

Software Methods: To Mark or Not to Mark?

By Aamir Kazi

Fish & Richardson

Since the Federal Circuit decided in *State Street* that business methods were patentable, the number of software patents filed each year has continued to increase. Many of these software patents protect the software only through a series of method claims. Traditionally, courts have not required embodiments of method only patents to be marked in accordance with 35 U.S.C. § 287 because there is no tangible item associated with a method claim. Accordingly, even though software is arguably a physical embodiment of a claimed process, software should not need to be marked. In other aspects, however, courts have begun minimizing the differences between software and the more tangible items, such as hardware. While software is increasingly treated like a tangible item by the courts, the marking requirements for software show no signs of changing.

The General Marking Requirement

The marking statute of the Patent Act clearly states that a patent owner has a duty to mark any patented article that is made, offered for sale, or sold within the United States. The mark on a patented article serves to notify the public that the article is protected by a patent, and thus cannot be copied. Under 35 U.S.C. § 287, when a patent owner has failed to mark the patented article, the patent owner cannot recover damages for infringement unless the patent owner can show that the infringer was notified of the infringement.

Courts have consistently applied the marking requirement to limit damages where the patent owner produces an unmarked article protected by system claims. However, the analysis is different for method claims. The law is clear that the notice provisions of § 287 do not apply where the patent is directed to a method. The rationale behind this apparent inconsistency is quite logical. While system claims generally produce some fabricated article, method claims often do not produce a tangible item capable of being marked. In fact, where there is a “tangible item associated” with a method claim, the patent owner must mark the tangible item, or limit damages to the period after which the infringer had notice. This “tangible item” test was recognized by the Federal

Circuit in *American Medical Systems, Inc. v. Medical Engineering Corp.* 6 F.3d 1523 (Fed.Cir.1993).

Generally, a method claim is associated with a tangible item when the patent containing the method claim also has system claims directed to the patented article. However, where a patent contains only method claims, it is more difficult to find a tangible item associated with the method claim. The Federal Circuit explained this point in *State Contracting & Engineering Corp. v. Condotte America, Inc.* 346 F.3d 1057, 1074 (Fed. Cir. 2003). In *Condotte*, the patent owner asserted two related patents against an alleged infringer. One patent contained only method claims, and the second patent contained corresponding system claims. The Federal Circuit held that a failure to mark the invention did not prohibit recovery under the patent covering the method claims, even though the patents were related and the same infringing use was identified in the case of both patents. In *Condotte*, the Federal Circuit suggested that the requirement of marking tangible items only applies where the asserted patent contains method and apparatus claims, and not where the asserted patent contains only method claims.

Marking of Software Products

At first glance, software products protected by method only patents would seemingly challenge the “tangible item” test of *American Medical*. Often, software is associated with a tangible item that is capable of being marked. For example, the software can be stored on a CD, or can be presented through a graphical user interface. Some legal commentators have suggested that software might require marking regardless of whether it is protected by a pure method patent or a method and apparatus patent. Such an interpretation would be consistent with the rationale behind the marking statute, because it is often untrue that there is nothing tangible to mark associated with the software.

Commentators suggest that the Federal Circuit has already begun to eliminate the characterization of software as

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Chair's Corner

By Todd McClelland
Alston & Bird LLP

Thank you for allowing me to serve as the Chair of the IPSection. It has truly been an honor and a privilege to serve in this position.

I have been fortunate to have a dedicated and hard working Executive Committee over the last twelve months. The many CLE programs and social events put on by our section are in large part the result of their good efforts. We are also grateful to the generous speakers, panelists and other volunteers who offer their time to educate our section members.

Perhaps one of our greatest accomplishments over the last twelve months was the creation of a new IP Section website. This website can be found at GeorgiaIP.org. Much effort was put into this website, and special thanks go to Tina McKeon, Alison Danaceau and Lauren Fernandez Staley. The website will serve as a one-stop-shop for all your IP-

related CLE needs in Georgia, including CLE offered by groups and organizations outside of the IP Section.

