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## Comment And Analysis

### A Harmonized Approach To Applying Secret Prior Art

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#### Abstract

As patent harmonization discussions proceed, one of the major issues to be harmonized concerns the citation of secret prior art. Previously filed, subsequently published applications can be utilized as prior art both against third-party applicants and the later-filing applicant himself.

In the United States, Japan, and Europe, such secret prior art is currently used in different ways. A new proposal is herein suggested which reintroduces the concept of "enlarged novelty" as applying to both third-party rejections and the later-filing applicant. This new system inherently results in a compromise of the three existing Patent Systems.

#### I. Patent Harmonization Discussions

Patent harmonization discussions have been going on for at least 25 years. Initial activities taking place at Geneva under the sponsorship of the World Intellectual Property Organization (WIPO) yielded hope for a substantive treaty but were ultimately stymied by lack of progress on the "first-to-file" issue. However, the discussions did result in the passage of a procedural Patent Law Treaty (PLT), which has already been successful. While not yet ratified, it has served as a model for changing all other patent laws, including the Patent Cooperation Treaty (PCT), to conform with the PLT.

Continued discussions on substantive patent law harmonization have proceeded on a rather slow basis. Confronted by a number of political obstacles, patent harmonization has been an elusive goal. Conflicting views between "east and west" on major patent issues such as patentable subject matter, technical effect, and first-to-file have slowed the pace towards any compromise solution. Likewise, "north-south" issues on pro-

tecting genetic resources and traditional folklore have likewise stymied progress on harmonization talks.

However, it appears that Non-Governmental Organizations (NGOs) are actively trying to eliminate duplication of effort by patent offices around the world to ultimately reduce the cost of patent protection globally, while maintaining high quality. As a result, a flurry of efforts has recently taken place to revive the stymied WIPO talks and attempt to give patent harmonization a "jump start".

On the one hand, the Trilateral Patent Offices (European Patent Office, Japan Patent Office, and U.S. Patent and Trademark Office) have proceeded by prioritizing the issues into primary and secondary groups and to address those issues in the primary list, while keeping the most difficult subjects as part of a secondary list. At the same time, the NGOs have met, and in a similar approach have put together a "mini basket" of issues which should be initially addressed in an attempt to achieve harmonization on these issues as a first step.

In both lists of issues, the main areas being addressed relate to those laws requiring harmonization in order to achieve an equal basis for an international-type search. At present, one of the difficulties in providing "good faith and credit" to an international search from one organization to another is the differences in substantive patent laws.

The grace period in the United States eliminates references which Europe and Japan would accept. Different interpretation of prior art, for example, local versus absolute, also provides differences in the utilization of prior art. Finally, one of the most difficult and distinct areas preventing uniform searching relates to the use of previously filed, subsequently published applications, typically referred to as "secret prior art".

To the extent that a common legal approach can be achieved in uniformly addressing such "secret prior art", great progress might be achieved toward ultimately obtaining harmonization on the "mini-basket" of issues presently being considered.

## II. What is “Secret Prior Art”?

Secret prior art refers to patent applications that have been previously filed but subsequently published with respect to a particular application that is being examined. Such secret prior art presents conceptual problems when utilizing it as prior art. On the one hand, as it was “secret” and not available to the public, it is difficult to utilize as information that was in the public domain, since no one could get access to that information and no one, except the inventor of the first-filed application, was aware of it.

At the same time, it cannot be totally disregarded, since it does show that someone else had previously invented that concept, described it, and satisfied the requirements of the patent system by disclosing it at least to the Patent Office in a patent application. In a first-to-invent system, it shows that someone else invented that information, at least to the extent that they established a previous filing date. In a first-to-file system, it shows that someone else had filed that invention previously. Accordingly, the prior-filed application cannot be totally disregarded as a prior art for the later-filed application.

