asian Week – August 23-29, 2002

The Los Angeles Times – August 18, 2002

Metropolitan-News Enterprise – August 14, 2002

The Rafu Shimpo, August 23, 2002

Dia Phuong, October 7, 2002

The Daily Journal – December 9, 2003

The Occidental College Magazine – Winter 2003

The Daily Journal – August 3, 2009

The Metropolitan News – August 3, 2009

I have conducted an Internet search as well as reviewed my own records and have provided all articles that I could find in which I was quoted or a remark was attributed to me. I do not believe that I gave interviews to all of these papers directly, and perhaps the some of these articles lifted materials from other published articles. After my appointment to the Los Angeles County Superior Court in 2002, I gave several interviews to the Vietnamese language media and to other papers in the Asian Pacific American community. Other than what has already been provided, I do not have any other materials.

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13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

Judge, State of California, County of Los Angeles - Appointed by former Governor Gray Davis in August 2002

As a Superior Court judge, I have the authority to preside over all lawsuits filed in the County of Los Angeles. I am currently assigned to hear primarily criminal law matters. As such, I preside over matters, including trials, filed and prosecuted by the District Attorney's Office in Los Angeles County.

a. Approximately how many cases have you presided over that have gone to verdict or judgment?

Thousands of cases, including over 65 jury trial.

i. Of these, approximately what percent were:

jury trials? _95__%; bench trials _5__% [total 100%]

civil proceedings? __1_%; criminal proceedings? _99__% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

I am a trial court judge and do not issue written opinions.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

(1) People v. Danny Young, Case No. GA070636; Trial dates: October 2 to 29, 2008

Defendant was charged with multiple counts of oral copulation and sodomy on a child under 10 years old, and lewd acts with a child under 14 years old. The victim was defendant's stepdaughter. The evidence showed that defendant repeatedly sexually abused his stepdaughter, including sodomizing her when she was only eight years old. He was eventually apprehended after percipient witnesses observed the child being forced to engage in a sex act with defendant in a vehicle. Following a lengthy trial, defendant was convicted of all counts. Due to defendant's prior criminal history, on January 6, 2009, defendant was sentenced under the Three Strikes Law to a term of 250 years to life.

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People's counsel: Ana Lopez
Deputy District Attorney
District Attorney's Office
300 E. Walnut
Pasadena, CA 91101
(626) 356-5620

Defense counsel: Geoffrey Pope
1375 Elma Ct.
Ontario, CA 91764
(909) 983-3917

(2) People v. Dunifu Ali Kincy, Case No. GA071703; Trial dates: September 18 to 24, 2008

Defendant was charged with assault with a semi-automatic firearm, discharge of a firearm, and gun charges, arising out of a gang-related shooting in Pasadena. After the shooting, defendant crashed his vehicle and fled the scene. Percipient witnesses were unable to identify the shooter, but circumstantial evidence tied defendant to the shooting. Following a jury trial, defendant was convicted of all counts, and the gang enhancement was found to be true. On October 28, 2008, defendant was sentenced to 24 years in the state prison.

People's counsel: Mario Haidar
Deputy District Attorney
District Attorney's Office
300 E. Walnut
Pasadena, CA 91101
(626) 356-5620

Defense Counsel: William Jacobson
2272 Colorado Blvd., # 1226
Los Angeles, CA 90041
(323) 255-3900

(3) People v. Gerardo Olmos, Case No. GA067272; Trial dates: August 28 to September 15, 2008

Defendant was charged with first degree murder of his common-law wife after a heated argument. The evidence showed that, while their 10-month old twins slept nearby, defendant killed the victim by stabbing her in the chest and neck. The coroner also opined that the victim may have also been strangled prior to her death. Defendant took the stand and testified to his state of mind, and the defense

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tried to mount a voluntary manslaughter / heat of passion defense. Following a trial, the jury found defendant guilty of second degree murder. On October 16, 2008, defendant was sentenced to 16 years to life.

People's counsel: Donna Hollingsworth
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave., Alhambra, CA 91801
(626) 308-5400

Defense counsel: Diane Link
Deputy Public Defender
Public Defender's Office
150 N. Commonwealth Ave., Alhambra, CA 91801
(626) 308-5302

(4) People v. Jorge Luis Guerra-Zamudio, GA 070706; Trial dates: June 17-23, 2008

Defendant was charged with felony driving while under the influence of alcohol causing severe injuries to a little girl and her father. After the accident, defendant and the other occupant of his car fled the scene. At trial, defendant argued that he was not the driver of the vehicle. The jury convicted defendant of all charges. On July 18, 2008, defendant was sentenced to over 5 years in the state prison.

People's counsel: David Ayvasian
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5302

Defense counsel: Tomas Requejo
800 E. Ocean Blvd., Ste 105
Long Beach, CA 90802
(213) 910-7963

(5) People v. Ricky Dowell and Jeremy Lewis, Case No. GA069537; Trial dates: May 5 to 14, 2008

Defendants were charged with attempted robbery, assault with a firearm and related charges, along with an allegation that the crimes were committed at the direction of, in association with, or for the benefit of a criminal street gang. The evidence showed that defendant Dowell engaged in a senseless beating of the victim with a firearm and attempted to rob him. The victim, who lived in the

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same neighborhood and has known defendant since he was a child, suffered serious and permanent injuries. Co-defendant Lewis acted as a look-out. A gang expert testified that the crimes were for the benefit of the Crips gang. Following a jury trial, both defendants were convicted of the substantive charges, and the jury found the gang allegation to be true. On July 10, 2008, defendant Dowell was sentenced to 25 years, due in large part to the allegations of personal use of a firearm, the street gang enhancement and the great bodily injury enhancement. On September 24, 2008, defendant Lewis was sentenced to 11 years and 4 months in the state prison, also due to the gang and firearm enhancements.

People's counsel: Fernanda Barreto
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5302

Defense counsel: Tommy Lee
Deputy Alternate Public Defender
Alternate Public Defender's Office
1611 S. Garfield Ave.
Alhambra, CA 91801
(909) 629-6844

John Fischer, Bar Panel
301 E. Colorado Blvd., #514
Pasadena, CA 91101
(626) 795-0605

(6) People v. Josiah Alastair Patterson, GA 069622; Trial dates: March 19-28, 2008

Defendant was charged with two counts of assault with a deadly weapon arising out of an incident at a party in which defendant hit the victim with a shovel, causing head injuries that required multiple staples. Virtually all the witnesses were intoxicated during the incident and their recollections differed significantly. Defendant also took the stand to testify in his own defense. Following a jury trial, defendant was acquitted of all charges.

People's counsel: Byron Beck
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5302

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Defense counsel: Omar Abukura
Los Angeles Criminal Defense APC
8200 Wilshire Blvd., #400
Beverly Hills, CA 90211
(310) 202-6300

(7) People v. John Carpenter, GA066584; Trial dates: October 22-November 6, 2007

Defendant was charged with attempted murder arising out of an incident in a local motel room in which defendant stabbed a paraplegic victim multiple times. Defendant fled the scene while the victim lay bleeding. The evidence showed that the victim may have been invited to defendant's motel room by other people in order to do drugs, although the victim denied that he used any drugs. The victim described the attack as unprovoked and rage-induced. Defendant, however, described the victim as the aggressor, and testified that he vigorously defended himself after the victim attempted to slash his throat in order to rob him. Defendant testified that he fled from the scene because of his criminal history and the fear that the police would discount his version of events. Despite the severity of the victim's injuries, the victim's version was rife with inconsistencies, and the jury found defendant not guilty.

People's counsel: Donna Hollingsworth
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5302

Defense counsel: Eric Stanford
Deputy Public Defender
Public Defender's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5007

(8) People v. Johnny Lieu, GA 066065; Trial dates: February 2007

Defendant was charged with multiple counts of kidnapping to commit robbery, false imprisonment and assault with a firearm. He was a juvenile at the time of the incident and was being tried as an adult. The evidence showed that several individuals wearing dark hooded sweatshirts and handkerchiefs over their faces attempted to rob the victim. The victim fled to his landlord's house at the rear of

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his own residence. Only one robber pursued him. While at the door of his landlord's house, the robber held a gun to the victim's head and demanded that the landlord open the door. Once the landlord complied, the robber forced his way inside, ordered the entire family to the ground, and robbed them. This case presented an interesting issue on the level of asportation required to establish kidnapping. The court denied the motion to dismiss the kidnapping charges, and the defendant was convicted of all counts following a jury trial. Defendant was sentenced to 16 years and 4 months.

People's counsel: Teresa Sullivan
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5302

Defense counsel: Rickard Santweir
1055 E. Colorado Blvd., #310
Pasadena, CA 91106
(626) 449-6504

(9) People v. Val Escatiola, GA 065384; Trial dates: September 7-15, 2006

Defendant was charged with felony stalking and vandalism. The evidence showed that over the course of several months, defendant frightened the victims, who were his neighbors, by pacing in front of their house and watching the victims whenever they came home. On April 12, 2006, defendant raced down the victims' driveway in his car and attempted to break into the victims' vehicle. Defendant also threw a brick through the victims' living room window, where one of them stood about 10 inches away. Later, defendant crashed his car into the victims' garage. A week later, defendant drove down the victims' driveway again, and a man who accompanied defendant attempted to force open the garage. Defendant was convicted following a jury trial of stalking and vandalism. On October 16, 2006, defendant was sentenced to 3 years.

People's counsel: Alice Milrud
Deputy District Attorney
District Attorney's Office
210 W. Temple St.
Los Angeles, CA 90012
(213) 974-3511

Defense counsel: Louise Gulartie
Deputy Alternate Public Defender
Alternate Public Defender's Office

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1611 S. Garfield Ave., Ste 100-C
Alhambra, CA 91801
(626) 308-7074

(10) People v. Cardona and Lario, 4AL05741; Hearing dates: May and June, 2005

Defendants, employees of the City of Monrovia Department of Public Works, were charged with various drug-related offenses. Defendants filed a motion to suppress evidence seized against them. The evidence showed that in the spring of 2004, the Chief of Police for the City of Monrovia initiated an informal investigation based on rumors of drug use and/or sales at the Department of Public Works. Based on the results of the investigation, the Chief of Police decided to install video-surveillance cameras over the defendants' desks in their offices without a warrant. After extensive hearing and argument, the court granted the motion to suppress the workplace search based on defendants' reasonable expectation of privacy in their offices. The decision was affirmed.

People's counsel: Teresa Sullivan
Deputy District Attorney
District Attorney's Office
150 N. Commonwealth Ave.
Alhambra, CA 91801
(626) 308-5302

Defense counsel: William Paparian
272 S. Los Robles Ave.
Pasadena, CA 91101
(626) 795-1750

William Maestas
Alternate Public Defender's Office
101 W. Mission Blvd., Ste 212
Pomona, CA 91766
(626) 962-0659

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

None.

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e. Provide a list of all cases in which certiorari was requested or granted.

None.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

To my knowledge, my decisions have been appealed 11 times to the Court of Appeal. Each decision was affirmed, some with minor modification. I am aware of two appeals that are currently pending.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

None.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

None.

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have not sat by designation on a federal court of appeals.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

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d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

There is no automatic recusal system in my court. I have never been asked by any party or litigant to recuse myself. I would recuse myself if I know one of the parties or litigant well. However, I do not recall this situation ever arising in my court.

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

None.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

None.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I did not serve as a clerk to a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I have not practiced alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

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1991-1994
Musick, Peeler & Garrett
One Wilshire Blvd.
Los Angeles, CA 90017
Associate Attorney

1995-2002
United States Attorney's Office
312 N. Spring Street
Los Angeles, CA 90012
Deputy Chief, General Crimes Section (2000-2002)
Assistant United States Attorney, Organized Crime Strike Force (1999-2000)
Assistant United States Attorney, Public Corruption & Government Fraud Section (1996-1999)
Assistant United States Attorney, General Crimes Section (1995-1996)

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have not served as a mediator or arbitrator in alternative dispute resolution proceedings.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

I began my legal career following graduation from law school in 1991 as an associate attorney in the Litigation Department of Musick, Peeler & Garrett. I practiced civil litigation in various areas, including commercial disputes, intellectual property, and construction defect.

From 1995 to August 2002, I served as an Assistant United States Attorney ("AUSA") with the United States Attorney's Office, Central District of California. I worked in various sections in the Criminal Division. For approximately two years prior to my appointment to the bench, I was as a Deputy Chief with the General Crimes Section, responsible for the training and supervision of all new AUSAs. The General Crimes Section handled a wide variety of cases, including violent crimes, narcotics trafficking, gun cases, and all types of fraud. In addition to training and supervision responsibilities, I frequently served as a "moot court" judge to prepare other AUSAs for oral argument in the Ninth Circuit.

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Prior to my promotion to Deputy Chief, I served for six months in the Organized Crime Strike Force Section, where I handled a Title III wiretap investigation of a Russian organized crime group responsible for the smuggling of sex slaves into the United States from the Ukraine. Prior to that, I served as an AUSA in the Public Corruption and Government Fraud section, specializing in the prosecution of complex fraud matters involving smuggling offenses, immigration fraud, mail and tax fraud, and money laundering. I handled all phases of the prosecution, including leading extensive grand jury investigations, complaints and arrests, indictments, trials, sentencings, appeals before the Ninth Circuit, and post-trial habeas corpus litigation. I was also selected to serve as the Department of Defense ("DOD") Fraud Coordinator, responsible for oversight of all DOD fraud prosecutions in the Central District of California. I met regularly with the managers of all federal agencies responsible for the investigation of DOD fraud, including the FBI, the Defense Criminal Investigative Service ("DCIS"), the NASA Office of the Inspector General, and the Office of Investigations for the Air Force and Navy, in order to plan new prosecution initiatives and coordinate significant investigations and prosecutions. While a member of the Public Corruption and Government Fraud Section, I prosecuted some of the Office's most significant cases. For example, I was co-lead counsel in prosecuting a case that was described by the U.S. Customs' Service as their largest commercial smuggling case. I was also the lead attorney in a multi-agency, two-year undercover investigation that resulted in the first ever conviction in the United States for providing material support and resources to a designated terrorist organization.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

As an Assistant United States Attorney, my client was the United States of America. I specialized in the prosecution of violent crimes, organized crime, narcotics trafficking, gun cases, organized crime, and complex fraud matters.

In private practice, I represented organizations and individuals involved in commercial disputes, intellectual property, and construction defect matters.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

All of my practice as an attorney has been in litigation. In private practice, I appeared in court occasionally. As an Assistant United States Attorney, I appeared in court frequently.

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i. Indicate the percentage of your practice in:
   1. federal courts: 70%
   2. state courts of record: 30%
   3. other courts;
   4. administrative agencies

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 33%
   2. criminal proceedings: 67%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I have tried 10 criminal cases to verdict as an attorney prior to becoming a judge. I was sole counsel representing the United States in seven trials, and co-lead counsel in three long trials.

i. What percentage of these trials were:
   1. jury: 80%
   2. non-jury. 20%

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

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(1) United States v. Perla Nunez, CR 01-145-NM; United States District Court, Central District of California; Honorable Nora M. Manella; 2001

This was a complex health care fraud case that resulted from an extensive grand jury investigation in which numerous witnesses were immunized and hundreds of documents were meticulously analyzed. Defendant, a registered nurse, was the owner of a home health agency called Care Plus Home Health Services, Inc. From approximately 1995 to 1998, defendant also owned or controlled several board and care facilities for primarily Medicare patients. Defendant created and orchestrated a scheme to defraud Medicare, resulting in a loss of millions of dollars. Defendant's sophisticated scheme of kick-backs and false books was calculated to avoid a paper trail. Defendant also concealed claims for non-existent services by creating numerous shell companies. After extensive investigation, defendant pleaded guilty on February 26, 2001 to health care fraud and tax charges, and cooperated with the government in connection with health care fraud perpetrated by other individuals. I was sole counsel for the United States of America

Defense Counsel: Richard Steingard
Sheppard Mullen Richter & Hampton LLP
333 S. Hope Street
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(213) 620-1780

(2) United States v. Sammy Dev, CR 01-224-RSWL; Related cases: United States v. James Yekrang, CR 01-225-CBM, United States v. Fouroozan Tabatabai, CR 01-663-RSWL; United States District Court, Central District of California; Honorable Ronald S.W. Lew (CR 01-224 and CR 01-663); Honorable Consuelo B. Marshall (CR 01-225); 2000 – 2001.

This case involved acceptance of illegal kick-back payments by defendants Yekrang and Tabatabai, employees at Allied Signal, Inc. (now Honeywell, Inc.) a government contractor. Defendant Dev was the owner of Object Foundry, Inc., a software company providing software-related consulting services to Allied Signal on a subcontract basis. Yekrang and Tabatabai accepted illegal payments from Dev in exchange for subcontract awards, contract extensions, and for the approval of inflated labor claims submitted by Dev to Allied Signal. Defendants disguised the illegal payments by funneling the money through various corporate bank accounts and falsely reporting the nature of the payments to the IRS. In less than two years, Dev paid about $250,000 in kickbacks. Defendants Dev and Yekrang pleaded guilty to kick-back and tax charges on April 2 and 9, 2001, respectively. Defendant Tabatabai pleaded guilty to tax evasion on September 21, 2001. These guilty pleas were secured following a one-year grand jury investigation. I was sole counsel for the United States of America.

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(213) 688-0370

Martin Bakst (for defendant James Yekrang)
15760 Ventura Blvd., Floor 16
Encino, CA 91436
(818) 981-1400

David Conn (for defendant Fouroozan Tabatabai)
(deceased)

(3) United States v. Bahram Tabatabai, et al., CR 99-225-CAS; United States District Court, Central District of California; Honorable Christina A. Snyder; 1999

This investigation, dubbed Operation Eastern Approach, was a complex, 2 ½-year undercover operation. I led a team of agents from the FBI, State Department, INS, and LAPD. The investigation led to the arrests of 35 individuals in several countries in 1999, and also resulted in the first successful prosecution in the United States for providing material support and resources to a designated foreign terrorist organization, a violation of Title 18, United States Code, Section 2339B. I was the sole counsel for the government during the two-year investigation. Due to the magnitude and significance of the case, a second prosecutor was assigned to assist me during the take-down phase of the investigation.

The investigation focused on a criminal enterprise run by an individual named Bahram Tabatabai. Tabatabai's operation in Los Angeles assisted foreign clients in filing false applications for U.S. entry visa and asylum status in the United States. These applications were supported by false documents created by numerous independent document producers. These false documents, including identity cards, passports, bank and employment records, were also submitted at various U.S. Embassies or Consulates in numerous countries. As the investigation progressed, it became apparent that this was an international network spanning six states and four countries. Significantly, Tabatabai and others were able to change their clients' identities during the asylum process by changing their names, dates of birth, and if necessary, creating false fingerprint cards. These individuals' identities were changed if they had an arrest record, were previously denied asylum under their true names, or were affiliated with a terrorist or subversive organization. During the "take-down" in March of 1999, I coordinated over 40 searches, arrests and interview teams consisting of more than 250 law enforcement agents. Agents seized more that $2 million in property and cash and confiscated weapons, narcotics, and hundreds of counterfeit identity documents. As a result of this investigation, four additional suspects were arrested in Turkey, Cyprus, and the Netherlands. On October 25, 1999, Tabatabai became the first individual ever in the United States to be convicted of providing material support and resources to a designated foreign terrorist organization.

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He also pleaded guilty to conspiracy to commit visa and asylum fraud. Further, 16 other individuals were indicted and eventually pleaded guilty to various fraud and immigration-related offenses. I was lead counsel for the United States of America

Co-counsel: Kenneth P. White
Brown & White
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(213) 613-9446

Defense counsel: Jerry Kaplan (for defendant Bahram Tabatabai)
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(phone number not available)

Phillip Deitch (for defendant Soraya Karimian)
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(818) 717-0901

John Yzurdiaga (for defendant Mersedeh Mohabber)
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Thomas S. Byrnes (for defendant Tabasom Gabaizadeh)
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David Chesnoff (for defendant Mohsen Arefe)
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T. Louis Palazzo (for defendant Mashid Arefe)
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Alex R. Kessel (for defendant Reza Veiseh)
Law Offices of Alex R. Kessel
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Law Offices of Laura C. Crawford
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(310) 560-4528

Ron Kaye (for defendant Amir Haghighatgoo)
Kaye, McLane & Bednarski LLP
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(626) 844-7660

(4) United States v. Jeffrey James Dennis, et al., CR 98-556-MMM; United States District Court, Central District of California; Honorable Margaret M. Morrow; 1998

In April and May of 1998, defendants committed two armed, take-over style robberies of a Bank of America in Duarte, California. In the first robbery, defendant Hunter guarded the door with a gun while defendant Dennis vaulted over the counter and robbed the merchant teller of approximately $13,000. One month later, defendants returned to the same bank, joined by a third robber. Defendants were more violent during this robbery, forcing a guard and customers to the floor at gunpoint. Defendant Hunter jumped over the counter and robbed all of the tellers. A third robber, who joined them during the second robbery, pleaded guilty prior to trial. Following the jury trial of defendants Hunter and Dennis, during which I handled half the witnesses and the closing and rebuttal arguments, defendants were convicted of conspiracy, armed bank robberies, and using and carrying a firearm during crimes of violence. I was co-lead counsel for the United States of America.

Co-counsel: Anthony Pacheco
Proskauer Rose
2049 Century Park East, Ste 3200
Los Angeles, CA 90067
(310) 284-5647

Defense counsel: Humberto Diaz (for defendant Darren Kevin Hunter)
Deputy Federal Public Defender
Federal Public Defender's Office
321 East Second Street
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Cornell Price (for defendant Jeffrey James Dennis)
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Marcia Brewer (for defendant Brenda Ann Cotton)
400 Corporate Pointe, Suite 800
Culver City, CA 90230
(310) 670-5325

(5) United States v. Johnny Wang, et al., CR 98-455-RAP; United States District Court, Central District of California; Honorable Richard A. Paez; 1997-1999

This case has been described by the U.S. Customs Service as the largest commercial smuggling case ever dismantled in the history of the Customs Service, in which over $100 million worth of goods were smuggled into the United States in less than one year. The duty loss to the government alone was over $10 million. The smuggling scheme was masterminded by Stephen Juang, who operated a Customs-bonded container freight station under various legal entities from approximately 1995 to 1997. Juang used the container freight station to smuggle goods manufactured in China or Hong Kong, including wearing apparel and luggage, subject to quota restrictions and high duty rates, as well as prohibited Asian medicines, into the United States. Juang successfully evaded detection by skillfully manipulating the Customs entry process and filing multiple false documentation describing the goods as cheap, low-duty items not subject to quota restrictions. Moreover, the identities of the actual importers were concealed, and Juang or his co-conspirators falsely listed "shell" corporations he controlled as the importers in order to maintain control over the shipments. Juang was paid millions of dollars for his services by dozens of importers. The paper trail on the individual importers other than Juang was extremely thin because Juang and his employees controlled all the documentation submitted to Customs. Thus, the cases against these individual importers were built mainly on Juang's cooperation. I was primarily responsible for handling Juang's cooperation and conducting his examination during the trials against the two importers who proceeded to trial. The remaining defendants pleaded guilty to smuggling charges. I was co-lead counsel for the United States of America.

Co-counsel: William Carter
Musick Peeler & Garrett LLP
One Wilshire Blvd.
Los Angeles, CA 90017
(213) 629-7863

Defense counsel: Michael Abzug (for defendant Stephen Juang)
Judge, Los Angeles County Superior Court
Metropolitan Courthouse
1945 S. Hill Street
Los Angeles, CA 90007
(213) 744-4073

Alex R. Kessel (for defendant Johnny Wang)
16000 Ventura Boulevard, Suite 1208

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Ed Robinson (for defendant Won Chi Lu, aka Frank Lu)
21515 Hawthorne Boulevard, Ste 665
Torrance, CA 90503
(310) 316-9333

David Reed (for defendant Tommy Chen)
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Los Angeles, CA 90010
(310) 854-5246

(6) United States v. Ken Lee Lam, CR 99-454-RAP; United States District Court, Central District of California; Honorable Richard A. Paez; 1999

This was a spin-off investigation of the prosecution described above. Defendant was a large New York-based importer of wearing apparel manufactured in China. Defendant conspired with Juang to smuggle defendant's goods into the United States. Defendant paid Juang a set fee per container to handle the importation and transportation of about 52 shipments and to file fraudulent documents with the Customs Service. In a two-year period, defendant avoided paying over $2 million in duties and saved millions more in quota fees. Following a 13-day jury trial, defendant was convicted on all counts. I was co-lead counsel for the United States of America.

Co-counsel: William Carter
Musick Peeler & Garrett LLP
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Los Angeles, CA 90017
(213) 629-7863

Defense Counsel: Joseph Vodnoy
316 West Second St., Ste 1200
Los Angeles, CA 90012
(213) 893-7500

(7) United States v. Sergio Glushankoff, CR 99-109-SVW; United States District Court, Central District of California; Honorable Stephen V. Wilson; 1995 - 1999

This investigation focused on the Foreign Trade Zone ("FTZ"), set up to facilitate international commerce. Defendant and numerous co-conspirators smuggled millions of dollars of textiles from China into the United States through the port of entry in Long Beach and Los Angeles. Defendant transported the goods to Laredo, Texas, and filed documents with the U.S. Customs Service showing that the shipments were purportedly

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exported to Mexico. (There is no duty assessed, and no quota restrictions apply, to goods that merely transit through the United States.) Once the goods were inspected at the Texas-Mexican border, numerous co-conspirators in Texas diverted the goods back to Los Angeles. Defendant's co-conspirators created false bills of lading and other documents in order to conceal the scheme. The fraud was difficult to detect because the Customs documents appeared legitimate. However, through the use of undercover agents and extensive surveillance for nine months, agents tracked the connection to the border in Laredo. Nevertheless, it was difficult to connect defendant to the fraud. As a result, I spent considerable effort securing the cooperation of defendant's co-conspirators in Laredo in order to build a case against defendant. Defendant eventually pleaded guilty to smuggling and tax charges. I also prosecuted two co-conspirators in Laredo for their participation in the scheme. They pleaded guilty and were sentenced in Texas. I was sole counsel for the United States of America.

Defense counsel: Thomas Campbell
Newell, Campbell & Roche
520 S. Grand Avenue, Suite 390
Los Angeles, CA 90071
(213) 622-9444

(8) United States v. Samuel Ehi Osakue, CR 96-431-R; United States District Court, Central District of California; Honorable Manuel L. Real; 1996

Defendant, a law student at Hastings Law School in San Francisco, fraudulently obtained a United States passport in 1989 by submitting a fraudulent birth certificate. Four years later, an investigation of defendant's brother, who was the main suspect in a major Nigerian credit card fraud ring, led to a search of the home defendant shared with his brother. Defendant presented the passport as proof of his identity. The evidence seized from defendant's home also connected him to other illegal activities. Through circumstantial evidence, including inconsistencies between defendant's passport application, his school records, and his brother's records, I proved at trial that defendant applied for a passport in a false identity. Defendant was convicted by the jury and became a fugitive while his appeal was pending in the Ninth Circuit Court of Appeal. I was sole counsel for the United States of America.

Defense counsel: Derek Li
Equal Employment Opportunity Commission
255 E. Temple St., 4th Fl.
Los Angeles, CA 90012
(213) 894-1077

(9) United States v. Nelson Garcia Orjuela, et al., CR 95-11-WJR; United States District Court, Central District of California; Honorable William J. Rea; 1995

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This investigation focused on a cocaine trafficking organization headed by three individuals, Orjuela, Posso, and Silva. The organization also included at least three other accomplices. The investigation relied heavily on wiretap interception of telephones and paging devices connected to defendants' organization, and extensive surveillance of defendants' activities. Defendants were planning to distribute multiple shipments of cocaine to wholesale distributors throughout the Los Angeles and other areas. Defendants were arrested when the organization received a shipment of approximately 50 kilograms of cocaine and attempted to deliver it to a distributor. After extensive pre-trial preparation, defendants pleaded guilty to conspiracy and drug trafficking charges. Defendants pleaded guilty in 1995 on the eve of trial. I was co-counsel for the United States of America.

Co-counsel: Larry Cho
Judge, Los Angeles Superior Court
1725 Main St.
San Monica, CA 90401
(310) 260-1854

Defense counsel: Richard Callahan (for defendant Nelson Garcia Orjuela)
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Robin R. Scroggie (for defendant Maria Posso)
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(213) 620-9576

John Yzurdiaga (for defendant Jose Ignacio Silva)
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(213) 622-9262

Gregory Nicolaysen (for defendant Carlos Ortiz Calle)
16000 Ventura Boulevard, Suite 500
Encino, CA 91436
(818) 998-2706

Phillip Trevino (for defendant Pablo Emilio Bedoya)
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Nadine Hettle (for defendant Alvaro Quintero)
Office of the Federal Public Defender
321 East 2nd Street

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(213) 894-2854

W. Michael Mayock (for defendant Gilbert Longoria)
65 N. Raymond Ave., # 235
Pasadena, CA 91103
(626) 405-1465

(10) In re Extradition of Duane Allen Vachon, SACV 96-672-GLT (EE); United States District Court, Central District of California; Honorable Elgin Edwards, United States Magistrate Judge; 1996 – 1997.

Defendant fled to the United States in 1994 after kidnapping and torturing two female victims in Australia. Defendant lured the victims to a remote cabin, where he and an accomplice hung the victims up by their hands and repeatedly tortured and assaulted them. I filed an extradition arrest warrant and litigated defendant's extradition proceedings. Defendant vigorously fought extradition, challenging every stage of the proceedings, including his detention based on several serious medical conditions and the probable cause for each charge against him. I extensively researched California law in order to prepare the government's response. After a hearing, the court certified that defendant was extraditable. Defendant then challenged the court's findings. When he lost, defendant filed a petition for writ of habeas corpus, and subsequently, a motion for stay pending appeal in the Ninth Circuit Court of Appeals. After his remedies were exhausted, defendant was extradited nearly a year after he was arrested. I served as sole counsel for the United States of America.

Defense Counsel: Neison Marks
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Fort Lauderdale, FL 33301
(954) 356-7436

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

None, other than the matters described above.

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19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

    None.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

    None.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    No, other than continuing participation in various bar organizations as a mentor and speaker.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report.

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

       My husband is employed as an Assistant United States Attorney in the Asset Forfeiture Section of the United States Attorney's Office, and this presents an ongoing potential conflict of interest. Obviously, I will ensure that I am not

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assigned any cases handled by him. I will also discuss with the United States Attorney's Office appropriate procedures to "wall off" my husband, if necessary, from cases pending in my court.

I have no financial arrangements that will likely present any potential conflict-of-interest. I have served in the public sector for nearly all of my professional life, and neither my husband nor I have any business arrangements or interests that may pose a conflict-of- interest.

b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

To the extent that any conflict issue arises during my service, I will follow my usual practice of analyzing each situation to determine whether the issue calls for disclosure or recusal. In all cases, I will follow the Code of Conduct for United States Judges.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

In law school, I began to volunteer at the Asian Pacific American Legal Center in Los Angeles. I met with indigent clients of APALC in order to conduct intake interviews. After I began practicing law, I consistently made time to provide free legal services. While in private practice, I asked my firm to authorize me to handle pro bono matters in the wake of the 1992 riots in Los Angeles, representing indigent Vietnamese speaking clients in small business disputes. As an attorney, I was always active in various Asian American bar associations, including the Asian Pacific American Bar Association, the Japanese American Bar Association, and the Southern California Chinese Lawyers Association. These organizations have annual Law Days in their respective communities. I frequently participated in Law Days organized by these associations, where I met with indigent clients and gave them free legal advice on immigration, landlord-tenant and business disputes. From approximately 1997 to 2002, after I joined the U.S. Attorney's Office, I handled adoption cases through Public Counsel's Adoptions Program, representing foster parents in adoption proceedings to adopt their foster children. I handled the filings and appear in court on behalf of these parents. I also frequently volunteered to speak at various community and student-sponsored forums on issues of concern to the Asian Pacific American communities.

Since becoming a judge, I can no longer provide free legal services. However, I am still active in bar activities, particularly in the Asian Pacific American community. I support these associations by attending their events and making myself available as a panel speaker and a mentor. I spend a substantial amount of time mentoring minority attorneys, both through formal bar association channels as well as on my own. I frequently meet

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with young attorneys in small groups or one-on-one to provide guidance and support. I am acutely aware that, as the first Vietnamese American woman judge in the State of California, I am looked upon as a role model, and I make an effort to be available in whatever way I can to my community.

Further, my children both attend public school where resources are limited. As such, I try and participate by volunteering as many hours as I can. I have for several years frequently served as one of the "Room Parents" for my children's classes and help coordinate activities for the teachers. Prior to law school, I spent about eight months serving as a substitute teacher in the Los Angeles Unified School District, working in economically depressed neighborhoods. Throughout college, I was active in the In-School Scouting program. I spent time weekly in underprivileged elementary school classroom to teach values such as honesty, friendship, tolerance and teamwork through various songs and activities. I also worked as a writing instructor in my college's writing assistance clinic and helped mostly minority students improve their essay writing skills.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

Senator Feinstein has established a bipartisan Judicial Advisory Committee for screening, interviewing and recommending candidates to the United States District Court, Central District of California. This Committee is comprised of several prominent local attorneys and former judges, and is chaired by Holly Fujie, the current President to the State Bar of California. Senator Feinstein's statewide Chair, David Casey, oversees all of the committees for each district.

On March 17, 2009, I interviewed with the local Committee. The Committee recommended me to David Casey. On April 14, 2009, I interviewed with Mr. Casey. On May 27, 2009, I was contacted by staff from the Department of Justice regarding the nomination process and paperwork. I have had numerous subsequent conversations with staff from the Department concerning pre-nomination paperwork. I interviewed with Associate Attorney General Thomas Perrelli and other Department of Justice personnel and a White House Counsel representative on July 15, 2009. My nomination was submitted to the Senate on July 31, 2009.

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b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

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Senator FRANKEN. Absolutely. Thank you.

Judge Chen, please make an opening statement, if you would like, and also introduce your family members who are here.

STATEMENT OF HON. EDWARD MILTON CHEN, TO BE DISTRICT JUDGE FOR THE NORTHERN DISTRICT OF CALIFORNIA

Judge CHEN. Thank you, Mr. Chairman. I do not have a formal opening statement, but I, too, would join in thanking, first of all, both of my home-State Senators, Senator Feinstein and Senator Boxer, for their support and kind words, and particularly Senator Feinstein for making the recommendation to the President. And, of course, I want to thank President Obama for placing his trust and confidence in me in making that nomination, and to you, Mr. Chairman, in chairing this meeting and to Ranking Member Sessions for participating in today's session. So thank you very much.

I am joined by a portion of my family today. With me from California is my wife of 29 years, Janet; my daughter of 18 years, Tara; my brother-in-law, Laurence Lee; my aunt and uncle who have traveled all this way to be with me, Robert and Ellen Wong. And I am especially proud and privileged to have with me my staff who decided to come here, knowing that I am completely useless without them, so they decided to support me, and I appreciate that: Leni Doyle, my judicial secretary; Betty Lee, my courtroom deputy; and Shao-Bai Wu, my law clerk.

And if I may, I just want to say a brief word about three people who are not here today.

Senator FRANKEN. Well, I want to welcome your family, and I know exactly how you feel about your staff.

[Laughter.]

Judge CHEN. Thank you. I want to mention my son, Luke, who, because of his special needs, is not able to make the cross-country trip. But he is here in spirit, and I want to state for the record that today is his birthday, and so I want to——

Senator FRANKEN. Happy birthday, Luke.

Judge CHEN. Thank you. And I also finally would like to pay tribute to my parents. My father came to this country in the 1920's on a visa with nothing more than $20 in his pocket and a suitcase full of consigned goods, looking to pursue the American dream. My mother came in 1939 from war-torn China to be reunited with her family in San Antonio, Texas, from whom she had been separated for nearly 20 years. My father worked very hard to provide financial security for my family, and when he became ill and passed away when I was very young, my mother was tasked with the burden of raising four boys and running the family business. And although neither of them lived to see this day, their courage, their perseverance, their dedication to family, and commitment to the community resides with me and continues to inspire me.

Thank you, Mr. Chairman.

[The prepared statement of Judge Chen appears as a submission for the record.]

[The biographical information of Judge Chen follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Edward Milton Chen

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Northern District of California

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: United States District Court
   450 Golden Gate Avenue, 15th Floor
   San Francisco, CA 94102

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1953; Oakland, California.

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1976 – 1979, University of California Boalt Hall School of Law (now known as University of California, Berkeley School of Law); J.D.; June, 1979

   1971 – 1975, University of California, Berkeley; A.B., June, 1975

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

4/01 to current
United States District Court for the Northern District of California
450 Golden Gate Avenue, 15th Floor
San Francisco, CA 94102
United States Magistrate Judge

9/85 to 4/01
American Civil Liberties Union Foundation of Northern California
39 Drumm Street
San Francisco, CA 94111
Staff Attorney

12/82 to 9/85
Coblentz Patch Duffy & Bass
(formerly Jacob Sills & Coblentz, and Coblentz Cahen McCabe & Breyer)
One Ferry Building, Suite 200
San Francisco, CA 94111
Litigation Associate

6/81 to 8/82
United States Court of Appeals for the Ninth Circuit
Chief Circuit Judge James R. Browning
316 James R. Browning United States Courthouse
95 Seventh Street
San Francisco, CA 94103
Law Clerk

6/80 to 5/81
Asian Law Caucus
Minami Lew & Tamaki LLP
360 Post Street, 8th Floor
San Francisco, CA 94108
Volunteer Attorney

6/79 to 4/80
United States District Court for the Northern District of California
U.S. District Judge Charles B. Renfrew
450 Golden Gate Avenue, 15th Floor
San Francisco, CA 94102
Law Clerk

9/78 to 11/78
California Supreme Court
Justice Matthew O. Tobriner
Judicial Extern

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6/78 to 8/78
Employment Law Center of the Legal Aid Society of San Francisco
600 Harrison St # 120
San Francisco, CA 94107
Law Clerk

6/77 to 8/77
San Francisco Neighborhood Legal Assistance Foundation
225 Bush St
San Francisco, CA 94104-4207
Law Clerk
Welfare Advocate (9/75 – 5/76)

9/75 – 5/76
University of California, Berkeley
Department of Asian American Studies
506 Barrows Hall #2570
Berkeley, CA 94720
Teaching Assistant

6/75 to 8/75
U.S. Department of Justice
Civil Rights Division, Appellate Section
950 Pennsylvania Avenue, NW
Washington, DC 20530
Summer Intern

Periodically, from 1975 to present
Board Member, Manager, Desk Clerk
Rose T.Y. Chen Holiday Lodge Motel,
Rose T.Y. Chen Administrative Trust, and
Rose T.Y. Chen Charitable Foundation

1992 to 2000
Board Member
Chinese Community Housing Corporation
1525 Grant Avenue
San Francisco, CA 94133

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I have not served in the military.

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8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

Judge of the Year, San Francisco Barristers Club, 2007

United States Attorney's Office, Asian Pacific American Heritage Month, Recognition, May 2005

Bay Area Asian Pacific American Law Students Association Conference, Building Bridges Lifetime Achievement Award, February 2005

Asian Pacific Bar Association of the Silicon Valley, Recognition, October 2004

United States Department of Justice, Asian Pacific American Heritage Month, Recognition, May 2003

Chinese Consolidated Benevolent Association & Chinese Consolidated Women's Association, Recognition, October 2002

California Law Review, Alumnus of the Year, 2002

Trailblazer Award, National Asian Pacific American Bar Association, 2001

Asian American Bar Association of the Greater Bay Area, Recognition, 2001

The Impact Fund, Recognition, April 2001

National Japanese American Historical Society, Day of Remembrance, Recognition, February 1999

Asian American Bar Association of the Greater Bay Area, Joe Morozumi Exceptional Legal Advocacy Award, 1998

Minority Bar Coalition Unity Award, November 1993

Order of the Coif, Boalt Hall, 1979

California Law Review, Associate Editor (top 5% of first year class selected), 1977

American Jurisprudence Awards in Contracts and Civil Procedure, 1977

Graduated with Great Distinction in General Scholarship, University of California, Berkeley, 1975

Phi Beta Kappa (Junior Year), University of California, Berkeley, 1973

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9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

Ninth Circuit Pro Se Implementation Committee, Chair, 2005 – present
Ninth Circuit Task Force on Self-Represented Litigants
California Commission on Access to Justice, Federal Courts Committee;
Chair, 2004 – present
Federal Magistrate Judges Association
International Committee of the Federal Magistrate Judges Association
Diversity Committee of Federal Magistrate Judges Association
Edward J. McFetridge American Inn of Court
American Bar Association
Bar Association of San Francisco
Barristers Club
Asian American Bar Association of the Greater Bay Area
National Asian Pacific American Bar Association
California State Bar, Human Rights Committee, Member, 1987 - 1989
Asian American Bar Association of the Greater Bay Area
Board of Directors, 1988 - 1990
Ninth Judicial Circuit Historical Society

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

Admitted to California State Bar in November 1980.

No lapses in membership until appointed as Magistrate Judge in April 2001. Under the Constitution of California, a person serving as a judge of a court of record is not considered to be a member of the State Bar while in office. See California Constitution Article 6, § 9.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

California State Bar (1980)
United States District Court for the Northern District of California (1980)
United States District Court for the Central District of California (1982)
United States District Court for the District of Arizona (1983)
United States Court of Appeals for the Ninth Circuit (1982)
United States Court of Appeals for the Fifth Circuit (1995)
Supreme Court of the United States (1985)

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There have been no lapses in membership until appointed as Magistrate Judge in April 2001.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Academy of Science (circa 1995 – present)
SF Jazz (circa 2003 – present)
Asian Art Museum (circa 2003 – present)

Past Member:
Smithsonian Institution (National Member thru their magazine subscription, years unknown);
KQED (January 1980 – 2009, off and on);
Chabot Science and Space Center (years unknown);
American Civil Liberties Union (circa 1985 – 2001);
Sierra Club (circa 1980 – 2001);
NAACP (circa 1980 – 2001);
Amnesty International (years unknown);
San Francisco Zoo (circa 1993 – 2000).

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

I am not a member, nor have I ever been a member, of any such organization.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

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"The Judiciary, Diversity, and Justice for All," 91 *California Law Review* 1109 (2003).

"Statement on the Civil Liberties Implication of Official English Legislation Before the U.S. Senate Committee on Governmental Affairs," in *Language Ideologies*, Vol. 2 (R. Gonzalez, ed.) (Nat'l Council of Teachers of English) (2001).

Naming Names – Racism's Double Standard, ACLU of N. Cal., June 18, 1999, *at* http://www.aclunc.org/news/opinions/naming_names_-_racism's_double_standard.shtml.

"Labor & Immigration: Examining the Intersection," Speech: Labor Law & Language Discrimination, Asian Law Journal Symposium on Law & Labor, 6 *Asian Law Journal* 223 (May 1999).

Recent Developments: "Introduction to Petition to U.S. Commission on Civil Rights," 5 *Asian Law Journal* 353 (May 1998).

"Garcia v. Spun Steak Co.: Speak English-Only Rules and The Demise of Workplace Pluralism," 1 *Asian Law Journal* 155 (1994).

"Language Rights in the Private Sector," in *Language Loyalties: A Sourcebook on the Official English Controversy* (J. Crawford, ed.) (University of Chicago Press) (1992).

Preface to "The University of California Hate Speech Policy: A Good Heart in Ill-Fitting Garb," 12 *Hastings Communications and Entertainment Law Journal*, 593 (1990).

"Defending Malicious Prosecution Suits By Police Officers Against Civil Rights Plaintiffs" in *Civil Rights Litigation and Attorney Fees Annual Handbook*, Vol. Six (Clark Boardman 1990) (co-author).

"Common Law Privacy: A Limit On An Employer's Power to Test for Drugs," 12 *George Mason Law Review* 651 (1990) (co-author).

Op-Ed Piece, "Today's Immigrants Learn English as Fast as Yesterday's Did," *New York Times* (September 29, 1989).

"Challenging Employee Drug Testing: Useful Principles for Privacy Litigation" in *Civil Rights Litigation and Attorney Fee Annual Handbook*, Vol. IV (Clark Boardman 1988) (co-author).

"The 'English-Only' Movement" in *East Wind*, Vol. VI, No. 1 (Spr.-Sum., 1987) (co-author).

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Comment, "The Case for Minority Participation in Reverse Discrimination Litigation," 67 *California Law Review* 191 (1979).

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

I served on the California State Bar Human Rights Committee between 1987 – 1989. The Committee reviewed various draft state legislation affecting human rights and the administration of justice. I believe those reports were reviewed by the State Bar, and if approved, were sent to the appropriate committee of the California legislature. The reports were drafted though a collaborative effort and not individually authored. I do not have access to those reports.

I served on the Ninth Circuit's Task Force on Self-Represented Litigants which rendered a report to the circuit in 2005.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

"Statement on the Civil Liberties Implication of Official English Legislation Before the U.S. Senate Committee on Governmental Affairs," in *Language Ideologies*, Vol. 2 (R. Gonzalez, ed.) (Nat'l Council of Teachers of English) (2001). Identical testimony was given before the House Subcommittee on Early Childhood, Youth and Families of the Committee on Economic and Educational Opportunities. This testimony was given in response to an invitation to testify about proposals to make English the official language of the United States.

Recent Developments: "Introduction to Petition to U.S. Commission on Civil Rights," 5 *Asian Law Journal* 353 (May 1998). The petition was filed on behalf of Asian American groups and leaders objecting to racially discriminatory practices and stereotypes made by elements of both major political parties as well as independent third party candidate and the media.

Also, I have testified before the United States Equal Employment Opportunity Commission (EEOC) on language and national origin discrimination and before the California State Senate and Assembly on language discrimination and employee privacy. I do not have those transcripts.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions,

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conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

Prior to taking the bench, I have given scores of speeches, lectures, panel discussions and presentations on a variety of issues. The subjects covered employee privacy rights and mandatory drug testing, employment discrimination laws, racial discrimination and profiling, language-based and national origin discrimination, and diversity. These speeches and presentations (between 1985 – 2001) were given to high school, college and law school students, conferences (such as annual conferences held by the ACLU, annual conference of the National Hispanic Bar Association, annual conference of the National Asian Pacific American Law Students' Association), seminars sponsored by the regional office of the Equal Employment Opportunity Commission, bar associations (such as the Bar Association of San Francisco and the Employment Section of the California State Bar), continuing education courses, annual conferences of the District Court for the Northern District of California, and labor and community groups (such as local unions). I do not have the text or notes from these speeches. However, I have a record of the following presentations at seminars, workshops, lectures, and conferences made while I was a practicing attorney:

New College of the Law, Class on Racism and the Law, 2/25/95, San Francisco, CA.

Harvard APALSA (Asian Pacific American Law Students Association) Annual Conference, Asian Pacific American Layers in Coalition, Panel on Public Interest Coalition Building and Litigation, 3/4/95, Cambridge, MA.

Equal Employment Opportunity Commission – New Approaches to Addressing National Origin Discrimination, 3/14/95, Washington, DC.

New Jersey State Bar Association – the California "Civil Rights" Initiative, 11/9/95, Cannot recollect location.

Chinese for Affirmative Action Conference on Civil Rights – Affirmative Action, Race Conscious Remedies and the Asian American Community, 5/3/96, San Francisco, CA.

Organization of Chinese Americans Annual National Convention – Asian Pacific Americans and Civil Rights Laws, 6/29/96, San Francisco, CA.

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The Bench/Bar Media Committee of the Bar Association of San Francisco – The Constitutionality of Proposition 209, 1/22/97, San Francisco, CA.

National ACLU Biennial Conference – Legal Challenges to the Federal Welfare Reform Act, 1/7/97, Cannot recollect location.

Harvard APALSA (Asian Pacific American Law Students Association) Annual Conference – Panel on Language and National Origin Discrimination, 3/8/97, Panelist, Cambridge, MA.

National Conference of Women's Bar Associations – the Aftermath of Proposition 209, 8/1/97, Cannot recollect location.

Equal Employment Opportunity Commission (Region IX) Technical Assistance Program – Principles of Language and National Origin Discrimination, 9/17/97, Washington, DC.

U.C. Davis School of Law, Panel on Constitutionality of Proposition 209, 10/23/97, Panelist, Davis, CA.

Language Minority Rights Institute – the Unz Initiative and Language Rights Law, 3/27/98, San Francisco Bay Area, CA.

National Employment Lawyers Association Convention – the Legal Status of Affirmative Action, 6/25/98, San Francisco Bay Area, CA.

Asian Pacific American Systemwide Alliance Annual Dinner – The Consequences of Proposition 209, 9/19/98, San Francisco Bay Area, CA.

ACLU of Northern California Annual Conference – Language Discrimination and Civil Liberties, 9/19/98, San Francisco Bay Area, CA.

Golden Gate Law School Public Interest Clinic – Presentation on ACLU Litigation Strategies and Procedures, 9/29/98, Speaker, San Francisco, CA.

Language Rights Project MCLE Seminar – Legal Principles of Language Rights Litigation, 11/20/98, San Francisco Bay Area, CA.

National Asian Pacific American Bar Association Convention – Affirmative Action and the Asian Pacific American Community, 11/98, Cannot recollect location.

University of California, Berkeley School of Law, Boalt Hall Asian Law Journal Symposium on the Intersectionality of Labor and Immigration – Panel on Workers' Rights: Empowering Undocumented and Underprivileged Immigrants (Lectured on Language Discrimination), 2/6/99, Panelist, Berkeley, CA.

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Asian Pacific American in Higher Education – Redefining Merit and Race Relations after Prop. 209, 3/12/99, Cannot recollect location.

Northern District of California Judicial Conference – New Trends in Civil Rights Litigation, 4/24/99, San Francisco Bay Area, CA.

National Lawyers' Guild Annual Conference – Issues in Civil Rights Litigation, 10/15/99, San Francisco Bay Area, CA.

National Association of Legal Defenders Association Annual Conference – Issues in National Origin Discrimination, 11/13/99, Cannot recollect location.

After taking the bench I have given presentations, speeches and panel discussions on a wide range of topics including electronic discovery, employment law, intellectual property, diversity in the judiciary, alternative dispute resolution and case management, and Asian American legal history. Below is a listing of the speeches/presentations. Except where noted, outlines and notes of the speeches and presentations are provided

Naturalization speeches, (while on criminal duty, speech given on various dates (twice annually) to those becoming American citizens at Masonic Auditorium), 2001 to approximately 2005, San Francisco, CA.

University of San Francisco School of Law, Public Interest Law Program, Public Interest Clearinghouse Commencement, 5/2/01, Speaker, San Francisco, CA.

Asian Pacific American Heritage Week, 5/31/01, (speech given to U.S. Attorney's Office), Speaker, San Francisco, CA.

University of San Francisco School of Law, Alternative Law Day, 9/22/01, Speaker, San Francisco, CA.

NAPALSA (National Asian Pacific American Law Student Association) Conference, 11/11/01, Speaker, Houston, TX.

Stanford Law School Presentation, 11/14/01, Speaker, Palo Alto, CA.

NAPABA (National Asian Pacific American Bar Association), Trailblazer Award, 11/16/01, Award Recipient. No notes/speech for this event. I conveyed my expression of gratitude for the award.

AABA (Asian American Bar Association of the Greater Bay Area), Annual Holiday Party, 12/13/01, Speaker, San Francisco, CA.

ABA's (American Bar Association) Equal Employment Opportunity Committee's Midwinter Meeting, Panelist, 3/21/02, San Diego, CA.

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AABA Installation Dinner, 3/22/02, Speaker, San Francisco, CA.
University of California, Berkeley School of Law, California Law Review Annual Banquet, Speaker and Honoree, 4/11/02, Berkeley, CA.

Filipino American Bar Association Annual Dinner, 4/13/02, Speaker, South San Francisco, CA.

Santa Clara University School of Law, Public Interest and Social Justice Graduation, 5/16/02, Speaker, Santa Clara, CA.

Law Day at U.S. District Court, 5/29/02, San Francisco, CA.

General Accounting Office Diversity Month, 6/14/02, Speaker, San Francisco, CA.

Introduction of Honoree Dale Minami at Employment Law Center's Annual Luncheon, 6/18/02, San Francisco, CA.

Brown Bag Lunch with Externs of U.S. District Court, U.S. Attorney's Office, Federal Public Defender's Office, 7/1/02, Speaker, San Francisco, CA.

U.S. District Court Retreat – Pro Bono Counsel, 10/23/02, Panelist, Sonoma, CA.

India trip, legal presentations on ADR (Alternative Dispute Resolution) and case management, sponsored by ISDLS (The Institute for the Study and Development of Legal Systems), 1/21/03 – 1/31/03, Panelist/Speaker, Mumbai, Delhi, and Ahmadabad, India. No notes/speech for these programs. The subject matters were case management and ADR (alternative dispute resolution).

University of California, Berkeley School of Law, SABA (Southeast Asian Bar Association) Conference, 2/15/03, Speaker, San Francisco, CA.

University of California, Davis School of Law, APALSA (Asian Pacific American Law Students Association) Conference, 2/24/03, Speaker, Davis, CA.

Harvard APALSA (Asian Pacific American Law Students Association) Conference, 3/1/03, Speaker, Cambridge, MA.

Northern District Judicial Conference, Affirmative Action Panel, 5/4/03, Panelist, Santa Rosa, CA.

Induction of Honorable John True, Superior Court Judge, 11/14/03, Speaker, Oakland, CA.

AABA Civil Rights Committee, 2/19/04, Panelist, San Francisco, CA.

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University of California, Berkeley School of Law, Externship Program, 3/15/04, Speaker, Berkeley, CA.

BASF (Bar Association of San Francisco) – Pro Bono Program Roundtable Discussion, 3/25/04, Panelist, San Francisco, CA.

University of San Francisco School of Law, Academic Support Program graduation, 5/22/04, Speaker, San Francisco, CA.

University of California Hastings College of the Law, APALSA (Asian Pacific American Law Students Association) Dinner, 5/22/04, Speaker, San Francisco, CA.

Stanford University School of Law, Diversity Panel Program, 9/27/04, Panelist, Palo Alto, CA.

APBA-SV (Asian Pacific Bar Association of Silicon Valley) Annual Dinner, 10/15/04, Speaker, Cupertino, CA.

Malaysia trip, legal presentations on I.P. enforcement, ADR, and case management, sponsored by ISDLS (The Institute for the Study and Development of Legal Systems), 11/28/04 – 12/6/04, Panelist/Speaker, Kuala Lumpur, Malaysia.

Annual Bay Area APALSA (Asian Pacific American Law Students Association) Conference – Santa Clara University School of Law, 2/5/05, Panelist, Santa Clara, CA. No notes/speech for this event. The subject matter was transition to the bench and the importance of diversity and the judiciary.

Federal Bar Association "Brown Bag Lunch" Speaker Series, 4/12/05, Speaker, San Francisco, CA.

Department of Education, OCI, Asian Pacific Islander Month – Federal Employees, 5/18/05, Speaker, San Francisco, CA.

University of California Hastings College of the Law, Public Interest Graduation, 5/20/05, Speaker, San Francisco, CA.

U.S. Attorney's Office, Asian Pacific Heritage Month, 5/26/05, Speaker, San Francisco, CA.

"Brown Bag Lunch" session, Federal Public Defender, with court externs, 7/29/05, Speaker, San Francisco, CA. No notes/speech for this event, as this was an informal meeting to discuss the practice of federal criminal law.

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California State Bar Convention, Diversity Award Reception, 9/10/05, Speaker, San Diego, CA.

Jordanian Delegation (via ISDLS with Steve Mayo) visiting U.S. District Court, 10/14/05, Speaker, San Francisco, CA.

BASF (Bar Association of San Francisco) Conference on Diversity in the Bay Area Legal Community, "The Importance of Building the Pipeline," 10/28/05, Panelist, San Francisco, CA.

Edward J. McFetridge American Inn of Court, Group Presentation, 12/14/05, Panelist, San Francisco, CA.

University of San Francisco School of Law, "Judge's Panel," 2/4/06, Panelist, San Francisco, CA. No notes/speech for this event. The subject matter was legal career and tips in the practice of law and appearances in court.

Annual Bay Area APALSA (Asian Pacific American Law Students Association) Conference, 2/4/06, Panelist, San Francisco, CA. No notes/speech for this event, but the subject matter was Asian Americans and the law.

Northern District Judicial Conference, "Litigating Morality in an Era of Secrecy" Panel, 4/28/06 – 4/30/06, Panelist, Santa Cruz, CA.

Operation Protect and Defend Annual Dinner, 5/4/06, Speaker, Sacramento, CA.

NELA (National Employment Lawyers Association) Convention, 6/25/06, Panelist, San Francisco, CA.

University of California, Berkeley School of Law, Thelton Henderson Center for Social Justice Gala, Introduction of Award Recipient, 9/15/06, Speaker, San Francisco, CA.

BASF's (Bar Association of San Francisco) Litigation Section Program – "The 2006 Electronic Discovery Amendments to the Federal Rules of Civil Procedure" MCLE Program, 11/8/06, Panelist, San Francisco, CA.

Federal Circuit Bar Association – Patent Law Conference at UC Berkeley, 2/16/07, Panelist, Berkeley, CA.

University of California, Berkeley School of Law, American Constitution Society, 3/6/07, Speaker, Berkeley, CA.

University of California Hastings College of the Law, "Clerkship Committee Panel, 3/6/07, Panelist, San Francisco, CA. No notes/speech for this event, but the subject matter was the value of judicial clerkships.

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APAHE (Asian Pacific Americans in Higher Education) Convention, 5/4/07, Speaker, Oakland, CA.

Chinese Historical Society of America and Northern District Historical Society Event: Remembering 1882: Fighting for Civil Rights in the Shadow of the Chinese Exclusion Act, 5/9/07, Panelist, San Francisco, CA. No notes/speech for this event. The subject matter was early court decisions affecting Asian Americans.

AABA (Asian American Bar Association of the Greater Bay Area), Asian American Legal History, 5/30/07, Moderator, San Francisco, CA.

California Bar Swearing-in Ceremony, 6/11/07, Speaker, Oakland, CA.

BASF (Bar Association of San Francisco) Barrister's Club Annual Judges Reception, "Judge of the Year" Award, 7/12/07, Speaker, San Francisco, CA.

ABA (American Bar Association) Annual Meeting, "The Anatomy of a Bad Faith Case" Program, 8/11/07, Panelist, San Francisco, CA.

University of California Hastings Law School, Orientation for Incoming Students, 8/13/07, Speaker, San Francisco, CA.

BASF Barristers Club, 10/17/07, Speaker, San Francisco, CA. No notes/speech for this event, but the subject matter was legal careers and tips on the practice of law.

Malaysia trip, training Malaysian judges on mediation, sponsored by the government of Malaysia, 11/30/07 – 12/7/07, Panelist/Speaker, Kuala Lumpur, Malaysia.

ABTL (Association of Business Trial Lawyers), Interview with Major Tom Fleener, 5/27/08, Moderator, Palo Alto, CA.

BASF (Bar Association of San Francisco) Pro Bono Committee, Presentation, 9/11/08, Panelist, San Francisco, CA. Although there are no notes, I spoke about the Court's civil pro bono program.

Ninth Circuit Law Clerk Orientation, "Wisdom from the Trial Court," 9/24/08, Panelist, San Francisco, CA.

Sacramento Unity Bar Annual Dinner, Speaker, 10/30/08, Sacramento, CA.

University of San Francisco Law School, Swearing-in for USF Alumni/New Attorneys, 12/5/08, Speaker, San Francisco, CA.

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U.S. Coast Guard, Asian Heritage Month, "Asian American/Pacific Island Observance: Leadership to Meet the Challenges of a Changing World," 5/28/09, Panelist, Alameda, CA.

Breakthrough San Francisco at SF Day School, "Career Day," 7/10/09, Speaker, San Francisco, CA. No notes/speech for this event, but I hosted a group of elementary and middle school students in my courtroom and talked to them about the judicial system and the legal profession.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

Below is a list of the clippings that I found through the Internet.
Amanda Bronstad, *Federal Courts React to Tide of Pro Se Litigants*, The National Law Journal, March 9, 2009, *at* http://www.law.com/jsp/article.jsp?id=1202428902779.

Equal Access, Equal Justice: The Federal Pro Bono Project, VLSP Community Advocate Newsletter, June 2005, *at* http://www.maildogmanager.com/page.html?p=000001XDDtjF6PzrUbe205ya8rXUxajQ. (linked from http://www.sfbar.org/volunteer/newsletter.aspx)

What Fred Korematsu Meant to Me, ACLU News (N. Cal.), Spring 2005, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file378_3553.pdf.

Bill Wallace, Kevin Fagan, Joe Garofoli, *Weapons search in San Leandro; Rocket launchers sought in warehouse*, S.F. Chron., A1, Apr. 17, 2004, *at* http://www.sfgate.com/cgi-bin/article.cgi?f=/c/a/2004/04/17/MNGLO66QR71.DTL&type=printable.

Michael R. Triplett, *Judges Counsel Attorneys to Settle Cases, Deal With Confidentiality, Privacy* Concerns, Daily Labor Report No. 57, Page C-1, March 25, 2002, *at* www.bna.com/bnabooks/ababna/eeo/2002/eeo2002mid3.doc/

Donna Domino, *Card Carrying Member: A Former ACLU Counsel Figured He'd Never Make it to the Bench, but He was Wrong*, S.F. Daily Journal, November 27, 2001

Jason Hoppin, *Chen Gives Asian a Voice on the Bench*, The Recorder, May 15, 2001

Ryan Kim, *Asian magistrate is a first in S.F.*, S.F. Chron., Apr. 27, 2001, *at* http://www.sfgate.com/cgi-bin/article.cgi?file=/chronicle/archive/2001/04/27/MNL225010.DTL.

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Maria Shim, *English-Only Workplace Suits Continue to Rise*, , American Lawyer Media, October 18, 2000, *at* http://englishfirst.org/workplace/workplaceacluprop63.htm

Federal Court Strikes Down English-Only Driving Test, ACLU News (N. Cal.), Jan./Feb. 2000, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file169_4424.pdf.

Fired Fresno Workers File Federal Suit for Language Discrimination, ACLU News (N. Cal.), Nov./Dec. 1999, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file439_4423.pdf.

Nursing Rights Workers Win Language Rights Settlement, ACLU News (N. Cal.), July/Aug. 1999, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file603_4421.pdf

Employee Wins $55,000 in Accent Discrimination Complaint, ACLU News (N. Cal.), July/Aug. 1999, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file603_4421.pdf.

