

RAYMOND A. JOAO, ESQ.  
122 BELLEVUE PLACE  
YONKERS, NY 10703  
(914) 969-2992

April 8, 2003

BY FEDERAL EXPRESS

Thomas J. Cahill, Esq.  
Chief Counsel  
Departmental Disciplinary Committee  
Supreme Court, Appellate Division  
First Judicial Department  
61 Broadway  
New York, New York 10006  
Attention: Mr. Joseph G. Wigley

RECEIVED  
APR 10 2003  
10:20 AM  
JUDICIAL DEPARTMENT  
NEW YORK

Re: Complaint of Mr. Eliot I. Bernstein  
Docket No. 2003.0532

Dear Mr. Cahill:

This is my response, pursuant to 22 NYCRR § 605.6(d), to the Complaint of Eliot I. Bernstein, president of Iviewit Holdings, Inc. ("Iviewit"), dated February 26, 2003 ("the Complaint").

I hereby deny each and every one of the general and specific allegations in the Complaint. Those allegations are simply untrue.

In addition, the allegations in the Complaint are vague and unsubstantiated and do not allege specific violations of the Disciplinary Rules of the Code of Professional Responsibility.

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 2

Finally, I believe that the Complaint was filed in retaliation to an action that Proskauer Rose LLP ("Proskauer") has brought against Iviewit to recover substantial unpaid legal fees.

For the reasons set forth below, I respectfully request that the Office of Chief Counsel recommend to the Committee that the Complaint against me be dismissed without referral.

**I. THIS ANSWER IS BEING FILED WITHOUT HAVING ACCESS TO THE PERTINENT IVIEWIT PATENT FILES.**

I do not have access to any of the Iviewit files and documents, retainer agreements (where applicable) or client correspondences that Mr. Bernstein apparently relied on in order to file the Complaint.

Upon receiving the Complaint, I contacted Arnold Klein, Esq., a partner of the Mineola, New York law firm of Meltzer, Lippe & Goldstein and requested access to its files for Iviewit, including any retainer agreements. During the time period of the Complaint, I was Of Counsel and Head of the Intellectual Property/Technology Rights Group of Meltzer, Lippe, Goldstein & Schlissel, the predecessor law firm of Meltzer, Lippe & Goldstein (collectively, "MLG"). Mr. Klein informed me, however, that MLG no longer had its Iviewit files because, in or about May of 2000, it sent its original files to the Wisconsin office of the law firm of Foley & Lardner.

I then contacted Foley & Lardner attorney Steven Becker who informed me that its original Iviewit files had been transferred to the Los Angeles Office of Blakely, Sokoloff, Taylor & Zafman.

Upon contacting Blakely, Sokoloff, Taylor & Zafman, I was informed by Farzad Amini that Blakely, Sokoloff, Taylor & Zafman is Iviewit's patent counsel, and he refused to provide me with a copy of any documents in the Iviewit files that are pertinent to the Complaint without Iviewit's approval.

In view of my inability to obtain a copy of any documents in the Iviewit files that are pertinent to the Complaint, I must qualify all of the responses relating thereto as being based on my memory and/or from research I performed on publicly accessible computer databases.

**II. MY BACKGROUND AND PERTINENT INFORMATION REGARDING MYSELF.**

I have BS and MS degrees (1982 and 1984, respectively) in Electrical Engineering from the Columbia University School of Engineering and Applied Science. I have approximately six years of engineering work experience for defense contracting firms where I worked on various electrical and electronic systems relating to radar, sonar, microprocessor-based digital computers, and electronic warfare threat detection systems.

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 4

I received my JD degree from the St. John's University School of Law in 1990. I was admitted in the Second Department in January 1991. I am admitted to practice before the United States Patent & Trademark Office as a Patent Attorney.

In 1999, I received an MBA in Finance from Baruch College of the City University of New York. I am currently enrolled in an MS Marketing program at Baruch, and I expect to receive that degree in due course.

In 1992, I began filing patent applications for my own inventions. To date, I have been awarded fifteen (15) United States Patents and have numerous other patents pending. I am currently devoting my full-time efforts towards commercializing my various intellectual properties.

On July 18, 1996, I filed a patent application in my name that disclosed a remote-controlled control, monitoring and/or security apparatus and method for vehicles, motor vehicles, marine vessels and vehicles, aircraft, recreational vehicles, residential premises and/or commercial premises. This patent application was allowed and was issued as United States Patent No. 5,917,405 (the "405 Patent") on June 29, 1999. A true copy of the 405 Patent is attached hereto as Exhibit A.

