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## **Protective Intellectual Property Services, LLC**

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### **MAXIMIZING THE VALUE OF YOUR INTELLECTUAL PROPERTY BY STRATEGIC INTELLECTUAL PROPERTY MANAGEMENT<sup>SM</sup>**

July 2007

Clients and Friends,

This newsletter contains current news about US patents and the US Patent and Trademark Office, current intellectual property (IP) court cases, domestic and international IP news and IP information of general interest to management of technology companies, inventors, entrepreneurs and attorneys.

This month, you will see a new feature, a contribution by one of our readers on a subject of interest. Please send me any questions or comments about the article and I will forward them to the author. If you would like to present a publication of interest to the readers of this newsletter, please contact Lanny at [suggestions@protectiveIPservices.com](mailto:suggestions@protectiveIPservices.com).

Also, because of the importance of a number of issues such as patent reform, obviousness criteria for patents, and the U.S. Patent Office's pilot program on peer review of patent applications, I have grouped together multiple articles on these topics to provide a range of news/opinions,

PIPS helps companies maximize the value of their IP by identifying a company's IP, providing strategic IP services; pre-legal IP protection assistance and negotiation services; and in-licensing of needed technologies and out-licensing of "excess" technologies. Please visit [PIPS's web site](#) for more information about PIPS, its services and capabilities.

Please contact PIPS to discuss your situation in a free 45 minute consultation.

We appreciate your feedback at [suggestions@protectiveIPservices.com](mailto:suggestions@protectiveIPservices.com).

#### **PATENTABLE SUBJECT MATTER WITHIN THE SCOPE OF U.S.C. SECTION 101**

(Inventions Patentable) The Law office of Adrienne Naumann

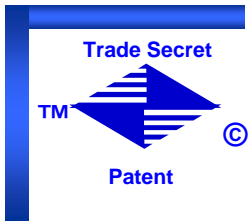
Although the scope of patentable subject matter is a complicated area of the law, proper subject matter is necessary for an enforceable patent. If an invention does not fulfill this statutory requirement, then a court or patent examiner need not determine whether other patentability criteria are fulfilled. Inconsistency in this law is especially troublesome for

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computer related processes, biomedical processes, and business methods. Consequently independent inventors, business persons and patent practitioners should carefully read the following linked article. This comprehensive discussion assists readers in fulfilling their subject matter requirements, as well as proposing legislative solutions for legal inconsistencies. ([more...](#))

## [USPTO](#)

### [MS Wins Right to Challenge Patent's Ownership](#)

InternetNews.com - USA

The US Patent & Trademark Office (USPTO) has ruled that Microsoft (Quote) can argue that it is the rightful owner of a patent lying at the center of an ...

### Peer Review:

#### [Pilot Concerning Public Submission of Peer Reviewed Prior Art](#)

([www.uspto.gov](http://www.uspto.gov))

This project will test whether [a loose public] collaboration can effectively locate prior art that might not otherwise be located by the Office during the typical examination process.

#### [US Patent Office To Require Class Presentations](#)

ADOTAS - New York, NY, USA

The director of the government's patent office put out a statement that said the Bush administration wants to reform the nation's patent system by allowing ...

#### [Peer-to-Patent Project begins one-year trial run next week](#)

Ars Technica - Boston, MA, USA

The US Patent and Trademark Office has announced that a one-year pilot program to test how well peer-review can work with the patent-granting process will ...

#### [Peer-to-Patent site relies on public for prior art](#)

ZDNet.com blogs - USA

Taking the patents to the people could be the new motto for the US Patent and Trademark Office. Beta News reports that the patent office will launch a new ...

#### [Peer-to-Patent Allows Public to Find Prior Art](#)

PC World - USA

Peer-to-Patent's exposure of prior art will weed out patents that would likely face challenges down the line. US technology vendors submitted five patent ...

#### [US looks to overhaul its patent system](#)

International Herald Tribune - France

The Bush administration wants to overhaul the US patent system by requiring better information from inventors and allowing public scrutiny of applications, ...