Perla Ni, *Accent Discrimination Claim Costs Company $55,000*, Asian Week, June 17-23, 1999, *at* http://asianweek.com/061799/news_settlement.html.

Language Rights Victories in State, Federal Courts, ACLU News (N. Cal.), Mar./Apr. 1999, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file748_4419.pdf.

Court Halts Wilson Plan to End Affirmative Action Programs, ACLU News (N. Cal.), Mar./Apr. 1999, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file748_4419.pdf.

Fresno Manufacturing Workers File Charges Against Company for Termination Based on English Proficiency, ACLU of N. Cal., Mar. 18, 1999, *at* http://www.aclunc.org/news/press_releases/fresno_manufacturing_workers_file_charges_against_company_for_termination_based_on_english_proficiency.shtml.

Alaska ACLU Files Suit Against State's English-Only Initiative, ACLU of N. Cal., Feb. 16, 1999, *at* http://www.aclunc.org/news/press_releases/alaska_aclu_files_suit_against_state's_english-only_initiative.shtml.

ACLU Applauds Two Court Decisions Supporting Language Rights, ACLU of N. Cal., Jan. 15, 1999, *at* http://www.aclunc.org/news/press_releases/aclu_applauds_two_court_decisions_supporting_language_rights.shtml.

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Patricia Digh, *Can't Anyone Here Speak English?*, MOSIACS, Dec. 1998, *at* http://www.asaecenter.org/PublicationsResources/whitepaperdetail.cfm?ItemNumber=12149.

Court Ok's Funds for Applicants Made to take Political Tests, ACLU News (N. Cal.), Nov./Dec. 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file273_4417.pdf.

Contra Costa County to Pay $1.2 Million to Settle Challenge to Use of Written 'Drug Test' as Requirement for General Assistance, ACLU of N. Cal., Oct. 30, 1998, *at* http://www.aclunc.org/news/press_releases/contra_costa_county_to_pay_$1.2_million_to_settle_challenge_to_use_of_written_'drug_test'_as_requirement_for_general_assistance.shtml.

Prop. 227 Appealed: Civil Rights Groups Seek Trial on Bilingual Ed Measure, ACLU News (N. Cal.), Sept./Oct. 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file931_4416.pdf.

Racism and the Criminal Justice System, ACLU News (N. Cal.), July/Aug. 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file959_4415.pdf.

ACLU Helps Defeat Official English Law in Arizona, ACLU News (N. Cal.), July/Aug. 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file959_4415.pdf.

Security Firm to Pay up to $2.1 Million to Settle Class Action Against Employee "Political Litmus Test", ACLU News (N. Cal.), July/Aug. 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file959_4415.pdf.

Students, Parents File Class Action to Block 227, ACLU News (N. Cal.), July/Aug. 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file959_4415.pdf.

Civil Rights Groups Respond to Proposition 227 Ruling, ACLU of N. Cal., July 15, 1998, *at* http://www.aclunc.org/news/press_releases/civil_rights_groups_respond_to_proposition_227_ruling.shtml.

Michael Bazeley, *S.J. Unified to seek waiver from Prop. 227*, S.J. Mercury News, June 4, 1998, *at* http://www.mail-archive.com/pen-l@galaxy.csuchico.edu/msg26859.html.

Academics, Contractors Sue Governor for Barring State Information on Discrimination, ACLU News (N. Cal.), May/June 1998, *at* http://www.aclunc.org/news/print_newsletters/asset_upload_file149_4414.pdf.

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Civil Rights Groups Announce Class Action, ACLU of N. Cal., May 3, 1998, *at* http://www.aclunc.org/news/press_releases/civil_rights_groups_announce_class_action.shtml.

Diana Kunde, *English-only lawsuit blurs lines between good business, discrimination*, Dallas Morning News, Apr. 14, 1998, *at* http://englishfirst.org/workplace/workplacedallas2(1998).htm.

Civil Rights Groups Sue Governor For Blocking Information on Discrimination, ACLU of N. Cal., Apr. 2, 1998, at http://www.aclunc.org/news/press_releases/civil_rights_groups_sue_governor_for_blocking_information_on_discrimination.shtml.

Court Allows Open Meeting Lawsuit Against Governor, Regents for Anti-Affirmative Action Vote, ACLU News (N. Cal.), Mar./Apr. 1998, at http://www.aclunc.org/news/print_newsletters/asset_upload_file674_4413.pdf.

Dorothy Ehrlich, *Law Firm's Fee Donation Creates New Racial Justice Fellowship*, ACLU News (N. Cal.), Jan./Feb. 1998, at http://www.aclunc.org/news/print_newsletters/asset_upload_file300_4418.pdf.

Maura Dolan, *Judge Extends Curb on Proposition 209*, L.A. Times, Dec. 17, 1997, *at* http://www.fullerton.edu/affirmativeaction/aanews/12-17-96.htm.

Laura Schiebelhut, *Groups still plan to fight Proposition 209*, Daily Cal., Nov. 6, 1997, *at* http://www.kernel.uky.edu/1997/fall/11/06/news52.shtml.

Justices Decline to Hear Challenge To California's Anti-Affirmative Action Initiative, ACLU of N. Cal., Nov. 3, 1997, *at* http://www.aclunc.org/news/press_releases/justices_decline_to_hear_challenge_to_california's_anti-affirmative_action_initiative.shtml

Nina Siegal, *Ganging up on civil liberties – anti-gang policing and civil rights*, Progressive, Oct. 1997, *at* http://findarticles.com/p/articles/mi_m1295/is_n10_v61/ai_19841065/pg_2/?tag=content;col1.

U.S. Supreme Court Refuses Stay on Proposition 209, Ms. Magazine, Sept. 5, 1997, *at* http://www.msmagazine.com/news/uswirestory.asp?id=3070.

Harriet Chiang, *U.S. High Court Allows Prop. 209 to Remain in Effect*, S.F. Chron., Sept. 5, 1997, *at* http://imgs.sfgate.com/cgi-bin/article.cgi?f=/c/a/1997/09/05/MN63383.DTL&hw=courts&sn=350&sc=099.

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Civil Rights Advocates Will Appeal Decision on 209, ACLU of N. Cal., Apr. 22, 1997, *at* http://www.aclunc.org/news/press_releases/civil_rights_advocates_appeal_decision_on_209;_say_panel's_ruling_ignores_law,_society's_racism.shtml.

Civil Rights Advocates Will Appeal Decision on 209, ACLU of N. Cal., Apr. 8, 1997, *at* http://www.aclunc.org/news/press_releases/civil_rights_advocates_will_appeal_decision_on_209_three-judge_panel's_ruling_ignores_law,_society's_racism.shtml

High Court Upholds San Jose's Anti-Gang Injunction, ACLU News (N. Cal.), Mar./Apr. 1997, at http://www.aclunc.org/news/print_newsletters/asset_upload_file367_4410.pdf.

High Court Hears ACLU Challenge to San Jose's Anti-Gang Injunction, ACLU News (N. Cal.), Jan./Feb. 1997, at http://www.aclunc.org/news/print_newsletters/asset_upload_file718_4409.pdf.

Proposition 209 Cannot Be Enforced, ACLU News (N. Cal.), Jan./Feb. 1997, at http://www.aclunc.org/news/print_newsletters/asset_upload_file718_4409.pdf.

A.J. Harwin, *Enforcement of Proposition 209 blocked by federal judge*, Daily Bruin, Dec. 2, 1996, at http://74.125.93.104/search?q=cache:O1589NtsBosJ:www.dailybruin.ucla.edu/archives/id/7965/+harwin+daily+bruin+enforcement+of+propostion+209+blocked+federal+judge&cd=1&hl=en&ct=clnk&gl=us.

ACLU Files Federal Lawsuit to Block Implementation of California's Anti-Affirmative Action Initiative, Nov. 6, 1996, *at* http://aad.english.ucsb.edu/docs/aclu.11.6.html.

Joseph Torres, *The Language Crusade*, Hispanic Magazine, June 1996, *at* http://faculty.ed.umuc.edu/~jmatthew/articles/crusade.html.

Yumi Wilson, *Court Denies Affirmative Action Suit/Wilson tried to halt state enforcement*, S.F. Chron. (Sacramento Bureau), Oct. 25, 1995, *at* http://www.sfgate.com/c/a/1995/10/25/MN56908.DTL.

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David Foster, *Workplace English-Only Rules: Preventing 'Tower of Babel' or aiding racism?*, Prescott Courier, Sept. 4, 1992, *at* http://news.google.com/newspapers?nid=886&dat=19920904&id=8B0OAAAAIBAJ&sjid=sH0DAAAAIBAJ&pg=6920,1038488.

Seth Mydans, *Pressure for English-Only Job Rules Stirring a Sharp Debate Across U.S.*, N.Y. Times, Aug. 8, 1990, *at* http://www.nytimes.com/1990/08/08/us/pressure-for-english-only-job-rules-stirring-a-sharp-debate-across-us.html?sec=&spon=&pagewanted=all.

Appeals Court Rejects Testing of Rail Workers, N.Y. Times, Feb. 12, 1988, *at* http://www.nytimes.com/1988/02/12/us/appeals-court-rejects-testing-of-rail-workers.html?sec=&spon=&pagewanted=all.

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

2001 – present: United States Magistrate Judge.
I was appointed by the U.S. District Court for the Northern District of California. The jurisdiction of the Court is defined by 28 U.S.C. § 636.

a. Approximately how many cases have you presided over that have gone to verdict or judgment?

I have presided over 15 cases to verdict. This does not include other cases I have adjudicated through motions.

i. Of these, approximately what percent were:

jury trials?	47%;
bench trials	53%
civil proceedings?	60%;
criminal proceedings?	40%

b. Provide citations for all opinions you have written, including concurrences and dissents.

See attached list of cases.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (4) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

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1. *United States v. Gardner*, No. CR 07–454 PJH (EMC) (N.D. Cal.)

Case Description:

Defendant Latosha Gardner was indicted on one count of conspiracy to engage in sex trafficking of a minor under 18 U.S.C. § 371, and one count of sex trafficking of a minor under 18 U.S.C. § 1591. After holding a detention hearing, I granted Ms. Gardner pretrial release subject to certain conditions. Subsequently, the government asked that another condition be imposed-- *i.e.*, electronic monitoring -- as required by the Adam Walsh Child and Safety Protection Act of 2006. Ms. Gardner argued that the Adam Walsh Act was unconstitutional, contending, *inter alia*, that the conditions imposed by the Act (1) constituted excessive bail in violation of the Excessive Bail Clause of the Eighth Amendment, (2) violated procedural due process, and (3) violated separation of powers.

I rejected the Eighth Amendment argument because the government had a valid interest in imposing the electronic monitoring condition and, as applied to the facts of the case, the condition was not excessive in relation to the government's interest. I rejected the separation of powers claim in part because of the historic role the legislature has played in establishing bail. As for the procedural due process claim, I expressed concern about the fact that the Act imposed certain release conditions without a judicial determination, but ultimately concluded that Ms. Gardner failed to identify any protectible liberty interest which was deprived by the condition of electronic monitoring. *United States v. Gardner*, 523 F. Supp. 2d 1025 (N.D. Cal. 2007).

Counsel for Plaintiff:	Brian Stretch United States Attorney's Office 450 Golden Gate Avenue, 11th Floor Box 36055 San Francisco, CA 94102 (415) 436-6842
Counsel for Defendant:	Jodi Linker Office of the Federal Public Defender 450 Golden Gate Avenue, 19th Floor Federal Building - Box 36106 San Francisco, CA 94102 (415) 436-7700

2. *Environmental Prot. Info. Ctr. v. Blackwell*, No. C-03-4396 EMC (N.D. Cal.)

Case Description:

Plaintiff Environmental Protection Information Center ("EPIC") filed suit against Defendant the United States Forest Service alleging the Service violated

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both the National Environmental Policy Act ("NEPA") and the National Forest Management Act ("NFMA") by authorizing a timber sale in the Mendocino National Forest, threatening the habitat of the northern spotted owl, the northern goshawk, the Pacific fisher, and the American pine marten.

I held that the Service violated both NEPA and NFMA, finding, *inter alia*, that the Service failed to meet NFMA monitoring obligations by relying on insufficiently reliable habitat capability models. *Environmental Prot. Info. Ctr. v. Blackwell*, 389 F. Supp. 2d 1174 (N.D. Cal. 2004).

Counsel for Plaintiff:	Peter M.K. Frost Western Environmental Law Center 1216 Lincoln Street Eugene, OR 97401 (541) 485-2471
Counsel for Defendant:	Owen Martikan United States Attorney Northern District of California 450 Golden Gate Avenue, 10th Floor San Francisco, CA 94102 (415) 436-7241

3. *Smith v. City of Oakland*, No. C-05-4045 EMC (N.D. Cal.)

Case Description:

Plaintiffs Torry Smith and Patricia Gray sued two police officers and the City of Oakland for violation of their civil rights in connection with a warrantless parole search of their home. The police allegedly planted a gun on Mr. Smith which resulted in his arrest, prosecution, and incarceration for 4½ months. I granted summary judgment and dismissed the City from the suit. *Smith v. City of Oakland*, No. C-05-4045 EMC, 2007 WL 2288328 (N.D. Cal. Aug. 9, 2007). The case against the officers was then tried to a jury. The jury found for the plaintiffs and awarded them over $6 million in damages.

Subsequently, I denied the defendants' post-trial motion for judgment as a matter of law and for new trial on liability but granted a remittitur reducing damages by approximately $2.5 million. *Smith v. City of Oakland*, 538 F. Supp. 2d 1217 (N.D. Cal. 2008).

Counsel for Plaintiff:	Benjamin Nisenbaum Law Offices of John L. Burris Airport Corporate Centre 7677 Oakport Street, Suite 1120 Oakland, CA 94621 (510) 839-5200

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Counsel for Defendant:

Gloria Y. Lee
McKesson Corporation
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San Francisco, CA 94104
(415) 983-8349

4. *Velez v. Roche*, No. C-02-0337 EMC (N.D. Cal.)

Case Description:

Plaintiff Pauline Velez filed suit against the United States Air Force, alleging discrimination on the basis of gender. She asserted both disparate treatment and hostile working environment claims. I granted partial summary judgment. The rest of the case was tried to a jury. The jury found in favor of the Air Force on the disparate treatment claim, but in favor of Dr. Velez on the hostile work environment claim, and awarded over $500,000 in damages.

The Air Force subsequently filed a post-trial motion challenging for judgment as a matter of law, for new trial and for remittitur. I granted the remittitur but denied the rest of the motions. *Velez v. Roche*, 335 F. Supp. 2d 1022 (N.D. Cal. 2004). No appeal was prosecuted on the merits. I awarded attorney's fees but applied several reductions. The Ninth Circuit, in an unpublished memorandum, remanded on the reduction of the lodestar and calculation of hourly rates. *Velez v. Roche*, No. 04-17425, 2007 WL 295502 (9th Cir. Jan. 19, 2007) (Wallace, J., concurring in part and dissenting in part).

Counsel for Plaintiff:

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Counsel for Defendant:

Claire T. Cormier
United States Attorney's Office
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5. *Davis, Cowell & Bowe, LLP v. Social Sec'y Adm'n*, No. C-01-4021 EMC, 2002 U.S. Dist. LEXIS 9548 (N.D. Cal. May 16, 2002), vacated by 281 F. Supp. 2d 1154 (N.D. Cal. 2003)

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Plaintiff sought injunctive relief under the Freedom of Information Act ("FOIA") for the failure of the Social Security Administration ("SSA") to comply with Plaintiff's requests for records. Plaintiff sought records reflecting communications between the SSA and two third-party employers, including inquiries made to the SSA by the employers about their employee's social security numbers and the SSA's response to those inquiries. The SSA claimed that any such information would be exempt from disclosure as tax return information.

I granted summary judgment to the SSA. Title 26 U.S.C. § 6103 provided blanket protection to tax information, and the W-2 and W-3 forms from which information was sought by the law firm was collected pursuant to the authority granted to the IRS to collect taxes. The fact that the returns passed through the Administration before reaching the IRS did not gainsay the fact that the information was filed under compulsion and the threat of criminal penalties related to the IRS's administration of tax laws. Nor did it negate the nexus between the data or information obtained and the furtherance of obligations controlled by the tax laws. Finally, the records sought were exempt from disclosure under 5 U.S.C.S. § 522(b)(3).

Subsequently, the parties appealed and then reached a resolution. I then vacated the summary judgment order because the parties had jointly moved for vacatur and the controversy had become moot by virtue of unilateral action taken by the prevailing party (*i.e.*, the SSA).

Counsel for Plaintiff:	Kristin L. Martin Davis Cowell & Bowe 595 Market Street, Suite 1400 San Francisco, CA 94105 (415) 597-7200
Counsel for Defendant:	Alex Tse Office of the San Francisco City Attorney 1390 Market Street, 6th Floor San Francisco, CA 94102 (415) 554-4277

6. *Visto Corporation v. Sproqit Technologies, Inc.*, No. C-04-0651 EMC (N.D. Cal.)

Case Description:

Plaintiff Visto Corporation brought suit against Defendant Sproqit Technologies, Inc. for infringement of its patent involving software for wireless devices such as smart phones. Sproqit counterclaimed for declaration of noninfringement and invalidity, tortious interference with prospective economic advantage, and defamation. I dismissed the counterclaims for interference and

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defamation. *Visto Corp. v. Sproqit Technologies, Inc.*, 360 F. Supp. 2d 1064 (N.D. Cal. 2005). I denied Visto's motion for preliminary injunction. *Visto Corp. v. Sproqit Technologies, Inc.*, 413 F. Supp. 2d 1073 (N.D. Cal. 2006). I subsequently held a tutorial session followed by a claims construction hearing. I issued a partial ruling on the claims construction. *Visto Corp. v. Sproqit Technologies, Inc.*, 445 F. Supp. 2d 1104 (N.D. Cal. 2006). Before I ruled on the remaining claims, Visto extended to Sproqit a covenant not to sue. I then dismissed the claim and counterclaims as moot over Sproqit's objection and rejected Visto's request to vacate all interlocutory orders including the claims construction ruling. *Visto Corp. v. Sproqit Technologies, Inc.*, No. C-04-0651 EMC, 2006 WL 3741946 (N.D. Cal. Dec. 19, 2006). Finally, I denied Sproqit's request for attorney fees. *Visto Corp. v. Sproqit Technologies, Inc.*, No. C-04-0651 EMC, 2007 WL 160942 (N.D. Cal. Jan. 17, 2007).

Counsel for Plaintiff:	Ronald Katz Manatt Phelps & Phillips LLP 1001 Page Mill Road Building 2 Palo Alto, CA 94304-1006 (650) 812-1300
Counsel for Defendant:	Devan Padmanabhan Dorsey & Whitney LLP 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402 (612) 340-2600

7. *Darling International v. Baywood Partners, Inc.*, No. C-05-3758 EMC (N.D. Cal.)

Case Description:

This case involved a contract dispute over an agreement by Defendant Baywood Partners, Inc. to purchase real property from Plaintiff Darling International. The property had substantial environmental problems and the contract provided for lengthy contingencies. The parties transacted with each other for a period of over 12 years, leaving their legal relationship ambiguous. I denied cross-motions for summary judgment. *Darling International, Inc. v. Baywood Partners, Inc.*, No. C-05-3758 EMC, 2006 WL 2374635 (N.D. Cal. Aug. 16, 2006). The case proceeded to a bench trial. I found that the original contract had been terminated but that Baywood was nonetheless entitled to specific performance (subject to certain equitable modifications) on the basis of waiver and estoppel. *Darling International, Inc. v. Baywood Partners, Inc.*, No. C-05-3758 EMC, 2007 WL 2088366 (N.D. Cal. July 13, 2007). I subsequently ruled on a number of post-trial motions and awarded attorney's fees to the prevailing party. *Darling International v. Baywood Partners, Inc.*, No. C-05-

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3758 EMC, 2007 WL 2904035 (N.D. Cal. Oct. 2, 2007) (denying motion to amend complaint); 2007 WL 2904034 (N.D. Cal. Oct. 2, 2007) (denying motion to alter judgment or for new trial); 2007 WL 4532233 (N.D. Cal. Dec. 19, 2007) (granting attorneys' fees and costs). The case resolved without appeal.

Counsel for Plaintiff:	Robert D. Crockett Latham & Watkins LLP 355 South Grand Avenue Los Angeles, CA 90071-1560 (213) 485-1234
Counsel for Defendant:	Daniel Miller Miller Starr & Regalia 1331 N. California Boulevard, Fifth Floor Walnut Creek, CA 94596 (925) 935-9400

8. *Wham-O, Inc. v. Sport Dimension, Inc.*, No. C-04-5055 EMC (N.D. Cal.)

Case Description:

Plaintiff Wham-O, Inc. filed suit against Defendant Sport Dimension, Inc. for patent infringement. The patent involved the application of laminated art on a bodyboard. I granted summary judgment to Sport Dimension. I rejected Sport Dimension's assertion of prosecution history estoppel but granted summary judgment on the basis of the all limitations rule. *Wham-O, Inc. v. Sport Dimension, Inc.*, 398 F. Supp. 2d 1081 (N.D. Cal. 2005).

Counsel for Plaintiff:	Bobbie Wilson Robert Cruzen Howard Rice Nemerovski Canady Falk & Rabki Three Embarcadero Center, 7th Floor San Francisco, CA 94111-4065 (415) 434-1600
Counsel for Defendant:	Alfred Bismonte Ashley Jiang Beck Ross Bismonte & Finley LLP Fairmont Plaza, Suite 1300 50 W. San Fernando Street San Jose, CA 95113 (408) 938-7900

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9. *City of Ann Arbor Emples. Ret. Sys. v. Gecht*, No. C-06-7453 EMC (N.D. Cal.)

Case Description:

Plaintiff, a retirement system for employees of the City of Ann Arbor, was a shareholder of Electronics for Imaging, Inc. ("EFI"). Plaintiff filed a derivative suit and class action in state court against various officers and directors of EFI, alleging, *inter alia*, that Defendants breached their fiduciary duty by failing to disclose in EFI's 2006 proxy statement their practice of backdating stock options to their benefit and to shareholders' detriment. The case was removed to federal court. Plaintiff moved to remand. Defendant argued that removal was proper, based, *inter alia*, on the removal provision of the Securities Litigation Uniform Standards Act ("SLUSA"). Plaintiff asserted that removal was not appropriate because it was exempted from SLUSA's reach as a class action based on the statutory or common law of the issuer's state of incorporation (known as the Delaware carve-outs). After analyzing the statutory language, I concluded that the Delaware carve-out applied. However, I found that remand was not appropriate under 28 U.S.C. § 1441(b) because the only Defendant "joined and served" at the time of removal was diverse, and thus federal jurisdiction obtained. *City of Ann Arbor Emples. Ret. Sys. v. Gecht*, No. C-06-7453 EMC, 2007 WL 760568 (N.D. Cal. Mar. 9, 2007). The case was voluntarily dismissed without prejudice in favor of litigation in Delaware.

Counsel for Plaintiff:	Mary S. Thomas Grant & Eisenhofer Chase Manhattan Centre 1201 North Market Street, Suite 2100 Wilmington, DE 19801 (302) 622-7000
	Alan R. Plutzik Bramson Plutzik Mahler & Birkhaeuser 2125 Oak Grove Road, #120 Walnut Creek, CA 94598 (925) 945-0200
Counsel for Defendant:	Ignacio E. Salceda Wilson Sonsini Goodrich & Rosati 650 Page Mill Road Palo Alto, CA 94304-1050 (650) 493-9300

10. *TK Power, Inc. v. Textron, Inc.*, No. C-04-5098 EMC (N.D. Cal.)

Case Description:

In this breach-of-contract/fraud action, Plaintiff TK Power, Inc. contended

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that it had contracted with Defendant Textron, Inc. to develop and supply high frequency on-board battery chargers for golf carts. TK Power asserted that, after investing significant time and money into developing the charger, Textron repudiated the contract. Textron claimed that TK Power had failed to successfully develop the prototypes necessary to advance to the production stage. I denied Textron's motion for summary judgment, *TK Power, Inc. v. Textron, Inc.*, No. C-04-5098 EMC, 2006 WL 733494 (N.D. Cal. Mar. 22, 2006), and the case was tried to a jury. *TK Power, Inc. v. Textron, Inc.*, 433 F. Supp. 2d 1058 (N.D. Cal. 2006) (opining on the application of the UCC in deciding on jury instructions). The jury found for Textron on one claim and hung on two others. I denied Textron's post-trial motion for judgment as a matter of law. *TK Power, Inc. v. Textron, Inc.*, No. C-04-5098 EMC, 2006 WL 2032577 (N.D. Cal. July 18, 2006). Pursuant to the parties' stipulation, I entered verdicts on the remaining two claims. The case has resolved by settlement.

Counsel for Plaintiff:	John Calvin Brown, III Redenbacher & Brown, LLP 580 California Street, Suite 1600 San Francisco, CA 94104 (415) 409-8600
Counsel for Defendant:	Jeffrey A. Healey Tucker Ellis & West 1150 Huntington Building 925 Euclid Avenue Cleveland, OH 44115 (216) 592-5000

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

1. *TK Power, Inc. v. Textron, Inc.*, 433 F. Supp. 2d 1058 (N.D. Cal. 2006)

Counsel for Plaintiff:	John Calvin Brown III Redenbacher & Brown LLP 580 California Street, Suite 1600 San Francisco, CA 94104 (415) 409-8600
Counsel for Defendant:	Jeffrey A. Healey Tucker Ellis & West 1150 Huntington Building

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2. *Wham-O, Inc. v. Sport Dimension, Inc.*, 398 F. Supp. 2d 1081 (N.D. Cal. 2005)

Counsel for Plaintiff:	Bobbie Wilson Robert Cruzen Howard Rice Nemerovski Canady Falk & Rabki Three Embarcadero Center, 7th Floor San Francisco, CA 94111-4065 (415) 434-1600
Counsel for Defendant:	Alfred Bismonte Ashley Jiang Beck Ross Bismonte & Finley LLP Fairmont Plaza, Suite 1300 50 W. San Fernando Street San Jose, CA 95113 (408) 938-7900

3. *Velez v. Roche*, 335 F. Supp. 2d 1022 (N.D. Cal. 2004)

Counsel for Plaintiff:	Jack W. Lee Minami Tamaki LLP 360 Post Street, 8th Floor San Francisco, CA 94108 (415) 788-9000
Counsel for Defendant:	Claire T. Cormier United States Attorney's Office Northern District of California, San Jose Branch 150 Almaden Boulevard, Suite 900 San Jose, CA 95113 (408) 535-5082

4. *United States v. Gardner*, 523 F. Supp. 2d 1025 (N.D. Cal. 2007)

Counsel for Plaintiff:	Brian Stretch United States Attorney's Office 450 Golden Gate Avenue, 11th Floor

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Counsel for Defendant: Jodi Linker
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(415) 436-7700

5. *Garcia v. Coleman*, No. C-07-2279 EMC, 2009 WL 799393 (N.D. Cal., Mar. 24, 2009)

Counsel for Plaintiff: Philip J. Terry
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(707) 526-4200

Counsel for Defendant: William J. Arnone, Jr.
Merrill Arnone & Jones LLP
3554 Round Barn Boulevard, Suite 303
Santa Rosa, CA 95403
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6. *Visto Corp. v. Sproqit Techs., Inc.*, No. C-04-0651 EMC, 2006 U.S. Dist. LEXIS 96173 (N.D. Cal. Oct. 4, 2006)

Counsel for Plaintiff: Ronald Katz
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Counsel for Defendant: Devan Padmanabhan
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7. *Environmental Prot. Info. Ctr. v. Blackwell*, 389 F. Supp. 2d 1174 (N.D. Cal. 2004)

Counsel for Plaintiff:	Peter M.K. Frost Western Environmental Law Center 1216 Lincoln Street Eugene, OR 97401 (541) 485-2471
Counsel for Defendant:	Owen Martikan United States Attorney Northern District of California 450 Golden Gate Avenue, 10th Floor San Francisco, CA 94102 (415) 436-7241

8. *Fitzgerald v. Cassil*, 216 F.R.D. 632 (N.D. Cal. 2003)

Counsel for Plaintiff:	Liza Cristol-Deman Brancart & Brancart P.O. Box 686 Pescadero, CA 94060 (650) 879-0141
Counsel for Defendant:	Michael T. Kennick Kennick & Associates 110 E. Wilshire Avenue, Suite 401 Fullerton, CA 92832 (714) 992-6600

9. *City of Ann Arbor Emples. Ret. Sys. v. Gecht*, No. C-06-7453 EMC, 2007 U.S. Dist. LEXIS 21928 (N.D. Cal. Mar. 9, 2007)

Counsel for Plaintiff:	Mary S. Thomas Grant & Eisenhofer Chase Manhattan Centre 1201 North Market Street, Suite 2100 Wilmington, DE 19801 (302) 622-7000 Alan R. Plutzik Bramson Plutzik Mahler & Birkhaeuser 2125 Oak Grove Road, #120 Walnut Creek, CA 94598 (925) 945-0200

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Counsel for Defendant:

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10. *North Pacifica, LLC v. City of Pacifica*, 274 F. Supp. 2d 1118 (N.D. Cal. 2003)

Counsel for Plaintiff:

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Keith Fromm
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Counsel for Defendant:

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Oakland, CA 94612
(510) 273-8780

Patrick J. McMahon
Gagen McCoy McMahon Koss Markowitz & Raines
279 Front Street
Danville, CA 94526
(925) 837-0585

e. Provide a list of all cases in which certiorari was requested or granted.

I am not aware of any cases in which certiorari was either requested or granted.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

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(1) *Genentech, Inc. v. Insmed, Inc.*, No. C-04-5429 CW (EMC), 233 F.R.D. 556 (N.D. Cal. 2006) and 234 F.R.D. 667 (N.D. Cal. 2006), *objections sustained by* 236 F.R.D. 466 (N.D. Cal. 2006).

I granted a request for an *in camera* review of documents in a patent infringement case to determine whether certain documents were protected by the attorney-client privilege. Subsequently, I ordered production of a portion of one of the documents over which the patentee had asserted privilege. The patentee objected to the rulings. The presiding judge sustained the objections. She held that an in camera review of documents was appropriate to determine whether the crime-fraud exception to the privilege was applicable – not whether there had been a waiver.

(2) *Navarro v. General Nutrition Corp.*, No.C-03-0603 SBA (EMC), 2004 U.S. Dist. LEXIS 24258 (N.D. Cal. Nov. 19, 2004), *adopted in part and rejected in part by* 2005 U.S. Dist. LEXIS 39726 (N.D. Cal. Sept. 22, 2005).

I prepared a report and recommendation in an employment case on two motions for attorney's fees. More specifically, I recommended that the plaintiff be awarded certain fees and that the defendant's fee request be denied in its entirety. The presiding judge awarded the plaintiff a smaller fee than I had recommended and further awarded the defendant a portion of its fees.

(3) *Velez v. Roche*, No. C-02-0337 EMC, 2004 U.S. Dist. LEXIS 29848 (N.D. Cal. Sept. 22, 2004), *rev'd by* 2007 U.S. App. LEXIS 2194 (9th Cir. Jan. 29, 2007).

In a Title VII case, I granted the plaintiff's motion for attorney's fees but reduced the award. The Ninth Circuit held that my 25% reduction of the lodestar required more specific substantiation and that my reduction in the hourly rate awarded was not justified as the hourly rates requested by the plaintiff were supported by sufficient evidence in the record. One judge dissented on the last point.

(4) *North Pacifica, LLC v. City of Pacifica*, No. C-01-4823 EMC, 234 F. Supp. 2d 1053 (N.D. Cal. 2002), and 2005 U.S. Dist. LEXIS 11442 (N.D. Cal. May 4, 2005), *aff'd in part and rev'd in part by* 2008 U.S. App. LEXIS 10257 (9th Cir. Cal., May 13, 2008).

In a § 1983 case brought by a real estate developer, I rejected the developer's substantive due process claim on summary judgment but, after a bench trial, ruled in its favor on the equal protection claim. The Ninth Circuit affirmed the dismissal of the substantive due process claim on different grounds. The appellate court also concluded that there was insufficient evidence to support the equal protection claim – *i.e.*, to establish that the city had intentionally singled out the developer for discriminatory treatment.

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(5) *Brayton Purcell LLP v. Recordon & Recordon*, 361 F. Supp. 2d 1135 (2005), *aff'd* No. 07-15383, 2009 U.S. App. LEXIS 17389 (9th Cir. Aug. 5, 2009).

In this copyright infringement case, I denied the defendant's motion to dismiss for improper venue. Under the Copyright Act, a determination of proper venue requires a court to do, in essence, a personal jurisdiction analysis. I concluded that there was "personal jurisdiction" based on existing Ninth Circuit precedent, although I recognized that there was Ninth Circuit authority that arguably held to the contrary. On appeal, the Ninth Circuit affirmed my decision. There was, however, a dissent by Judge Reinhardt which concluded that "personal jurisdiction" was lacking.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

As a Magistrate Judge, I have served both as a presiding judge (*i.e.*, in cases in which all the parties have consented to my jurisdiction) and as a referral judge. The bulk of the referrals are discovery referrals.

For my consent cases, most of my opinions have been published, either in a published reporter or through an electronic publication (*i.e.*, WestLaw or Lexis).

For cases referred to me by other judges, many of my substantive opinions have been published, at least through an electronic publication. However, many of my discovery orders have not been published, either in a published reporter or through an electronic publication. I have heard over 325 cases referred to me. Most have resulted in unpublished orders. Many resulted in more than one unpublished order. I estimate that I have written between 200 – 300 orders that have not been published. Each of these orders is available through ECF (the Northern District of California's e-filing program).

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

1. *United States v. Gardner*, 523 F. Supp. 2d 1025 (N.D. Cal. 2007)

2. *Doe I v. Liu Qi*, 349 F. Supp. 2d 1258 (N.D. Cal. 2004) (report and recommendation, ultimately adopted by presiding judge)

3. *Smith v. City of Oakland*, No. C-05-4045 EMC, 538 F. Supp. 2d 1217 (N.D. Cal. 2008)

4. *Khanna v. State Bar of Cal.*, 505 F. Supp. 2d 633 (N.D. Cal. 2007)

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5. *Board of Trs. v. Doctors Med. Ctr. of Modesto, Inc.*, No. C-07-1740 EMC, 2007 U.S. Dist. LEXIS 64016 (N.D. Cal. Aug. 17, 2007)

6. *Adibi v. California State Bd. of Pharm.*, 461 F. Supp. 2d 1103 (N.D. Cal. 2006)

7. *Napa Valley Publ. Co. v. City of Calistoga*, 225 F. Supp. 2d 1176 (N.D. Cal. 2002)

8. *Cuviello v. City of Oakland*, No. C-06-5517 MHP (EMC), 2007 U.S. Dist. LEXIS 59833 (N.D. Cal. Aug. 14, 2007) (report and recommendation, ultimately adopted by presiding judge)

9. *North Pacifica, LLC v. City of Pacifica*, No. C-01-4823 EMC, 234 F. Supp. 2d 1053 (N.D. Cal. 1002) and Order dated 10/23/03, Docket No. 64.

10. *Rev. Charles Mayfield v. City of Oakland*, No. C-07-0583 EMC, 2007 U.S. Dist. LEXIS 59947 (N.D. Cal. Aug. 6, 2007); 2007 U.S. Dist. LEXIS 83983 (N.D. Cal. Nov. 2, 2007)

11. *Cuviello v. City of Oakland*, No. C-06-5517 MHP (EMC) (N.D. Cal. July 20, 2009) (Docket No. 218) (report and recommendation)

12. *Brayton Purcell LLP v. Recordon & Recordon*, 361 F. Supp. 2d 1135 (2005), *aff'd* No. 07-15383, 2009 U.S. App. LEXIS 17389 (9th Cir. Aug. 5, 2009).

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have not sat by designation on a federal court of appeals.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

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b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I maintain a standing recusal list of individuals and entities consistent with Code of Conduct for United States Judges. These include entities in which I (in any management capacity) own stocks, law firms which I have retained to handle personal and business matters, and close friends. I also review the parties and counsel in each case to ensure I do not have a close relationship to any of the parties, identified witnesses, or counsel that would interfere with my neutrality or compromise the appearance of justice.

I have identified the Coblentz law firm as a party whose involvement would automatically trigger my disqualification. This is a firm where I formerly worked and which continues to represent me in personal matters. I previously identified the ACLU, a former employer, as a party whose involvement would automatically trigger my disqualification.

I also recuse myself in cases in which a party is represented by an attorney (Thomas Frankovich) who had previously filed a lawsuit against a restaurant and a family limited liability company (of which I am a member and manager.) The LLC owned the building in which the restaurant was located.

I have recused myself in the following cases:

1. 8/17/01; CR01-0125 WDB; United States of America v. Benjamin Moore. I recused myself sua sponte. I had contributed to a victim's fund for a child mauled by two pit bulls. The owner of the dogs appeared in federal court on an unrelated charge. I recused to insure the appearance of fairness.

2. 10/17/01; C01-1344 SBA (EMC); Under Seal; I recused myself sua sponte. The defendant in this case was Marin County Office of Education/Special Education and my son was (and still is) in the County special education program. It is a small program and because I had met many of the staff, I felt it was appropriate to recuse myself to insure the appearance of fairness. I have identified this defendant as a party whose involvement in a case would automatically trigger my disqualification.

3. 3/26/02; C02-0080 CW (EMC); Alex S. v. Tamalpais Union High Sch. Dist. I recused myself sua sponte for the reasons stated above as to Case No. C01-1344.

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4. 5/9/02; C02-1402 PJH; Lee v. Nierras
I recused myself sua sponte because one of the defendants in the case was the law firm of which one of the named partners is a personal friend.

5. 5/9/02; C02-2543 WHA; Zatopa v. Lowe
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm, where I formerly worked and which continues to represent me in personal matters.

6. 6/28/02; C02-2665 EMC; Chowdhury v. Northwest
I recused myself sua sponte. The plaintiff was represented by, inter alia, the ACLU of Northern California, where I formerly worked. At the time I was assigned the case, my employment with the ACLU had ended approximately a year earlier.

7. 6/26/02; C02-2878 EMC; Chan v. Intuit
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

8. 7/25/02; C02-2755 EMC; Butler v. Igasaki
I recused myself sua sponte because I know the defendant personally.

9. 11/5/02; C01-0881 PJH (EMC); Scully v. Japan Senior Citizens Welfare Org'n
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

10. 1/16/03; C03-0199 EMC; Lau v. Chan
I recused myself sua sponte. The defendant is the brother-in-law of my courtroom deputy.

11. 3/6/03; C02-5901 VRW; Lepp v. Kelly
I recused myself sua sponte in this case because I had issued the search warrant.

12. 7/24/03; C01-4298 PJH (EMC); ECast Inc. v. Touchtunes Music Corp.
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

13. 11/14/03; C02 5971 JSW; Boston Telecomm. v. Wood
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

14. 11/25/03; C03-5145 EMC; McGehee v. Cae McGehee Inc.
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

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15. 4/5/04; C04-1135 MMC (EMC); Maverick Recording Co. v. Does
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

16. 4/20/04; C02-3703 MMC (EMC); Anditon v. Correctional Officer Mark Priest
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

17. 5/17/04; C03-4084 MJJ (EMC); Arista Records, Inc. v. Williams
I recused myself sua sponte as one of the defendants in the case was represented by, inter alia, the Coblentz law firm.

18. 6/14/04 & 6/18/04; C04-0527, C04-0551; Williams v. Peralta Community College
The pro se plaintiff asked to revoke her consent to proceeding before a magistrate judge. Her request to revoke consent was made only after I made a substantive ruling against her. I denied the plaintiff's request because she did not provide any valid reason as to why she should be permitted to withdraw her consent. See Dixon v. Ylst, 990 F.2d 478, 480 (9th Cir. 1993) ("Once a civil case is referred to a magistrate judge under section 636(c), the reference can be withdrawn by the court only 'for good cause shown on its own motion, or under extraordinary circumstances shown by any party.' There is no absolute right, in a civil case, to withdraw consent to trial and other proceedings before a magistrate judge."). Subsequently, the plaintiff objected to my ruling, arguing that I was prejudiced, that I had misled her, and that I had violated her rights. I construed her objection as a request to disqualify, which I denied because she did not provide any facts to support her assertions.

19. 8/6/04; C04-0493 MEJ (EMC); Li v. Nostalgia Entertainment Co.
I recused myself sua sponte. One of the defense attorneys (Paul Justi) represented me in a personal matter.

20. 11/12/04; C02-1068 CW (EMC); Janvrin Holdings Ltd. v. Hilsenrath
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

21. 1/5/05; C02-2338 EMC; Drax Holdings v. Apodaca
I recused myself sua sponte. One of the plaintiffs was represented by a law firm where my career law clerk's husband works and is a partner. My career law clerk is the only law clerk I have.

22. 1/13/05; C04-4195 WHA; Northern California River Watch v. City of Santa Rosa
The defense attorneys from the Downey Brand law firm alerted me (via a filed letter) that the firm represents me in my individual capacity. Because of that representation, I recused myself.

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23. 4/1/05 & 8/1/05; C03-0437 EMC; Hamann v. City of Oakland
The pro se plaintiff filed a letter which asked me to disclose all potential conflicts or disqualify myself immediately. This letter was filed only after I denied her request for reconsideration of the prior presiding judge's denial of temporary injunctive relief. I construed the letter as a request for disqualification.

I denied the request for disqualification because the plaintiff had not provided any argument or evidence as to why there should be disqualification. See 12-63 Moore's Fed. Prac. -- Civ. ' 63.20[8][c] ("Disqualification of a judge is not required on the basis of remote, contingent, indirect, or speculative interests. Recusal statutes are not intended to give litigants a veto power over sitting judges, or a vehicle for judge shopping.").

Subsequently, the plaintiff appeared to make another request for temporary injunctive relief, which I again denied. The plaintiff then sent a letter to the District's Executive Committee, asking for reassignment to a district court judge. For the plaintiff's benefit, I construed her letter as a request for disqualification. I denied the request because the allegations in the plaintiff's letter (i.e., that I was involved in a conspiracy against her) were not substantiated.

Thereafter, the plaintiff moved to withdraw her consent to proceeding before me. Judge Henderson of this District denied the request. He also denied a request for reconsideration.

24. 7/12/05; CR05-70534 MAG; Under Seal
I recused myself sua sponte (with knowledge and consent of the U.S. Attorney's Office) from certain bail and pretrial matters because the investigation involved criminal charges against various individuals, one of whom was an employee or associate of a commercial tenant which leased space in a building owned by a family real estate partnership in which I have an interest.

25. 12/19/05; C05-5206 CRB; Under Seal
I recused myself sua sponte in this forfeiture case because I had issued the search warrant.

26. 11/1/06; C05-1330 CW (EMC); Putnam v. Putnam Lovell Group NBF Secs., Inc.
I recused myself sua sponte because the defendants were represented by, inter alia, a law firm which at the time was representing my family in a business matter.

27. 11/29/06; C03-5376 SBA (EMC); U.S. Fidelity & Guaranty Co. v. Scott Cos.
I recused myself sua sponte because the defendants were offering evidence from an expert (an appraiser) that I have employed for family business matters. After the parties submitted a joint letter asking me to withdraw my recusal order and indicating that defendants would no longer be offering evidence from that

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particular expert, I withdrew the recusal order and heard the case with the parties' consent.

28. 4/27/07; C07 2271 SBA; Reyes v. Alcantar
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

29. 5/24/07; C06 6497 EMC; G v. Kentfield School District
I recused myself sua sponte for the reasons stated above as to Case No. C01-1344 (#1 above.) The defendant in this case was Marin County Office of Education/Special Education and my son was (and still is) in the County special education program.

30. 3/31/08; C07-4005 EMC; Chang v. Rockridge Manor Condo.
The pro se plaintiff filed a motion for recusal after I issued a substantive ruling against her. I denied the request because the plaintiff was claiming bias based solely on an adverse ruling I had issued. She did not substantiate any claim of extrajudicial bias. See United States v. Grinnell Corp., 384 U.S. 563, 583 (1966) (explaining that "[t]he alleged bias and prejudice to be disqualifying must stem from an extrajudicial source and result in an opinion on the merits on some basis other than what the judge learned from his participation in the case").

31. 4/21/08; C08-1173 EMC; Eidex Family Partnership, L.P. v. Justice
The pro se plaintiff sought to revoke consent to proceeding before a magistrate judge after I issued an opinion stating that there was no subject matter jurisdiction over the case. I denied the plaintiff's request because the sole basis of his request was his dissatisfaction with my ruling. Subsequently, Judge White of this District also denied the plaintiff's request for reassignment. Judge White later denied a request for reconsideration.

32. 2/10/09; C09-0564 EMC; 625 3rd Street Associates, LP v. Alliant Credit Union
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

33. 8/4/09, C07-5569 MHP, Alphaville Design, Inc. v. Knoll, Inc. I recused myself sua sponte. Plaintiff is represented by, inter alia, the Coblentz law firm.

In addition, I have recused myself sua sponte from a number of cases in cases in which a party is represented by a particular attorney, Thomas Frankovich**. Mr. Frankovich had previously filed a lawsuit against a restaurant and a family limited liability company of which I am a member and manager. The LLC owned the building in which the restaurant was located. These cases include

1/24/05; C04-4075 EMC; Connally v. Packaging Store
1/27/05; C04-2919 MJJ (EMC); Connally v. Red Boy Pizza
6/20/05; C04-4462 MJJ (EMC); Loskot v. Extended Stay CA, Inc.

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8/30/05; C05-1752 EMC; Loskot v. Howard Johnson
4/20/07; C07 2099 SI; Ramirez v. Star Restaurant Cotati
4/20/07; C07 2100 JSW; Yates v. Foster Freeze Berkeley
5/7/07; C07 2410 SI; Connally v. Phyllis's Giant Burger
5/14/07; C07 2525 MMC; Yates v. D & A Café
1/24/08; C08 0356 JSW; Yates v. Unicorn Pan Asian Cuisine
2/6/08; C08 0736 MMC; Heatherly v. Washoe House Inc.
4/29/08; C08 2163 PJH; Connally v. All Star Doughnuts
4/29/08; C08 2165 SI; Yates v. Twice is Nice
6/3/08; C08 2292 PJH; Connally v. Depot Garden Cafe
6/3/08; C08 2545 CW; Yates v. Sushi Bistro Inc.
8/19/08; C08 3914 CW; Yates v. Tequila Grill
9/17/08; C08-4251 EMC; Loskot v. Americas Best Value Inn
10/3/08; C08 4574 CRB; Yates v. Thai Me Up, Inc.
11/5/08; C08 4875 CRB; Yates v. 3407 Sacramento Street LLC
12/8/08; C08 5365 CW; Yates v. Rose Wing Properties
3/24/09; C09-1189 EMC; Yates v. Ignacio Properties LLC
4/7/09; C09-1450 EMC; Jankey v. Silver Spur
6/5/09, C09-2438 EMC, Jankey v. Milano Pizza
6/29/09, C08-5319 EMC, Yates v. Sutter Health

**I have attempted to locate all of the ADA cases filed by Mr. Frankovich from which I recused myself. There may, however, be additional cases from which I recused myself, based on Mr. Frankovich's involvement, that are not listed on the log. The frequency of Mr. Frankovich's cases as they appear on my recusal list is illuminated by the Ninth Circuit's decision in *Molski v. Evergreen Dynasty Corp.*, 500 F.3d 1047 (9th Cir. 2007) (affirming district court decision from the Central District of California, which declared a client of Mr. Frankovich a vexatious litigant and imposing on the client – as well as Mr. Frankovich's law firm – a sanction which required them to obtain leave of court before filing another ADA complaint in that district).

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

None.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

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I am a member of the Democratic Party and have been since I registered to vote in 1971. I have never held any office in any political party or held a position or played a role in any political campaign with two exceptions. I held a house fund raiser for Art Agnos, candidate for mayor of San Francisco in or about 1987. I served as Co-chair of Californians Against Proposition 63 in 1986 without compensation. This was a campaign organized to oppose a statewide proposition to make English the "official" language of California. I co-chaired a group of community organizations and individuals in overseeing the campaign which was managed by a paid campaign manager.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I served as a clerk to the Honorable James R. Browning, United States Court of Appeals for the Ninth Circuit, from June 1981 to August 1982.

I served as a clerk to the Honorable Charles B. Renfrew, United States District Court for the Northern District of California, from June 1979 to April 1980.

ii. whether you practiced alone, and if so, the addresses and dates;

I have not practiced alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

4/01 to current
United States District Court for the Northern District of California
450 Golden Gate Avenue, 15th Floor
San Francisco, CA 94102
United States Magistrate Judge

9/85 to 4/01
American Civil Liberties Union Foundation of Northern California
39 Drumm Street
San Francisco, CA 94111
Staff Attorney

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12/82 to 9/85
Coblentz Patch Duffy & Bass
(formerly Jacob Sills & Coblentz, and Coblentz Cahen McCabe & Breyer)
One Ferry Building, Suite 200
San Francisco, CA 94111
Litigation Associate

6/81 to 8/82
United States Court of Appeals for the Ninth Circuit
Chief Circuit Judge James R. Browning
316 James R. Browning United States Courthouse
95 Seventh Street
San Francisco, CA 94103
Law Clerk

6/80 to 5/81
Asian Law Caucus
Minami Lew & Tamaki LLP
360 Post Street, 8th Floor
San Francisco, CA 94108
Volunteer Attorney

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I did not serve as a mediator or arbitrator prior to taking the bench. As a Magistrate Judge, I have served as a settlement judge. The Magistrate Judges of the Northern District of California are deeply involved in our court's alternative dispute resolution program. We are regularly referred, as a substantial part of our caseload, cases for settlement conferences which typically entail conferences which last for several hours and sometimes several days through multiple sessions. In the past eight years, I have held several hundred settlement conferences in connection with settlement efforts in nearly 500 cases. The subject matters of cases include such diverse matters as environmental law, admiralty, ERISA, intellectual property (patent, copyright and trademark), disability discrimination, contracts, torts, wage and hour laws, family medical leave, employment discrimination, civil rights, consumer rights, attorney's fees entitlement, and insurance coverage. Below is a sample of cases I have settled.

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1. *Denise Young, et al. v. Tosco Corporation*, No. C-98-1325 MHP (N.D. Cal.)
William Sumter, et al. v. Tosco Corporation, No. C-98-1326 MHP (N.D. Cal.)
Bud Johnson v. Tosco Corporation, No. C-98-1327 MHP (N.D. Cal.)

Case Description:

This was a mass tort case brought by 500 individuals against Tosco refinery stemming from plant explosions and fires. Three related cases were brought by employees directly injured by the explosion, employees indirectly exposed to toxic fumes or otherwise traumatized, and neighbors who believed that they had been subjected to release of toxic materials. My settlement efforts entailed a "town hall" style meeting to explain to the plaintiffs the legal status of the case, the terrain of the legal and factual issues they would have to negotiate, and the advantages of alternative dispute resolution. I then worked with counsel for both parties to devise an orderly and efficient strategy to handle the settlement process. Claims were strategically grouped and settled in seriatum. Although most of the claims were settled globally by a sum certain, nearly 100 claims had to be settled individually.

Counsel for Plaintiff:
Alan R. Freedman
Law Offices of Alan R. Freedman
501 Santa Monica Boulevard, #307
Santa Monica, CA 90401
(310) 394-2344

Counsel for Defendant:
Johnathan T. Krawcheck
Weinberg Wheeler Hudgins Gunn & Dial
950 East Paces Ferry Road, Suite 3000
Atlanta, GA 30326
(404) 876-2700

William Mulvihill
Boornazian Jenson & Garthe
555 12th Street, Suite 1800
Oakland, CA 94607
(510) 834-4350

2. *Sterling M. Enterprises, Inc. v. Lee's Sandwiches International, Inc.*, No. C-05-4477 MHP (N.D. Cal.)

Case Description:

This was a trademark infringement suit brought by the owner of a chain of delicatessens in San Francisco seeking to prevent the entry into the City of a similarly named Vietnamese sandwich chain originating from San Jose.

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Counsel for Plaintiff:	James M. Wagstaffe Kerr & Wagstaffe LLP 100 Spear Street, Suite 1800 San Francisco, CA 94105 (415) 371-8500
Counsel for Defendant:	Marc M. Gorelnik Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor San Francisco, CA 94111 (415) 576-0200

3. *Equal Employment Opportunity Commission / Abdellatiff Hadji v. Albion River Inn, Inc.*, No. C-06-5356 SI (N.D. Cal.)

Case Description:

This suit was brought by the EEOC on behalf of a restaurant employee claiming national origin discrimination and retaliation when he was fired for refusing to apologize to a customer who subjected him to ethnic epithets. The parties negotiated a detailed consent decree.

Counsel for Plaintiff:	William R. Tamayo U.S. Equal Employment Opportunity Commission, San Francisco District Office 350 The Embarcadero, Suite 500 San Francisco, CA, 94105-1260 (415) 625-5600
Counsel for Plaintiff-Intervenor:	Robert Rubin Lawyers' Committee for Civil Rights of the San Francisco Bay Area 131 Steuart Street, Suite 400 San Francisco, CA 94105 (415) 543-9444
Counsel for Defendant:	Raymond N. Stella Erlach Law Offices of Raymond N. Stella Erlach One Maritime Plaza, Fourth Floor San Francisco, CA 94111 (415) 788-3322

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4. *Ramona Ford, Angelina Ford v. City of Oakland*, No. C-03-3304 MJJ (N.D. Cal.)

Case Description:

Plaintiffs were shot with simulated bullets fired by Oakland police officers during unrest following an AFC Championship game in Oakland. One suffered facial scarring. Plaintiffs sought damages and fees.

Counsel for Plaintiff:
Wayne J. Johnson
P.O. Box 19157
Oakland, CA 94619
(510) 451-1166

Counsel for Defendant:
Randolph W. Hall
Oakland City Attorney's Office
One Frank H. Ogawa Plaza, 6th Floor
Oakland, CA 94612
(510) 273-3601

5. *Steve M. Castillo v. Charles D. Marshall, Warden, et al.*, No. C-94-2847 MJJ (N.D. Cal.)

Case Description:

In this suit, an inmate of the California Department of Corrections challenged his identification as a prison gang member and sought changes to the gang validation criteria and procedures used by state prison officials. Settlement entailed negotiation of significant policy changes.

Counsel for Plaintiff:
Charles F.A. Carbone
PMB 212
3128 16th Street
San Francisco, CA 94103
(415) 531-1980

Counsel for Defendant:
Gregory S. Walston
The Walston Legal Group
222 Columbus Avenue, Suite 408
San Francisco, CA 94133
(415) 956-9200
Rochelle C. Holzmann
California State Attorney General's Office
455 Golden Gate Avenue, Suite 11000
San Francisco, CA 94102-7004
(415) 703-5853

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6. *Charles Davis, et al., v. CA Health and Human Services*, No. C-00-2532 SBA (N.D. Cal.)

Case Description:

In this class action suit, plaintiffs challenged the institutionalization of people with disabilities in need of long term care at Laguna Honda Hospital in San Francisco. Plaintiffs contended that the city and the state failed to ensure that such individuals receive the most integrated settings appropriate to their individual needs. A comprehensive settlement incorporated significant policy changes.

Counsel for Plaintiff:

Kimberly Swain
Elissa Gershon
Disability Rights California
1330 Broadway #500
Oakland, CA 94612-2509
(510) 267-1200

Counsel for Defendant:

Ellen Shapiro
Blake Loebs
City Attorney's Office
City & County of San Francisco
Fox Plaza
1390 Market Street, Sixth Floor
San Francisco, CA 94102-5408
(415) 554-3879 (Ms. Shapiro)
(415) 554-9657 (Mr. Loebs)

Beverley R. Meyers
California State Attorney General's Office
455 Golden Gate Avenue, Suite 11000
San Francisco, CA 94102-7004
(415) 703-5853

7. *Semiconductor Energy Laboratory Company, Ltd. v. Acer Incorporated, et al.*, No. C-02-2800 WHA (N.D. Cal.)

Case Description:

This was a patent infringement suit involving multiple international parties in which the parties had a substantial financial stake. The patent concerned LCD technology.

Counsel for Plaintiff:

Donald K. Harris
Jenner & Block LLC
One IBM Plaza

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330 N. Wabash, Suite 4500
Chicago, IL 60611
(312) 222-9350

Counsel for Defendant: William H. Wright
Orrick Herrington & Sutcliffe
777 South Figueroa Street, Suite 3200
Los Angeles, CA 90017-5855
(213) 629-2020

8. *Claudia Koch dba Zazou v. Anthropologie, Inc., Anthropologie Direct LLC, Urban Outfitters, Inc.*, No. C-03-3602 SI (N.D. Cal.)

Case Description:

This action was brought by a fabric design asserting copyright violation by a major retailer. The case involved multiple parties and cross claims.

Counsel for Plaintiff: Megan E. Gray
Gray Matters
2017 Kalorama Road,
NW, Suite 3
Washington, DC
20009
(202) 265-2738

Counsel for Defendant: Kenneth E. Keller
Krieg Keller Sloan Reilley & Roman LLP
114 Sansome Street, 4th Floor
San Francisco, CA 94104
(415) 249-8330

9. *Xiufang Situ, et al., v. Michael O. Leavitt*, No. C-06-2841 TEH (N.D. Cal.)

Case Description:

This was a nationwide class action lawsuit brought against the U.S. Secretary of Health & Human Services seeking to compel the United States government to ensure access to prescription drug benefits under the new Medicare law. Settlement required multiple conferences from which policy changes evolved.

Counsel for Plaintiff: Gill Deford
Center for Medicare Advocacy, Inc.
P.O. Box 350
Willimantic, CT 06226
(860) 456-7790

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Counsel for Defendant: John R. Griffiths
United States Department of Justice, Civil Division,
Federal Programs Branch
20 Massachusetts Avenue, N.W.
Washington, DC 20530
(202) 415-4652

10. *Dave Alba, et al. v. City and County of San Francisco*, No. C-05-1667 TEH (N.D. Cal.)

Case Description:

In this suit, Plaintiffs, a group of 350 peace officers for the San Francisco Sheriff's Department, sued the City for violation of the Fair Labor Standards Act. They contended the City excluded certain non-discretion incentive pay in computing their "regular rate" of pay for overtime purposes. I presided over two settlement conferences and facilitated settlement of all claims.

Counsel for Plaintiff: David P. Mastagni
Will M. Yamada
Mastagni, Holstedt, Amick, Miller, Johnsen & Uhrhammer
1912 I Street
Sacramento, CA 95811
(916) 446-4692

Counsel for Defendant: Jonathan C. Rolnick
Office of the San Francisco City Attorney
1390 Market Street, 5th Floor
San Francisco, CA 94102-5408
(415) 554-3815

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

Since 2001, I have served as a Magistrate Judge for the United States District Court for the Northern District of California. My prior practice was in civil litigation, divided between state and federal courts. I engaged in complex constitutional and statutory litigation with the American Civil Liberties Union Foundation of Northern California between 1985 and 2001. I practiced commercial civil litigation between 1982 and 1985 with the Coblentz law firm in San Francisco. I also handled some criminal defense work at the firm.

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ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

At the Coblentz law firm from 1982 – 1985, most of my clients were commercial entities and individuals engaged in business litigation. A small percentage involved criminal defense as the firm had a small criminal practice (about 5% of the cases). At the ACLU Foundation of Northern California between 1985 – 2001, I represented a range of clients who sought to vindicate their civil rights and liberties, including students and protestors denied free speech, consumers, employees and businesses subject to discrimination, and citizens subject to wrongful arrest, excessive force, or denial of due process.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

While at the Coblentz firm 100% of my work was in litigation. I appeared in court frequently (weekly or monthly). At the ACLU of Northern California, I appeared in court less frequently; 3 – 4 times per year.

i. Indicate the percentage of your practice in:
   1. federal courts; 50%
   2. state courts of record; 50%
   3. other courts;
   4. administrative agencies

ii. Indicate the percentage of your practice in:
   1. civil proceedings; 90-95%
   2. criminal proceedings. 5-10%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I tried 2 cases to verdict, both as associate counsel. Other cases were either settled or resolved by motion.

i. What percentage of these trials were:
   1. jury: 50%
   2. non-jury: 50%

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any

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oral argument transcripts before the Supreme Court in connection with your practice.

I filed a brief in opposition to the petition for certiorari in *Vickers v. Ricketts*, 798 F.2d 369 (9th Cir. 1986), *cert. denied*, 479 U.S. 1054 (1987).

I filed amicus briefs on behalf of the ACLU in the following cases:
Richmond v. J. A. Croson Co., 488 U.S. 469 (1989)
Skinner v. Railway Labor Executives' Association, 489 U.S. 602 (1989)
Arizonans for Official English v. Arizona, 520 U.S. 43 (1997).

I served as co-counsel in *Alexander v. Sandoval*, 532 U.S. 275 (2001).

While my name may have appeared on other Supreme Court briefs as a staff attorney of the ACLU Foundation of Northern California, the above cases are the only ones in which I took an active role.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

    a. the date of representation;

    b. the name of the court and the name of the judge or judges before whom the case was litigated; and

    c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

1. *Korematsu v. United States*, No. CR-27635 W (N.D. Cal.); District Judge Marilyn Hall Patel

I was co-counsel for Fred Korematsu in his coram nobis petition to overturn his 1942 conviction for violating the WW II order relocating Japanese Americans to internment camps. The petition was brought after documents were discovered establishing that, during the original criminal proceeding and appeals, the federal government had withheld from the courts exculpatory documents inconsistent with its claim of military justification for the relocation order. I conducted extensive legal research on constitutional standards against claims of military justification and national security and other procedural aspects of the case, as well as applicability of fee shifting statutes to *coram nobis* proceedings. Judge Patel granted the petition and vacated the conviction without trial, finding that the United States had essentially confessed error. *Korematsu v. United States*, 584 F. Supp. 1406 (N.D. Cal. 1984).

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Co-counsel: Dale Minami
Minami Tamaki LLP
360 Post Street, 8th Floor
San Francisco, CA 94108-4903
(415) 788-9000

Opposing Counsel: Victor D. Stone
United States Department of Justice
Office of Enforcement Operations
1301 New York Avenue NW, #1111
Washington, D.C. 20530
(202) 616-0728

2. *Browne v. Sedgwick Detert Moran & Arnold*, No. 570710-2 (Alameda County Superior Court)

I represented the plaintiffs in a legal malpractice suit. The plaintiffs, entertainment lawyers in New York, had been named in a breach of contact/fraud suit brought by Fantasy Records against our clients and jazz recording artists The Blackbirds. An insurance defense firm was retained by the carrier to defend. As a result of complicated (and somewhat convoluted) legal maneuvers, a default judgment of $12.5 million was entered against our clients. The Coblentz law firm was brought in to resolve the lawsuit at policy limits of $1 million. We then represented our clients in a legal malpractice action. I was charged with the primary responsibility for discovery. After extensive discovery, the malpractice action was settled without dispositive motions or trial. No judge had been assigned to the case.

