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Protective Intellectual Property Services, LLC

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URL: www.protectiveIPservices.com



MAXIMIZING THE VALUE OF YOUR INTELLECTUAL PROPERTY (IP) THROUGH STRATEGIC IP MANAGEMENT AND COMMERCIALIZATIONSM

TRANSLATING TECHNOLOGY INTO THE LANGUAGE OF BUSINESSSM

October 2007

Clients and Friends,

The major items this month are a continuation of the concerns regarding the "Patent Act of 2007", the changes in the US Patent and Trademark Office's regulations about patent processing which will limit the number of claims and continuations unless the applicant provides the USPTO with a lot of expensive-to-acquire information, and the definition and application of willful infringement in patent infringement cases,

The ABA and the US patent examiners have come out against the patent act, and President Bush has said that he doesn't like some of the proposed changes and may veto the legislation if it reaches his desk as it passed the House of Representatives. I have organized the articles into broad groupings to make it easier to follow an issue. There are articles representing all points of view so that you can read them and make up your own minds. Whichever way you decide, you should make your views known to your US Senators as soon as possible since the legislation will probably be considered in the Senate within the next week.

PIPS helps companies protect their current and future products and services by identifying a company's IP; providing strategic IP services, IP protection assistance and negotiation services; providing part-time IP management services; and in-licensing of needed technologies and out-licensing of "excess" technologies. PIPS also translates "Tech-Speak" into the language of strategic partners, financial sources, legal advisors and other non-technical business people that need to understand the company.

Please visit [PIPS' web site](#) for more information about PIPS, its services and capabilities. PIPS works directly with idea-based companies and/or with their attorneys.

Please contact PIPS to discuss your situation in a [free confidential](#) 45 minute consultation.

We appreciate your feedback at suggestions@protectiveIPservices.com.

USPTO

Wu tackles backlog in patent reviews

The Register-Guard - Eugene, OR, USA

AP PORTLAND - Portland patent attorney Kassim Ferris has been telling clients that federal examiners might not get to their patent application for six years ...

Board of Patent Appeals & Interferences Final Decisions Now Text ...

ag-IP-news Agency - Amman, Jordan

This web page is accessible via the Board's web page on the USPTO's website. Specifically, the database of final Board decisions that are posted on the ...

Disclaimer: PIPS is not responsible for the content of the articles in this newsletter, nor for the results of any decisions based on them.

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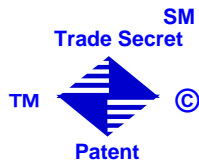
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[Two Patent-Related Scourges Addressed](#)

By Seth Shulman

In other welcome (by most corporations, anyway) patent news, a recent court ruling will make it more difficult for patent holders to collect much-feared treble damages for so-called willful infringement of their patents. ...

[USPTO & UK IPO Announce "Fast-track" Patent Examination](#)

By Daily Dose of IP

The USPTO recently announced that it and the United Kingdom Intellectual Property Office ("UK IPO") will now be "accepting" patent applications for fast-track examination. According to the USPTO press release (link below), "[t]he Patent ...

[New USPTO Rules, Legal Decision Signal Changes For US Patent Practices](#)

By Dugie Standeford for Intellectual Property

Watch New rules by the US Patent and Trademark Office (USPTO) governing the continuation of patent applications will wreak havoc in the biotechnology and high-tech sectors, according to some ...

[New patent rules relating to patent prosecution](#)

Fulbright & Jaworski LLP

The United States Patent and Trademark Office (PTO) has announced that its new rules relating to examination of claims and filing of continuations will publish by the end of August 2007 and will take effect sometime after October 1, 2007.

[USPTO reduces flexibility of patent applicants to fully claim their inventions](#)

Perkins Coie LLP

The U.S. Patent and Trademark Office published new regulations on August 21, 2007, that limit continuation applications and other patent claims filing strategies.

[Patent office issues new and amended rules relating to patent applications](#)

Jackson Walker LLP

On Tuesday, August 21, 2007, the U.S. Patent

and Trademark Office (PTO) published its final rules relating to "Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims and Examination of Claims in Patent Applications" (the "New Rules").