Secret prior art can then be utilized against all third parties, as well as against the applicant in certain circumstances, which differ from country to country. Against third parties, it presents prior art conceived of by another. Even as against the applicant, however, it presents an indication that all of the material was previously disclosed by the applicant himself and constitutes a prior official disclosure for the later submission into the public domain.

The extent of utilization of such secret prior art has two possibilities. One is the “prior claim approach”, which only utilizes the specific claims of the first patent application against a later-filed application. The difficulty with this approach is that it takes many years until the claims of the first application are fully known. As a result, it may delay the prosecution of the second application, since the second application cannot move forward until the claims of the first patent application have been defined.

The more widely accepted approach is the “whole contents approach”. In this case, the entire text of the first patent application is utilized as prior art to be applied against what is being claimed in the second application.

## III. Current Systems Applying Secret Prior Art

At present, the U.S., Europe, and Japan each have different approaches to utilizing secret prior art as a reference against third parties, as well as against the applicant himself. Each of these approaches defines a workable system that has been utilized for years, and each approach presents a viable possibility that can be the basis for a harmonized system. However, each of these approaches also presents some conceptual contradictions and often does not appear to be logical or equitable in applying such secret prior art. Each of these approaches actually has two parts. One is applying the secret prior art against third parties, and the other is applying the secret prior art against the applicant himself. Each of these will be analyzed below.

### A. Secret Prior Art Utilized Against Third Parties

#### i. European Approach

The European approach is to use the whole contents of the secret prior art against a third-party pending application. However, it only utilizes the whole contents for strict novelty-defeating purposes. Such strict novelty is sometimes referred to as “photographic novelty”. Thus, to the extent that the later-filed application differs even slightly from what is contained in the secret prior art, a patent will issue to the second applicant. Consequently, to the extent the second applicant claims something which is not directly within the secret prior art disclosure but might be obvious from it, he would also get a patent. This can best be described below in Fig. 1.<sup>1</sup>

FIG 1 – Europe applying Secret Prior Art against another applicant

	Disclosure		
Applicant 1	A, B, C		
Applicant 2 -	Claims B	- No Patent	
Applicant 2 -	Claims B'	- Patent	
Applicant 2 -	Claims BD	- Patent	

#### ii. Japanese Approach<sup>2</sup>

The Japanese system generally is similar to the European system in applying the whole contents of the secret prior art only for novelty-defeating purposes against a third-party applicant who files later. However, according to the Japanese Patent Office, the whole contents of the first application is applied not only for what is “photographically” presented, but also for information that one could understand or grasp from the disclosure or from the matters which can be said to be substantially disclosed in the secret prior art – specifically, anything that can be derived by considering the common technical knowledge in the arts at the time of filing of the secret prior art.

Such common technical knowledge in the arts is the matter which is apparent on the basis of arts well known to the person having ordinary skill in the art. Thus, in Japan the concept of “novelty” is broader than just “photographic novelty”. The situation in Japan would be as shown in Fig. 2 below.

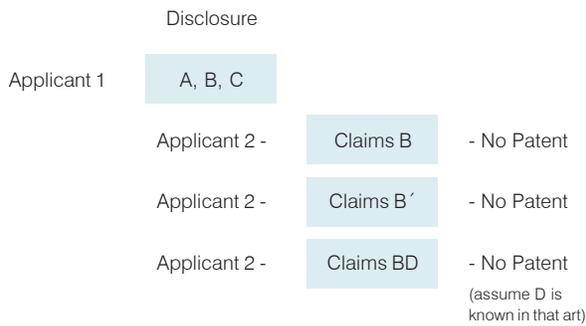
FIG 2 – Japan applying Secret Prior Art against another applicant

	Disclosure		
Applicant 1	A, B, C		
Applicant 2 -	Claims B	- No Patent	
Applicant 2 -	Claims B'	- No Patent	
Applicant 2 -	Claims BD	- Patent	

iii. U.S. Approach

The U.S. approach also applies the whole contents of the secret prior art. However, it utilizes it both for novelty-defeating purposes and for obviousness purposes. Accordingly, in the U.S. they will apply everything that is disclosed in the secret prior art directly, as well as combining it with any other reference which may either have been published or may also have been part of the secret prior art. This situation is described in Fig. 3 below.