Co-counsel: Charles R. Breyer
District Judge
United States District Court
450 Golden Gate Avenue, 19th Floor
San Francisco, CA 94102
(415) 522-3660

Opposing Counsel: William Chapman
Chapman Popik & White
650 California Street, 19th Floor
San Francisco, CA 94108
(415) 352-3000

3. *Kim v. Northwest Mutual Life Insurance Company*, No. C-95-2178 DLJ (N.D. Cal.); District Judge D. Lowell Jensen

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This was a class action challenging defendant's policy of refusing to consider for life insurance applicants who were not proficient in English. The complaint asserted claims under the California Unruh Civil Rights Act, the insurance code, and unfair business practices law as well, under Section 1981 of the federal Civil Rights Act. I took the lead in preparing the legal analysis for the case. Shortly after the case was filed, the parties entered into protracted settlement negotiations. The parties eventually agreed to a comprehensive settlement which was approved by the court. A settlement class was certified.

Co-counsel:

Christopher Ho
Legal Aid Society -- Employment Law Center
600 Harrison Street, Suite 120
San Francisco, CA 94107
(415) 864-8848

Harry Bremond
Wilson Sonsini Goodrich & Rosati
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Palo Alto, CA 94304
(650) 493-9300

Robert Fabela
Office of the City Attorney
City Of San Jose
200 East Santa Clara Street
San Jose, CA, 95113-1905
(408) 535-1900

Opposing Counsel:

George Riley
O'Melveny & Myers
Embarcadero Center West
275 Battery Street, Suite 2600
San Francisco, CA 94111
(415) 984-8700

4. *Price v. Pacific Refining Co.*, No. 292000 (Contra Costa County Superior Court); Superior Court Judge Richard Flier, Superior Court Judge Peter Spinetta

I, along with co-counsel Brad Seligman and John True, represented oil refinery workers who were subjected to unannounced suspicionless drug testing. I had primary responsibility for developing the legal analysis in the then-emerging privacy law under the California Constitution. I also conducted extensive discovery and developed expert evidence. The court granted a preliminary injunction enjoining random drug testing and certified the plaintiff class. Subsequently, the case was settled. The defendant agreed to

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restrict testing to that based on individualized suspicion, compensate the named plaintiffs and the plaintiff class, and pay plaintiffs' attorneys' fees.

Co-counsel:

John M. True, III
Superior Court Judge
Alameda County Superior Court, Department 512
Hayward Hall of Justice
24405 Amador Street
Hayward, CA 94544
(510) 690-2721

Brad Seligman
The Impact Fund
125 University Avenue
Berkeley, CA 94710
(510) 834-3473

Opposing Counsel:

James Hargarten
100 Robinhood Drive
San Francisco, CA 94127
(415) 239-1109

5. *Kirk v. Hesselroth*, No. C-82-6732 SAW (N.D. Cal.), No. 89-15188 (9th Cir.); District Judge Stanley Weigel; Circuit Judge Thomas Tang, Circuit Judge Robert R. Beezer, District Judge Albert Stephens (by designation)

I, along with James Petruzzi of Pillsbury Madison and later Alan Marks (solo practitioner), represented the plaintiff who was erroneously arrested as a result of inaccurate computer records for failing to register as a sex offender. District Judge Stanley Weigel found that the plaintiff's Fourth Amendment rights, but not his right to due process, were violated, and that the defendant officer's claim of qualified immunity raised questions of fact. *Kirk v. Hessolroth*, 707 F. Supp. 1149 (N.D. Cal. 1989). The ruling was appealed by the defendant. I argued the case before the Ninth Circuit. The Ninth Circuit affirmed. *Kirk v. Hesselroth*, 914 F.2d 262 (9th Cir. 1990) (unpublished opinion). The case was then tried by co-counsel and a defense verdict rendered.

Co-counsel:

James Petruzzi
Mason & Petruzzi
4900 Woodway #745
Houston, TX 77056
(713) 840-9993

Opposing Counsel:

Scott Emblidge
Moscone Emblidge & Quadra LLP
Mills Tower #2100

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220 Montgomery Street
San Francisco, CA 94104
(415) 362-3591

6. *Ramirez v. Bohannon Development Co.*, No. C-93-1651 FMS (N.D. Cal.); District Judge Fern M. Smith, Magistrate Judge (now District Judge) Phyllis J. Hamilton

In this suit, I represented Latino youths who contended they were detained, interrogated, and ejected from a shopping mall because their physical appearance and clothing fit an alleged gang profile. The lawsuit claimed that the mall violated state and federal civil rights laws. As lead counsel of a team of public interest and private firms, I framed the legal analysis and supervised discovery. The case was settled without trial or dispositive motion. Attorney fees were granted on motion.

Co-counsel: Richard Abramson
SRI International
333 Ravenwood Ave
Menlo Park, CA 94025
(650) 859-6068

Opposing counsel: Gary M. Lepper
Law Offices of Gary M. Lepper
1600 S. Main Street, Suite #305
Walnut Creek, CA 94596-5340
(925) 256-6180

7. *People ex rel. Gallo v. Acuna*, No. H011802 (California Court of Appeal), No. S046980 (California Supreme Court); Superior Court Judge Robert Michael Foley; Appellate Court Justice Franklin D. Elia, Appellate Court Justice Eugene M. Primo, Appellate Court Justice Patricia Bamattre-Manoukian; California Supreme Court Chief Justice Ronald M. George, California Supreme Court Justice Janice R. Brown (authored the opinion), California Supreme Court Justice Marvin R. Baxter, California Supreme Court Justice Kathryn Mickle Werdegar, California Supreme Court Justice Joyce L. Kennard, California Supreme Court Justice Ming W. Chin, California Supreme Court Justice Stanley Mosk

The City of San Jose brought one of the first gang injunction suits against a number of individuals alleged to be members of a street gang. The suit contended that illegal and other annoying conduct of the gang caused a public nuisance in particular areas within the city and sought a preliminary and permanent injunction against gang members from associating in public with other gang members and from engaging in a host of activities (talking with passengers in cars, wearing gang colors, intimidating residents, etc.). I, along with a legal team of public interest and private law firms, represented the defendants, contending that the injunction sought violated the First Amendment and due process. I was lead counsel in framing the legal issues and along with co-counsel

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conducted discovery. The Superior Court granted the preliminary injunction. The Court of Appeal reversed in part and narrowed the injunction. *People ex rel. Gallo v. Acuna*, 48 Cal. App. 4th 641 (1995). The California Supreme Court reversed the Court of Appeal and reaffirmed the injunction. *People ex rel. Gallo v. Acuna*, 14 Cal. 4th 1090 (1997). No trial was held.

Co-counsel: Amitai Schwartz
2000 Powell Street, Suite #1286
Emeryville, CA 94608-1805
(510) 597-1775

Opposing counsel: Joan Gallo
Hopkins & Carley
The Letitia Building
70 South First Street
San Jose CA 95113-2406
(408) 286-9800

8. *Garcia v. Spun Steak Company*, No. C-91-1949 RHS (N.D. Cal.); No. 91-16733 (9th Cir.); District Judge Robert Schnacke; Circuit Judge Diarmuid F. O'Scannlain, Circuit Judge John T. Noonan, Jr., Circuit Judge Robert Boochever

I represented two employees and the local union of a meat packing plant. The employees were disciplined for violating the company's English-only rule prohibiting employees from speaking Spanish in connection with work. The suit contended the policy violated Title VII of the Civil Rights Act of 1964 and the EEOC regulations promulgated thereunder as a form of national origin discrimination. Along with public interest and private co-counsel, I served as lead counsel in fashioning the legal claim and developing expert evidence; I also shared discovery responsibilities. District Judge Robert Schnacke granted summary judgment to the plaintiffs. The Ninth Circuit (per Judges Diarmuid F. O'Scannlain and John T. Noonan, Jr., with Judge Robert Boochever dissenting) reversed. *Garcia v. Spun Steak Company*, 998 F.2d 1480 (9th Cir. 1993).

Co-counsel: Christopher Ho
Legal Aid Society -- Employment Law Center
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San Francisco, CA 94107
(415) 864-8848
William Orrick, III
Coblentz Patch Duffy & Bass
One Ferry Building, Suite 200
San Francisco, CA 94111
(415) 391-4800

Opposing Counsel: James A. Carter

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Carter Carter & Fries
44 Montgomery Street, Suite #2500
San Francisco, CA 94104
(415) 989-4800

9. *Coalition for Economic Equity v. Wilson*, No. C-96-4024 TEH (N.D. Cal 1996); 946 F. Supp. 1480 (N.D. Cal. 1996); *rev'd* 122 F.3d 692 (9th Cir. 1997); *cert. denied* 522 U.S. 963 (1997); District Judge Thelton E. Henderson; Circuit Judge Diarmuid F. O'Scannlain, Circuit Judge Edward Leavy, Circuit Judge Andrew J. Kleinfeld

In this case, a class of business, labor, and civil rights groups and individuals, supported by a number of public agencies, challenged the constitutionality of California's Proposition 209 which barred race and gender-conscious affirmative action programs in government. The plaintiffs contended that by enacting a state constitutional amendment which disabled state and local agencies from implementing voluntary affirmative action programs designed to prevent and remedy discriminatory and/or exclusionary practices, Proposition 209 interfered with women and minorities' access to local, regional and state government in seeking remedial legislation. The suit contended that by distorting and burdening the political process for women and minorities, Proposition 209 violated the Equal Protection Clause under *Hunter v. Erickson*, 393 U.S. 385 (1969) and *Washington Seattle School District No. 1*, 458 U.S. 457 (1982). The suit also contended that by prohibiting agencies from enacting voluntary affirmative action to prevent discrimination, Proposition 209 conflicted with Title VII and Title VI of the Civil Rights Act of 1964 which encourage voluntary compliance. The District Court (Henderson, J.) ruled in favor of the plaintiffs and enjoined Proposition 209. *CEE v. Wilson*, 946F. Supp. 1480 (N.D. Cal. 1996). The Ninth Circuit reversed and upheld the constitutionality of Proposition 209. 122 F.3d 692 (9th Cir. 1997). The Supreme Court denied *certiorari*. 522 U.S. 963 (1997). I shared responsibility for briefing and argument before the District Court, and briefing in the appellate courts.

Co-counsel: Mark D. Rosenbaum
ACLU Foundation of Southern California
1313 West Eighth Street
Los Angeles, CA 90017
(213) 977-9500

Opposing counsel: Floyd Shimomura
Law Offices of Floyd D. Shimomura
719 Fairview Drive
Woodland, CA 95695
(916) 712-6842

Linda Cabatic
California State Attorney General's Office
Office of Administrative Hearings

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2349 Gateway Oaks Drive, Suite 200
Sacramento, CA 95833
(916) 263-0774

10. *The People v. M.S.*, No. 116304 (San Francisco Superior Court), No. A055072 (California Court of Appeal), No. 2035200 (California Supreme Court), 10 Cal. 4th 698 (1995); California Supreme Court Chief Justice Malcolm M. Lucas, California Supreme Court Justice Kathryn M. Werdegar (authored the opinion), California Supreme Court Justice Armand Arabian, California Supreme Court Justice Marvin R. Baxter, California Supreme Court Justice Ronald M. George, California Supreme Court Justice Stanley Mosk

Defendant juveniles were charged with hate crimes under California Bane Act. The charges arose out beatings occurring in the Castro District of San Francisco. The juveniles challenged the constitutionality of the hate crimes laws, as violative of the First Amendment and Due Process. I authored the amicus brief of the ACLU supporting the victims and the prosecution, defending the constitutionality of the statutes. The California Supreme Court upheld the constitutionality of the hate crimes laws and agreed with the arguments made by the ACLU, and specifically cited our brief in distinguishing violence and threats of violence proscribed by the statute from fighting words and incitement. See 10 Cal. 4th at 714, n.6 and accompanying text.

Prosecutor: Ronald S. Matthias
California State Attorney General's Office
455 Golden Gate Avenue, Suite #11000
San Francisco, CA 94102-3664
(415) 703-5500

Defense counsel: Jean Allan
132 Vicksburg Street
San Francisco, CA 94114
(No contact number provided on State Bar website as of February 2009)

Donna Teshima
Family Youth & Children's Services
Berkeley Mental Health
3282 Adeline Street
Berkeley, CA 94703
(510) 981-5280

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s).

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(Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

I have not performed any lobbying activities other than providing policy positions of the ACLU to legislative bodies.

As a Magistrate Judge, I preside through verdict or other disposition over civil cases in which parties have consented to Magistrate Judge jurisdiction pursuant to 28 U.S.C. § 636(c). In our district, Magistrate Judges are on the draw for newly filed cases. At any given time, I typically have a consent docket of about 100 cases (including cases in which consents are pending). I have tried 15 cases to verdict. I also adjudicate motions assigned by District Judges, typically involving discovery and other pretrial matters. I also serve as a settlement judge in matters referred to Magistrate Judges for settlement. I serve as criminal duty judge two months of every year, during which time I handle all preliminary matters up through indictment, including initial appearances, arraignments, and bail determinations. I retain all misdemeanor cases that appear during my duty through judgment and sentencing. I also grant or deny applications for arrest warrants, search warrants, seizure warrants, pen registers, trap and trace devices, tracking devices, and other investigative requests within Magistrate Judge jurisdiction. I have also empanelled criminal grand juries, adjudicated suppression motions, and taken felony pleas. Finally, Magistrate Judges are involved in court administrative matters. I have served as chair of the Court's Pro Se Committee, am currently the liaison judge for pro bono matters and serve on the Court's Committee on Non-Appropriated Funds. I was responsible for the production of the District Court's *Handbook for Litigants without a Lawyer*. I was appointed by former Chief Judge Mary M. Schroeder to the Ninth Circuit Task Force on Unrepresented Litigants and later appointed Chair of the Implementation Committee which succeeded the Task Force. I also chair the Federal Courts Committee of the California Commission on Access to Justice.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have not held a formal teaching position at a law school. I have guest lectured on a variety of topics at Boalt, Hastings, and Golden Gate on such topics as employment law, constitutional law, and judicial externships. Also, as my resume indicates, I have lectured and participated in panels at numerous continuing education seminars on topics including electronic discovery, employment law, intellectual property, and Asian American legal history. I have also lectured on case management and alternative dispute resolution ("ADR") in India and trained judges of the High Court on mediation in Malaysia. I have been invited to teach as a visiting lecturer at the University of Hawaii School of Law for its "J-Term" in 2010. I have been asked by the Federal Judicial Center to teach a class on implicit bias and judicial decision-making during the 2009 orientation for new magistrate judges.

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20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

    ACLU Foundation of Northern California pension plan – the plan provides defined retirement benefits.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    I intend to continue to oversee property management staff who manage family assets. My compensation will be below the maximum established by the Code of Conduct for United States Judges (*i.e.*, 15% of judicial salary).

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.
    I do not anticipate any relationships or arrangements that are likely to present a conflict-of-interest other than those already on my recusal list described below.

    b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

    I maintain a standing recusal list of individuals and entities consistent with Code of Conduct for United States Judges. These include entities in which I (in any management capacity) own stocks, law firms which I have retained to handle

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personal and business matters, and close friends. I also review the parties and counsel in each case to ensure I do not have a close relationship to any of the parties, identified witnesses, or counsel that would interfere with my neutrality or compromise the appearance of justice.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

Before entering law school, I served as an intern in the Appellate Section of the Division of Civil Rights, U.S. Department of Justice. As a law student, I served as an extern and/or volunteer to San Francisco Neighborhood Legal Services Foundation, Employment Law Center, and the Asian Law Caucus. As an attorney with Coblentz Patch Duffy & Bass, I provided pro bono legal services to an indigent inmate on death row in Arizona (Robert Vickers) at the request of the NAACP Legal Defense and Educational Fund, Fred Korematsu in challenging his World War II conviction for violating the Japanese internment order, and various indigent clients of the Bar Association of San Francisco Volunteer Legal Services Program. In private practice, I devoted 15% of my billable time on pro bono matters. As a staff attorney at the ACLU Foundation of Northern California where I was employed full time for more than 15 years, legal services were provided free of charge.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

Senator Feinstein announced an invitation for applications for position of District Judge. I submitted an application form provided by the Senator's Office on February 5, 2009. I was interviewed by the Senator's Judicial Advisory Committee for the Northern District of California on February 20, 2009. I was then interviewed by David S. Casey, Senator Feinstein's Statewide Coordinator for the Judicial Advisory Process, on March 5, 2009. I was then contacted on March 30, 2009 by staff from the U.S. Department of Justice, Office of Legal Policy, and sent pre-nomination paperwork to complete. I have had subsequent

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conversations with that office regarding the process and paperwork. I was interviewed by staff members of White House counsel and Associate Attorney General Tom Perrelli and Department of Justice staff on May 22, 2009. My nomination was submitted to the Senate on August 6, 2009.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

AFFIDAVIT

I, Edward Milton Chen, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

8/2/09
(DATE)

(NAME)

(NOTARY)

BETTY PUI SIN LEE
COMM. #1645671
NOTARY PUBLIC • CALIFORNIA
SAN FRANCISCO COUNTY
Comm. Exp. FEB. 14, 2010

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
UNITED STATES COURTHOUSE
450 GOLDEN GATE AVENUE
SAN FRANCISCO, CA 94102

CHAMBERS OF
EDWARD M. CHEN
UNITED STATES MAGISTRATE JUDGE

January 20, 2010

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
Washington, DC 20510

Dear Mr. Chairman:

I have reviewed the Senate Questionnaire I previously filed in connection with my nomination on August 6, 2009 as a United States District Judge for the Northern District of California. With the following exceptions, I certify that the information contained in that document is, to the best of my knowledge, true and accurate. I have updated my response to question 13.b and question 14. I am forwarding an updated Net Worth Statement and Financial Disclosure Report as requested in the Questionnaire. I am also updating answers to question 3.b of the Confidential Questionnaire for Judicial Nominees.

Q. 13b – Citations

Knopp v. Life Ins. Co. of N. Am., No. C-09-0452 CRB (EMC), 2009 U.S. Dist. LEXIS 120267 (N.D. Cal. Dec. 28, 2009)

Seastrom v. Department of the Army, No. C-08-4108 EMC, 2009 U.S. Dist. LEXIS 119840 (N.D. Cal. Dec. 23, 2009)

Finley v. County of Martin, No. C-07-5922 EMC, 2009 U.S. Dist. LEXIS 119863 (N.D. Cal. Dec. 23, 2009)

Zhang v. Saks, Inc., No. C-09-4447 EMC, 2009 U.S. Dist. LEXIS 118333 (N.D. Cal. Dec. 21, 2009)

Berry v. UCSF, No. C-09-0499 EMC, 2009 WL 5092027 (N.D. Cal. Dec. 17, 2009)

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Dudek v. Law Office of Scott Carruthers, No. C-09-1591 EMC, 2009 U.S. Dist. LEXIS 121741 (N.D. Cal. Dec. 15, 2009)

Clemens v. J.P. Morgan Chase Nat'l Corporate Servs., No. C-09-3365 EMC, 2009 U.S. Dist. LEXIS 111646 (N.D. Cal. Dec. 1, 2009)

J2 Global Communications, Inc. v. Blue Jay Inc., No. C 08-4254 PJH, 2009 WL 4572726 (N.D. Cal., Dec. 1, 2009)

Hendricks v. Detroit Diesel Corp., No. C-09-3939 EMC, 2009 U.S. Dist. LEXIS 116872 (N.D. Cal. Nov. 25, 2009)

Harwood Inv. Co. v. Wells Fargo Bank, N.A., No. C-09-3410 EMC, 2009 U.S. Dist. LEXIS 109872 (N.D. Cal. Nov. 24, 2009)

Harris v. Vector Mktg. Corp., No. C-08-5198 EMC, 2009 U.S. Dist. LEXIS 113208 (N.D. Cal. Nov. 20, 2009)

Stevens v. Thomas Keller Rest. Group, No. C-09-0622 EMC, 2009 U.S. Dist. LEXIS 112408 (N.D. Cal. Nov. 17, 2009)

Santos v. Peralta Cmty. College Dist., No. C-07-5227 EMC, 2009 U.S. Dist. LEXIS 106143 (N.D. Cal. Nov. 13, 2009)

Simpson v. McNack, No. C-06-4837 EMC, 2009 U.S. Dist. LEXIS 105527 (N.D. Cal. Nov. 12, 2009)

Harris v. Vector Marketing Corp., No. C-08-5198 EMC, 2009 WL 3710696 (N.D. Cal. Nov. 4, 2009)

United States v. Hawley, No. CR-09-0610 EMC, 2009 U.S. Dist. LEXIS 105640 (N.D. Cal. Oct. 30, 2009)

Scott v. Astrue, No. C-09-1549 EMC, 2009 U.S. Dist. LEXIS 100633 (N.D. Cal. Oct. 29, 2009)

Hines v. Cal. PUC, No. C-07-4145 CW (EMC), 2009 U.S. Dist. LEXIS 107838 (N.D. Cal. Oct. 29, 2009)

County of Santa Clara v. Astra USA, Inc., No. C-05-3740 WHA (EMC), 2009 U.S. Dist. LEXIS 107841 (N.D. Cal. Oct. 23, 2009)

Sullivan v. Washington Mut. Bank, FA, No. C-09-2161 EMC, 2009 U.S. Dist. LEXIS 104074 (N.D. Cal. Oct. 23, 2009)

Cuviello v. City of Oakland, No. C-06-5517 MHP (EMC), 2009 U.S. Dist. LEXIS 102537 (N.D. Cal. Oct. 19, 2009)

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Finley v. Count of Martin, No. C-07-5922 EMC, 2009 U.S. Dist. LEXIS 98507 (N.D. Cal. Oct. 13, 2009)

Yee v. United States Sec'y of Labor, No. C-08-4259 MMC (EMC), 2009 U.S. Dist. LEXIS 89978 (N.D. Cal. Sept. 29, 2009)

Sinclair v. City of Sacramento, No. C-07-5668 EMC, 2009 U.S. Dist. LEXIS 86358 (N.D. Cal. Sept. 4, 2009)

Harris v. Vector Mktg. Corp., No. C-08-5198 EMC, 2009 U.S. Dist. LEXIS 80634 (N.D. Cal. Sept. 4, 2009)

County of Santa Clara v. Astra USA, Inc., No. C-05-3740 WHA (EMC), 2009 U.S. Dist. LEXIS 85742 (N.D. Cal. Sept. 3, 2009)

Parker West Int'l, LLC v. Clean Up Am., Inc., No. C-08-2810 EMC, 2009 U.S. Dist. LEXIS 86346 (N.D. Cal. Sept. 1, 2009)

Stuart v. Radioshack Corp., 259 F.R.D. 200 (N.D. Cal. 2009)

Consumer Solutions Reo, LLC v. Hillery, No. C-08-4357 EMC, 2009 U.S. Dist. LEXIS 76244 (N.D. Cal. Aug. 26, 2009)

United States v. Garfias, No. CR-09-xr-90128 EMC, 2009 U.S. Dist. LEXIS 80763 (N.D. Cal. Aug. 20, 2009)

Visintini v. Hayward, No. C-08-5393 EMC, 2009 U.S. Dist. LEXIS 68426 (N.D. Cal. Aug. 5, 2009)

Banga v. Experian Info. Solns., No. C-08-4147 SBA (EMC), 2009 U.S. Dist. LEXIS 71460 (N.D. Cal. Aug. 4, 2009)

J2 Global Communs., Inc. v. Blue Jay, Inc., No. C-08-4254 PJH (EMC), 2009 U.S. Dist. LEXIS 111609 (N.D. Cal. Aug. 4, 2009)

Saxon Mortg. Servs. v. Hillery, No. C-08-4357 EMC, 2009 U.S. Dist. LEXIS 67160 (N.D. Cal. Aug. 3, 2009)

Q. 14 – Recusal

9/18/09, C09-4194 EMC, Loskot v. Bravo Pizza, et al.

The plaintiff is represented by Thomas Frankovich. Mr. Frankovich had previously filed a lawsuit against a restaurant and the owner of the building which leased space to the restaurant, a family limited liability company of which I am a member and manager.

Sincerely,

Edward M. Chen
U.S. Magistrate Judge

cc:
The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
Washington, DC 20510

Senator FRANKEN. Thank you, Judge Chen.

Ms. Gee, we have met your Mom, but I want to say welcome once again and thank you for coming. And any opening statements you would like to make, please, now would be a good time.

STATEMENT OF DOLLY M. GEE, TO BE DISTRICT JUDGE FOR THE CENTRAL DISTRICT OF CALIFORNIA

Ms. GEE. Thank you, Chairman Franken. I would like to thank President Obama for nominating me to the Central District court bench. I would also like to thank Senators Feinstein and Boxer for their support, and Senator Boxer for her kind and gracious introduction. I would also like to thank you, Chairman Franken, and Ranking Member Sessions and all of the other members of the Judiciary Committee for considering my application.

At this time, I would like to introduce once again my mother, Helen Gee, who I am blessed to have here with me to experience this occasion.

Senator FRANKEN. Welcome.

Ms. GEE. And I also would like to introduce other people who have come to support me at this hearing from afar: my cousin, Lily Lee; three friends of mine who are like sisters to me: Margo Feinberg, a partner of mine in my law firm; Kathryn Hirano, from Los Angeles; and Betty Bolden.

Senator FRANKEN. Welcome to you all.

Ms. GEE. If I may, I would like to also acknowledge some people who would like to have been here but could not be here: my husband, Albert Wong, who is watching the live webcast; as well as my brother Kelvin and my sister-in-law Kay; and all of my nieces and nephews; and members of my law firm who are also watching.

[The prepared statement of Ms. Gee appears as a submission for the record.]

[The biographical information of Ms. Gee follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Dolly Maizie Gee

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Central District of California

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: Schwartz, Steinsapir, Dohrmann & Sommers LLP
   6300 Wilshire Boulevard, Suite 2000
   Los Angeles, California 90048-5268

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1959; Hawthorne, California

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   August 1981 - May 1984, UCLA School of Law; Juris Doctor (June 15, 1984)

   September 1977 - March 1981, University of California, Los Angeles; B.A., 1981

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

   1986 - present
   Schwartz, Steinsapir, Dohrmann & Sommers LLP
   6300 Wilshire Boulevard, Suite 2000

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Los Angeles, California 90048-5268
Partner (January 1991 – Present)
Associate (October 1, 1986 – December 1990)

1994 – 1999
Federal Service Impasses Panel (Federal Labor Relations Authority) (part-time)
1400 K Street, N.W., Suite 200
Washington, D.C. 20005
Panel Member

Asian Americans & Civil Rights, UCLA School of Law (part-time)
Los Angeles, California 90095
Lecturer (February 1994 - May 1994)

1984 – 1986
United States District Court for the Eastern District of California
Honorable Milton L. Schwartz, United States District Judge (deceased)
former U.S. Courthouse
650 Capitol Mall
Sacramento, California 95814
Law Clerk

Taylor, Roth & Hunt
Los Angeles, California
Law clerk (June 1983 - August 1983)

Asian Law Caucus
468 Bush Street, 3rd Floor
San Francisco, California 94108
Law clerk (June 1982 - August 1982)

Unpaid positions:
Bet Tzedek Legal Services (part-time)
145 S. Fairfax Avenue
Los Angeles, California 90036
Clinical Extern (January 1984 - May 1984)

California Supreme Court
Honorable Allen Broussard, Associate Justice (deceased)
350 McAllister Street
San Francisco, California 94102
Student Extern (August 1983 - December 1983)

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social

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security number) and type of discharge received, and whether you have registered for selective service.

I have not served in the U.S. Military or registered for selective service.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

Named a "Southern California Super Lawyer" by *Los Angeles Magazine* (2004-09)
President's Award, Asian Pacific American Bar Association of Los Angeles (2008)
Trailblazer Award, National Asian Pacific American Bar Association (2001)
Public Service Award, Asian Pacific American Bar Association of Los Angeles (1999)
Certificates of Recognition from the Mayor of Los Angeles, Los Angeles City Attorney, and California Secretary of State for service rendered as President of Southern California Chinese Lawyers Association during the 1992 civil unrest (1993)
State Bar of California, Wiley W. Manuel Award for Pro Bono Legal Services (1991 & 1993)
Community Service Award, City of Monterey Park (1992)
Community Service Award, Los Angeles City Human Relations Commission (1991)
Distinguished Advocate Award, UCLA Law School Moot Court Honors Competition (1983)
Hortense Fishbaugh Scholarship (1982)
Summa Cum Laude, UCLA (1981)
UCLA Chancellor's Marshal (1981)
Phi Beta Kappa Society (1981)
Gold Medal, Pac-10 Southwest Regional Champion, Novice 8, UCLA Women's Crew Team (1979)
Scholar-Athlete Award, UCLA Athletics Department (1979)

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

Ninth Circuit Advisory Board, Member (2005-08)

State Bar of California (1984-present); Member, Commission on Judicial Nominees Evaluation (1996-98)

U.S. District Court, Central District of California, Standing Committee on Discipline (1999-2001)

U.S. District Court, Central District Lawyer Representative, Ninth Circuit Judicial Conference (1993-96)

American Bar Association

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Los Angeles County Bar Association (1986-present); Member, Board of Trustees (1993-95); Delegate, State Bar Conference of Delegates (1993 & 1994); Member, Judicial Appointments Committee (1993-95); Member, Diversity in the Legal Profession Committee (Member, Labor & Employment Section (1992-present)

Asian Pacific American Bar Association of Los Angeles County; Co-Founder and Member, Board of Governors (1998-2000)

Asian Pacific American Women Lawyers Alliance

National Asian Pacific American Bar Association ("NAPABA") (1989-present)

Multicultural Bar Alliance; Co-Founder (1992)

National Lawyers Guild, Los Angeles Chapter

Southern California Chinese Lawyers Association (1986-present); President (1992-93); President-Elect (1991-92); Member, Board of Governors (1988-91); Co-Chair, Joint Minority Bar Task Force on Diversity (1993-95); Co-Chair, Food Basket Program (1990 & 1991)

Southern California Civil Rights Coalition, Co-Chair (1990-92)

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

California State Bar – December 3, 1984

There has been no lapse in membership.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

All state courts in the State of California – December 3, 1984
United States District Court, Central District of California – December 28, 1984
United States District Court, Eastern District of California – August 29, 1986
United States District Court, Southern District of California – January 7, 1987
United States District Court, Northern District of California – January 3, 2000
United States Court of Appeals for the Ninth Circuit – June 14, 1988

There has been no lapse in membership.

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11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Chinese American Museum of Los Angeles (2004-present)

Ninth Circuit Historical Society (1999-present)

Western Center on Law and Poverty, Member, Board of Directors (1993-95); Vice President (1996-98)

California Women's Law Center, Member, Board of Directors (1995-98)

Asian Pacific American Legal Center of Southern California, Member, Board of Directors (1983, 2003-present); Executive Advisory Board (1992)

Asian Pacific Americans for a New L.A., Co-Chair (1993-94)

Museum of Tolerance (1992-93)

American Civil Liberties Union (1990-99)

Automobile Club of Southern California (1989-present)

UCLA Asian Pacific Alumni Association; Member, Board of Directors (1988-92); Co-Chair, Educational Concerns Committee (1988-92)

Phi Beta Kappa Society (1981-present)

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

None of the organizations in which I am or have been a member discriminate on the basis of race, sex, religion or national origin.

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12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

Social Security Administration, Mesa Field Office, Mesa, Arizona & Council 147, American Federation of Government Employees, AFL-CIO , Case No. 97 FSIP 146; Arbitrator's Opinion and Decision, April 14, 1998

Department of the Treasury, Internal Revenue Service, Fresno Service Center, Fresno, California & Chapter 97, National Treasury Employees Union, Case No. 95 FSIP 97; Arbitrator's Opinion and Decision, October 12, 1996

In the Matter of Department of the Army, Army Corps of Engineers, Portland District and Local 7, National Federation of Federal Employees, Case No. 95 FSIP 169; Arbitrator's Opinion and Decision, April 12, 1996

Op-Ed article, "Riordan Delivers Diversity, Up to a Point," Los Angeles Times, co-wrote, July 18, 1993

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

Ethnic Diversity in Los Angeles County Law Firms: Findings from the Survey by the Los Angeles County Bar Association and the Joint Minority Bar Task Force on Diversity, co-wrote the Executive Summary, December 1995

Los Angeles County Bar Association Resolution regarding Proposition 187, edited, October 1994

Southern California Chinese Lawyers Association Newsletter, President's Messages (informal newsletters mailed to approximately 300 Association members during my term as President in 1992-93)

I helped edit but did not sign a joint Asian American Bar Associations letter to Sen. Alan Cranston regarding the nomination of Robert Bork. The letter was dated September 21, 1987.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal

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interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

Incoming President's Remarks, Seventeenth Annual Installation Dinner of the Southern California Chinese Lawyers Association, March 27, 1992

Panelist, "Racial Relations," Vietnamese American Student Conference, UCLA, April 24, 1993

Moderator, program discussing issues facing Asian Pacific women in the law, New Otani Hotel, Los Angeles, August 1992

Speaker, press conference by Asian American leaders following verdict in case of four police officers tried for the beating of Rodney King, April 30, 1992

Although I do not have verbatim notes, I have provided the basic text of a speech which reflects a general outline for all of the following remarks relating to Proposition 209, a California ballot measure banning affirmative action by public entities:

Panelist, "Civil Rights or Civil Wrong?: The California Civil Rights Initiative and the Case for Affirmative Action," Women Lawyers Association of Los Angeles, May 23, 1995

Panelist, "Civil Rights or Civil Wrong?: The Case for Affirmative Action," Southern California Chinese Lawyers Association, August 8, 1995

Panelist, "Affirmative Action Isn't Just Black and White: Asian Pacific American and Latino Perspectives in Support of Affirmative Action," April 13, 1996, sponsored by the Mexican American Legal Defense & Education Fund and the Asian Pacific American Legal Center of Southern California

Speaker, "History of Affirmative Action," Racial Justice Symposium, YWCA of Greater Los Angeles, April 23, 1996

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Panelist, "Proposition 209: Affirmative Action Debate," Japanese American Citizens League, San Fernando Valley Chapter, October 11, 1996

As an officer or board member of the Southern California Chinese Lawyers Association, the Los Angeles County Bar Association, and the Asian Pacific American Bar Association of Los Angeles County, I often was invited to speak at many bar-related functions of which I maintain no records. I either did not use notes or did not retain any notes from those speeches. To the best of my recollection, those speeches pertained to bar association programs, including student mentorship, mandatory continuing legal education, professional development, or community service/pro bono activities (especially in connection with the 1992 civil unrest in Los Angeles), and did not involve any issues relating to constitutional law or legal policy. The following are such oral presentations that I recall and for which I could find no record of my remarks:

Panelist, "Asian American Women in the Law," Loyola Law School Asian Pacific American Law Students Association, March 25, 1993

Panelist, "Creating a Joint Asian American Bar Association," Loyola Law School, October 20, 1993

Panelist, "Hot Topics in Employment Law," Americans With Disabilities Act and Family Medical Leave Act, Asian Pacific American Legal Center, December 14, 1993

Workshop Presenter (Sexual Harassment), 1994 17th Annual Women's Conference, Pasadena Commission of the Status of Women, March 5, 1994

Moderator, "Empowerment Through Effective Communication," Public Speaking Workshop for Women, Asian Pacific American Women's Alliance, Loyola Law School, October 22, 1994

Workshop Moderator, Informal and Formal Grievance Processes; National Center for State Courts, First National Conference on Eliminating Racial & Ethnic Bias in the Courts, March 2-5, 1995, Albuquerque, New Mexico
Panelist, "Survival Skills," Maximizing Employability in the 90s Conference, Loyola Law School, March 1, 1997

Speaker, "Background Regarding Formation of APABA," Asian Pacific American Bar Association Founders' Reception, September 16, 1998

Speech upon receiving Trailblazer Award at the National Asian Pacific American Bar Association Annual Convention, Scottsdale, Arizona, November 16, 2001

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Panelist, "Maximizing Employability Conference," Loyola Law School, March 31, 2001

Speaker, "Litigation Practice Tips: The New Federal Rules," 2001 United Food & Commercial Workers Attorneys' Conference, La Costa, California, September 10, 2001

Panelist, "Writers' Block: An Update on the Writers' Age Discrimination Case," Los Angeles County Bar Association, Labor & Employment Law Section, Entertainment Industry Labor & Employment Law Conference, December 2, 2005

Panelist, "Looking Forward: Public & Community Service in a New Economy," National Asian Pacific American Bar Association 2009 Regional Conference, June 20, 2009

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

Class-action suit filed by television writers who say they are being discriminated against because of age, National Public Radio (NPR), January 11, 2003.

Asian-Americans break through, make mark in the practice of law, The San Diego Union-Tribune, November 28, 1994.

LOS ANGELES STILL ASLEEP AFTER WAKE-UP CALL: A year after riots, there is anger at government inaction, The Financial Post (Toronto, Canada), March 16, 1993.

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? _____

i. Of these, approximately what percent were:

jury trials? ___%; bench trials ___% [total 100%]

civil proceedings? ___%; criminal proceedings? ___% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

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c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

e. Provide a list of all cases in which certiorari was requested or granted.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have not held a judicial office.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

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c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I have not served as judge.

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

From October 3, 1994 to January 10, 1999, I served as a member of the Federal Service Impasses Panel ("FSIP"), which is an agency within the Federal Labor Relations Authority established under 5 U.S.C. § 7119. President Clinton appointed me to this seven-member Panel. My term expired on January 10, 1999. The other Panel members and I served as neutral decision-makers in resolving impasses between federal labor unions and federal agencies. This was a part-time position.

In 1995-96, 1999-2000, and 2005-06, the Office of the Election Officer appointed me as a Regional Coordinator of the International Brotherhood of Teamsters ("IBT") Delegate and Officer Elections held in those years. The Office of the Election Officer, an independent election monitor, was established under the supervision of the Honorable David N. Edelstein, U. S. District Judge for the Southern District of New York, pursuant to the Consent Order entered on March 21, 1989 in the matter of U. S. v. International Brotherhood of Teamsters, et al., 88 Civ. 4486 (DNE). In my position as Regional Coordinator, I served as a neutral supervisor of the delegate elections of 27 IBT local unions in Southern California, Nevada, and Hawaii. During those elections, I also investigated and recommended dispositions for election protests relating to alleged violations of election rules.

In May 1999, I was nominated by President Clinton to be United States District Judge for the Central District of California. My nomination was returned to the President on December 15, 2000.

I have never been a candidate for elective office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have

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ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

None.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

From September 10, 1984 to August 29, 1986, I served as a law clerk to the Honorable Milton L. Schwartz, United States District Judge for the Eastern District of California.

ii. whether you practiced alone, and if so, the addresses and dates;

I have never practiced alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

1986 - present
Schwartz, Steinsapir, Dohrmann & Sommers LLP
6300 Wilshire Boulevard, Suite 2000
Los Angeles, California 90048-5268
Partner (January 1991 – Present)
Associate (October 1, 1986 – December 1990)

1994 – 1999
Federal Service Impasses Panel (Federal Labor Relations Authority) (part-time)
1400 K Street, N.W., Suite 200
Washington, D.C. 20005
Panel Member

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

(1) I have served as an arbitrator for the Kaiser Permanente Independent Arbitration System since 2000. I was selected as the arbitrator in

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approximately eight cases, four of which settled or were dismissed and four of which resulted in the issuance of an Opinion and Award following arbitration.

(2) In 1994, President Clinton appointed me to serve as a member of the Federal Service Impasses Panel ("FSIP"), an agency within the Federal Labor Relations Authority ("FLRA"). As a member of the FSIP from 1994 to 1999, I participated in hundreds of FSIP decisions relating to impasses between federal labor unions and federal agencies. In those instances where I was individually assigned to mediate/arbitrate cases, I successfully mediated three cases and issued an Opinion and Decision or prepared a Decision and Order on behalf of the Panel in five cases. The Opinions and Decisions are reported in the FSIP Releases through the FLRA. The following are eight examples of the mediations and arbitrations in which I participated as the neutral:

(a) Department of the Treasury, Internal Revenue Service, Fresno Service Center, Fresno, California & Chapter 97, National Treasury Employees Union (10/12/96), Case No. 95 FSIP 97

Following a mediation/arbitration, I issued an Opinion and Decision banning indoor smoking and establishing outdoor smoking areas.

(b) Department of the Army, Army Corps of Engineers, Portland District, Portland, Oregon & Local 7, National Federation of Federal Employees (4/12/96), Case No. 96 FSIP 169

Following mediation/arbitration, I issued an Opinion and Decision regarding bargaining over permissive subjects, establishment of a peer recognition award program, payment of travel and per diem expenses for Union officials on official time, and the method of accounting for official time.

(c) Department of the Interior, Bureau of Reclamation, Yuma Area Office, Yuma, Arizona & Local R14-143, National Association of Government Employees (6/12/96), Case No. 96 FSIP 56

This case involved a successful mediation regarding which entities to include in a prevailing wage survey relating to wages and wage practices for a 16-member unit of dredging employees, and whether a negotiated wage increase would be retroactive.

(d) Department of Energy, Western Area Power Administration, Golden, Colorado & Local 3824, American Federation of Government Employees, AFL-CIO (9/9/96), Case No. 96 FSIP 99

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Following an informal conference which did not resolve the impasse, I prepared a Decision and Order on behalf of the Panel regarding the numbers, types, and grades of bargaining-unit employees affected by the Employer's proposed reorganization of three regional offices of the agency.

(e) Department of Defense, Defense Commissary Agency, Fairchild Air Force Base, Fairchild AFB, Washington & Local 11, National Federation of Federal Employees (3/13/97), Case No. 97 FSIP 25

In this case, I successfully mediated a dispute regarding seven articles in the parties' initial collective bargaining agreement, including Grievance Procedure; Work Schedules; Work Environment; Health, Safety and Welfare; Hazard and Differential Pay; Contracting Out; and Miscellaneous Provisions.

(f) Department of Commerce, Patent and Trademark Office, Arlington, Virginia & Patent Office Professional Association (6/2/97), Case No. 97 FSIP 62

I successfully mediated a settlement between two very contentious parties resolving 43 Union proposals and 16 Employer proposals arising from bargaining over a reorganization and move of employees within the Crystal City, Virginia office complex.

(g) Department of the Treasury, Internal Revenue Service, Fresno Service Center, Fresno, California & Chapter 97, National Treasury Employees Union (9/22/97), Case No. 97 FSIP 102

Following an informal conference, I prepared a Decision and Order on behalf of the Panel regarding two alternative work schedule ("AWS") issues arising during renegotiations of a local AWS agreement.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

My practice is diverse and includes civil litigation, class actions, arbitration, appeals, negotiations, and transactional work, with an emphasis in the areas of labor and employment law. In addition to court litigation, I also have appeared before administrative agencies and commissions such as the National Labor Relations Board, the California Public Employment Relations Board, the U.S. Equal Employment Opportunity Commission, and the California Department of Fair Employment and Housing. I have represented plaintiffs as well as

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defendants in employment discrimination and sexual harassment cases. At times, I am appointed by insurance companies to provide representation to defendants under comprehensive general liability, fiduciary, or directors and officers insurance policies.

I conduct independent workplace investigations of alleged employee misconduct. I frequently provide employees with training on sexual harassment and other employment laws. I advise individual clients regarding covenants not to compete and negotiate initial employment contracts and severance packages for professionals and executives in diverse fields, including academia and the accounting, banking, health care, and entertainment industries.

Since the year 2000, in addition to the work outlined above, I have served as an arbitrator for the Kaiser Permanente Independent Arbitration System and have been selected to serve as an arbitrator in several alleged medical malpractice or breach of contract cases. During the 1995-96, 1999-2000, and 2005-06 International Brotherhood of Teamsters Delegate and Officer Elections, I served as a neutral Regional Coordinator under the auspices of the Office of the Election Officer, established under the supervision of Hon. David N. Edelstein, U.S. District Judge for the Southern District of New York. In that capacity, I supervised ballot counts and investigated and recommended dispositions for election protests relating to alleged violations of election rules.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

Throughout my career, I have served as counsel to individuals, class members, employee benefit trust funds, employers, and labor organizations. Since approximately 1995, I also have served as a mediator and an arbitrator.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

During the course of my career, I have appeared in court frequently to occasionally, depending upon the nature of the litigated cases at issue in a given time. My caseload is diverse and includes transactional work, court litigation, with a substantial pre-trial motion practice, and litigation in arbitral and other forums, such as administrative agencies and commissions. In 1995 and 1999, I spent a substantial amount of time serving as Regional Coordinator of the International Brotherhood of Teamsters Delegate and Officer Elections. As a result, I had fewer appearances in court during that period of time.

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i. **Indicate the percentage of your practice in:**
   1. **federal courts:** 50%
   2. **state courts of record:** 40%
   3. **other courts;**
   4. **administrative agencies:** 10%

ii. **Indicate the percentage of your practice in:**
   1. **civil proceedings:** 100%
   2. **criminal proceedings.**

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I served as associate counsel in one jury trial and lead counsel in one bench trial. I served as associate counsel in one other bench trial which settled before a judgment was rendered. I have served as sole counsel in six administrative hearings and eight arbitrations, where a final decision was rendered rather than settled.

i. **What percentage of these trials were:**
   1. **jury:** 50% of the court trials mentioned above
   2. **non-jury.** 50% of the court trials mentioned above

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

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(1) In Re TV Writers Cases, Case Nos. BC 268836, etc.; Hon. Emilie H. Elias, Los Angeles Superior Court

In 2002, I joined with two other law firms and the AARP Foundation Litigation as co-counsel in litigating 23 separate precedent-setting class action lawsuits filed by more than one hundred television writers against (i) twelve different groups of television networks, studios, and production companies, and (ii) eleven major talent agencies. We represent plaintiffs—television writers who are members of the Writers Guild of America over age 40—who assert that each of the agencies, networks, and studios has for many years engaged in an industry-wide pattern or practice of age discrimination denying representation and employment to older television writers in Hollywood. Plaintiffs allege a violation of the Fair Employment and Housing Act, Cal. Gov't Code §§ 12920 *et seq.*; the Unruh Civil Rights Act, Cal. Civ. Code §§ 51 & 51.5; and the Unfair Competition Law ("UCL"), Cal. Bus. & Prof. Code §§ 17200 *et seq.*

The TV Writers Cases are currently pending in the Los Angeles Superior Court's Complex Civil Division. The following reported decisions arise out of the TV Writers Cases: *Alch, et al. v. Superior Court*, 165 Cal. App. 4th 1412 (2008) and *Alch, et al. v. Superior Court*, 122 Cal. App. 4th 339 (2004).

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(2) Elliott, et al. v. Board of Trustees of Kaiser Steel Corp. Retirees' Benefit Trust, et al., Case No. CV 06-4716 AG (AJWx); Mulloy, et al. v. Moreno, et al., Case No. CV 06-3910 AG (AJWx); Hon. Andrew J. Guilford; U.S. District Judge, Central District of California, Southern Division

These two related class actions arose from allegations of fiduciary breach against current and former trustees of the Kaiser Steel Corporation Retirees Benefit Trust ("RBT") under the Employee Retirement Income Security Act of 1974 ("ERISA"), as amended, 29 U.S.C. §§ 1104 and 1105. I represented the current RBT Trustees, who were plaintiffs in the Mulloy case, in prosecuting former RBT Trustees for breach of fiduciary duty, including misuse of trust assets. I also represented the current RBT Trustees in defending against claims of fiduciary breach brought by plan participants in the Elliott case. I successfully defended the current RBT Trustees against the Elliott plaintiffs'

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motions for preliminary injunction and for imposition of a receivership. In 2007, the current RBT Trustees recovered over $400,000 for the RBT pursuant to a class action settlement in the Mulloy case. The Elliott case also resulted in a class action settlement with the appointment of a special master to oversee the RBT's management of certain trust assets and provide periodic reports to the court.

Opposing Counsel: Richard D. McCune, Jr., Esq. (plaintiffs' counsel in Elliott case)
McCune Wright LLP
2068 Orange Tree Lane, Suite 216
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(909) 557-1250

Kenneth E. Johnson, Esq. (defense counsel in Mulloy case)
Theodora, Oringher, Miller & Richman PC
2029 Century Park East, 6th Floor
Los Angeles, CA 90067-2907
(310) 557-2009

(3) UAW v. Titan International, Inc., Case No. CV 99-9435-DT (RCx); Hon. Dickran Tevrizian (retired); U.S. District Judge, Central District of California

I represented plaintiff United Auto Workers' ("UAW") in this one in a series of federal court actions filed under the Labor-Management Relations Act, 29 U.S.C. § 185(a), pertaining to plaintiff United Auto Workers' ("UAW") claim that the closure, sale and lease of defendant's subsidiary's wheel production facility violated the parties' collective bargaining agreement. Following an arbitration in which the arbitrator ruled in favor of the UAW, the UAW pursued this action against the parent corporation contending that it was an alter ego of and/or joint employer with its subsidiary. The matter resolved after defendant agreed to pay over $2 million into a qualified settlement fund for distribution to 165 employees who lost their jobs as a result of defendant's plant closure.

Opposing Counsel: William Waldo, Esq.
(formerly of Paul Hastings)
Bononi Law Group LLP
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Los Angeles, CA 90071
(213) 553-9200

(4) Express Postal Options International, et al. v. Deutsche Post Global Mail, Ltd., Case No. CV-03-3281 RSWL (RCx); Hon. Ronald S. W. Lew; U.S. District Judge, Central District of California

I filed this case in state court on behalf of plaintiffs seeking declaratory relief regarding the enforceability of the non-competition clauses in their employment agreements with defendant, their former employer. Defendant, a large business competitor and multinational corporation, removed the case to federal court invoking diversity

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jurisdiction and filed a parallel action against my clients in the New Jersey state court. The case was heavily litigated, with cross-applications for temporary restraining orders, a motion for preliminary injunction, discovery motions, a motion for partial summary judgment, and cross-motions for summary judgment. The case finally settled with the assistance of Hon. Rosalyn Chapman, Magistrate Judge.

Opposing Counsel: Thomas Petrides, Esq.
K & L Gates LLP
10100 Santa Monica Blvd., 7th Floor
Los Angeles, CA 90067
(310) 552-5000

(5) Russell Alexander vs. Board of Trustees, Compton Unified School District, Los Angeles Superior Court (South Central Court District), Case No. TC005378; Hon. Enrique Romero (former Los Angeles Superior Court Judge).

I filed a petition for writ of mandate on behalf of a public school administrator to challenge the School District's failure to abide by its own rules and regulations when it demoted him on three consecutive occasions without regard to his seniority and positive job evaluations. The trial court granted the petition for writ of mandate and ordered that my client be reinstated to his former administrative position. The School District appealed and the Court of Appeal affirmed the trial court's decision in favor of my client.

Opposing Counsel: Melanie E. Lomax, Esq. (deceased)

(6) Bench, et al. v. The Walt Disney Company, et al., Case No. CV-S-97-8203 TJH (AIJx); Hon. Terry J. Hatter; Senior U.S. District Judge, Central District of California

I represented plaintiffs in this class action on behalf of over 4000 class members (retired and current employees of the Disney defendants), seeking to enforce Disney's promise of lifetime, cost-free retiree health care benefits under ERISA, 29 U.S.C. § 1001 *et seq.* and the LMRA, 29 U. S. C. § 185. After approximately four years of litigation, the case resolved pursuant to two separate class settlements for different subclasses ensuring lifetime retiree health care benefits with various eligibility requirements.

Co-Counsel: William T. Payne, Esq.
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Opposing Counsel: Phyllis Kupferstein, Esq.
(formerly of Quinn Emanuel Urquhart Oliver & Hedges)
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Los Angeles, CA 90017
(213) 236-9107

(7) Dunihue, et al. vs. USWA, et al., SA CV 90-0663 GLT(RWRx); Dunihue and Felde vs. Bitonti, et al., SA CV 91-0316-GLT (RWRx) (consolidated action); Hon. Gary L. Taylor (retired); U.S. District Judge, Central District of CA, Southern Division

I represented nine defendants, the United Steelworkers of America, the Kaiser Steel Corporation Retirees Benefit Trust, and seven individual trustees, in defending against 16 causes of action for alleged breach of fiduciary duty and prohibited transactions under ERISA and for alleged RICO violations. During the course of this action, I brought three separate motions to dismiss and a motion for summary judgment, successfully opposed a motion for preliminary injunction, successfully opposed a motion to compel discovery, and served as trial counsel in a seven-day bench trial. After plaintiffs rested their case and I made an oral motion to dismiss under Fed. R. Civ. P. 52(c), the Court entered judgment on all 16 counts in favor of my clients.

Co-Counsel: Joseph Austin, Esq. (inactive status)
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Linda Klamm, Esq.
Hanson Bridgett LLP
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San Francisco, CA 94105
(415) 777-3200

Opposing Counsel: Daniel E. O'Neill, Esq. (inactive status)
8804 Tamarind
Fontana, CA 92335
(909) 822-5330

(8) United States of America vs. International Union of Petroleum and Industrial Workers, Case No. CV 88-00343-WMB (GHKx); Hon. William M. Byrne (deceased); U.S. District Judge, Central District of California

I represented defendant, International Union of Petroleum and Industrial Workers ("IUPIW"), in successfully opposing a subpoena enforcement action brought by the U. S. Department of Labor ("DOL"). The DOL sought to obtain documents in the possession

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of the IUPIW's local unions by serving a subpoena duces tecum on the International Union rather than on the local unions themselves. The Court denied the DOL's motion to enforce the subpoena duces tecum and the DOL appealed. The case ultimately resulted in a published Ninth Circuit opinion affirming the District Court's decision. (United States v. IUPIW, 870 F.2d 1450 (9th Cir. 1989).)

Opposing Counsel: Hon. Claudia J. Silbar (former Assistant U. S. Attorney)
Orange County Superior Court
700 Civic Center Drive West
Orange, CA 92701
(714) 834-3341

(9) United Food & Commercial Workers Union, Local 770 vs. Vons Grocery Company, Case No. CV 87-04337-RMT(Kx); Hon. Robert M. Takasugi; Senior U.S. District Judge, Central District of California

The collective bargaining agreement between my client, United Food & Commercial Workers Union, Local 770, and respondent, Vons Grocery Company, contained a successorship provision which required any buyer of a retail grocery store to agree to abide by the terms of the Local 770 collective bargaining agreement. Vons attempted to consummate the sale of the store without requiring the buyer to honor the successorship provision. I filed a Petition to Compel Arbitration under Section 301 of the Labor-Management Relations Act ("LMRA"), 29 U.S.C. § 185, and obtained a preliminary injunction preventing the sale pending expedited arbitration of Local 770's contractual claim. The case was resolved after Local 770 prevailed in the arbitration.

Opposing Counsel: Lawrence J. McLaughlin, Esq.
McLaughlin & Irvin
2661 Tallant Road, Suite 709
Santa Barbara, CA 93105
(818) 667-1401

(10) National Technical College vs. UAW (and counterclaim), CV 86-2665-AWT(Px); Hon. A. Wallace Tashima (former U.S. District Judge).

My law partner Henry M. Willis and I represented defendant and counter-claimant, UAW, in a jury trial in which the parties asserted claims against each other for breach of contract, fraud, and violations of the Racketeer Influenced and Corrupt Organizations Act ("RICO"), 18 U.S.C. § 1961 *et seq*. The UAW alleged that plaintiff and counter-defendant, National Technical College ("NTC"), breached its agreement to provide job training in dental hygiene to unemployed workers through a UAW-sponsored program. The UAW prevailed against NTC in the main action and prevailed on its own counterclaim for breach of contract.

Opposing Counsel: Gary D. Stabile, Esq. (inactive status)
3120 The Strand

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18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

My significant legal activities in addition to my regular law practice have included my work as an arbitrator/mediator on the Federal Service Impasses Panel and my pro bono work. Of particular significance to me is the pro bono work I did on behalf of victims of the 1992 Los Angeles civil unrest with the Asian Pacific American Legal Center of Southern California and the Southern California Chinese Lawyers Association.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

During the spring semester of 1994, I was one of four co-instructors for a course called "Asian Americans & Civil Rights" at the UCLA School of Law. As a part of that course, I lectured on the U.S. Supreme Court cases pertaining to the internment of Japanese Americans during World War II and employment discrimination. I do not have a copy of the syllabus.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

Under my firm's partnership agreement, I am entitled to certain finite payments of partnership income following my withdrawal as a partner: $45,000 of my capital account is payable immediately upon my withdrawal and $200,000 is payable in 72 monthly installments. A pro rata share of firm profits will be paid out within 90 days after my withdrawal from the partnership. In addition, I am entitled to a percentage (based upon my pro rata partnership share as of the time of my withdrawal) of any contingency recovery arising out of the resolution of the In re TV Writers Cases, described above in response to Question No. 17.

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21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    No.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report.

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement.

24. **Potential Conflicts of Interest**:

    a. **Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.**

    Persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when I first assume the position to which I have been nominated, if confirmed, would include any cases involving attorneys affiliated with my law firm or clients represented by my law firm. I plan to recuse myself in all such cases.

    b. **Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.**

    I would comply with the Code of Conduct for United States Judges, including disqualifying myself in those instances where my impartiality might reasonably be questioned and refraining from financial dealings that might reflect adversely on my impartiality. Where disqualification is not required but there may be the appearance of a conflict, I would either voluntarily disqualify myself or disclose the relevant facts to the parties on the record and let them decide whether they wish me to withdraw. I also would review statements of interested parties to ascertain whether there is any basis for my disqualification and comply with any financial reporting requirements.

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25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

Since approximately 1987, I have provided free legal advice to individuals referred to me by the Asian Pacific American Legal Center of Southern California ("APALC"), a non-profit legal organization providing legal services to disadvantaged members of the Asian/Pacific Islander community in Southern California. I also have served on the Board of Directors of the APALC since 2003. Most of the consultations occurred on the telephone and concerned employment or wage and hour issues. From approximately 1987 to 1988, I participated in the Saturday legal clinics sponsored by APALC at the Chinatown Service Center, where I provided free legal advice to individuals on a walk-in basis during a three-hour shift. I gave advice and/or referrals on such topics as landlord-tenant disputes, small claims, wage and hour law, family law, and immigration. I maintain no records of the amount of time I spent on these pro bono services or the identities of the individuals to whom I provided legal advice. Since 2004, I have provided two hours of pro bono training on sexual harassment bi-annually to the staff of APALC. In January 2009, I also provided two hours of pro bono training on sexual harassment to Jewish Family Services.

As co-chair of the Food Basket Committee of the Southern California Chinese Lawyers Association ("SCCLA") in 1990 and 1991, I organized efforts through the Los Angeles Chinatown Service Center to distribute hundreds of holiday food baskets to needy residents of the Los Angeles Chinatown area. I estimate that I expended at least 40 hours per year in that effort.

As President of SCCLA in 1992-93, I helped to organize a three-day "community law school" in Monterey Park where volunteer attorneys provided lectures to members of the local community on such topics as consumer protection, criminal law, landlord/tenant law, and family law.

Following the acquittal of the police officers involved in the Rodney King beating on April 29, 1992, Los Angeles experienced one of the largest outbreaks of urban violence in U.S. history. On April 30, 1992, Thanh Lam was shot and killed as he stopped at a traffic signal in Compton, California. The Lam family's store also was destroyed by arsonists. In my capacity as SCCLA President, I assisted Mr. Lam's family in their unsuccessful effort to find the individual who killed Mr. Lam. I served as their spokesperson and liaison to the FBI task force that investigated the killing and helped them to set up a $10,000 reward through the Los Angeles County Board of Supervisors. In 1992, I was co-chair of Asian Americans for a New L.A. ("APANLA") which served as a clearinghouse for information and coordinated the various relief efforts being undertaken in the Asian American community in the aftermath of the civil unrest. In my capacity as SCCLA President and co-chair of APANLA, I coordinated volunteer attorneys to provide pro bono legal services to the Lam family and many other victims of

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the civil unrest. In addition, I participated in the State Bar of California's LAW-HELP-LA program to assist victims of the Los Angeles civil unrest. I estimate that I spent at least 25 hours per month in pro bono services during the six-month period following the civil unrest. I maintain no records of the time I spent on pro bono legal services during that period.

I served as co-chair of the Southern California Civil Rights Coalition ("SCCRC") from approximately 1990 to 1992. I was SCCLA's representative in the SCCRC. The SCCRC was composed of bar associations and community-based organizations which sought to educate each other and the community at large about civil rights issues and hate crimes. The SCCRC monitored the progress of and supported the passage of the proposed Civil Rights Acts of 1990 and 1991. The Civil Rights Act of 1991 was signed into law by President George H. W. Bush. The SCCRC ceased to exist in 1993.

From approximately 1998 to 2003, I worked with the Community Education Committee of the Asian Pacific American Bar Association of Los Angeles County ("APABA") to develop bilingual brochures regarding basic legal rights and obligations. We developed brochures in the Chinese, Korean and Khmer languages regarding such diverse topics as domestic violence, landlord-tenant law, criminal procedure, employment rights, and citizenship and naturalization. These brochures were used during annual Law Days which APABA sponsored or co-sponsored with other organizations in the San Gabriel Valley and in the Cambodian community.

As a Central District of California lawyer representative to the Ninth Circuit Judicial Conference from 1993 to 1996, I participated on the pro se litigants committee to develop a pilot volunteer mediation program to help diminish the large backlog of prisoners' pro se civil rights cases in the U.S. District Court for the Central District of California.

During the period from 1993 through 1998, I served on the Board of Directors of the Western Center on Law & Poverty, which advocates on behalf of California's poor. My role was to attend quarterly Board meetings and assist the Center in its annual fundraising efforts. I estimate that I devoted approximately 20 hours per year to my duties as a Board member.

From 1996-2000, I gave pro bono legal advice to individuals referred to me on an ad hoc basis by the California Women's Law Center ("CWLC") Breast Cancer Legal Project. Most of the consultations took place on the telephone and concerned employment or insurance law issues. In 1997, I handled a case for a woman with breast cancer who, as a part of her job application, had been asked by a prospective employer to sign an authorization form releasing information pertinent to her medical condition. Since such pre-employment inquiries are impermissible under the Americans With Disabilities Act, I requested that this employer cease asking for such broad-based information in connection with its employment applications. The client died before any court complaint could be filed, but the employer did voluntarily cease the practice. I expended 46 pro bono hours on this case.