[The new patent rules - what you don't know can hurt you](#)

Stroock & Stroock & Lavan LLP

Patent applicants beware!

[USPTO reduces flexibility of patent applicants to fully claim their inventions](#)

Perkins Coie LLP

The U.S. Patent and Trademark Office published new regulations on August 21, 2007, that limit continuation applications and other patent claims filing strategies.

[Federal Circuit addresses willfulness and the advice of counsel defense](#)

Sutherland Asbill & Brennan LLP

In a recent and unanimous en banc decision, the U.S. Court of Appeals for the Federal Circuit reversed its long-standing rule requiring that an accused patent infringer exercise an affirmative duty of due care to determine whether or not he is infringing to avoid a finding of willful infringement.

[In re Seagate revises patent law on willfulness](#)

Orrick

On August 21, 2007, the Federal Circuit issued a unanimous (and highly anticipated) en banc ruling in *In re Seagate Tech., LLC*, Misc. No. 830 (Fed. Cir. Aug. 21, 2007) that has significantly revised the law of willful patent infringement.

[Rappers get litigious over IP](#)

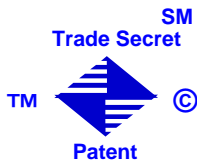
Manatt Phelps & Phillips LLP

Two rappers went to court last week over intellectual property they claim is being used without their permission.

[Tech group challenges copyright notices as unfair and deceptive](#)

Steptoe & Johnson LLP

The Computer and Communications Industry Association (CCIA) -- which counts Google, Yahoo!, Oracle, and Microsoft among its members -- has filed a complaint with the Federal Trade Commission alleging that various content providers are committing "unfair or



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deceptive acts or practices" by "misrepresenting consumer rights under copyright law" in the copyright warnings that appear at the beginning of sports broadcasts, DVDs, and books.

[In re Seagate Technology, LLC –willful infringement and the scope of waiver of the attorney-client privilege and work product doctrine](#)

Fenwick & West LLP

On August 20, 2007, the Federal Circuit, sitting en banc, articulated a new standard for willful infringement: patentees must show at least objective recklessness.

[Federal Circuit adopts new willfulness standard, clarifies privilege waiver](#)

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[Patent office issues new and amended rules relating to patent applications](#)

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On Tuesday, August 21, 2007, the U.S. Patent and Trademark Office (PTO) published its final rules relating to “Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims and Examination of Claims in Patent Applications” (the “New Rules”).

[Qualcom rue wilful use as damages to Broadcom are doubled](#)

Shepherd & Wedderburn LLP

In case anyone is in any doubt as to McDonald's motives and the value of obtaining patent protection they need look no further than the recent case of Broadcom against Qualcomm regarding the breach by Qualcomm of three of Broadcom's patents relating to mobile phone chips.

[SoundExchange offers small webcasters royalty deal](#)

Paul Weiss Rifkind Wharton & Garrison LLP

In hopes of quieting the uproar over a recent Copyright Royalty Board (CRB) order that more than doubles royalty rates that Internet radio broadcasters must pay to stream music online, SoundExchange offered small webcasters a

discount plan that would enable eligible entities to pay no more than 12% of their annual revenues in royalty fees.

[Levi's sues Polo for trademark infringement](#)

Manatt Phelps & Phillips LLP

Levi Strauss & Co. is suing Polo Ralph Lauren Corp. for allegedly copying the jeans and apparel maker's trademarked pocket stitching design.

[New rules for U.S. patent applications](#)

Fenwick & West LLP

Earlier today, the United States Patent and Trademark Office (USPTO) published new rules for patent prosecution.

[Willful patent infringement standards changed](#)

Perkins Coie LLP

After a Federal Circuit decision this week, patent owners will have a harder time proving willful infringement and defendants will be less likely to have to disclose the opinions of their trial counsel regarding the merits of patent cases.

[The U.S. Patent and Trademark Office revises its rules on continued examination filings, patentably indistinct claims, and examination of claims](#)

Sutherland Asbill & Brennan LLP

On August 21, 2007, the United States Patent and Trademark Office (“USPTO”) published controversial changes in its patent rules concerning continued examination practice, patent applications containing patentably indistinct claims, and examination of claims (the “Revised Patent Rules”).