Among the many things disclosed in the 405 Patent is the use of a video recording device or a camera for providing respective video information, a picture, or an image, to a device by transmitting the respective video information, picture, or image, on or over a communication network or system. The communication network or system can be any

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 5

communication network or system. The 405 Patent also discloses transmitting video information, a picture, or an image, on or over the Internet and/or the World Wide Web.

The 405 Patent also discloses the use of an audio recording device for providing audio information to a device by transmitting the audio information on or over a communication network or system. The communication network or system can be any communication network or system. The 405 Patent also discloses transmitting audio information on or over the Internet and/or the World Wide Web.

The 405 Patent also discloses an apparatus and method which can be used to any one or more of control, activate, deactivate, enable, and/or disable, any one or more of the vehicles, premises, systems, equipment systems, subsystems, equipment, devices, components, or appliances, disclosed in the 405 Patent via, on, or over, a communication network or system. The 405 Patent also discloses controlling any one or more of a video recording device, a camera, an audio recording device, a microphone, a tape recorder, etc., via a communication network or system. The 405 Patent also discloses performing any of the control, activation, deactivation, enabling, and/or disabling, operations on or over the Internet and/or the World Wide Web.

In April 2002, I received significant media attention and recognition for the 405 Patent for a use of the technology in controlling and/or monitoring aircraft remotely and for providing the capability of obtaining video information from an aircraft and/or for providing the capability of obtaining audio information from an aircraft. A copy of a

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 6

New York Newsday article, dated April 22, 2002, is representative of the attention that I received for the 405 Patent and is attached hereto as Exhibit B.

**III. MY EMPLOYMENT RELATIONSHIP WITH MELTZER, LIPPE, GOLDSTEIN, & SCHLISSSEL**

In February of 1999, I joined the law firm of Meltzer, Lippe, Goldstein & Schlissel, the predecessor of MLG, in an Of Counsel capacity and as Head of the Intellectual Property/Technology Rights Group. I joined that firm to assist its efforts to restart an Intellectual Property Group after the previous group, which included Kenneth Rubenstein, Esq., had left in 1998 to join the Proskauer firm. I resigned from Meltzer, Lippe, Goldstein & Schlissel on April 19, 2000.

I was never a partner at Meltzer, Lippe, Goldstein & Schlissel or its successor firm, MLG. I have never represented myself as being a partner of Meltzer, Lippe, Goldstein & Schlissel or its successor firm MLG, and I am not aware of any such misrepresentations made to that effect to Iviewit by any third party.

Similarly, at no time was I ever a partner of Proskauer. I have never represented myself as being a partner of Proskauer, and I am not aware of any such misrepresentations made to that effect to Iviewit by any third party.

In or about February or March 1999, Mr. Rubenstein, who at the time was at Proskauer, contacted me to say that he was referring Eliot Bernstein to me because Mr. Bernstein had invented a new process or technique for compressing image and/or video information. Shortly thereafter, I had a conversation with Mr. Bernstein who informed

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 7

me that he had invented a new process or technique for performing a compression of an image file, that he was in the process of forming a company, and that he wanted to file a patent application for his invention. Mr. Bernstein asked me various questions concerning my experience and qualifications. Since these were questions which a competent businessman would and should ask in qualifying an attorney and especially a patent attorney, I provided him with information concerning my credentials and experience. I informed Mr. Bernstein that I had substantial experience in drafting and prosecuting high technology inventions and especially those relating to Internet and/or World Wide Web technologies. I also informed Mr. Bernstein that I was an inventor and that I had number of patents and patents pending for numerous inventions of my own. I described to Mr. Bernstein the general subject matter relating to my then soon-to-be issuing 405 Patent and some of its various features regarding transmitting video information *via* the Internet and/or the World Wide Web. I also explained to Mr. Bernstein that I specialized in helping inventors and start-up companies in developing patent portfolios to help them build and sustain a competitive advantage.

Sometime after the issuance of the 405 Patent on June 29, 1999, I informed Mr. Bernstein of the issuance of that patent and its patent number. I had discussed the 405 Patent with Mr. Bernstein from time to time. I would sometimes use my own patents as a teaching tool to show how non-provisional applications can be drafted and how inventive activities should be pursued in order to build upon innovations. Mr. Bernstein told me that he had read the 405 Patent.

With regard to payment for legal services, Mr. Bernstein informed me that, because Iviewit was in the start-up phase, he would only be able to pay, to the best of my recollection, from between \$3,000 and \$3,500 for a patent application. I informed him that this financial limitation would not be acceptable to Meltzer, Lippe, Goldstein & Schlissel in view of the effort and time typically required to prepare such an application.