FIG 3 – U.S. applying Secret Prior Art against another applicant



B. Against the Applicant Himself

i. European Approach

In Europe, they utilize the same whole-contents approach for novelty-defeating purposes against the applicant exactly as against a third party. This is typically referred to as "self-collision" or "internal collision". Namely, to the extent that the applicant has disclosed an invention in a secret prior art, he can no longer claim that same invention in a later application, the concept being that once he disclosed it in the first application, he must claim it there and cannot claim it elsewhere. He can file a divisional on that first application, but he cannot claim it in any other application.

However, again, this novelty is only "photographic novelty", so that should he claim a slight variation, an equivalent, a species, or some other slightly different invention in a later application, the earlier, secret prior art application will not be used against him. Clearly, if he claims in a later-filed application an invention that is only obvious over the first disclosure, he will definitely get a patent, since the first application is only utilized for very narrow novelty-defeating purposes. This is shown below in Fig. 4. It should be noted that it is a similar situation to applying the secret prior art against third parties.

FIG 4 – Europe applying Secret Prior Art against same applicant



ii. Japanese Approach

In Japan, however, they do not care about self-collision. Specifically, the prior art cannot be used against the applicant himself, or even the same inventor of the claimed invention and different assignees, even for novelty-defeating purposes. One of the reasons for this is that in Japan, large industry files many applications. Typically, the applications may be initially prepared by the inventor himself and reviewed by a patent attorney before filing. The disclosure put together by the inventor, or even a patent attorney, may often overlap another disclosure, since large groups of inventors typically work together. Accordingly, the same disclosure of a particular invention may be found in a number of different applications, all being filed around the same time, although not on the same day.

As a result, the particular application which claims that invention may be later than an earlier application that already described that invention. Accordingly, the situation in Japan is shown below in Fig. 5.

FIG 5 – Japan applying Secret Prior Art against same applicant



iii. U.S. Approach

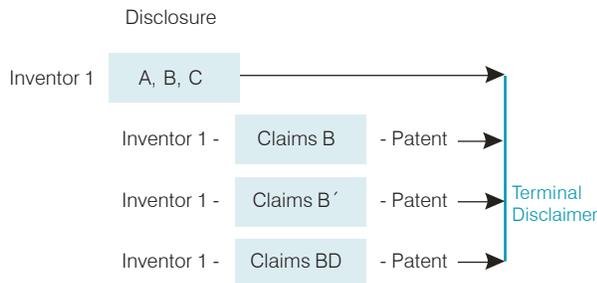
The U.S. situation is much more complicated. Firstly, it makes a distinction whether the secret prior art and the later application were filed by the same inventor<sup>3</sup> or not, and also makes a distinction whether there is an obligation to assign the secret prior art invention and the later invention to a single applicant, at the time each was filed. Furthermore, it makes a distinction between applying the reference for novelty-defeating purposes and for obviousness purposes.

Additionally, U.S. law includes terminal disclaimers. Should the same inventor claim the same invention twice, this is absolutely prohibited as being statutory double-patenting. On the other hand, should the applicant be claiming an invention that is obvious over a previously disclosed invention, such would be considered obvious double-patenting and would require a terminal disclaimer so that both patents must remain owned by the same inventive entity or its assignee and would terminate at the same time to avoid any extension of the patent grant beyond the expiration date of the patent issuing from the original invention.

Shown below in Fig. 6 is U.S. application of secret prior art applied against the same inventor. In this case, there would actually be no application of the secret prior art against the inventor himself. However, a terminal disclaimer would be re-

quired even though the secret prior art is not a reference. (It is understood that the same invention is not being claimed twice, namely it is not being claimed in the first application, although it is disclosed in that first application).

