



THE MASSACHUSETTS CHAPTER OF THE FEDERAL BAR ASSOCIATION

STEPHEN HANSEN • EDITOR

NEWSLETTER FALL 2013

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In-Coming President's Column

by Michelle I. Schaffer

It is wonderful to have started my term with an Executive Board that truly reflects the diverse practice areas held by members of our Chapter at-large. Collectively, we prosecute and defend claims on behalf of individuals, corporations and governmental bodies, joined in our efforts to protect the rights of all parties to fair access to our federal courts. We are both civil and criminal practitioners and our substantive law areas run the gamut of federal court practice. We have representation from the Clerk's Office and the Judiciary, and these ties will continue to facilitate our collaboration with the Court. We have participation from our Young Lawyers and Law School Divisions, each of which are eager to provide opportunities for education, networking and socializing. Our geographic representation extends westward from Boston to Worcester and Springfield where divisions of our Chapter have been formed. As a Board, we are committed to making our Chapter relevant and responsive to the many and varied interests of our membership.

At the outset, I personally want to congratulate and thank our past President Matt Moschella on his outstanding leadership. With the initiatives he put into place, our planning for the current year is well underway.

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The following highlights some of this year's projects:

- Our flagship Judicial Breakfast Series got off to a great start this year on November 5, 2013 with Judge Young leading a discussion and seeking input from the bar about "How the Court Can Do Things Better."
- A bi-monthly luncheon series of discussions with the judges has been initiated in Worcester; the first was held on October 30, 2013 on Mediation and Alternative Dispute Resolution in the Federal Court.
- The Young Lawyers Division has announced a luncheon series to provide educational, networking and mentoring opportunities for young lawyers and law students.
- We are working to bring to the Chapter additional seminars that will address federal practice areas and some will be in collaboration with other bar organizations, law schools and the Federal Litigation Section of FBA National. Because of these joint efforts, the Fall roster of events available to our members currently included these programs:
 - (a) Ethical Witness Preparation: Drawing Difficult Lines, November 6, 2013 (co-sponsor with Boston Bar Association);
 - (b) Benchmarks: Evaluating Measurements for Judicial Productivity, November 8, 2013 (co-sponsor with New England School of Law); and
 - (c) Publicity and Health Care Fraud Litigation, November 7, 2013 (Suffolk University Law School).

Many other activities are being planned:

Our Chapter was recently awarded the 2013 Community Outreach grant by the Federal Bar Foundation for the Care/Restart Interview Skills Workshop and this event took place on December 4, 2013.

We will continue to have The Pro Bono Mediation Advocates Program for *pro se* parties and are scheduling an updated training session.

Our Annual Judicial Reception, this year, honoring Magistrate Judge Robert B. Collings is being planned for the Spring.

Federal courts across the country are grappling with restrictions on spending and the continuing threat of shut down and furlough. The fragility of the federal court system could not be more palpable. We are aware of and grateful for the work that has been done within our District to minimize the impact of government shutdown on access to the Judiciary, and the administration of justice. Our goals for the year will include identifying what we can do as a group to foster our common interests in a strong, independent and efficient federal Judiciary. To that end, our Chapter Government Relations Liaison will be in close collaboration with those within the District, FBA National and other FBA Chapters.

The entire Executive Board welcomes your input and participation. Our Chapter will be made better by your involvement.

I wish everyone a happy holiday season!

Michelle I. Schaffer
President, FBA – Massachusetts



2013 FBA NATIONAL MEETING

Report from San Juan, Puerto Rico

The Federal Bar Association held its National Annual Meeting in San Juan, Puerto Rico on Thursday September 26 through Saturday, September 28, 2013. The Massachusetts Chapter was well represented. Outgoing Chapter President Matt Moschella, First Circuit Vice President Christopher Sullivan, incoming Chapter Secretary Harvey Weiner and National Delegate Jonathan Mutch all were in attendance.

At Saturday's National Council Meeting, the officers reported that the Federal Bar Association is holding steady financially and has managed to increase its ranks of members in a continuing difficult economic climate. Over 16,000 attorneys nationwide are currently members of the Federal Bar Association. Incoming President Gustavo Gelpi, United States District Court Judge for the District of Puerto Rico, was sworn in during the meeting. Continuing the focus on membership, Judge Gelpi explained his plans to form new Chapters in regions currently without a local FBA presence and to better coordinate national-level

resources to help existing Chapters grow their memberships.