On account of the inability of Iviewit to pay for a patent application, I informed Mr. Bernstein that I could instead prepare and file a provisional patent application. I explained that, by filing a provisional patent application, he could at least receive a "patent pending" status for his invention. In this regard, I told Mr. Bernstein that a provisional patent application is not a true patent application, but rather a so-called "time stamp". It is not a true patent application because no patent can ever issue from it. Rather, it is a priority document to enable an inventor to obtain "patent pending" status for an invention for a one-year period. In order to obtain a patent, an inventor must file a non-provisional patent application within one year of the provisional patent application filing date and claim the benefit of the priority of the previously filed provisional application. If a non-provisional application is not filed within the required one year time period, the ability to claim the priority to the filing date of the provisional application is forfeited. A priority date is key in determining patentability of an invention, as it is the date upon which the prior art relating to an invention is determined.

Upon Mr. Bernstein's insistence that he needed "patent pending" status to protect his invention, and given his financial constraints, I informed him that I would draft a



provisional patent application that would include only the information that he provided to me. I also informed him that I would prepare the first provisional patent application in the format of a more detailed non-provisional patent application for about \$3,000. I further informed Mr. Bernstein that Meltzer, Lippe, Goldstein & Schlissel and I would only undertake such a task if he signed a Retainer Agreement acknowledging that he understood the nature of a provisional patent application and that he agreed that I would only prepare a provisional application and no more. Mr. Bernstein agreed to these terms by signing a written Retainer Agreement, which MLG no longer has.

In the ensuing months, Mr. Bernstein came up with additional ideas for which he wanted to file patent applications. Provisional patent applications were filed for each of these alleged inventions as well.

In an attempt to ascertain the identity of the applications prepared and/or filed by me, on behalf of Iviewit, I conducted research using publicly accessible information. To the best of my knowledge, I prepared and/or filed the following eight provisional patent applications:

<u>Filing Date</u>	<u>Provisional Application Serial No.</u>
March 24, 1999	60/125,824
June 3, 1999	60/137,297
June 7, 1999	60/137,921
June 29, 1999	60/141,440
August 2, 1999	60/146,726
August 19, 1999	60/149,737
September 22, 1999	60/155,404
December 8, 1999	60/169,559

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 10

Some of the above provisional patent applications were prepared in the more detailed format of a non-provisional patent application, while others were filed in a brief invention disclosure format. Each application was filed with Mr. Bernstein's direction, knowledge, and approval.

On March 10, 2000, pursuant to Mr. Bernstein's directions and within the required one-year time period, I filed a non-provisional patent application claiming priority to the March 24, 1999 provisional patent application. This non-provisional patent application was assigned U.S. Patent application Serial No. 09/522,721.

On or before March 24, 2000, I also recall filing a Patent Cooperation Treaty ("PCT") application with the United States Patent & Trademark Office. I have been unable to locate any information regarding this PCT application.

A PCT application is not a true patent application, *i.e.* it cannot issue as a patent unless an application is made to enter a national or regional stage for a particular country or region, respectively. Instead, a PCT application can be described, in a simple manner, as being a document that can be relied upon for priority in order to file a patent application in any desired number of PCT signatory countries or regions throughout the world. In essence, a PCT is a "time stamp" that can allow an inventor or applicant to file patents in any one or more of the 85 plus national patent offices (countries) or regional patent offices, which are signatories of the PCT Treaty, for up to 30 months from the original patent application filing date (*i.e.* an earliest filed and claimed provisional or non-provisional application). In effect, the PCT application allows an inventor to secure

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 11

an option to file patents in the signatory countries or regions for generally up to 30 months from the earliest application priority date. If no national or regional application is filed for a particular country or region within that 30 month time period, the PCT application priority right is forfeited as to those countries or regions for which filings had been foregone.

#### **IV. MY PROCEDURE IN PREPARING AND FILING A PROVISIONAL OR NON-PROVISIONAL PATENT APPLICATION.**

I follow a standard procedure in preparing and filing a patent application. Upon receiving an invention disclosure and/or meeting with an inventor, I draft the patent application. Depending upon the format of the application, I prepare a draft document and transmit a copy of it to the inventor and await comments or revisions. I then review those comments or revisions from a technical and legal standpoint. If I make changes to the first draft, I send the revised, second draft to the inventor for his or her approval. This process is repeated as necessary until the inventor approves of the final form of the application and instructs me to file the document. When a provisional patent application was to be filed from an invention disclosure, this procedure may or may not be followed. Only upon receiving the inventor's final approval to file the document, would I then file the approved version of the document as the respective provisional or non-provisional patent application.

