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**SONIA SOTOMAYOR SUPPLEMENTAL RESPONSE TO
SENATE QUESTIONNAIRE
PART I BIOGRAPHICAL INFORMATION, QUESTION 12**

12. The following, in reverse chronological order, are speeches I have given since the filing of my Senate Questionnaire:

Sonia Sotomayor, *Speech at the IACC, International Anti-Counterfeiting Coalition Luncheon (October 16, 1997).*

Sonia Sotomayor, *Remarks at the MCC, Metropolitan Correctional Facility Hispanic Heritage Month Program Celebration (October 3, 1997).*

**REMARKS AT THE MCC NATIONAL HISPANIC HERITAGE
MONTH PROGRAM CELEBRATION
OCTOBER 3, 1997**

I was delighted that the MCC staff invited me here today. I have enormous respect for the work of the MCC and the Bureau of Prisons. I recognize that an arrest of a defendant in our society is only the beginning of a process, the first step in insuring the safety of our communities. It is at this early and vital stage in the process that we rely on this facility, and on the Bureau of Prisons, to cope with an enormous work load, a workload that is as impressive as the breadth of your responsibilities.

What you do awes me -- housing and securing prisoners of different regional, ethnic, religious and socioeconomic backgrounds in multi-tiered, multifaceted environments from detainee facilities, like this the MCC, high to low security prisons, community homes, and medical facilities. You manage not only to secure and supervise this enormous prisoner population, but you transport prisoners between facilities and to court and you provide prisoners with training, education, work, counseling, and medical and psychiatric treatment. In the midst of all this, you address and deal with the complex security, emotional and other health problems of a population wrought with difficulties. Indeed, as a former prosecutor, and now as a judge next door, I know that -- particularly here at the MCC -- prisoners and their family and friends tend to be very agitated and anxiety ridden following their arrest.

Added to your burdens are the difficulties of dealing with a prisoner population who -- I exaggerate only slightly -- probably speak every language of the world, and obviously the language of my ancestors, Spanish. As some of you may know, although I was born and raised in the Bronx, my mother and father were born and raised to adulthood in Puerto Rico. Growing up, I spent many summers in Puerto Rico. At home and in Puerto Rico, I not only learned our language, but I learned also of the rich and diverse culture of Hispanics. I am proud to be an American and know that all of the Hispanics in the room are also. I also know, however, that we all value and take pride in our Hispanic backgrounds. I have described myself as having the soul of a Latina in the way I love life. I suspect many of you here feel the same way.

I am sure this facility, the MCC, and the Bureau of Prisons recognize that despite the commonality of our language, each Hispanic community, be it from the mainland US, Caribbean or Latin America, has its own traditions. I suspect you know this because I know that more than 25% of your prison population is Hispanic. Your Warden has also told me that the MCC employs a very significant number of Hispanics. You must take great pride in knowing that each one of you is an important role model to the prison population, that the prison population by your example knows that Hispanics who work hard and educate themselves can achieve responsible positions in our society.

It is a tribute to the this facility, the MCC, that you and your staff would celebrate this National Hispanic Heritage Month with our Hispanic communities. As many of you know, the Hispanic population represents the fastest growing segment of the U.S. population. Since 1980, the Hispanic population has grown about five times as fast as the non-Hispanic population and Hispanics are expected to be the largest ethnic minority in the U.S. in the 21st century. This fact undoubtedly will continue to affect the work of the Bureau and its need to continue its responsiveness to Hispanic related issues. You have made a wonderful start.

The Bureau should take great pride in what it does. In all of my contacts with the Bureau, I have never seen anything less than total professionalism in all of its work. The Bureau and its staff have extended me every courtesy and have been most gracious in assisting me in my work. I fully expect that the Bureau will maintain its wonderfully high standards far into the future and I look forward to continuing my contact with you. Thank you for inviting me to share in this celebration today.

**SPEECH AT THE IACC (INTERNATIONAL ANTI-COUNTERFEITING COALITION)
OCTOBER 16, 1997 LUNCHEON**

I am delighted to be here today to greet old friends and acquaint myself with some of the IACC's new members. As many of you know [or have just been told], my old firm, Pavia and Harcourt, has been an IACC member for many years. Tony Cannetella of the firm is at this meeting. Fran Bernstein, my friend, mentor and partner who died in 1987, and who some of you may remember, had Pavia join the IACC because she believed, as early as the 1970s, that trademark and copyright laws would become ever so more important in the marketplace and provide an important practice area for many firms. Well before her death, she predicted

Congress would eventually, as it has just within the last few years, give greater protection to famous marks. Fran today would be very pleased to know that her predictions have all come true. While at Pavia, and at Fran's insistence, I had attended many an enjoyable and educational IACC conference. I had also worked very closely with a number of IACC members on various trademark and anti-counterfeiting issues, including the passage of New York state's penal statute criminalizing directly trademark counterfeiting. Thus, I have been looking forward to coming here in part because the event is a reunion for me, but also because of an incident that occurred just a few months ago when I called my old firm, Pavia and Harcourt, to leave a message for a friend.