[A receding tide for patents? An early assessment of In re Seagate Technology, LLC](#)

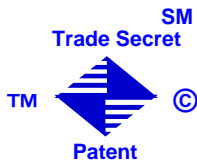
Gardere Wynne Sewell LLP

The recent decision in *In re Seagate Technology, LLC*, Miscellaneous Docket No. 830 (Fed. Cir. 2007), is another setback for patentees, who lost several important battles in the United States Supreme Court earlier this year.

[USPTO issues final rules limiting continuations and number of claims](#)

Foley & Lardner LLP

Today, the United States Patent and Trademark



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Office (USPTO) issued its final rules limiting continuations and the number of claims.

[Guidelines for examination support document \(ESD\)](#) USPTO.gov

Applicant may present more than five independent claims or more than twenty-five total claims in an application, if applicant files an examination support document (ESD) in compliance with 37 CFR 1.265 before the first Office action on the merits of the application.

[How long does a BPAI appeal take?](#)

Dennis Crouch's Patently-O

On average it took just under 18 months (542 days) from the filing of the appeal brief until a decision was reached by the BPAI.

COURTS

[Court to Consider Technology Patent Case](#)

The Associated Press -

WASHINGTON (AP) -- The Supreme Court said Tuesday it will consider a technology patent case that could have far-reaching ramifications for computer makers ...

[Supremes to rule on PC makers' patent spat](#)

Register - London, England, UK

By Austin Modine in Mountain View → More by this author The US Supreme Court will review a patent dispute between LG Electronics and a group of Taiwanese ...

[Major Headaches Possible for Tech Patent Holders](#)

InternetNews.com - USA

By Andy Patrizio The US Supreme Court on Tuesday agreed to hear a technology patent case that has the potential to throw the entire technology supply chain ...

[Claiming software-based inventions in the wake of Microsoft v AT&T](#)

Dickstein Shapiro Morin & Oshinsky LLP

Thirty-five years ago, the Supreme Court interpreted the patent statutes in such a way as to open a loophole through which would-be patent infringers could escape liability.

[The practical effect of the KSR decision](#)

Baker, Donelson, Bearman, Caldwell & Berkowitz PC

In KSR, the Supreme Court swung the pendulum away from the rigid "teaching/suggestion/motivation" test, or "TSM," towards a more flexible analysis.

[WILLFUL INFRINGEMENT](#)

[The Federal Circuit changes the rules of willful patent infringement and patent opinions](#)

Kilpatrick Stockton LLP

In re Seagate Technology, LLC, F.3d , Misc. Docket No. 830 (Fed. Cir. Aug. 20, 2007) sets forth new rules in three important areas related to willful patent infringement. First, the court replaced the "duty of due care" standard for willful patent infringement with a two-part "objective recklessness" standard which will make it more difficult to prove willful infringement.

[Federal Circuit addresses willfulness and the advice of counsel defense](#)

Sutherland Asbill & Brennan LLP

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[In re Seagate revises patent law on willfulness](#)

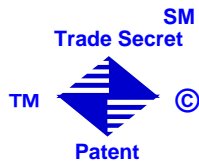
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[In re Seagate Technology, LLC –willful infringement and the scope of waiver of the attorney-client privilege and work product doctrine](#)

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[Willful patent infringement standards changed](#)

Perkins Coie LLP

After a Federal Circuit decision this week, patent owners will have a harder time proving willful infringement and defendants will be less likely to have to disclose the opinions of their trial counsel regarding the merits of patent cases.

[Federal Circuit overrules precedent - a sea change in the law on willfulness](#)

Paul Hastings Janofsky & Walker LLP

In a decision dated August 20, 2007, Seagate Technology, LLC (Miscellaneous Docket No. 830), the Court of Appeals for the Federal Circuit has reversed precedent dating almost to the inception of that Court, and raised the standard for proving that an adjudged infringer's conduct was willful (which could entitle the patent owner to up to treble damages and attorney fees).

[US Supreme Court decisions in eBay, Medimmune, and KSR deliver triple dose of bad news to non-practicing patent holders](#)

Thelen Reid Brown Raysman & Steiner

Over the last 15 months, the U.S. Supreme Court has issued three significant patent decisions with negative consequences for the non-practicing patent holder or "patent troll" business model.