FIG 6 – U.S. applying Secret Prior Art against same inventor

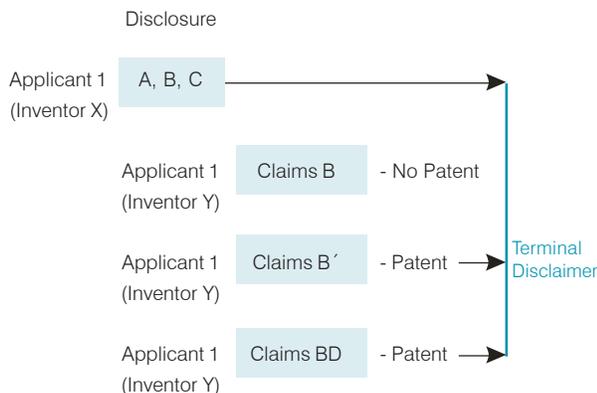


In connection with applying the secret prior art where there are different inventive entities of claims in the later application compared with the first application, although at the time of their respective inventions all inventors had an obligation to assign to the same assignee, a different situation occurs. In this case, if the same invention is disclosed in the secret prior art, the secret prior art will be applied for novelty purposes. In this case, no patent will issue unless the second inventive entity was the same inventive entity of the invention disclosed in the first application.

However, the secret prior art will not be applied for obviousness purposes, since U.S. law has been changed to acknowledge the fact that groups work together, and therefore one inventor may learn an invention from another and improve upon it within the same group, working for the same company, and therefore the company should not be deprived of those inventions coming from the group when one inventor improves upon the other.

Accordingly, applying secret prior art in the U.S. against the same assignee but different inventors will result in the following as shown in Fig. 7.

FIG 7 – U.S. applying Secret Prior Art against different inventors but common assignee



### III. Logical Inconsistencies With Existing Approaches

Although each of the European, Japanese, and U.S. approaches provides a workable system, there are logical inconsistencies with each of these systems producing contradictions and logically difficult results.

By way of example, the European approach fails to provide adequate protection to an applicant who comes up with a basic idea. Since the secret prior art will only be utilized against third parties for “photographic novelty” to the extent the first applicant makes a basic contribution, a later applicant can come along and make a very slight or equivalent modification or substitution and get his own patent.<sup>4</sup> Sometimes this can deprive the original applicant of any of the practical, commercial benefits of his first invention.

Especially in a first-to-file system, where there is a rush to get the application on file, there may not be adequate time to include every variation. However, once the first applicant files the application, he locks in his rights. Although he had been the first to file for the invention, someone else may come up with a very minor change and gain independent patent rights of a much more significantly commercial invention.

Furthermore, limiting the applicant to the specific wording of the patent application places his invention as the “sacrificial lamb” to the linguistic capabilities of a patent attorney. Since Europe only precludes “photographic novelty” to the extent the patent attorney used a particular word or phrase rather than a different phrase, someone with a slightly different wording would be able to get an independent patent thwarting the rights of the true first-to-file inventor.

Additionally, while the applicant himself can always file divisionals and claim all aspects of his original disclosure to the extent of the linguistic capabilities of the patent attorney, should he fail to do so until grant of his first application as a result of self-collision, he is precluded from recovering what he originally disclosed should he file a second application. If he filed the divisional shortly before grant, he would be able to cover what he had disclosed. If he files it after grant, he is now precluded, although he was the one who originally disclosed it.

Additionally, since the European and Japanese approaches do not have terminal disclaimers, although it is not an identical invention as disclosed, the public is subjected to extending the monopoly for what are essentially minor variations of the same invention, because “photographic novelty” will not prevent the same applicant from extending the monopoly with minor variations. This problem would be further exacerbated if there were to be a grace period where the applicant’s own publication would not be prior art against the applicant for the time limit of the grace period.

The U.S. system likewise presents logical inconsistencies. Under the U.S. system, a “secret prior art” is utilized and combined with other references, in some cases also other “secret prior art”. This is effectively saying that one skilled in

the art would find it obvious to take what is not known to anyone publicly and combine it with something else which is known or even not known to anyone publicly, in order to make the invention obvious on the date the second application was filed.