A new secretary answered, and after she asked me to spell my name, she also asked me if the partner who I was calling knew who I was and why I was calling. Imagine my shock, before becoming a judge, I had spent most of my professional career at Pavia and I had not expected to be so soon forgotten. The new secretary's question, personally painful, made me remember, however, that just as I had experienced significant change in my life in the last five years on the bench, so had the institutions of which I had previously been a part. The secretary that I spoke with, although she viewed me as a stranger, helped me to realize that I needed to devote more time to keeping in touch with the professional organizations, like the IACC, that had been so important to me before I became a judge. For this reason, I was very grateful when Heather McDonald and Barbara Colson-- who thankfully had not forgotten me -- called and asked that I speak at

this luncheon.

My practice at Pavia had been quite diverse and stimulating. I worked in a wide variety of fields like automobile franchising, grain commodity trading, and intellectual property. I found the intellectual property part of my practice, however, the most enjoyable. My investigative experience with the Manhattan D.A.'s office came in handy when I found myself doing anticounterfeiting work on behalf of Fendi and other trademark owners. I particularly enjoyed the many lovely afternoons in Chinatown spent, wearing a bullet proof vest, with Heather McDonald, the Dragon lady, as she was affectionately called by the local vendors, seizing counterfeit goods from the nooks and crannies many of us never imaged existed within the maze of buildings that is Chinatown.

I am sure Demspter Leech of Harper Associates still remembers the pleasant afternoon we spent outside Shea Stadium chasing counterfeiters around the parking lot on motorcycles. I have never gotten back on a motorcycle after that day when I belatedly realized that cars were much bigger than motorcycles and that I had lost reason in the heat of pursuit by ever getting on the motorcycle as a passenger at all to chase the vans that stored the counterfeit goods. All jesting aside, I am very thankful that I have a much more sedate and secure job now, and a car that I am very fond of as well.

My work as a judge obviously does not include the opportunity I had while in private practice to work with the many talented lawyers I met through the IACC. On the other hand, I do have the opportunity to have many of you appear before me. After five years on the bench, and with a wide basis for comparison, I can say that the intellectual property bar has some of the most well-informed and best prepared litigators of any federal practice area. It is a pleasure as a judge to be able to have a conference or oral argument with lawyers who so thoroughly understand the many nuances of laws in an area that is constantly evolving, changing and raising new questions. This Bar has every reason to be proud of the quality of work that it does.

Despite the many things I do miss about private practice, I very much appreciate that as a judge I can participate directly in the legal discussion going on in many of the fascinating areas of intellectual property, areas that are developing in new and important ways. I am sure everyone here is anxiously awaiting the Supreme Court's review of the Ninth Circuit 's decision in Quality King v. L'Anza Research, 96-1470, in which Quality King had been held to have violated Section 602(a) of the Copyright Act. Section 602(a) prohibits the importation of copyrighted goods acquired outside the U.S. without the copyright owners' permission. Obviously, a finding of copyright liability under Section 602(a) would be a potent tool by copyright owners against grey market goods.

A second important intellectual property case now before the Supreme Court, and also from the Ninth Circuit, is Fletner v. Columbia Pictures, 96-1768. The Fletner cases will address whether judges or juries should decide statutory damages under the Copyright Act. The Ninth Circuit, as most other circuits like the Second, has always considered the issue of statutory damages to be a decision for judges, not juries.

As a matter of practice and out of respect for the deliberating court, I do not speak about pending cases before any court. Hence, I will not attempt to predict the outcome of either of these two cases. I note, however, that the Supreme Court reverses an awful lot of Ninth Circuit opinions. For the many investigators here, the Ninth Circuit is based in California and covers eight of the most western states of the Union. In the last few years, the Supreme Court has reviewed and reversed more Ninth Circuit decisions than decisions from any other Circuit. I believe last year alone, the Ninth Circuit accounted for almost twenty-five percent of the Supreme Court's docket, and only 1 or 2 of the Ninth Circuit decisions were affirmed. This statistic should give a moment of pause to anyone pleased with the Ninth Circuit's outcome in either Quality King or Feltner.

I have not had the extensive opportunity of some of my other colleagues on the district court to address cutting edge issues in the intellectual property area. For example, Judge Richard Owen, an accomplished musician, in Wood v. Bourne, 841 F. Supp. 118, *aff'd* 60 F.3d 978 (1995), had the opportunity to address the significant royalty claims generated by the use of the song “When the Red, Red Robin Comes Bob, Bob, Bobbin Along” during an extended copyright renewal term.

