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MAXIMIZING THE VALUE OF YOUR INTELLECTUAL PROPERTY THROUGH STRATEGIC INTELLECTUAL PROPERTY MANAGEMENTSM

August 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 as in last month, there are large discussions and stories generated by the Supreme Court's KSR and Microsoft decisions and Congress' pending patent law reform. Because of the importance of these issues I have included many articles on these topics. They have been grouped together to make it easier for you to find them, In addition to "news", "commentary" is also unbiasedly included. There are two parties in the patent law revision debate – the high technology companies such as Microsoft, Intel and Hewlett Packard on one side and the innovation-oriented companies such as entrepreneurs, venture capitalists, trade groups, drug and medical equipment manufacturers, engineering societies, and research universities on the other. These articles should help you understand the issues if you are not familiar with them or see the other point of view if you are already knowledgeable.

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. PIPS works directly with idea-based companies or with attorneys.

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

We appreciate your feedback at suggestions@protectiveIPservices.com.

USPTO

Continuation Changes: Where we stand and

What to Do Dennis Crouch's Patently-O

Current status of the USPTO's changes to continuation and claiming practice:

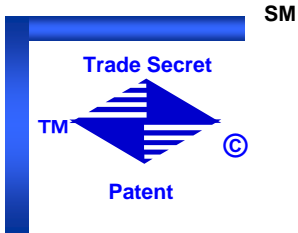
Business method patents: growth amidst uncertainty sums up the Patent and Trademark Office's business method partnership meeting

Alston & Bird LLP

The Patent and Trademark Office's business method technology center is gearing up to handle a new surge of applications from the financial industry, while closely following appeals from recent decisions by the Board of Patent Appeals and Interferences limiting the scope of

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patentable subject matter available for business method inventions.

[USPTO Sued Over "Unqualified Appointment"](#)

Slashdot - USA

Techdirt is reporting that a small group of patent lawyers and investors are suing the US Secretary of Commerce in order to prevent the appointment of ... For more information on this issue see Greg Aharonian of the Internet Patent News Service (www.patenting-art.com)

[COURTS](#)

[KSR and Post-KSR](#)

[KSR v. Teleflex – the Supreme Court dilutes the obviousness standard](#)

Bricker & Eckler LLP

On April 30, the U.S. Supreme Court issued an opinion with far-reaching consequences on existing patents, new patents, patent infringement litigation and, ultimately, the value of patent portfolios.

[KSR v. Teleflex and its impact on the analysis of patent claim obviousness](#)

Ice Miller LLP

The U.S. Supreme Court recently delivered its long-awaited opinion in KSR International Co. v. Teleflex Inc.

[The Supreme Court sanctions the use of common sense](#)

Baker Botts LLP

In its recently issued decision in KSR International, Co. v. Teleflex, Inc., the United States Supreme Court held that trial courts may draw upon common sense when determining whether the claims of a patent or application are obvious.

[Trying A Patent Validity Case In A Post-KSR World](#)

Mondaq News Alerts (subscription) - London, UK

However, based on the author's experience in a recent case in which patent validity was raised as the principal defense to our client's infringement claim, ...

[First two Federal Circuit post-KSR obviousness decisions affirm patents' invalidity](#)

Fenwick & West LLP

In its first decisions to issue in the wake of the Supreme Court's KSR Int'l Co. v. Teleflex Inc. decision, 127 S.Ct. 1727 (2007), the Federal Circuit has affirmed two district court decisions of obviousness.

[The Supreme Court meets expectations in KSR and Microsoft](#)

Reed Smith LLP

In May, two long-anticipated and back-to-back opinions, Microsoft v. AT&T, 127 S.Ct. 1746 (2007), and KSR Int'l Co. v. Teleflex, Inc., 127 S.Ct. 1727 (2007), issued from the U.S. Supreme Court.

[Supreme Court rules on obviousness standard for determining patentability](#)

Hogan & Hartson LLP

On April 30, 2007, the Supreme Court decided KSR International Co. v. Teleflex, Inc., an important decision regarding the statutory standard for determining whether a patent is obvious within the meaning of 35 U.S.C. § 103.1.

