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## Protective Intellectual Property Services, LLC

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Maximizing Inventions' and Knowledge's Contribution to Your Company's Growth and Value™  
Managing Intellectual Property Consistent with Your Business Plans™

Volume 19

### Welcome to the October 2008 issue of the PIPS IP Update Newsletter:

In order to read the entire article, double left click on the underlined colored title when you are connected to the internet.

#### **US Patent and Trademark Office**

##### Evidence Based Prosecution: More Claims Filed Equates with Longer Time in Prosecution

Dennis Crouch's Patently-O

The correlation makes sense: more claims would generally mean more work for the PTO to reject each claim, and more work for the applicant to respond in kind.

##### Microsoft Granted Patent for 'Page Up' and 'Page Down' Keystrokes

ShortNews.com - Regensburg, Germany

The US Patent and Trademark Office has granted Microsoft a patent which covers 'page up' and 'page down' keystrokes. Patent #7415666, is "a method and ...

##### USPTO Addresses Foreign Preparation of U.S. Patent Applications

Ice Miller LLP

Are you considering outsourcing preparation of your next United States patent application to a practitioner in a foreign country? Have you been encouraged to do so to save money? According to the U.S. Patent and Trademark Office (USPTO), such a decision may be a violation of U.S. law.

##### USPTO process does no favors for tech companies

The Industry Standard - San Francisco, CA, USA

These issues seem to be forcing a complete overhaul of our current system in the US for protection of intellectual property. At some point, patents seemed ...

##### A new focus on fraud in trademark prosecution

Wiley Rein LLP

Fraud on the United States Patent and Trademark Office (USPTO) always has been an important consideration for trademark owners.

##### Program Could Revolutionize The Patent Office

RedOrbit - Dallas, TX, USA

The most powerful players in the technology industry are complaining that the US patent system puts too many patents in the hands of people who can use them ...

#### **Courts**

##### Patent exhaustion doctrine re-charged by Supreme Court: potential loss of control after first sale under license

Sutherland

The U.S. Supreme Court's June 2008 unanimous decision in *Quanta Computer, Inc. v. LG Electronics, Inc.*, 128 S.Ct. 2109, re-charged the doctrine of patent exhaustion, whereby the first unrestricted sale of a patented item

terminates the patent owner's control over any patent rights in the item sold.

##### Federal court rules that open source licenses are enforceable under copyright law

Reed Smith LLP

On August 13, 2008, the U.S. Court of Appeals for the Federal Circuit issued the first reported decision by a federal appellate court dealing with the burgeoning area of open source licensing.

##### New decision highlights need to consider impact of open source licenses for your internal systems and marketed software products

Jackson Walker LLP

Many businesses have recently been enamored of "open source" software, most of which is available free of charge and permits end-users to make and distribute their own modifications.

##### When is a software license actually a sale? A new district court decision addresses the copyright first sale doctrine and software

Wiley Rein LLP

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In *Vernor v. Autodesk, Inc.*, the federal district court in Seattle added a new decision to the mix of software-related first sale doctrine cases.

### [Biotechnology patents - when is the right time to file?](#)

Maclay Murray & Spens

A recent case brought against Human Genome Sciences Inc has dealt a blow to biotechnology companies that make claims to parts of the human genetic sequence and highlights the importance of assessing at what stage to file a patent for biotechnology inventions.

### [Loose lips sink ships - posting inventions on secure internet servers may affect your patent rights in USA](#)

McDermott Will & Emery

In *SRI International v Internet Security Systems Inc and Symantec Corp* [2008] (U.S. Federal Circuit) 2007-1065, a U.S. court held that a disclosure posted onto a computer server that is for all intents and purposes "secure" could still irrevocably destroy the novelty of a U.S. patent.

## Domestic

### **U.S. Patent Reform**

#### [Senate passes intellectual property bill](#)

Search-Autoparts.com - North Olmsted, OH, USA

The US Senate recently unanimously passed legislation on Intellectual Property Rights Enforcement, Senate Bill 3325. The bill, which was introduced by Sen. ...

#### [US Congress scraps controversial copyright proposal](#)

VNUNet.com - UK

The Enforcement of Intellectual Property Right Act of 2008 had been proposed by senators Tom Leahy and Arlen Specter as a way to update intellectual ...