[In re Nuijten](#)

Nixon Peabody LLP

If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.

[First US lawsuit filed to enforce the General Public License](#)

Pillsbury Winthrop Shaw Pittman LLP

On September 20, 2007, the first U.S. lawsuit was filed to enforce the General Public License

version 2 ("GPLv2"), one of the most widely used of the scores of open source licenses

[Microsoft, Eolas Settle Patent Dispute](#)

eWeek - New York, NY

The nearly decade-long browser patent infringement dispute between Microsoft and Eolas Technologies is over. Terms of the out-of-court settlement were not ...

[DOMESTIC](#)

[Trolls \(and other bad news\) lurking in your mailbox](#)

Ice Miller LLP

If you haven't received one yet, you will.

[PATENT ACT OF 2007](#)

[Patent Reform News from Patently-O](#)

By krisn(krisn)

Patent Law Blog (Patently-O): Patent Reform News An update on patent reform legislation working its way through Congress right now. An interesting amendment (from the comments includes):. banning of patents on "tax planning methods". ...

[Patent reform legislation](#)

Baker, Donelson, Bearman, Caldwell & Berkowitz PC

Last month, the House and Senate Judiciary committees approved their respective versions of legislation intended to overhaul the U.S. patent system.

[Patent law reform must foster innovation, not burden inventors ...](#)

Houston Chronicle - United States

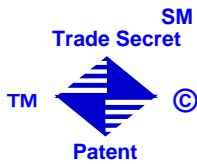
This month, the US House passed a bill to reform patent laws, a legal mine-field that is at once highly complex and arcane and yet critical to fostering ...

[White House Seeks Changes To Patent Reform Proposal](#)

InformationWeek - Manhasset,NY,USA

President Bush issued a statement supporting the concept of patent reform, but said he will oppose the current bill unless changes are made. ...

[Biotech Firms Wary of Changes to Patent Application Regulations](#)



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San Diego Business Journal - CA,USA

By HEATHER CHAMBERS Upcoming changes to US Patent and Trademark Office rules are creating a stir in the biotech world, where intellectual property ...

[Patent Protests](#)

Press-Enterprise (subscription) - Riverside,CA,USA

By CHRIS MONDICS PHILADELPHIA - After decades of relative calm, a battle royal has broken out among leading industries over the nation's patent laws with ...

[Tech, drug companies battle over US patent reform](#)

ABC News - USA

By Diane Bartz WASHINGTON (Reuters) - Lawmakers returning from their summer break are expected to consider patent law changes that have pitted two of ...

[ABA opposes Patent Reform Act of 2007](#)

...the IP section of the American Bar Association has just sent a strongly worded letter to Congress OPPOSING both the House and Senate patent reform bills.

[Apple's 2007 Lobbying: Patent System Reform, Education Tax Breaks](#)

Mac Rumors - Newport News,VA,USA

Topics of interest to Apple appear to be updating the US patent system, and advocacy of bills to increase funding for technology in education and provide ...

[Microsoft Patent Win in Court May Cut Its Chances in Congress](#)

Bloomberg - USA

Microsoft's success in reversing a \$1.52 billion trial loss was the latest in a series of court victories that may undermine its chance for broad changes in US patent ...

[Consumer Groups Back Patent Bill](#)

PC World - USA

Five consumer groups have given their support to legislation that would overhaul the

US patent system, saying the bill would create fairer penalties for ...

[Patent Examiners Oppose Patent Reform Proposal](#)

InformationWeek - Manhasset,NY,USA

A group that claims to represent more than 5000 patent examiners and professionals says patent reform proposals would hurt the American patent approval ...

[Google Calls for Patent Reform](#)

InformationWeek - Manhasset,NY,USA

In light of legal action from Polaris IP, Google execs say the US patent system has not kept pace with the changes in the innovation economy. ...

[House Passes Patent Reform Amid Flurry Of Tech Patent Suits](#)

InformationWeek - Manhasset,NY,USA

By Marianne Kolbasuk McGee Just as several companies were pressing fresh technology patent-infringement claims this week, the US House of Representatives ...