In truth, the only one privy to the “obvious combination” of two items of “secret prior art” is the patent examiner, who must decide what is obvious to one of ordinary skill in the art and not be that skilled artisan himself.

Furthermore, the anomaly of applying the U.S. law against inventors, as compared to applicants, also presents inconsistencies. Should there be a common applicant (assignee) with different inventors, no patent will issue if it was previously disclosed (applying 102(e)) but a patent will issue on an obvious variant (not applying 102(e)/103), as the group works together. The law thus recognizes a group working together but not a patent attorney writing an application based upon the work of the group and incorporating more than one idea, although not claiming it.

Moreover, the “working group” concept fails if the working group is a corporation and a university that work in joint development, two corporations working in joint development, etc. Innovation often occurs where two different legal entities not under common control are engaged in research and development.

Accordingly, although all of the various existing systems have functioned and operate effectively, none of them provides a perfect logic to all aspects of utilizing “secret prior art”.

#### IV. New Proposal For Applying Secret Prior Art

Although, in a harmonized treaty, any of the existing approaches could be utilized as the accepted standard, in order to do so there would have to be full concessions on the part of one approach to accept the other approach. While concessions are always available in negotiating harmonization treaties, compromise often is preferable. However, in compromising, what is often done is to take one of the existing approaches and “tailor” or modify it in certain aspects.

As has been frequently pointed out, an existing approach may have been proven effective for many years. It is built on numerous other intertwined aspects. “Tinkering” with one aspect and modifying it often has detrimental effects on another aspect, and it is not that easy to take an existing approach and simply modify it in one or two aspects. It is often preferable to come up with a totally new approach which provides a compromise in its effect, and at the same time is one that can be accepted based upon logical principles of law and equity, and fairness for all systems involved and their applicants.

In this regard, a new proposal is presented for dealing with secret prior art which effectively provides a compromise and, at the same time, provides a new approach which differs from all existing approaches. The new approach is based upon applying the whole contents of secret prior art for what is referred to as “enlarged novelty” purposes.<sup>5</sup> To some extent,

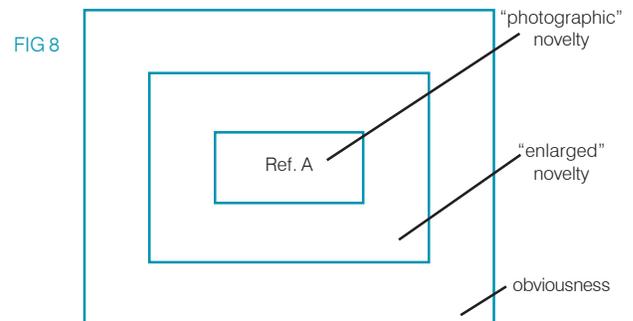
it is not a new concept but reverts back to an old understanding of the concept of novelty.

For example, under the German national patent system this is a concept of novelty, which covers all that one skilled in the art usually understands from a document and which is broader than the photographic novelty approach that is currently being utilized by the European Patent Office and by most of its Member States. By way of example, if a generic invention is disclosed in the secret prior art, it should preclude a subsequent application from covering a species not particularly identified within the generic disclosure (unless the “species” is in the nature of a “selection” which could give rise to patentability).

Likewise, later equivalents should be precluded. Later well-known substitutes should be precluded. Anything that would be well known to one skilled in the art reading the original disclosure should also be precluded. Thus, the first disclosure should not only provide novelty-defeating from a “photographic” viewpoint, but from an “enlarged novelty” viewpoint. To some extent, this is similar (although perhaps broader) than the present Japanese understanding of “novelty”. Moreover, this German concept of novelty is similar to the American concept of “inherency” found in a single prior art reference.