I followed this procedure, when applicable, with regard to Mr. Bernstein's and Iviewit's patent applications, whether they were provisional, non-provisional, or PCT, in nature.

**V. RESPONSES TO THE ALLEGATIONS OF THE GENERAL COMPLAINT**

This section addresses the allegations set forth in the Complaint. All of the allegations accusing me of misconduct or a failure to use reasonable care are denied. Further, these allegations lack a factual basis and are false.

On page 1 of the Complaint, it is alleged that I was initially misrepresented to Iviewit as being a partner of Proskauer and that I was allegedly a partner of Meltzer, Lippe, Goldstein & Schlissel. This allegation is false. Neither I nor anyone else, to my knowledge, represented to either Iviewit or Mr. Bernstein that I was a partner of Proskauer or a partner of Meltzer, Lippe, Goldstein & Schlissel.

On page 2 of the Complaint, Mr. Bernstein alleges that he "engaged the services of Proskauer and in turn Joao, among others, through an engagement letter" attached as Exhibit "A". I did not receive a copy of this alleged engagement letter when the Office of Chief Counsel sent me the Complaint. Further, I am not aware of any arrangement between Proskauer and its clients that would have engaged either Meltzer, Lippe, Goldstein & Schlissel or myself. As I stated earlier, Mr. Bernstein executed a Retainer Agreement with Meltzer, Lippe, Goldstein & Schlissel for the purpose of having me

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 13

prepare his March 1999 provisional patent application. This Retainer Agreement did not include Proskauer.

Mr. Bernstein's allegation that "Joao upon viewing the technologies developed by Bernstein, and held by the Company, realized the significance of the technologies, its various applications to communications networks for distributing video data images and for existing digital processes, including, but not limited to digital cameras, digital video disks (DVD), digital imaging technologies for medical purposes and digital video", to the extent understood, is denied in its entirety. Mr. Bernstein's alleged innovations involved digital image file compression techniques and/or digital video file compression techniques which were directed to what could be described to a lay person as a high tech processing or development of a digital rendition of an image or a video. As described above, various applications of transmitting images or video in a communication network were invented by myself as early as 1996. I have never ventured into the field of video file compression or image file compression. Further, Mr. Bernstein was aware of my 405 Patent as early as the summer of 1999. I deny appropriating any of Iviewit's alleged technologies.

I deny any allegations that malfeasances were perpetrated against Iviewit. I further deny that any fraud was perpetrated by myself against the U.S. Patent and Trademark Office.

**VI. RESPONSES TO THE SPECIFIC ALLEGATIONS OF THE GENERAL COMPLAINT**

I deny the allegation that I did not use reasonable care in performing legal services for either Iviewit or Mr. Bernstein. At all times, I provided Iviewit and Mr. Bernstein with the highest degree of care and attention.

My responses to each of the specific allegations are provided below.

A. I deny the allegation that I failed to take reasonable care to ensure that the intellectual property of Iviewit was protected. To the contrary, to the best of my recollection and through independent research, without having access to the Iviewit files, during the period from March 1999 through March 2000, I, through Meltzer, Lippe, Goldstein & Schlissel, filed eight provisional patent applications for Iviewit or Mr. Bernstein. These eight provisional patent applications are identified below:

<u>Filing Date</u>	<u>Provisional Application Serial No.</u>
March 24, 1999	60/125,824
June 3, 1999	60/137,297
June 7, 1999	60/137,921
June 29, 1999	60/141,440
August 2, 1999	60/146,726
August 19, 1999	60/149,737
September 22, 1999	60/155,404
December 8, 1999	60/169,559

During the same period, I, though Meltzer, Lippe, Goldstein & Schlissel, and pursuant to Mr. Bernstein's direction, filed a non-provisional patent application corresponding to, and claiming the benefit of the priority of, the March 24, 1999

provisional patent application. This non-provisional patent application was filed on March 10, 2000 and was assigned U.S. Patent application Serial No. 09/522,721.

Pursuant to Mr. Bernstein's direction, I also filed a PCT application to claim priority to the March 24, 1999 provisional patent application on or before March 24, 2000.

I performed all reasonable steps to ensure that Iviewit's intellectual properties were protected in accordance with Mr. Bernstein's instructions. In any event, the Complaint does not allege what I did or failed to do that has left Iviewit's intellectual properties unprotected or at jeopardy.