The Saturday meeting took place as the federal government shutdown loomed. The chair of the Government Relations Committee, West Allen of Las Vegas, reported on his recent testimony before a Congressional panel on the negative impact of budget reductions, such as sequestration, to the federal courts and those served by the courts. Mr. Allen explained the FBA's role as a voice for the federal court system constituency, and encouraged Chapters and individual members to contact their Congressional leaders.

On Saturday night the Installation Dinner for incoming President Gelpi was held in the Grand Ballroom the Hilton Caribe Hotel. One highlight of the dinner, certainly for the Massachusetts Chapter, was outgoing President Bob DeSousa presenting our own Matt Moschella with the Presidential Award for service to the Federal Bar Association. Congratulations, Matt!

The next upcoming National Council meeting will be Saturday March 29, 2014 during the FBA Mid-Year meeting (held annually in Washington, D.C.) and then on Saturday September 6, 2014 during the 2014 Annual Meeting in Providence, Rhode Island.

Pictured: Massachusetts Chapter members participated in a Joint Army-FBA reception for Camp Edwards Day on June 1-2, 2013. In the photo is current Massachusetts Chapter Secretary Harvey Weiner.



Updates from the Clerk's Office

by Robert J. Farrell

The Clerk's Office has weathered the stormy beginning to Fiscal Year 2014. Hopefully a budget will be passed and signed into law before mid-January. In addition to the beginning to the new fiscal year, the Court has announced important changes to the bench.

In August, Judge Joseph L. Tauro advised President Obama that he would be taking senior status as of September 26, 2013. Judge Tauro has served as a Judge of the United States District Court since 1972. He was elevated to the position of Chief Judge in January 1992 and served in that capacity until January 1999. His public service prior to being appointed to the bench included that as United States Attorney for Massachusetts, Chief Legal Counsel to the Governor of Massachusetts, and two years in the Army as a Nike Guided Missile Officer.

In October, Judge Edward F. Harrington announced that he will assume inactive status effective December 31, 2013. Judge Harrington served as a United States District Judge for over 25 years and, before his judicial appointment, as an attorney for the United States Department of Justice in Washington, D.C. and in Boston in various positions for over 15 years. Those positions included United States Attorney and Chief of the Organized Crime Strike Force. He was a member of a select group of attorneys sent by Attorney General Robert Kennedy to Mississippi during the "long hot summer of 1964" to protect the rights of college students, who were conducting schools in voter registration there.

Press releases announcing both Judges' decisions may be found on the court's website.

On September 24, 2013, President Obama nominated Mark G. Mastroianni and Indira Talwani to district judgeships with the District of Massachusetts.

Mr. Mastroianni has been nominated to fill the seat in Springfield created when Judge Michael Ponsor took senior status on August 15, 2011. Ms. Talwani was nominated to fill the seat in Boston created when Judge Mark L. Wolf took senior status on January 1, 2013.

The Court continues to reach out, through the FBA, other bar associations and with Discovering Justice to provide meaningful training opportunities to the bar and to the community it serves. On October 2, 2013, the court hosted a Discovering Justice program with South African Justice Albie Sachs. Justice Sachs discussed differences between the American and South African constitutions and the social reasons behind those differences. On October 16, 2013, the court hosted a young lawyers' round table. Chief Judge Patti Saris, Judge George O'Toole, Judge Denise Casper, Judge Timothy Hillman, Chief Magistrate Judge Leo Sorokin, Magistrate Judge David Hennessy, Chief Bankruptcy Judge Frank Bailey and Bankruptcy Judge Melvin Hoffman participated in discussions with a group of 80 young lawyers. On October 30, the Court sponsored a seminar with Professor Charles Ogletree and Johanna Wald, both of Harvard Law School's Charles Hamilton Houston Institute for Race and Justice, on "Confronting Subconscious Bias."

CM/ECF NEWS:

Did you know that you can link your PACER account to your ECF account?

You may link your PACER Account to your CM/ECF account in one of two ways: by going to the Utilities menu in ECF and clicking on "Change your PACER Login" or by going to PACER. Either choice will bring the user to a PACER login screen. Immediately above the login portion of the screen, a check box may be found to "Make this my default PACER login." Click on that box and CM/ECF will automatically log into PACER when the user runs a query or other report.

FBA EVENTS



Reception for the Swearing in Ceremony of Clerk Robert J. Farrell on October 25, 2013. Pictured (left): Robert J. Farrell, Miriam Conrad, and Lisa M. Tittlemore. Pictured (right): Matthew C. Moschella, Robert J. Farrell, Michelle I. Schaffer, Harvey Weiner, Jonathan D. Mutch, and Christopher P. Sullivan.