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As a member of the Board of Directors of the UCLA Asian Pacific American Alumni Association and Co-Chair of its Educational Concerns Committee from 1988 to 1992, I helped to organize annual careers conferences and develop mentorship programs for undergraduate students at UCLA. I also have served as a mentor to law students through bar association mentorship programs.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

I submitted my personal data questionnaire to Senator Barbara Boxer's office on or about February 27, 2009. Thereafter, by letter dated March 25, 2009, the Chair of Senator Boxer's Central District Judicial Appointment Advisory Committee notified me of my interview date. The Advisory Committee interviewed me on April 9, 2009. On or about May 28, 2009, I was contacted by staff from the U.S. Department of Justice. I have had subsequent conversations with the Department regarding the nomination process and paperwork. On August 3, 2009, I interviewed with Associate Attorney General Thomas Perrelli, staff from the Department of Justice, and representatives from the White House Counsel's office. My nomination was submitted to the Senate on August 6, 2009.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

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AFFIDAVIT

I, Dolly M. Gee, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

9/8/09
(DATE)

Dolly M. Gee
(NAME)

See attached
(NOTARY)

State of California
County of Los Angeles

Subscribed and sworn to (or affirmed) before me on this 8th day of September, 2009, by Dolly M. Gee, proved to me on the basis of satisfactory evidence to be the person(s) who appeared before me.

Signature

(Seal)

ROBERT RODRIGUEZ
Commission # 1825495
Notary Public - California
Los Angeles County
My Comm. Expires Dec 31, 2012

Senator FRANKEN. Thank you, Ms. Gee.
Judge Seeborg.

STATEMENT OF HON. RICHARD SEEBORG, TO BE DISTRICT JUDGE FOR THE NORTHERN DISTRICT OF CALIFORNIA

Judge SEEBORG. Thank you very much, Mr. Chairman. I also will forego an opening statement, but would like to join in some of the thank-you's.

First of all, I would very much like to thank my home-State Senators, Senator Feinstein and Senator Boxer, and also thank Senator Feinstein for her very kind words, which I appreciate very much.

I would like to express my profound gratitude to President Obama for nominating me to this position of very high public trust.

I would like to thank you, Mr. Chairman, for presiding today and Senator Sessions also for participating in the hearings and all the members of the Judiciary Committee.

I would like to acknowledge, as have some of my co-nominees, some people who are not here: my parents, Ken and Jane Seeborg, and my grandparents, Ken and Vivian Sartori. All of them would so much have enjoyed being here, but they are with me in spirit.

I would like to introduce some people who have come with me today, several former colleagues and wonderful friends from my days in the U.S. Attorney's Office: Marcia Jensen, Leo Cunningham, and their daughter, Alexandra, who is a freshman at GW here in Washington. I would also like to introduce my college roommate who has come down from Boston, Jonathan Kaufman, and his son, Nick Kaufman.

Thank you very much, Mr. Chairman.

[The prepared statement of Judge Seeborg appears as a submission for the record.]

[The biographical information of Judge Seeborg follows.]

UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Richard Gus Seeborg

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Northern District of California

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: United States District Court
   280 South First Street
   San Jose, CA 95113

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1956; Landstuhl, Germany

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1978-1981, Columbia University School of Law; J.D., May, 1981

   1974-1978, Yale College; B.A. (History) May, 1978

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

   2001 – Present
   United States District Court for the Northern District of California
   United States Magistrate Judge

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1998 – 2001
Morrison & Foerster
755 Page Mill Road
Palo Alto, CA 94304
Equity Partner

1991 – 1998
Office of the United States Attorney
280 South First Street
San Jose, CA 95113
Assistant United States Attorney

1982 – 1991
Morrison & Foerster
425 Market Street
San Francisco, CA 95104
Associate (1982-1987)
Equity Partner (1987-1991)

1981 – 1982
United States District Court for the District of Columbia
333 Constitution Avenue, NW
Washington, DC 20001
Law Clerk to the Honorable John H. Pratt

July – August 1980
McCutchen, Brown, Doyle & Enerson
Three Embarcadero Center
San Francisco, CA 94105
Summer Law Clerk

May – July 1980
Kirkland & Ellis
1001 K Street
Washington, D.C. 20001
Summer Law Clerk

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

I did not serve in the military.

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8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

College: Phi Beta Kappa; Summa Cum Laude; Distinction in the History Major

Law School: Harlan Fiske Stone Scholar (2nd and 3rd years)

U.S. Attorney's Office:

(1) Commendation by the U.S. Customs Service associated with search warrants in a heroin drug smuggling case. (U.S. Attorney's Bulletin, 1/15/93)

(2) Commendation by the Director of the Office of International Affairs, Department of Justice, in connection with the extradition of Steven Jensen to Canada. (U.S. Attorney's Bulletin, 5/15/93)

(3) Commendation by the Internal Revenue Service in connection with the conviction of Dr. Frederick Slater on tax evasion charges. (U.S. Attorney's Bulletin, 2/15/93)

(4) Commendation by the Special Counsel for Financial Institution Fraud, Department of Justice, in connection with U.S. v. Hopkins, et al. (U.S. Attorney's Bulletin, 5/15/94)

Volunteer Service Award 1987, 1988. San Francisco Department of Social Services (Chair of Morrison & Foerster Holiday Toy Drive).

U.S. Speaker and Specialist Grant, U.S. Department of State to participate in an IPR enforcement program in Italy (March 27–April 3, 2004)

Santa Clara County Trial Lawyers' Association - Federal Judge of the Year 2009

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

Santa Clara County Bar Association 1991-Present (Chair, Federal Courts Committee 2003-2005)

Lawyer Representative to the Ninth Circuit Judicial Conference 1996-1999

Federal Magistrate Judges Association 2001-present

San Francisco County Bar Association 1982-1991

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10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

State of California; January 8, 1982

No lapses in membership until appointed as Magistrate Judge in February 2001. Under the Constitution of California, a person serving as a judge of a court of record is not considered to be a member of the State Bar while in office. See California Constitution Article 6, § 9.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

United States District Court for the Northern District of California, 1982
United States District Court for the Eastern District of California, 1983
United States Court of Appeals for the Ninth Circuit, 1984
United States Court of Appeals for the Third Circuit, 1984

No lapses in membership until appointed as Magistrate Judge in February 2001. Under the Constitution of California, a person serving as a judge of a court of record is not considered to be a member of the State Bar while in office. See California Constitution Article 6, § 9.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

I have served as chair of the Northern District of California's Education Committee and also have been a member of the Rules Committee, the Non-Appropriated Funds Committee, the CJA Administration Committee, and as Liaison Judge to the Admiralty Advisory Lawyers' Group appointed by the Chief Judge. I was responsible for the creation and implementation of the assisted settlement program in the San Jose Division which selected and trained a panel of local lawyers prepared to accept appointment on a pro bono basis to assist pro se litigants in judicially supervised settlement conferences.

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Beyond my responsibilities within the district, in 2003 I was appointed by the Chief Judge of the Ninth Circuit to the Ninth Circuit Jury Instructions Committee, a group consisting of six district judges and one magistrate judge charged with the task of revising the Ninth Circuit pattern jury instructions for both civil and criminal matters. Also, since 2004 I have served as a member of the Electronic Public Access Working Group, a committee selected by the Administrative Office of the United States Courts to consult on improving public access to electronically filed court documents.

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

I am not now nor have I ever been a member of any organization that discriminates on the basis of race, sex, religion, or national origin.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

Co-author, Federal Pretrial Civil Procedure in California, 4 volumes, Matthew Bender & Co., Inc. (2004)

Co-author, Chapter 42, "Trade Libel: California Business Jury Instructions," Matthew Bender & Co., Inc. (1995)

As one of seven federal judicial officers on the Ninth Circuit Jury Instructions Committee, I co-authored the Ninth Circuit Manual of Model Jury Instructions, Civil, published by Thomson & West in 2007.

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

None

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c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

None

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

Presentation Regarding Intellectual Property Case Management; 11/17/08; Justice Center, Santiago, Chile; (Organized by the U.S. Embassy, Santiago)

Panelist-- Challenges *in Enforcement of IPR;* 3/10/08-3/12/08; High Court Karnataka, Bangalore, India; (Sponsored by the U.S. Department of Justice)

Instructor-- Judicial Mediation; 12/3/07-12/6/07; Malaysian Supreme Court, Putrajaya, Malaysia; (Sponsored by The Judicial and Legal Training Institute -- Government of Malaysia)

Opening Remarks, *IPR Enforcement in India & the Creation of an IPR Court,* 8/2/07, Institute for the Study and Development of Legal Systems, San Francisco, CA.

Panelist-- IPR *Seminar for Judges and Public Prosecutors;* 6/6/07-6/8/07; Bangkok, Thailand; (Sponsored by ASEAN and the U.S.P.T.O.)

Speaker-- *The Art of Mediation;* 2/27/07; High Court Karnataka, Bangalore, India (Sponsored by the U.S. Department of Justice)

Panelist-- *Perspectives on Patent Law and Innovation;* 2/16/07; Federal Circuit Bar Association, Berkeley, CA

Panelist-- *Case Management and ADR;* 8/21/06-8/30/06; Various presentations in the High Courts of Delhi and Bangalore, India; (sponsored by the U.S. Department of Justice)

Panelist-- *Perspectives on Patent Law and Innovation;* 2/18/05; Federal Circuit Bar Association, Berkeley, CA;

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Panelist-- *Best Practices in Federal Court;* 11/2/04; Santa Clara County Bar Association, San Jose, CA

Panelist-- IPR Judicial Workshop; 3/31/04-4/2/04; Montecatini, Italy; (sponsored by the U.S. Embassy, Italy)

Panelist-- *A View from the Trenches: Nuts and Bolts of Settlement Conferences with Magistrate Judges;* 4/20/04; Northern District of California Practice Program, San Francisco, CA

Panelist-- Various programs with the Indian Judiciary and Bar regarding case management; 1/22/03-1/31/03; Mumbai, Ahmenabad, and Delhi, India; (sponsored by the Institute for the Development of Legal Systems)

Panelist-- *Ethical Issues in Judicial Mediation;* 10/15/02; Santa Clara County Bar Association, San Jose, CA;

Panelist-- *Ethics in the Valley: an Ethics Roundtable;* 2/18/02; Santa Clara County Bar Association and Stanford Law School; Palo Alto, CA

Panelist-- *Standards of Professionalism: What's Expected in Federal Court*; 12/06/01; Santa Clara County Bar Association, San Jose, CA

Panelist-- *Investigating Business Fraud--the Perspective of Counsel;* 2/25/00; Institute of Internal Auditors, Oakland, CA

Panelist-- Shareholder Litigation Panel; 5/18/99; Financial Executives Institute, Santa Clara Valley Chapter, Palo Alto, CA

Panelist-- Securities Litigation Presentation; 3/24/99; Bar Association of San Francisco, San Francisco, CA

Panelist-- *An Update on Insider Trading Issues;* 2/23/99; The SEC Institute, San Francisco, CA; and 4/24/98, The SEC Institute, San Diego, CA

Panelist-- *When Do Corporations and Their Officers and Directors Become Targets of Criminal Enforcement of the Securities Laws?*; 6/4/98; Securities Litigation and Arbitration National Institute, San Francisco, CA

Panelist-- *Corporate Guidelines;* 5/1/97; Federal Bar Association and The U.S. Sentencing Commission; San Francisco, CA

Panelist-- *Expert Witnesses in the Criminal Case;* 7/26/96; Continuing Education of the Bar, San Jose, CA

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Panelist-- *What Civil Lawyers Need to Know When the FBI Knocks on Your Client's Door;* 12/1/95; California State Bar, Criminal Law Section, San Diego, CA

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

In addition to the articles listed below, there may have been other occasions during the time I served as an Assistant United States Attorney when I responded to media inquiries or commented on a criminal case.

Contra Costa Times, March 28, 2005, "Jane Seeborg Quietly Gave Strength to the Symphony"

Los Angeles Daily Journal, May 16, 2004, "Magistrate Judge Is Patience Personified"

San Francisco Daily Journal, April 19, 2004, "Seeborg Is Following His True Calling"

The Recorder, March 27, 2001, "Richard Seeborg: To the Magistrate Judgeship Born"

The San Francisco Chronicle, November 16, 1999, "Hollow Words: Federal Prosecutors Say White-Collar Crime Is a Priority, but They Have Filed Only a Few Charges Against Silicon Valley Executives"

Business Journal-San Jose, May 14, 1999, "Tech Firms Watching Trade Secret Trials"

Recorder, January 27, 1998, "High Tech Prosecutor Decides to Move On"

San Jose Mercury News, August 15, 1997, "Man Held in Power Strip Scam"

San Jose Mercury News, June 28, 1997, "Clinton Names Black S.J. Judge to Appeals Court: Democratic Convert Faces GOP Scrutiny"

The San Francisco Chronicle, December 5, 1996, "S.J. Banks Absolved In Loan Scam: Plaintiffs Lose Ruling in $60 Million Swindle"

San Jose Mercury News, November 1, 1996, "Former Loan Broker Pleads Guilty to $26 Million Ponzi Scheme"

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The San Francisco Chronicle, November 1, 1996," Leader of Ponzi Scheme Pleads Guilty in San Jose"

San Jose Mercury News, October 18, 1996, "Chip Maker Exec Pleads Guilty in Secrets Theft"

San Jose Mercury News, October 1, 1996, "Son Plans to Testify Against Father as Part of Plea Bargain in Fraud Case"

San Jose Mercury News, August 14, 1996, "U.S. Charges Silicon Valley Men with Stock Fraud"

San Jose Mercury News, August 14, 1996, "Fraud Alleged in Los Gatos Scorpion: Mortgage Execs Face New Charges"

San Jose Mercury News, February 29, 1996, "Judge Acquits Principals of the Failed Bank of Los Gatos"

San Jose Mercury News, February 29, 1996, "Federal Judge Acquits Principals of the Failed Bank of Los Gatos: Fraud Case Tossed"

San Jose Mercury News, January 18, 1996, "Ex-Owner Indicted in High-Tech Case: Technology Allegedly Stolen from Firms"

San Jose Mercury News, August 5, 1995, "Bail Denied for Businessman in S.J. Investment Fraud Case"

San Jose Mercury News, August 3, 1995, "S.J. Man Indicted in Alleged Investment Scam Conspiracy: Fraud Charges Filed in Century Loan Case"

San Jose Mercury News, June 23, 1995, "Two More Indicted in Wire Fraud"

San Jose Mercury News, June 22, 1995, "Two Men Indicted for Wire Fraud"

The San Francisco Chronicle, June 6, 1995, "Father and Son Deported, Held in Mortgage Scam"

The San Francisco Chronicle, May 25, 1995, "Jury Indicts 2 Suspects In High-Tech Spy Ring: Case Involves Lam Research Drawings"

San Jose Mercury News, May 25, 1995, "2 Indicted in Technology Theft: Stolen Designs Were Allegedly Sold to Semiconductor Spares"

United Press International, May 25, 1995, "Feds Uncover Silicon Valley Spy Ring"

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Business Journal-San Jose, April 17, 1995, "Foursome Found Guilty of Fraud Win Shot at New Trial"

San Jose Mercury News, April 4, 1995, "Alleged High-Tech Spy Ring Surfaces in Silicon Valley"

The Filipino Express, March 12, 1995, "Fil-Am Charged with Fraud and Money Laundering: Rodolfo Suaco is Charged with Cheating Investors Out of $7 Million"

San Jose Mercury News, March 1, 1995, "Missing Man Accused of Investment Fraud"

The San Francisco Chronicle, February 28, 1995, "Peninsula Man Sought In Big Scam: Currency-Exchange Deal Cost Investors $7 million"

San Jose Mercury News, January 19, 1995, "S.J. 'Con Artist' is Sentenced to Federal Prison, Bilked Elderly of $700,000, Authorities Say"

San Jose Mercury News, September 2, 1994, "Chip Firm Employee Charged with Forgery, Money Laundering"

American Banker, May 13, 1994, "Judge Orders Retrial of Pebble Beach Exec and Four Others Convicted of Bank Fraud"

San Jose Mercury News, May 13, 1994, "Convictions Set Aside"

The San Francisco Chronicle, May 13, 1994, "New Trials Ordered in Bank Fraud Case"

National Mortgage News, May 9, 1994, "Former President of Ginnie Mae Faces California Trial"

The San Francisco Chronicle, April 29, 1994, "Redwood City Executive Accused of Bid Fraud"

San Jose Mercury News, February 26, 1994, "Trial to Begin for 5 Accused in Bank of Los Gatos Fraud"

The San Francisco Chronicle, November 4, 1993, "Broker Indicted In Insurance Scam"

The San Francisco Chronicle, May 4, 1993, "FBI Agents Seize Grenades In Search of Salinas Home"

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13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.
I was appointed United States Magistrate Judge, United States District Court for the Northern District of California, and have served since February 2001.

    a. Approximately how many cases have you presided over that have gone to verdict or judgment?

    Excluding cases in which I have entered judgment upon a stipulation, a motion to dismiss, or a motion for summary judgment, I have presided over approximately 14 cases that have gone to verdict or judgment.

        i. Of these, approximately what percent were:

        jury trials? 75%; bench trials 25% [total 100%]

        civil proceedings? 98%; criminal proceedings? 2% [total 100%]

    b. Provide citations for all opinions you have written, including concurrences and dissents.

    See attached

    c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

    (1) *Technology Licensing Corporation v. Gennum Corporation*
    No. C 01-04204 RS

    This patent case involved conflicting claims of infringement and invalidity arising out of two patents held by Technology Licensing Corporation ("TLC") that described an invention which detected and synchronized video signals for broadcast on receiving equipment such as televisions. Gennum, a Canadian corporation, produced various chips that TLC claimed infringed its patents.

    Shortly before the case was set for jury trial, I granted Gennum's motion excluding TLC's reasonable royalty methodology under a *Daubert* analysis that had the effect of reducing recoverable damages from approximately $80 million to $6 million. 2004 WL 1274391 (3/26/04). TLC thereupon withdrew its prayer for monetary damages and sought solely injunctive relief. I then granted Gennum's motion for a finding that TLC no longer maintained a right to a jury trial, but granted TLC's request to stay the action to afford it the opportunity to seek a writ of mandamus from the U.S. Court of Appeals for the Federal Circuit.

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That Court granted the writ and subsequently issued an opinion affirming my decision that TLC had given up its right to a jury trial. *In re Technology Licensing Corporation*, 423 F.3d 1286 (Fed.Cir.2005).

I then presided over a several week bench trial resulting in an opinion and order in favor of Gennum finding non-infringement of TLC's patents. 2007 WL 1319528 (May 4, 2007). On October 10, 2008 the U.S. Court of Appeals for the Federal Circuit issued a published opinion affirming my decision in all respects. 2008 WL 4529095 (Fed. Cir. October 10, 2008)

Counsel for Gennum: J. Donald McCarthy
Duane Morris LLP
633 West Fifth Street, #4600
Los Angeles, CA 90071
213/689-7413

Todd R. Miller
Jones Day
555 South Flower Street, 50th Floor
Los Angeles, CA 90071
213/489-3939

Counsel for TLC: Timothy J. Vezeau
Michael A. Dorfman
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, IL 60661
312/902-5200

(2) *Gregory Neal Grimes v. United Parcel Service*
No. C 05-01824 RS

Plaintiff, a mid-level manager with defendant United Parcel Service, brought an employment discrimination suit alleging that his employer failed to engage in the interactive process or to accommodate his mental disability. After a three-week jury trial, the jury rendered a verdict for the defendant. The remaining equitable claims under California Business and Professions Code § 17200 for unfair competition premised on Grime's argument that UPS had implemented an impermissible "100% healed" policy were tried to the Court. In ruling in favor of defendant, I found that plaintiff had not carried his burden of demonstrating the existence of such a policy at UPS. 2008 WL 2544777 (6/23/08). The case is currently on appeal to the United States Court of Appeals for the Ninth Circuit.

Counsel for Plaintiff: Kathryn Burkett Dickson
Dickson Ross
1970 Broadway, Suite 1045

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Oakland, CA 94612
510/268-1999

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415/864-8848

Leslie Levy
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300 Frank H. Ogawa Plaza, Suite 120
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Counsel for Defendant: E. Jeffrey Grube
Kerri Harper
Paul Hastings Janofsky & Walker LLP
55 Second Street, 24th Floor
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415/856-7000

(3) *Estate of Bojcic v. City of San Jose*
No. C 05-03877 RS

The mother and estate of Ziam Bojcic brought suit against police officer Donald Guess and the City of San Jose arising out of an altercation outside a Starbucks coffee shop which led to the officer shooting and killing Mr. Bojcic. The action, brought under Section 1983, alleged that the officer used excessive force against Mr. Bojcic in violation of his constitutional rights. After I granted summary judgment in favor of the City of San Jose on plaintiff's *Monnell* claim and denied summary judgment as to the officer, (2007 WL 2825656, 9/26/07), the case proceeded to jury trial. After a three-week trial, the jury returned a verdict in favor of the defendant officer. The case is currently on appeal to the United States Court of Appeals for the Ninth Circuit.

Counsel for Plaintiff: Randall H. Scarlett
Scarlett Law Group
536 Pacific Avenue
Barbary Coast Building
San Francisco, CA 94133
415/352-6264

Cal J. Potter III
1125 Shadow Lane

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Las Vegas, NV 89102
702/385-1954

Counsel for Defendants: Clifford S. Greenberg
Steven B. Dippell
Office of the City Attorney
200 East Santa Clara St
San Jose, CA 95113
408/535-1900

(4) *Facebook, Inc. v. ConnectU LLC*
No. C 07-01389 RS

Plaintiff Facebook brought suit claiming that defendant ConnectU engaged in common law misappropriation and violated various federal and state computer statutes by collecting e-mail addresses of Facebook's registered users and then soliciting those customers for its competing business. The case was actively litigated and presented first impression issues regarding personal jurisdiction on claims of internet hacking and the reach of state and federal computer statutes. *See*, Order Denying Defendants' Motion to Dismiss for Lack of Personal Jurisdiction (2007 WL 2326090, 8/13/07), and Order Granting Motion to Dismiss Claims (2007 WL 4249926, 11/30/07). The case ultimately settled prior to trial.

Counsel for Plaintiff: Neel Chatterjee
Orrick Herrington & Sutcliffe LLP
1000 Marsh Road
Menlo Park, CA 94025
650/614-7400

Counsel for Defendant: Scott R. Mosko
Finnegan Henderson Farabow Garrett & Dunner
Stanford Research Park
3300 Hillview Avenue
Palo Alto, CA 94304
650/849-6600

(5) *Digital Envoy, Inc. v. Google, Inc.*
No. C 04-01497 RS

This action arose out of a dispute between the parties as to the scope of a license obtained by Google from Digital Envoy covering technology used to identify the geographic location of visitors to a website. Digital Envoy contended that its license did not permit Google to use the technology on its highly successful AdSense program whereby Google displayed advertisements on third party websites. Through a series of motions and orders, the case was progressively narrowed, culminating in an order I issued finding that the License Agreement

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between the parties precluded the recovery of contract damages by Digital Envoy. 2005 WL 2999364 (11/8/05). *See also*, 2005 WL 2174958 (9/8/05) and 370 F. Supp 2d 1025 (ND Cal. 2005). The case ultimately settled prior to the entry of judgment.

Counsel for Plaintiff: Timothy Kratz
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404/443-5500

Counsel for Defendant: David H. Kramer
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304
650/493-9300

(6) *Roger S. Cripe, et al. v. City of San Jose*
No. C 96-20060 RS

A group of San Jose police officers who had sustained neck and back injuries brought an action against the City of San Jose. They claimed that the City's policy restricting to certain limited positions those officers who were disabled from serving on patrol assignments violated their rights under the Americans with Disabilities Act (ADA).

The case was initially assigned when filed in 1996 to the late U.S. District Judge William A. Ingram, who granted summary judgment in favor of the defendants. After the Ninth Circuit reversed that decision in 2001, on remand the parties all consented to have the case assigned to me for all purposes. I thereafter presided over a six week jury trial that resulted in a hung jury on the issue of the business necessity defense. The parties subsequently settled the case by way of a consent decree relative to positions available to disabled officers as well as a payment to the plaintiffs in the amount of $750,000.

Counsel for Plaintiff John C. Stein
The Boccardo Law Firm LLP
111 W. St. John St., 11th Floor
San Jose, CA 95113
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Frank A. Jelinch
Law Offices of Frank A. Jelinch
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Counsel for Defendant: Clifford S. Greenberg
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408/535-1900

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70 West Hedding St.
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San Jose, CA 95110
408/299-5904

7. *National Railroad Passenger Corp. v. Valley Pallet Recyclers, Inc.*
No. C 00-21123 RS (and Related Cases)

This action arose out of a collision which occurred on November 4, 1999 between a train and a semi-tractor and trailer at an intersection of the Union Pacific Railroad mainline in Salinas, California. Numerous actions and cross-actions were filed by property owners on which the crossing was located. The case was initially assigned to U.S. District Judge James Ware and I acted as the settlement judge, conducting several day-long sessions with all parties. That process resulted in a settlement with all parties with the exception of the property owner, Valley Pallet Recyclers. At that point, all remaining parties requested and consented to my acting as presiding judge for trial. A one-week jury trial ensued with the jury finding that the actions of Union Pacific and the truck driver were the "substantial factors" leading to the accident, apportioned liability at 30% (driver) and 70% (railroad) and declined to find that Valley Pallet Recyclers' conduct constituted a substantial factor for which damages should be assessed.

Counsel for Plaintiffs: B. Clyde Hutchinson
1999 Harrison St., #2600
Oakland, CA 94612
510/433-2600

John C. Stein
The Boccardo Law Firm LLP
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Counsel for Defendant: Andrew B. Kreeft
Low Ball & Lynch
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8. *Comcast of Cal. II v. City of San Jose*
No. C 03-02532 RS

Comcast instituted this action to challenge the constitutionality of the formal cable franchise renewal procedures established by the City of San Jose under the Federal Cable Act. I conducted a hearing on Comcast's motion for a preliminary injunction on September 17, 2003 and twelve days later issued an order denying the motion on the grounds of lack of ripeness under the Federal Cable Act and failure to demonstrate likelihood of success on the merits of Comcast's free speech and due process claims. 286 F.Supp. 2d 1241 (N.D. Cal. 2003). Subsequently, I granted the City of San Jose's motion to dismiss for lack of subject matter jurisdiction on ripeness grounds. 2004 WL 3080347 (N.D. Cal., August 23, 2004). The matter settled pending appeal.

Counsel for Plaintiff: John L. Carlton
Arnold & Porter
777 South Figueroa Street, 44th Floor
Los Angeles, CA 90017
213/243-4000

Counsel for Defendant: Michael R. Groves
Office of the City Attorney
200 East Santa Clara Street
San Jose, CA 95113
408/535-1912

9. *Ann Minshew d/b/a The Blue Lagoon v. City of Santa Cruz & Patricia Sapone*
No. C 00-20846 RS

Plaintiff, the owner of the "Blue Lagoon" Bar in Santa Cruz, brought a Section 1983 action against the City of Santa Cruz and Deputy Chief of Police Sapone alleging that the Police Department had engaged in a campaign of harassment toward the Bar, including frequent bar checks, the shining of police car lights into the establishment and various other conduct that amounted to a violation of plaintiff's Fourth Amendment rights. I presided over a two-week jury trial in January 2004. The jury returned a verdict in favor of plaintiff awarding her $112,621.90, exclusive of attorneys' fees which the defendants did not appeal.

Counsel for Plaintiff: Terri Keyser-Cooper
100 N. Arlington Avenue #10F
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623451.078

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849 Almar Avenue, Suite C403
Santa Cruz, CA 95060
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Kate Wells
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Santa Cruz, CA 95062
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Counsel for Defendants: Vincent P. Hurley
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Aptos, CA 95003
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10. *ASAT Holdings Ltd. v. Motorola, Inc.*
No. C 03-01514 RS

This declaratory judgment action centered around a dispute regarding whether or not plaintiff ASAT Holdings was obliged to make millions of dollars in royalty payments to defendant Motorola under a patent license/immunity agreement entered into between Motorola and ASAT's predecessor covering the manufacture of ball grid array packages. The case was very actively litigated, involving numerous motions to dismiss, stay and transfer, and ultimately motions for partial summary judgment against Motorola, which I granted. 2004 WL 2646657 (N.D. Cal. November 17, 2004). The case subsequently settled and was dismissed by stipulated order in June, 2005.

Counsel for Plaintiff: David H. Kramer
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304
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Counsel for Defendant: Morgan W. Tovey
Quinn Emanuel
50 California Street, 22nd Floor
San Francisco, CA 94111
415/875-6600

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

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(1) *Tech. Licensing Corp. v. Gennum Corp.*, No. C 01-04204 RS

2004 WL 1274391 (N.D. Cal. Mar. 26, 2004)
2007 WL 1319528 (N.D. Cal. May 4, 2007)

J. Donald McCarthy
Duane Morris LLP
633 West Fifth Street, #4600
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213/689-7413

Todd R. Miller
Jones Day
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213/489-3939

Timothy J. Vezeau
Michael A. Dorfman
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, IL 60661
312/902-5200

(2) *Capcom Co., Ltd. v. MKR Group, Inc.*, No. C 08-00904 RS

2008 WL 4661479 (N.D. Cal. Oct. 20, 2008)

Rodger Cole
Fenwick & West
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801 California Street
Mountain View, CA 94041
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Kenyon & Kenyon
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(3) *Estate of Bojcic v. City of San Jose*, No. C 05-03877 RS

2007 WL 2825656 (N.D. Cal. Sept. 26, 2007)

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408/535-1900

(4) *Facebook, Inc. v. ConnectU LLC*, No. C 07-01389 RS

2007 WL 2326090 (N.D. Cal. Aug. 13, 2007)
2007 WL 4249926 (N.D. Cal. Nov. 30, 2007)

Neel Chatterjee
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Stanford Research Park
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650/849-6600

(5) *Digital Envoy, Inc. v. Google, Inc.*, No. C 04-01497 RS

370 F. Supp. 2d 1025 (N.D. Cal. 2005)

Timothy Kratz
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David H. Kramer
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650 Page Mill Road
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650/493-9300

(6) *Comcast of Cal. II v. City of San Jose,* No. C 03-02532 RS

286 F. Supp. 2d 1241 (N.D. Cal. 2006)

John L. Carlton
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777 South Figueroa Street, 44th Floor
Los Angeles, CA 90017
213/243-4000

Michael R. Groves
Office of the City Attorney
200 East Santa Clara Street
San Jose, CA 95113
408/535-1912

(7) *ASAT Holdings Ltd. v. Motorola, Inc.,* No. C 03-01514 RS

2004 WL 2646657 (N.D. Cal. Nov. 17, 2004)

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415/659-8700

(8) *In re PMC-Sierra Inc. Derivative Litig.*, No. C 06-05330 RS

2008 WL 2024888 (N.D. Cal. May 8, 2008)
Patrick E. Gibbs
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Shawn Williams
Coughlin Stoia
100 Pine Street, Suite 2600
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(9) *Marquez Bros. Int'l, Inc. v. Arletico Morelia S.A.*, No. C 05-01889 RS

2005 WL 1869501 (N.D. Cal. Aug. 5, 2005)

Nicole Healy
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Lisa Aguiar
Squire Sanders & Dempsey
600 Hansen Way
Palo Alto, CA 94301
650/856-6500

(10) *In re Legato, Inc., Securities Litig.*

204 F.R.D. 167 (N.D. Cal. 2001)

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Bernstein Litowitz
12481 High Bluff Drive
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858/793-0070

Nicole Healy
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304
650/493-9300

e. Provide a list of all cases in which certiorari was requested or granted.

Tech. Licensing Corp. v. Gennum Corp., No. C 01-04204 RS, 2004 U.S. Dist. LEXIS 10604 (Mar. 26, 2004), *aff'd per curiam sub nom. In re Tech. Licensing Corp.*, 423 F.3d 1286 (Fed. Cir. 2005); *cert. denied sub nom. Tech. Licensing Corp. v. U.S. Dist. Court for N. Dist. of Cal.*, 547 U.S. 1178 (2006).

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f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

Suever v. Connell, 439 F.3d 1142 (9th Cir. 2006)

The Ninth Circuit Court of Appeals vacated and remanded my decision which had held that a class of individuals whose assets had been seized by the state controller as "unclaimed property" were barred from seeking recovery by the Eleventh Amendment to the U.S. Constitution The Circuit's decision was based on its earlier holding in *Taylor v. Westly*, 402 F.3d 924 (9th Cir. 2005), which had been issued after I had already dismissed the *Suever* case without leave to amend. The Ninth Circuit remanded the case for a determination of which claims could properly be characterized as either seeking a return of property or prospective relief, and that therefore would not be subject to an Eleventh Amendment bar.

Niva v. U.S. Bureau of Land Mgmt., 245 F. App'x 621 (9th Cir. 2007)

The Ninth Circuit Court of Appeals reversed my decision after a bench trial that the BLM was entitled to recreational use immunity under California law in connection with a vehicle accident occurring on an area of public land. The Court of appeals remanded the case to me for further proceedings.

Vick v. Astrue, 231 F. App'x 590 (9th Cir. 2007)

The Ninth Circuit Court of Appeals reversed my decision which had upheld the determination of an administrative law judge that a social security claimant had failed to establish disability, and remanded with directions for entry of judgment in the claimant's favor.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

I have never designated any of my decisions for publication in any reporter system. I am aware that several of my decisions were selected for publication in the Federal Reporter of Decisions or the Federal Supplement Second Series. Virtually all of my substantive decisions dating to around 2005 are available online through Westlaw and LexisNexis, and a lesser percentage of earlier decisions are also available there. I retain copies of all my decisions from my tenure as a Magistrate Judge in binders in my chambers; the originals of those decisions appear in the Court files.

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h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

Comcast of Cal. II, L.L.C. v. City of San Jose, 286 F. Supp. 2d 1241 (N.D. Cal. 2003) (free speech and due process claims in the context of regulation of cable television services)

Facebook, Inc. v. ConnectU LLC, No. C 07-01389 RS, 2007 WL 2326090 (N.D. Cal. Aug. 13, 2007) (Constitutional "minimum contacts" jurisdiction in internet context)

Estate of Bojcic v. City of San Jose, No. C 05-03877 RS, 2007 WL 2825656 (N.D. Cal. Sept. 26, 2007) (claims of excessive force in violation of the Fourth Amendment)

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

I have not sat by designation on a federal court of appeals.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

In all instances listed below, the decision to recuse was made *sua sponte*. I have not been requested by any litigant to recuse myself from any matter. The Northern District of California employs an "automatic" triggering system that alerts the judge where a case involves an entity listed on the judge's financial disclosure form.

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Case Name	*Reason for recusal*	*Procedure*
Mendez v. Intel Corp.	Stock ownership	Automatic
Morse v. JetBlue Airways Corp.	Stock ownership	Automatic
Knopf v. Semel, et al.	Party represented by former law firm colleagues	Review of pleadings
Mangindin v. Washington Mutual	Stock ownership	Automatic
Mirana v. Battery Tai-Shing Corp.	Party represented by former law firm colleagues	Review of pleadings
Mendoza v. Bank of America, et al.	Stock ownership	Automatic
Sheppard v. Intel Corp.	Stock ownership	Automatic
Jones v. Merck	Stock ownership	Automatic
Intel v. Intelsys	Stock ownership	Automatic
Facebook, Inc. v. ConnectU, LLC	Motion to enforce settlement brought after conclusion of case and counsel for a party had made reference to settlement negotiations	Recusal upon filing of motion to enforce settlement
Morgan Stanley v. Horath	Stock ownership	Automatic
Watson, et al. v. Albin, et al.	Party represented by former law firm colleagues	Review of pleadings
Michael Scott Properties, et al. v. Washington Mutual, et al.	Stock ownership	Automatic
Intel Corp. v. Intelagents, LLC	Stock ownership	Automatic
Dossett v. Merck and Co.	Stock ownership	Automatic
Camino v. Merck and Co.	Stock ownership	Automatic
Williams Sonoma v. Target Corp.	Stock ownership	Automatic
Moore v. Merck and Co.	Stock ownership	Automatic
Pioneer v. Samsung SDI Co. Ltd.	Party represented by former law firm colleagues	Review of pleadings
Schrimpf v. Intel Corp.	Stock ownership	Automatic
In re Nextcard Securities Litigation	Party represented by former law firm colleagues	Review of pleadings
Medina v. UPS	Stock ownership	Automatic
National Semiconductor, et al. v. NCH Corp.	Stock ownership	Automatic
Zoltar Satellite Systems v. LG Electronic Mobile Communications	Party represented by former law firm colleagues	Review of pleadings
Arikat, et al. v. J.P. Morgan	Party represented by former	Review of pleadings

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Chase & Co.	law firm colleagues	
Blackwell v. Apple Computer	Party represented by former law firm colleagues	Review of pleadings
Nakhimovsky v. Berlan, et al.	Party represented by former law firm colleagues	Review of pleadings
Amtel Corporation v. LM Ericson Telefon A.B.	Stock ownership	Automatic
Sternberg v. The Walt Disney Co., et al.	Stock ownership	Automatic
Muschella, et al. v. Apple Computer, Inc.	Party represented by former law firm colleagues	Review of pleadings
Wimmer v. Apple Computer, Inc.	Party represented by former law firm colleagues	Review of pleadings
Lam Research Corp. v. Deshmukh	Party represented by former law firm colleagues	Review of pleadings
Walls v. Merck and Co.	Stock ownership	Automatic
National Semiconductor, et al. v. NCH Corp.	Stock ownership	Automatic
Nitgen Co., Ltd. v. Secugen Corp., et al.	Party represented by former law firm colleagues	Review of pleadings
Miller, et al. v. Leapfrog Enterprises	Party represented by former law firm colleagues	Review of pleadings
Laffin v. Cerus Corp.	Party represented by former law firm colleagues	Review of pleadings
Workshare Technology, Inc. v. Litera Corp.	Party represented by former law firm colleagues	Review of pleadings
Premier Technical Sales, Inc. v. AMI Semiconductor, Inc., et al.	Party represented by former law firm colleagues	Review of pleadings
ECast, Inc. v. Touchtunes Music Corp.	Party represented by former law firm colleagues	Review of pleadings
Watson v. Singh, et al.	Former colleague from U.S. Attorney's Office party to action	Review of pleadings
Pascual v. Novellus Systems, Inc.	Party represented by former law firm colleagues	Review of pleadings
Crabtree v. Eli Lilly and Co.	Stock ownership	Automatic
Nokia, Inc. v. Enstar Networking Corp.	Stock ownership	Automatic
In re Intershop Communications, A.G. Securities Litigation	Party represented by former law firm colleagues	Review of pleadings
Storage Technology Corp. v. Cisco Systems	Stock ownership	Automatic
Wright v. Strauss, et al.	Party represented by former law firm colleagues	Review of pleadings

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Cisco Systems, Inc. v. Bennett	Stock ownership	Automatic
Cisco Systems, Inc. v. Gordon	Stock ownership	Automatic
Allen v. Ramp Networks, et al.	Party represented by former law firm colleagues	Review of pleadings
Cisco Systems, Inc. v. Akamai Technologies, Inc.	Stock ownership	Automatic
Hampton v. Intel Corp.	Stock ownership	Automatic
Westerschulte v. Nokia, Inc.	Stock ownership	Automatic
Intel Corp. v. Intelistat, Inc.	Stock ownership	Automatic
Intel Corp. v. Intel Video, Inc.	Stock ownership	Automatic
Hall, et al. v. Cisco Systems (and related cases)	Stock ownership	Automatic
Land v. The Boeing Corp.	Stock ownership	Automatic
IP Learn, LLC v. Saba Software, Inc.	Party represented by former law firm colleagues	Review of pleadings
Virgil v. The Walt Disney Co.	Stock ownership	Automatic
Koski v. Santa Clara University	Serving as adjunct professor for party	Review of pleadings

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

I have held no public office. I have had no unsuccessful candidacies for elective office or unsuccessful nominations for appointed office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

None

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16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I served as a law clerk to United States District Court Judge John H. Pratt (D.D.C.) 1981-1982.

ii. whether you practiced alone, and if so, the addresses and dates;

I have not practiced alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

Morrison & Foerster
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Associate (1982-1987)
Equity Partner (1987-1991)

Morrison & Foerster
755 Page Mill Road
Palo Alto, CA 94304
Equity Partner (1998-2001)

Office of the United States Attorney
280 South First Street
San Jose, CA 95113
Assistant United States Attorney (1991-1998)

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

In my capacity as a Magistrate Judge in the Northern District of California I am called upon regularly to conduct settlement conferences on cases assigned to the other judicial officers in this District. Since my appointment in February, 2001 I have conducted literally hundreds of settlement conferences. These have ranged from very complex intellectual property matters to claims brought by *pro se* litigants in relatively straightforward but emotionally charged disputes. Resolution of these

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cases has involved everything from the payment of money and letters of apology to patent licenses and corporate acquisitions. Also, because of my experience handling federal criminal matters as a prosecutor, I am one of the Magistrate Judges in this District that conduct settlement conferences in criminal cases. Below are a small sample of the matters on which I have acted as settlement judge:

(1) *3M Co. v. Maurice Kanbar*
No. C 06-01225 JW
Plaintiff 3M sued defendants for trademark infringement concerning a rolling sticky note product called Rollit. The settlement involved both monetary and non-monetary terms.

(2) *Ecological Rights Found. v. Sierra Pac. Indus.*
No. C 01-00520 MEJ
In this case, a non-profit environmental organization brought action against a company that owned and operated a lumber milling facility adjacent to Humboldt Bay seeking monetary and injunctive relief as a result of soil and water contamination. After several sessions a settlement was achieved that entailed the entry of a detailed Consent Decree.

(3) *Cypress Semiconductor Corp. v. Sipex Corp.*
No. C 07-05778 JF
This case involved claims of trade secret misappropriation connected with the departure of a senior executive from one company to its competitor. Plaintiff sued both the departing executive and the company which he subsequently joined. The case was successfully settled.

(4) *Beinin v. Center for the Study of Popular Culture*
No. C 06-02298 JW
The plaintiff, a professor of Middle East Studies at Stanford University, brought a copyright action against a non-profit organization pertaining to the defendant's use of the professor's picture on a pamphlet entitled "Campus Support for Terrorism." The case settled at the conclusion of the second settlement session I conducted.

(5) *Broadlogic Network Techs. v. Gilat Satellite Networks*
No. C 01-20663 JW
Plaintiff brought action for payment for customized satellite receiver boards that defendant, an Israeli company, claimed did not perform to specifications. The case settled.

(6) *Avago Techs. v. PixArt Imaging*
No. C 03-04871 JW

This patent action involved optical mouse sensor technology for use with personal computers. The parties instituted a host of claims for

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infringement and counterclaims for invalidity covering numerous patents. After lengthy negotiations the case settled.

(7) *In re: Beer Distribution Antitrust Litig.*
No. C 97-20644 JF
This case pitted a group of regional "craft" beer brewing companies against defendant Anheuser Busch, Inc. Four class action complaints, ultimately consolidated, claimed that defendant had violated the antitrust laws through the operation of "exclusivity" provisions in its agreements with distributors. The case settled after settlement conference sessions and follow-up telephone negotiations.

(8) *San Jose Charter of the Hells Angels Motorcycle Club v. City of San Jose*
No. C 99-20022 JF
As a result of searches and seizures undertaken by city police officers and county sheriff officials against members of the Hells Angels Motorcycle club in which property was destroyed and pet dogs were killed, a group of Hells Angels members sued the City of San Jose, the County of Santa Clara, and various law enforcement officers for constitutional civil rights violations. After protracted settlement conferences, the defendants agreed to pay plaintiffs collectively a seven figure settlement.

(9) *Stanford Hosp. v. Serv. Workers, Local 715*
No. C 06-04929 RMW
Plaintiff hospital brought an action to restrict a local union's organizing activities within the hospital facility. The case settled with an agreed protocol governing defendants' access to the hospital property.

(10) *Quedillas Walker v. County of Santa Clara*
No. C 04-02211 RMW
The case concerned a constitutional claim by plaintiff who was ultimately determined to have been innocent of the crime of murder for which he had been imprisoned for twelve years. After several settlement sessions, the County of Santa Clara agreed to enter into a seven figure settlement with the plaintiff.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

Since February 2001, I have served as a United States Magistrate Judge for the Northern District of California, San Jose Division. From 1982 to 1987, and then again from 1998 to 2001, I was first an associate and then a partner with the law firm of Morrison & Foerster in San Francisco and Palo Alto where my practice focused on general commercial, intellectual

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property, securities and antitrust litigation for corporations and individuals. From 1991 to 1998, I served as an Assistant United States Attorney in the criminal division. My practice in that office involved white collar criminal prosecution, including wire, mail, and bank fraud, high technology crime, tax evasion, money laundering and export violations. In addition, I prosecuted numerous gun and bank robbery cases as well as foreign extradition matters.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

My clients in private practice were corporations and individuals. As a United States Attorney, I represented the United States of America.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

While in private practice from 1982 to 1991 and again from 1998 to 2001, my work was exclusively in litigation and on average I would make several court appearances per month. From 1991 to 1998 as an Assistant United States Attorney, I appeared in court regularly each week, sometimes with several appearances per day.

i. Indicate the percentage of your practice in:
   1. federal courts: 70%
   2. state courts of record; 30%
   3. other courts;
   4. administrative agencies

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 60%;
   2. criminal proceedings. 40%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

Excluding cases decided by virtue of dispositive motions before the court, I tried to verdict nine cases, four as sole counsel, three as lead counsel, and two as associate counsel.

i. What percentage of these trials were:
   1. jury: 89%
   2. non-jury. 11%

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e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, amicus or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

I have not practiced before the Supreme Court of the United States.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

a. the date of representation;

b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

(1) *United States v. Herpick*, No. CR 95-20077 RMW (N.D. Cal. 1996-1997); U.S. District Judge Ronald Whyte (San Jose);

Case Description: This matter involved charges of conspiracy, wire and mail fraud associated with the collapse of Century Loan in San Jose. The three defendants were alleged to have swindled over 200 investors out of more than $40 million in a second mortgage scheme. I served as co-lead counsel on the case. Two defendants pled guilty and were sentenced to terms of imprisonment of several years each and ordered to pay full restitution to their victims. The remaining defendant was acquitted after a several week jury trial.

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San Francisco, CA 94104
415/392-5811

Co-counsel:

Marcia Jensen
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Los Gatos, CA 95032
408/358-1878

(2) *United States v. Hopkins*, No. CR 92-20106 JW (N.D. Cal. 1994-1996); U.S. District Judge James Ware (San Jose)

Case Description: In this case five defendants were charged with bank fraud and one with additional charges of misapplication of the funds of a Savings & Loan in connection with the acquisition and operation of the now defunct Bank of Los Gatos. I served as co-lead counsel on the case. In the initial trial of the case in 1993, all five defendants were convicted by jury. The District Court set aside the verdicts and ordered a retrial. At the close of the government's case upon retrial, the Court ruled for the defendants.

Opposing Counsel:

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Co-counsel:

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(3) *United States v. Biehl*, No. CR 95-20082 RMW (N.D. Cal. 1995-1996); U.S. District Judge Ronald Whyte (San Jose)

Case Description: This matter involved three related indictments in which various insiders at a number of large Silicon Valley semiconductor companies stole proprietary parts drawings and diverted them to another company which then manufactured parts to be sold in competition with the original equipment manufacturers. I was the sole prosecutor on the case. All six defendants pled guilty to the charges and received sentences ranging from 3 years in prison to probation.

Opposing Counsel:

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Vicky H. Young
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Palo Alto, CA 94301
415/421-4347

(4) *United States v. Amidi Group* (Case Number Unknown) (N.D. Cal. 1993); U.S. District Judge James Ware (San Jose)

Case Description: Defendant, a plastics exporting company which participated in a program sponsored by the U.S. Agency for International Development, made unauthorized kickbacks to Egyptian importers to purchase its products. I was the sole prosecutor on the case. The company pled guilty to eleven felony counts and was fined $140,000.

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Opposing Counsel:
Honorable Charles R. Breyer
United States District Judge
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San Francisco, CA 94102
415/522-3660

(5) *United States v. Ashtech, Inc.* (Case Number Unknown) (N.D. Cal. 1992-1994); U.S. District Judge William Ingram (San Jose)

Case Description: The defendant, a manufacturer of global positioning systems, was charged with violating the Export Control Act by transshipping various units from the UAE to Iran without a valid customs license. *See In re Grand Jury*, 31 F.3d 826 (9th Cir. 1994). I was the sole prosecutor on the case. The defendant corporation pled guilty and was sentenced to pay a $150,000 fine.

Opposing Counsel:
Lawrence A. Callaghan
Tucker, Ellis & West LLP
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San Francisco, CA 94105

(6) *United States v. Walterbach*, No. CR 93-20117 RMW (N.D. Cal. 1993); U.S. District Judge Ronald Whyte (San Jose)

The defendant was charged with wire and securities fraud in connection with a scheme to sell senior citizen investors fraudulent international certificates of deposit in a mail drop offshore bank. The defendant pled guilty to the wire and securities fraud counts in the indictment and was sentenced to 18 months imprisonment and ordered to make full restitution to the victims of the scheme. I was the sole prosecutor on the case.

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(7) *United States v. Seaton*, No. CR 94-20024 RMW (N.D. Cal. 1992-1993); U.S. District Judge Ronald Whyte (San Jose)

This matter involved kickbacks paid by a vendor to Lockheed employees associated with government contracts. The three defendants pled guilty and received various sentences

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ranging from six months half-way house detention to probation. I was the sole prosecutor on the case.

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(8) *Coca-Cola Co. v. Omni Pacific Co., Inc.*, No. CV 98-0784 SI (N.D. Cal. 1998-2000); U.S. District Judge Susan Illston (San Francisco)

This case involved claims of trademark infringement and antitrust counterclaims arising out of the transshipment of Coca-Cola products to the Far East. I was one of three partners representing Coca-Cola from Morrison & Foerster. The case settled shortly before trial.

Opposing Counsel:
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Tomio Narita
Wineberg, Simmonds & Narita
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415/352-2200

(9) *United States v. Slater*, No. CR 92-20015 JW (N.D. Cal. 1992); U.S. District Judge James Ware (San Jose)

The defendant, an optometrist who operated several eye care offices, was indicted for tax evasion for failing to report cash payments received from patients. The defendant was convicted on all counts by a jury and was sentenced to four months incarceration. I was the sole prosecutor on the case.

Opposing Counsel:
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(10) *United States v. Webster*, No. CR 91-20047 JW (N.D. Cal. 1991); U.S. District Judge James Ware (San Jose)

The defendant, an individual with an extensive criminal record, was indicted for having possessed with intent to distribute five pounds of methamphetamine. The defendant was convicted after jury trial and received a sentence of 30 years imprisonment. I was the sole prosecutor on the case.

Opposing Counsel:

Berndt I. Brauer
111 West St. John Street
San Jose, CA 95113
408/275-1290

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

While engaged in private practice from 1982 to 1991 and again from 1998 to 2000, I handled a large number of matters that either resolved by way of settlement or through dispositive motion practice. Major pieces of litigation included: the defense of a group of television stations in an antitrust action brought by a competing television group, representation of the state of Alaska in a dispute with several large oil companies regarding transfer pricing policies and resource taxes, representation of a national delivery company in an action against its health care insurer for fraud, and counseling regarding product liability issues for a California wine industry trade group. I have not performed any lobbying activities on behalf of any client or organizations.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

From 1996 through 1999 and then again from 2001 through 2004, I served as an adjunct faculty member at the Santa Clara University School of Law. In that capacity I was the co-instructor for a regularly scheduled course entitled "Federal Criminal Litigation" which focused on the development of, and defense to, federal criminal cases from investigation through trial and sentence. In addition to my formal teaching assignment, I have regularly participated in moot court programs at various law schools and in the San Jose City-wide competition for high school students.

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At the invitation of other law professors, I am regularly called upon to guest lecture and am a frequent panelist on continuing legal education programs presented by bar associations and non-profit organizations. In addition, I have taught on many occasions overseas on programs sponsored by the U.S. State and Justice Departments, as well as the U.S. Patent and Trademark Office. In particular, I have worked extensively in India on alternative dispute resolution and intellectual property rights programs and have participated in conferences focused on intellectual property rights enforcement in Italy and Thailand. In 2007, at the invitation of the Malaysian government, I conducted a three-day training program for their high court judges on judicial mediation.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

    None

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    None

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See Attached Financial Disclosure Report

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

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As a Magistrate Judge, I maintain the system described in section (b) below to address conflicts of interests and I do not anticipate any additional issues should I be appointed a United States District Judge.

b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

As required by the Code of Judicial Conduct, I maintain a recusal list reflecting entities in which I hold a financial interest as well as individuals with a sufficiently close connection, social or business-related, that would preclude any participation in cases involving them. In addition, I review personally the counsel, parties, and potential witnesses in all cases assigned to me to make sure my involvement in the case would not violate conflict of interest rules or raise any appearance of impropriety.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

Prior to entering government service in 1991 and then again when I returned to private practice from 1998 to 2001, I handled numerous *pro bono* matters as an attorney with Morrison & Foerster. These included participation in cases brought in through the staffing of the Bar Associations' legal clinic, as well as matters such as a libel action against a community Spanish language newspaper. As a partner in the firm, I regularly served as the supervisor on *pro bono* matters principally handled by associates in Morrison & Foerster's San Francisco and Palo Alto offices. As a Magistrate Judge, I developed the program in the San Jose federal courthouse to provide *pro bono* counsel to indigent litigants in connection with judicial settlement conferences. I also participate each year in the Court's Law Day activities in which students from schools in the community come to the Court for tours, lectures, and moot court activities.

Prior to joining the court, I served from 1998 to 2001 as a member of the Board of Directors of the Volunteer Exchange of Santa Clara County, a non-profit organization dedicated to connecting individuals and groups to volunteer opportunities in the community. While practicing with Morrison & Foerster, I served on the committee of the Morrison & Foerster Foundation which reviewed and awarded educational grants. In addition, during the late 1980s I was in charge of the extensive holiday toy drive undertaken by the San Francisco office of the law firm.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and

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the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

On January 13, 2009, I submitted an application for the position of United States District Judge for the Northern District of California to David S. Casey, Jr., statewide chair of Senator Dianne Feinstein's Judicial Advisory Process. On February 20, 2009, I was interviewed by the five members of Senator Feinstein's Northern California Selection Committee in San Francisco. On March 4, 2009, I was interviewed by Mr. Casey at his office in San Diego, California. Subsequently, I had a number of conversations with Department of Justice officials regarding the preparation of pre-nomination paperwork. On June 19, 2009, I had an interview in Washington, DC, with Associate Attorney General Thomas Perrelli and staff members from the Department of Justice and the White House Counsel's Office. My nomination was submitted to the Senate on August 6, 2009.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No

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AFFIDAVIT

I, Richard G. Seeborg, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

August 24, 2009
(DATE)

(NAME)



(NOTARY)

Senator FRANKEN. Welcome to you all. We will start the questioning now, and I guess I get to start.

Judge Nguyen, we got to confirm Judge Sotomayor, the first Latina Justice of the Supreme Court, and now you are going to be the first Vietnamese American woman to be a Federal district court judge in the United States, if confirmed. How has this experience affected you, being a first? And how does—or has it affected your judging? And if so, how has it?

Judge NGUYEN. When I was fortunate enough to be appointed to the State court bench by Governor Gray Davis, I was the first Vietnamese American judge ever appointed to that position, and being a first of anything is both a privilege, but also carries with it certain responsibilities. And I take that responsibility very seriously.

I know and appreciate the fact that I am a role model for so many people, not only from the Vietnamese American community but also from other communities as well. And in my years as a State court judge, I have done what I could in order to mentor and guide young people who look to me for guidance and career advice and encourage them to participate in the community and to try to give back to the community.

But the process of judging does not change merely by my ethnicity. The law remains the same, and my task as a judge is to apply the law to the facts of each case.

Senator FRANKEN. Thank you.

Judge Chen, I see that you are part of the pro bono team that successfully represented Fred Korematsu in his effort to overturn his conviction for failing to report to an internment camp. Can you tell us more? It seems like a fascinating case. Can you tell us more about the case?

Judge CHEN. Yes. Well, as you probably know, 110 Japanese Americans were interned during World War II out of fear that they would commit sabotage or espionage along the West Coast, and they were evacuated pursuant to military orders.

The Supreme Court ultimately upheld in a series of cases both the curfew that was imposed on Japanese Americans as well as their ultimate internment, even though two-thirds of those were American citizens and included children, women, and the elderly, none of whom were ever accused of disloyalty, none of whom ever were given a hearing.

Those cases I think live in infamy for many Americans as decisions that were wrongly decided. The coram nobis case in which I participated added some new information to that, and that is, what was discovered some 40 years after the fact through researchers going through the archives was that the United States Justice Department had in its possession a number of documents which contradicted its assertion that the order was necessitated by military necessity; that there were, in fact, reports from the FBI, from the Office of Naval Intelligence, from the FCC that showed that there was not a threat and that the rumors that had been circulated of signaling and this sort of thing, in fact, had been investigated and found to be unfounded.

And so once those documents were uncovered, the legal team of which I was a part went back to court and petitioned for a writ of coram nobis, a little-known writ, to essentially allege that the

United States Justice Department had withheld critical evidence, material evidence from the court. And it was on that basis that the conviction of Mr. Korematsu was overturned. And I think the lesson that we learned from that is the importance of having checks and balances and having meaningful judicial review.

Senator FRANKEN. Thank you, Your Honor.

Ms. Gee, I saw that you currently serve as an arbiter for Kaiser Permanente for the independent arbitration system that they have—an arbitrator. The job you are about to take is very different. Can you speak to how serving as an arbitrator is different than serving as a judge?

Ms. GEE. Serving as an arbitrator is somewhat different in that the rules of evidence that would apply in a Federal proceeding would not necessarily be applicable. There are certain rules of evidence, but more relaxed with regard to hearsay and other types of rules.

In many respects, however, it is similar. The ability to listen and to learn, to dispassionately listen to the parties present the facts of their case, and to apply whether it is negligence principles or contract interpretation principles to the situation at hand.

Those are skills that I believe are transferable to a position as a U.S. district court judge, if I am fortunate enough to be confirmed.

Senator FRANKEN. Thank you. I have used up my time, so I apologize to Judge Seeborg.

Judge SEEBORG. That is quite all right, Senator.

Senator FRANKEN. Senator Sessions.

Senator SESSIONS. Thank you, Mr. Chairman.

Judge Seeborg, good luck.

[Laughter.]

Judge SEEBORG. Thank you, Senator.

Senator SESSIONS. There is some advantage being at the end of the table there.

Judge Nguyen, I have an appreciation for Assistant United States Attorneys, having been one before, and I was impressed that you headed a 2½-year investigation that led to the arrest of 35 individuals in several countries. That is a big effort when you do those kinds of cases. It led to the first successful prosecution in the United States for providing material support and resources to a designated foreign terrorist in violation of 18 U.S.C. 2339.

Do you believe that material support provision remains an important tool for prosecutors?

Judge NGUYEN. Well, it is up to the legislature to make the law, and whatever the state of the law is, if I am fortunate enough to be confirmed, I will faithfully apply it.

Senator SESSIONS. Well, I certainly agree with that, but as you having worked with that statute, did you find it helpful in your case to render justice?

Judge NGUYEN. Well, certainly, when I handled that prosecution, given the facts of that case, I obviously thought that it was justified.

Senator SESSIONS. Well, I thank you for that good work and believe it is something that you can take pride in.

Tell me about your understanding of precedents. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect even if you personally were to disagree with those precedents?

Judge NGUYEN. Absolutely yes, Senator Sessions. That is how I have conducted myself as a State trial court judge and how I intend to conduct myself as a United States district court judge, if I am fortunate enough to be confirmed.

Senator SESSIONS. Thank you very much.

Judge Chen, I will ask you the same question. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with the precedents or, I will add, the policy results that may occur from your ruling?

Judge CHEN. Absolutely, Senator Sessions. That requirement, of course, is part of the rule of law which I respect and which I have endeavored to apply. And I think that has particular force with respect to the district court because we are the subordinate court within the system, and we take our commands from the circuit courts and from the Supreme Court.

Senator SESSIONS. As a magistrate judge, how did the—is that the right word now?

Judge CHEN. Yes, it is. The magistrate judge is fine.

Senator SESSIONS. I remember one magistrate judge, I wrote him a letter and said, "Dear Magistrate Judge," he thought that was funny. I thought that was the right name. But how are you allowed—various district judges give more or less power and responsibility to magistrate judges. I am of the view generally that they should be given responsibility that the law allows for the most part. What kind of responsibilities were you given in your court?

Judge CHEN. Well, I am very fortunate, as Judge Seeborg, my colleague, is, to be in the Northern District of California where the judges have decided to give the full range of responsibility permissible under Article III of the Constitution to magistrate judges. So not only do we hear matters that are assigned to us by the district judges, but we have our own caseload. We are on the wheel, and our names are drawn when cases are filed. And so long as the parties consent, we have full jurisdiction over the case through disposition. And so it is common for magistrate judges to rule on motions to dismiss, summary judgment, to hold trials, and have those matters appeal directly to the Ninth Circuit.

Senator SESSIONS. In the California Law Review, you wrote this: "Diversity enhances the quality of decisionmaking. In addition to analyzing and applying the law, judges have to make determinations that draw not so much upon the legal acumen but on the understanding of people and human experiences. Such experiences inform assumptions that affect legal decisions. At trial and in evidentiary hearings, judges have to assess credibility of witnesses. A witness' testimony may seem more credible if it is consistent with the judge's knowledge or experience and, conversely, less credible if it remains outside the judge's experience. Simply put, a judge's lifetime experiences affect the willingness to credit testimony or understand the human impact of legal rules upon which the judge must decide. These determinations require a judge to draw upon

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something that is not found in the case, reports that line the walls of our chambers; rather, judges draw upon the breadth and depth of their own life experiences, upon the knowledge and understanding of people and of human nature, and inevitably one's ethnic and racial background contribute to those life experiences."

Does that statement accurately reflect your judicial philosophy?