Judge Sidney Stein more recently issued a very instructive and important decision in Bensusan Restaurant Corp v. King, 937 F. Supp 295 (S.D.N.Y 1996), in which he dismissed a complaint on personal jurisdiction grounds involving the defendant's advertisement on Internet of a Missouri restaurant that used the name Blue Note. The Blue Note is also the name of an internationally famous jazz club based in New York. The Second Circuit just this month, on Sept 10, 1997, at 1997 WL 560048, affirmed Judge Stein's dismissal.

Although I have not been involved in cases of the same magnitude and importance as those considered by many of my colleagues, I have been fortunate to have seen a wide smattering of significant legal issues in the cases that have come before me. I cannot speak about the case because it is still before me, but many of you know that I recently issued a decision in Tasini v. New York Times, which deals with the electronic publishing rights of newspapers and magazines under Section 201 of the Copyright Act.

In my Castle Rock case, reproted at 955 F. Supp. 260, I also addressed the substantial similarity test, as well as the fair use doctrine, as those copyright concepts applied to a derivative work based upon the Seinfeld show. I have also extensively addressed the development of Second Circuit product configuration trade dress law in Krueger v. Nightingale, 915 F. Supp. 595 (S.D.N.Y. 1996).

I was recently told at a patent law conference that the Federal Circuit reverses in whole or in part an unprecedented 80 % of the cases appealed to it. With that statistic, I took some pride that my finding of inequitable conduct in one patent case, Refrac v. Lotus, was affirmed. Clearly, any judge who is a part of the Second Circuit, will eventually have interesting and significant intellectual property cases on his or her docket. As the center of domestic and international commerce in the United States, such cases will continue to be brought in our jurisdiction.

I am not saying anything new to the practitioners in this room, however, in forewarning you that you should exercise care in selecting the jurisdiction in which you bring an intellectual property case.. Circuits and district courts differ widely on the emphasis and tests they apply to many intellectual property issues. Judge Stein's in the Blue Note case held that merely listing the Missouri Blue Note on an Internet site, without selling tickets in New York, was not enough to create a presence in New York justifying the exercise of jurisdiction over the defendant under New York's long arm statute. Other courts in other jurisdictions, addressing similar issues, have read their state jurisdictional statutes more expansively.

I direct you, for example, to Inset Systems v. Instruction Set, 937 F. Supp 161 (D. Conn. 1996), in which another district court in Connecticut, which is also a part of the Second Circuit, asserted jurisdiction where the plaintiff had a registered Inset trademark and defendant obtained a domain name on the Internet as “inset.com”. In the Inset case, unlike the Blue Note decision, the Court did not require a showing that defendant had made any sales in Connecticut.

This is an interesting and unsettled area, and I know that the New York Law Journal has published several articles about the split among courts on these Internet jurisdictional issues. I refer those of you who are interested in this topic to three articles in particular: the first, by Eric Schneiderman and Ronald Kornreich is called Personal Jurisdiction and Internet Commerce, and it was published in the Journal on June 4, 1997, page 1; a second article, by Edward Brodsky, is entitled Solicitation via the Internet; Jurisdiction over Claims, and was published on June 11, 1997, page 3; the final article, Cyberspace In Court, includes a short but good discussion of the philosophical underpinnings of the current split, and was authored by Dominic Bencivenga and published on November 21, 1996, page 5.

In a different area of the law, trade dress, in the last year, Judge Oakes of the Second Circuit in Knitwaves v. Lollytogs, 71 F.3d 996, held that Judge Friendly's test in Abercrombie & Fitch for evaluating the inherent distinctiveness of trademarks was not applicable in a product configuration trade dress case. The Second Circuit in Fun-damental Too, Ltd v. Gemmy Industries Corp, 111 F.3d 993 (1997), has underscored that Judge's Oakes Knitwaves test is limited to trade dress issues involving product design and that the Abercrombie test still applies to trade dress packaging cases in the Second Circuit.

Instead of applying the Abercrombie classifications to determine whether a product is inherently distinctive, Judge Oakes limited his analysis to one question: that question is whether the product design was likely intended or was likely used “to serve primarily as a designator of origin of the product.”

Judge Oakes's adopted his test from a three question approach previously developed by the Third Circuit in Duraco Products v. Joy Products Entertainment , 40 F3d 1431, 1449 (3d Cir. 1994). In Duraco, the Third Circuit held that for a product configuration to qualify as an inherently distinctive trade dress, it must be 1) unusual and memorable, 2) conceptionally separable from the product, and 3) likely to serve primarily as a designator or origin of the product.