The Massachusetts Chapter of the Federal Bar Association held a welcoming reception for incoming Chief Judge Patti B. Saris at the John Joseph Moakley Federal Courthouse on February 27, 2013.

Young Lawyers Division (YLD) Fall Updates

By Jennifer L. Ioli, Sherin and Lodgen, LLP

On September 17, 2013 the Federal Bar Association's Young Lawyers Division (YLD) held a mock interview program for Boston University Law School students. The program took place during the annual "on campus interviewing" period at Boston University and was designed to assist law students by offering practice interviews, extra opportunity for interviewing skills feedback, and a sounding board for student questions about the interviewing process and the legal community. Three YLD Board Members – Michelle Hinkley, Catherine Lizotte, and Stephen Hansen – met with ten current BU Law School second year students. The YLD Board received positive feedback from both the students involved and the BU Career Development Office. The YLD plans to return to Boston University for another program and expand the program to other area law schools in the coming year.

On October 25, three YLD board members – Michelle Hinkley, Erika Reis, and Jennifer Ioli – attended the swearing in ceremony for Clerk Robert M. Farrell at the federal court. These board members also attended the November 5, 2013 "Breakfast with the Bench" event at the federal court, featuring Judge Young.

On October 23, the YLD held its second meeting of the year with its 2013-2014 board members. The YLD board discussed the plans for the upcoming year and is excited to announce that the YLD will be launching its own LinkedIn page!

On December 11, the YLD began the first of three lunch panel discussions for young attorneys. The first YLD "Brief Bites" lunch was held at City Hall, and featured speakers Eve Piemonte-Stacey and Scott Lopez. Lopez, of Lawson and Weitzen, LLP and Assistant United States Attorney Piemonte-Stacey discussed their experiences practicing criminal law in federal court. Over twenty young attorneys attended.

The YLD's next lunch is scheduled for February 26, 2014 at the John Joseph Moakley Federal Courthouse. The YLD is honored to welcome Magistrate Judge Judith Dein as its next speaker.

The U.S. Supreme Court Rules On A Crucial Class Action Dispute (*Standard Fire Ins. Co. v. Knowles*)

By Patrick M. Curran, Ogletree, Deakins, Nash, Smoak & Stewart, P.C.

On March 19, 2013, the U.S. Supreme Court decided its first Class Action Fairness Act ("CAFA") case, *Standard Fire Insurance Co. v. Knowles*. The closely-watched case, which drew *amicus curiae* briefs from a large number of business groups, public interest organizations, and insurance companies, required the Court to decide whether a plaintiff could defeat removal under CAFA by stipulating to limitations on damages sought, for himself and the absent putative class members, to less than the \$5 million jurisdictional threshold.

The named plaintiff in the case, Greg Knowles, filed his class action complaint against Standard Fire Insurance Company ("Standard," or the "Company") in Arkansas state court after suffering property damage in a 2010 hailstorm. He alleged that Standard had underpaid claims for property damage that he and other covered Arkansas homeowners had incurred by refusing to pay charges associated with the homeowners' retention of general contractors in repairing the damage that they had suffered. In an apparent effort to avoid federal jurisdiction, Knowles alleged only state-law claims, limited his definition of the class to residents of Arkansas, and asserted both that no individual class member's claim exceeded \$75,000 and that the aggregated damages of all class members did not exceed \$5 million. In addition, Knowles stipulated (in the complaint itself and in a stipulation attached to it) that he would not seek damages exceeding \$75,000 for any class member, and that he would not seek class damages in excess of \$5 million.

Standard removed the case to federal court, and Knowles responded by filing a motion to remand on the ground that the necessary amount in controversy had not been met. The district court granted the motion to remand, and Standard filed a petition for permission to appeal to the U.S. Court of Appeals for the Eighth Circuit. The Court of Appeals denied the petition, prompting Standard to file a petition for certiorari. The Supreme Court granted Standard's petition on August 31, 2012.