[Nonobviousness in chemical cases; lead-compound requirement](#)

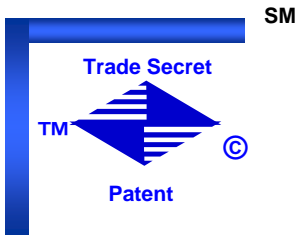
Patterson Belknap Webb & Tyler LLP

The Federal Circuit affirmed a decision finding claims 1, 2 and 5 of Takeda's U.S. Patent No. 4,687,777 nonobvious.

[Judge suggests compromise in Vonage patent case](#)

Paul Weiss Rifkind Wharton & Garrison LLP

During oral arguments on Vonage Holdings' appeal of a jury verdict that found Vonage liable for infringing voice-over-Internet protocol (VoIP) patents belonging to Verizon Communications, a judge with the U.S. Court of Appeals for the Federal Circuit suggested that the parties could reach a "middle ground" that would provide Verizon with compensation for Vonage's use of the technologies in question while enabling Vonage to remain in business.



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[Criminal trade secret prosecution emerges as IP protection tool](#)

Fenwick & West LLP

On May 23, 2007, Coca-Cola employee Joya Williams was sentenced to eight years in prison for trying to sell Coke's trade secrets to rival Pepsi.

[Honeywell Int'l, Inc. v. Universal Avionics Sys. Corp.](#)

Nixon Peabody LLP

[T]he patentee's definition governs, even if it is contrary to the conventional meaning of the term.

[Patent term extensions, apply in time... or else!](#)

Stinson Morrison Hecker LLP

The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product may be extended under patent law.

[Federal Circuit elucidates 'foreseeability' component of equivalents test](#)

Dewey Ballantine LLP

In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 05-1492 (July 5, 2007), the United States Court of Appeals for the Federal Circuit has further refined the analysis of when the doctrine of equivalents applies.

[Further Limitations on Doctrine of Equivalents: Equivalent Foreseeable if Disclosed in Relevant Art](#)

Dennis Crouch's Patently-O
In 1988, Festo sued SMC for infringement of its magnetized pistons. Since then, the CAFC has issued numerous *Festo* opinions including two *en banc*. The Supreme Court has also ruled twice. This appeal, like many of the others involve the scope and limits of the doctrine of equivalents (DOE).

[Chinese firm wins patent infringement lawsuit in US](#)

Xinhua - China

BEIJING, July 20 -- General Protecht, an electrical product manufacturer based in East China's Zhejiang Province, has won a three-year patent infringement ...

[Eleventh Circuit revises "revisionist" opinion on copyright infringement](#)

Holland & Knight LLP

Six years after handing a freelance photographer a victory in a copyright appeal against National Geographic, the U.S. Eleventh Circuit Court of Appeals reversed course.

[Split decisions: the issue of "use" in the context of search engine keyword-triggered advertising](#)

Arent Fox LLP

Keyword-triggered search engine advertising continues to be highly profitable for internet search engine companies.

[Festo XIII: making the unforeseeable foreseeable](#)

Sutherland Asbill & Brennan LLP

After nearly 20 years, two Supreme Court visits, and two Federal Circuit en banc reviews, a Federal Circuit panel has recently issued yet another *Festo* opinion addressing prosecution history estoppel and infringement under the doctrine of equivalents.

DOMESTIC

Patent Reform

[Look Who's Fighting Patent Reform](#)

www.businessweek.com

VCs, trade groups, and universities have taken up the fight against Big Tech. ...The goal was to stem the tide of patent litigation, much of it generated by inventors and small companies trying to protect their intellectual property.

[Senators Impose Potential Limits On Patent Challenges](#)

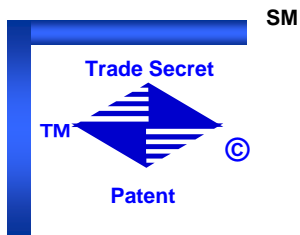
CNNMoney.com - USA

WASHINGTON -(Dow Jones)- Lawmakers agreed Thursday to limit the number of court venues through which patent holders could pursue allegations that their ...