Both Judge Oakes in Knitwaves and the Third Circuit in Duraco developed different tests from Abercrombie for product configuration cases because each court believed that although packaging trade dress and trademarks are by their nature geared to identifying a source or producer of a product, product configurations generally suggest the product itself, not its source. Trademark protection is generally granted only to that which identifies a source, not to products, as Knitwaves pointed out, which are only aesthetically pleasing. By their tests, both the Second and Third Circuits have attempted to develop a way to separate out the practical commercial aspects of a product's configuration from its source identification.

The Eighth Circuit, on the other hand, in Stuart Hall Co. V. Ampad, 51 F.3d 780 (8th Cir. 1995), rejected the Duraco analysis and adhered to the use of the Abercrombie classifications for all trade dress cases.

My decision in Krueger discussed some of the analytical difficulties I saw with the Knitwaves test. In fact, Judge Oakes recently in a footnote in Landscape Forms v. Columbia, 70 F.3d 251 (2d Cir. 1997), accepted some of my analytical observations particularly my observation that distinguishing between a producer's aesthetic intent from source identifying intent was difficult because most producers want their products to be both aesthetically pleasing and a source indicator.

In Landscape, Judge Oakes also endorsed the use, as I had suggested in Krueger, of the evidentiary question set forth in Seabrook Foods v. Bar-Well Foods, 568 F.2d 1342 (CCPA 1977), to determine when a product was likely to serve primarily as a source indicator. Judge Oakes in Landscape described the Seabrook approach as “often decisive” in determining whether objectively a product was or was not similar to others in its market thereby making it “inherently distinctive” and thereby likely to identify a product’s source. Seabrook asks “whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicati[um] or origin.”

What does the Knitwaves test mean to you as practitioners? It means that in the Second and Third Circuits, you can not rely on the presumptions of source identification that attach to inherently distinctive designs. You will have to offer proof more akin to the proof necessary to prove secondary meaning. In order to show that you intended to have your design serve primarily as a source indicator, you will have likely have to prove both that you marketed your product design as a trademark and that the public has come to identify your design with you as the source. All of you know that developing secondary meaning evidence is very burdensome, therefore, as practitioners you will have to determine whether bringing such cases in the Second and Third Circuits makes legal and economic sense.

Ultimately, it will be the Supreme Court who decides the split among the Circuits in the trade dress configuration area, just as the Supreme Court decided a related question in Two Pesos by extending trade dress protection to a restaurant design or in Qualitex v. Jacobsen by disagreeing with courts like the Second Circuit which had not extended trademark protection to product colors which had achieved a secondary meaning. I have discussed some differences among the Circuit and District courts now only to underscore that you as practitioners must be aware that differences exist on many intellectual property questions before you bring cases in any particular jurisdiction. As attractive as the Second Circuit may be on some intellectual property questions, it may not be as expansive as other courts, as in the Internet personal jurisdiction

issue, on other questions.

In reading Judge Oakes decisions in Knitwaves and Landscape, as well as the Third Circuit's decision in Duraco, it appears that these Courts are greatly concerned with ensuring that trade dress is not used to restrict competition in potentially similar looking products. As Judge Oakes in Landscape observed, Knitwaves ensured that the "commonly-adopted ... form or ornamentation ..", autumnal patterns of leaves and squirrels on a sweater], were not granted trade dress protection. The Second Circuit in EPS Marketing v. Russ Berrie, 76 F.3d 487, a case involving similar looking troll dolls, and in L&JG Stickley v. Canal Dover, 79 F.3d 258 (1996), a case involving original and reproduction Stickley furniture, also placed great emphasis on the competitive similarity of the goods in the marketplace.

More recently, in National Basketball Association and NBA Properties v. Motorola, 105 F.3d 841, 852 1997, this theme emphasizing competition, albeit in a different context, reflected itself in the Second Circuit's conclusion that "only a narrow 'hot-news' misappropriation claim survives preemption for actions concerning materials within the realm of copyright."

In summary, I do not view the Second Circuit as hostile to the claims of property right owners but I believe, because it is the center of international and domestic commerce, that the Second Circuit also has a greater concern, than some other circuits have expressed in this area, with the need for the fullest protection of product competition permitted under law. The concern expressed by the Second and Third Circuits in Knitwaves and Duraco that product configuration does not lend itself easily to the Abercrombie test is not inconsequential.

Copyright and patent laws give only limited monopolies to their owners. Trademark and trade dress protection could potentially be unlimited and might well affect the competition among product producers. I hope all of you remember that although the courts may ultimately decide these legal issues, it is you the practitioners who will help shape the focus of the arguments and who will provide the evidence, as in Qualitex v. Jacobson or Two Pesos, that might convince the courts that applying traditional trademark or dress tests correctly could enhance, rather than restrict competition, by stimulating creative product designs and investments in promoting those designs.

The issues in this area are often interesting and always complex. We can only guess as to how the Supreme Court will ultimately resolve some of these questions, but I know that we will all watch with great interest.