B. I deny the allegation that I failed to and/or inadequately completed work regarding patents, copyrights and trademarks. First, Mr. Bernstein or Iviewit never asked me to perform any services with regards to copyrights and/or trademarks. Second, all the work that I performed was provided to Mr. Bernstein and, in certain instances to Mr. Brian Utley, then CEO of Iviewit, in a timely manner for review, for any suggestions, and for edits and/or revisions. I caused no provisional patent application, non-provisional patent application, and/or PCT application, to be filed without their approval. In instances when an invention disclosure was filed as a provisional patent application, in order to obtain the earliest possible filing date for the alleged invention, such filings also were made pursuant to their direction and with their knowledge and approval beforehand. Further, I never received any complaints regarding my work product and/or the patent

filing strategies being utilized. In any event, the Complaint does not allege how I allegedly failed to and/or inadequately completed work.

C. I deny the allegation that I failed to list proper inventors. At no time did Mr. Bernstein or any other person associated with Iviewit mention that others besides Mr. Bernstein were inventors of, or involved in the conception or reduction to practice of, the compression technologies that formed the basis for Iviewit's provisional patent applications, the non-provisional patent application, and the PCT application. To the contrary, Mr. Bernstein claimed sole inventorship for all provisional patent applications filed on Iviewit's behalf with the exception of, to the best of my recollection, one such application that also named Mr. Utley as an inventor. To the best of my recollection, I do recall Mr. Brian Utley being named as an inventor in a provisional patent application that may have been the application filed in December 1999. In this instance, I was specifically told that Mr. Utley was to be a named co-inventor of the technology disclosed in the application. Mr. Bernstein always had indicated and led me to believe that he was the only or sole inventor of the pertinent technology except in the instance when Mr. Utley was a named co-inventor on the pertinent patent application. I do not recall any other inventors being brought to my attention. Contrary to the allegations in the Complaint, Mr. Bernstein appears to continue his assertions to the present time that he is the sole inventor of the Iviewit technology. I attach hereto as Exhibit C a copy of a web page obtained from the Iviewit web site at [www.iviewit.com](http://www.iviewit.com), wherein Mr. Bernstein is described as the "Inventor of the I View It concept".



If, in fact, any foreigners or foreign nationals were co-inventors with Mr. Bernstein during the time when I represented Iviewit, such information was concealed from me. There was simply no good reason for Mr. Bernstein to have withheld this information from me. Furthermore, in filing the non-provisional patent application of March 10, 2000, I believe that such filing would normally include a Declaration by Mr. Bernstein attesting to the fact that he was the only or sole inventor of the invention disclosed therein. At the time of the filing of the March 10, 2000 non-provisional patent application, Mr. Bernstein again failed to mention any other and, in particular, any foreign inventors. This particular allegation is the first notice to me of these alleged two other inventors.

I further was unaware that any advice was allegedly being sought regarding any foreign inventors and the ability to name any such individuals as inventors in any patent application. I was also unaware that any alleged advice was being provided or that any alleged immigration work for any alleged foreign national(s) was being provided by Proskauer. The Complaint is my first knowledge of these allegations.

Mr. Bernstein never told me that Iviewit's technology was invented by any foreign inventors. Further, I was unaware of any legal advice given to Bernstein that the "immigration status" of these "foreign inventors" had to be "adjusted" before they could be listed as inventors in any type of United States Patent application. A foreign inventor can be listed at any time in a United States Patent application regardless of immigration status.

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 18

Each and every provisional patent application that was filed with the United States Patent and Trademark Office was duly filed and received by the Office as evidenced by the assigning of a U.S. Provisional Patent Application Serial Number to each application. Further, the one non-provisional patent application that also was filed with the United States Patent and Trademark Office was duly filed and received by the Office as evidenced by the assigning of a U.S. Patent Application Serial Number to that application. I left Meltzer, Lippe, Goldstein & Schlissel in April 2000 and thereafter no longer represented Iviewit or Mr. Bernstein. After leaving Meltzer, Lippe, Goldstein & Schlissel, I was not asked to file any other or subsequent patent applications on behalf of Iviewit, Mr. Bernstein or any other inventors of any alleged Iviewit inventions. Subsequent to leaving Meltzer, Lippe, Goldstein & Schlissel, I also had no responsibility regarding the PCT patent application.