[Senate Panel Inches Toward Patent Reform](#)

Washington Post - United States

The Senate Judiciary Committee on Thursday edged closer to approving a bill



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designed to revamp the nation's patent system. However, the panel was unable to ...

[IT Groups Push For Patent Reform](#)

InformationWeek - Manhasset,NY,USA

CompTIA said Thursday that many of its members are hamstrung by patent litigation and consumers around the world suffer for it. By KC Jones The Computing ...

[Senate Panel Amends Patent Reform Bill](#)

InternetNews.com - USA

By Sean Michael Kerner Patent reform in Congress took a tentative step forward today with the Senate Judiciary Committee approving several amendments to the ...

[House Committee OKs Patent Bill](#)

Forbes - NY,USA

By CHRISTOPHER S. RUGABER 07.18.07, 4:12 PM ET A House committee on Wednesday approved patent reform legislation that the technology sector has sought for ...

[Patent reform must nix one-size-fits-all structure](#)

CNET News.com - San Francisco,CA,USA

Tech politics watcher Brian Kahin says the patent system should suit different needs, granting one sort of patent for software, for instance,

[Senate Panel Approves Patent Reform Bill](#)

Forbes - NY,USA

By CHRISTOPHER S. RUGABER 07.19.07, 7:49 PM ET The Senate Judiciary Committee approved a sweeping patent reform bill Thursday that seeks to improve patent ...

[High-tech and biotech clashing over patent law overhaul](#)

International Herald Tribune - France

But this week they are on opposite sides of a fight playing out in Washington: How to overhaul the nation's patent system. Both industries depend on ...

[Opinion: Is the House Getting It Right on Patent Reform?](#)

Computerworld - Framingham,MA,USA

July 20, 2007 (Computerworld) -- The House of Representatives has approved the form of a bill that would significantly reform United States patent law, ...

[US Patent Reform Bill Moves Out of Committee](#)

SYS-CON Media - Montvale,NJ,USA

By Enterprise Open Source News Desk The proposed Patent Reform Act of 2007 that critics of the US patent system put so much stock in has cleared the House ...

[Director of USPTO comments on proposed patent rule changes](#)

Gowling Lafleur Henderson LLP

In an interview with the New York Times, Jon W. Dudas, director of the USPTO, voiced his support for the proposed rule changes currently being sought before the House and the Senate.

[Senate Panel OKs Patent Reform Bill](#)

Washington Post - United States

The Senate Judiciary Committee approved a bill Thursday designed to revamp the nation's patent system, legislation that includes several provisions that ...

[Patent Reform Act: It Has Everything an Infringer Could Want](#)

Wall Street Journal - USA

In his July 12 editorial-page commentary "Patent Nonsense," Bruce Sewell, general counsel of Intel, paints a dire picture of the US patent system in broad ...

[Congress moves to rewrite patent laws](#)

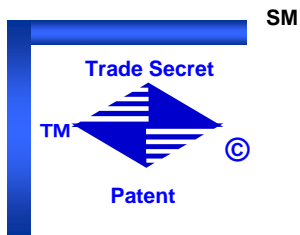
Herald News Daily - Williston,ND,USA

Rather than the patent system being the incentive for "so much of our innovation, it has become a constraint on innovation," said Rep. ...

[Patent Deform](#)

By Patent Prospector

Some patent infotainment in today's Wall Street Journal letter page, as David



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Vandagriff of Heliuss gets his licks in on Bruce Sewell, Intel patent clown, for being such a corporate slut. On the same page, James McKeown writes like he ...

["Attempted infringement" appears in new House intellectual property ...](#)

Ars Technica - Boston,MA,USA

HR 3155, the Intellectual Property Enhanced Criminal Enforcement Act of 2007, aims widely. Everything gets a section: unauthorized recording of films in ...