#### [White House Asked To Create an IP](#)

Czar SYS-CON Media - Montvale, NJ, USA

... and may veto – that would establish a so-called Senate-confirmed IP czar or Intellectual Property Enforcement Coordinator with cabinet-level chevrons, ...

#### [Congress Gets Tough On Intellectual Property](#)

Chemical & Engineering News - USA

The bipartisan legislation, the Prioritizing Resources & Organization for Intellectual Property Act (S. 3325), passed the Senate by unanimous consent on ...

### [Congress Considers Legislation To Toughen IP Enforcement](#)

The Metropolitan Coporate Counsel - Mountainside, NJ, USA

The House measure, HR 4279, known as the Prioritizing Resources and Organization for Intellectual Property Act of 2008 or the "PRO-IP" Act, was passed by ...

### [IP piracy bill passed by US Congress](#)

InfoWorld - San Francisco, CA, USA

The legislation, called the Prioritizing Resources and Organization for Intellectual Property (PRO-IP) Act, now goes to President George Bush for his ...

### [FAQ: What to expect from a new IP cabinet position](#)

CNET News - San Francisco, CA, USA

The intellectual property enforcement bill Congress passed over the weekend has won strong bipartisan support and wide-ranging approval from the business ...

### [iForem Unveils Escrow Assured\(TM\) On-Demand Intellectual Property ...](#)

Earthtimes (press release) - London, UK

(Business Wire) In the company's continuous effort to provide solutions that protect the integrity of intellectual property, iForem today introduced Escrow ...

### [Anti-Piracy Bill Headed for the White House](#)

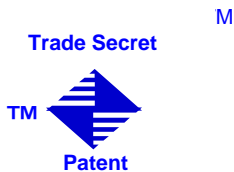
InternetNews.com - USA

The bill, known as Prioritizing Resources and Organization for Intellectual Property Act of 2008, passed in the Senate on Friday. Now, with the blessing of ...

### [Congress passes 'unconstitutional' Pro-IP bill, Bush likely to veto](#)

ZDNet - USA

Over the weekend, Congress passed the outrageous Pro-IP bill (that stands for, Prioritizing Resources and Organization for Intellectual Property Act, ...



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### [Patent law reform and the health care](#)

[lobby](#) Ober Kaler

Last April 18, 2007, Congressman Howard Berman introduced bill H.R. 1908 into the House of Representatives while Senator Patrick Leahy introduced its counterpart into the Senate.

### [Congress considers legislation to](#)

[toughen IP enforcement](#) Wiley Rein LLP

Congress is considering several bills purporting to strengthen the rights and remedies available to copyright and trademark holders, and make it easier to prosecute repeat offenders by creating a new federal agency to oversee intellectual property enforcement.

### [Presidential Candidates positions on Intellectual Property](#)

#### [US presidential campaigns clash on patent law](#)

[Out-Law.com](#) - London,England,UK

Intellectual property advisors to both US presidential candidates have said that the US patent system is in need of reform. The advisors told a meeting at ...

#### [IP advisers agree US patent office needs reform](#)

[Bizjournals.com](#) - Charlotte,NC,USA

John McCain and Barack Obama battle for the presidency, some of their top intellectual property policy advisers met in Denver recently to debate patent ...

### [Protecting our creative core](#)

[Washington Times](#) - Washington,DC,USA

In the global market, America has long maintained a competitive advantage in innovation and intellectual property (IP). Intellectual property drives this ...

### [IBM Wants Patent On Finding Areas Lacking Patents](#)

[Slashdot](#) - USA

theodp writes "It sounds like a goof — especially coming from a company that pledged to raise the bar on patent quality — but the USPTO last week disclosed ...

### [FAQ: What to expect from a new IP cabinet position](#)

[CNET News](#) - San Francisco,CA,USA

The intellectual property enforcement bill

Congress passed over the weekend has won strong bipartisan support and wide-ranging approval from the business ...

### [iForem Unveils Escrow Assured\(TM\) On-Demand Intellectual Property ...](#)

[Earthtimes](#) (press release) - London,UK

(Business Wire) In the company's continuous effort to provide solutions that protect the integrity of intellectual property, iForem today introduced Escrow ...