Judge CHEN. Well, let me put that in context, if I can, Senator. The point I was trying to make in that law review piece was that there is a benefit to having a diverse judiciary; that the judgments we make, some of those are based on deductive reasoning and analysis of law, and sometimes they are based on more intuitive analysis—judging the witness' credibility, making a decision with respect to bail or sentencing. That requires an understanding of human factors in different—in various contexts.

And the point I was trying to make is that the broader the breadth of experience both for an individual judge and collectively as a court, I think the better the ability of judges to make those assessments. And I tried to give some illustrations in that piece about how the collegiality amongst judges, whether it is a formal exchange amongst the members of the Supreme Court or the court of appeals or the informal exchange that often happens in the district court, in the hallways and the dining rooms, that we learn from each other about various perspectives, different perspectives, and life experiences.

Senator SESSIONS. Well, you know, the average litigant would be nervous if he thought a decision was being made on what you judges talked about in the dining hall or in the hallways. I mean, the case should be decided, should it not, on the evidence introduced and the law properly applied to that evidence?

Judge CHEN. No, and I agree with that fully, and I did not mean to suggest that cases are decided in a hallway. But——

Senator SESSIONS. Well, I am just raising this point because it is something we have talked about before. I suppose your experience might help you have insight into a witness' credibility. Everybody has different experiences, and it might. But I was a little concerned that you say you might understand the human impact of legal rules upon which a judge must decide.

You know, the oath says that a judge should do equal justice to the poor and the rich. I assume you would take that oath and intend to follow that.

Judge CHEN. Absolutely, and I did take that oath when I was sworn in as a magistrate judge.

Senator SESSIONS. And that you would be impartial.

Judge CHEN. Absolutely.

Senator SESSIONS. I know you served—what—18 years as counsel for the American Civil Liberties——

Judge CHEN. Sixteen years, actually.

Senator SESSIONS. Sixteen. Now, you were on their payroll as a——

Judge CHEN. As a staff attorney.

Senator SESSIONS. A staff attorney. Well, you know, the ACLU has filed some excellent cases. They have filed some I am not comfortable with.

Is my time up?

Senator FRANKEN. Well, you are right, but I was giving you—in my role as Chairman, I was giving you leeway because you are the distinguished Ranking Member, and I was torn, frankly.

[Laughter.]

Senator FRANKEN. But I guess your time is up, and I would——

Senator SESSIONS. Well, one thing Senator Franken always has tremendous skill at: timing.

[Laughter.]

Senator FRANKEN. Thank you.

Senator Feinstein.

Senator FEINSTEIN. Thank you very much, Mr. Chairman.

I think I know where Senator Sessions is going, and let me say this to him: Judge Chen has been a very fair magistrate judge for 8 years. I have tested this, because I also am aware he has been a fierce advocate prior to that time. And I might have some differences of opinion with some of the things, and I am going to raise one in a moment. But, nonetheless, he has been examined by a Republican screening Committee and by a Democratic screening committee for the position of magistrate judge, and everybody has found he is fair.

I would like to just read on this subject one comment of the Coalition of Northern California Asian American Bar Associations, and it is this: "He has made a successful transition from a zealous advocate to a balanced and conscientious adjudicator who is committed to the impartial and active administration of justice. Judge Chen has earned a reputation as an even-handed jurist who is constantly mindful of the role that judges fulfill in our society."

Senator SESSIONS. Well, I think a person can be a zealous advocate and be a great judge.

Senator FEINSTEIN. So let me ask a question that takes you back a ways, because it was of some concern to me. In 1988, you filed a brief challenging Federal railroad regulations that require that certain employees be tested for drug use at random. You made similar arguments in a series of articles about the same time. As I understand it, the Supreme Court disagreed with your position and held that these drug tests were, in fact, constitutional.

So here is the problem—or here is the question, I should say. I do not really believe there is a problem. Will you have a problem as a district court judge following the Supreme Court's law in this regard or any other?

Judge CHEN. Absolutely not, Senator. The Supreme Court has now ruled in a series of cases on that particular topic, the permissibility or not of drug testing, and the law has now evolved to a much clearer point than it was back in 1988. And I take the decisions of the Supreme Court as my command, and I would follow those.

And I would add that in my position as a magistrate judge it is common, indeed routine, for us to impose mandatory drug testing on pre-trial releasees, on probationers. And I have not had a problem at all, even though one might think that it could be at odds with my former advocacy.

I understand my role as a judge now is entirely different, and my task is to apply the law as it is given to us and to the facts of the case.

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Senator FEINSTEIN. Well, you come very well regarded, and by a whole host of varying authorities. And I think you did make that transition as advocate to judge. And I think you have 8 years under your belt to show that.

So with this in mind was the reason that I recommended you and that your performance as a magistrate judge has been sterling.

Judge CHEN. Thank you, Senator.

Senator FEINSTEIN. And I think you are to be complimented on that.

You know, let me quickly ask this of all of the panelists. I think the Ranking Member, Senator Sessions, essentially referred to this. We hold precedent as very important and the ability of a judge to be cognizant of precedent and to follow it. I would like a comment from each of you as to whether you would see yourself as bound by legal precedent. Judge Nguyen.

Judge NGUYEN. Yes, I would absolutely be bound by precedent. Sitting as a lower-court judge, that is my obligation.

Senator FEINSTEIN. Judge Chen.

Judge CHEN. I would, Senator, and I have a fairly lengthy record of published opinions now as a magistrate judge.

Senator FEINSTEIN. Yes, you do.

Judge CHEN. And I think you would see that I adhere to precedent and try to read the precedent as best I can.

Senator FEINSTEIN. Judge Gee.

Ms. GEE. Not quite "Judge Gee" yet, but——

Senator FEINSTEIN. Oh, I am sorry.

[Laughter.]

Senator FEINSTEIN. Almost.

Ms. GEE. If confirmed as a judge, I would most definitely take very seriously my obligation to apply the precedent of the circuit as well as of the United States Supreme Court.

Senator FEINSTEIN. Thank you.

Judge Seeborg.

Judge SEEBORG. Senator, I believe I have done that in my tenure as a magistrate judge, and I can give you that assurance that, if confirmed, I will continue to follow precedent.

Senator FEINSTEIN. Thank you very much.

Those are my questions. Thank you.

Senator FRANKEN. Thank you, Senator Feinstein. Thank you, Ranking Member Sessions.

Before I adjourn, the Committee has received a number of letters from individuals and organizations who are supporting the nominees before us today. Just to name a few, we have a letter from the Congressional Asian Pacific American Caucus in support of Judge Nguyen, Judge Chen, and Ms. Gee; testimony from the National Asian Pacific American Bar Association and Asian American Justice Center in support of these three nominees; a letter from the Asian Pacific Bar of California; and a letter from six Northern California Asian American Bar Associations in support of Judge Chen. So, without objection, I would like to submit all these letters and testimony for the record.

[The information appears as a submission for the record.]

Senator FRANKEN. I would also like to introduce Chairman Leahy's opening statement into the record.

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[The prepared statement of Chairman Leahy appears as a submission for the record.]

Senator SESSIONS. Mr. Chairman, briefly, could I ask one more question?

Senator FRANKEN. Absolutely.

Senator SESSIONS. A lot of people have firm views about the death penalty. I do not believe a judge should be disqualified or a nominee disqualified if they do not support the death penalty but if the—it is a lawfully applied penalty. My question is: Do you have any personal views such that you would be unwilling to carry out a death penalty if it was properly imposed?

Judge NGUYEN. No, I do not, Senator Sessions.

Judge CHEN. I do not, Senator Sessions.

Ms. GEE. I do not, Senator Sessions.

Judge SEEBORG. I do not, Senator.

Senator SESSIONS. Judge Chen, according to the website of the ACLU, it believes the death penalty inherently violates the constitutional ban on cruel and unusual punishment and guarantees of due process and equal protection. Do you agree with that?

Judge CHEN. Well, those views are not the views of the Supreme Court, and I abide by the rulings of the Supreme Court. And I will tell you that I had one death penalty case that I handled as a lawyer. In that case, we did not bring a broad challenge, a sweeping challenge. It was very fact specific about the case, the ineffective assistance of counsel that this individual had and mistakes that were made by the trial judge. So it was a very narrowly focused case, and we brought that case to ensure that the person had fair process. It was not a broad challenge.

Senator SESSIONS. Well, great attention is provided on those cases by the courts, and that is legitimate. But I guess my question is: Do you agree with this position of the organization you worked for 16 years?

Judge CHEN. Well, other than that one case, I have never been involved in any of the policymaker or any of the broader efforts of the ACLU on that issue. And I would affirm again that as a district judge I see my role very differently today than as an advocate some 15 years ago.

Senator SESSIONS. Ms. Gee, you were a member, I believe, of the ACLU for years, 8 years. Do you agree with that legal position that is on their website?

Ms. GEE. Ranking Member Sessions, I have never been in a policy position or had any active role in the ACLU other than to be a member. I take very strongly the position that as a district court I would have the obligation to apply the law and that I would set aside any personal opinions whatsoever in my faithful adherence to the law.

Senator SESSIONS. Well, you know, you voluntarily joined an organization. I usually do not join one I do not agree with. But I think it is legitimate to ask those questions. We will submit some more questions for the record.

Mr. Chairman, these are able nominees who I believe have good integrity, and I appreciate the opportunity to ask these questions.

Senator FRANKEN. Thank you, Senator.

Senator Feinstein, any more questions?

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Senator FEINSTEIN. No, Mr. Chairman.

Senator FRANKEN. Well, in that case, I would like to thank Senator Feinstein and the distinguished Ranking Member. I also want to thank each of you for your testimony today. You are all very impressive, and I will hold the hearing opening for 1 week for submission of questions for the nominees and other materials.

The hearing is adjourned.

[Whereupon, at 3:27 p.m., the Committee was adjourned.]

[Questions and answers and submissions for the record follow.]

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QUESTIONS AND ANSWERS

Responses of Edward Milton Chen
Nominee to the U.S. District Court for the Northern District of California
to the Written Questions of Senator Tom Coburn, M.D.

1. **You have actively opposed English-only proposals and have equated them with unconscious racism. In one speech, you discussed "language discrimination" and asserted that individuals' "attitudes towards language often mask their . . . sometime unconscious attitudes towards the people who speak that language." In 1995, you testified before the Senate and House of Representatives in opposition to legislation to make English the official language, arguing that such legislation violated the First Amendment and was "unnecessary, patronizing, and divisive." You also wrote a letter to the editor to the *New York Times* stating that English-Only laws are "based on false, xenophobic assumptions," and in a 1987 article you stated that the English-Only movement "is anti-immigrant and xenophobic in character."**

   a. **Oklahoma's legislature just passed a constitutional amendment that would declare English as the official state language. Do you believe that amendment represents an unconscious attitude of the people of Oklahoma towards people who speak another language?**

Response: I have no particular reason to believe the amendment represents such an attitude. Nearly all the comments quoted in the text of Question 1 were made in response to specific legislative proposals pending in Congress and California or to particular arguments made by proponents. The comments, some of which are more than 20 years old, were made as an advocate articulating the positions of my employer, the ACLU of Northern California in those specific contexts. These statements have not and will not inform or influence the performance of my duties as a judge to apply the law neutrally and free from personal preferences.

   b. **Do you believe the Oklahoma amendment is "unnecessary, patronizing, divisive, anti-immigrant, and xenophobic?**

Response: I have no particular reason to believe the amendment is unnecessary, patronizing, divisive, anti-immigrant, and xenophobic.

   c. **8 U.S.C.A. § 1423 of the United States Code requires citizens who are naturalized to have "an understanding of the English language, including an ability to read, write, and speak words in ordinary usage in the English language..." Do you believe this requirement is "unnecessary, patronizing, and divisive"?**

Response: No.

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2. You have criticized the Ninth Circuit's opinion in *Garcia v. Spun Steak*, in which the Ninth Circuit held that English-only rules imposed on bilingual employees were not discriminatory. You have said that the opinion "is delivered in an environment of growing anti-immigrant backlash and in a society that increasingly fears and distrusts rather than values and celebrates ethnic and linguistic diversity." You claim that the decision "can only exacerbate that fear and distrust."

a. Is *Garcia* still good law in the Ninth Circuit?

Response: Since taking the bench, I have not researched or had the opportunity to apply the law after *Garcia v. Spun Steak*. I am not aware of any subsequent decision of the Supreme Court or the Ninth Circuit overturning the *Garcia* decision. As far as I know, it is still good law in this Circuit.

b. If confirmed, will you respect and apply this precedent?

Response: Yes, I will respect and apply this precedent.

c. In one article on *Garcia*, you stated that "the Ninth Circuit ignored the EEOC's view" on how to interpret a relevant case. What deference do you believe that courts should give to administrative decisions?

Response: As a district judge, if I am confirmed, I would be bound by the decisions of the Supreme Court and the Ninth Circuit (or Federal Circuit in appropriate cases) regarding the level of deference to be given to administrative decisions. Although I have not had the occasion to address this issue since becoming a magistrate judge in 2001, my general understanding is that the level of deference may turn on a number of factors. *See, e.g.*, *Chevron, U.S.A., Inc. v. NRDC, Inc.*, 467 U.S. 837 (1984) (stating that a court and agency must give effect to the unambiguously expressed intent of Congress; adding that, if Congress has not directly addressed the precise question, court may defer to agency's interpretation if based on a permissible construction of the statute); *EEOC v. Arabian Am. Oil Co.*, 499 U.S. 244 (1991) (stating that deference to EEOC guidelines depends upon numerous factors including thoroughness evident in agency's consideration, validity of its reasoning, consistency with earlier and later pronouncements, and factors which give it power to persuade). I would apply the applicable Supreme Court and circuit court precedents in determining the appropriate level of deference.

3. In 1998, you helped write an ACLU *amicus* brief filed in California state court (*Kathleen R. v. City of Livermore*, Case No. V-015266-4 (Cal. Sup. Ct. July 10, 1998)). The *amicus* brief supported a library against a plaintiff who sued to require the library to screen obscene material from its Internet computers. The brief argued that the remedy the plaintiff sought to impose on the library would violate the First Amendment.

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a. Do you believe that Federal anti-obscenity laws are unconstitutional?

Response: I do not believe they are inherently unconstitutional. It is my understanding that the Supreme Court has addressed the constitutionality of various federal legislation in this area. *See, e.g.*, *United States v. Williams*, 128 S. Ct. 1830 (upholding 18 U.S.C. § 2252A(a)(3)(B)); *United States v. American Library Ass'n*, 539 U.S. 194 (2003) (holding that Children's Internet Protection Act does not violate First Amendment); *Ashcroft v. ACLU*, 542 U.S. 656 (2004) (upholding preliminary injunction against enforcement of Child Online Protection Act). I would adhere to and apply Supreme Court precedent. Although my name may have been listed as counsel of record in *Kathleen R. v. City of Livermore*, I had no role in any of the briefing or argument in that case. Because the ACLU of Northern California had a small office of only 3-4 attorneys, it was the practice of the office to list all of the staff attorneys on the pleadings. I never litigated any First Amendment challenge to an obscenity law and am not familiar with *Kathleen R.*

b. Do you believe they are constitutionally problematic in any way?

Response: I do not believe they are constitutionally problematic in any inherent way. Such statutes are not constitutionally problematic unless they violate constitutional principles under the precedent established by the Supreme Court and governing circuit court decisions. If such a case were to come before me as a district judge, if confirmed, I would apply binding precedent.

4. You have made several statements regarding racism in America. For example, in the September 22, 2001 remarks mentioned previously, you characterized as "Institutionalized racism" the "federalization of state crimes" and the "[c]riminalization of immigration laws."

a. What specific federalized crimes do you think are a product of "institutionalized racism"?

Response: My reference to "institutionalized racism" was a reference to facially neutral laws and policies which have the effect of disproportionately affecting one racial or ethnic group even if not so intended. I gave as an example the enhancement in punishment under federal law for crack as opposed to powder cocaine. As the U.S. Sentencing Commission has recognized, the crack/powder distinction has had a disproportionate impact upon African Americans even though that was an unintended consequence.

b. Do you believe laws that protect our border are racist?

Response: No, I do not. My 2001 remarks were not intended to convey that laws which protect our border are racist.

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5. According to a *Washington Post* article that emerged after the Ninth Circuit refused to hold California Proposition 209 unconstitutional, you encouraged state agencies to "not dismantle their affirmative action programs until the U.S. Supreme Court decides whether it will review the ban." Critics have said that you "urged public officials in California to violate their oaths of office and to violate the law by not complying with a provision of the state constitution."

a. What is your response to this criticism?

Response: I did not nor would I ever urge public officials to violate their oath or the law. The view of the legal team of which I was a part at the time was that it would make practical sense to pause and proceed with caution before taking irreversible steps because review was being sought in the U.S. Supreme Court and because the process of implementing Proposition 209 which, even if upheld against a federal constitutional challenge, was subject to varying legal interpretations (*e.g.*, whether recruitment of women and minorities is permissible if actual selections were gender and race-neutral; whether agencies receiving federal funds could maintain affirmative action if without them, they risk liability under federal law; whether voluntary integration plans for public schools were permissible, etc.). To the extent the *Washington Post* article implies otherwise, the attributed remark is not a quote of what I said but a mischaracterization by a spokesperson who took an opposing view.

b. Did you, in fact, encourage officials not to comply with the law until the Supreme Court acted on the matter?

Response: No.

6. Concerning Proposition 209, you said that "'[t]here is nothing neutral about [it] . . . . If implemented, only women and minorities will be excluded from public education, jobs and business opportunities. Only women will be barred from equal access to the political process.'"[1]

a. Now, more than 10 years later, do you believe that is the case?

Response: Over the past 10 years, I transitioned from an advocate to a judge. I have not studied the impact of Proposition 209.

b. Have women and minorities been excluded from positions in California?

Response: Since transitioning from advocate to judge, I have not studied the extent to which women and minorities may have been excluded. If a case contending that women and/or minorities were excluded from certain positions in

[1] Press Release, *Civil Rights Advocates Will Appeal Decision on 209*, ACLU of Northern California, April 22, 1997.

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California were to come before me, I would as a district judge, if confirmed, apply the law as established by the Supreme Court and the Ninth Circuit to the facts which are properly presented in the specific case. I would not prejudge any case, nor would my prior role as advocate in the Proposition 209 case have any bearing or influence upon my roles as a district judge were I to be confirmed.

7. In 2005 remarks before the Diversity Celebration at the California State Bar Convention, you suggested that the slow response to Hurricane Katrina was connected with race: "Would the response have been different had the majority of victims been white and middle class rather than poor and black? Would the response have been quicker had it been Kennebunkport instead of New Orleans?"

a. Do you believe that the slow response to Hurricane Katrina—a slow response from the Federal, state, and local governments—was due to race?

Response: I do not know if the slow response was due to race. Indeed, in my remarks, I posed a number of potential questions about the response including those unrelated to race. My questions were meant to reflect issues that had been raised in the media and which had become the subject of national debate. Given the nature of the event which focused on diversity and the timing of the event just weeks after Hurricane Katrina, I thought it was appropriate to include questions that had been raised in the national discussion about race.

8. In remarks given at the Hastings Public Interest Graduation on May 20, 2005, you described the funeral service for Fred Korematsu, one of your former clients. In commenting on the fact that the congregation sang "America the Beautiful," you described your "own feelings of ambivalence and cynicism when confronted with appeals to patriotism – sometimes I cannot help but feel that there are too much [sic] injustice and too many inequalities that prevent far too many Americans from enjoying the beauty extolled in that anthem."

a. As you know, litigation frequently is filed in Federal court challenging the constitutionality of the Pledge of Allegiance. Do you feel "ambivalent" and "cynical" when you pledge allegiance to the flag?

Response: No. I have no ambivalence or cynicism when I recite the Pledge of Allegiance. I am deeply committed to our Nation and grateful for the blessings it has afforded my family and me, and I am unequivocally dedicated to our system of justice and the rule of law. The ambivalence I was referring to in that remark was meant as a foundation for the comment that immediately followed in those remarks about Fred Korematsu. I continued my remarks by stating that Fred Korematsu demonstrated the true meaning of patriotism, not by reciting the symbols of patriotism, but by standing up for the principles for which those symbols stand – our national commitment to freedom, justice,

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and equality under the law. I was inspired by Fred Korematsu's faith in the promise of our Nation.

b. Do you feel "ambivalent" and "cynical" when you hear the National Anthem?

Response: As with the Pledge of Allegiance, I feel no ambivalence or cynicism when I hear the National Anthem. I feel pride and hope.

c. If such litigation were to come before you as a district judge, what assurances can you give that you would be able to fairly and impartially rule on the issues?

Response: I have given to the Committee my assurance under oath that I will apply the law and adhere to binding precedent. As a magistrate judge for over eight years, I have done my best to fulfill the oath of office I took to apply the law fairly and neutrally. I believe that my record in the office of U.S. Magistrate Judge for the last eight years serves as further assurance to the Committee.

9. You unsuccessfully litigated to invalidate injunctions issued against gang members (*see, e.g.*, *People ex rel. Gallo v. Acuna*, 14 Cal. 4th 1090 (Cal. 1997)). The injunctions prohibited the gang members from engaging in a wide range of activities within a particular neighborhood, including appearing with other gang members.

a. Do you believe that anti-gang injunctions violate the First Amendment?

Response: The California Supreme Court has upheld the constitutionality of anti-gang injunctions as was issued in *Acuna*. Although I have not had occasion to address the issue as a judge and therefore have not had occasion to research the law, I am not aware of any subsequent precedent that has substantially altered the constitutional analysis. I will follow Supreme Court precedent.

b. Do you believe that such injunctions are based in racism?

Response: No.

c. If confirmed, will you put aside any personal views you have regarding anti-gang injunctions and impartially apply the law?

Response: Yes. I give my assurance that my prior advocacy as a lawyer on this issue would have no influence upon my decisions as a district judge if I am confirmed and that I would impartially apply the law.

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Responses of Edward Milton Chen
Nominee to the U.S. District Court for the Northern District of California
to the Written Questions of Senator Jeff Sessions

1. **At your confirmation hearing, I asked you about the following statement that you have made in several speeches and that was published in the *California Law Review*:**

> **"diversity enhances the quality of decision-making. In addition to analyzing and applying the law, judges have to make determinations that draw not so much upon legal acumen, but on an understanding of people and of human experiences. Such experiences inform assumptions that affect legal decisions. At trial and in evidentiary hearings, judges have to assess the credibility of witnesses. A witness' testimony may seem more credible if it is consistent with the judge's knowledge or experience, and, conversely, less credible if it remains outside the judge's experience. . . .**
>
> **Simply put, a judge's life experiences affect the willingness to credit testimony or understand the human impact of legal rules upon which the judge must decide. These determinations require a judge to draw upon something that is not found in the case reports that line the walls of our chambers. Rather judges draw upon the breadth and depth of their own life experience, upon the knowledge and understanding of people, and of human nature. And inevitably, one's ethnic and racial background contributes to those life experiences."**

When I asked whether this accurately reflected your judicial philosopby, you responded that there is a benefit to having a diverse judiciary. I am unclear as to what you mean by that statement, as well as the above quote.

a. Please explain your statement that there is a benefit to having a diverse judiciary.

Response: In the *California Law Review* article from which the quote is taken, I tried to explain the various benefits of a diverse judiciary. Among them are the establishment of judicial role models for students and attorneys; helping to dispel stereotypes that certain demographic groups, because of their prior absence from the field, are not capable or are less capable of being judges; and the message of inclusion sent to historically under-represented communities which could help break down barriers to access to justice and engender confidence and trust in the courts. I do not believe that race or gender should affect a judge's interpretation of the law.

b. Do these statements accurately reflect your judicial philosophy?

Response: The quoted statement was not intended as a reflection of any judicial philosophy.

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It was intended as an empirical (albeit not scientific) observation that the nature and breadth of a judge's life experience can affect his or her perceptions and hence decision-making process. Thus, diversity facilitates an interchange of ideas, experiences, and perspectives among judges -- much the way it does in a classroom, private business, or other public institution. That observation does not change my fundamental philosophy that a judge, particularly at the district court level, must apply the law as determined by binding authorities (the Supreme Court and the applicable Court of Appeals) to the facts free from personal philosophies and preferences. To do otherwise corrodes the integrity of the courts and ultimately the rule of law itself.

c. Do you believe that an individual's race or gender affects the quality of his or her decisionmaking?

Response: I do not believe that the quality of decision-making is affected by one's gender or race. An individual's race or gender should not drive one's decisions as a judge. Judges should do everything humanly possible to uphold their oath to apply the law without regard to the person's status.

d. Can you give me an example of an "experience" that "informed" one of your "assumptions" that "affected one of your legal decisions?"

Response: I am not aware of any particular experience that informed one of my own assumptions which affected a legal decision I have made. I have made a conscious effort to check any personal feelings or intuitive notions I might possess, and have applied the law as I best understand it to facts based on objective criteria.

2. What in your view is the role of a judge?

Response: The role of a judge is to be fair, neutral, and evenhanded in applying the law and finding facts (when called to do so) without regard to personal preferences.

a. Do you think it is ever proper for judges to indulge their own values in determining what the law means?
- **i. If so, under what circumstances?**
- **ii. Please identify any cases in which you have done so.**
- **iii. If not, please discuss an example of a case where you have had to set aside your own values and rule based solely on the law.**

Response: It is never proper for judges to indulge their own values in determining what the law means. I have never indulged my own values in determining what the law means. I have set aside my prior positions as an advocate and made the transition to the role of a neutral judge when I took the bench as a magistrate judge eight years ago. For instance, although I litigated cases challenging random drug testing as a lawyer, I now, as a magistrate judge, routinely impose

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mandatory drug testing as a condition on pretrial releasees and probationers. Although it is my understanding that the ACLU either has or does oppose preventive detention, I routinely detain criminal defendants without bail when I find they pose a flight risk or danger to the community pursuant to the Bail Reform Act of 1984. Although I sought recovery of attorney's fees in numerous civil rights cases as a lawyer on behalf of plaintiffs, as a magistrate judge, I cut a requested fee award in a Title VII case, and was ultimately reversed by the Ninth Circuit for being too stringent.

b. Do you think it is ever proper for judges to indulge their own policy preferences in determining what the law means?
i. If so, under what circumstances?
ii. Please identify any cases in which you have done so.
iii. If not, please discuss an example of a case where you have had to set aside your own policy preferences and rule based solely on the law.

Response: It is never proper for judges to indulge their own policy preference in determining what the law means. I have never done so. As illustrations of where I have made rulings based solely on the law free from any prior positions I had taken as a lawyer, see my answer to Question 2.a.

3. How would you define "judicial activism?"

Response: I do not use the phrase "judicial activism." There is no universal definition as "judicial activism" has taken on various meanings, which appear to depend in part upon the context. If, as applied to the district court, judicial activism means deciding issues broader than that necessary to adjudicating the case and allowing a judge's own values and policy preferences to influence the decision-making, rather than adhering to the law and finding facts on an objective basis, I am not a judicial activist.

4. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: The proper mode of constitutional interpretation appears to be a subject of debate within the Supreme Court. As a district court judge, if confirmed, I would apply the constitutional analysis as directed by precedents of the Supreme Court and the Ninth Circuit. It is for the higher courts, not the district court, to resolve and establish the proper mode of constitutional analysis.

5. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

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a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: I am unconditionally committed to following the precedents of higher courts faithfully and giving them full effect, regardless of my personal agreement or disagreement with such precedents.

b. How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision of your own best judgment of the merits?

Response: Even if I believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision, I nonetheless would be bound by that decision and would adhere to and apply that decision. It is not for the district court to second guess the higher courts.

6. In remarks before the Berkeley School of Law chapter of the American Constitution Society, you stated that you find "most rewarding . . . . [c]ontributing to the development of the law via published opinion, especially if it comports with my view of justice."

a. Please explain what you mean by your "view of justice."

Response: My reference to my "view of justice" was directed primarily at matters which improve the administration of justice. The vast majority of decisions at the magistrate judge level pertain to pretrial matters such as discovery, case management, and pretrial motions. Most of our published decisions appear in the Federal Rules Decisions. I was taught by former District Judge Charles Renfrew for whom I clerked that the most important rule of the Federal Rules of Civil Procedure is Rule 1 – which directs that the rules should be construed and administered to secure the "just, speedy, and inexpensive determination" of every action and proceeding. Toward that end I have issued numerous published opinions which have contributed to clarification of rules and procedures.

b. Please provide an example of a case in which the outcome comported with your view of justice.

Response: In *Semitool, Inc. v. Tokyo Electron Am.*, 208 F.R.D. 273 (N.D. Cal. 2002), I issued an opinion which I believe clarified the otherwise confusing and conflicting law as to when early discovery is permissible. I concluded that whether there should be expedited discovery should turn on whether there is good cause for such discovery, and not upon whether the party seeking discovery has satisfied a standard akin to preliminary injunctive relief, as had been argued. I believe the ruling provided a fair balance of competing interests and was consistent with Federal Rule of Civil Procedure 26. The decision has been widely

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cited. My ability to contribute to the efficient and just administration of justice has been gratifying.

c. Please provide an example of a case in which you "contribute[d] to the development of the law via published opinion."

Response: Please see my answer to Question 6.b.

d. Are you able and willing to "contribute to the development of the law via published opinion" even if it does not comport with your view of justice?

Response: Yes.

e. Have you "contribut[ed] to the development of the law via published opinion" in circumstances where it did not comport with your view of justice?

Response: Yes. As an example, I presided over a case in which I felt that removal to federal court from state court was not consistent with general policy underlying the removal statute, but concluded that the strict language of the statute required me to sustain the removal.

7. In remarks given on September 22, 2001, you briefly mentioned the "horror and disbelief" you felt following the 9/11 attacks. You then stated that you

> **"had a sickening feeling in [your] stomach about what might happen to race relations and religious tolerance on our own soil . . . . [O]ne has to wonder whether the seemingly irresistible forces of racism, nativism and scapegoating which has recurred so often in our history can be effectively restrained."**

Similarly, in remarks at Stanford Law School on November 14, 2001, you seemed to draw a comparison between the conditions that led to the internment of Japanese Americans in World War II and the circumstances following the 9/11 attacks. Do you believe that it is appropriate for a sitting judge to comment publicly on policy matters, especially those in a national security context?

Response: No, I do not believe it is appropriate for a sitting judge to publicly comment on policy matters. My remarks at Stanford Law School were directed at students aspiring to public service. My intent was not to make a comment on policy matters, but to give the students illustrations of some of the issues that should warrant their thought and attention and inspire them to get involved in addressing some of the difficult and challenging legal questions that lay ahead. I also wanted to impress upon the students the importance of the rule of law. If my remarks were taken as a comment on policy, I regret that and will endeavor to safeguard against that in the future.

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8. You also have made comments regarding political matters, which is rather unusual for a judge. For example, in a November 11, 2001 speech before the National Asian Pacific American Law Student Association, you criticized Senator Fred Thompson for his work in trying to investigate campaign finance controversies involving John Huang and Charlie Trie, both of whom eventually pled guilty to felony campaign finance law violations. Similarly, in an October 2008 speech, you made a joke at the expense of the Republican Vice-Presidential nominee.

a. Do you believe it is appropriate for a judge to publicly comment on political matters?

Response: No, I do not believe it is appropriate for judges to publicly comment on political matters. In my speech before the National Asian Pacific American Law Student Association in 2001, I did not intend to comment on political matters. Rather, I was giving a number of examples of discriminatory attitudes against Asian Americans that continue in contemporary times, in order to urge students to think about the issues of bias and discrimination they could well face. I gave a host of examples both historically and currently, including a survey of attitudes towards Asian Americans, a skit at the American Society of Newspaper Editors, and unfair questions posed by the press to an Asian American Republican candidate for public office about divided loyalties. I also referenced the campaign finance controversy in the 1990's which many in the Asian American community know started with the Democratic National Committee's vetting policies directed at Asian American donors and grew to include more widely circulated inflammatory comments about John Huang and Charlie Trie by others. Seen in this context, these were a collection of anecdotes, not directed at any one political party or institution, but marshaled to make a more general point. In my October 2008 speech, I had joked about a number of things including a self-deprecating joke aimed at Asian Americans. That joke plus my inclusion of a joke about the Republican vice presidential nominee's involvement with the PTA was, in retrospect, in poor taste and should not have been made.

b. If a judge's role is to interpret and not make the law, doesn't it blur the line between the two when a judge comments on political matters, as you did?

Response: As stated in my answer to Question 8.a., I did not intend to comment on political matters, as such would be improper because it could compromise the appearance of impartiality. I take my role as a judge to interpret and not make the law seriously, and I believe my record on the bench for the last eight years demonstrates that. If my remarks were taken as a comment on political matters, I regret that and will endeavor to avoid such in the future.

c. Rule 4.1 of the ABA code of Judicial Ethics states:

"a judge plays a role different from that of a legislator or executive branch official. Rather than making decisions based upon the expressed views or

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preferences of the electorate a judge makes decisions based upon the law and the facts of every case. Therefore, in furtherance of this interest, judges and judicial candidates must, to the greatest extent possible, be free and appear to be free from political influence and political pressure. ... Public confidence in the independence and impartiality of the judiciary is eroded if judges ... are perceived to be subject to political influence. .. [and are prohibited] from making speeches on behalf of political organizations or publicly endorsing or opposing candidates for public office ..."

i. Do you believe your statements comported with the spirit of this rule?
ii. Do you believe that "to the greatest extent possible" you attempted to appear "free from political influence"?

Response: I do not believe my comments, put in the context as I have explained above, violated Rule 4.1 of the ABA Code of Judicial Ethics. I do not believe my comments were perceived to be the subject of political influence or seen as made on behalf of political organizations or endorsing any candidate for public office. That certainly was not my intent.

9. While a staff attorney for the ACLU of Northern California, you wrote a letter to the editor of the *New York Times* stating that English-only laws are "based on false, xenophobic assumptions." In a 1987 issue of *East Wind* magazine, you co-authored an article that stated, among other things, that the English only movement "is anti-immigrant and xenophobic in character."

a. Do you believe that English-only laws are *per se* unconstitutional?

Response: No. No court to my knowledge has held that English-only rules are *per se* unconstitutional.

b. Do you believe that they are always based on racist assumptions or perceptions?

Response: No. English-only laws passed by the legislature or by initiative are presumptively constitutional. Absent presentation of specific evidence to the contrary, I do not believe there is any authority supporting a presumption that such laws are based on racist assumptions or perceptions.

c. Given your many statements and positions regarding this issue, what assurances can you give that you will rule fairly and impartially on any matter involving an English-only policy or practice?

Response: I assure the Committee that, if the issue were to come before me, I would rule, if confirmed as a district judge, fairly and impartially. I have taken, and if confirmed, will again take the oath to do so. To do otherwise would not only violate my personal oath, but undermine the overarching value to which I

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subscribe – adherence to the rule of law. As I noted in my answer to Question 2.a., I have issued numerous ruling as a judge which would appear contrary to positions I previously took as an advocate. I believe these rulings are the best evidence of my commitment to the rule of law.

10. As an ACLU attorney, you frequently and strongly supported affirmative action programs. You litigated against efforts to invalidate anti-affirmative action initiatives. In 1996, you took part in the ACLU's unsuccessful challenge to California's Proposition 209, which outlawed preferential treatment to individuals on the basis of race, gender or ethnicity in state hiring, contracting and education. You also filed on behalf of the ACLU an *amicus* brief with the Supreme Court in *Richmond v. J.A. Croson Co.* in an unsuccessful effort to defend Richmond's Minority Business Utilization Plan, an affirmative action program. If confirmed, will you commit to follow the precedent of the Ninth Circuit and Supreme Court and put aside your views regarding affirmative action?

Response: Yes, I will commit to following precedent of the Ninth Circuit and Supreme Court in all areas including issues pertaining to affirmative action, regardless of my views or prior advocacy.

11. According to the ACLU's website, the ACLU believes that the death penalty inherently violates the constitutional ban on cruel and unusual punishment and the guarantees of due process and equal protection. At your hearing, I asked you whether you agreed with the ACLU's position. You responded that you were never involved in the policymaking or broader efforts of the ACLU on this issue. However, I am still unclear as to whether you agree or disagree with the ACLU's position on the death penalty.

a. Do you agree with the ACLU's position on the death penalty, as set forth on its website?

Response: I am not familiar with the ACLU's website statements on the death penalty. As phrased in your question, the law since *Gregg v. Georgia*, 428 U.S. 153 (1976), is now clearly established that the death penalty does not inherently violate the constitutional ban on cruel and unusual punishment and the guarantees of due process and equal protection. As a district judge, if confirmed, I would apply that precedent.

b. The ACLU Capital Punishment Project, which "challenges the unfairness and arbitrariness of capital punishment while working towards its ultimate repeal," filed an *amicus* brief in the Supreme Court case *Kennedy v. Louisiana*, arguing that the Eighth Amendment's rule against cruel and unusual punishment prohibited application of the death penalty for child rapists under "evolving standards of decency." The Supreme Court held that the death penalty for the crime of child rape always violates the Eighth Amendment. Writing for a five-justice majority, Justice Kennedy based his

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opinion partly on the fact that 37 jurisdictions – 36 states and the federal government – did not allow for capital punishment in child rape cases. In reality, however, Congress and the President specifically authorized the use of capital punishment in cases of child rape under the Uniform Code of Military Justice (UCMJ) in the National Defense Authorization Act of 2006, as reported first by Col. Dwight H. Sullivan in his blog and later by the *New York Times*.

i. Given the heinousness of the crime, as well as the new information on the federal government's codification of capital punishment in child rape cases under the UCMJ, do you believe *Kennedy v. Louisiana* was wrongly decided? If not, why?

Response: Because I have had no occasion to examine the issue raised in *Kennedy v. Louisiana* since taking the bench, I have not studied the opinions of the justices therein and have not formed an opinion on it. Most importantly, as a district judge, if confirmed, I would be bound by the Supreme Court's decision in *Kennedy* and would apply it.

ii. Following the Supreme Court's decision, President Obama announced at a press conference: "I think that the death penalty should be applied in very narrow circumstances for the most egregious of crimes. I think that the rape of a small child, 6 or 8 years old, is a heinous crime." Do you agree with that statement?

Response: Yes. The circumstances in which the death penalty is to be applied is in the first instance the prerogative of Congress as to federal legislation. If called upon to adjudicate the constitutionality of such legislation, the district court would be bound to follow the precedent of the Supreme Court and the applicable circuit court.

12. In a 1990 *Hastings Communications and Entertainment Law Journal* article, you endorsed certain hate crimes legislation designed to address "racial harassment severe enough to inflict psychic injury." You also filed an *amicus* brief in California state court that argued in favor of the constitutionality of a particular hate crimes statute.

a. As a general matter, do you believe that hate crimes statutes are Constitutional?

Response: Hate crime statutes, like any other statute, are generally entitled to a presumption of constitutionality. The California Supreme Court has upheld California hate crime legislation against a generalized First Amendment challenge, rejecting the argument that punishing hate crimes more severely than an analogous general crime is tantamount to punishing speech or thought. I have not examined precedent in the federal courts other than noting the Supreme Court has addressed

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specific challenges in such cases as *Virginia v. Black*, 538 U.S. 343 (2003), *Wisconsin v. Mitchell*, 508 U.S. 476 (1993), and *R. A. V. v. St. Paul*, 505 U.S. 377 (1992).

b. How should a hate crimes statute be drafted to avoid Constitutional difficulties?

Response: My understanding is that there are Supreme Court precedents, as noted above. Other than that, I do not have any views as to the proper drafting of hate crimes statutes.

c. If confirmed, will you put aside any personal views you have regarding hate crimes legislation, and impartially apply the law?

Response: Yes. As with all areas of the law, I would put aside any personal views regarding hate crimes legislation and impartially apply the law.

13. As you may know, President Obama has described the types of judges that he will nominate to the federal bench as follows:

"We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."

a. Do you agree with President Obama's quote?

Response: I am a nominee and not a selector of nominees. It is the prerogative of the President to nominate the federal judges of his choosing, subject to the advice and consent of the Senate, and to employ the criteria he determines are appropriate in making those decisions.

b. Do you believe that you fit President Obama's standard as described in his quote?

Response: I have not personally lived all of the experiences the President described in the selected quote. I have, however, had diverse, sometimes opposing, experiences that deepen my understanding of the varying perspectives that litigants bring to court. For instance, while I have represented criminal defendants and alleged gang members, I have been the victim of gang violence and other crimes. While I have a developmentally disabled child and cared for my wheelchair-bound mother towards the end of her life, I have managed the family business and understand the financial burden of complying with disability access codes.

c. What role do you believe that empathy should play in a judge's consideration of a case?

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Response: Empathy should not drive the outcome of the judge's decision-making. Empathy can, however, make the judge sensitive to the litigants. Understanding the human needs and interests which underlie each case can serve as an important reminder that every case is important and can and will impact human lives. Empathy can also help insure that the judge treats all the parties with dignity and respect.

d. Do you think that it is ever proper for judges to indulge their own subjective sense of empathy in determining what the law means?
i. If so, under what circumstances?
ii. Please identify any cases in which you have done so.
iii. If not, please discuss an example of a case where you have had to set aside your own subjective sense of empathy and rule based solely on the law.

Response: It is never proper for judges to indulge their own subjective sense of empathy in determining what the law means. With respect to my own experience, I have ruled in favor of parties who were unsympathetic but nonetheless had the law and facts on their side. Likewise, I have detained individuals who appeared earnest but nonetheless posed a risk of flight or danger to community and thus had to be held without bail. I have mediated numerous individual cases where I believe the settlement did not properly reflect the value of the case (both too high and too low), but felt constrained in my role as a neutral.

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Responses of Dolly M. Gee
Nominee to the U.S. District Court for the Central District of California
to the Written Questions of Senator Jeff Sessions

1. **In 1996, you spoke regarding the Historical Perspective of Affirmative Action. In that speech, you made the point that many of the laws necessary to remediate civil rights abuses were in place after the Civil War. But you stated that you believed society did not respond to those laws and that inaction required additional legal protections such as the Civil Rights Act of 1964 and subsequent Supreme Court decisions.**

   a. **Do you believe it is the role of judges to interpret laws to compel social change, regardless of whether we agree that such social change may be beneficial?**

Response: I believe that a judge's role is to fairly and impartially ascertain the facts in individual cases and to faithfully apply to those facts the laws as enacted by the legislature or as set forth in binding legal precedent. A judge should not interpret the laws to compel any pre-determined result or promote a personal agenda, whether it be for or against social change or any other personal purpose or preference.

   b. **Do you believe that after the Civil War, the Supreme Court, and courts in general, were acting as legal impediments to social change?**

Response: No, the courts are not the proper forum for implementing social change. In my 1996 speech regarding the history of affirmative action, I pointed out that real progress in the realm of social equality accelerated and emerged from the crucible of democratic action (e.g., the Civil Rights Movement), legislative action (e.g., the Civil Rights Act of 1964), and executive action (e.g., presidential Executive Orders).

2. **You state in your Questionnaire that you "helped edit but did not sign a joint Asian American Bar Associations letter to Sen. Alan Cranston regarding the nomination of Robert Bork" to be an Associate Justice of the Supreme Court. However, since 1986 you have been a member of the Southern California Chinese Lawyers Association, which is the first signatory to the letter. In 1987, one year after the letter was written, you became a member of the Association's Board of Governors.**

   a. **Do you agree with the statements and sentiments of the letter that was drafted?**

Response: To the extent that the letter criticized judicial activism and endorsed judicial restraint and respect for legal precedent, I agree with the intent of the letter.

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b. Do you agree with the statement in the letter that the Senators should not have confirmed Judge Robert Bork because his "extremist social philosophy must inevitably shape his judicial behavior"?

Response: I must defer to the judgment of the U.S. Senators who reviewed Judge Bork's complete record as to whether his judicial opinions exhibited requisite qualities of judicial restraint and respect for binding legal precedent.

c. Why should you be treated by a different standard for confirmation than you were willing to apply to Judge Bork?

Response: While many people think that Supreme Court nominees should be subjected to a different standard than District Court nominees, I believe that all judicial nominees should be evaluated for their ability to be fair and impartial, including evidence of respect for legal precedent and faithful adherence to the law. To that extent, I do not believe that I should be treated by a different standard for confirmation as that applied to Judge Bork. Although I do not have a judicial track record as yet, my work as an arbitrator and court-appointed neutral reflects no ideological bias.

3. President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."

a. Do you agree with President Obama's quote?

Response: I cannot say what President Obama intended in making that statement. I construe President Obama's comments, however, to mean that judges should have an open mind, broad life experience, and should not pre-judge litigants or witnesses due to factors that have nothing to do with the merits of their case or testimony. If that is the import of President Obama's comments, then I agree with the quote.

b. Do you believe that you fit President Obama's standard as described in his quote?

Response: Based upon my understanding of his quote, I believe that I fit President Obama's description.

c. What role do you believe that empathy should play in a judge's consideration of a case?

Response: I do not believe that empathy should dictate the outcome of a case or that it should be a substitute for the dispassionate application of the law to the facts of a case. Empathy may come into play in how a judge treats litigants or witnesses in his or

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her courtroom—for example, with dignity and respect rather than disdain or condescension.

d. Do you think that it is ever proper for judges to indulge their own subjective sense of empathy in determining what the law means?

Response: No, I do not.

i. If so, under what circumstances?

4. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: Yes, unequivocally.

b. How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision of your own best judgment of the merits?

Response: If I am confirmed to be a U.S. District Judge, I would be obligated and duty-bound to apply the decisions of the Ninth Circuit Court of Appeals and the United States Supreme Court, regardless of whether I personally agree with those decisions or not.

5. What in your view is the role of a judge?

Response: The role of a judge is to fairly and impartially apply the law to the facts of each individual case regardless of the judge's own subjective views, and, when called upon, to serve as the neutral trier of fact.

a. Do you think it is ever proper for judges to indulge their own values in determining what the law means?

Response: No, I do not.

i. If so, under what circumstances?

b. Do you think it is ever proper for judges to indulge their own policy preferences in determining what the law means?

Response: No, I do not.

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c. If so, under what circumstances?

6. How would you define "judicial activism?"

Response: Judicial activism appears to have a variety of meanings, including decision-making that disregards the facts, clear and unambiguous statutory language, and/or binding legal precedent; making law rather than interpreting it (i.e., "legislating from the bench"); insinuation of a judge's personal preferences into judicial decision-making; and aggrandizement of judicial power to the detriment of executive or legislative power.

7. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: The beauty and brilliance of our Constitution are that its timeless values have endured even as our society has evolved. I believe that application of the plain language of the Constitution and respect for binding precedent are the twin pillars of constitutional interpretation for any federal district judge.

8. You were a member of the ACLU for nine years. According to the ACLU's website, the ACLU believes that the death penalty inherently violates the constitutional ban on cruel and unusual punishment and the guarantees of due process and equal protection. At your hearing, I asked you whether you agreed with the ACLU's position. You responded that you never had an active role in the organization. However, I am still unclear as to whether you agree or disagree with the ACLU's position on the death penalty.

a. Do you agree with the ACLU's position on the death penalty, as set forth on its website?

Response: It is the duty of every federal district judge to apply the existing law on the death penalty in appropriate cases and, if I am confirmed as a judge, I intend to do so. There are no moral or philosophical constraints that would interfere with my ability to apply existing law. I am not familiar with the contents of the ACLU's website but, if the ACLU's position on the death penalty is as stated, it is not consistent with my own.

a. The ACLU Capital Punishment Project, which "challenges the unfairness and arbitrariness of capital punishment while working towards its ultimate repeal," filed an *amicus* brief in the Supreme Court case *Kennedy v. Louisiana*, arguing that the Eighth Amendment's rule against cruel and unusual punishment prohibited application of the death penalty for child rapists under "evolving standards of decency." The Supreme Court held that the death penalty for the crime of child rape always violates the Eighth

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Amendment. Writing for a five-justice majority, Justice Kennedy based his opinion partly on the fact that 37 jurisdictions – 36 states and the federal government – did not allow for capital punishment in child rape cases. In reality, however, Congress and the President specifically authorized the use of capital punishment in cases of child rape under the Uniform Code of Military Justice (UCMJ) in the National Defense Authorization Act of 2006, as reported first by Col. Dwight H. Sullivan in his blog and later by the *New York Times*.

i. Given the heinousness of the crime, as well as the new information on the federal government's codification of capital punishment in child rape cases under the UCMJ, do you believe *Kennedy v. Louisiana* was wrongly decided? If not, why?

Response: I am not familiar with the record before the Supreme Court in Kennedy v. Louisiana. If I am confirmed as a federal district judge, however, I will be duty bound to apply existing Supreme Court precedent, including Kennedy v. Louisiana, regardless of my personal views on whether it was wrongly decided.

ii. Following the Supreme Court's decision, President Obama announced at a press conference: "I think that the death penalty should be applied in very narrow circumstances for the most egregious of crimes. I think that the rape of a small child, 6 or 8 years old, is a heinous crime." Do you agree with that statement?

Response: Yes. Nonetheless, if I am confirmed as a federal district judge, I will be obligated to apply existing Supreme Court precedent, including Kennedy v. Louisiana so long as it has not been overturned.

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Responses of Jacqueline H. Nguyen
Nominee to the U.S. District Court for the Central District of California
to the Written Questions of Senator Jeff Sessions

1. **President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."**

a. Do you agree with President Obama's quote?

Response: I interpret President Obama's comment to refer to the notion that a judge who has empathy and compassion may better be able to appreciate the burdens and challenges of the litigants, witnesses and victims who appear in her court. In the context of heavy caseloads, these qualities contribute to a better judicial demeanor and temperament, and serve as a reminder that while cases may be routine to the court, they are very important to the parties and witnesses, and that each person entering the courtroom deserves to be treated with patience and respect.

Response: I do not believe, however, that empathy should play a role in interpreting or applying the law.

b. Do you believe that you fit President Obama's standard as described in his quote?

Response: I believe that I am a fair and compassionate person. However, I do not believe that these qualities have ever affected my ability to analyze and strictly apply the law to the facts of any case. If I am confirmed as a United States district court judge, I intend to continue to adhere faithfully to the law in every case.

c. What role do you believe that empathy should play in a judge's consideration of a case?

Response: I do not believe that empathy should play a role in interpreting and applying the law. A judge must apply the law to the individual facts of each case.

d. Do you think that it is ever proper for judges to indulge their own subjective sense of empathy in determining what the law means?

Response: No.

i. If so, under what circumstances?

ii. Please identify any cases in which you have done so.

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Response: None.

iii. If not, please discuss an example of a case where you have had to set aside your own subjective sense of empathy and rule based solely on the law.

Response: In a number of cases involving young defendants charged with serious crimes or gang enhancements, I have set aside my sense of empathy for these defendants as well as their families in imposing lengthy or life sentences as called for by the law.

2. What in your view is the role of a judge?

Response: The role of a judge is to apply the law to the facts of each case and to determine facts when called upon to do so. For the district court, that law is dictated by the United States Supreme Court and the precedent within that circuit.

a. Do you think it is ever proper for judges to indulge their own values in determining what the law means?

Response: No.

i. If so, under what circumstances?

ii. Please identify any cases in which you have done so.

Response: None.

iii. If not, please discuss an example of a case where you have had to set aside your own values and rule based solely on the law.

Response: On several occasions in sentencing matters, my personal views have been different than the sentence called for by the law. In these instances, I did not have any difficulty setting aside my own views and apply the law.

b. Do you think it is ever proper for judges to indulge their own policy preferences in determining what the law means?

Response: No.

i. If so, under what circumstances?

ii. Please identify any cases in which you have done so.

Response: None.

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iii. If not, please discuss an example of a case where you have had to set aside your own policy preferences and rule based solely on the law.

Response: I have presided over cases in which I felt that the sentence called for by the statute was not fairly reflective of the crime, and that either it was too lenient or too harsh. In these instances, I did not have any difficulty setting aside my own policy preferences and apply the law.

3. How would you define "judicial activism?"

Response: Judicial activism can mean deciding issues beyond the facts of a particular case in order to create new policy, or injecting personal views into the law rather than strictly applying it. I believe that a judge must respect and apply precedent.

4. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

Response: I believe that the Constitution sets forth certain core principles, and that the courts must do their best to decide how these principles apply, if at all, to situations that did not exist at the time the Constitution was written. In general, I believe that judicial restraint is the most prudent approach when it comes to constitutional interpretation. At the district court level, the judge's role is limited to applying the law as determined by the Supreme Court and the applicable circuit to the facts before the court.

5. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: Yes.

b. How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision of your own best judgment of the merits?

Response: I would apply the law as determined by the Supreme Court and the Ninth Circuit Court of Appeals even if I believed that the higher court seriously erred in rendering its decision. The role of a district court judge is to apply the law, as set by binding precedent, not substitute the judge's own judgment about what the law should be.

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Responses of Richard Seeborg
Nominee to the U.S. District Court for the Northern District of California
to the Written Questions of Senator Jeff Sessions

1. President Obama has described the types of judges that he will nominate to the federal bench as follows: "We need somebody who's got the heart, the empathy, to recognize what it's like to be a young teenage mom. The empathy to understand what it's like to be poor, or African-American, or gay, or disabled, or old. And that's the criteria by which I'm going to be selecting my judges."

a. Do you agree with President Obama's quote?

Response: The quote by President Obama appears to pertain to criteria for the selection of judges. I have neither directly nor indirectly participated in selecting, nominating, or appointing judges on the state or federal level. In terms of judicial decision-making, I believe a district judge must apply the law as reflected in the Constitution, legislative enactments, and legal precedent to the facts of a specific case and not be swayed by feelings of empathy toward one party or the other.

b. Do you believe that you fit President Obama's standard as described in his quote?

Response: I feel that I am a person with a sense of empathy for others who nonetheless will be prepared to apply the law and render judicial decisions in a fair and neutral fashion, as my record as a United States Magistrate Judge since 2001 reflects.

c. What role do you believe that empathy should play in a judge's consideration of a case?

Response: I believe that a district judge's duty is to follow the law as set forth in the Constitution, congressional statutes, and case precedent and not to substitute personal feelings in reaching a judicial decision. At the same time, I think it is important for a judge in conducting legal proceedings not to check his or her humanity at the courthouse door. The courtroom can be an intimidating place for individuals not accustomed to those surroundings, be they jurors, *pro se* litigants, crime victims, and others. I think the district judge must display empathy and understanding in his or her interactions with such individuals, while at the same time setting that approach aside in the process of making a judicial decision.

d. Do you think that it is ever proper for judges to indulge their own subjective sense of empathy in determining what the law means?

Response: No.

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i. If so, under what circumstances?

Response: Not applicable.

ii. Please identify any cases in which you have done so.

Response: Not applicable.

iii. If not, please discuss an example of a case where you have had to set aside your own subjective sense of empathy and rule based solely on the law.

Response: In a case I decided in 2006 a young woman walking in Pacific Grove, California, suffered a horrific random attack at the hands of two off-duty soldiers who were subsequently convicted of attempted murder. The young woman sued the United States for negligence in connection with the supervision by the Marine Corps of the two perpetrators of the attack. While I had great empathy for the innocent victim, I felt compelled to grant summary judgment in favor of the United States as I concluded that the law and case precedent did not, in this instance, support imposing liability on the government under the Federal Tort Claims Act.

2. What in your view is the role of a judge?

Response: In my view, the role of a judge is to resolve the disputes presented in a case by reference to the law as set forth in the Constitution, legislative enactments, and judicial precedent. The role of a district judge in particular is to apply the Constitution, the laws enacted by Congress, and precedent established by the Supreme Court and the applicable Court of Appeals to the facts at issue in each case.

a. Do you think it is ever proper for judges to indulge their own values in determining what the law means?

Response: No.

i. If so, under what circumstances?

Response: Not applicable.

ii. Please identify any cases in which you have done so.

Response: Not applicable.

iii. If not, please discuss an example of a case where you have had to set aside your own values and rule based solely on the law.

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Response: The case I described in I (d) (iii) above presented a situation in which an innocent crime victim was foreclosed from monetary recovery. The perpetrators were judgment-proof and no applicable legal basis supported a monetary award against any other party. While I believe that victims of crime should be able to recover for the injuries they incur, I was obligated as a judge to set that general value aside where no law or case precedent supported a finding against the party named as a defendant in the civil lawsuit.

b. Do you think it is ever proper for judges to indulge their own policy preferences in determining what the law means?

Response: No.

i. If so, under what circumstances?

Response: Not applicable.

ii. Please identify any cases in which you have done so.

Response: Not applicable.

iii. If not, please discuss an example of a case where you have had to set aside your own policy preferences and rule based solely on the law.

Response: While no such specific case comes to mind, as a general matter I would deem it my obligation to base any ruling on the law regardless of any personal policy views I might hold. I believe that my record as a Magistrate Judge since 2001 reflects that I have not substituted any personal policy preferences in place of a decision based on the law as applied to the facts of the case presented.

3. How would you define "judicial activism?"

Response: The term "judicial activism" is not one I use, as I have heard many different definitions ascribed to it by different individuals. However, if called upon to select a definition, I would offer: judicial activism occurs when a judge goes beyond the application of the law to the facts of a case, and instead makes judicial determinations based on a personal view of what the law should be.

4. Some people refer to the Constitution as a "living" document that is constantly evolving as society interprets it. Do you agree with this perspective of constitutional interpretation?

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Response: I believe that the Constitution sets forth immutable principles that do not and should not change with the times. In applying those principles to the facts of a particular case, a court may confront a factual scenario not directly contemplated by the Framers as a result of developments over time. In those instances, I believe a judge needs to look to the language of the Constitution and case precedent in the process of adjudicating a constitutional claim.

5. Supreme Court precedents are binding on all lower federal courts and Circuit Court precedents are binding on the district courts within the particular circuit.

a. Are you committed to following the precedents of higher courts faithfully and giving them full force and effect, even if you personally disagree with such precedents?

Response: Yes.

b. How would you rule if you believed the Supreme Court or the Court of Appeals had seriously erred in rendering a decision? Would you nevertheless apply that decision of your own best judgment of the merits?

Response: If confirmed as a district judge, I would follow precedent set forth by the Supreme Court and the applicable Circuit Court of Appeals regardless of whether or not I personally felt such precedent was correctly decided.

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SUBMISSIONS FOR THE RECORD

COALITION OF NORTHERN CALIFORNIA ASIAN AMERICAN BAR ASSOCIATIONS

Asian American Bar Association of the Greater Bay Area

Asian Pacific Bar Association of Silicon Valley

fbanc
Filipino Bar Association of Northern California

Korean American Bar Association of Northern California

South Asian Bar Association of Northern California

Vietnamese American Bar Association of Northern California

September 11, 2009

Via First Class Mail and Facsimile

The Honorable Patrick J. Leahy, Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510
Fax: (202) 224-9516

The Honorable Jeff Sessions, Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510
Fax: (202) 224-9102

Re: Nomination of Magistrate Judge Edward M. Chen
United States District Court, Northern District of California

Dear Chairman Leahy and Ranking Member Sessions:

On behalf of the various Asian American bar associations in the San Francisco Bay Area, we write in support of Magistrate Judge Edward M. Chen's nomination and confirmation to the United States District Court for the Northern District of California. As a result of Judge Chen's unique experience as a federal magistrate judge, his previous career as a distinguished practitioner, and his service to the community, our collective bar

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associations urge the United States Senate to confirm Judge Chen for an Article III judgeship.

The Senate Judiciary Committee no doubt possesses Judge's Chen's application and supporting materials, so we will not repeat his exemplary qualifications. It should suffice to say that as a practitioner, Judge Chen was an attorney of the highest caliber. Judge Chen's effectiveness as an advocate in a wide range of commercial and constitutional cases equip him with the knowledge and experience necessary to serve as a district judge. His two decades of civil litigation practice prior to assuming the bench in 2001 were marked by significant achievements, as demonstrated by his role as counsel of record in dozens of reported cases. Judge Chen's experience as a practitioner has also played an important role in our nation's history. He was co-counsel to Fred Korematsu in Mr. Korematsu's successful coram nobis petition to overturn his 1942 conviction for violating the World War II order relocating Japanese Americans to internment camps. The Court's granting of the petition and vacating of Mr. Korematsu's conviction in 1984, over a quarter of a century ago, serves as one of the landmark civil rights decisions in American jurisprudence.

Judge Chen's current service as a magistrate judge for almost eight years has further provided him with invaluable experience to assume the duties of an Article III judge. By overseeing a large consent docket, producing a remarkable number of written opinions, and fulfilling other duties of a magistrate judge including presiding over discovery and other pretrial matters, and numerous settlement conferences), he has made a successful transition from a zealous advocate to a balanced and conscientious adjudicator who is committed to the impartial and active administration of justice. Judge Chen has earned a reputation as an evenhanded jurist who is constantly mindful of the role that judges fulfill in our society. Notably, Judge Chen's involvement in community activities that involve the education of lay people on legal matters and the accessibility of the courts (such as his work at the Court pertaining to pro se litigants) reflects his understanding of and regard for the relationship between the law and ordinary citizens, and the effect of the rule of law in society. As a reflection of the high regard that the San Francisco Bay Area legal community holds for Judge Chen, the San Francisco Barristers' Club awarded him the "Judge of the Year Award" in 2007.

Judge Chen's commitment to the Asian American community, particularly the Asian American legal community, further strengthens his qualifications. For many years, Judge Chen has participated on numerous panels, workshops, and conferences. In 1998, the Asian American Bar Association of the Greater Bay Area awarded him the Joe Morozumi Exceptional Legal Advocacy Award. In 2001, he also received the Trailblazer Award from the National Asian Pacific American Bar Association. Judge Chen has taught elementary school pupils, lectured law school students, and mentored young attorneys. His commitment to community is unparalleled. Members of all minority bar associations in the San Francisco Bay Area are fortunate that Judge Chen has continued to stay involved throughout the years in order to further educate and encourage us all.

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We are mindful and concerned that the Northern District of California – an area that has one of the highest concentrations of Asian Americans in the United States – has never had, in its more than 150-year history, an Asian American Article III judge. With Judge Chen's nomination to the District Court, this country has a wonderful opportunity to make history. We have no doubt that Judge Chen would continue to be an outstanding judicial officer if he is confirmed. We support and endorse his application without reservation, and respectfully urge his confirmation.

Thank you for your consideration. If we can provide further information, please reach any of us at the phone numbers listed below.