To the extent that the second inventor can show that his particular species, equivalent, substitute, etc. would not have been within the original “enlarged” disclosure, as it provides unexpected benefits, unusual results, or the like, he may present arguments to overcome such secret prior art rejection. Also, as the secret prior art can only be used for novelty (enlarged) defeating purposes, it cannot be combined with any other reference or any other material to provide an obviousness type rejection.

By way of example, Fig. 8 indicates schematically what constitutes the “enlarged novelty” beyond the “photographic novelty” of the secret prior art Reference A and the potential for combining it with other references to provide an “obviousness” rejection from that Reference A. It is only the “enlarged novelty” that would be utilized for applying such secret prior art.



Conceptually, the approach of using the “enlarged” novelty for applying secret prior art is to give the full benefit of the invention to the inventor who is the first to file. Although he may have rushed to file his application first, and his patent attorney

may have used specific words, he should still be entitled to the full benefit of his invention. Thus, to the extent that he covered a generic concept and listed some but not all species, someone else should not be able to come up with another species falling within the generic class and get a separate patent on it (except for the “selection” concept indicated above, which should be held to high standards of proof).

Likewise, although he may have described his invention and given some examples, someone else should not be able to come up with one other equivalent or well-known substitute and get a separate patent on that. The inventor should be given the full breadth of his invention and be able to stop others from getting patents on anything falling within the scope of his invention. However, he should not be able to stop others from making use of his invention and combining it with other independent ideas. Thus, he should not be able to utilize his secret prior art for obviousness purposes where it is necessary to combine the secret prior art with other references.

In connection with applying “secret prior art” in an “enlarged” novelty approach, the result applying it against third parties would be as shown in Fig. 9 as follows.

FIG 9 – Applying Secret Prior Art against another applicant in “Enlarged Novelty” system



It should be noted that the effective result of using the “enlarged novelty” approach is effectively a compromise between the European approach (Fig. 1) and the U.S. approach (Fig. 3), and rather similar to the Japanese approach (Fig. 2).

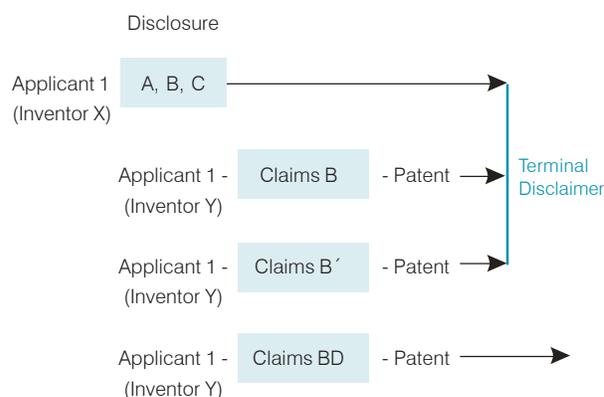
It is also believed that this same “enlarged novelty” concept can be utilized in connection with the applicant himself. The applicant should be able to ultimately claim anything disclosed in his first application from an “enlarged” viewpoint. Specifically, the applicant should be able to claim both his “photographic” disclosure and an “enlarged” version of that disclosure in his second application.

Furthermore, it should not make a difference whether it is the inventor himself who filed the second application or whether it is another inventor within the same applicant group. So long as both inventors were part of the applicant, in the sense that they had an obligation to assign it to the same applicant, we must recognize the group aspect of inventions and grant patents to the applicant whether the invention was disclosed in the first application and claimed in the second, or claimed in the first, so long as the true inventor is named in the application claiming his invention.

However, in all fairness to the public, in cases where it is a common applicant that is working with members of a single group expanding the invention, a terminal disclaimer should be applied. However, such terminal disclaimer should only be limited to the “enlarged novelty” of the invention, not to anything that results from obvious advances of the invention.

Accordingly, in the proposed system the following Fig. 10 would result when applying secret prior art against an applicant, regardless of who is the inventor.

FIG 10 – Applying Secret Prior Art against different inventors but common assignee



It will be noted that this approach again results in a compromise between Japan, Europe, and the U.S. It provides anti-collision features, terminal disclaimer features, equates applicants and inventors, and provides a logical and equitable compromised system.