### [Senate panel approves RIAA-backed copyright expansion bill](#)

[CNET News](#) - San Francisco,CA,USA

By a 14-4 margin, the Senate Judiciary Committee voted for the Enforcement of Intellectual Property Rights Act, which would create stricter IP laws, ...

### [Intellectual Property](#) About.com Inventors: What's Hot Now - <http://inventors.about.com/>

What type of intellectual property do you need - a patent trademark or copyright?

### [Litigation before the US International Trade Commission](#)

[Kenyon & Kenyon LLP](#)

"Patent litigation in the United States": in-house counsel throughout the world know what those six words mean.

### [When Academia Puts Profit Ahead of Wonder](#)

[NY Times](#)

The New York Times today published an editorial about the problems created by the Bayh-Dole Act that promotes the patenting and licensing of university inventions that arise from federally supported research.

### [In Pictures: Top Patent-Revenue-Generating Universities](#)

[Forbes](#) - NY,USA

... recent data) of 189 universities by the Association of University Technology Managers, which tracks university-spawned patents and licensing revenues. ...

### [Intellectual property protection goes global](#)

[Secure Computing](#) - Australia By Sue

The legislation, called the International Intellectual Property Protection and Enforcement Act of 2008, would require the Office of the United States ...



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### [An Invaluable Report on Spin-out Companies from University Science ...](#)

MarketWatch - USA

... has announced the addition of the "Spin-Outs: Creating Businesses from University Intellectual Property" report to their offering. ...

### [Precedential No. 40: "SAM EDELMAN" Confusingly Similar to "EDELMAN ...](#)

By The TTABlog

In its first precedential decision in more than a month, the Board affirmed a Section 2(d) refusal to register the mark SAM EDELMAN for luggage, handbags, and other Class 18 goods, finding it likely to cause confusion with the ...

### [Program turns to online masses to improve patents](#)

Chicago Daily Herald - Chicago,IL,USA

AP WASHINGTON -- Some of the biggest players in the technology industry complain that the US patent system is broken -- putting too many patents of dubious ...

### [China getting higher marks for tackling piracy](#)

Reuters - USA

... City the other day is hardly an endangered species, but China is quietly starting to win plaudits for its efforts to protect intellectual property. ...

### [Intellectual Ventures: A massive patent pyramid scheme?](#)

CNET News - San Francisco,CA,USA

Techdirt goes into depth on ex-Microsoft executive Nathan Myhrvold's Intellectual Ventures, adding a slew of new reasons to consider the patent-hoarding ...

### [Think "insurance" when facing an IP claim](#)

Burns & Levinson LLP

Let's say you've been sued for copyright or trademark infringement or violation of trade secrets.

## **International**

### [China to amend patent law, eyes stricter penalty for violators](#)

Xinhua - China

25 (Xinhua) -- China unveiled draft amendments to the patent law on Monday, lifting application standards and promising heavier fines on piracy.

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### [China to amend patent law, eyes stricter penalty for violators](#)

Xinhua - China

25 (Xinhua) -- China unveiled draft amendments to the patent law on Monday, lifting application standards and promising heavier fines on piracy.

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### [Protecting Your Company's Security Posture When Doing Business ...](#)

Pharmaceutical Processing - Rockaway,NJ,USA

What are the country's Intellectual Property protection laws? Protecting your company's intellectual property (IP) often starts at the HR level. ...

### [Some famous Canadian patents](#)

The Gazette (Montreal) - Quebec,Canada

Canada's first patent was granted in 1791 by the Governor General in Council to Angus MacDonnel, a Scottish soldier garrisoned at Quebec City, and to Samuel ...

### [Federal Government considers overhauling patent laws](#)

The Australian - Sydney,Australia

Intellectual Property Research Institute of Australia director Elizabeth Webster said Australia needed to "get rid of low-value patents". ...

### [New UN intellectual property chief cites challenges of booming patents](#)

UN News Centre

Francis Gurry of Australia, appointed by acclamation by the General Assembly of the World Intellectual Property Organization (WIPO) as its new Director ...