[Consumer Groups File Comments Supporting US Patent Office's Stem ...](#)

Earthtimes.org - USA

Last July the groups, the Foundation for Taxpayer and Consumer Rights (FTCR) and the Public Patent Foundation (PUBPAT) challenged the patents because they ...

[US Mayors Pass Piracy-Prevention Resolution](#)

InformationWeek - Manhasset,NY,USA

By KC Jones The US Conference of Mayors passed a resolution supporting more training, education, and enforcement of intellectual property laws. ...

[IBM Opens Its Software Patent Treasure Trove](#)

IEEE Spectrum - New York,NY,USA

The IBM announcement said the intellectual property involved in the decision centered around specifications and protocols that could be involved in ...

[IBM Extends Patent Pledge](#)

InternetNews.com - USA

IBM spokesperson Ari Fishkind said that vendors cannot patent a standard itself, but there is sometimes technology that a standard may somehow need or touch ...

[ITC flexes its muscle in cell phone case; agency can offer IP rightsholders broad relief against infringement](#)

Goodwin Procter LLP

Considering a new cell phone or iPhone alternative?

[Disbarment of prosecutor who worked for invention promotion company](#)

Fish & Richardson PC

Fed Cir affirms grant of summary judgment upholding disciplinary action taken by PTO Director that excludes Bender from practicing before the PTO.

[For 112\(6\) claims, bare statement that known techniques or methods can be used does not disclose adequate corresponding structure](#)

Fish & Richardson PC

Fed Cir affirms judgment of indefiniteness because "the claim limitation 'control means' has no corresponding structure described in the specification as required by 35 U.S.C. 112, ¶ 6."

...

[IRS releases guidance on federally-sponsored research arrangements](#)

Orrick

On June 26, 2007, the Internal Revenue Service (the "IRS") released Revenue Procedure 2007-47 (the "Revenue Procedure"), which is designed to resolve the issue of whether rights granted to the federal government pursuant to research contracts, grants or cooperative agreements funded in whole or in part by the federal government will result

[Trademark licensor liability for defective products under US law](#)

Chadbourne & Parke LLP

Trademark licensing in all its forms — promotional, collateral and classical — has become an increasingly large and dynamic part of the global economy.

[Virtual property at risk: contract and IP set to collide](#)

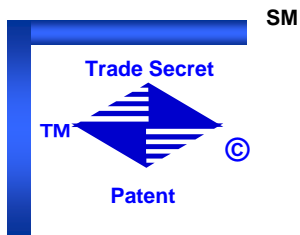
Lang Michener LLP

From foundations laid in the 1960s, through the birth of the Worldwide Web in the early '90s, to the subsequent bursting of the dot-com bubble, and beyond, the Internet has taken on a life of its own.

[Unauthorized, but unused, copies of software still infringe copyright](#)

Miller Canfield Paddock & Stone

Businesses today utilize a variety of software programs in performing their day-to-day operations.



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[Customer proposals and experimental demonstrations of terrain warning system did not constitute offer for sale or public use](#)

Finnegan Henderson Farabow Garrett & Dunner LLP
In Honeywell International Inc. v. Universal Avionics Systems Corp., Nos. 05-1112, -1151, -1152 (Fed. Cir. May 25, 2007), the Federal Circuit vacated the district court's claim construction and remanded for a new infringement determination.

[You have invented the next great medical device... now protect it](#)

McGuireWoods LLP

You have just invented the greatest medical device the world will ever see.

[Obvious to update electromechanical learning device with modern electronic components](#)

Finnegan Henderson Farabow Garrett & Dunner LLP
In Leapfrog Enterprises, Inc. v. Fisher-Price, Inc., No. 06-1402 (Fed. Cir. May 9, 2007), the Federal Circuit affirmed the district court's judgment of noninfringement and invalidity of claim 25 of U.S. Patent No. 5,813,861 ("the '861 patent").