Very truly yours,

Garner Weng
President, Asian American Bar Association of the Greater Bay Area
(415) 995-5081

Anna Suh
President, Korean American Bar Association of Northern California
(415) 975-3707

Reuben Chen
President, Asian Pacific Bar Association of Silicon Valley
(650) 843-5480

Kiran Jain
President, South Asian Bar Association of Northern California
(510) 238-3837

Rhean Fajardo
President, Filipino Bar Association of Northern California
(650) 991-8122

Cindy Mader
President, Vietnamese American Bar Association of Northern California
(415) 292-7067

cc: Senator Dianne Feinstein
Gregory B. Craig, White House Counsel
Catie Whitney

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ASIAN AMERICAN JUSTICE CENTER

ADVANCING EQUALITY

September 9, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510

Re: Federal Judicial Nominations of Jacqueline H. Nguyen (C.D. Cal.), Dolly M. Gee (C.D. Cal.), and Edward M. Chen (N.D. Cal.).

Dear Chairman Leahy and Ranking Member Sessions:

The Asian American Justice Center (AAJC) is dedicated to the advancement of human and civil rights for Asian Americans through advocacy, public policy, public education, and litigation. AAJC is a national leader on issues of particular importance to the Asian American community including: affirmative action, anti-Asian violence prevention and race relations, census, immigrant rights, immigration, language access, and voting rights. AAJC was founded in 1991 by regional legal defense fund organizations rooted in local communities. AAJC carries out its mission by operating closely with its three affiliates: the Asian Pacific American Legal Consortium (APALC) in Los Angeles, the Asian Law Caucus (ALC) in San Francisco and the Asian American Institute (AAI) in Chicago. In total, AAJC has a network of nearly 100 community-based organizations in 25 states and the District of Columbia. AAJC recognizes a critical need for greater participation by Asian Americans in the federal courts. Of the approximately 875 federal Article III judges, only eight are Asian Americans. This woeful underrepresentation of Asian Americans in the federal judicial system deprives our courts of unique perspectives that are essential to resolving the complex issues before our courts today.

AAJC urges the timely confirmation of Judge Jacqueline H. Nguyen for the United States District Court for the Central District of California, Ms. Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California. Each nominee is superbly qualified and would faithfully and skillfully serve on the United States District Court. Further, the confirmation of these nominees will prominently signal to the Asian American community that our federal judicial system is moving toward greater inclusion and increased access for all seeking justice. For decades, Judge Nguyen, Ms. Gee, and Judge Chen have been

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well-respected leaders in the Asian American community and their confirmation will ensure a vital, yet underrepresented, perspective is fostered in our federal judicial system.

Judge Jacqueline H. Nguyen serves as a judge with the Los Angeles County Superior Court. She was appointed in August 2002 and is the first Vietnamese American woman to serve as a judge in California. Judge Nguyen's confirmation would promote the first Vietnamese American to an Article III judgeship in our country's history. Judge Nguyen has a strong background in criminal law that will serve her well on the bench. Prior to her appointment to the Superior Court, Judge Nguyen served as an Assistant United States Attorney with the Criminal Division of the United States Attorney's Office where she was the Deputy Chief of the General Crimes Section. She also served on the Organized Crimes Strike Force, and the Public Corruption and Government Fraud Section while at the United States Attorney's Office. Judge Nguyen is active in the community and has been recognized repeatedly for her many achievements.

Judge Nguyen rose from humble beginnings as part of an immigrant family. As a child, she came to America amidst the fall of South Vietnam on a chaotic journey riddled with uncertainty and filled with fear. Once here, she grew up helping her mother clean dental offices and later that work ethic translated into a full tuition scholarship to Occidental College and later admission to UCLA School of Law. These events that formed Judge Nguyen's experiences, achievements, and character are unique to Vietnamese Americans and at the same time it is a story shared by countless American families. Her experience and character give us full confidence that she will make an excellent jurist on the United States District Court for the Central District of California. We give Judge Nguyen our highest endorsement.

Ms. Dolly M. Gee is a partner with the law firm of Schwartz, Steinsapir, Dohrmann & Sommers LLP. Ms. Gee has long recognized the importance serving her community and this is evidenced by the numerous awards she has received for her leadership. For example, in the early 1990s following the racial strife and violence in Los Angeles that riveted the nation, Ms. Gee's pro bono activities promoted racial tolerance and aided those harmed by violence. Ms. Gee's private practice specializes in labor and employment law and she has extensive experience in federal and state court litigation. Ms. Gee also has deep experience as a neutral mediator and arbitrator. She worked on the Federal Service Impasse Panel where she mediated and arbitrated impasses between federal agencies and federal sector labor unions. She has also worked as a court-appointed independent election monitor for delegate elections of 27 International Brotherhood of Teamsters local unions in California, Nevada, and Hawaii. In this position, Ms. Gee investigated and recommended dispositions of election protests relating to alleged violations of election rules.

Ms. Gee's legal career was inspired by her family. Her father came to the United States from a small farming village in Toisan, China. He later served in the U.S. Navy during World War II and then worked for our nation's burgeoning young aerospace industry to support the Apollo space missions. Ms. Gee's interest in labor and employment law flows from watching her mother working as a garment worker. Ms. Gee's commitment to professional excellence and service has been clear throughout her career. Ms. Gee's abilities and her character make her worthy of our highest endorsement.

Judge Edward M. Chen is a well-respected federal magistrate judge in the Bay Area and has served in that position for over eight years. In this capacity he has presided over numerous criminal and civil cases, including bench and jury trials. Judge Chen's experience as a magistrate judge gives him a special familiarity with the tasks and challenges facing federal district court judges. Even though approximately 35% of the San Francisco/Bay Area population is Asian American and Pacific Islander, there has never been an Asian American Article III judge in the area. He would be the first. Judge Chen's confirmation would elevate a qualified, respected jurist within the very community that he has long served to great acclaim. Prior to becoming a magistrate judge, Judge Chen served as: a staff attorney for the American Civil Liberties Union; a litigation associate at Coblentz Patch Duffy & Bass; a law clerk to the Honorable James R.

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Browning, Chief Judge of the United States Court of Appeals for the Ninth Circuit; and a law clerk to the Honorable Charles B. Renfrew, United States District Court, Northern District of California. Judge Chen is an active leader in his community. Of particular note, Judge Chen participated in the legal team that successfully overturned – in a *coram nobis* case – Fred Korematsu's World War II conviction for failing to comply with the Japanese internment order. Judge Chen has garnered numerous awards that reflect the legal community's high regard for his careful work as a jurist.

Judge Chen's professional success is extraordinary when considering the adversity he faced in his childhood. His father emigrated from China in the 1920s as a merchant and his mother immigrated to Texas in the late 1930s. When Judge Chen was 9 years old, his father suffered a stroke and remained in a coma before passing away three and a half years later. His family continued the import business his father started and he maintained that business early in his legal career. Judge Chen continues to deal with personal challenges as the parent of two children, one with developmental disabilities and the other with learning disabilities. Through it all, Judge Chen has maintained an impeccable professional reputation with an outward focus on helping others who seek justice. We give Judge Chen our highest endorsement.

After reviewing their accomplishments and record it is with tremendous confidence and pleasure that we endorse Judge Jacqueline H. Nguyen, Ms. Dolly M. Gee, and Judge Edward M. Chen for confirmation as federal district court judges. Their continued pursuit of justice and professional excellence is remarkable. These individuals will enrich our judicial system with their expertise and unique perspectives. Although Asian Americans would remain underrepresented on the federal bench, the confirmation of these three individuals is a move in the right direction for our justice system. Accordingly, the Asian American Justice Center endorses and urges the confirmations of Judge Jacqueline H. Nguyen and Ms. Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California.

Sincerely,

Karen K. Narasaki

President and Executive Director

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ASIAN/PACIFIC BAR OF CALIFORNIA

Office of the President
EDWIN K. PRATHER
Clarence & Dyer LLP
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Fax: 415-749-1694
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September 15, 2009

Via First Class Mail and Facsimile

The Honorable Patrick J. Leahy, Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510
Fax: (202) 224-9516

The Honorable Jeff Sessions, Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510
Fax: (202) 224-9102

Re: Nominations of Magistrate Judge Edward M. Chen, United States District Court, Northern District of California; Judge Jacqueline Nguyen and Dolly Gee, Esq., United States District Court, Central District of California

Dear Chairman Leahy and Ranking Member Sessions:

On behalf of the Asian/Pacific Bar of California (ABC), I write to offer our strongest support for the Honorable Edward M. Chen, the Honorable Jacqueline Nguyen, and Dolly Gee, Esq. – all of whom have been nominated by President Obama to serve on the United States District Courts for the Northern and Central Districts of California.

ABC is the umbrella group for Asian American bar associations in the State of California, as well as the collective voice for the Asian American legal community in the state. ABC is dedicated to the promotion and appointment of qualified Asian Americans to the bench. Through its statewide network of lawyers, ABC is a prominent and powerful advocate for increasing the diversity of state and federal judicial officers.

According to the United States Bureau of the Census, Asian Americans currently make up over 15% of California's population. The Asian American community in California is growing rapidly and, within a few years, Asian Americans will likely comprise over one-fifth of the state's population. Given California's already significant Asian American population, the

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need for more Asian American federal judges is quite compelling. In California's four federal districts, only 5 of 79 sitting judges – less than 6% – are Asian American; one in the Southern District of California, three in the Central District of California, and one in the Eastern District of California. There is not now, nor has there ever been, an Asian American District Court Judge in the Northern District of California in its more than 150-year history. This absence is shocking given that the San Francisco Bay Area's population has the highest percentage of Asian Americans in the state.

If confirmed, Judge Nguyen, Ms. Gee, and Judge Chen would break important new ground in the federal judiciary. Judge Nguyen would become the first Vietnamese American district court judge in the nation. Similarly, Ms. Gee would be the first Chinese American female district court judge in the United States. Both Judge Nguyen and Ms. Gee would be the first Asian American women to serve as district court judges in the state of California. Judge Chen would become the first Asian American district court judge in the Northern District of California.

While diversifying the federal bench is an important issue, it is essential that all judicial appointees be of the highest caliber. Judge Chen, Judge Nguyen, and Ms. Gee all meet the highest standards expected of the federal judiciary. Although they have taken different paths to this point – one a former prosecutor, one from private practice, and one a former public interest lawyer – they have each made substantial contributions to our local community and have made a difference in the lives of many on statewide and national levels. Collectively, based on their qualifications and background, these candidates will bring to the bench an intellectual engagement with the law and a practical approach to addressing the needs of a changing society.

Magistrate Judge Edward M. Chen

Judge Chen has proven himself at every step of his career – as an advocate, a judge, and a community servant. For the past eight years, Judge Chen has served with distinction as a federal magistrate judge handling both civil and criminal matters in the Northern District of California. He is well respected by lawyers, both defense attorneys and prosecutors alike, for his even-handedness, fairness, and commitment to achieving justice. As a magistrate judge, he has written over 300 published decisions and orders covering a wide range of legal issues, and has presided over 20 civil and criminal jury and bench trials. Judge Chen also succeeded in his career before assuming the bench, including his time at a private law firm, the American Civil Liberties Union, and serving as the judicial law clerk to both the Honorable James R. Browning of the United States Court of Appeals for the Ninth Circuit, and for the Honorable Charles B. Renfrew of the United States District Court for the Northern District of California.

Judge Chen has demonstrated a strong devotion to community service throughout his career. Judge Chen was co-counsel to Fred Korematsu in Mr. Korematsu's successful *coram nobis* petition to overturn his 1942 conviction for violating a presidential order sending Japanese Americans to internment camps during World War II. Judge Chen's achievements for the public interest are numerous and his service has been recognized by many organizations, including the

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National Asian Pacific American Bar Association, the Minority Bar Coalition of Northern California, the United States Attorney's Office for the Northern District of California, and the United States Department of Justice, among many others. Among these numerous awards, Judge Chen was voted "Judge of the Year" by the Barristers Club of San Francisco in 2007.

Judge Chen, unanimously rated "well qualified" by the American Bar Association, is deserving of our strongest endorsement.

Judge Jacqueline Nguyen

Judge Nguyen has served with distinction as a Los Angeles County Superior Court Judge since 2002. Upon her appointment, she was the first Vietnamese American woman to serve on the California bench. She currently hears both misdemeanor and felony cases and also manages the operations of the Alhambra, California courthouse in which she presides, allowing her to work closely with court stakeholders, law enforcement, prosecutors, and the defense bar. Prior to her appointment to the Superior Court, Judge Nguyen served as a federal prosecutor in the U.S. Attorney's Office, ending her career there as the deputy chief of the General Crimes Section. Judge Nguyen also spent several years at a civil law firm.

Judge Nguyen has always been committed to her community, having served in leadership roles in the Asian Pacific American Bar Association of Los Angeles, among others. She has received several awards, including the Trailblazer Award from the National Asian Pacific American Bar Association, a recognition award from the Asian Pacific American Legal Center, and awards from the United States Department of Justice, United States Department of State, and the Federal Bureau of Investigation.

Judge Nguyen, also unanimously rated "well qualified" by the American Bar Association, is deserving of our strongest endorsement.

Dolly Gee, Esq.

Ms. Gee is a partner at Schwartz, Steinsapir, Dohrmann & Sommers LLP in Los Angeles, where she has practiced throughout her 23-year legal career. She specializes in labor and employment law and also serves as an arbitrator on Kaiser Permanente's Independent Arbitration System. Ms. Gee previously served on the Federal Service Impasses Panel (by Presidential appointment) and as a court-appointed independent election monitor. She has lectured at UCLA School of Law and served as the judicial law clerk to the Honorable Milton L. Schwartz of the United States District Court for the Eastern District of California.

Ms. Gee has been steadfastly dedicated to public service, having served on the boards of many legal nonprofits, including the Asian Pacific American Legal Center, the Western Center on Law and Poverty, the Asian Pacific American Bar Association of Los Angeles County, and the California Women's Law Center. Ms. Gee has received several awards for her legal and pro

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bono work, including awards from the State Bar of California, the City of Los Angeles, the Los Angeles Human Relations Commission, and the National Asian Pacific American Bar Association, among many others. Through her various activities, Ms. Gee has always fought to promote equal access to justice.

Judge Gee, unanimously rated "qualified" by the American Bar Association, is deserving of our strongest endorsement.

Judge Chen, Judge Nguyen, and Ms. Gee are qualified, deserving, and necessary additions to the bench. They are extraordinary people whose combination of legal acumen, character, and experience will allow them to become valuable members of the federal judiciary. We urge their speedy confirmation.

Very truly yours,

Edwin K. Prather

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Superior Court of California
County of San Francisco

Judges:
Bruce E. Chan
Andrew Cheng
Samuel Feng

Judges:
Newton J. Lam
Cynthia M. Lee
Ronald E. Quidachay

Judges:
Lillian K. Sing
Julie Tang
Garrett L. Wong

September 17, 2009

Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, D.C. 20510
FAX (202) 224-9516

Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, D.C. 20510
FAX (202) 224-9102

Dear Chairman Leahy and Ranking Member Sessions:

We are writing this letter as Asian American judges of the San Francisco Superior Court unanimously urging your support of Magistrate Judge Edward M. Chen's confirmation to the United States District Court for the Northern District of California. We are judges from diverse practice backgrounds – some of us were prior prosecutors who worked in the public sector and others were prior defense lawyers who worked in the private sectors. We were appointed as judges in a bipartisan nature by both Republican and Democratic Governors.

Collectively we have known Judge Chen for over thirty years, stretching back from high school and college, through his career as a commercial and public interest lawyer, to his current position as Magistrate Judge. Professionally he has devoted his entire career to furthering the public interest and equal access to justice. As a lawyer he has represented the disadvantaged in protecting their rights, particularly in matters that affect Asian Americans and other immigrant and under-represented groups.

As a Magistrate Judge, he has earned a solid reputation, as he has exhibited exemplary judicial skills, issued balanced and thoughtful rulings, and demonstrated an excellent judicial temperament. The Bar Association of San Francisco"s Barristers Club has awarded him "Judge of the Year" in 2007. The Asian American Bar Association of the Greater Bay Area and National Asian Pacific American Bar Association have also awarded Judge Chen for his accomplishments and commitment to our community.

As Asian Pacific American Judges of the Superior Court, we understand the importance of a diverse judiciary inclusive of all segments of our society. This, of course, includes the Asian Pacific American community which has never been represented on the District Court in the San Francisco Bay Area, home of one of the largest Asian American communities in the nation. We are familiar with the members of the bar and bench. We also understand the unique value of prior judicial experience in preparing a nominee for such an important position on the federal bench. While we believe there are many qualified Asian Americans eligible for appointment to the federal bench, we can think of no person more qualified and experienced, more universally known and respected, or more deserving than Judge Chen. We strongly support his nomination, and urge you to vote in favor of his nomination.

Sincerely yours,

Bruce E. Chan | Andrew Cheng | Samuel Feng

Newton J. Lam | Cynthia M. Lee | Ronald E. Quidachay

Lillian K. Sing | Julie Tang | Garrett L. Wong

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Boat People SOS, Inc.
Ủy Ban Cứu Người Vượt Biển
10038
"Meeting Urgent Needs Today, Empowering Communities for Tomorrow"

September 10, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510

Re: Federal Judicial Nominations of Jacqueline H. Nguyen (C.D. Cal.), Edward M. Chen (N.D. Cal.), and Dolly M. Gee (C.D. Cal.)

Dear Chairman Leahy and Ranking Member Sessions:

Boat People SOS (BPSOS) is a national immigrant services organization serving the Vietnamese American and Immigrant community. BPSOS was founded in 1980 by Vietnamese Asylees and Refugees to assist the Vietnamese boatlifts of refugees fleeing persecution in communist Vietnam. From 1980 through 1996, BPSOS assisted in the resettlement of over 20,000 refugees. Currently, BPSOS focuses on providing essential integration services for self sufficiency including ESL, Citizenship, Financial Literacy, Health Awareness and Family Based Immigration Services. Additionally, BPSOS provides disaster assistance in the Gulf Coast in the aftermaths of Hurricanes Katrina, Rita, Gustav and Ike and case management and assistance for victims of domestic violence and human trafficking.

BPSOS endorses the nominations of Judge Jacqueline H. Nguyen for the United States District Court for the Central District of California, Ms. Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California. Each nominee is expertly qualified for this position. Further, the confirmation of these nominees will provide needed diversity in the federal judicial system which will increase the accessibility for all seeking justice. For decades, Judge Nguyen, Ms. Gee, and Judge Chen are well-respected leaders in the Asian American community and their confirmation will ensure a vital, yet underrepresented, perspective is fostered in our federal judicial system.

Judge Jacqueline H. Nguyen serves as a judge with the Los Angeles County Superior Court. She was appointed in August 2002 and is the first Vietnamese American woman to serve as a judge in

6066 Leesburg Pike, Suite 100 * Falls Church, VA 22041 * Tel (703) 538-2190 * www.bpsos.org

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California. If confirmed, Judge Nguyen would become the first Vietnamese American Article III judge in the history of the United States. Judge Nguyen has a strong background in criminal law. Prior to her appointment to the Superior Court, Judge Nguyen served as an Assistant United States Attorney with the Criminal Division of the United States Attorney's Office where she was the Deputy Chief of the General Crimes Section. She also served on the Organized Crimes Strike Force, and the Public Corruption and Government Fraud Section while at the United States Attorney's Office. Judge Nguyen is active in the community and has been recognized repeatedly for her many achievements.

Judge Nguyen rose from humble beginnings as part of an immigrant family. As a child, she came to America amidst the fall of South Vietnam on a chaotic journey riddled with uncertainty and punctuated by terrifying moments. She grew up helping her mother clean dental offices and later that work ethic translated into a full tuition scholarship to Occidental College and then admission to UCLA School of Law. These early events that shaped Judge Nguyen's experiences, achievements, and character are unique to Vietnamese Americans and at the same time it is a story shared by countless American families. Her experience and character give us full confidence that she will make an excellent jurist on the United States District Court for the Central District of California. We give Judge Nguyen our highest endorsement.

Ms. Dolly M. Gee is a partner with the law firm of Schwartz, Steinsapir, Dohrmann & Sommers LLP. She specializes in labor and employment law and has extensive experience in federal and state court litigation. Ms. Gee also has substantial experience as a neutral mediator and arbitrator. She served on the Federal Service Impasse Panel where she mediated and arbitrated impasses between federal agencies and federal sector labor unions. She has also served as a court-appointed independent election monitor for delegate elections of 27 International Brotherhood of Teamsters local unions in California, Nevada, and Hawaii. In this position, Ms. Gee investigated and recommended dispositions of election protests relating to alleged violations of election rules. Ms. Gee has long recognized the importance serving her community and this is evidenced by the numerous awards she has received for her leadership. For example, in the early 1990s following the racial strife and violence in Los Angeles, Ms. Gee's pro bono activities promoted racial tolerance and aided those harmed by violence.

Ms. Gee's legal career was inspired by her family. Her father came to the United States from a small farming village in Toisan, China. He later served in the U.S. Navy during World War II and then worked for North American Aviation and Rockwell International to support the Apollo space missions. Ms. Gee's interest in labor and employment law grew from watching her mother working as a garment worker. Ms. Gee's commitment to professional excellence and service has been clear throughout her career. Ms. Gee's abilities and her character make her worthy of our highest endorsement.

Judge Edward M. Chen is a well-respected federal magistrate judge in the Bay Area and has served in that position for over eight years. In this capacity he has presided over numerous criminal and civil cases, and has authored over three hundred published opinions. Judge Chen's experience as a magistrate judge gives him a special familiarity with the tasks and challenges facing federal district court judges. Even though approximately 35% of the San Francisco/Bay Area population is Asian American and Pacific Islander, there has never been an Asian American Article III judge in the area. Given his judicial experience, Judge Chen is perfectly poised to make history in that manner. Prior to becoming a magistrate judge, Judge Chen served as: a staff attorney for the American Civil Liberties Union; a litigation associate at Coblentz Patch Duffy & Bass; a law clerk to the Honorable James R. Browning, Chief Judge of the United States Court of Appeals for the Ninth Circuit; and a law clerk to the Honorable Charles B. Renfrew, United States District Court, Northern District of California. Judge Chen is an active leader in his community. Of particular note, Judge Chen participated in the legal team that successfully overturned – in a *coram nobis* case – Fred Korematsu's World War II conviction for

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failing to comply with the Japanese internment order. Judge Chen has garnered numerous awards that reflect the legal community's high regard for his careful work as a jurist.

Judge Chen's professional success is exceptional when considering the adversity he faced in his childhood. His father emigrated from China in the 1920s as a merchant and his mother immigrated to Texas in the late 1930s. When Judge Chen was 9 years old, his father suffered a stroke and remained in a coma before passing away three and a half years later. His family continued the import business his father started and he maintained that business early in his legal career. Judge Chen continues to deal with family challenges as the parent of two children, one with developmental disabilities and the other with learning disabilities. Through it all, Judge Chen has maintained an impeccable professional reputation with a focus on helping others who seek justice. We give Judge Chen our highest endorsement.

After reviewing their accomplishments, qualifications, and character, it is with great pride and enthusiasm that BPSOS endorses Judge Jacqueline H. Nguyen, Ms. Dolly M. Gee, and Judge Edward M. Chen for confirmation as federal district court judges. Their leadership in pursuit of justice for the underserved and underprivileged is extraordinary. The confirmation of these individuals would be a historically important step toward addressing the systemic underrepresentation of Asian Americans in our judicial system. Accordingly, the Asian American Justice Center proudly endorses and urges the confirmations of Judge Jacqueline H. Nguyen and Ms. Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California.

Sincerely,

Dr. Thang Dinh Nguyen, Ph.D.
Executive Director

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LOS ANGELES POLICE DEPARTMENT

WILLIAM J. BRATTON
Chief of Police

ANTONIO R. VILLARAIGOSA
Mayor

P. O. Box 30158
Los Angeles, Calif. 90030
Telephone: (213) 485-3204
TDD: (877) 275-5273
Ref #: 1.14

September 15, 2009

Honorable Patrick Leahy
United States Senate
Chairman, Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510

Honorable Jeff Sessions
United States Senate
Ranking Member, Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, D.C. 20510

Dear Senator Leahy and Senator Sessions:

As the Chief of Police for the Los Angeles Police Department, I have come to appreciate the many citizens who contribute to the greater good of this great city. One such person is Dolly Gee. Others who have vetted Dolly can speak about the breadth and scope of her professional qualifications. Dolly is known as a bridge-builder who has worked both in her professional life and public service activities to foster racial harmony and understanding and to promote tolerance in Los Angeles, a diverse community which too often has been scarred by racial strife and violence.

For example, as President of the Southern California Chinese Lawyers' Association in 1992, Dolly actively represented her bar association's efforts to combat the rise of hate crimes and to assist people injured by the civil unrest after Los Angeles Police Officers were acquitted in the Rodney King beatings. She served as a liaison to the FBI Task Force that investigated the apparent hate crime against Thanh Lam, who was killed while driving home from work during the civil unrest on April 29, 1992.

Dolly was one of the founders of the Multi-Cultural Bar Alliance which seeks to bring diverse groups within the Los Angeles legal community together for common cause. She continues to this day to participate in the efforts of bar and community organizations to encourage volunteerism and public service. In recognition of her many pro bono activities, Dolly has

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received public service awards and commendations from the Mayor of the City of Los Angeles, the Los Angeles Human Relations Commission, the Office of the Los Angeles City Attorney, and the State Bar of California, to name just a few.

I respectfully urge you to confirm Dolly's nomination as a Federal District judge. If confirmed, Dolly would become the first female Chinese American Federal District judge in the nation, marking another milestone in the Asian American community. I believe that based on her performance and her reputation, she will she will exhibit the same evenness of temperament, respect for the law, and dedication to the pursuit of equal justice that have characterized her personal and professional life to date.

Thank you for your consideration.

All the best,

WILLIAM J. BRATTON
Chief of Police

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Office of the Clerk
UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT
James R. Browning United States Courthouse
95 Seventh Street
San Francisco, California 94103-1526

Cathy A. Catterson
Clerk of Court

(415) 355-8000

June 29, 2007

Dongxiao Yue
[redacted]

Re: Complaint of Judicial Misconduct No. 07-89078

Dear Mr. Yue:

We have received the complaint of judicial misconduct filed pursuant to 28 U.S.C. § 351(a) against Magistrate Judge Chen. Docket Number 07-89078 has been assigned to this matter.

Pursuant to the Rules of the Judicial Council of the Ninth Circuit Governing Complaints of Judicial Misconduct or Disability, a copy of the complaint has been forwarded to Chief Judge Schroeder, Chief Judge Walker, Chief Magistrate Judge Larson and Magistrate Judge Chen.

Very truly yours,

Cathy A. Catterson

CAC/gb

[redacted]

UNITED STATES COURTS

NINTH CIRCUIT COURT OF APPEALS

COMPLAINT OF JUDICIAL MISCONDUCT

AGAINST

MAGISTRATE JUDGE EDWARD M. CHEN

STATEMENT OF FACTS

[redacted]

INTRODUCTION

This complaint, brought under 28 U.S.C. §351(a), alleges that Magistrate Judge Hon. Edward M. Chen ("Magistrate Chen" or "Chen") demonstrated a pattern of bias and prejudice in handling a FRCP Rule 11 sanction motion filed in the case titled Netbula, LLC v. BindView Development Corp, et al (C06-0711-MJJ, Northern District of California).

BACKGROUND OF THE EVENTS LEADING TO THIS COMPLAINT

In January 2006, Complainant's firm, Netbula, LLC ("Netbula" or "Plaintiff"), filed a copyright infringement lawsuit against BindView Development Corp, et al. On May 15, 2006, the parties held an informal confidential settlement conference. Six people attended the meeting: Complainant ("Yue"), Plaintiff's former counsel Neil A Smith, three defense lawyers (including Mr. Jedediah Wakefield) and a representative of a defendant company. Prior to the meeting, each side requested many categories of documents from the other side. The Complainant brought to the meeting a folder of key documents requested by defendants, including documents evidencing license and pricing of the copyrighted work. Defendants also brought some but not all the requested documents[1].

In July 2006, Mr. Richard Antognini, who had no personal knowledge of the May 15, 2006 meeting, substituted Neil Smith as Plaintiff's counsel. On September 29, 2006, the parties filed a Joint Case Management Statement ("JCMS") (Docket No. 40). In the Section titled "*Description of Events Submitted by Defendants*", defendants wrote:

> On May 15, 2006, BindView, Symantec (through their current outside counsel) and Netbula (through its former counsel) met to discuss a possible settlement of this matter... **Symantec and BindView provided the materials requested of them... Netbula, on the other hand, did not provide *any* of the materials requested of them.**
>
> (JCMS, p.4:22-27, emphasis added)

In subsequent court filings, defense counsel repeated similar allegations. On November 7, 2006, Complainant filed a declaration to refute Defendants' accusations (Don Yue Decl, Docket No. 57). Despite Yue's effort to clarify the events surrounding the May 15, 2006 meeting, defendants persisted with their allegation that Plaintiff produced no requested documents for the May 15 meeting in discovery motions they later filed.

[1] Out of the nine categories of documents requested by Plaintiff, Defendants brought documents for four categories.

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On March 14, 2007, Plaintiff served defense counsel a Rule 11 motion, alleging five violations. One was about Defendants' allegation about the May 15, 2006 meeting in the JCMS. Another was about an affirmative defense in Defendants' Second Amended Answer filed in December 2006.

On April 6, 2007, after defense counsel refused to withdraw or correct the papers, Plaintiff filed the Rule 11 motion (Docket No. 103). On April 24, 2007, the Rule 11 Motion was referred to Magistrate Chen. On June 6, 2007, a hearing was held before him. On June 11, 2006, Chen denied Plaintiff's Rule 11 motion for being untimely. Docket No. 193. In the same order, Chen awarded defense counsel $20,000 in attorney's fees.

JUDICIAL MISCONDUCT FACTS

A. Events at the Rule 11 Motion hearing on June 6, 2007

At the very beginning of the Rule 11 Motion hearing, Magistrate Chen indicated that he was inclined to deny the Rule 11 Motion for failing to meet the safe-harbor provision of the Rule 11, despite the fact the Rule 11 motion was filed twenty-three (23) days after it was served. Chen then went onto how much attorney's fees should be awarded to defense counsel. After the argument about fees was heard, Chen refused to hear about the merits and took the matter under submission.

B. Magistrate Chen's misconduct

In reaching his decision of denying Plaintiff's Rule 11 motion and awarding Defense counsel $20,000 in fees, Magistrate Chen performed a set of mischaracterizations and distortions of the record.

1. Mischaracterization on the *Price v. Hawaii* case

In their Opposition to the Rule 11 Motion, Defendants cited *Price v. Hawaii*, 789 F. Supp 330, 335-336 (D. Haw. 1992) to support their argument that the Rule 11 Motion was untimely. In its Reply brief, Plaintiff pointed out that *Price* was not comparable because there the Rule 11 motion was filed two years after dismissal of the case. Plaintiff cited *another case* in which an attorney was sanctioned more than one year after the frivolous contentions were filed.

Defendants relied on *Price*. Judging from his ruling, Chen adopted Defendants' theory wholesale.

Remarkably, Chen wrote in his ruling:

> **Netbula's reliance on *Price v. Hawaii*, 789 F. Supp. 330 (D. Haw. 1992), is not well placed.** There, the court did note that "'in the case of pleadings the sanctions issue under Rule 11 normally will be

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> determined at the end of the litigation"; ...**The instant case involves contentions made in motions, and not pleadings.**
>
> *Chen's June 11, 2007 Ruling*, Docket 193, pp.2:26-3:4

2. False characterization of Plaintiff's Rule 11 Motion

One of the alleged Rule 11 violations was in defendants' affirmative defenses in their Second Amended Answer (filed in December 2006). Affirmative defenses are pleadings.

Chen's assertion that the contentions did not involve pleadings is thus patently false.

3. Mischaracterization of the record regarding the May 15, 2006 meeting

In the JCMS, Defendants alleged that "Symantec and BindView provided the materials requested of them... Netbula, on the other hand, did not provide ***any*** of the materials requested of them." Defendants' message was simple: Defendants good, Plaintiff bad.

Chen wrote:

> "In any event, Defendants' statement was not misleading. Netbula had not produced all the documents requested."
>
> *Chen's June 11, 2007 Ruling*, Docket 193, p.4:15-16.

Chen obtained the conclusion that "*Defendants' statement was not misleading*" by mischaracterizing the record. If Chen quoted the original language defendants wrote ("Netbula...did not provide ***any*** of the materials requested of them."), the misleading and prejudicial nature of defendants' statement would be undeniable.

Had Defendants stated that "Netbula had not produced all the documents requested" as Magistrate Chen suggested, it would have implied that Netbula brought some documents requested, and there would have been no dispute at all.

Chen twisted the records to put defendants in a favorite light.

4. Chen's decision on fee award was driven by bias

Magistrate Chen then went on to fees:

> The question is what are reasonable fees in this instance... the fee award should not be nominal. Although the Rule 11 motion was clearly untimely, Defendants reasonably addressed the merits of the motion as well as the procedural defenses because there was no guarantee that the Court would deny the motion on a procedural basis. Moreover, even if there were a strong likelihood that the Court would deny the motion,

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> defense counsel's credibility had been attacked, and they were entitled to defend against the charge that they had acted frivolously, a grave charge.
>
> *Magistrate Chen's June 11, 2007 Ruling*, pp.5:23-6:23

From the quotes above, Chen predicated his fee calculation on the "credibility" of the defense counsel[2] or Plaintiff's "attack" on it – without first determining whether Plaintiff's attack was legitimate. Chen sought to use fee awards as a punitive or retaliatory measure against Plaintiff for its "grave charge" that defense counsel "had acted frivolously." Chen ignores "the plain language of the rule": "when one party files a motion for sanctions, the court must determine whether any provisions of subdivision (b) have been violated." *Warren v. Guelker*, 29 F.3d 1386 (9th Cir. 1994). Chen simply sides with a big law firm and lashes back against an easy target – a solo practitioner who had been frustrated by defendants' conduct and tried to seek court's enforcement of the Rule.

5. Chen's fee award is arbitrary and encourages frivolous filings

The Magistrate continued on his fee award discussion as follows

> In addition, contrary to Netbula's assertion, the factual investigation needed to respond to the Rule 11 motion on the merits was not a task that could quickly be accomplished. For example, a **fair amount of time was reasonably expended to look into the history of events surrounding the May 15, 2006, settlement meeting.**
>
> Given the circumstances, having reviewed the opposition brief and affidavit, the Court concludes that an award of $20,000 is reasonable.
>
> *Chen's June 11, 2007 Ruling*, pp.5:23-6:23, emphasis added.

Defense counsel had a duty to perform a competent inquiry before they file papers about the confidential May 15, 2006 meeting[3]. With the Rule 11 motion, Plaintiff forced defense counsel to change their position and admit for the first time that Complainant did bring documents to the meeting. Yet, Chen ordered Plaintiff to pay Defense counsel a good amount of money for looking into the "*history of events surrounding the May 15, 2006, settlement meeting.*" (That meeting, which happened four months before the JCMS was filed, lasted about two hours).

---

[2] Defense counsel is from Fenwick & West LLP, a large law firm. Plaintiff's counsel is a solo practitioner who held a small office.

[3] Complainant contends that it was unethical for defendants to tell the court about that confidential settlement conference in the first place.

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6. Chen's total bias in his ruling

Due to the page limit, complainant is unable to list other evidence of bias and prejudice permeated in Chen's ruling. For instance, Plaintiff alleged three frivolous sub-allegations by defendants in their December 2006 Second Amended Answer. Chen ignored two of the plainly frivolous sub-allegations. Chen also ignored the fact that Plaintiff repeatedly alerted defendants to their frivolous allegation about the publication date of the copyrighted work. Chen then blamed Plaintiff for not trying to resolve the dispute between the parties before filing the Rule 11 motion with the court.

7. Chen's false pretense for the concern of "expenditure of judicial resources"

Chen claimed that he was concerned about "expenditure of judicial resources." In its briefs, Plaintiff argued that defendants could have avoided burdening the court with the Rule 11 Motion by candidly withdrawing or correcting their papers. Instead, defendants attempted to intimidate Plaintiff into giving up the Rule 11 motion. Therefore, Defendants should be held responsible for the consumption of judicial resources. Chen ignored this argument.

The central purpose of Rule 11 is to deter baseless filings. If Magistrate Chen had been really concerned about "judicial resources," he would have made a well-researched and legally sound ruling that would limit further dispute. Instead, he made a patently biased ruling that will lead to protracted proceedings.

CONCLUSION

The evidence above shows that Magistrate Judge Chen acted with bias, prejudice, arbitrariness, negligence and lack of concern for the rules of the court. Moreover, the legal errors Magistrate Chen made were so egregious that they are tantamount to judicial misconduct. Since the alleged conduct is prejudicial to the effective and expeditious administration of the business of the courts, Complainant asks the court to take appropriate disciplinary action.

Dated: June 19, 2007

By: 

Dongxiao Yue

Attachment: EXHIBITS

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JUDICIAL COUNCIL

FOR THE NINTH CIRCUIT

FILED
OCT 19 2007
CATHY A. CATTERSON, CLERK
U.S. COURT OF APPEALS

In re Charge of	No. 07-89078
Judicial Misconduct	ORDER AND MEMORANDUM

Before: SCHROEDER, Chief Judge

A complaint of misconduct has been filed against a magistrate judge of this circuit. Administrative consideration of such complaints is governed by the Rules of the Judicial Council of the Ninth Circuit Governing Complaints of Judicial Misconduct or Disability (Misconduct Rules), issued pursuant to the Judicial Councils Reform and Judicial Conduct and Disability Act of 1980. 28 U.S.C. §§ 351-364.

Complainant, whose business firm was a litigant, alleges that the judge demonstrated a pattern of bias and prejudice in denying complainant's firm's motion for sanctions and granting an opposing party's motion for attorney's fees. He alleges the judge mis-characterized and distorted the record, ignored allegations in the motion, made errors of law, and was driven to award fees by bias instead of the merits of the motion. He alleges the judge sided with a big law firm instead of the "easy target" solo practitioner representing complainant's firm.

Complainant's exhibits, including the parties' motions

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and the judge's order, were carefully reviewed.

Complaint's allegations that the judge mischaracterized the record, ignored allegations in the motion, and made errors of law, relate to the merits of the judge's ruling. A complaint will be dismissed if it is directly related to the merits of a judge's ruling or decision in the underlying case. 28 U.S.C. § 352(b)(1)(A)(ii); Misconduct Rule 4(c)(1). A challenge to a judge's rulings should be sought through the correct review procedure and not through the procedures for judicial misconduct. See In re Charge of Judicial Misconduct, 685 F.2d 1226, 1227 (9th Cir. Jud. Council 1982)(If complainant wants to challenge the judge's rulings, correct review procedure, "not the procedures for judicial misconduct, [is] the proper remedy.") Only a court has the power to change a decision or ruling. The judicial council, the body that takes action under the misconduct complaint procedure, does not have that authority. Even multiple or very wrong legal decisions may be addressed under the ordinary course of appellate review. These charges, therefore, are dismissed.

Complainant failed to include any objectively verifiable proof other than the judge's order supporting his allegation of bias and prejudice. Conclusory charges that are wholly unsupported, as here, will be dismissed. 28 U.S.C. § 352(b)(1)(A)(iii); Misconduct Rule 4(c)(3). This charge, therefore, is dismissed.

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COMPLAINT DISMISSED.

Chief Judge

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December 18, 2007

Clerk of the Court
United States Court of Appeals for the Ninth Circuit
P. O. Box 193939
San Francisco, CA 941119-3939

Re: Complaint of Judicial Misconduct No. 07-89078

Dear Clerk of the Court,

I hereby petition the judicial council for review of chief judge's order (the "Order") dismissing my complaint against Magistrate Judge Edward M. Chen for judicial misconduct.

Applying the Standards referenced in the September 2006 Report by the committee led by Justice Stephen Breyer ("Implementation of the Judicial Conduct and Disability Act of 1980"), I believe that the Order's merit-related dismissal was unwarranted. My complaint did not seek a review of the decisions made by Magistrate Judge Chen, but merely raised issues on the apparent bias, prejudice and arbitrariness in the way he issued the ruling.

Standard 2 of the Committee says that "an allegation... that the judge ruled against the complainant because the complainant was [in certain category], is not merits-related." My complaint alleged that Magistrate Judge Chen ruled against my firm because he chose an easy target to "lash". Therefore, my complaint was not merits-related.

The Order made no analysis of the allegations, but merely stated that the complaint "failed to include any objectively verifiable proof other than the judge's order." However, the Complaint alleged that "Chen refused to hear about the merits" at the Rule 11 motion hearing. Complaint at p.2:12-24.

Committee Standard 4 states:

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> Indeed, a complaint need not itself identify a particular transcript or witness... Depending on what the transcript or the witnesses reveal, it may be appropriate for the chief judge to question the judge complained against.

The Order cited 28 U. S. C. 352(b)(1)(A)(iii), but did not conclude that the complaint was "[f]rivolous, lacking sufficient evidence to raise an **inference** that misconduct has occurred." The complaint inferred that Magistrate Judge Chen's handling of the Rule 11 motion was out of bias and failed to even maintain the appearance of justice.

What Magistrate Chen allegedly did was pervasive twisting of the facts and record to fit his conclusion. Does such pervasive twisting raise an inference of misconduct? Or is such pervasive twisting merits related?

I believe that the twisting of facts and record are not merits related, because the alleged misconduct is the act of "twisting", not the act of deciding the case based on the product of the twisting.

I am not complaining about Magistrate Chen's ruling derived from the "twisted facts and record" – that would be the subject of an appeal. I am complaining about "the act of twisting." Twisting is an act to create falsehood, no person should do it. A federal magistrate judge should be held to an even higher standard.

The inquiry is an objective one: identify the facts and allegations in the record and determine whether Judge Chen twisted them.

For the foregoing reasons, I respectfully petition the council for a review of the chief judge's order of dismissal.

Sincerely,

Dongxiao Yue

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Letter to Senator Franken Re Judicial Nominee Edward M. Chen

September 23, 2009

Senator Al Franken
U.S. Senate Committee on the Judiciary; and
Members of the Senate Committee on the Judiciary
433 Russell Senate Office Building
United States Senate
Washington, DC 20510

Dear Senator Franken and Honorable Members of the Senate Judiciary Committee,

As a member of the American Justice Group, I previously requested to testify at today's Judiciary Committee hearing in opposition to confirming Edward M. Chen to the federal judgeship. I also submitted documents that showed Chen's lack of integrity and intellectual honesty.

At today's hearing, Chen stated his belief that personal prejudices founded upon ethnic background is legitimate discretion in judging a case. Chen also revealed that judges in the Northern District of California discussed cases in the hallway and at lunch. Chen's statements were disturbing admissions.

Ex parte communications among judges threaten impartial decision-making. In my company's copyright case against a large company, after I criticized Chen's distortions and filed a judicial misconduct complaint against him, the presiding judge retaliated against me by dismissing my company's claims, inventing the infamous "Jenkins-Laporte Doctrine", which seriously undermined U.S. Copyright Law.

At the conclusion of today's hearing, Senator Franken acknowledged that the Judiciary Committee had received letters in support of Chen, but did not mention the letters against Chen. Such an omission may create a mistaken public impression that the Committee received no opposition letters. My telephone inquiry with the Committee's Majority Office confirmed that it received the letters and documents opposing Chen. A complete record should reflect that Chen did meet oppositiou to his nomination.

I request to testify before the full U.S. Senate against Chen's confirmation. Please forward my request to the proper Senate body.

Sincerely,

Dongxiao Yue, Ph. D.

[redacted]

Cc: Members of the U.S. Senate

[redacted]

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[redacted]

September 16, 2009

Senator Patrick J. Leahy
Chairman of the U.S. Senate Committee on the Judiciary; and
Members of the Senate Committee on the Judiciary
433 Russell Senate Office Building
United States Senate
Washington, DC 20510

Dear Senate Leahy and Honorable Members of the Judiciary Committee,

As a member of the American Justice Group, I request to testify in opposition to the confirmation of Edward M. Chen to the Article III judgeship of the United States. I have previously filed a judicial misconduct complaint against Chen, alleging willful distortion and mischaracterization of record in order to curry favor with big money.

My testimony will focus on Chen's character and his judicial style, based on my experience on how he conducts hearings and writes opinions. I believe that I can aid Congress in its due diligence in checking the qualifications of Chen before appoint him to the lifetime tenure of a federal judge.

The potential damage to the United States and the people due to the failure to perform a full examination of Chen may be immeasurable.

I request to testify at Chen's committee hearing scheduled for September 23, 2009. I am attaching a brief statement of fact, and will provide additional documents to support my testimony against Chen.

Sincerely,

Dongxiao Yue, Ph. D.

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Statement of Fact in Opposition to the Confirmation of Judicial Nominee Edward M. Chen

The following statement of fact shows how Chen handled a case in which a large powerful company was the defendant.

In January 2006, Netbula, LLC, a small software company, sued Symantec Corporation for copyright infringement (case number C06-0711-MJJ (N.D. Cal)). Before Symantec answered the complaint, the parties held a private settlement meeting on May 15, 2006. Dr. Yue, on behalf of Netbula, brought a stack of important documents, and the parties discussed them. The meeting did not result in a settlement. At the ending of the meeting, the Symantec executive declined to take the documents.

Later, Symantec informed the Court that in the May 15, 2006 meeting "Symantec ... provided the materials requested of them... Netbula, on the other hand, did not provide any of the materials requested of them."

Symantec also accused Netbula of "unclean hands" in its affirmative defenses. Netbula's copyright certificate stated that its software was first published in September 1996. Symantec alleged that Netbula did not exist until a year later and accused Netbula of cheating the Copyright Office.

Since Symantec did not provide any factual basis for its allegation, Netbula pointed out in court filings that Symantec's allegation was baseless. But Symantec ignored Netbula's protest and continued to make the similar accusations in its affirmative defenses filed with the Court in December 2006.

Symantec also continued to tell the Court that Netbula did not bring any documents to the May 15, 2006 meeting. Frustrated, on March 14, 2007, Netbula's new lawyer, a young black woman, served a Rule 11 motion on defense counsel.

Symantec's lawyers was given a 21-day "safe-harbor" period to withdraw their misrepresentations, but they refused. On April 6, 2007, after the expiration of the safe-harbor period, Netbula filed the Rule 11 motion with the District Court. The presiding judge referred the motion to Edward M. Chen.

In the briefing of its Rule 11 motion, Netbula referred to a May 16, 2006 email sent by Symantec's attorney Jedediah Wakefield, in which he discussed the documents Dr. Yue brought to the meeting the previous day. That email was copied onto two other Symantec lawyers. Faced with this evidence, Symantec admitted that Netbula did bring documents to the May 15 meeting.

Symantec also admitted that it was mistaken about the year of Netbula's formation. It explained that its lawyers did not check Delaware records; they only checked California records.

Chen conducted the hearing of Netbula's Rule 11 motion on June 7, 2007. First, he said that case law on Rule 11 motions was scarce. After he noted that Netbula's lawyer was a young solo practitioner, he stated that Netbula was

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wasting court resources and he was inclined to side with Symantec.

On June 11, 2007, Chen issued a ruling that denied Netbula's motion and awarded Symantec $20,000.00 in attorneys' fees.

Rule 11 of Federal Civil Procedure does not set a time limit for filing the motion. In its papers, Netbula cited precedents where Courts granted Rule 11 motions more than a year after the violation, and noted that Netbula's motion was made only three months after the last alleged violation. Chen disagreed. He wrote:

> Netbula's Rule 11 motion was untimely because it was not filed until many months after Defendants' offending contentions were made... The instant case involves contentions made in motions, and not pleadings.

But, Netbula sought sanctions for Symantec's false statements in its Affirmative Defenses filed in December 2006. Affirmative defenses are pleadings, not motions.

On the May 15, 2006 meeting, Chen wrote:

> "In any event, Defendants' statement was not misleading. Netbula had not produced all the documents requested."[1]

On the issue of when Netbula was founded, Chen admitted that Symantec was wrong, but he blamed Netbula[2]:

> although it appears that Defendants' could have easily determined the date Netbula was organized in Delaware and thus presents the strongest case for service of a Rule 11 motion, this issue illustrates why the safe harbor provision is important... Netbula should have asked Defendants to withdraw the contention because Netbula was incorporated earlier in Delaware. It could have easily document such to Defendants' satisfaction. Netbula did not do so. In fact, even in its reply brief, Netbula failed to bring this corrective information to Defendants' and the presiding judge's attention.

After putting the blame on the party who was telling the truth, Chen wrote why the Symantec's attorneys should be awarded $20,000.00:

> defense counsel's credibility had been attacked, and they

[1] Neither side brought ALL documents requested to the May 15 meeting. Symantec's allegation was that Netbula did not bring ANY document.

[2] As stated above, Netbula had no idea why Symantec accused Netbula of not founding until 1997. Symantec did not provide supporting affidavit for its factual contentions. Netbula always presented itself as "a Delaware Limited Liability Company" and Defense counsel knew it from the beginning. Netbula filed the Rule 11 motion after the expiration of the 21-day "safe-harbor" period and AFTER Symantec to correct its misrepresentations and mistakes.

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> were entitled to defend against the charge that they had acted frivolously, a grave charge... the factual investigation needed to respond to the Rule 11 motion on the merits was not a task that could quickly be accomplished. For example, a fair amount of time was reasonably expended to look into the history of events surrounding the May 15, 2006, settlement meeting. Given the circumstances, having reviewed the opposition brief and affidavit, the Court concludes that an award of $20,000 is reasonable.

On August 6, 2007, the presiding judge held that Chen's finding was erroneous. The judge ruled that Netbula's motion was too early, rather than too late:

> Plaintiff points out that the magistrate judge erroneously found that the Rule 11 motion did not involve pleadings, since Plaintiff did request that the Court impose sanctions on Defendants for claimed mischaracterizations in their second amended answer. However, this argument does not undermine the *conclusion* that the motion is untimely... Rule 11 motion for sanctions arising from Defendants' pleading was untimely because Plaintiff filed it too *early* by not awaiting the end of the case.

Another Magistrate Judge, Hon. Wayne D. Brazil, had the following to say about Symantec attorneys and the May 15, 2006 meeting:

> THE COURT (Judge Brazil asking Symantec lawyer): Were you at that meeting, May 15th?
>
> MR. WAKEFIELD (Symantec lawyer): I was, Your Honor.
>
> THE COURT: Okay. And they said -- they say they produced a bunch of documents, showed, disclosed, offered for you guys to keep. No, no, we don't want them piecemeal. We want the whole 9 yards, otherwise we don't get paid enough money....
>
> THE COURT: ...Most litigants cannot come here because the profit per partner[3] is $900,000 a year. This is a mirage of an institution for everybody except general motors. And that's shameful to our society. So that's -- that's the context here.

Dated: September 16, 2009

By: _____
Dongxiao Yue, Ph. D.

[3] Mr. Wakefield was a partner at the defense lawfirm.

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RE: Judicial Nominee Edward M. Chen's Statement to the Senate

To: U.S. Senate Judiciary Committee
***Attachment**: (1) Chen's Statement to the Senate (p.41); and*

(2) Docket Sheet of the Change v. Berkeley Case

On page 41 of Judge Edward Milton Chen's Answer to the Questionnaire For Judicial Nominees, he submitted to the U.S. Senate about a case he presided:

> 3/31/08; C07-4005 EMC; Chang v. Rockridge Manor Condo. The pro se plaintiff filed a motion for recusal after I issued a substantive ruling against her. I denied the request because the plaintiff was claiming bias based solely on an adverse ruling I had issued. She did not substantiate any claim of extrajudicial bias.

As shown on the *Chang* case Docket Sheet (attached), University of California at **Berkeley**, UC Berkeley Chancellor Robert Birgeneau, UC Berkeley General Counsel Susan Von Seeburg were also named defendants in the *Chang v. Rockridge* case, represented by U.C. Berkeley graduate Gaylynn Kirn Conant.

And, Judge **Chen is alumnus of U.C. Berkeley and U.C. Berkeley School of Law**. Public documents show that he lectured at defendant school in 2007, **donated money to the defendant in 2007-2008** and had other ties to the defendant.

In a similar case, when a Judge was alumnus of defendant school, the Court of Appeal ordered evidentiary hearings to ascertain the judge's "associations and affiliations with the Law School". *Easley v. University of Michigan Board of Regents*, 853 F.2d 1351 (6th Cir. 1988); see also, *Liljeberg v. Health Svcs. Acquisition Corp., 486 U.S. 847 (1988)* (vacating judgment where trial judge had ties to defendant school).

Apparently, Judge Chen did not inform Ms. Chang about his associations with the defendant. Instead, on November 14, 2007, in the Initial Case Management Scheduling Conference, Chen ordered: "**A trial date has not been set. No formal discovery and no initial disclosures until further order by this Court.**" See Docket Entry No. 80. Federal Rules of Civil Procedure require that Initial disclosures to be made **before** the Initial Case Management Conference. See FRCP 26(a) (1) (C) and 26(f).

Three months later, on February 13, 2008, Judge Chen granted defendant's motion for summary judgment, without permitting plaintiff to conduct discovery. Chen's judgment Order ridiculed plaintiff's claims as "**patently fanciful and insubstantial**", as well as "**fantastic or delusional.**"

Thus, Judge Chen zealously defended defendant U.C. Berkeley -- his Alma Mater.

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UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Edward Milton Chen

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Northern District of California

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: United States District Court
   450 Golden Gate Avenue, 15th Floor
   San Francisco, CA 94102

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1953; Oakland, California.

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1976 – 1979, University of California Boalt Hall School of Law (now known as University of California, Berkeley School of Law); J.D.; June, 1979

   1971 – 1975, University of California, Berkeley; A.B., June, 1975

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

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particular expert, I withdrew the recusal order and heard the case with the parties' consent.

28. 4/27/07; C07 2271 SBA; Reyes v. Alcantar
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

29. 5/24/07; C06 6497 EMC; G v. Kentfield School District
I recused myself sua sponte for the reasons stated above as to Case No. C01-1344 (#1 above.) The defendant in this case was Marin County Office of Education/Special Education and my son was (and still is) in the County special education program.

30. 3/31/08; C07-4005 EMC; Chang v. Rockridge Manor Condo.
The pro se plaintiff filed a motion for recusal after I issued a substantive ruling against her. I denied the request because the plaintiff was claiming bias based solely on an adverse ruling I had issued. She did not substantiate any claim of extrajudicial bias. See United States v. Grinnell Corp., 384 U.S. 563, 583 (1966) (explaining that "[t]he alleged bias and prejudice to be disqualifying must stem from an extrajudicial source and result in an opinion on the merits on some basis other than what the judge learned from his participation in the case").

31. 4/21/08; C08-1173 EMC; Eidex Family Partnership, L.P. v. Justice
The pro se plaintiff sought to revoke consent to proceeding before a magistrate judge after I issued an opinion stating that there was no subject matter jurisdiction over the case. I denied the plaintiff's request because the sole basis of his request was his dissatisfaction with my ruling. Subsequently, Judge White of this District also denied the plaintiff's request for reassignment. Judge White later denied a request for reconsideration.

32. 2/10/09; C09-0564 EMC; 625 3rd Street Associates, LP v. Alliant Credit Union
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

33. 8/4/09, C07-5569 MHP, Alphaville Design, Inc. v. Knoll, Inc. I recused myself sua sponte. Plaintiff is represented by, inter alia, the Coblentz law firm.

In addition, I have recused myself sua sponte from a number of cases in cases in which a party is represented by a particular attorney, Thomas Frankovich**. Mr. Frankovich had previously filed a lawsuit against a restaurant and a family limited liability company of which I am a member and manager. The LLC owned the building in which the restaurant was located. These cases include

1/24/05; C04-4075 EMC; Connally v. Packaging Store
1/27/05; C04-2919 MJJ (EMC); Connally v. Red Boy Pizza
6/20/05; C04-4462 MJJ (EMC); Loskot v. Extended Stay CA, Inc.

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ADRMOP, APPEAL, E-Filing, ProSe

U.S. District Court
California Northern District (San Francisco)
CIVIL DOCKET FOR CASE #: 3:07-cv-04005-EMC

Chang v. Rockridge Manor Condominium et al
Assigned to: Magistrate Judge Edward M. Chen
Case in other court: 08-15539
08-16348
08-16753
Cause: 42:1983 Civil Rights Act

Date Filed: 08/03/2007
Date Terminated: 07/03/2008
Jury Demand: Plaintiff
Nature of Suit: 440 Civil Rights: Other
Jurisdiction: Federal Question

Plaintiff

Christine Chang
individually and as guardian ad litem for Eric Sun, disabled

represented by **Christine Chang**
341 Tideway Drive #214
Alameda, CA 94501
PRO SE

Plaintiff

Eric Sun
disabled
TERMINATED: 05/06/2008

represented by **Eric Sun**
PRO SE

V.