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In its briefs and at oral argument before the Court, Standard argued that the term “claim,” as it is used in the CAFA provision that establishes the method for calculating the amount in controversy by aggregating the class members’ “claims” (codified at 28 U.S.C. § 1332(d)(6)) refers not to the amount actually sought by the individual class members, but rather to each member’s total right of recovery (based on the facts and allegations specific to the case). Standard also attacked Knowles’s effort to avoid CAFA jurisdiction by means of his stipulation on a number of grounds. The Company argued, for example, that the stipulation could not bind other class members, and that it did not even bind Knowles himself adequately because it merely stated that he would decline to “seek” damages in excess of the CAFA amount, not that he would decline to “accept” such damages if they were awarded to him. Standard also argued that Knowles’s decision to limit damages to those suffered during a two-year period, in order to stay under the CAFA amount, despite the five-year limitations period for his asserted claims would violate the putative class members’ due process rights and was therefore ineffective. According to Standard, then, the stipulation was non-binding and could not prevent Knowles from amending the complaint to seek additional damages in the future – and as a result, it also could not prevent the satisfaction of CAFA’s jurisdictional amount and removal to federal court.

Knowles, for his part, relied on the long-established principle that the plaintiff is the master of his complaint and may therefore limit not only the claims that he chooses to assert, but also the damages for which he demands recovery in connection with those claims. Standard’s interpretation of Section 1332(d)(6), according to Knowles, would undermine that fundamental rule without any clear statement from Congress that it intended to do so. Knowles also argued that Standard’s concerns about amendment were unfounded, since in the event of such an amendment there would be nothing to prevent Standard from seeking removal at that time (Congress having removed the one-year limitation on diversity-based removal in CAFA). Similarly, Knowles argued that Standard’s concerns about the rights of absent class members were premature because Knowles and

his counsel could not make decisions affecting those rights until after class certification – and the trial court could act to protect those rights, to the extent that it found them to be affected adversely by Knowles’s stipulation, at the class certification stage by denying certification for failure to satisfy the adequacy of representation requirement.

At the argument on January 7, counsel for both sides were questioned closely by the Justices, particularly Chief Justice Roberts and Justices Kagan, Alito, and Breyer. The Chief Justice, for example, described Standard’s effort to limit the plaintiff-as-master-of-his-complaint principal as “a bit of a slippery slope,” while Justice Kagan expressed similar concerns that Standard’s attack on stipulations like Knowles’s could lead to restrictions on a plaintiff’s ability to define the claims and name the defendants, and amounted in effect to a request that the Court “blow up the whole world.” Justice Alito, for his part, focused on the potential for abuse of such stipulations, observing that it would be “perverse” if they were permitted to bind absent class members, while Justice Breyer noted a discrepancy between CAFA’s text, which he said seemed to favor Knowles’s position, and its purpose, which he characterized as “seem[ing] to strongly cut the other way.” Justice Breyer also suggested a potential interpretation of Section 1332(d)(6) that would strike a compromise between the parties’ positions: that the trial court, in determining the amount in controversy, should aggregate “the real value of the real amounts that the class is likely to have.”

Ultimately, the Supreme Court unanimously reversed the decision in the lower court and concluded that class counsel cannot avoid removal through a precertification stipulation limiting damages to less than the federal jurisdictional amount. In an opinion by Justice Breyer, the Supreme Court described its rationale as “a simple one: Stipulations must be binding.” Conceding that such a stipulation would be binding in non-class litigation, the Court described the stipulation in a class action as being “contingent” because a class representative cannot bind unnamed class members until the class is certified. Therefore, the Court found that only Knowles himself was bound by his stipulation, and as such, could not avoid removal of the class action.

The First Circuit's Decision in *Nystedt v. Nigro* and the Reach of Quasi-Judicial Immunity

By Jillian B. Hirsch, Day Pitney LLP

The First Circuit Court of Appeals examined the reach of quasi-judicial immunity in *Nystedt v. Nigro*, No. 12-1245, 2012 U.S. App. LEXIS 23947 (1st Cir. Nov. 20, 2012). In particular, the Court considered -- for the first time -- whether the doctrine protected the actions of a court-appointed discovery master. In affirming the lower court's decision, the Court ruled that a court-appointed discovery master, in carrying out his duties, is "functionally indistinguishable from a trial judge" and, therefore, "share[s] a judge's immunity from suit." *Id.* at *11.

At the outset, the *Nystedt* case began as a simple will contest. Evan Nystedt died in 2004. Thereafter, his attorney, Earl Munroe, offered his will for probate. The court provisionally appointed Munroe as executor; however, when it became apparent that Munroe had used his position to squander estate assets, Evan Nystedt's closest living relative, Douglas Nystedt ("Nystedt"), initiated a will contest. In connection with that will contest, the probate court appointed a discovery master, Eugene Nigro ("Nigro"), "to monitor the discovery process" and ensure "full[] compl[iance] with [] reasonable [discovery] requests" "on a timely basis." *Id.* at *2-3.