#### [Apple Beware: Microsoft Awarded Web Phone Patent](#)

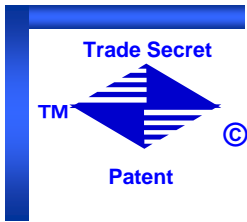
By [info@usernomics.com](mailto:info@usernomics.com) (Usernomics)

"Could Apple's iPhone be at the mercy of a patent just granted to Microsoft? Could be, judging by US Patent 7225409, "Graphical User Interface For A Screen Telephone," which was awarded to Microsoft on Tuesday. ...

## [COURTS](#)

### Obviousness:

[On Intellectual Property: obviousness-by-combination](#) [www.cenriqueortiz.com/weblog](http://www.cenriqueortiz.com/weblog)  
New IP could be based on other's prio-



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art; this actually occurs often. Below is the Forgent v. EchoStar Jury Instructions on Obviousness: "One way to decide whether one of ordinary skill in the art would combine what is described in ...

## [Supreme Court revitalizes obviousness defense in patent cases](#)

Quinn Emanuel Urquhart Oliver & Hedges LLP

In what some are considering the most important patent case in decades, the Supreme Court in KSR International Co. v. Teleflex, Inc. unanimously put an end to the Federal Circuit's rigid application of the "teaching, suggestion, or motivation" test for obviousness.

## [Company Pursues Patent Fight With eBay](#)

Forbes - NY,USA

By SONJA BARISIC 06.12.07, 6:31 PM ET  
A small Virginia company in a patent fight with eBay Inc. asked a federal judge Tuesday to stop the online auction ...

## [MercExchange v. eBay: Injunction Hearing](#)

(Dennis Crouch's Patently-O) ...eBay has slowed MercExchange's infringement case to a virtual crawl. Over three years ago, a jury found that eBay willfully infringed MercExchange's patent.

## [Wi-Fi Takes Shape As The Next Patent Battleground](#)

InformationWeek - Manhasset,NY,USA

By Richard Martin A little-noticed Federal court decision issuing an injunction against wireless LAN equipment vendor Buffalo Technology in its patent fight ...

## [Federal Circuit says U.S. courts can't decide foreign patent infringement claims](#)

Quinn Emanuel Urquhart Oliver & Hedges LLP

The U.S. Court of Appeals for the Federal Circuit recently eliminated the possibility for plaintiffs to pursue foreign patent infringement claims in U.S. courts.

## [DOMESTIC](#)

Patent Reform Legislation:

### [Chief Justice Michel Writes to Committee on Patent Reform](#)

Patent Baristas - Cincinnati,OH,USA

The parties in typical patent infringement cases dispute several claim terms in many claims, often involving many different patents. ...

### [The Judge Dissents on Patent Reform](#)

Washington Post - United States

As Congress wrestles with legislation aimed at overhauling the US patent system for the first time in half a century, the chief federal judge assigned to ...

### [Senators seek delay in patent bill](#)

ITworld.com - Southboro,MA,USA

A group of five Republican senators is seeking a delay in legislation, supported by several large tech vendors, that would overhaul the US patent system. ...

### [Real or hype? The business and litigation impact of patent reform](#)

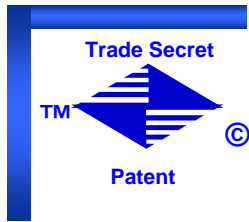
Foley & Lardner LLP

Ever since the FCC released a report in 2003 raising the need for patent reform, Congress has been considering how to address perceived problems with the patent system, such as the apparent ease of obtaining invalid patents and the difficulty of challenging such patents once they are granted.

### [Changes to US patent law must nurture our culture of innovation](#)

WTN News - Madison,WI,USA

Be very afraid when a member of Congress announces that a major reason to "reform" the US patent system is that no one else in the world does it like us. ...



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### [The Patent Reform Act of 2007 Will Weaken Patents and Jeopardize ...](#)

Business Wire (press release) - San Francisco, CA,  
Appearing on behalf of BIO, Alkermes, Inc. Senior Vice President and General Counsel Kathryn Biberstein outlined the organization's views on patent reforms ...

### [MDMA Voices Concerns Over The Patent Reform Act of 2007: Bill Will ...](#)

Earthtimes.org - USA  
In a letter sent to key members of the House and Senate Judiciary Committees, a diverse set of stakeholders stated that the Patent Reform Act would "hinder ...