[Trademark protection for ASPIRINA denied as proposed mark is merely descriptive and similar in sound, appearance, and meaning to generic term "aspirin"](#)

Finnegan Henderson Farabow Garrett & Dunner LLP
In In re Bayer Aktiengesellschaft, No. 06-1279 (Fed. Cir. May 24, 2007), the Federal Circuit affirmed the TTAB's ruling that the proposed mark ASPIRINA was merely descriptive for analgesic goods and affirmed the denial of Bayer Aktiengesellschaft's ("Bayer") intent-to-use application to register the mark.

[Narrow claim language precludes infringement on summary judgment](#)

Finnegan Henderson Farabow Garrett & Dunner LLP
In Foremost in Packaging Systems, Inc. v. Cold Chain Technologies, Inc., No. 06-1582 (Fed. Cir. May 2, 2007), the Federal Circuit affirmed the district court's grant of SJ of noninfringement of claims 9, 13, and 22 of Foremost in Packaging Systems, Inc.'s ("Foremost") U.S. Patent No. 5,294,302 ("the '302 patent").

INTERNATIONAL

[Ethiopia: Brilliant strategy against Starbucks means more for farmers](#)

African Path - Minneapolis, MN, USA

One key aspect of the Ethiopian experience is that they worked from within the modern intellectual property system to help poor farmers. [. ...

[Ethiopia triumphs over Starbucks: wins rights to coffee](#)

FinalCall.com - Chicago, IL, USA

The deal allows Ethiopia to better use the modern trading system and especially the system's often-controversial intellectual property rights provisions. ...

[Incoming EPO president reopens software patent debate](#)

Register - London, England, UK

By Lucy Sherriff More by this author New head of the European Patent Office (EPO), Alison Brimelow, has signalled her intentions early, calling a public ...

[CATA claims new patent precedent could spell doom for IT R&D](#)

ITWorld Canada - Canada

Last month, a federal improvement/selection patent case involving a pharmaceutical company (Eli Lilly Canada Inc. vs. Novopharm Limited et al) resulted in ...

[Poorer nations lack support to sink piracy](#)

Swissinfo - Switzerland

The international community must do more to help poorer countries protect intellectual property rights and tackle counterfeiting, according to a Swiss ...

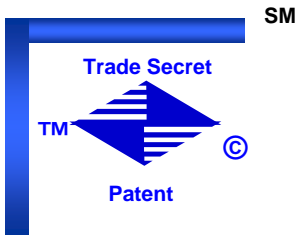
OTHER

PIPS can help you with the strategic decisions discussed in the articles below.

[Inventors' Guide to Patent Legalese](#)

TheStreet.com - USA

But when is the right time to patent and how do



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you find the right person to help you? First decide whether to patent your idea at all. ...

[Take out a patent early on, expert says](#)

Scotsman - United Kingdom

UNIVERSITY spin-outs and small and medium enterprises are being warned that obtaining a patent to their new technology should come at the same time as ...

[IP Law: Package It in Intellectual Property Rights](#)

IDEX Online - Israel

In a short message, he is informed by his client that he must provide a listing of all the intellectual property rights associated with the designs that are ...

[How Do I ... Get a Patent](#)

Washington Post - United States

If your average Dr. Evil took a trip down to 600 Dulany St. in Alexandria, Va., to patent his atomic destructor machine, his plans would have been thwarted ...

[Copyright, patent and trademark distinctions aren't always clear](#)

San Francisco Chronicle - CA, USA

What is the difference between patent and trademark? Generally speaking, patents allow the creator of certain kinds of inventions that contain new ideas to ...

[Getting Smart About Intellectual Property Is A No-Brainer](#)

IndustryWeek - USA

US firms leave \$1 trillion on the table every year by under-using their intellectual property. By Pat Toole, Vice President, Intellectual Property ...

[A Patent Is Worth Having, Right? Well, Maybe Not](#)

New York Times - United States

They found that starting in the late 1990s, publicly traded companies saw patent litigation costs outstrip patent profits. Specifically, they estimate that ...

[Four things you may not know about technology Patent applications](#)

ZDNet - USA

So let tell you four things you need to know about Patent applications but may not. Patents don't need to be revolutionary. My patent posts often receive ...

[Elsevier restates its self-archiving policy](#)

By Peter Suber(Peter Suber)

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