In May 2006, Nystedt sought to oust the special master, claiming that he had done a poor job of facilitating discovery and that he had engaged in *ex parte* communications with Munroe's counsel. Nystedt's efforts were unsuccessful, and the case went to trial in 2007. Following the trial, the court disallowed the will, leaving Nystedt as the sole beneficiary of the estate. On appeal, the decision of the lower court was affirmed; by that time, however, the value of the estate had been greatly diminished, and Nystedt had incurred more than \$200,000 in legal fees.

Thereafter, Nystedt brought suit in U.S. District Court in Massachusetts against a number of defendants, including Nigro and his law firm, alleging, among other things, violations under the Racketeer Influenced and Corrupt Organizations Act, 18 U.S.C. §§ 1961-1968 and common

law conspiracy for having prolonged the will contest and causing the value of the estate to plummet. Nigro and his firm moved to dismiss the complaint on the basis of quasi-judicial immunity. The district court granted the motion and an appeal followed.

The First Circuit Court of Appeals ruled that Nigro was entitled to quasi-judicial immunity and affirmed the district court's decision. Quasi-judicial immunity, the court explained, "provides absolute immunity for those who perform tasks that are inextricably intertwined with the judicial function" (*id.* at *10) or, in other words, "the adjudication of disputes between parties" (*id.* at *12). Nystedt argued that Nigro was acting in a non-judicial capacity in several respects, namely when he engaged in *ex parte* communications with Munroe's counsel and when he sent to the court invoices for services rendered as discovery master. The court disagreed, concluding that all of the discovery master's actions fell squarely within the boundaries of quasi-judicial immunity because they were "intimately associated with the adjudication of discovery disputes." (*Id.*) With respect to the invoices, they were sent at the direction of the court, which had instructed Nigro to bill for his services at his standard hourly rate. With respect to the *ex parte* communications, there was no allegation or evidence that those communications pertained to anything other than Nigro's work as the court-appointed discovery master. As the court emphasized, "that a court-appointed discovery master performs a judicial function in an imperfect (or even unethical) way does not, by itself, dissolve his quasi-judicial immunity." (*Id.* at *13-14.)

A Covenant Not to Sue Can Disable a Competitor's Trademark Cancellation Action – But at What Cost?

By Steven A. Abreu, Sunstein Kann Murphy & Timbers LLP

A company's covenant not to sue for infringement of a trademark, if broad enough, can deprive a court of jurisdiction to consider a competitor's counterclaim seeking the cancellation of the asserted mark. So held the U.S. Supreme Court in *Already, LLC v. Nike Inc.*

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which addressed Nike's allegation of infringement against a much smaller company.

Nike had already forced many small makers of similar shoes to drop their designs, but Already showed some fight. It counterclaimed against Nike, seeking to cancel Nike's trade dress registration covering the design aspects of the Air Force 1 shoe.



Nike voluntarily gave Already a broadly worded covenant not to sue it for infringing the Air Force 1 trademark. A federal trial court concluded that it could no longer consider Already's bid to invalidate the registration because, once the covenant was granted, there was no longer a case or controversy, so the Court lacked subject matter jurisdiction. Article III of the Constitution grants to the judicial branch the authority to adjudicate "cases" and "controversies."

Nike's covenant not to sue stated that "Already's actions... no longer infringe or dilute the Nike trademark at a level sufficient to warrant the substantial time and expense of continued litigation." Nike further promised not to raise against Already any trademark or unfair competition claim based on any of Already's existing footwear designs, or any future design that constituted a "colorable imitation" of Already's current products. Nike argued that its covenant not to sue and its motion to dismiss its own claim with prejudice deprived the court of jurisdiction to consider the cancellation counterclaim

because no case or controversy remained. Over Already's objection, the trial court judge agreed with Nike and dismissed the counterclaim, stating that because Already sought "to invoke the Court's declaratory judgment jurisdiction, it [bore] the burden of demonstrating that the court has subject matter jurisdiction over its counterclaim." The Court of Appeals agreed, and Already appealed to the Supreme Court.

Several amicus briefs were filed. Those taking Already's side view Nike as a large manufacturer intimidating its smaller competitors, disrupting their distribution channels with the threat of litigation based upon a possibly invalid trademark, then backing away once the damage had been done, preserving for a later day the possibility of asserting the trademark against someone else.