### [Biotechs Brace for Patent Reform, High Court Impacts](#)

San Diego Business Journal - CA,USA  
By KATIE WEEKS While large pharmaceutical companies have been the industry mouthpiece about controversial patent reforms, local legal experts say it's ...

### [Patent Reform Act to aid nanotechnology?](#)

Nanodot - USA  
Berman's bill will enable private-citizen-experts to help patent examiners research the novelty of proposed patents so that they can make a more informed ...

### [Proposed Patent Reforms Worry Device Industry](#)

FDA news (subscription) - Falls Church,VA,USA  
Industry groups say the Patent Reform Act of 2007 threatens to "devastate life sciences investment" by weakening the patent system for medical devicemakers.

### [Tech vendors disagree on patent reform](#)

Washington Post - United States  
Representatives from Texas Instruments and AmberWave Systems say proposed legislation goes too far in overhauling the patent system. ...

### [US patent overhaul shouldn't be rushed](#)

Chicago Tribune - United States  
By William J. Jones Reform of the nation's patent system, the 218-year-old wellspring of American innovation and material progress, has become a rush ...

### [Republicans on Patent Reform: Slow down and get it right.](#)

Dennis Crouch's Patently-O  
Republicans want further consideration of issues before marking up patent legislation

### [Attorney General wants to make "attempted" piracy a federal crime](#)

Afterdawn.com - USA  
He also reminded us that his department submitted the Intellectual Property Protection Act of 2007 in May to Congress. The bill would allow for easier ...

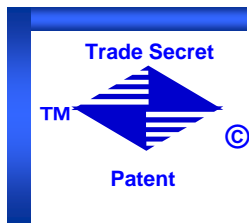
### [Permanent injunctions getting scarce: patent holders turn to ITC](#)

Ars Technica - Boston,MA,USA  
Patent litigation is usually a high-stakes game, especially for a company found to be infringing on another's intellectual property. ...

### [Intellectual Property Transparency](#)

By undisclosed@blogs.motorola.com (Padmasree-Warrior)  
The issue I want to debate is WHAT tech companies must DO with their intellectual property. Depending on how a company asserts its patents - industry innovation can either bloom or wither.

### [Bill to Prohibit Patents on Nucleic Acid Sequences Presented to US ...](#)



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By Sheppard Mullin

Several months ago Representative Xavier Becerra from Southern California, and Rep. Dave Weldon of Florida introduced the Genomic Research and Accessibility Act (HR 977) in the US House of Representatives. As drafted, the bill would

...

## [US Fights Product Piracy](#)

Voice of America - USA

By Bill Rodgers Intellectual property theft has cost the US economy some \$250 billion, according to some estimates, and more than 700000 American jobs. ...

## [Academia and industry to share intellectual property](#)

VNUNet.com - UK

Leading US universities and IT companies have agreed a set of guiding principles for sharing intellectual property derived from collaborative research. ...

## [International patent strategy: springboard to going global](#)

Fenwick & West LLP

In today's global marketplace, patent protection continues to be an important part of a company's overall business and intellectual property strategy.

## [Pending legislation regulating patent infringement settlements](#)

Latham & Watkins

A number of bills have been introduced in the United States Congress this year that are intended to eliminate perceived anticompetitive settlements of patent infringement litigation between generic and brand-name pharmaceutical manufacturers.

## [Justice Department continues to target IP crimes — implications of the proposed Intellectual Property Protection Act of 2007](#)

Ballard Spahr Andrews & Ingersoll LLP

Recognizing both the growing significance

of intellectual property to the US economy and the increasingly sophisticated nature of IP theft, the Justice Department ("DOJ") has been intensifying its efforts to target, investigate, and prosecute intellectual property crimes.

## [Software development and the work made for hire doctrine](#)

McGuireWoods LLP

When your business develops new computer software for internal use, who is it that actually puts pen to paper (or finger to keyboard and mouse) to write that software?

## INTERNATIONAL

## [We need to crack down on China for intellectual property theft](#)

Cincinnati Enquirer - Cincinnati,OH,USA

Intellectual property theft may not command the attention of a Bonnie-and-Clyde heist. But when our ideas are stolen, when our made-in-the-USA products are ...

## [China : Beijing keen to protect intellectual property rights](#)

Fibre2fashion.com - India

China Association for the Protection of Patent organized a seminar in Beijing on April 27, regarding safeguard of intellectual property rights of Chinese ...