Defendant

Rockridge Manor Condominium
TERMINATED: 02/21/2008

represented by **Sara B. Allman**
Allman & Nielsen
100 Larkspur Landing Circle
Suite 212
Larkspur, CA 94939
415/461-2700
Fax: 415-461-2726
Email: all-niel@comcast.net
ATTORNEY TO BE NOTICED

Defendant

Rockridge Manor Homeowners Asso
TERMINATED: 02/21/2008

represented by **Sara B. Allman**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Rockridge Manor Board of Directors
TERMINATED: 02/21/2008

represented by **Sara B. Allman**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

[redacted]

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[redacted]

Charles Blakeney *Rockridge Manor President of Board of Directors* *TERMINATED: 02/21/2008*	represented by	**Sara B. Allman** (See above for address) *ATTORNEY TO BE NOTICED*
Defendant		
Eva Ammann *Rockridge Manor Manager*	represented by	**Edward Joseph Rodzewich** Valerian Patterson & Stratman 1650 Harbor Bay Parkway, Suite 100 Alameda, CA 94502 510-521-0612 Fax: 510-337-0125 Email: Edward.Rodzewich@farmersinsurance.com *LEAD ATTORNEY* *ATTORNEY TO BE NOTICED*
Defendant		
Truck Insurance Exchange	represented by	**Lee J. Danforth , Esq.** Coddington, Hicks & Danforth 555 Twin Dolphin Drive, Suite 300 Redwood City, CA 94065 (650) 592-5400 Email: LDanforth@CHDLawyers.com *LEAD ATTORNEY* *ATTORNEY TO BE NOTICED* **Richard Stuart Baum** Coddington, Hicks & Danforth 555 Twin Dolphin Drive, Suite 300 Redwood City, CA 94065 650-592-5400 Fax: 650-592-5027 Email: RBaum@CHDLawyers.com *ATTORNEY TO BE NOTICED*
Defendant		
University of California Berkeley	represented by	**Gaylynn Kirn Conant** Lombardi Loper & Conant, LLP Lake Merritt Plaza 1999 Harrison Street Suite 2600 Oakland, CA 94612-3541 510-433-2600 Fax: 510-433-2699 Email: gkc@llcllp.com *LEAD ATTORNEY* *ATTORNEY TO BE NOTICED*
Defendant		

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Robert Birgeneau
UC Berkeley Chancellor

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Alan Kolling
UC Berkeley Public Records Coordinator

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Susan Von Seeburg
UC Berkeley General Counsel

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Victoria Harrison
UC Berkeley Police Department

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Adan Tejada
UC Berkeley Police Department
Lieutenant

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Tom Klatt
UC Berkeley Police Department Manager

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Constance Peppers Celaya
UC Berkeley Police Department
Dispatcher

represented by **Gaylynn Kirn Conant**
(See above for address)
ATTORNEY TO BE NOTICED

Defendant

Pamela Zimba

represented by **Andrew Raymond Adler**
Boornazian Jensen & Garthe
P.O. Box 12925
555 12th St., Suite 1800
Oakland, CA 94604-2925
510-834-4350
Fax: 510-839-1897
Email: aadler@bjg.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Alan Edward Swerdlow
Boornazian Jensen & Garthe
555 - 12th Street
Suite 1800

[redacted]

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[redacted]

P.O. Box 12925
Oakland, CA 94604-2925
510-834-4350
Fax: 510-839-1897
Email: aswerdlow@bjg.com
TERMINATED: 01/11/2008
ATTORNEY TO BE NOTICED

Defendant

Albert Coombes

represented by **Albert Frank Coombes**
Law Offices of Albert F. Coombes
15915 Ventura Blvd.
Penthouse 4
Encino, CA 91436
818-986-1533
Fax: 818-986-1657
Email: coombeslaw@aol.com
ATTORNEY TO BE NOTICED

Defendant

The Regents of the University of California

represented by **Gaylynn Kirn Conant**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
08/03/2007	1	COMPLAINT; summons issued against Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, Pamela Zimba, Albert Coombes, Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney, Eva Ammann, Truck Insurance Exchange, University of California Berkeley (Filing fee $ 350, receipt number 3461100905). Filed by Christine Chang. (slh, COURT STAFF) (Filed on 8/3/2007) (Entered: 08/06/2007)
08/03/2007	2	ADR SCHEDULING ORDER: Case Management Statement due by 10/31/2007. Case Management Conference set for 11/7/2007 01:30 PM. (Attachments: # 1 EMC Standing Order; # 2 Case Management Standing Order)(slh, COURT STAFF) (Filed on 8/3/2007) (Entered: 08/06/2007)
08/03/2007		CASE DESIGNATED for Electronic Filing. (slh, COURT STAFF) (Filed on 8/3/2007) (Entered: 08/06/2007)
09/26/2007	3	CONSENT to Proceed Before a US Magistrate Judge by Christine Chang. (slh, COURT STAFF) (Filed on 9/26/2007) (Entered: 10/01/2007)
09/26/2007	4	SUMMONS Returned Executed by Christine Chang. Robert Birgeneau served on 9/7/2007, answer due 9/27/2007; Alan Kolling served on 9/7/2007, answer due 9/27/2007; Susan Von Seeburg served on 9/7/2007, answer due 9/27/2007; Victoria Harrison served on 9/7/2007, answer due 9/27/2007; Adan Tejada served on 9/7/2007, answer due 9/27/2007; Tom Klatt served on 9/7/2007, answer due 9/27/2007; Constance Peppers Celaya served on 9/7/2007, answer due 9/27/2007; Rockridge

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		Manor Condominium served on 9/7/2007, answer due 9/27/2007; Rockridge Manor Homeowners Asso served on 9/7/2007, answer due 9/27/2007; Rockridge Manor Board of Directors served on 9/7/2007, answer due 9/27/2007; Charles Blakeney served on 9/7/2007, answer due 9/27/2007; Eva Ammann served on 9/7/2007, answer due 9/27/2007; Truck Insurance Exchange served on 9/7/2007, answer due 9/27/2007; University of California Berkeley served on 9/7/2007, answer due 9/27/2007. (slh, COURT STAFF) (Filed on 9/26/2007) (Entered: 10/01/2007)
10/05/2007	5	MOTION for Default Judgment as to defendant Rockridge Manor Homeowners Asso filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	6	MOTION for Default Judgment as to defendant Rockridge Manor Board of Directors filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	7	MOTION for Default Judgment as to defendant Rockridge Manor President of Board of Directors Charles Blakeney filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	8	MOTION for Default Judgment as to defendant Rockridge Manor Manager Eva Ammann filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	9	MOTION for Default Judgment as to defendant Truck Insurance Exchange filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	10	MOTION for Default Judgment as to defendant University of California Berkeley filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	11	MOTION for Default Judgment as to defendant University of California Berkeley Chancellor Robert Birgeneau filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	12	MOTION for Default Judgment as to defendant University of California Berkeley Public Records Coordinator Alan Kolling filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	13	MOTION for Default Judgment as to defendant University of California Berkeley Police Department Chief Victoria Harrison filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	14	MOTION for Default Judgment as to defendant University of California Berkeley Police Department Lieutenant Adan Tejada filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	15	MOTION for Default Judgment as to defendant University of California Berkeley Police Department Manager Tom Klatt filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/05/2007	16	MOTION for Default Judgment as to defendant University of California Berkeley Police Department Dispatcher Constance Celaya filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/5/2007) (Entered: 10/09/2007)
10/10/2007	17	First MOTION to Dismiss for Lack of Jurisdiction *and failure to state claim* filed by Albert Coombes. Motion Hearing set for 11/28/2007 10:30 AM in Courtroom C, 15th

[redacted]

		Floor, San Francisco. (Coombes, Albert) (Filed on 10/10/2007) (Entered: 10/10/2007)
10/17/2007	18	MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* filed by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. Motion Hearing set for 11/28/2007 10:30 AM in Courtroom C, 15th Floor, San Francisco. (Conant, Gaylynn) (Filed on 10/17/2007) Modified on 10/18/2007 (ewn, COURT STAFF). (Entered: 10/17/2007)
10/17/2007	19	MEMORANDUM in Support re 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* filed byThe Regents of the University of California, Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya. (Related document(s) 18) (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	20	Declaration of GayLynn Kim Conant *in Support of Motion/Application for Relief from Default* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	21	Declaration of Constance Peppers Celaya *in Support of Application for Relief from Default* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	22	Declaration of Tejada in Support of 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 18) (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	23	Declaration of Tom Klatt in Support of 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 18) (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	24	Declaration of Susan Von Seeburg in Support of 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 18) (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	25	Declaration of Jim Taylor in Support of 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 18) (Conant, Gaylynn) (Filed on

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		10/17/2007) (Entered: 10/17/2007)
10/17/2007	26	Proposed Order re 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	27	CERTIFICATE OF SERVICE by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California re 18 MOTION to Set Aside Default */Application for Relief from Default/Opposition to Motion for Default Judgment and Leave to File Motion to Dimisss* (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	28	MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for More Definite Statement [F.R.C.P. 12(e)[* filed by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. Motion Hearing set for 11/28/2007 10:30 AM in Courtroom C, 15th Floor, San Francisco. (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	29	MEMORANDUM in Support *of Motion to Dismiss* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 28) (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	30	Request for Judicial Notice *in Support of Defendants Motion to Dismiss* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 28) (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	31	Proposed Order *Granting Defendants' Motion to Dismiss* by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/17/2007	32	CERTIFICATE OF SERVICE by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California *re Motion to Dismiss* (Conant, Gaylynn) (Filed on 10/17/2007) (Entered: 10/17/2007)
10/18/2007	33	CONSENT to Proceed Before a US Magistrate Judge by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California.. (Conant, Gaylynn) (Filed on 10/18/2007) (Entered: 10/18/2007)
10/18/2007	34	CONSENT to Proceed Before a US Magistrate Judge by Albert Coombes.. (Coombes, Albert) (Filed on 10/18/2007) (Entered: 10/18/2007)
10/18/2007	35	CERTIFICATE OF SERVICE by Albert Coombes re 34 Consent to Proceed Before a US Magistrate Judge (Coombes, Albert) (Filed on 10/18/2007) (Entered: 10/18/2007)
10/18/2007	36	CERTIFICATE OF SERVICE by Christine Chang re 15 MOTION for Default Judgment as to, 12 MOTION for Default Judgment as to, 8 MOTION for Default Judgment as to, 14 MOTION for Default Judgment as to, 16 MOTION for Default

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		Judgment as to, 9 MOTION for Default Judgment as to, 5 MOTION for Default Judgment as to, 13 MOTION for Default Judgment as to, 6 MOTION for Default Judgment as to, 11 MOTION for Default Judgment as to, 7 MOTION for Default Judgment as to, 10 MOTION for Default Judgment as to (slh, COURT STAFF) (Filed on 10/18/2007) (Entered: 10/23/2007)
10/25/2007	37	ADR Clerks Notice re: Non-Compliance with Court Order. (tjs, COURT STAFF) (Filed on 10/25/2007) (Entered: 10/25/2007)
10/25/2007	38	ADR Certification (ADR L.R. 3-5b) of discussion of ADR options (Conant, Gaylynn) (Filed on 10/25/2007) (Entered: 10/25/2007)
10/25/2007	39	NOTICE of need for ADR Phone Conference (ADR L.R. 3-5 d) (Conant, Gaylynn) (Filed on 10/25/2007) (Entered: 10/25/2007)
10/25/2007	40	ADR Certification (ADR L.R. 3-5b) of discussion of ADR options (Coombes, Albert) (Filed on 10/25/2007) (Entered: 10/25/2007)
10/29/2007	41	CASE MANAGEMENT STATEMENT *(Separate)* filed by Albert Coombes. (Coombes, Albert) (Filed on 10/29/2007) (Entered: 10/29/2007)
10/29/2007	42	CERTIFICATE OF SERVICE by Albert Coombes re 41 Case Management Statement (Coombes, Albert) (Filed on 10/29/2007) (Entered: 10/29/2007)
10/31/2007	43	CASE MANAGEMENT STATEMENT filed by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 10/31/2007) (Entered: 10/31/2007)
10/31/2007	44	CERTIFICATE OF SERVICE by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California re 43 Case Management Statement (Conant, Gaylynn) (Filed on 10/31/2007) (Entered: 10/31/2007)
10/31/2007	48	Memorandum in Opposition re defendant's 28 Motion to Dismiss filed by Christine Chang. (slh, COURT STAFF) (Filed on 10/31/2007) (Entered: 11/02/2007)
10/31/2007	49	EXHIBITS to 48 Memorandum in Opposition filed by Christine Chang. (Related document(s) 48) (slh, COURT STAFF) (Filed on 10/31/2007) (Entered: 11/02/2007)
11/01/2007	45	CASE MANAGEMENT STATEMENT filed by Pamela Zimba. (Adler, Andrew) (Filed on 11/1/2007) (Entered: 11/01/2007)
11/01/2007	46	CONSENT to Proceed Before a US Magistrate Judge by Pamela Zimba.. (Adler, Andrew) (Filed on 11/1/2007) (Entered: 11/01/2007)
11/01/2007	47	CLERK'S NOTICE of Impending Reassignment to U.S. District Judge (bpf, COURT STAFF) (Filed on 11/1/2007) (Entered: 11/01/2007)
11/02/2007	50	CONSENT to Proceed Before a US Magistrate Judge by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney.. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	51	MOTION to Shorten Time filed by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)

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11/02/2007	52	Proposed Order by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	53	MOTION to Set Aside Default filed by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	54	MEMORANDUM in Support filed byRockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	55	Declaration *of Paul A. Conroy in Support of Motion for Relief From Default* filed byRockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	56	Declaration *of Adelio Zumino in Support of Motion for Relief from Default* filed byRockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	57	Declaration of Charles Blakeney *in Support of Motion for Relief From Default* filed byRockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	58	Declaration of Scott Halbrook *in Support of Motion for Relief From Default* filed byRockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	59	MOTION for Summary Judgment filed by Rockridge Manor Homeowners Asso. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	60	MEMORANDUM in Support re 59 MOTION for Summary Judgment filed byRockridge Manor Homeowners Asso. (Related document(s) 59) (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	61	Declaration of Paul A. Conroy in Support of 59 MOTION for Summary Judgment, 60 Memorandum in Support filed byRockridge Manor Homeowners Asso. (Related document(s) 59 , 60) (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	62	Request for Judicial Notice *in Support of Motion for Summary Judgment* filed byRockridge Manor Homeowners Asso. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	63	MOTION to Dismiss filed by Rockridge Manor Homeowners Asso. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/02/2007	64	MEMORANDUM in Support *of Motion to Dismiss* filed byRockridge Manor Homeowners Asso. (Allman, Sara) (Filed on 11/2/2007) (Entered: 11/02/2007)
11/05/2007	65	CERTIFICATE OF SERVICE by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney *Amended Proof of Service* (Allman, Sara) (Filed on 11/5/2007) (Entered: 11/05/2007)

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11/05/2007	66	CLERK'S NOTICE Case Management Conference set for 11/14/2007 01:30 PM. Case Management Statement due by 11/9/2007. (bpf, COURT STAFF) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	67	MOTION to Dismiss *Notice of Motion and Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted and for a More Definitive Statement* filed by Pamela Zimba. (Swerdlow, Alan) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	68	Declaration of Andrew J. Adler in Support of 67 MOTION to Dismiss *Notice of Motion and Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted and for a More Definitive Statement* filed byPamela Zimba. (Attachments: # 1 Exhibit Exhibit 1# 2 Exhibit Exhibit 2# 3 Exhibit Exhibit 3# 4 Exhibit Exhibit 4)(Related document(s) 67) (Swerdlow, Alan) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	69	Proposed Order *Granting Motion to Dismiss* by Pamela Zimba. (Swerdlow, Alan) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	70	Request for Judicial Notice *In Support of Motion to Dismiss for More Definite Statement* filed byPamela Zimba. (Swerdlow, Alan) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	71	Proposed Order *On Request for Judicial Notice In Support of Motion to Dismiss for Failure to State a Claim and For More Definite Statement* by Pamela Zimba. (Swerdlow, Alan) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	72	CERTIFICATE OF SERVICE by Pamela Zimba (Swerdlow, Alan) (Filed on 11/5/2007) (Entered: 11/05/2007)
11/05/2007	73	Memorandum in Opposition re defendant Albert Coombes' 17 MOTION to Dismiss filed by Christine Chang. (slh, COURT STAFF) (Filed on 11/5/2007) (Entered: 11/06/2007)
11/05/2007	74	MOTION to Appoint Guardian ad Litem filed by Christine Chang. Motion Hearing set for 11/28/2007 10:30 AM. (slh, COURT STAFF) (Filed on 11/5/2007) (Entered: 11/06/2007)
11/08/2007	76	CONSENT to Proceed Before a US Magistrate Judge by Truck Insurance Exchange. (slh, COURT STAFF) (Filed on 11/8/2007) (Entered: 11/09/2007)
11/09/2007	75	CASE MANAGEMENT STATEMENT *Defendants Case Management Conference Statement* filed by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 11/9/2007) (Entered: 11/09/2007)
11/13/2007	77	STIPULATION AND ORDER TO SET ASIDE DEFAULT (As to Truck Insurance Exchange). Signed by Judge Edward M.Chen on 11/13/07. (bpf, COURT STAFF) (Filed on 11/13/2007) (Entered: 11/13/2007)
11/13/2007	78	CLERK'S NOTICE Continuing Motion Hearing Motion Hearing reset for 12/20/2007 09:30 AM in Courtroom C, 15th Floor, San Francisco. (bpf, COURT STAFF) (Filed on 11/13/2007) (Entered: 11/13/2007)
11/13/2007	79	PLAINTIFF'S CASE MANAGEMENT STATEMENT and Proposed Hearing Date for Motions filed by Christine Chang. (slh, COURT STAFF) (Filed on 11/13/2007) (Entered: 11/15/2007)

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11/13/2007		Proposed Order granting hearing date and Application for Guardian Ad Litem submitted by Christine Chang. (slh, COURT STAFF) (Filed on 11/13/2007) (Entered: 11/15/2007)
11/14/2007	82	CONSENT to Proceed Before a US Magistrate Judge by Eva Ammann. (slh, COURT STAFF) (Filed on 11/14/2007) (Entered: 11/16/2007)
11/15/2007	80	Minute Entry: Initial Case Management Conference held on 11/14/2007 before Edward M. Chen. A trial date has not been set. No formal discovery and no initial disclosures until further order by this Court. No defaults will be taken at this juncture as all named defendants have appeared either generally or specially. Plaintiff shall file an Application to Appoint Counsel for Guardian Ad Litem by 11/26/07. Plaintiff shall have until 12/24/07 to decide whether to proceed with the application to be appointed with counsel represented her in her capacity as guardian ad litem, or to withdraw her application and have Eric Sun dismissed from the case. Case continued to: 01/16/08 at 10:30 a.m. for various motions. (Date Filed: 11/15/2007). (Tape #1:40-2:06 p.m..) (bpf, COURT STAFF) (Date Filed: 11/15/2007) (Entered: 11/15/2007)
11/15/2007	81	CASE MANAGEMENT SCHEDULING ORDER: Motions Hearing reset for 1/16/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco.. Signed by Judge Edward M. Chen on 11/15/07. (bpf, COURT STAFF) (Filed on 11/15/2007) (Entered: 11/15/2007)
11/20/2007	84	SUMMONS Returned Executed by Christine Chang. Pamela Zimba served on 10/5/2007; Albert Coombes served on 9/26/2007. (slh, COURT STAFF) (Filed on 11/20/2007) (Entered: 11/27/2007)
11/21/2007	83	MOTION to Appoint Guardian ad Litem filed by Christine Chang. Motion Hearing set for 1/16/2008 10:30 AM. (slh, COURT STAFF) (Filed on 11/21/2007) (Entered: 11/27/2007)
11/28/2007	85	ORDER by Judge Edward M. Chen Denying 5 Plaintiffs' Motion for Default Judgment; Denying 6 Plaintiffs' Motion for Default Judgment; Denying 7 Plaintiffs' Motion for Default Judgment; Denying 8 Plaintiffs' Motion for Default Judgment; Denying 10 Plaintiffs' Motion for Default Judgment; Denying 11 Plaintiffs' Motion for Default Judgment; Denying 12 Plaintiffs' Motion for Default Judgment; Denying 13 Plaintiffs' Motion for Default Judgment; Denying 14 Plaintiffs' Motion for Default Judgment; Denying 15 Plaintiffs' Motion for Default Judgment; Denying 16 Plaintiffs' Motion for Default Judgment; and Finding as Moot 18 Defendants' Motion to Set Aside Default/Default Judgment; Finding as Moot 53 Defendants' Motion to Set Aside Default/Default Judgment. (emcsec, COURT STAFF) (Filed on 11/28/2007) (Entered: 11/28/2007)
11/29/2007	86	ORDER by Judge Edward M. Chen Denying 83 Plaintiffs' Application/Motion to Appoint Counsel for Guardian Ad Litem. (emcsec, COURT STAFF) (Filed on 11/29/2007) (Entered: 11/29/2007)
12/05/2007	87	***** FILED IN ERROR. PLEASE REFER TO DOCUMENT 88 . ***** First MOTION to Dismiss *Plaintiff's Complaint* filed by Truck Insurance Exchange. Motion Hearing set for 1/16/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco. (Baum, Richard) (Filed on 12/5/2007) Modified on 12/5/2007 (feriab, COURT STAFF). (Entered: 12/05/2007)

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12/05/2007	88	First MOTION to Dismiss *Plaintiff's Complaint* filed by Truck Insurance Exchange. Motion Hearing set for 1/16/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco. (Attachments: # 1 Memorandum of Points & Authorities in Support of Motion)(Baum, Richard) (Filed on 12/5/2007) (Entered: 12/05/2007)
12/05/2007	89	Proposed Order re 88 First MOTION to Dismiss *Plaintiff's Complaint* by Truck Insurance Exchange. (Baum, Richard) (Filed on 12/5/2007) (Entered: 12/05/2007)
12/21/2007	90	ORDER. Signed by Judge Edward M. Chen on 12/21/07. (bpf, COURT STAFF) (Filed on 12/21/2007) (Entered: 12/21/2007)
12/21/2007	96	Letter from Christine Chang re appointment of counsel. (sv, COURT STAFF) (Filed on 12/21/2007) (Entered: 12/28/2007)
12/26/2007	91	Memorandum in Opposition re 88 First MOTION to Dismiss *Plaintiff's Complaint* filed by Christine Chang. (sv, COURT STAFF) (Filed on 12/26/2007) (Entered: 12/26/2007)
12/26/2007	92	EXHIBITS re 91 Memorandum in Opposition filed byChristine Chang. (Related document(s) 91) (sv, COURT STAFF) (Filed on 12/26/2007) (Entered: 12/26/2007)
12/26/2007	93	Memorandum in Opposition re 59 MOTION for Summary Judgment, 63 MOTION to Dismiss filed byChristine Chang. (sv, COURT STAFF) (Filed on 12/26/2007) (res, COURT STAFF). (Entered: 12/26/2007)
12/26/2007	94	Memorandum in Opposition re 67 MOTION to Dismiss *Notice of Motion and Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted and for a More Definitive Statement* filed byChristine Chang. (sv, COURT STAFF) (Filed on 12/26/2007) (Entered: 12/26/2007)
12/26/2007	95	MOTION/Application for Reconsideration filed by Christine Chang. Motion Hearing set for 1/16/2008 10:30 AM. (sv, COURT STAFF) (Filed on 12/26/2007) (Entered: 12/26/2007)
12/31/2007	97	Reply to Opposition 94 *re Motion to Dismiss for Failure to State a Claim upon which Relief can be Granted or, in the alternative, for a more definite statement* filed by Pamela Zimba. (Adler, Andrew) (Filed on 12/31/2007) Modified on 1/2/2008 (sv, COURT STAFF). (Entered: 12/31/2007)
12/31/2007	98	Reply to Opposition 94 *and Certificate of Service* filed by Albert Coombes. (Coombes, Albert) (Filed on 12/31/2007) Modified on 1/2/2008 (sv, COURT STAFF). (Entered: 12/31/2007)
01/02/2008	99	Reply Memorandum 63 *in Support of Defendants' Motion to Dismiss* filed by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 1/2/2008) Modified on 1/3/2008 (sv, COURT STAFF). (Entered: 01/02/2008)
01/02/2008	100	CERTIFICATE OF SERVICE by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California re 99 Reply Memorandum, *in Support of Defendants' Motion to Dismiss* (Conant, Gaylynn) (Filed on 1/2/2008) (Entered: 01/02/2008)
01/02/2008	101	REPLY to Response to Motion *to Dismiss* filed byTruck Insurance Exchange. (Attachments: # 1 Supplement Proof of Service)(Baum, Richard) (Filed on 1/2/2008) (Entered: 01/02/2008)

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01/02/2008	102	Reply Memorandum *of Points and Authorities in Support of Defendant Rockridge Manor Homeowners' Association's Motion for Summary Judgment 59* filed by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 1/2/2008) Modified on 1/3/2008 (sv, COURT STAFF). (Entered: 01/02/2008)
01/02/2008	103	Reply Memorandum 63 *of Points and Authorities in Support of Defendant Rockridge Manor Homeowners' Association's Motion to Dismiss* filed by Rockridge Manor Condominium, Rockridge Manor Homeowners Asso, Rockridge Manor Board of Directors, Charles Blakeney. (Allman, Sara) (Filed on 1/2/2008) Modified on 1/3/2008 (sv, COURT STAFF). (Entered: 01/02/2008)
01/02/2008	105	MOTION for Reconsideration re appointment of counsel filed by Christine Chang. (sv, COURT STAFF) (Filed on 1/2/2008) (Entered: 01/04/2008)
01/03/2008	104	ORDER by Judge Edward M. Chen Denying 95 Plaintiffs' Application/Motion for Reconsideration to Appoint Counsel for Guardian Ad Litem. (emcsec, COURT STAFF) (Filed on 1/3/2008) (Entered: 01/03/2008)
01/11/2008	106	*** **FILED IN ERROR. PLEASE SEE DOCKET # 107 .** *** NOTICE of Change In Counsel by Andrew Raymond Adler *for Defendant Pamela Zimba* (Adler, Andrew) (Filed on 1/11/2008) Modified on 1/14/2008 (ewn, COURT STAFF). (Entered: 01/11/2008)
01/11/2008	107	NOTICE of Change In Counsel by Andrew Raymond Adler *for Defedant Pamela Zimba* (Adler, Andrew) (Filed on 1/11/2008) (Entered: 01/11/2008)
01/16/2008	108	Minute Entry: Motion Hearing held on 1/16/2008 before Edward M. Chen. Court took matter under submission (Date Filed: 1/16/2008). (Court Reporter Belle Ball.) (bpf, COURT STAFF) (Date Filed: 1/16/2008) (Entered: 01/16/2008)
01/16/2008	109	SUMMONS Returned Executed by Christine Chang. Eva Ammann served on 1/16/2008. (slh, COURT STAFF) (Filed on 1/16/2008) (Entered: 01/22/2008)
02/13/2008	110	ORDER by Judge Edward M. Chen Granting 17 28 63 67 88 Defendants' Motion to Dismiss or, in the Alternative, for a More Definite Statement; and Granting 59 Defendant's Motion for Summary Judgment. (emcsec, COURT STAFF) (Filed on 2/13/2008) (Entered: 02/13/2008)
02/20/2008	111	MOTION to Dismiss, MOTION for More Definite Statement filed by Eva Ammann. (slh, COURT STAFF) (Filed on 2/20/2008) (slh, COURT STAFF). (Entered: 02/21/2008)
02/20/2008	112	MEMORANDUM OF POINTS AND AUTHORITIES in Support re 111 MOTION to Dismiss, MOTION for More Definite Statement filed by Eva Ammann. (Related document(s) 111) (slh, COURT STAFF) (Filed on 2/20/2008) (slh, COURT STAFF). (Entered: 02/21/2008)
02/20/2008	113	MOTION for Summary Judgment filed by Eva Ammann. (slh, COURT STAFF) (Filed on 2/20/2008) (slh, COURT STAFF). (Entered: 02/21/2008)
02/20/2008	114	MEMORANDUM OF POINTS AND AUTHORITIES in Support re 113 MOTION for Summary Judgment filed by Eva Ammann. (Related document(s) 113) (slh, COURT STAFF) (Filed on 2/20/2008) (slh, COURT STAFF). (Entered: 02/21/2008)

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02/21/2008	115	CLERK'S NOTICE re: Failure to E-File and/or Failure to Register as an E-Filer re 111 , 112 , 113 , 114 . (slh, COURT STAFF) (Filed on 2/21/2008) (Entered: 02/21/2008)
02/21/2008	116	JUDGMENT in favor of Defendants Rockridge Manor Homeowners Association, Rockridge Manor Condominium, Rockridge Manor Board of Directors, Rockridge Manor President of Board of Directors Charles Blakeney, and Charles Blakeney ONLY.. Signed by Betty Fong, Deputy Clerk on 2/21/08. (bpf, COURT STAFF) (Filed on 2/21/2008) (Entered: 02/21/2008)
02/21/2008	117	AMENDED JUDGMENT in favor of Defendants Rockridge Manor Homeowners Association, Rockridge Manor Condominium, Rockridge Manor Board of Directors, Rockridge Manor President of Board of Directors Charles Blakeney, and Charles Blakeney (only).. Signed by Betty Fong, Deputy Clerk on 2/21/08. (bpf, COURT STAFF) (Filed on 2/21/2008) (Entered: 02/21/2008)
02/22/2008	118	CLERK'S NOTICE Continuing Motion Hearing Motion Hearing set for 3/26/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco. (bpf, COURT STAFF) (Filed on 2/22/2008) (Entered: 02/22/2008)
02/29/2008	119	FIRST AMENDED COMPLAINT against Robert Birgeneau, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Constance Peppers Celaya, Pamela Zimba, Albert Coombes, The Regents of the University of California, Eva Aminann. Filed by Eric Sun, Christine Chang. (slh, COURT STAFF) (Filed on 2/29/2008) (Entered: 03/06/2008)
02/29/2008	120	MOTION and MEMORANDUM OF POINTS AND AUTHORITIES in Support to Appoint Counsel for Plaintiff Chang to Serve as Guardian ad Litem filed by Christine Chang, Eric Sun. Motion Hearing set for 4/23/2008 10:30 AM. (slh, COURT STAFF) (Filed on 2/29/2008) (Entered: 03/06/2008)
02/29/2008	121	Declaration in Support of 120 MOTION to Appoint Counsel for Plaintiff Chang to Service as Guardian ad Litem filed by Christine Chang, Eric Sun. (Related document(s) 120) (slh, COURT STAFF) (Filed on 2/29/2008) (Entered: 03/06/2008)
02/29/2008	122	Declaration of Hiawatha Harris, M.D. in Support of 120 MOTION to Appoint Counsel for Plaintiff Chang to Serve as Guardian ad Litem filed by Christine Chang, Eric Sun. (Related document(s) 120) (slh, COURT STAFF) (Filed on 2/29/2008) (Entered: 03/06/2008)
02/29/2008	123	NOTICE OF APPEAL as to 110 Order filed by Christine Chang, Eric Sun. Filing fee not paid. (slh, COURT STAFF) (Filed on 2/29/2008) **(USCA Case No. 08-15539)** (Entered: 03/06/2008)
02/29/2008	124	Declaration in Support of 123 Notice of Appeal filed by Christine Chang, Eric Sun. (Related document(s) 123) (slh, COURT STAFF) (Filed on 2/29/2008) (Entered: 03/06/2008)
03/06/2008	125	Transmission of Notice of Appeal and Docket Sheet to US Court of Appeals re 123 Notice of Appeal. (slh, COURT STAFF) (Filed on 3/6/2008) (Additional attachment(s) added on 3/6/2008: # 1 new appeal) (slh, COURT STAFF). (Entered: 03/06/2008)
03/06/2008		Copy of Notice of Appeal and Docket sheet mailed to all counsel. (slh, COURT STAFF) (Filed on 3/6/2008) (Entered: 03/06/2008)

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03/06/2008	126	Mailed request for payment of docket fee to appellant (cc to USCA) (slh, COURT STAFF) (Filed on 3/6/2008) (Entered: 03/06/2008)
03/07/2008	127	ORDER by Judge Edward M. Chen denying 120 Motion to Appoint ad Litem. (bpf, COURT STAFF) (Filed on 3/7/2008) (Entered: 03/07/2008)
03/07/2008	128	MOTION for Reconsideration filed by Christine Chang. Motion Hearing set for 4/23/2008 10:30 AM. (slh, COURT STAFF) (Filed on 3/7/2008) (Entered: 03/10/2008)
03/11/2008	129	ORDER by Judge Edward M. Chen denying 128 Motion for Reconsideration re 123 Notice of Appeal filed by Eric Sun, Christine Chang, 128 MOTION for Reconsideration filed by Christine Chang (bpf, COURT STAFF) (Filed on 3/11/2008) (Entered: 03/11/2008)
03/12/2008		Certified copy of 129 Order sent to USCA. (slh, COURT STAFF) (Filed on 3/12/2008) (Entered: 03/12/2008)
03/14/2008	132	TRANSCRIPT of Proceedings held on 1/16/08 before Judge Chen. Court Reporter: Belle Ball. (slh, COURT STAFF) (Filed on 3/14/2008) (Entered: 03/17/2008)
03/17/2008	130	Second MOTION to Dismiss filed by Albert Coombes. Motion Hearing set for 4/22/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco. (Coombes, Albert) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	131	MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* filed by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. Motion Hearing set for 4/23/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco. (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	133	ORDER re briefing schedule re 111 MOTION to Dismiss MOTION for More Definite Statement filed by Eva Ammann, 113 MOTION for Summary Judgment filed by Eva Ammann. Signed by Judge Edward M. Chen on 3/17/08. (bpf, COURT STAFF) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	134	USCA Case Number 08-15539 for 123 Notice of Appeal. (slh, COURT STAFF) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	135	Proposed Order re 130 Second MOTION to Dismiss by Albert Coombes. (Coombes, Albert) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	136	MEMORANDUM OF POINTS AND AUTHORITIES in Support re 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California (Conant, Gaylynn) (Filed on 3/17/2008) Modified on 3/19/2008 (slh, COURT STAFF). (Entered: 03/17/2008)
03/17/2008	137	CERTIFICATE OF SERVICE by Albert Coombes re 135 Proposed Order *Granting Defendant's Motion to Dismiss Plaintiffs' First Amended Complaint* (Coombes, Albert) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	138	Declaration of Constance Peppers Celaya in Support of 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment*

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		[F.R.C.P. 56] MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 131) (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	139	Declaration of Victoria Harrison in Support of 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 131) (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	140	Declaration of Susan Von Seeburg in Support of 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 131) (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	141	Declaration of Adan Tejada in Support of 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* filed byRobert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Related document(s) 131) (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	142	Proposed Order re 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California. (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/17/2008	143	CERTIFICATE OF SERVICE by Robert Birgeneau, Alan Kolling, Susan Von Seeburg, Victoria Harrison, Adan Tejada, Tom Klatt, Constance Peppers Celaya, The Regents of the University of California re 131 MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* MOTION to Dismiss *Pursuant to FRCP 12(b)(6) or, in the Alternative, Motion for Summary Judgment [F.R.C.P. 56]* (Conant, Gaylynn) (Filed on 3/17/2008) (Entered: 03/17/2008)
03/18/2008	144	CLERK'S NOTICE Continuing Motion Hearing Motion Hearing set for 4/30/2008 10:30 AM in Courtroom C, 15th Floor, San Francisco. (bpf, COURT STAFF) (Filed on 3/18/2008) (Entered: 03/18/2008)
03/20/2008	145	MOTION to Dismiss filed by Pamela Zimba. Motion Hearing set for 5/14/2008 02:30 PM in Courtroom C, 15th Floor, San Francisco. (Adler, Andrew) (Filed on 3/20/2008) (Entered: 03/20/2008)

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03/20/2008	146	MEMORANDUM of Points and Authorities in support re 145 MOTION to Dismiss by Pamela Zimba (Adler, Andrew) (Filed on 3/20/2008) Modified on 4/9/2008 (slh, COURT STAFF). (Entered: 03/20/2008)
03/20/2008	147	Proposed Order re 145 MOTION to Dismiss by Pamela Zimba (Adler, Andrew) (Filed on 3/20/2008) Modified on 4/9/2008 (slh, COURT STAFF). (Entered: 03/20/2008)
03/24/2008	150	Declaration re Late Service of defendant Eva Ammann's Motion to Dismiss and Summary Judgment filed by Christine Chang. (slh, COURT STAFF) (Filed on 3/24/2008) (Entered: 03/25/2008)
03/24/2008	151	MOTION for Recusal filed by Christine Chang. (slh, COURT STAFF) (Filed on 3/24/2008) (Entered: 03/25/2008)
03/24/2008	152	AFFIDAVIT in Support re 151 MOTION for Recusal by Christine Chang. (slh, COURT STAFF) (Filed on 3/24/2008) (Entered: 03/25/2008)

PACER Service Center

Transaction Receipt

PACER Login:		**Client Code:**	
Description:	Docket Report	**Search Criteria:**	3:07-cv-04005-EMC
Billable Pages:		**Cost:**	

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To: U.S. Senate Judiciary Committee

RE: Judicial Nominee Edward M. Chen's Statement to the Senate Judiciary on a Recusal Motion

Facts:
(1) Chen has ties with defendant;
(2) Chen donates money to defendant;
(3) Chen refuses to recuse himself;
(4) Chen forbids discovery;
(5) Chen dismisses plaintiff's case;
(6) Chen blasts plaintiff as delusional;
(7) Chen hides the truth from the Senate!

Attached:

Appeal of Chen's Ruling in favor of U.C. Berkely in the *Chang v. U.C. Berkeley* Case

[redacted]

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UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Edward Milton Chen

2. **Position**: State the position for which you have been nominated.

   United States District Judge for the Northern District of California

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   Office: United States District Court
   450 Golden Gate Avenue, 15th Floor
   San Francisco, CA 94102

   Residence: [redacted]

4. **Birthplace**: State year and place of birth.

   1953; Oakland, California.

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1976 – 1979, University of California Boalt Hall School of Law (now known as University of California, Berkeley School of Law); J.D.; June, 1979

   1971 – 1975, University of California, Berkeley; A.B., June, 1975

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

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particular expert, I withdrew the recusal order and heard the case with the parties' consent.

28. 4/27/07; C07 2271 SBA; Reyes v. Alcantar
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

29. 5/24/07; C06 6497 EMC; G v. Kentfield School District
I recused myself sua sponte for the reasons stated above as to Case No. C01-1344 (#1 above.) The defendant in this case was Marin County Office of Education/Special Education and my son was (and still is) in the County special education program.

30. 3/31/08; C07-4005 EMC; Chang v. Rockridge Manor Condo.
The pro se plaintiff filed a motion for recusal after I issued a substantive ruling against her. I denied the request because the plaintiff was claiming bias based solely on an adverse ruling I had issued. She did not substantiate any claim of extrajudicial bias. See United States v. Grinnell Corp., 384 U.S. 563, 583 (1966) (explaining that "[t]he alleged bias and prejudice to be disqualifying must stem from an extrajudicial source and result in an opinion on the merits on some basis other than what the judge learned from his participation in the case").

31. 4/21/08; C08-1173 EMC; Eidex Family Partnership, L.P. v. Justice
The pro se plaintiff sought to revoke consent to proceeding before a magistrate judge after I issued an opinion stating that there was no subject matter jurisdiction over the case. I denied the plaintiff's request because the sole basis of his request was his dissatisfaction with my ruling. Subsequently, Judge White of this District also denied the plaintiff's request for reassignment. Judge White later denied a request for reconsideration.

32. 2/10/09; C09-0564 EMC; 625 3rd Street Associates, LP v. Alliant Credit Union
I recused myself sua sponte. One of the defendants in the case was represented by, inter alia, the Coblentz law firm.

33. 8/4/09, C07-5569 MHP, Alphaville Design, Inc. v. Knoll, Inc. I recused myself sua sponte. Plaintiff is represented by, inter alia, the Coblentz law firm.

In addition, I have recused myself sua sponte from a number of cases in cases in which a party is represented by a particular attorney, Thomas Frankovich**. Mr. Frankovich had previously filed a lawsuit against a restaurant and a family limited liability company of which I am a member and manager. The LLC owned the building in which the restaurant was located. These cases include

1/24/05; C04-4075 EMC; Connally v. Packaging Store
1/27/05; C04-2919 MJJ (EMC); Connally v. Red Boy Pizza
6/20/05; C04-4462 MJJ (EMC); Loskot v. Extended Stay CA, Inc.

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UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

CHRISTINE CHANG, individually and as guardian ad litem for Eric Sun, disabled Plaintiff – Appellant, and ERIC SUN, disabled, Plaintiff, v. ROCKRIDGE MANOR CONDOMINIUM; et al., Defendants – Appellees.	No: 08-16753 D.C. No. 3:07-cv-04005-EMC PETITION FOR REHEARING EN BANC AND FOR LEAVE TO FILE MOTION FRE 60(b)

Appeal from the United States District Court
for the Northern District of California
Edward M. Chen, Magistrate Judge, Presiding

PETITION FOR REHEARING EN BANC AND FOR LEAVE TO FILE MOTION FRE 60(b) – FILED SEPT. 14, 2009

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The district court improperly dismissed the claim of U.C. Berkeley defendants' **ex parte communication** with the state court judge. See plaintiffs' motion FRE 60(b)(2) – Relief from judgment or order. Some U.C. Berkeley defendants submitted affidavits disputed one incident of ex parte communication, some did not dispute the first nor second incidents. But Judge Chen, nevertheless, dismissed all U.C. Berkeley defendants on the ex parte communication Claim.

Judge Chen refused to recuse himself after plaintiffs filed a motion for recusal and a supporting affidavit. See **Docket Entry No. 151, 152, and 154.** However, I found out recently, Judge Chen received a B.A. from U.C. Berkeley in 1975, and J.D. from U.C. Berkeley School of Law in 1979. A search of Judge Chen's name at http://www.law.berkeley.edu reveals that Judge Chen has been giving seminars at U.C. Berkeley, and presumably been receiving compensation for his work at defendant school. Judge Chen is also listed as a significant donor to U.C. Berkeley law school. See **exhibit 1.**

Judge Chen abused his discretion dismissed all U.C. Berkeley defendants. He concealed the fact of his associations with the U.C. Berkeley defendant school. See *Easley v. University of Michigan Board of Regents*, 853 F.2d 1351 (Court of Appeals for The Six Circuit 1988). Plaintiff-appellant Easley appealed from rulings by district court Judge Feikens, based upon Judge Feikens' associations with the defendant school, U.C. Michigan Law School.

Judge Chen abused his discretion dismissed all U.C. Berkeley defendants. On November 14, 2007, Judge Chen ordered, "No formal discovery and no initial disclosures until further order by this court." See **Docket Entry No. 80**. Three months later, on February 13, 2008, Judge Chen dismissed all U.C. Berkeley defendants, blaming plaintiffs for not offering any evidence to the contrary. See **Docket Entry No. 110**.

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The district court abused its discretion in declining to exercise supplemental jurisdiction over the attorney defendants. Judge Chen refused to recuse himself after plaintiffs filed a motion for recusal and a supporting affidavit. See **Docket Entry No. 151, 152, and 154**.

Judge Chen abused his discretion in declining to exercise supplemental jurisdiction claims. Judge chen, first disallowed all formal discovery and disclosures (see **Docket Entry No. 80**), secondly, refused to recuse himself (see **Docket Entry No. 151, 152, and 154**), thirdly, dismissed all U.C. Berkeley defendants (see **Docket Entry No. 110**), then, declined to exercise supplemental jurisdiction claims over the attorney defendants. Judge Chen intentionally deprived plaintiffs' **Due Process Rights in the Fourteenth Amendment of United States Constitution**. See **exhibit 1**.

The district court abused its discretion in declining to exercise supplemental jurisdiction over the attorney defendants' **fraud**. See *Mellor v. Chamberlin*, 673 P.2d 610 (Supreme Court Washington 1983), also *Coson v. roehl*, 387 P.2d 541 (Supreme Court Washington 1963).

The district court abused its discretion in declining to exercise supplemental jurisdiction over the attorney defendants' **perjury**. The attorney defendants did not dispute plaintiffs' allegations of their perjury in the state court trial on August 5, 2004. Perjury carries a statute of limitation for four years. See *The State of Washington v. Douette*, 71 P. 556 (Supreme Court of Washington 1903).

Plaintiffs respectfully petition the Ninth Circuit Appeals Court to remand our case to the district court for retrial, due to Judge Chen's violation of Federal Rules and deprived plaintiffs' Due Process Rights guaranteed by the Fourteenth Amendment of the United States Constitution.

Christine Chang and for Eric Sun

Christine Chang and for Eric Sun, Plaintiffs

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To: U.S. Congressmen and President Obama

It will be an irreversible mistake if Edward M. Chen is nominated to the Federal Bench.

Recently, Mr. Chen pulled off a Catch-22 on the plaintiffs in the U.S. District Court case No. 3:07-cv-04005-EMC, which Mr. Chen mentioned in his answer to the Senate Judiciary Questionnaire. On November 14, 2007, Mr. Chen ordered: "No formal discovery and no initial disclosures until further order by this Court." See **Docket Entry No. 80.** Three months later, Mr. Chen dismissed all of plaintiffs' claims, blaming plaintiff not offering any evidence to the contrary. See **Docket Entry 110.**

I was the pro se plaintiff representing myself and my son in the case above, against the University of California at Berkeley and its officials ("U.C. Berkeley"). We, mother and son, are disabled, due to the aggravated assault and battery by U.C. Berkeley employees, and their continuing stalking and harassment. We filed suit in state court. After the state court judge was compromised by defendants' ex parte communications, we filed federal claims in the U.S. District Court. Judge Chen took the case.

U.C. Berkeley defendants did not dispute our allegations: its employees' aggravated assault and battery, stalking and harassment, perjury in the state court procedures, ex-parte communication with the state court judge, and conspiracy between U.C. Berkeley and defendants. These were indisputable, based on state court trial transcripts and hearing testimony.

After forbidding us to conduct discovery, Mr. Chen labeled our injuries a theoretical matter, fantastic or delusional scenarios, sheer speculation lacking plausibility, fantastic conspiracy, patently fanciful and insubstantial. Mr. Chen exonerated the U.C. Berkeley employees who filed affidavits, but avoided to mention the employees who did not file affidavits. He twisted the facts about employee defendants' perjury, fraud, and ex parte communication with the state judge, which were indisputable based on state court record. See, Chen's order dated February 13, 2008, **Docket Entry No. 110.**

I filed a motion for recusal and a supporting affidavit. Mr. Chen refused to recuse himself from the case. **Docket Entry No. 151, 152, 154**. In his answer to the Senate Questionnaire, Mr. Chen stated that he "denied the request because the plaintiff was claiming bias based solely on an adverse ruling I had issued." However, as I found out recently, Mr. Chen received a B.A. from U.C. Berkeley in 1975, and J.D. from U.C. Berkeley School of Law in 1979. A search of Chen's name at http://www.law.berkeley.edu reveals that Mr. Chen has been giving seminars at the defendant school, and presumably been receiving compensation for his work at defendant school. Mr. Chen was also listed as a significant donor to U.C. Berkeley law school in 2007-2008. In his answer to the U.S. Senate Judiciary Committee, Mr. Chen concealed the fact that U.C. Berkeley and its officials were named defendants in my case, represented by Gaylynn Kirn Conant, also a U.C. Berkeley graduate.

Mr. Chen's biased, prejudiced, oppressive and crooked behavior against the poor and powerless is shocking. He rules in favor of the rich and powerful, from whom he receives praises and recommendations. Mr. Chen will not uphold the laws and U. S. Constitution. It will be a tragic mistake if Edward M. Chen climbs up to the lifetime tenure of the federal bench.

EXHIBIT 1

Christine Chang, Plaintiff of Case No. 3:07-cv-04005-EMC

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To: U.S. Congressmen and President Obama

It will be an irreversible mistake if Edward M. Chen is nominated to the Federal Bench.

Recently, Mr. Chen pulled off a Catch-22 on the plaintiffs in the U.S. District Court case No. 3:07-cv-04005-EMC, which Mr. Chen mentioned in his answer to the Senate Judiciary Questionnaire. On November 14, 2007, Mr. Chen ordered: "No formal discovery and no initial disclosures until further order by this Court." See **Docket Entry No. 80.** Three months later, Mr. Chen dismissed all of plaintiffs' claims, blaming plaintiff not offering any evidence to the contrary. See **Docket Entry 110.**

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Christine Chang
Plaintiff of Case No. 3:07-cv-04005-EMC

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Oppose the Nomination of Edward M. Chen to Federal Bench

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To: U.S. Congress and President Obama

We write to you to register our serious concerns about Edward M. Chen's nomination to the U.S. federal court. Chen's biased judicial style has come to our attention through legal cases publicized on the Internet. As tax payers who pay judges to do justice, We oppose his nomination and confirmation.

Chen's ruling in the Netbula v. Symantec litigation shows his judicial philosohpy. In 2006, Netbula, LLC, a small software company sued Symantec Corporation for copyright infringement. Symantec made numerous misrepresentations to the Court. Even the presiding judge had found that Symantec "mischaracterize[d]" the record. However, when Netbula requested a Court order to force Symantec to correct its court filings, instead of upholding the integrity of the judicial process, Chen denied Netbula's request and ordered Netbula to pay $20,000 to Symantec. The following is but one example of how Chen distorts the record.

On May 15, 2006, Netbula and Symantec held a confidential private meeting. Netbula brought a stack of paper documents, and the parties and attorneys discussed them. At the end of the meeting, Symantec declined to take the Netbula documents. Then, it alleged in a Court filing that "Symantec ... provided the materials requested of them... Netbula, on the other hand, did not provide any of the materials requested of them."

After Symantec refused to correct their misrepresentations, Netbula's lawyer (a young black lady) filed a motion for Rule 11 sanctions. Faced with indisputable evidence, Symantec finally admitted that Netbula did bring some documents to the meeting.

Magistrate Chen heard the motion. After noting Netbula small and its attorney a solo practitioner, he distorted the record and ordered Netbula to pay $20,000.00 to Symantec. Chen wrote: "[Symantec's] statement was not misleading. Netbula had not produced all the documents requested."

To justify his ruling in favor of Symantec, Chen writes:
"The factual investigation [Symantec] needed to respond to [Netbula's] Rule 11 motion on the merits was not a task that could quickly be accomplished. For example, a fair amount of time was reasonably expended [by Symantec] to look into the history of events surrounding the May 15, 2006, settlement meeting... the Court concludes that an award of $20,000 [to Symantec] is reasonable."

In fact, three Symantec attorneys had an email discussion on May 16, 2006 about the documents Netbula brought to the meeting the previous day. Chen awarded Symantec attorneys for making a false statement that was refuted by their own email.

The above is just one example of Chen's contortionist jurisprudence. For more details, please review misconduct complaint No. 07-89078 filed with the Ninth Circuit. The Netbula v. Symantec case information can be found on the web site http://www.american-justice.org

Chen's judicial philosohpy raises serious concerns on whether he can be true to the oath of a judge -- to "do equal right to the poor and to the rich."

For this reason, we request Your Honor not to appoint Chen to the lifetime tenure of Article III Judge of the United States.

Sincerely,

The Undersigned

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The Oppose the Nomination of Edward M. Chen to Federal Bench Petition to U.S. Congress and President Obama was **created by American Justice Group and written by Equal Justice Under Law** (forequaljustice@gmail.com). This petition is hosted here at www.PetitionOnline.com as a public service. There is no endorsement of this petition, express or implied, by Artifice, Inc. or our sponsors. For technical support please use our simple Petition Help form.

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
1	carol Shi		Edward Chen does not represent the Asian American community, nor does he represent justice in the court room. He bases his rulings completely on whichever party has the most money and power, not on legal standards. We cannot blindly support Chen because he is Chinese. He does nothing for the Asian community, and if you look closely at his rulings, he purposely rules against Asians, regardless of whether they are legally correct. Obama must remove him as a magistrate, not promote him to be a District Court judge.	Fremont,
2	Steven Li		I am concerned about basic human rights violated by such corrupt judge. I oppose his nomination.	Santa Cla
3	Yong Li	yli01776@yahoc	This judge mistreated his own race. From "did not provide ANY document" to "not provide All document" trick game and shame!	
4	Bo Liu		Please don't appoint Edward Chen. His integrity is questioned.	Redwood
5	Feng Ying		I oppose his nomination.	
6	Lily Fan		remove Chen from Federal Court !	
7	Weidian Ma	weidian_ma@m	Biased judicial style	
8	linda wong		No Edward Chen !!!	
9	Peter H. J.		Chen demonstrated a pattern of bias and prejudice, he should be removed from Court.	
10	Mike Tran		I oppose the Nomination of Chen	
11	Bin Xie	bxiekc@gmail.c	I am an Chinese American, but I strongly oppose the Nomination of Edward M. Chen to Federal Bench	
12	Zhiying Lao		I am not happy with his appointment.	
13	Ben Wang		I oppose his appointment	
14	Kao Li		justice for all	
15	Ying Lu		The courtroom door is open to all	
16	Peter Lin		No Edward Chen !!!	
17	Xiangling Li		Chen is not good as a Judge.	
18	Hong Jun		I oppose injustice.	
19	Qin Wang		Chen can not represent justice	California
20	Bin Zhang		Please remove Chen from the Court.	
21	Fengling Zhen		I oppose injustice.	
22	Michael Lin		Obama must remove Chen as a magistrate, not promote him to be a District Court judge.	

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623451.194

PETITION SIGNATURES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
23	Ping Zhao		Remove Chen from the Court	
24	Lishen Ying		rights.	
25	Sharon Chen		Chen should be removed from the Court due to his misconducts at legal cases.	
26	Ming Qin		opposition	
27	lisa Fen		Chen is NOT qulified to be appointed.	
28	Huilan Yang		against corruption in judicial system	
29	Jack Meyer		I've lost hope in the judicial system.	
30	Eric Zhu		Chen is a disgrace to all Asians	
31	Joy Z.		I hope this man is punished	
32	Ting G		Edward Chen is a liar	
33	J Qian		remove chen from office immediately	
34	Ken Zhang		Edward Chen - RESIGN NOW!	
35	Mary Fisher		this magistrate's behavior is an abomination	
36	Paul K		actions	
37	Henry		our court system's blatant lies are finally revealed here	
38	Wilson Jose		chen's actions offend all minorities	
39	M Ronald		NO TO CHEN!	
40	Lucy Sharma		this man be appointed. What will happen to my rights?	
41	Meena Sampath		license?	
42	K Wang		This man is the epitome of injustice	
43	Qin Feng		What an awful person!	
44	Gary Lin		How does he sleep at night?	
45	Xu K		i wonder if he still considers himself human	
46	Jason Gupta		i fully support this petition	
47	Lina Tao		obama was supposed to help civil rights, not remove them by nominating edward chen	
48	Susie Chen		edward chen is social injustice at its peak	
49	Xing P.		I hope Obama regrets nominating Edward Chen and immediately retracts it!	
50	Alexander Chen		EDWARD CHEN MUST RESIGN NOW!	
51	Ju Xia		Chen - God will punish you	
52	Hong Zheng		Chen will be punished	
53	B Garcia		CHEN - LEAVE OFFICE!	
54	John Durham		I am a parent, and I am very glad my son did not choose to go into law. It's people like Edward Chen that make the entire US corrupt.	

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
55	fang Shih		No to Edward Chen	
56	Yong Yang		we need JUSTICE not injustice.	
57	Kunyang Chen		No to a corrupt judge	
58	Jin Fan		No to injustice !	
59	Linda Lei		We are concerned about basic human rights violated by this corrupt judge.	Milpitas C
60	haiqun yun		Chen?s judicial conduct is poor.	
61	Xiaoling		Please reconsider the Nomination of Chen.	
62	Kevin Thompson	kmuinma@come	Judicial corruption is out of control in this country. The Catholic priest scandal has nothing on the betrayals of public trust occurring in our courts, which are accountable to no one. How much longer are our legislators going to ignore the problem?	
63	Ming Shi		I Oppose the Nomination of Edward M. Chen to Federal Bench	
64	Yue Bai		I oppose the nomination of Edward M Chen	
65	Jon Steele		Obey and defend the Constitution or its treason	
66	li ying	iis3x@126.com	she(chen) tooo bad to chinese	
67	Randy Pentico		He can not be trusted.	
68	hanjuan jin		We need real justice in the system	
69	Ronald E. Jenks, Sr.		Take America back!	
70	Shelton Liu		Chen.	San Jose
71	John Stevens		Obama needs to choose another prominent candidate to fill Seat.	
72	Sondra Clark		We need to know Chen's birthplace , if he was born outside the United States, he can't become a U.S. Federal judge.	
73	Ming Hua		I am not happy when Chen was appointed to the Federal Bench.	
74	Xiao Hua		No to Chen.	
75	Ailan Shih		The nomination of Edward Chen to Federal Bench is a big mistake	
76	Qing He		No to Injustice. No to Chen.	
77	Nancy Liang		I don't fell safe with Edward Chen.	
78	Shihong Chen		No to Chen	
79	Mingjun Zhao		I oppose Edward Chen.	
80	Li Kai		I oppose Chen	
81	Huang Ping		choose another candidate instead of Chen.	

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
82	Mike L. Tran		I don't believe Chen based on his record.	
83	Ting Zhang		No to Chen.	
84	Lucy Yang		We need justice.	
85	Zilan Bai		Chen demonstrates a poor judicial conduct.	
86	Baichao Li		Based on Chen's record, I don't trust him.	
87	Edward Zhang		Chen can be replaced by any one if we don't care an nominee?s integrity	
88	Zhiquang lei		Chen made clear errors in the past cases, I oppose the Nomination of Chen.	
89	peter Lin		please replace him	
90	Dalun Zheng		I don't trust Chen	
91	Eric Li		No to corruption in judicial system	
92	Bowen zhang		Chen is not qulified to be a judge	
93	Zhu, Ping		I am concerned my human rights	
94	yongping zhu			
95	Dr. Wendy Xia		If a judge abuse the doctrine of judicial immunity, there will be justice for no one.	
96	Hong Sun			
97	Boping Song			
98	JAMES			
99	Gary Multer		There is no evidence showing that Chen was a good magistrate.	
100	Yin Lu			
101	Yawen Chen			
102	Longjun Wu			
103	Dr. Bojun Song		Corruption in the judiciary negatively affects the implementation of the principles of fair trial and erodes the rule of law	
104	Wenping Feng			
105	Scott Li			
106	Jack Zhang			
107	Meiyun Lin		I have concerns about Chen's judicial philosophy	
108	PAUL		I read a litigant 's complaint against Chen, I have concerns about Chen's integrity.	
109	Lucy Liang			
110	Beverly Wong			
111	Robert Lackman	hubaoqingdao@	Proverbs 18:5 It is not good to be partial to the wicked or to deprive the inocent of justice	

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
112	Qiling Yang			
113	Tao Zhao		I am a Chinese American. I oppose the Nomination of Chen becaue we need justice.	
114	Robert Bensley	brilliantvideo@g	Keep him out	Boston M
115	TAMARA			
116	Chunbo Zhang		Distrot the records and bully a small compmny, Chen's integrity is questioned.	
117	Ying Zhang			
118	Xiaohua Shih			
119	Guo, Hongying			
120	Yang He			
121	Yong Ping			
122	Eric Zhou		Based on the errors made by Chen in the cases of 2006, I oppose the Nomination of Chen.	
123	Joy Zhao		Chen?s judicial philosohpy raises serious concerns on whether he can be true to do equal right to the poor and to the rich.	
124	Chi Zhang		I oppose Chen's nomination and confirmation.	
125	Ye Chen			
126	Wenke Wang			
127	Jin Lin			
128	Tao Li		No to Chen, He can not do equal right to all based on the Netbula v. Symantec case	
129	Xinglian Zhao		Chen?s contortionist jurisprudence make me sick	
130	Andrew Xia			
131	Yiming			
132	Michael			
133	Andrew Lee		I oppose the nomination of Edward Chen because he made a biased judgement toward a small company. How can I trust him in any other cases?	
134	Penny Woo		Judge of the U.S. District Court should be a person who can constantly exercise objective judgement.	
135	Aljerin Butler, Jr	albutlerjr@hotm	It does happen some time.	Framingh
136	Lisa Wu		Chen is not good as a magistrate, how can he become a District Judge ?	California
137	Peter Wong		Chen made clear errors in the case Netbula v. Symantec because he was able to abuse the doctrine of judicial immunity.	CA

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
138	Qiang Wei			
139	Qing He		Look at the case Netbula v. Symantec, I cannot trust him in any other cases.	
140	Kai Li			
141	Tianming Lu			
142	Yiang Yu			
143	Pingyiang			
144	Yuming Lu			
145	Bo Wen			
146	Liping Yang		Keep Chen out !	
147	Li Yue		Chen's ruling in the Netbula v. Symantec litigation, Chen is not good Judge.	
148	Xing Li		I oppose the nomination of Chen	
149	Qiling Li			
150	Andy Liu		I don't want to pay my tax money to Chen because he has manifested bias.	
151	Ping Zhu		This system is full of flaws and lians, how could we expect to get a qualified judge from the liars?	
152	Bob Shieh			
153	Stella Lin			
154	Lisa Chhi			
155	Larry Fell			
156	Marilyn Nakamura		Keep Chen out of our courtrooms!	
157	Brandon Gupta			
158	Rose Zhang			
159	Mason Li			
160	Sasha Karrach			
161	barry liu			
162	Carrie Sok			
163	Zihao Wu			
164	ray ip			
165	Ramya Syed		what an awful man	
166	Dan Pasahan			
167	Lawson Gabtuck			
168	Michael He			
169	Maria Kotak			
170	Shuzo Yamagami			
171	Meiling Poon		I can't believe he's even a judge	

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
172	Sihong Chen		I cannot blindly support Chen because he is Chinese.	
173	Fang Liu			
174	Lanfang He		Based on Chen's ruling in the Netbula v. Symantec, I and my family oppose the nomination of Chen.	
175	adolph rubio		I DON'T THINK HE'S THE RIGHT MAN	
176	Ari Cohn	acohn@majicon	hello	1514 Alta
177	AGBA Leon		an	
178	Liang Feng	yli01776@gmai	Keep him out.	Massachu
179	Jing Fei Zhu	yli01776@gmai	Say no to Chen	
180	Lily Fan			
181	Fengmei Yu			
182	Jack Chen			
183	Qiming Li			
184	Cindy Liu		Chen is actually purposely ruling on behalf of parties with money and power, thereby eliminating the rights of all citizens	San jose,
185	Wen Zhao		Chen is not a right man	
186	Xiangling			
187	Bin Yang		We are concerned about basic human rights violated by this corrupt judge.	
188	Ying Liu			
189	Wenhua Zhu			
190	Wang, Jun		Don't let Chen to manipulate his status as a minority to appear as though he is furthering civil rights,	California
191	LiKai Wang			
192	Andrew Liqun Li		Oppose someone with a trace recorde like Mr Chen's to be on the federal bench	
193	Benton Bain		Oppose the Nomination of Edward M. Chen to Federal Bench	

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PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
194	Bill E.		not a supporter of President Obama, or of the current majority party in Congress. But I can see nothing in the information provided here which shows bias or shows this person is in any way unfit for a judicial appointment. Obviously any court case involves a dispute as to the facts, and a judge has to make a decision to place more weight on one set of evidence than the other. I know nothing about this judge and nothing about this court case other that what I have read here, but from what I can gather, this petition is being organized by people who may be connected with the loosing side in this particular court case. That is no reason to disqualify someone from a judicial appointment.	
195	Doyle F. Harrell		Any judge should represent all parties equally. Obviously this is not the case with Mr, Chen.	
196	Doyle F. Harrell		Any judge should represent all parties equally. Obviously this is not the case with Mr, Chen.	
197	Darlene Crawford		Please watch who gets on the bench. We are depending on you.	
198	Darlene Crawford		Please watch who gets on the bench. We are depending on you.	
199	Arthur Gnaegy		No way this should go through at all	7399 club
200	Debbie Diefenderfer		No way this should happen	
201	Dalene Cornelia		Say "NO" to Chen	
202	Debra Biffert	biff@pop.ctctel.c	I oppose Ed Chen's nomination to Federal Bench	
203	Xukai Li		I oppose the nomination of Chen after reading a litigant's complaint against Chen's misconducts.	Redwood,
204	Gaiwen Shih			
205	Edmund Gruebele		I Oppose the attached petition.....	
206	Peter Huang		The improper practices by Chen in Federal District Court highlight problems in the judicial system, which need to be changed. The absolute immunity is required for the benefit of the public, not for the protection of malicious or corrupt judges.	
207	Fang Lin		I Oppose the Nomination of Chen	
208	bill dillon		yet another non transparent	
209	Dayne Penney		Please oppose this nomination	

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623451.201

PETITION SIGNATUES www.petitiononline.com/emc_bad/

Numbe	Name	Email	Comments	Address
210	**Christine Chang**		I "OPPOSE" the nomination of Chen to Federal Bench because my own painful experience of Chen's extremely bias and prejudice judgments against plaintiffs despite mounting evidence of disabled plaintiffs who are injured tremendously by the defendants. I "OPPOSE" the nomination of Chen who disallowed plaintiffs taking discovery then abruptly judged against plaintiffs without reinstating discovery helping the defendants take advantage of plaintiffs who are lay persons. I "OPPOSE" the nomination of Chen who is extremely bias and prejudice against plaintiffs and could not uphold law and U.S. Constitution.	
211	**Doris Ulrich**		Please remove Chen	
212	**David Colacchio**		Truth and Justice	
213	**Carl Grula**		Opposed	Lansdale
214	**Bill Sparks**	bsparks@sparks	Do not vote for E.M. Chen to Federal Bench	
215	**Debbie Darnold**		Not a good choice	Hannibal
216	**Colin Nicholas**	colin.coac@gma	we need judges of integirty and honesty	
217	**Barbara Williamson**		oppose Judge Chen	

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JAPANESE AMERICAN CITIZENS LEAGUE
1828 L Street, NW • Suite 802 • Washington, DC • 20036
Ph: (202) 223-1240 • Fax: (202) 296-8082 • E-mail: dc@jacl.org

September 11, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510

Re: Federal Judicial Nominations of Jacqueline H. Nguyen (C.D. Cal.), Edward M. Chen (N.D. Cal.), and Dolly M. Gee (C.D. Cal.)

Dear Chairman Leahy and Ranking Member Sessions:

The Japanese American Citizens League (JACL) is the oldest and largest Asian American civil rights organization in the United States. JACL monitors and responds to issues that enhance or threaten the civil and human rights of all Americans and implements strategies to effect positive social change, particularly in the Asian Pacific American community. Through our extensive member network and relationships with various civil rights organizations, we strive to promote a world that honors diversity by respecting the values of fairness, equality and social justice. Consistent with our mission, we endorse the recent nominations of Judge Edward M. Chen, Ms. Dolly M. Gee, and Judge Jacqueline H. Nguyen and would applaud their prompt confirmation. These individuals are tremendously qualified and their many contributions to the community have gone far to advance JACL's vision. The confirmation of these judicial nominees would help our federal judicial system draw on the unique, yet underrepresented, abilities of our nation's rich Asian American community.

Judge Edward M. Chen is a well-respected federal magistrate judge in the Bay Area and has served in that position for over eight years. In this capacity he has presided over numerous criminal and civil cases, and has authored over three hundred published opinions. Judge Chen is an active leader in his community. JACL particularly applauds and appreciates Judge Chen's work on the legal team that successfully overturned – in a *coram nobis* case – Fred Korematsu's

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World War II conviction for failing to comply with the Japanese internment order. This case revealed that the alleged evidence justifying the Japanese internment order was fabricated or exaggerated to a great extent. It went far to restoring the dignity of Japanese Americans and the faith of all Americans who revere human and civil rights. We respect Judge Chen's record of public service, professional achievement, and continued quest for justice. It is particularly astounding given the Bay Area's substantial Asian American population that, if confirmed, Judge Chen would be the first Asian American Article III judge to serve there. He deserves our strongest endorsement.