### [India sees a rise in patent, trademark applications: DIPP](#)

Business Standard - Mumbai,Maharashtra,India

According to the Department of Industrial Policy and Promotion (DIPP) and Intellectual Property Rights (IPRs), the filing of patent applications has ...

## **Other**

### [Intellectual Property Assignment and License Agreement](#)

By Ross Yader Legal Research Center - <http://legal.realdealdocs.com>

An Intellectual Property Assignment and License



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Agreement is a unique agreement whereby one party, the assignor, transfers to another party, the assignee, rights to their intellectual property, be it in a copyright, trademark, ...

[Intellectual Property and Open Source: A Practical Guide to ...](#) PDF CHM Books Catalogue - <http://www.pdfchm.com/>

If you work in information technology, intellectual property is central to your job -- but dealing with the complexities of the legal system can be mind-boggling. This book is for anyone who wants to understand how the legal system ...

[What's a Brand Worth Anyhow?](#)

Wiglaf Journal - Chicago, IL, USA

A two-part article with far more detailed information started in the August issue of "Intellectual Property Today" and is available on-line at ...

[Insurance coverage for intellectual property and e-commerce liabilities](#) Perkins Coie LLP

The prevalence of—and risks associated with—litigation over intellectual property (IP) rights has escalated tremendously over the past decade.

[Companies should exploit intellectual property, says IPO](#) <http://www.smallbusiness.co.uk>

He comments that if the intellectual property belongs to the owner of the business they should make sure they know how to 'protect it and ... properly manage it and maximise its value to them and their company.' ...

[If you can't beat patent trolls, join them](#)

GlobalSpec - Engineering News... -

<http://www.globalspec.com/engnews>

After failing to get Congress to pass a patent reform bill, some large technology companies have decided that if they can't beat the patent trolls, they can at least use some of the trolls' own weapons against them. ...

[The Pursuit of Patents](#)

The Gazette (Montreal) - Quebec, Canada

She contacted some professionals who deemed the concept a winner then helped her through the thorny issues of getting a patent, a prototype and a ...

[www.TechTransferOnline.com Becomes the Largest Database of ...](#)

MarketWatch - USA

Seekers of intellectual property (IP) can create a free account and start searching the site within a

few minutes. Although the database keeps growing at ...

[Comment : Fonts are Intellectual Property too!](#) ITProPortal - London, UK

... into account when it comes to commissioning a new typeface is that font designs and fonts software are actually classed as Intellectual Property (IP). ...

[Describing Intellectual Property in Your Business Plan](#)

By agquemuel

Most companies that are worthy of raising venture capital have proprietary Intellectual Property (IP). In fact, the quality of the IP and the management team are often the two most important aspects of a venture capitalist's investment ...

[Intellectual Property and Open Source](#)

Slashdot - USA

stoolpigeon writes "There isn't a person writing code in this country who is not impacted by US intellectual property laws. I think that it is safe to say, ...

[Determining a Fair Price for Intellectual Property](#)

Legal Research Center -

<http://legal.realdealdocs.com> By Ross Yader

For many companies, their intellectual property - such as processes, customer lists, trademarks, copyrights, or patents - may be their most valuable asset. In instances of a sale or liquidation of a company, a valuation of this ...

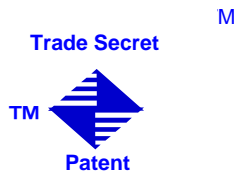
[Keywords and advertising: should I buy my competitor's trademark?](#) Venable LLP

In some businesses it is fairly common and routine practice: buy the competitor's trademark as a keyword from Google (or other search engines) and show up in search results when the public searches for the competition's products.

[District of Columbia - Demonstration of allegedly infringing product at a trade show not sufficient to constitute "use" under the patent laws](#)

Winston & Strawn LLP

The Federal Circuit upheld a dismissal by the District Court for the District of Columbia for lack of personal jurisdiction because the accused infringer's demonstration of its accused product



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at a District of Columbia tradeshow did not

constitute "use" under 35 U.S.C. § 271(a).

PIPS works with "C" level personnel at small to medium size technology companies to maximize their inventions' and knowledge's contribution to their companies growth and value. We do this by identifying a company's intellectual property and creating and implementing an intellectual property strategy that is consistent with the company's business plans. We also create IP policies and manage the company's IP portfolio.