## [G8: Health Over Intellectual Property Rights, Says G5](#)

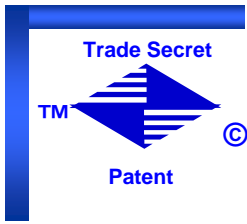
Inter Press Service (subscription) - Rome,Italy

HEILIGENDAMM, Germany, Jun 8 (IPS) - The Group of Eight industrialised countries suffered a setback Friday in its plan to strengthen intellectual property ...

## [G8 Summit Agrees On Africa Declaration With Weakened TRIPS Language](#)

Intellectual Property Watch - Geneva,Switzerland

A government source close the negotiation



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told Intellectual Property Watch that this declaration was supposed by some to have

## [G8 declaration on innovation and intellectual property will ...](#)

Reuters AlertNet - London, England, UK

Intellectual property protection does not stimulate development of medicines to treat diseases that primarily affect people in developing countries. ...

## [An open letter to Steve Lohr of the New York Times: Regarding Jon ...](#)

By jim

The intellectual property exchange markets work very effectively to provide companies ready access to the inventions they need at a price they can afford. Inventions are licensed efficiently to companies and entrepreneurs by ...

## [China, US hold consultations on IPR protection](#)

China Daily - China

China and the United States have held consultations in Geneva on issues involving the protection of intellectual property rights (IPR), the Chinese Mission ...

## [Filings at the European Patent Office Continue to Grow](#)

HULIQ - Hickory, NC, USA

The proportion of filings originating from the 32 member states of the European Patent Organisation fell by over 1%, from 49.6% to 48.5%. ...

## [Extradited Software Piracy Ringleader Sentenced to 51 Months in Prison](#)

PR Newswire (press release) - New York, NY, USA

In one of the first ever extraditions for an intellectual property offense, Hew Raymond Griffiths, 44, a British national living in Bateau Bay, Australia, ...

## [OTHER](#)

## [Protecting my invention - 'My ex-business partners are using my invention. What can I do and what protection should I have put in place?'](#)

Lexology.com, Thomas Eggar

Many companies invest substantial sums in the development of new products but then fail to put in place proper protection, which often means that competitors can be free to utilise the relevant technology or invention without need for the initial investment. counterbalanced the main ...

## [Ocean Tomo Completes First Pan-European Live Intellectual Property ...](#)

Business Wire (press release) - San Francisco, CA, USA

"Intellectual property auctions are rapidly developing into a world-recognized marketplace where IP can be sold not only efficiently but at world record ...

## [Provisional or Non-Provisional Patent Application -- Which Should ...](#)

TechLINKS (press release) - Atlanta, GA, USA

By Dr. Thomas R. (Terry) Williamson III on Monday, June 18, 2007 A provisional patent application is not a patent, and furthermore, never becomes a patent, ...

## [Companies undervalue their intellectual property](#)

VNUNet.com - UK

Companies are not extracting maximum value from their intellectual property (IP), despite being aware of the increasing importance of owning research and ...

## [How to protect your product, trade name or book](#)

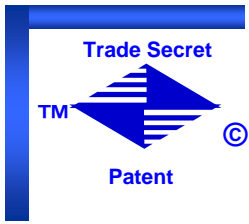
St. Clair Record - Edwardsville, IL, USA

But there is a third very important type of property-it's called "Intellectual Property." Intellectual property consists of patents, trademarks and ...

## [Report: Corporate Intellectual Property](#)

Wireless Week - USA

... survey by Price Waterhouse Coopers,



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over half of all technology companies don't extract the full value from their intellectual property (IP) holdings. ...

## [Intellectual property is the 'currency of tomorrow'](#)

Information World Review - London,UK

Some 85 per cent of technology executives said that intellectual property would increase in importance for their organisations over the next three to five ...

## [Intellectual Property Scholars Conference: August 8 and 9: Chicago](#)

By Christopher Brooks(Christopher Brooks)

The Berkeley Center for Law and Technology is one of the sponsors of the Intellectual Property Scholars Conference to be held August 8 & 9 at DePaul in Chicago. Aaron Burstein will present Toward a Culture of Cyber Security Research.