D. I deny the allegation that I failed to ensure that the relevant patent applications that I was asked to file contained all necessary and pertinent information relevant to the technologies as required by law. Mr. Bernstein had agreed that I would file provisional applications as his development progressed. Those applications were prepared and filed and included all information which was provided by Mr. Bernstein for each respective invention disclosure. Each and every one of the filed applications, provisional and non-provisional, which I was entrusted to file were duly filed and received by the United States Patent and Trademark Office. Each and every patent application accomplished its intended purpose, that is, to establish the respective earliest possible filing dates and/or

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 19

priority dates. Further, to the best of my knowledge, the legal sufficiency of these applications were never challenged or objected to by the United States Patent and Trademark Office. Mr. Bernstein fails to state any evidence to the contrary.

A search of public international patent records at <http://guest:guest@ipdl.wipo.int> was performed by myself on March 13, 2003. The search identified five (5) separate PCT applications filed in the name of Iviewit. These Iviewit PCT applications, apparently filed by Foley & Lardner's Office in Wisconsin, are listed below by their PCT application Number and filing date:

<u>PCT APPLICATION NUMBER</u>	<u>FILING DATE</u>
PCT/US00/21211	August 2, 2000
PCT/US00/15602	June 7, 2000
PCT/US00/15408	June 2, 2000
PCT/US00/15406	June 2, 2000
PCT/US00/15405	June 2, 2000

A copy of the search results page is attached hereto as Exhibit D. A text copy of each of the above PCT applications, identified respectively as Exhibits E through I are also attached hereto. The priority claims made in the PCT applications shows that priority was claimed to each of the Iviewit Provisional applications with the exception of the U.S. Provisional Patent Application Serial No. 60/125,824 filed on March 24, 1999. Priority for U.S. Provisional Patent Application Serial No. 60/125,824 was, however, claimed in the PCT application filed on or about March 24, 1999, which application was transferred to Foley & Lardner. In this regard, the provisional application filings served

their intended purposes as priority documents establishing the respective priority dates for the alleged inventions disclosed therein.

E. I deny the allegation that billing statements and transmitted documents were falsified. The Complaint fails to identify what alleged falsifications took place.

F. I deny the allegation that patent documents were falsified or that the contents thereof were changed prior to filing. No information in any of the Bernstein/Iviewit patent applications was ever changed or omitted from any patent application prior to filing after the document had been approved for filing by Bernstein/Iviewit. For each application filed, the same protocol was used, Mr. Bernstein, and/or Mr. Utley when he was a named inventor, provided information to me usually in a very short disclosure document which, if I recall correctly, consisted of a description of the technology and/or the enumerated processing steps. In some instances, additional information may have also been conveyed verbally in conferences or meetings with Mr. Bernstein and/or Mr. Utley. In each instance, I would generate a document to be filed with the U.S. Patent and Trademark Office and would provide same to Iviewit for review. I would await any comments and instructions for revisions. Thereafter, I would receive instructions to file the pertinent document, either as a provisional patent application, a non-provisional patent application, and/or a PCT application. After the pertinent application was filed, Mr. Bernstein was provided with a complete copy of all filed papers. Mr. Bernstein and/or Mr. Utley never informed me of any such alleged omissions or changes to any filed application.

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 21

I also deny the allegation that I filed patents in my own name "that would succeed upon the Company's patents failing," and I further deny the allegation that any of my inventions or patent applications would appear to be ideas learned while representing Iviewit.

Iviewit's technology and its alleged inventions were in the image data file compression and video data file compression technical art areas. I have never claimed to have invented and/or have never filed any patent application in my name for any inventions for or relating to any image data file compression or video data file compression technology or technologies. As I noted above, I have invented and patented inventions involving the transmission of video or images on or over a communication network or on or over the Internet and/or the World Wide Web. My inventions did not address image file compression or video file compression simply because such data file compression was not necessary in my inventions. Mr. Bernstein was made aware of some of my inventions and, in particular my 405 Patent, which he had knowledge of dating back to the summer of 1999. In any event, the Complaint fails to identify which of my patents or pending patent applications appear to be allegedly based on ideas learned while I represented Iviewit. I never appropriated any ideas learned from Iviewit or Mr. Bernstein at any time.

To the contrary, while preparing this letter, I discovered that Mr. Bernstein may have appropriated ideas contained in my 405 Patent as his own after he retained Foley & Lardner as Iviewit's new patent counsel. For example, compare PCT/US00/15602

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 22

application at page 1, lines 7-8 (Exhibit F), which states "The present invention [ALSO RELATES] to a system and method for controlling a video device over a network" and at Page 2, lines 3-30, with the subject matter of my 405 patent (Exhibit A) at Col. 1, lines 5-16, in Claims 1, 4, 6, 7, 12, 13, 14, 15, 16, 18, 19 and 20, at Cols. 74 thru 78, in Figures 5B and 11B and the descriptions relating thereto at Cols. 28 thru 29 and at Cols. 49 thru 50, respectively, at Cols. 12 thru 13, at Cols. 22 thru 24, at Cols. 52 thru 53, at Cols. 56 thru 57, and at Cols. 69 thru Col. 70.