Judge Jacqueline H. Nguyen is a judge with the Los Angeles County Superior Court. She was appointed in August 2002 and is the first Vietnamese American woman to serve as a judge in California. If confirmed, Judge Nguyen would become the first Vietnamese American Article III judge in the history of the United States. Prior to her appointment, Judge Nguyen served as an Assistant United States Attorney with the Criminal Division of the United States Attorney's Office where she was the Deputy Chief of the General Crimes Section. She also served on the Organized Crimes Strike Force, and the Public Corruption and Government Fraud Section while at the United States Attorney's Office. Judge Nguyen is extremely active in the community and has been recognized for her many achievements. We are especially impressed by her role as a leader in the Asian American legal community and we are confident that she will serve as an excellent district court judge. Judge Nguyen deserves our strongest endorsement.

Ms. Dolly M. Gee is a partner with Schwartz, Steinsapir, Dohrmann & Sommers LLP. She specializes in labor and employment law and has extensive experience in federal and state court litigation. Ms. Gee also has substantial experience as a neutral mediator and arbitrator. She served on the Federal Service Impasse Panel where she mediated and arbitrated impasses between federal agencies and federal sector labor unions. She has also served as a court-appointed independent election monitor for delegate elections of 27 International Brotherhood of Teamsters local unions in California, Nevada, and Hawaii. In this position, Ms. Gee investigated and recommended dispositions of election protests relating to alleged violations of election rules. Ms. Gee's reputation for fairness and professionalism in these quasi-judicial roles is well deserved. She has also used these skills to serve as a respected leader in her community. In the early 1990s following the racial strife and violence in Los Angeles, Ms. Gee's pro bono activities promoted racial tolerance and aided those harmed by violence. Her continued leadership on community issues and excellence as attorney has been widely recognized by various commendations and awards. We appreciate her dedication and character and we are confident that she will serve as an outstanding district court judge. Ms. Gee deserves our strongest endorsement.

After measuring their professional accomplishments, qualifications, and character, it is our pleasure to endorse Judge Jacqueline H. Nguyen, Ms. Dolly M. Gee, and Judge Edward M. Chen for confirmation as federal district court judges. Each individual we endorse here has made a special contribution to their communities, both locally and nationally. The confirmation of these individuals would add highly qualified jurists to the federal bench who bring ideas, views, and experiences that are inadequately represented among our Article III judges today. Accordingly, the Japanese American Citizens League proudly endorses and urges for the speedy confirmations of Judge Jacqueline H. Nguyen and Ms. Dolly M. Gee for the United States District

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Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California.

Sincerely,

S. Floyd Mori
National Director

[redacted]

[redacted]



KARDON LAW, INC.

FORMER FEDERAL PROSECUTOR | CRIMINAL DEFENSE

We Take Justice Personally

September 15, 2009

Via Facsimile and Regular Mail

Honorable Patrick J. Leahy
United States Senate
Chairman, Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Honorable Jeff Sessions
United States Senate
Ranking Member, Committee on the Judiciary
224 Dirksen Senate Office Building
Washington, DC 20510

Re: The Honorable Jacqueline H. Nguyen

Dear Chairman Leahy and Ranking Member Sessions:

It is with great honor that I am submitting this letter in support of The Honorable Jacqueline H. Nguyen for confirmation as United States District Judge for the United States District Court for the Central District of California. I have known Judge Nguyen for 21 years, from the time we began our legal studies at the University of California, Los Angeles. After graduating from law school, we both spent three years in private practice and then met up again at the United States Attorney's Office (USAO) in Los Angeles, where Judge Nguyen remained for eight years. Judge Nguyen was highly respected at the USAO, both as a trial attorney and as a supervisor. She is incredibly smart, hard-working, efficient and well-reasoned in her decision-making. Most importantly, she displays the utmost integrity at all times. She is calm, thoughtful and respectful of others. She is the definition of "power" versus "force." She leads by example, not with a iron fist.

In trial practice, one often hears from colleagues that a Judge is "prosecution-oriented" or "defense-oriented." While I have not appeared before Judge Nguyen since I became a criminal defense attorney, I can tell you assuredly what her reputation is in the legal community. Judge Nguyen is known not to favor either side. She is beloved by the prosecutors and the defense alike.

[redacted]

[redacted]

What is said is that "Judge Nguyen is smart," "Judge Nguyen is thoughtful," and "Judge Nguyen respectfully listens to the arguments on both sides and is fair." That is completely in line with what I have known of Judge Nguyen for over two decades, and is precisely what we need on the federal bench.

I urge that the Committee conduct a speedy confirmation of Judge Nguyen, for the benefit of all in the Central District of California.

Sincerely,

KARDON LAW, INC.

NANCY KARDON

cc: Hon. Dianne Feinstein
Gregory Craig, Esq., White House Counsel

[redacted]

http://judiciary.authoring.senate.gov/hearings/testimony.cfm

United States Senate Committee on the Judiciary

< Return To Hearing

Statement of

The Honorable Patrick Leahy

United States Senator
Vermont
September 23, 2009

Statement Of Senator Patrick Leahy (D-Vt.),
Chairman, Senate Judiciary Committee,
Hearing On Judicial Nominations
September 23, 2009

Today, we will hear from four nominees for lifetime appointments to the Federal bench in California and it is appropriate that the hearing be chaired by Senator Feinstein. I thank Senator Feinstein and Boxer for their strong support of these nominations.

This is an historic hearing and an historic day. This is the first time that three Asian Pacific American nominees have appeared before the Committee at the same time. Indeed, three Asian Pacific American judicial nominees have never been confirmed in the same year. Of the approximately 875 judges on the Federal bench, only eight are Asian Pacific American. That is less than one percent. The progress we make today is long overdue.

I am glad that President Obama is following through on his commitment to nominate men and women to the Federal bench who reflect the diversity of America. Diversity on the bench helps ensure that the words "equal justice under law," inscribed in Vermont marble over the entrance to the Supreme Court, are a reality, and that justice is rendered fairly and impartially. With his nominations the President took a major step forward and with today's hearing, we are moving closer to that crucial goal. Today is an important milestone not only for the Asian Pacific American community, but for all Americans.

Judge Jacqueline Nguyen and Dolly Gee have been nominated to the district court for the Central District of California. If confirmed, these outstanding nominees will be the first Asian Pacific American women to serve as district court judges in the State of California. Judge Nguyen will become the first Vietnamese American district court judge in the United States, and Ms. Gee will be the first female Chinese American district court judge in the Nation. More than 10 years after her first nomination to the Central District of California in May 1999, I am pleased that Ms. Gee finally will receive a hearing before this Committee.

President Obama has also nominated Judge Edward Chen to serve as district court judge for the Northern District of California. If he is confirmed, he will become the first Asian Pacific American district court judge in the 150- year history of the Northern District of California. Judge Chen is already the first Asian Pacific American to serve in that district as a magistrate judge.

Today we will also hear from Judge Richard Seeborg, another Northern District of California magistrate judge, whose excellent work makes him a qualified nominee.

All of the nominees before the Committee today are qualified for these important responsibilities. The California Senators who recommended them know this to be true as does the President who nominated them. The American Bar Association's Standing Committee on the Federal Judiciary has rated them all as qualified, and three of them unanimously as "well qualified," their highest rating.

I want to thank the Committee's Ranking Member, Senator Sessions, for his cooperation in scheduling and preparing for this hearing. I have accommodated the Ranking Member and the Republican members of the Committee by holding confirmation hearings no more frequently than every two weeks. I look forward to working with them to continue our consideration of judicial nominations steadily, so that we can fill vacancies and ensure that justice is not delayed, or denied, to any American because of over burdened courts.

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I hope our progress in the Committee will soon be mirrored in the Senate. Over the past few months, we have seen an unprecedented delay in the consideration of qualified and noncontroversial nominations. We have had to overcome filibusters and spend months seeking time agreements in order to move nominations which, in the past, were regularly considered without delay.

I am concerned that the action of the Republican leadership signals an intent to return to the practices of the 1990s that more than doubled circuit court vacancies and led to the pocket filibuster of more than 60 of President Clinton's nominees. The crisis they created led to public criticism of their actions by Chief Justice Rehnquist during those years.

I hope that instead of withholding consents and threatening filibusters of President Obama's judicial nominees both sides of the aisle will join together to treat the nominees of President Obama fairly. I made sure that we treated President Bush's nominees more fairly than President Clinton's nominees had been treated. In the 17 months that I served as chairman of this Committee during President Bush's first term, the Senate confirmed 100 of his judicial nominations. By this time in President Bush's first term we had confirmed six of his nominations to federal circuit and district courts. Nine months into President Obama's first term, the Senate has confirmed only one of his lower court nominees, despite the fact that President Obama made his first nomination nearly two months earlier than did President Bush. We can do better. The American people deserve better.

After months of delay, the Senate last week finally confirmed Judge Gerard Lynch to serve on the Second Circuit. Despite the fact that Judge Lynch's nomination was noncontroversial, despite the fact that it was reported out of Committee unanimously and with glowing words from Ranking Member Sessions, it still took more than three months after his nomination was reported by this Committee for the Senate to confirm him. When we finally voted, we confirmed Judge Lynch by an overwhelming vote of 94 to three. There was simply no reason for that kind of delay.

Nine nominations reported by the Judiciary Committee remain pending on the Senate's Executive Calendar, seven of them from before the last recess. Five of the stalled nominees – Dawn Johnsen to be the Assistant Attorney General for the Office of Legal Counsel, Judge William K. Sessions to chair the U.S. Sentencing Commission, Tom Perez to be the Assistant Attorney General for the Civil Rights Division, Mary Smith to be the Assistant Attorney General for the Tax Division, and Christopher Schroeder to be the Assistant Attorney General for the Office of Legal Policy – should be confirmed without further delay to fill important positions in Executive Branch. Despite the fact that this Committee reported some of these nominations as long as six months ago, they have yet to receive a vote on the Senate floor.
Judicial nominations have not fared any better. President Obama made his first judicial nomination in March when he chose David Hamilton for the Seventh Circuit. The nomination has been on the Executive Calendar since early June, despite the support of the most senior of Senate Republicans, Senator Lugar. The nomination of Judge Andre Davis to the Fourth Circuit was reported by the committee on June 4 by a vote of 16 to three but has yet to receive Senate consideration.

It is imperative that we move quickly to fill the growing number of vacancies throughout the Federal courts. There are currently 94 vacant seats on the Federal bench, including 20 on the circuit courts. In addition, 26 future vacancies have already been announced. That means that Federal judicial vacancies will soon number 120 unless we begin to move judicial nominations in regular order. I urge President Obama to send qualified nominees to the Senate as quickly as possible so that we can begin to address this alarming spike in vacancies. And I urge Republican Senators to work with us to confirm qualified nominees without unnecessary delay.

I am pleased to welcome the nominees and their families to the Committee today, and I look forward to considering these nominations.

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September 11, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510

Re: Magistrate Edward Chen for U.S. Federal Judge

Dear Senators Leahy and Sessions,

I strongly recommend to you the confirmation of Magistrate Edward Chen for appointment to Judge of the U.S. District Court, Northern District of California. I have known Ed Chen and his family for more than 30 years. As a U.S. Magistrate for the past eight years, Ed Chen has demonstrated outstanding judicial skills, fairness in his rulings and in the administration of justice. He is courteous, polite, and has a wonderful judicial temperament. He would be an outstanding federal judge.

I am a former Presiding Justice of the California Court of Appeal (1983 to 1992), the former California Insurance Commissioner (2000-2003) and am now a Mediator, Arbitrator, and Special Master with JAMS.

After graduating from UC Berkeley Law School (Boalt Hall) in 1979, Ed Chen clerked for Judge Charles Renfrew and Chief Judge James Browning. He then worked for the Bill Coblentz's law firm handling a variety of civil and criminal cases. He worked for the ACLU

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Legal Counsel principally handling cases protecting minority citizens, advising immigrants and advocating for civil rights for a diverse clientele.

I have worked with Ed Chen in a variety of community civic activities in the Bay Area. He is active in the Asian Bar Association, the Academy of Science, the Asian Art Museum and numerous school programs, principally to help children with disabilities. I knew his father and mother who also were generous with their time and resources for the community. Ed has also published many articles and lectured with legal groups on civil rights, privacy, labor and immigration issues.

Ed has an excellent, well-earned reputation as a U.S. Magistrate. He is bright, works hard, is collegial, and is very fair with the public he serves. I urge you to confirm him for U.S. District Judge.

Kindly give Ed Chen your favorable consideration for U.S. District Judge. I would be happy to elaborate further if you wish.

Respectfully yours,

Harry W. Low

Justice Harry W. Low (Retired)

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JAMS

THE RESOLUTION EXPERTS®



Hon. Harry W. Low (Ret.) has over 35 years of dispute resolution experience as a sitting judge and JAMS neutral. Justice Low's expertise includes employment law, business litigation, sexual harassment, insurance disputes, personal injury, real or personal property disputes, and environmental law. Justice Low has 25 years of judicial experience in civil, criminal, and government law and has authored opinions on virtually every area of California law.

ADR Experience and Qualifications

- Conducted a wide variety of mediations, arbitrations, and settlement conferences since joining JAMS in 1992
- Conducted fact finding studies and written reports for institutions and agencies
- Extensive experience in handling wrongful termination, sexual harassment, breach of contract, insurance coverage issues, tort claims, and medical and legal malpractice cases
- Highly experienced in handling discovery disputes assisting lawyers in appellate matters, and mediating successfully many pending appellate cases.
- Special Master in a number of complex cases, including a major toxic pollution dispute
- Trustee for insolvent insurer

Representative Matters

- Mediated employment disputes involving sexual harassment, wrongful termination, discrimination, and enforcement of settlement
- Mediated insurance coverage cases involving construction costs, business ventures, and tort coverage
- Successfully mediated civil rights cases involving privacy issues and allegations of racial discrimination by a major restaurant chain; civil rights disputes with government agencies and commercial businesses
- Mediated real estate disputes involving land use issues, brokers duties, property partitions, and co-owner disputes
- Arbitrated allocation of clean-up costs from leaking storage tanks at sites nationwide; arbitrated Proposition 65 food and medical products
- Arbitrated international telecommunications dispute, health insurance disputes, business and property disputes
- Successfully mediated insurance equitable contribution indemnification among 32 insurance companies

Honors, Memberships, and Professional Activities

- BAJI Committee Member, 2003-Present
- Spirit of Excellence Award, American Bar Association, 2002
- Judge Lowell Jensen Public Service Award, Boalt Hall School of Law, UC Berkeley, 2000
- Distinguished Alumni Award for extraordinary contributions to the legal profession, Boalt Hall Alumni Association, UC Berkeley, 1993
- President, San Francisco Human Rights Commission, 1999-2000
- President, San Francisco Police Commission, 1992-1996
- National President, Appellate Judge Conference of the American Bar, 1991
- National President, Chinese-American Citizens Alliance, 1981-1991
- President, California Judges Association, 1978-1979
- Board member, Center for Judicial Education and Research

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- California Judicial Council
- President, Center for Pacific Rim at the University of San Francisco
- Founding Chairman of the Board, The Chinese American International School
- Lectured extensively throughout the United States, Asia, and Europe

Background and Education

- Insurance Commissioner, State of California Department of Insurance, 2000-January 2003
- Presiding Justice, California Court of Appeal, 1983-1992
- Judge, San Francisco County Superior Court, 1974-1983
- Judge, San Francisco Municipal Court, 1967-1974
- Commissioner, Worker's Compensation Appeals Board
- Deputy Attorney General for California in the Civil and Tax Division
- J.D., Boalt Hall School of Law, University of California, Berkeley
- B.A., University of California, Berkeley

References Available Upon Request

[redacted]



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Fax: 916.443.1541

September 22, 2009

The Honorable Patrick Leahy, Chairman
Committee on the Judiciary
United States Senate
Washington, DC 20510

The Honorable Jeff Sessions, Ranking Member
Committee on the Judiciary
United States Senate
Washington, DC 20510

RE: Judicial Nomination of Edward M. Chen

Dear Chairman Leahy and Ranking Member Sessions:

It is with great admiration that the Mexican American Legal Defense and Educational Fund (MALDEF) endorses the nomination of U.S. Magistrate Judge Edward M. Chen as a federal district judge to the U.S. District Court for the District of Northern California.

In 2001, Judge Chen was the first Asian American magistrate judge appointed to California's Northern District and, once confirmed, he will be the first Asian American district court judge appointed to the Northern District bench. However, these are not the only milestones that mark Judge Chen's legal career.

Judge Chen is a graduate of the UC Berkeley School of Law where he became a member of the esteemed honor society, the Order of the Coif, and served on the California Law Review. After law school, he worked as a judicial law clerk in both the federal district and circuit courts. He excelled as a litigator in private practice, as a public interest lawyer at the ACLU, and as a member of the legal team that was successful in overturning the conviction of Fred Korematsu in *Korematsu v. U.S.*, the World War II Japanese internment case. I have personally had the opportunity to co-counsel a significant case with Judge Chen before his appointment as magistrate judge. He is worthy of all the respect and accolades he has received.

Judge Chen is respected and admired by his colleagues on the bench, as well as by the lawyers who appear before him, for his commitment to fairness and his superior judicial temperament. Known for his dedication to public service and mentoring,

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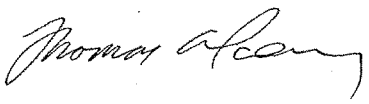
he enthusiastically shares his passion for the law and legal profession with many aspiring law students and new lawyers.

Judge Chen possesses a judicial record illustrative of his adherence to the rule of law. He has earned the endorsement of federal prosecutors and police associations as well as many civic and legal organizations. The American Bar Association has also rated Judge Chen "unanimously well-qualified" to join the federal district court ranks. He is the recipient of numerous awards and has published several articles on civil rights.

For these reasons, MALDEF proudly supports Judge Chen's candidacy and urges the members of the Senate Judiciary Committee to report his nomination to the full Senate without delay.

Sincerely,



Thomas A. Saenz
President and General Counsel

THS:cmk

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representative to the Ninth Circuit Judicial Conference and was a member of the Ninth Circuit Advisory Board.

As a result of her many pro bono efforts, Ms. Gee has received public service awards and commendations from the City of Los Angeles, the City of Monterey Park, the Los Angeles Human Relations Commission, the Office of the California Secretary of State, the Office of the Los Angeles City Attorney, the State Bar of California, and the Asian Pacific American Bar Association of Los Angeles County. Ms. Gee received NAPABA's Trailblazer Award in 2001. Since 2004, she has been named each year as a "Southern California Super Lawyer" by *Los Angeles Magazine*.

Based on their qualifications, professional achievements, and commitment to public service, Judge Jacqueline H. Nguyen, Judge Edward M. Chen, and Dolly M. Gee would make immediate contributions as federal district court judges. Each nominee has significant professional accomplishments that demonstrate his or her fitness for the bench. Moreover, each nominee brings a unique personal life story that would inspire all Americans. In light of the exceedingly low number of Asian Pacific American federal judges nationwide, the addition of all three individuals to the federal judiciary is important to NAPABA. Accordingly, the National Asian Pacific American Bar Association proudly endorses and urges the speedy confirmations of Judge Jacqueline H. Nguyen and Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California.

Sincerely,

Andrew T. Hahn, Sr.
President

Tina R. Matsuoka
Executive Director

John C. Yang
Co-Chair, Judiciary Committee

Wendy Wen Yun Chang
Co-Chair, Judiciary Committee

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NATIONAL ASIAN PACIFIC AMERICAN BAR ASSOCIATION

September 8, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510

Re: Federal Judicial Nominations of Jacqueline H. Nguyen (C.D. Cal.), Edward M. Chen (N.D. Cal.), and Dolly M. Gee (C.D. Cal.)

Dear Chairman Leahy and Ranking Member Sessions:

On behalf of the National Asian Pacific American Bar Association ("NAPABA"), we strongly endorse and urge the prompt confirmation of Judge Jacqueline H. Nguyen and Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California. Each of these applicants has the experience, intellectual capacity, and judicial temperament to be excellent United States District Court judges. This is the first time in history that three Asian Pacific American judicial candidates have been before this Committee at the same time. All three have support from a wide range of local groups and individuals. Each candidate also independently has the strong backing of the Asian Pacific American community nationally. Among other things, each of these nominees has received NAPABA's Trailblazer Award, which is NAPABA's highest award and is bestowed on lawyers whose professional achievements have paved the way for other Asian Pacific American lawyers.

NAPABA is a national bar association representing the interests of Asian Pacific American attorneys, judges, law professors, and law students. Now in its 21st year, NAPABA represents the interests of 60 affiliate organizations and over 40,000 Asian Pacific American attorneys. NAPABA is deeply committed to supporting the appointment of qualified Asian Pacific Americans to the federal bench, where Asian Pacific Americans are woefully underrepresented. The following key facts illustrate the need for greater Asian Pacific American representation in the federal judiciary:

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- Of the approximately 875 federal Article III judges, only 8 are Asian Pacific American – less than 1 percent.
- Only 4 of the over 70 Article III judges serving in California are Asian Pacific American. If the number of Asian Pacific American Article III judges serving in California reflected California's general population, approximately 10 judges would be Asian Pacific American.
- There have only been 2 Asian Pacific American female Article III judges in the history of the United States, neither of whom serves in California.
- There has never been a Vietnamese American to serve as an Article III judge anywhere in the nation – Judge Nguyen would fill that void.
- There has never been a Chinese American female to serve as an Article III judge anywhere in the nation – Ms. Gee would fill that void.
- Although Asian Pacific Americans constitute approximately 35% of the population in the San Francisco/Greater Bay Area, there has never been an Asian Pacific American Article III judge in this area – Judge Chen would fill that void. The lack of an Asian Pacific American judge in this District is particularly unfortunate, given that many of the most infamous decisions affecting Asian Pacific Americans – including *United States v. Korematsu*, *Yick Wo v. Hopkins*, and *Lau v. Nichols* – were first rendered by the federal district court in San Francisco.

Judge Jacqueline H. Nguyen is currently a judge with the Los Angeles County Superior Court, where she has served since her appointment in August, 2002 as the first Vietnamese American woman to serve as a judge in California. In addition to her regular duties as a trial court judge, Judge Nguyen is currently the Site Judge for the Alhambra Courthouse. As Site Judge, Judge Nguyen is in charge of the administrative operation of the Alhambra Courthouse, which she accomplishes through close working relationships with the sitting judges, court leadership, law enforcement, and the assigned prosecutors and defenders. Prior to her appointment to the bench, Judge Nguyen worked for many years as an Assistant United States Attorney with the United States Attorney's Office for the Central District of California, ultimately serving as Deputy Chief of the General Crimes Section, after stints with the Organized Crimes Strike Force, and the Public Corruption and Government Fraud Section. Judge Nguyen is perhaps best known for her ground breaking anti-terrorism prosecution in the "Operation Eastern Approach" case of *United States v. Tabatabai*, the first successful prosecution in the United States for providing material support and resources to a designated foreign terrorist organization.

Judge Nguyen has received several awards for her achievements. These awards include the Federal Law Enforcement Officers Association's Contribution to the Field of Law Enforcement Award (2002), several commendation and achievement awards from the Department of Justice, the Federal Bureau of Investigation, and the State Department, NAPABA's Trailblazer Award (2006), a special recognition award from the Asian Pacific American Legal Center (2002), and the Alumni Award from Occidental College.

Judge Nguyen has demonstrated a lifelong commitment to the community. She was a volunteer Pro Bono attorney with Public Counsel's foster adoption project. She was a founding member of the Asian Pacific American Bar Association of Los Angeles, eventually serving as its president. She has served as a board member of the Women Lawyers Association of Los Angeles, a

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board member of the Japanese American Bar Association, and a member of the Asian Concerns Committee.

Judge Nguyen is a testament to both the beauty, and the promise, of the American Dream. Judge Nguyen escaped the fall of South Vietnam with her family in a harrowing trip, starting with a terrifying toss over a fence, to a plane ride filled wall to wall with people, temporary separation from her father, through a chaotic Saigon, to the Philippines, to Guam, and eventually, to Camp Pendleton, California. Having been born into a life of privilege, then to lose it all to the chaos of war, Judge Nguyen embraced her new life in America with grace, fortitude, determination, and cheerful modesty, assisting her mother in cleaning dental offices growing up, eventually earning a scholarship to Occidental College, and then later, UCLA School of Law, continuing all the while to help her mother in the family donut shop on the weekends. A story that could be crushing to many, Judge Nguyen's strength of character and determination shines. She brings a deep diverse experience, both professional and personal, that would serve her well as a United States District Court Judge.

Judge Edward M. Chen is a well-respected jurist with a history of service in the Bay Area, not only as a judge but as an attorney and community volunteer. He has served as a United States Magistrate Judge for the Northern District of California for over eight years, where he has presided over numerous civil and criminal trials by jury and bench. He has adjudicated scores of cases by motion, and is the author of over 300 published opinions and orders covering a wide range of subject matters. He therefore already has the experience of running a federal district court docket, and would be poised to contribute immediately in the Northern District. Prior to his appointment as a magistrate judge, Judge Chen served as a staff attorney for the American Civil Liberties Union, as a litigation associate at Coblentz Patch Duffy & Bass, and as a law clerk for the Honorable Charles B. Renfrew, former Judge for the United States District Court for the Northern District of California, and James R. Browning, then Chief Judge of the United States Court of Appeals for the Ninth Circuit.

Judge Chen has demonstrated a commitment to public service and the legal community throughout his career. Most notably, Judge Chen was on the legal team representing Fred Korematsu that successfully overturned – in a *coram nobis* case – his World War II conviction for failing to comply with the Japanese internment order. Judge Chen's confirmation as an Article III judge on the same court that initially convicted Mr. Korematsu would represent a symbolic arc of history that affirms the strength of the American justice system. But Judge Chen's community service has not been limited to this one case. He has served on the board of directors of the Asian American Bar Association of the Greater Bay Area, the Chinatown Community Development Corporation, and the Middlebridge School, which serves children with learning disabilities. Judge Chen also chaired the Marin Montessori School's diversity committee.

Judge Chen has been a longstanding leader in the legal community generally in the Bay Area and the Asian Pacific American community specifically. Judge Chen was voted Judge of the Year in 2007 by the Barristers Club of San Francisco and has been ranked "exceptionally well qualified" by the Bar Association of San Francisco. Among the awards and recognitions that he has received are NAPABA's Trailblazer Award in 2001, the Building Bridges Lifetime Achievement Award from the Bay Area Asian Pacific American Law Students Association Conference, the Joe Morozumi Exceptional Legal Advocacy Award from the Asian American Bar Association of the Greater Bay Area, and the Minority Bar Coalition Unity Award. He was recently re-appointed to a second term by the district judges of his court.

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Judge Chen overcame adversity at a young age and understands the challenges faced by many families. Judge Chen's father emigrated from China as a merchant in the 1920s and his mother immigrated to Texas in the late 1930s during the Sino-Japanese war. Judge Chen was born and raised in racially diverse Oakland, California. When Judge Chen was 9 years old, his father suffered a stroke and slipped into a coma for 3 ½ years before passing away. His mother was left to care for Judge Chen and his three older brothers and also to take over the family import business started by his father, a business that Judge Chen helped to run when he became an adult. Judge Chen understands family challenges even now. He is the parent of a child who is severely developmentally disabled and another with learning disabilities. All of these experiences – as a judge, a community advocate, a small business owner, the son of immigrants, and as a father – combine to make Judge Chen a well-rounded nominee who will always seek to ensure just results for all litigants.

Dolly M. Gee is a managing partner with Schwartz, Steinsapir, Dohrmann & Sommers LLP, where she specializes in labor and employment law. She has extensive experience in federal and state court litigation involving all aspects of labor and employment law, representing both plaintiffs and defendants. Although Ms. Gee has not served as a judge before, she has a substantial amount of quasi-judicial experience. From 1994 to 1999, Ms. Gee served as a member of the Federal Service Impasses Panel, where she mediated and arbitrated numerous disputes and participated in hundreds of summary dispositions of impasses between federal agencies and federal sector labor unions. She is an arbitrator for the Kaiser Permanente Independent Arbitration System, in which she arbitrates medical negligence claims. During the 1995-96, 1999-2000, and 2005-06 International Brotherhood of Teamsters Delegate and Officer Elections, Ms. Gee served as an independent election monitor under the auspices of the Office of the Election Officer, established under the supervision of the Honorable David N. Edelstein, U.S. District Judge for the Southern District of New York. In that capacity, she investigated and recommended dispositions for hundreds of election protests relating to alleged violations of election rules. During law school, Ms. Gee was an extern for the Honorable Allen E. Broussard of the California Supreme Court. After law school, she was a law clerk for the Honorable Milton L. Schwartz, U.S. District Judge for the Eastern District of California.

Ms. Gee also serves as a role model for all lawyers, and especially Asian Pacific American and female lawyers. Ms. Gee's parents emigrated from small farming villages in Toisan, China and she grew up in a predominantly African American community near South Central Los Angeles. Her father served in the U.S. Navy during WWII and was among the first wave of Chinese American aerospace engineers who worked on the Space Shuttle and Apollo space missions for North American Aviation and later Rockwell International. Her mother was a garment worker whose experiences inspired Ms. Gee to go into the field of labor and employment law.

Ms. Gee's bar association and public service activities reflect her commitment to fostering racial harmony and understanding, and promoting tolerance in Los Angeles, a diverse city which has seen its share of racial conflict and violence. She is a former Trustee of the Los Angeles County Bar Association. She is a past president of the Southern California Chinese Lawyers Association and a founder and advisory board member of the Asian Pacific American Bar Association of Los Angeles County. She has served as a board member of the Western Center on Law & Poverty, the California Women's Law Center, and the Asian Pacific American Legal Center of Southern California. She was a member of the State Bar of California's Judicial Nominees Evaluation Commission, where she evaluated candidates for state judicial positions. She also has served as a Central District lawyer

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NATIONAL ASIAN PACIFIC AMERICAN BAR ASSOCIATION

September 18, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

Re: Federal Judicial Nominations of Jacqueline H. Nguyen (C.D. Cal.), Edward M. Chen (N.D. Cal.), and Dolly M. Gee (C.D. Cal.)

Dear Chairman Leahy:

On behalf of the National Asian Pacific American Bar Association ("NAPABA") and the Asian American Justice Center ("AAJC"), we would like to submit for the Committee's consideration and for the record the attached written testimony in support of the confirmations of Judge Jacqueline H. Nguyen and Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California.

Please feel free to contact us should you have any questions or concerns. We appreciate the Committee's inclusion of this testimony for this historic confirmation hearing.

Sincerely,

Andrew T. Hahn, Sr.
President
National Asian Pacific American Bar Association

Karen K. Narasaki
President & Executive Director
Asian American Justice Center

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TESTIMONY BEFORE THE COMMITTEE ON THE JUDICIARY
UNITED STATES SENATE

FOR THE HEARING ON THE NOMINATIONS OF

EDWARD M. CHEN,
TO BE UNITED STATES DISTRICT JUDGE FOR THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

DOLLY M. GEE,
TO BE UNITED STATES DISTRICT JUDGE FOR THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

JACQUELINE H. NGUYEN,
TO BE UNITED STATES DISTRICT JUDGE FOR THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

SEPTEMBER 23, 2009

BY THE
NATIONAL ASIAN PACIFIC AMERICAN BAR ASSOCIATION
AND
ASIAN AMERICAN JUSTICE CENTER

The National Asian Pacific American Bar Association (NAPABA) and the Asian American Justice Center (AAJC) submit this testimony in strong support of three nominees presented today for confirmation: Edward M. Chen, nominee to be United States District Judge for the United States District Court for the Northern District of California; Dolly M. Gee, nominee to be United States District Judge for the United States District Court for the Central District of California; and Jacqueline H. Nguyen, nominee to be United States District Judge for the Central District of California. Each nominee has excellent credentials to serve as federal district court judges, and each nominee has the strong backing of the Asian Pacific American community nationally.

NAPABA is the national bar association representing the interests of Asian Pacific American attorneys, judges, law professors, and law students. NAPABA represents the interests of over 40,000 attorneys nationally and 60 local Asian Pacific American bar associations. Its members include solo practitioners, large law firm lawyers, corporate counsel, legal service and nonprofit attorneys, judges, and lawyers serving at all levels of government. Through its national network of affiliates and committees, NAPABA provides a strong voice for increased diversity of federal and state judiciaries, advocates for equal opportunity in the workplace,

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seeks to eliminate anti-Asian crime and anti-immigrant sentiment, and promotes professional development of minorities in the legal profession.

AAJC is a national organization dedicated to defending and advancing the civil and human rights of Asian Americans through advocacy, public policy, public education, and litigation, and is the nation's leading expert on issues of particular importance to the Asian American community in the areas of equal rights, anti-Asian violence prevention and race relations, census, health law policy, immigrant rights, immigration, language access, and voting rights. It works closely with its three affiliates – the Asian American Institute in Chicago, the Asian Law Caucus in San Francisco, and the Asian Pacific American Legal Center in Los Angeles – and nearly 100 community partners in 44 cities, 25 states, and the District of Columbia.

NAPABA and AAJC applaud the Judiciary Committee for considering these three candidates promptly, and for considering them together. This is the first time in history that three Asian Pacific American judicial candidates have been before this Committee at the same time. Similarly, never before in history have three Asian Pacific American federal judicial nominees been confirmed in the same year. In the history of the United States, there have been only 17 Asian Pacific American Article III judges.

NAPABA and AAJC also thank Senator Feinstein for her recommendation of Judge Nguyen and Judge Chen, and thank Senator Boxer for her recommendation of Ms. Gee. The organizations also appreciate the confidence that President Obama has demonstrated by nominating them.

The historic significance of this hearing underscores the woeful underrepresentation of Asian Pacific Americans in the federal judiciary. The following key facts illustrate the need for greater representation:

- Of the approximately 875 federal Article III judgeships, only 8 are Asian Pacific American – less than 1 percent. Incredibly, of the approximately 180 active federal appellate court judges, none are Asian Pacific American.
- Only 4 of the over 70 Article III judges serving in California are Asian Pacific American. If the number of Asian Pacific American Article III judges serving in California reflected that state's general population, approximately 10 judges would be Asian Pacific American.
- There have only been 2 Asian Pacific American female Article III judges in the history of the United States, none of whom serve in California. There has never been an Asian Pacific American female federal appellate court judge in the history of the United States. There has never been an Asian Pacific American female federal appellate court judge in the history of the United States.
- There has never been a Vietnamese American to serve as an Article III judge anywhere in the nation.

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- There has never been a Chinese American female to serve as an Article III judge anywhere in the nation.
- Although Asian Pacific Americans constitute approximately 35% of the population in the San Francisco/Greater Bay Area, there has never been an Asian Pacific American Article III judge in this area. The lack of an Asian Pacific American judge in this District is particularly unfortunate, given that many of the most infamous decisions affecting Asian Pacific Americans – including *Yick Wo v. Hopkins*, 118 U.S. 356 (1886), *Korematsu v. United States*, 323 U.S. 214 (1944), and *Lau v. Nichols*, 414 U.S. 563 (1974) – were first rendered by the courts in San Francisco.
- It is also worth noting that only 5 of the 24 active status judge in the Central District of California are women.

Having this historical perspective is noteworthy. Diversity is important because of the results that a diverse judiciary is more likely to produce. A judiciary that more closely resembles the American citizenry is more likely to engender confidence by that citizenry in the justness of the results reached. A judiciary that has diverse perspectives is more likely to ensure that cases are decided fairly, evenly, without predisposition, and with an open mind.

With respect to the Asian Pacific American community, the importance of diverse perspectives within the judiciary can be illustrated by two scenarios that have frequently arisen in courtrooms across America. The first scenario involves the veracity of an Asian Pacific American witness whose credibility is questioned because the witness refuses to look directly at an examiner or a judge. Certainly, the failure to make eye contact could be a sign that a witness is not telling the truth. In many Asian cultures, however, looking down or avoiding eye contact is simply a show of respect or deference to someone who is in a more authoritative position. The second scenario involves an Asian Pacific American witness who seems to be agreeing with every question that a cross-examiner or judge asks him, even though the answers have the effect of impeaching the witness. Again, in this scenario, the witness's apparent willingness to say "yes" may be caused by the witness's culture, where explicit disagreement is a sign of disrespect. If a jurist understands these cultural tendencies, then a jurist might be able to determine whether culture may be affecting perception instead of dismissing that witness as unreliable or non-credible. In this manner, the administration of justice is affected.

Thus, diversity is not necessarily a goal in itself but rather a means to ensuring that a just result is reached. Although certainly judges can be educated about different cultures and how characteristics might manifest themselves in the courtroom, judges also learn every day from each other as a result of conversations in chambers, over lunch, or at judicial conferences. A diverse judiciary will help to ensure that all judges have the benefit of a diversity of perspectives and experiences to allow them to make the most informed decision possible.

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Of course, neither diversity nor the historic significance of these nominations – standing alone – would compel the confirmations of these nominees if they are not otherwise qualified. Rather, all three nominees have the experience, intellectual capacity, integrity, and temperament to serve admirably as U.S. district court judges. Two nominees have proven track records as sitting jurists and the third has substantial quasi-judicial experience. The legal community has strong confidence in all three nominees, as demonstrated by a wide range of bipartisan support from bar organizations, community groups, law enforcement, and individual leaders in the legal community.

Each of the three Asian Pacific American nominees currently before this Committee has the types of experiences that would help to create a better justice system. The individual qualifications and attributes of each nominee will be summarized below.

Judge Edward M. Chen is a well-respected jurist with a history of service in the Bay Area, not only as a judge but as an attorney and community advocate. He has served as a United States Magistrate Judge for the Northern District of California for over eight years, where he has presided over numerous civil and criminal trials by jury and bench. He was recently re-appointed for a second term. Judge Chen has adjudicated scores of cases by motion, and is the author of over 300 published opinions and orders covering a wide range of subject matters. Notwithstanding that large number of published opinions, Judge Chen has been reversed less than 5 times. He therefore already has the experience of running a federal district court docket, and would be poised to contribute immediately in the Northern District. Prior to his appointment as a magistrate judge, Judge Chen served as a staff attorney for the American Civil Liberties Union, as a litigation associate at Coblentz Patch Duffy & Bass, as a law clerk for the Honorable James R. Browning, then Chief Judge of the United States Court of Appeals for the Ninth Circuit, and as a law clerk for the Honorable Charles B. Renfrew, U.S. District Judge for the Northern District of California. Judge Chen served on the *California Law Review* and graduated Order of the Coif from University of California – Berkeley School of Law. He has been unanimously ranked "well qualified" by the American Bar Association.

Judge Chen has demonstrated a commitment to public service and the legal community throughout his career. Most notably, Judge Chen was on the legal team representing Fred Korematsu that successfully overturned – in a *coram nobis* case – his World War II conviction for failing to comply with the Japanese internment order. *Korematsu v. United States*, 584 F. Supp. 1406 (N.D. Cal. 1984). Judge Chen's confirmation as an Article III judge on the same court that initially convicted Mr. Korematsu would represent a symbolic arc of history that affirms the strength of the American justice system. But Judge Chen's community service has not been limited to this one case. He has contributed in numerous ways, including service on the boards of directors of the Asian American Bar Association of the Greater Bay Area, the Chinatown Community Development Corporation, and the Middlebridge School, which serves children with learning disabilities. Judge Chen also chaired the Marin Montessori School's diversity committee.

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Judge Chen has been a longstanding leader in the Bay Area legal community generally and in the Asian Pacific American community specifically. Judge Chen was named Judge of the Year in 2007 by the Barristers Club of San Francisco and has been ranked "exceptionally well qualified" by the Bar Association of San Francisco. Among the awards and recognitions that he has received are: Building Bridges Lifetime Achievement Award, Bay Area Asian Pacific American Law Students Association Conference (2005); Trailblazer Award, NAPABA (2001); Joe Morozumi Exceptional Legal Advocacy Award, Asian American Bar Association of the Greater Bay Area (1998); Unity Award, Minority Bar Coalition (1993).

Judge Chen overcame adversity at a young age and understands the challenges faced by many families. Judge Chen's father emigrated from China as a merchant in the 1920s and his mother immigrated to Texas in the late 1930s during the Sino-Japanese war. Judge Chen was born and raised in racially diverse Oakland, California. When Judge Chen was 9 years old, his father suffered a stroke and slipped into a coma for 3 ½ years before passing away. His mother was left to care for Judge Chen and his three older brothers and also to take over the family import business started by his father. When Judge became an adult, he helped to run that business. Growing up, Judge Chen has held jobs as a musician, valet, and restaurant worker, but also has managed small businesses such as a motel with 40 employees, a retail clothing store, and his family's real estate investments. Judge Chen understands family challenges even now. He is the parent of a child who is severely developmentally disabled and another with learning disabilities. All of these experiences – as a judge, a community advocate, a small business owner, the son of immigrants, and as a father – will combine to allow Judge Chen to approach each case with balance and neutrality, as he has done so with distinction as a federal magistrate judge. Judge Edward M. Chen is worthy of elevation to become a U.S. District Court Judge for the Northern District of California.

Dolly M. Gee is a partner with Schwartz, Steinsapir, Dohrmann & Sommers LLP, where she specializes in labor and employment law, often representing teachers under federal and state education code. She has extensive experience in federal and state court litigation involving all aspects of labor and employment law. Although Ms. Gee has not served as a judge before, she has a substantial amount of quasi-judicial experience. From 1994 to 1999, Ms. Gee served as a member of the Federal Service Impasses Panel, where she mediated and arbitrated numerous disputes and participated in hundreds of summary dispositions of impasses between federal agencies and federal sector labor unions. During the 1995-96, 1999-2000, and 2005-06 International Brotherhood of Teamsters Delegate and Officer Elections, Ms. Gee served as an independent election monitor under the auspices of the Office of the Election Officer, established under the supervision of the Honorable David N. Edelstein, U.S. District Judge for the Southern District of New York. In that capacity, she investigated and recommended dispositions for hundreds of election protests relating to alleged violations of election rules. Since 2000, Ms. Gee has served as an arbitrator for the Kaiser Permanente Independent Arbitration System, where she has arbitrated several disputes involving medical malpractice or

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breach of contract. Upon graduation from law school, she was a law clerk for the Honorable Milton L. Schwartz, U.S. District Judge for the Eastern District of California. Ms. Gee has been unanimously ranked "Qualified" by the ABA.

Ms. Gee serves as a role model for all lawyers, and especially Asian Pacific American and female lawyers. Ms. Gee's parents emigrated from small farming villages in Toisan, China. Her father served in the U.S. Navy during World War II and was among the first wave of Chinese American aerospace engineers who worked on the Apollo space missions for North American Aviation and later Rockwell International. Her mother was a garment worker and her experiences inspired Ms. Gee to go into the field of labor and employment law. English was Ms. Gee's second language.

Ms. Gee's bar association and public service activities reflect her commitment to fostering racial harmony and understanding, and promoting tolerance in Los Angeles, a diverse community which too often has been scarred by racial strife and violence. Notably, Ms. Gee was President of the Southern California Chinese Lawyers Association (SCCLA) in 1992 when police officers involved in the Rodney King beating were acquitted, which sparked one of the largest outbreaks of urban violence in U.S. history. At that time, many Asians were victims of violent crime, theft, and vandalism. Ms. Gee coordinated volunteer attorneys to provide pro bono legal services to the victims of civil unrest. Importantly, Ms. Gee also worked tirelessly with other bar associations and community groups to restore peace, ease racial tensions, and create a more unified city. Her work since that time has not diminished, and she has been a leader in working with both the federal and state court systems: Standing Committee on Discipline, U.S. District Court for the Central District of California (1999-2001); Advisory Board Member, U.S. Court of Appeals for the Ninth Circuit (2005-2008); Commission on Judicial Nominees Evaluation, State Bar of California (1996-1998). Ms. Gee's other leadership positions have included: Board of Trustees, Los Angeles County Bar Association (1993-1995); Co-Founder/Board of Governors, Asian Pacific American Bar Association of Los Angeles (1998-2000); Board of Directors, Western Center on Law & Poverty (1993-1995; Vice President, 1996-1998); Board of Directors, California Women's Law Center (1995-1998); Board of Directors, Asian Pacific American Legal Center of Southern California (1983, 2003-present).

As a result of her many pro bono efforts, Ms. Gee has received public service awards and commendations from the City of Los Angeles, the City of Monterey Park, the Los Angeles Human Relations Commission, the Office of the California Secretary of State, the Office of the Los Angeles City Attorney, and the Asian Pacific American Bar Association of Los Angeles County. Ms. Gee received NAPABA's Trailblazer Award in 2001. Since 2004, she has been named each year as a "Southern California Super Lawyer" by *Los Angeles Magazine*. Ms. Gee's many accomplishments – as a successful and well-respected attorney, an arbitrator/mediator/"neutral," and as a community leader – demonstrate that she will be a judge who will be respected and admired for her fairness and ability to make all litigants feel that they have been treated justly regardless of outcome.

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Judge Jacqueline H. Nguyen has been a judge with the Los Angeles County Superior Court for over seven years. When appointed, she was the first Vietnamese American woman to serve as a judge in California. As a judge, she has presided over thousands of cases, including over 65 jury trials. Judge Nguyen's record as a jurist is stellar – to date, none of her cases have been reversed on appeal. In addition to her regular duties as a trial court judge, Judge Nguyen is currently the Site Judge for the Alhambra Courthouse. As Site Judge, Judge Nguyen is in charge of the administrative operation of the Alhambra Courthouse, which she accomplishes through close working relationships with the sitting judges, court leadership, law enforcement, and the assigned prosecutors and defenders. Prior to her appointment to the bench, Judge Nguyen worked for many years as an Assistant United States Attorney with the United States Attorney's Office for the Central District of California, ultimately serving as Deputy Chief of the General Crimes Section, after stints with the Organized Crimes Strike Force, and the Public Corruption and Government Fraud Section. Judge Nguyen is perhaps best known for her ground breaking anti-terrorism prosecution in the "Operation Eastern Approach" case of *United States v. Tabatabai*, the first successful prosecution in the United States for providing material support and resources to a designated foreign terrorist organization.

Judge Nguyen has received several awards for her achievements. These awards include the Federal Law Enforcement Officers Association's Contribution to the Field of Law Enforcement Award (2002), NAPABA's Trailblazer Award (2006), a special recognition award from the Asian Pacific American Legal Center (2002), the Alumni Award from Occidental College (2007), and several commendation and achievement awards from the Department of Justice, the Federal Bureau of Investigations, and the State Department.

Judge Nguyen has demonstrated a lifelong commitment to the community. She was a volunteer pro bono attorney with Public Counsel's foster adoption project. She – along with Ms. Gee – was a founding member of the Asian Pacific American Bar Association of Los Angeles, and served as its president in 1999-2000. She has served as a board member of the Women Lawyers Association of Los Angeles, a board member of the Japanese American Bar Association of Greater Los Angeles, and was Co-Chair of the Asian Concerns Committee.

Judge Nguyen is a testament to both the beauty, and the promise, of the American Dream. Judge Nguyen was born in Dalat, South Vietnam, the daughter of a South Vietnamese Army major who worked closely with U.S. intelligence officers. She escaped the fall of South Vietnam with her family in a harrowing trip, starting with a terrifying toss over a fence, to a plane ride filled wall to wall with people, temporary separation from her father, through a chaotic Saigon, to the Philippines, to Guam, and eventually, to Camp Pendleton, California. Having been born into a life of relative security, then to lose it all to the chaos of war, Judge Nguyen embraced her new life in America with grace, fortitude, determination, and cheerful modesty, assisting her mother in cleaning dental offices growing up. She earned a four-year full tuition scholarship to Occidental College, and then graduated from UCLA School of Law.

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Throughout it all, she continued to help in the family donut shop on weekends and also taught as an elementary school substitute teacher. A story that could be crushing to many, Judge Nguyen's strength of character and determination shines. She brings a deep diverse experience, both professional and personal, that would serve her well as a United States District Court Judge.

* * * * *

Jacqueline H. Nguyen, Judge Edward M. Chen, and Dolly M. Gee would make immediate contributions as federal district court judges. Each nominee has significant professional accomplishments that demonstrate his or her fitness for the bench. Moreover, each nominee brings a unique personal life story that would inspire all Americans. Especially given the exceedingly low number of Asian Pacific American federal judges nationwide, the addition of all three individuals to the federal judiciary is important to NAPABA and AAJC. NAPABA and AAJC are encouraged by the progress being made here today, and look forward to working with this Committee and the Administration as many more Asian Pacific Americans are nominated for federal judgeships. Indeed, the addition of these three individuals to the federal judiciary should be important to all Americans interested in ensuring that the federal judiciary is reflective of all of the different communities that make up the fabric of the United States. Accordingly, the National Asian Pacific American Bar Association and the Asian American Justice Center proudly support and urge for the speedy confirmations of Judge Jacqueline H. Nguyen and Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California. Thank you for considering this testimony today.

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Honorable Patrick J. Leahy
Chairman,
U.S. Senate Committee on the Judiciary
433 Russell Senate Office Building
Washington, D.C. 20510

Dear Honorable Leahy,

The National Asian Peace Officers Association (NAPOA) is seeking your assistance in the selection process of the United States District Court Judge for the Central District of California. Attorney Dolly M. Gee is very well respected in the law enforcement community as well as the Asian community. Attorney Gee has a proven and respected track record who possesses the necessary qualities to be an excellent United States District Court Judge.

The NAPOA with local Asian community leaders recommends Attorney Dolly M. Gee to be the next United States District Court Judge for the Central District of California. NAPOA believes that she will make an excellent United States District Court Judge and serve the citizens of the nation well. The NAPOA conducted a comprehensive vetting process in making this recommendation. The NAPOA currently has over 22 regional Asian Peace Officers Associations around the country representing over 10, 000 local, state, and Federal law enforcement officers in the United States. For further information on NAPOA please go to www.napoaonline.org.

If you have any questions, please do not hesitate in contacting me at (408) 439-0086 or email at napoapresident@yahoo.com.

Respectfully Yours,

Regan O. Fong
President
National Asian Peace Officers Association

Cc: President Barack Obama

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Los Angeles, CA

September 18, 2009

Via Facsimile and U.S. Mail

The Honorable Patrick Leahy
Chairman
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510
Fax: 202.224.9516

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
152 Dirksen Senate Office Building
Washington, DC 20510
Fax: 202.224.9102

RE: ***Letter in Support of the Judicial Nomination of Judge Jacqueline H. Nguyen as United States District Court Judge for the Central District of California***

Dear Chairman Leahy and Ranking Member Sessions:

The National Conference of Vietnamese American Attorneys Association ("NCVAA") is dedicated to the development of the system of justice and committed to providing a forum for attorneys to exchange idea regarding legal issues affecting the global community and specifically the Vietnamese American communities around the world. The NCVAA expresses its strongest support for the prompt confirmation and historical appointment of Los Angeles County Superior Court Judge Jacqueline H. Nguyen as a United States District Court Judge for the Central District.

When appointed in 2002 by Governor Gray Davis, Judge Nguyen became the first Vietnamese American woman to serve as a judge in the State of California. If confirmed by the Senate, Judge Nguyen would be the third female Asian Pacific American Article III judge in United States history, the first female Asian Pacific American Article III judge in California, and the first and only Vietnamese American to serve as an Article III judge anywhere in the nation.

Born in Dalat, South Vietnam, Judge Nguyen was one of eleven siblings and a daughter of a South Vietnamese army major who had worked closely with United States intelligence officials. Her journey to the United States began in 1975 and took her from South Vietnam to the Philippines, to Guam, and eventually to Camp Pendleton, California. Judge Nguyen's personal background, triumphs and successes embodies the "American Dream."

Judge Nguyen's intellectual qualifications are not in doubt. She has stellar academic records and has held important government positions during her career. After earning a B.A. degree in English from Occidental College, Los Angeles, California in 1987, and a J.D. from University of California, Los Angeles School of Law in 1991, Judge Nguyen began her legal career in private practice as an associate at the law firm Musick, Peeler & Garrett in downtown Los Angeles.

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Judge Nguyen was also an Assistant United States Attorney in the Office of the United States Attorneys. During her six years in that office, she was commended for her work as an Assistant in the Public Corruption and Government Fraud Section, overseeing Department of Defense fraud prosecution, and as the Deputy Chief in the General Crimes Section.

As a judge, her opinions are thoughtful and cautious, reflecting her careful approach in analyzing and applying the law to the facts and circumstances at hand, while respecting the common law and legal precedents. As a federal prosecutor in the U.S. Attorneys Office, Judge Nguyen was known for her anti-terrorism prosecution. Her victory in the "Operation Eastern Approach" case in *U.S. v. Tabatabai* was one of the first successful prosecutions in the United States for providing material support and resources to a designated foreign terrorist organization, in violation of 18 U.S.C. 2339B.

The NCVAA believes that Judge Nguyen is highly qualified for the position and hopes that the Senate will expediently confirm her as the U.S. District Court Judge for the Central District of California. Thank you for your attention to this important milestone, and please do not hesitate to contact us if you have any questions.

Sincerely,

Dominique N. Thieu (co-chair)

May Trinh Gibbs (co-chair)

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CHARLES B. RENFREW

710 SANSOME STREET
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September 11, 2009

Honorable Patrick J. Leahy, Chairman
U.S. Senate Committee on the Judiciary
433 Russell Senate Office Building
Washington, D.C. 20510

Honorable Jeff B. Sessions
Ranking Member
U.S. Senate Committee on the Judiciary
335 Russell Senate Office Building
Washington, D.C. 20510

Re: LETTER OF SUPPORT FOR MAGISTRATE JUDGE EDWARD M. CHEN'S CONFIRMATION FOR THE U.S. DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

Dear Chairman Leahy and Ranking Member Sessions:

I write in support of Magistrate Judge Edward M. Chen's confirmation for the United States District Court for the Northern District of California.

I have known Ed for thirty years. When I was a judge on the Northern District, I hired Ed as a law clerk. We did not finish that clerkship year because I resigned from the Court to become Deputy Attorney General in the Carter Administration. Nevertheless, I had ample opportunities to observe Ed and his work product. He demonstrated a keen intellect with compassion and judgment that was surprising, for his years.

Because of the attraction of the San Francisco Bay Area, I received hundreds of applications for clerkships from very well qualified young men and women. A number of those who accepted clerkships with me went on to clerk at the United States Supreme Court. Ed measured up with the best of them.

As you doubtless know, there is a special relationship that develops between a judge and his or her law clerks. One time I remarked to a law clerk that as a judge I was selecting "my children." She replied, "no judge, we are selecting a parent." I had that relationship with Ed. I watched with pride his legal career and his appointment as a United States Magistrate Judge. His eight years of service in that capacity points the way to the type of district judge he will be.

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Ed's legal career has always focused on public service. His intelligence, integrity, judgment and compassion make him a perfect candidate for the District Court. While some might say I am biased in Ed's favor, I feel I can be objective about his qualifications. I served on the American Bar Association Standing Committee on Federal Judiciary, which evaluates federal judicial nominations. That experience, plus my own judicial background, provided me with the basis for understanding the demands, duties and responsibilities of a federal trial judge. Ed meets and exceeds those requirements.

It is also worth commenting that Ed would be the first Asian American district court judge in a community that has many Asian Americans. But his nomination does not rest upon his ethnicity, rather it is because I can think of no finer candidate who possesses the qualities one would hope for in a federal trial judge.

Sincerely,

Charles B. Renfrew

CHARLES B. RENFREW

CBR/der

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SAN FRANCISCO DEPUTY SHERIFFS' ASSOCIATION, INC.
444 6th Street San Francisco, CA 94103 Phone (415) 861-8060, Fax (415) 861-8057
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PRESIDENT David Wong | VICE-PRESIDENT Scott Osha | SECRETARY Eugene Cerbone | TREASURER Shedrick McDaniels | SERGEANT AT ARM Brian Savage

September 10, 2009

Honorable Patrick J. Leahy
Chairman,
U.S. Senate Committee on the Judiciary
433 Russell Senate Office Building
Washington, D.C. 20510

Honorable Jeff B. Sessions
Ranking Member,
U.S. Senate Committee on the Judiciary
335 Russell Senate Office Building
Washington, D.C. 20510

Re: Letter of Support for Magistrate Judge Edward M. Chen's confirmation for the United States District Court for the Northern District of California

Dear Chairman Leahy and Ranking Member Sessions,

On behalf of the San Francisco Deputy Sheriffs' Association which represents 800 rank and file members of the San Francisco Sheriff's Department, I write in support of Magistrate Judge Edward M. Chen's confirmation to the United States District Court for the Northern District of California.

Recently, Magistrate Judge Chen successfully mediated a case involving the City and County of San Francisco and Deputy Sheriffs' wages, benefits and working conditions. Judge Chen's judicious approach to the problem satisfied both parties and resulted in a successful settlement of the case. His judicial temperament, work ethic and professional abilities were instrumental in resolving the concerns of both sides; thus eliminating the need of a protracted and expensive trial. Judge Chen's ability to understand and analyze each side of the dispute, resulted in the court issuing a fair and balanced decision, which left a deep and lasting impression among the members of our Association, who risk their lives daily to protect the people and communities within the City and County of San Francisco.

The Association endorses the application of Magistrate Judge Edward Chen for Presidential Appointment to the Federal District Court. We believe Edward M. Chen has the necessary experience and qualification for the position.

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SAN FRANCISCO DEPUTY SHERIFFS' ASSOCIATION, INC.
444 6th Street San Francisco, CA 94103 Phone (415) 861-8060, Fax (415) 861-8057
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PRESIDENT David Wong | VICE-PRESIDENT Scott Osha | SECRETARY Eugene Cerbone | TREASURER Shedrick McDaniels | SERGEANT AT ARM Brian Savage

President Barack Obama has commented on the importance of choosing judges with experience, dedication and understanding. Edward M. Chen's current service as a magistrate judge for the past eight years has provided him with invaluable experience to assume the duties of an Article III judge. Judge Edward M. Chen has earned a reputation as an evenhanded jurist who is constantly mindful of the role that judges such as himself fulfill in our society: *as keepers of the rule of law and public trust in our system of justice.*

We thank you in advance for your consideration of our endorsement and look forward to the appointment of the first Asian American District Court Judge to the Northern District of California.

Sincerely,

David Wong, President

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September 17, 2009

The Honorable Patrick J. Leahy
Chairman
Committee on the Judiciary
United States Senate
224 Dirksen Senate Office Building
Washington, DC 20510

The Honorable Jeff Sessions
Ranking Member
Committee on the Judiciary
United States Senate
152 Dirksen Senate Office Building
Washington, DC 20510

Re: Federal Judicial Nominations of Jacqueline H. Nguyen (C.D. Cal.), Edward M. Chen (N.D. Cal.), and Dolly M. Gee (C.D. Cal.)

Dear Chairman Leahy and Ranking Member Sessions:

I am writing to you today asking for your support in confirming Judge Jacqueline H. Nguyen and Ms. Dolly M. Gee for the United States District Court for the Central District of California and Judge Edward M. Chen for the United States District Court for the Northern District of California.

The Southeast Asia Resource Action Center (SEARAC) is a national organization advancing the interests of Cambodian, Laotian, and Vietnamese Americans through leadership development, capacity building, and community empowerment. We were founded in 1979 as the Indochina Refugee Action Center (IRAC) to facilitate the relocation of Southeast Asian refugees into American society. We strive to empower Southeast Asian Americans to advocate for themselves on issues of concern to their communities, including issues involving our federal judicial system.

There has never been an Asian Americans Article III judge in the Northern District of California . The underrepresentation of Asian Article III judges is not reflective of California's 15 percent Asian American population, and of the 875 Article III judges in the nation, only eight are Asian American, a rate that is less than one percent. Therefore, SEARAC endorses the nominations and urges the immediate confirmation of Judge Edward M. Chen, Ms. Dolly Gee and Judge Jacqueline H. Nguyen. Each individual is highly recognized and respected at the local and national levels. Their experiences, combined and individually, are beyond exemplary and would build our federal bench to a stronger, more representative system.

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Ms. Dolly M. Gee experiences as a community leader demonstrates her dedication to equality and the rule of law. To address the racial tensions in Los Angeles in the early 1990's, Ms. Gee advocated for tolerance and provided free legal assistance to the underserved in her community. Now as a partner with Schwartz, Steinsapir, Dohrmann & Sommers LLP, she continues her dedication to equality and the rule of law by specializing in labor and employment law. However, Ms. Gee's ability to equate fairness was greatly demonstrated when she served on the Federal Service Impasse Panel as a mediator resolving hundreds of impasses between federal agencies and labor unions. Recognizing that Ms. Gee's track record of resolving problems through her impartial decision making, she became a court-appointed election monitor in the election of 27 International Brotherhood of Teamsters local unions in California, Nevada, and Hawaii. Through all her work, Ms. Gee has shown a strong understanding of the legal system's emphasis of being fair and just. We strongly believe that Ms. Gee will continue her excellence in being fair and just as a district court judge. We offer our earnest endorsement to Ms. Gee's confirmation.

Judge Edward M. Chen serves as a federal magistrate judge for the United States District Court for the Northern District of California since 2001. Judge Chen's reputation of being fair has earned him respect from other federal district court judges and re-appointment to a second term. His experience in over 20 criminal and civil trials by jury and bench cases, authoring over 300 published decision and orders, and conducting over 500 settlement conference makes Judge Chen a well seasoned judicial nominee. Before serving as a judge, Judge Chen became part of Asian American history when he and his legal team represented Fred Korematsu in a *coram nobis* case. Judge Chen and his team were successful in overturning Fred Korematsu's conviction for failing to comply with the Japanese internment order during World War II. The holding for this case showed the unjust reasoning behind Japanese internment, not only for Korematsu, but for all Japanese Americans that were affected by internment. This success is only one of many of Judge Chen's successes in fighting for justice. Judge Chen's experiences illustrate his dedication to justice and why he is well respected by so many of his peers. SEARAC offers our deepest support for Judge Chen's confirmation.

Judge Jacqueline H. Nguyen became the first Vietnamese American woman judge in California when she was appointed with the Los Angeles County Superior Court in 2002. Judge Nguyen not only brings her experience as a judge with the Los Angeles County Superior Court, as an Assistant United States Attorney for the Criminal Division of the United States Attorney's Office and later as the Office's Deputy Chief of the General Crimes Sections, she is the face of California. In a state that is home to the largest Southeast Asian American population, numbering over 700,000, Judge Nguyen's journey embodies the struggle of many Southeast Asian American refugees that settled in California and the success that all Americans dream of. She would be the first Vietnamese American in the nation to become an Article III judge. We extend our strongest endorsement of Judge Nguyen's confirmation.

Individually, each judicial nominee has shown an aptitude for justice and impartiality that is needed to be an Article III judge. Accordingly, the Southeast Asia Resource Action Center urges the confirmation of Judge Jacqueline H. Nguyen and Ms. Dolly M. Gee for the United States District Court for the Central District of California, and Judge Edward M. Chen for the United States District Court for the Northern District of California.

Sincerely,

Executive Director

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