[House passes controversial patent reform bill](#)

EETimes.com - USA

7) a sweeping and controversial patent reform bill. HR1908 aims to raise the quality of patents and reduce patent litigation and abuse. ...

[Patent overhaul approved in House](#)

San Jose Mercury News - CA, USA

By Frank Davies WASHINGTON - The US House Friday approved an overhaul of the patent system designed to rein in excessive litigation and improve patent ...

[House passes sweeping revision of US patent laws](#)

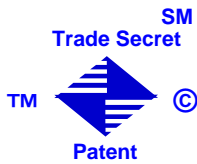
International Herald Tribune - France

Bloomberg News, AP WASHINGTON: The US House of Representatives has approved the most sweeping changes to US patent law in more than half a century, ...

[Patent Problems Pending with the Patent Reform Act of 2007, Group Says](#)

Associated Content - Denver,CO,USA

Dr. Poltorak has also co-written books on



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intellectual property (Essentials of Intellectual Property published in 2002 and Essentials of Licensing ...

[Patent Reform Moves to Senate](#)

eWeek - New York, NY

The ink was barely dry on the patent reform bill that was approved by the House of Representatives on Sept. 7 when speculation began over the fate of the ...

[Patent law passed in US, but Presidential veto could follow](#)

A new US law which would reduce the damages to be paid out for patent infringement has been passed by one half of the US legislature. via The Register.

[Countervailing forces propel patent reform](#)

EETimes.com - USA

The US patent system is shifting under a building head of political steam. But just what all the changes and their fallout will be is still unclear, ...

[Patent law overhaul: Bad for start-ups?](#)

CNET News.com - San Francisco,CA,USA

Patent-dependent companies and inventors have fighting words for a bill that passed the House and, they hope, will die in the Senate.

...

[Inventors protest at US patent bill](#)

VNUNet.com - UK

Protests have begun over a reform of the patent laws being considered by the US government. Dean Kamen, inventor of the Segway and holder of 440 patents, ...

[Inventors Protest US Patent Bill](#)

www.keznews.com

"You do not shut down the national pastime of baseball because some players are using steroids," Kamen told the San José Mercury News. "You can go after 'trolls' and other bad actors without unintended consequences that are harmful." ...

[Tech Startups Oppose Patent Reform](#)

As debate over the Patent Reform Act of

2007 moves from the House, which passed a bill on September 7, to the Senate, small tech companies and individual inventors descended on senators to voice their opposition.

[New Trademark Protection Act prohibits keyword advertising](#)

Baker, Donelson, Bearman, Caldwell & Berkowitz PC

Utah has recently passed legislation prohibiting keyword advertising when such advertising involves the sale of trademarks used in the state of Utah.

[Vonage loses appeal in Verizon patent case](#)

CNET News.com - San Francisco,CA,USA

After months of battle, Vonage has lost the bulk of its appeal in the Verizon Communications patent infringement case. In March, a jury in Virginia found ...

[In light of Patent woes, Vonage could be acquired by Sprint after all](#)

ZDNet - USA

Mike says it is a shame because while Vonage holds no Patents, it's figured out a way to market VoIP to the masses that many VoIP Patent-holders have not. ...

[Pharmaceutical testing device manufacturer likely infringed competitor's trademarks](#)

Faegre & Benson LLP

Westech, a manufacturer of aerosol testing devices, likely infringed upon trademarks owned by Minnesota-based MSP Corporation and engaged in false advertising, the U.S. District Court for the District of Minnesota held Aug. 7.

[Court finds copyright infringement in republication of photo by news source](#)

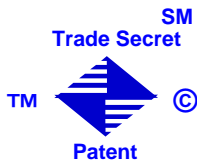
Winston & Strawn LLP

A lawsuit was brought against the local Boston CBS station by photographer Christopher Fitzgerald, who took the only known pictures of a well-known mobster's (Stephen Flemmi) arrest in 1995 and licensed their one-time use to CBS.

[Patent system is crashing: IBM wants to patent outsourcing](#)

By freitasm

The USPTO is considering IBM's patent application for Outsourcing of Services, a



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'method for identifying human-resource work content to outsource offshore of an organization' to 'countries where cheaper labor prices and/or cheaper ...