## Conclusion

It is therefore seen that using the “enlarged novelty” approach for applying secret prior art, both against other applicants and in connection with the applicant himself, there is provided a new compromise type of system that provides a logical and equitable approach to the applicant, other inventors, and the public at large. It also happens to provide a mid-way position between the existing approaches currently employed in Japan, Europe, and the United States.

Furthermore, it avoids the necessity of “tinkering” with any existing approach which may cause problems, and instead comes up with a new overall approach. Also, it avoids the political problem of having any one country or region “conceding” to the approach of the other, but instead creates a totally new approach and consistent logic to reach an effective compromise position.

## Notes

- 1 In the examples that follow, "disclosure A, B, C," means that the application discloses these three inventions but does not claim them. "Claims B" means that the application claims invention B. "Claim B'" means the application claims an invention slightly different than invention B disclosed. "Claims BD" means the application combines invention B with another known idea such that the combination BD is an obvious variation of B but requires combining the teaching of B with another reference.
- 2 The Japanese information has been provided by Shinji Kato, Japanese Patent Attorney, Partner of PROSPEC Patent Firm, Tokyo Branch Office, Japan.
- 3 In the USA only, the applicant is the inventor, not an assignee of the inventor. Because inventorship can vary from claim to claim, the "inventive entity" of each claim needs identification in both the prior application and the later application for prior art purposes.
- 4 The later applicant's work is done and filed without knowledge of the earlier applicant's work. But in rapidly emerging technologies, parallel innovation paths often occur.
- 5 In some respects this concept has been suggested informally in the past. Among those who had considered this concept in the past, in addition to the authors of this paper, was Mike Pantuliano of Clifford Chance. On behalf of the IIPS at the London "Roundtable" of NGOs on November 10 and 11, 2003, he advanced, in general terms, the proposal being formally presented here in this paper. He also endorsed the notion that under an "enlarged novelty" concept, for citation purposes a first-filed, later published application would not be combinable with other known or unknown references. His proposal was submitted only with respect to the application of secret prior art to third parties. However, in this paper it is now extended to apply also with respect to an applicant.



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### Qualifications and Career Profile

Samson Helfgott has practiced for over 30 years in domestic and international patent, trademark and copyright matters, international patent strategy and patent and trademark administration before foreign patent tribunals. He is a prolific writer and lecturer, who is frequently published in the area of international litigation pertaining to patents, among others.

### Associations and Committees

Mr. Helfgott is a member of the American Bar Association (IPL Section) where he heads all of the International Intellectual Property matters, serving as International Activities Coordinator. He is Chairman of the Harmonization Committee of the New York Patent, Trademark and Copyright Law Association (Board of Directors 1986-89). He is Chairman of the Foreign Practice Committee of the Intellectual Property Owners Association. He has chaired many committees at the American Intellectual Law Association. He is currently the Treasurer of the International Intellectual Property Society (President, 1994-96). He serves on the U.S. Bar, EPO Liaison Council, having previously been his Chairman. He was the founder and first Chairman of the U.S. Bar/JPO Liaison Council. He has represented the American Bar Association at international meetings and at international diplomatic conferences on world patent harmonization.

Mr. Helfgott is admitted to practice before the Supreme Court of the United States, the United States Court of Appeals for the Federal Circuit, the Southern and Eastern Districts of New York, the Supreme Court of the State of New York, and the United States Patent and Trademark Office.

### Education

Mr. Helfgott earned an undergraduate degree *cum laude* (B.E.E., 1961) from the City College of the City University of New York, and graduate degrees from Yeshiva University (M.H.L., 1962) and New York University (M.E.E., 1963). Mr. Helfgott earned his law degree *cum laude* (J.D., 1972) from Fordham University and a doctorate degree (D.H.L., 1974) from Yeshiva University. Mr. Helfgott speaks Hebrew and German.

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