Please also note the text of PCT/US00/15602 at Page 2, line 40 to Page 3, line 3 wherein the document states in pertinent part:

Compression and other manipulation of the video data is optional, since such manipulation typically results in decreased resolution and definition. Furthermore, saving compressed files of video data is not required to provide enhanced playback of video data to users over the network. [WHILE] the exemplary embodiments are explained with reference to video signals, it is understood that a video signal may include corresponding audio signals therein. Alternatively, the corresponding audio signals may be processed through a different method.

The Chief Counsel is respectfully requested to note the gist of the above statement, that compression is optional, and that audio can be provided along with video. Please refer to the 405 Patent and Figures 5B and 11B and the descriptions relating thereto at Cols. 28 thru 29 and at Cols. 49 thru 50, respectively, at Cols. 12 thru 13, at Cols. 22 thru 24, at Cols. 52 thru 53, at Cols. 56 thru 57, and at Cols. 69 thru 70.

Please also refer to Exhibit F at page 6, lines 32-35 and please compare this passage with the 405 patent (Exhibit A) at Col. 74, lines 33-44.

Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 23

For the sake of brevity, I will stop at the above examples, although numerous other examples of my technology and disclosure finding its way into PCT/US00/15602, filed June 7, 2000, can also be identified if necessary.

I respectfully submit that the above instances of the apparent copying of certain aspects of my 405 Patent, an issued United States Patent, and a published document which Mr. Bernstein knew about and told me he had reviewed on at least one occasion, provide unequivocal support for my position that it was not me who obtained ideas from Iviewit, but rather, it was Mr. Bernstein or some other Iviewit individual who obtained ideas from my issued 405 Patent and sought to file a patent for an invention which was disclosed by me in a United States Patent application filed almost four years earlier and patented and issued almost one year prior to the filing date of PCT/US00/15602. Further, Mr. Bernstein would now have the Chief Counsel believe that he or others at Iviewit invented technology which brings video and audio over the Internet or the World Wide Web and that he or others at Iviewit also invented the idea of controlling video cameras remotely via the Internet or the World Wide Web. My 405 Patent speaks for itself. Mr. Bernstein's claim is simply untenable.

G. I have no knowledge regarding Crossbow Ventures or any of its investment decisions with regard to Iviewit.

Lastly, I disagree that any of my actions resulted in a loss to Iviewit. Upon information and belief, Iviewit, according to its web site, has multiple patent applications pending in the United States and abroad. A copy of the pertinent web page is attached as


Thomas J. Cahill, Esq.  
April 8, 2003  
Page No. 24

Exhibit J. On further information and belief, Iviewit has exercised its rights pursuant to its PCT applications in filing three (3) European patent applications and what is believed to be five (5) Australian patent applications. A copy of a public records search attached as Exhibit K indicates that these applications have been filed. The status of these applications is unknown to me. Clearly, however, Iviewit does have patent counsel who appears to be actively representing Iviewit in various patent matters.

On March 25, 2003, Iviewit was selected as a new company to take part in the Epoch Incubator project sponsored by IBM, O'Melveny & Meyers, Deloitte & Touché, Silicon Valley Bank and Zone Ventures. A copy of this relevant press release is attached hereto as Exhibit L.

In view of the foregoing, I respectfully request that the Chief Counsel recommend that the Complaint be dismissed without referral. In the event that the Chief Counsel needs additional information, I will willingly comply by providing same. In the further event that additional information concerning me is given to the Chief Counsel, I respectfully request an opportunity to respond to that information before the Chief Counsel makes a recommendation in this matter.