Intellectual Property Rights (IPR) is the privileges given to the owners of works that are created with the help of individual intelligence. ...

INTERNATIONAL

WTO Inquiry Launched Into US Complaints Against China's IP Record

Intellectual Property Watch - Geneva, Switzerland

Washington claims Beijing's apparent failure to clamp down adequately on intellectual property rights violations has facilitated the growth of one of the ...

How to Protect Intellectual Property in China

Kiplinger.com - Headlines - <http://www.kiplinger.com>

One of the gravest risks of doing business in China is having your most valuable resources -- intellectual property -- stolen and misused. Here are ways to thwart would-be counterfeiters.

EU Split Arises Over Thai Effort To Obtain Cheaper Patented Drugs

Intellectual Property Watch - <http://www.ip-watch.org/weblog>

By David Cronin for Intellectual Property Watch
A dispute has erupted between two of the European Union's most powerful institutions over Thailand's decision to circumvent pharmaceutical patents in order to boost its supply of cheap ...

Enforcement finally benefits user

Economic Times - India

Intellectual property rights (IPRs) policies and precedents have substantially changed in the past decade, both in the context of the environment in which ...

WTO to Rule on US Claim China's Piracy Laws Are Lax (Update2)

Bloomberg - USA

25 (Bloomberg) -- The World Trade Organization will decide whether China's laws on piracy of intellectual property fail to meet international norms, ...

Intellectual Property- Its Meaning and Development in India

PR-GB.com (press release) - Sofia, Bulgaria

OTHER

Concepts of Innovation, Invention Should Now Be Regarded Differently

Midwest Business

Consonant with the etymological origin of the word, "innovation" implies the creation of something new. In this regard, innovation is often equated with invention. However, the two definitions -- innovation and invention -- have been evolving.

Google puts in patent application for SMS text message payment ...

IntoMobile - Los Angeles, CA, USA

The search giant has just published their patent application (filed Feb. 28, 2006) for an SMS text message-payment system, ostensibly called "GPay," that ...

Google files patent for mobile commerce

Computerworld - Framingham, MA, USA

September 04, 2007 (Computerworld) -- Google Inc. has filed a patent that would allow users to pay for goods from vending machines and retailers -- as well ...

Property Rights in the 21st Century: Don't Steal This Paper or My ...

By Shiril Kennedy Docuticker - <http://www.docuticker.com/>

"The importance of protecting personal and intellectual property rights cannot be overemphasized. From the expansion of eminent domain to the free software movement, the right to retain possession of and benefit financially from both ...

Intellectual pursuits

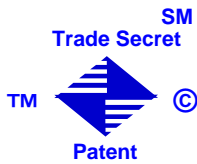
Sydney Morning Herald - Sydney, New South Wales, Australia

Protecting intellectual property rights can present a minefield of traps for young players in IT startups. Decisions have to be made carefully right from ...

Protecting intellectual property

TechJournal South - Research Triangle Park, NC, USA

By Stephen Allred and Brian Barger, This advice



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holds true for companies attempting to protect their intellectual property and trade secrets. ...

[Why Intellectual Property is Important](#)

Hawaii Reporter - Kailua, HI, USA

Intellectual property is an important matter that should be respected. Here are some of my reasons why. You are a lesser-known singer or band, performing in ...

[Patent Baristas » What's A Reasonable Royalty Rate?](#)

Patent Baristas

As usual, "it depends." However, the Patent Baristas blog has an excellent answer to that question. [Originally posted on The Invent Blog. Copyright (c) Stephen M. Nipper 2004-2007. All Rights Reserved.]

[Your IP Rights have been licensed to syndicate!](#)

ZDNet UK - UK

... up into its constituent parts presents some new governance challenges for organizations who want to contain and protect their intellectual property. ...

[Intellectual property baffles ex-employee](#)

Arizona Republic - Phoenix, AZ, USA

I just received a letter from my old employer that reminds me of my continuing obligations to them regarding intellectual property, including names of ...

[Read between the lines: software licensing issues for banks](#)

Bricker & Eckler LLP

Sometimes looks can be deceiving, and when it comes to software licenses, this proverbial phrase certainly applies.