The Supreme Court was sensitive to this concern and was critical of the courts below for imposing on Already the burden of establishing that proper jurisdiction existed after the issuance of the covenant not to sue. Relying on what it called the "voluntary cessation doctrine," the court held that Nike, not Already, bore the "formidable" burden of proving that no case or controversy remains.

Yet the Court held that Nike had met this burden by showing that its trademark enforcement action against Already "could not reasonably be expected to recur." Nike had included in its covenant not to sue an irrevocable and broad promise to both Already and its distributors that it would not bring suit against either of the lines of sneakers in question or any sneakers which were a "colorable imitation" of the current sneakers.

By implication, sneakers which were not a "colorable imitation" of Already's existing sneaker designs would not be confusingly similar to Nike's Air Force 1 registered trade dress, because to qualify as something other than a colorable imitation, they would have to contain numerous differences. It would be these numerous differences that would keep the new shoe design from being confusingly similar to Nike's trade dress registration.

In support of its argument that a case or controversy

By Benjamin Stern, Holland & Knight

On November 6, 2013, the Massachusetts Chapter co-sponsored a CLE with the Litigation Section and the Federal Practice and Procedure Committee of the Boston Bar Association titled “Ethical Preparation of Witnesses: Drawing Difficult Lines.” The program featured Dan Small, of Holland & Knight, a nationally recognized expert on witness preparation.

Small, who has published a well-regarded ABA book on witness preparation, began the program by offering general observations. He first discussed the “gap” between what a witness may know about a case and about testifying and what the attorney may know. Too often, attorneys assume that witnesses are (or should be) more familiar with the process than they actually are. As a result, attorneys and witnesses may not develop the rapport necessary to have an effective session. Small then shared his “Top 10” rules for witness preparation. The first rule, from which all others flow, is to tell witnesses to “take their time.” Another rule, which is a corollary of the first, is to tell witnesses that they must remember they are making a written record. Preparing a witness is, to a large degree, getting them in the right frame of mind. Too often witness prep. is rushed, but it is important to remember that cases are often won in depositions or other non-trial testimonial settings. Offering repeated practice examination can be the difference between an effective witness and one that opposing counsel runs roughshod over in questioning.

Small identified ethical issues that may crop up during witness preparations. For example, the oath a witness takes isn’t simply to tell “the truth,” but the “whole truth” (which means both good and bad stuff) and “nothing but the truth” (which means what the witness saw, heard, or did). He pointed out the inherent tension between the ethical rules requiring that attorneys prepare witnesses and the search for “the truth” in a witness’ testimony. Although we are all aware of obvious perjury issues, there are other, more subtle forms and challenges that can get the unwary lawyer in trouble. Small challenged the audience to explore the line between coaching a witness during preparation and explaining to a witness the legal framework for the case.

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survived this broad covenant, Already noted that its investors had been scared off from investing in Already based not only on Nike’s infringement action, but also on its continued registration of the Air Force 1 trade dress design. Already also argued that the covenant was not broad enough to protect all of Already’s future shoe designs.

In essence, Already argued that the Sword of Damocles continued to swing above its head. However, the Supreme Court was not impressed and noted that Already was unable, despite express invitations to do so both in oral argument before the Supreme Court and in the lower courts, to come up with any design that would expose it to the prospect of liability.

In a separate concurrence, Justice Kennedy, joined by three other justices, wrote that “courts should proceed with caution before ruling that covenants not to sue can be used to terminate litigation. . . to ensure that covenants are not an automatic mechanism for trademark holders to use courts to intimidate competitors without, at the same time, assuming the risk that the trademark will be found invalid and unenforceable.”

While the covenant not to sue certainly helped Nike in this case, offering such a covenant should remain a strategy of last resort because the covenant must be very broad in order to achieve the litigation-ending effect that Nike achieved. Being unable to police one’s trademarks against a competitor can lead to the weakening of protection of the marks against the entire industry because it allows competitors to introduce similar marks to consumers. This in turn lessens a mark’s distinctiveness and hampers policing efforts against third parties, because a more crowded field of similar marks now exists.

Further, any competitor now alleged to infringe Nike’s Air Force 1 registration knows that an effective response strategy is to threaten to cancel their registration. Thus, although Nike did not have to defend its trademark registration from cancellation, it gave up a lot of ground to Already and to the entire athletic shoe industry.

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