Sincerely,

  
Raymond A. Joao



DEPARTMENTAL DISCIPLINARY COMMITTEE

SUPREME COURT, APPELLATE DIVISION

FIRST JUDICIAL DEPARTMENT

61 BROADWAY

NEW YORK, N.Y. 10006

(212) 401-0800

FAX: (212) 401-0810

PAUL J. CURRAN, Esq.  
CHAIRMAN

HALIBURTON FALES, 2d., Esq.  
HON. THOMAS B. GALLIGAN  
MARTIN R. GOLD, Esq.  
DENIS MCINERNEY, Esq.  
ROY L. REARDON, Esq.  
STEPHEN L. WEINER, Esq.  
SPECIAL COUNSEL

LAWRENCE J. BANKS  
SALLY W. BERG  
DOUGLAS W. BRANDRUP, Esq.  
CHRISTOPHER E. CHANG, Esq.  
ANN J. CHARTERS  
BRIAN M. COGAN, Esq.  
DENIS F. CRONIN, Esq.  
TELESFORO DEL VALLE JR., Esq.  
CHARLES E. DORKEY III, Esq.  
PAUL F. DOYLE, Esq.  
JUSTIN E. DRISCOLL III, Esq.  
PATRICIA FARRIN, Esq.  
MARION T. ETHEREDGE  
STEVEN N. FEINMAN, Esq.  
ROSALIND S. FINK, Esq.  
CHARLOTTE MOSES FISCHMAN, Esq.  
BEATRICE S. FRANK, Esq.  
MARANDA E. FRITZ, Esq.  
WILLIAM A. GALLINA, Esq.  
ROBERT L. HAIG, Esq.  
RICHARD J. HOLWELL, Esq.  
SUSAN M. KARTEN, Esq.  
JOHN J. KENNEY, Esq.  
DAVID G. KEYKO, Esq.  
MYRON KIRSCHBAUM, Esq.  
LENORE KRAMER, Esq.  
WILLIAM FRANCIS KUNTZ II, Esq.  
MICHAEL A. LACHER, Esq.  
DEBORAH E. LANS, Esq.  
MARVIN LEFFLER  
BURTON N. LIPSHIE, Esq.  
HENRIETTA LYLE  
MARY B. MAGUIRE  
CHARLES C. MARINO  
DOUGLASS B. MAYNARD, Esq.  
LAWRENCE D. MCGOVERN, Esq.  
CHARLES G. MOERDLER, Esq.  
MATHIAS E. MONE, Esq.  
MERCEDES A. NESFIELD  
JANE W. PARVER, Esq.  
ANTHONY M. RADICE, Esq.  
ANDREW W. REGAN, Esq.  
TIMOTHY G. REYNOLDS, Esq.  
MICHAEL J. ROSENBERG  
REUBEN SAMUEL, Esq.  
AUGUSTIN J. SAN FILIPPO, Esq.  
SAMUEL W. SEYMOUR, Esq.  
DANIEL E. SIFF, Esq.  
MARIAN E. SILBER, Esq.  
EUGENE P. SOUTHER, Esq.  
JOHN L. WARDEN, Esq.  
ERIC J. WARNER, Esq.  
SUSAN WELSHER  
COMMITTEE MEMBERS

THOMAS J. CAHILL  
CHIEF COUNSEL

SHERRY K. COHEN  
FIRST DEPUTY CHIEF COUNSEL

ANDRAL N. BRATTON  
DEPUTY CHIEF COUNSEL

CHRISTINE C. ANDERSON  
ROBERTA N. BERKWITS  
ANGELA CHRISTMAS  
NICOLE CORRADO  
JORGE DOPICO  
MADY J. EDELSTEIN  
JEREMY S. GARBER  
NAOMI F. GOLDSTEIN  
JOSEPH J. HESTER  
JUN HWA LEE  
VITALY LIPKANSKY  
STEPHEN P. MCGOLDRICK  
JAMES T. SHED  
EILEEN J. SHIELDS  
JUDITH N. STEIN  
RAYMOND VALLEJO  
LA TRISHA WILSON  
STAFF COUNSEL

April 16, 2003

PERSONAL AND CONFIDENTIAL

Mr. Eliot I. Bernstein  
IVIEWIT  
10158 Stonehenge Circle  
Boynton Beach, FL 33437

Re: Matter of Raymond A. Joao, Esq.  
Docket No. 2003.0532

Dear Mr. Bernstein:

We are forwarding herewith an answer to your recent complaint against the above-named attorney. If you disagree with the attorney's statement, please write us, telling us specifically how and why; if you have any documents substantiating your points of disagreement, forward them to us. Also, please tell us what has happened in regard to this matter since the time you filed the complaint.

If we do not hear from you within twenty (20) days, we may conclude that you agree with the attorney's statement.

All inquiries concerning this matter should be addressed to Joseph G. Wigley, Legal Assistant.

*Very truly yours, Cahill*

Thomas J. Cahill

TJC:adp/P:JGW/A:JNS  
DC14 (F424/TB505)