Eventually, we hope the website will facilitate on-line registration and automate the registration process. This is a continuing effort, and we welcome all thoughts, comments and assistance our members might provide.

Starting in July, Wab Kadaba of Kilpatrick Stockton starts his term as Chair of the IP

Section. I have known Wab for many years and anticipate that next year's IP Section will be in good hands. Indeed, planning for this year's IP Institute is already well underway and Wab is leading the effort.

In closing, I would like to thank the Executive Committee for their hard work. It has been a great year and I am truly grateful. I also want to thank everyone else who has contributed to the IP Section. ●



Todd McClelland receives a gift for a year of great service to the section.

IP Section Launches New Website

By Lauren Fernandez Staley
Gardner, Groff, Greenwald & Villanueva, P.C.

You have by now noticed the IP Section's new logo and newsletter format, but along with our brand new look and feel, the Section has been hard at work on a new website. On April 24, the Communications Committee, under the direction of Co-Chairs Alison Danaceau and Tina McKeon, unveiled both the brand new logo and the new homepage to a packed house at Carolyn's on West Peachtree. The new site, located at www.GeorgiaIP.org, is the new home for the IP Section. GeorgiaIP.org is also your first stop for all things IP in Georgia, including an event calendar, resources, podcasts, news, and information about membership and of course, the popular IP Institute.

The site's homepage features a quick glance of featured upcoming events, as well a rotating collage of candid photos of members. Check the site regularly for updated photos from recent events. With one click, you can see all that's going on each month, staying connected and active in the IP community. And should you miss an event, look to our site for free podcasts to stay current and up-to-date.

Our site also includes free online copies of our newsletters and an extensive resources page that includes links for Patents, Trademarks, Copyrights, IP Blogs, and more. GeorgiaIP.org provides easy access to information about the Section, how to contact the Section leadership, and how to join the Section. It will also be the gateway to registration and information about the annual IP Institute.



The new "home" of the IP Law Section of the State Bar of Georgia. Visit us at GeorgiaIP.org!

And just because I know you're curious ... the site also does have limited advertising space. All proceeds go toward offsetting the cost of website maintenance. For inquiries on future availability and rates, please email me at lstaley@gardnergroff.com.

Such a huge undertaking as this site required the involvement of many. On behalf of the Communications Committee, thanks to Todd McClellan, Chair, and Wab Kadaba, Chair-Elect, for supporting this endeavor, and to the Co-Chairs of the Communications Committee, Alison Danaceau and Tina McKeon, for conceiving of and leading this project.



David Lilenfeld at the website kick-off.

Also, a special thanks to Philip Burrus (Philip Burrus Intellectual Property Law Group) for graciously advising us and supplying the podcasts for the site. Committee members, including Chris Glass (Morris, Manning & Martin) and Chris Curfman (Needle & Rosenberg), provided valuable research for our Resources page, MAMA Creative, and its owner Leyla Compani, as well as our web developer Rick Eisenbart of Latitude 17 South. Working with them has been a fantastic experience from the start. And last but not least, substantial thanks to Gardner Groff, for allowing me to devote considerable time to this project. ●



Derek Harris and future IP Section member Kayle Harris celebrate at the IP Section website kick-off happy hour.

IP Member in Focus: Virginia Taylor

By Collin A. Webb
Hexagon Group

Virginia Taylor recently granted me the opportunity to discuss trademark and copyright licensing. Ms. Taylor, a partner at Kilpatrick Stockton, mentors new associates in the firm, and she shared with me a few techniques she uses in practicing the art of drafting license agreements.

The crucibles that forge knowledgeable lawyers are law school, litigation and failure. Law school makes for insubstantial fodder for a bar article (after all, we have all been through it or are going through it) and lawyers might endure hours of torture before discussing their failures. So Ms. Taylor discussed some of her license-drafting lessons learned from litigation, especially the lessons she learned during a long and protracted litigation involving Cabbage Patch Kids.

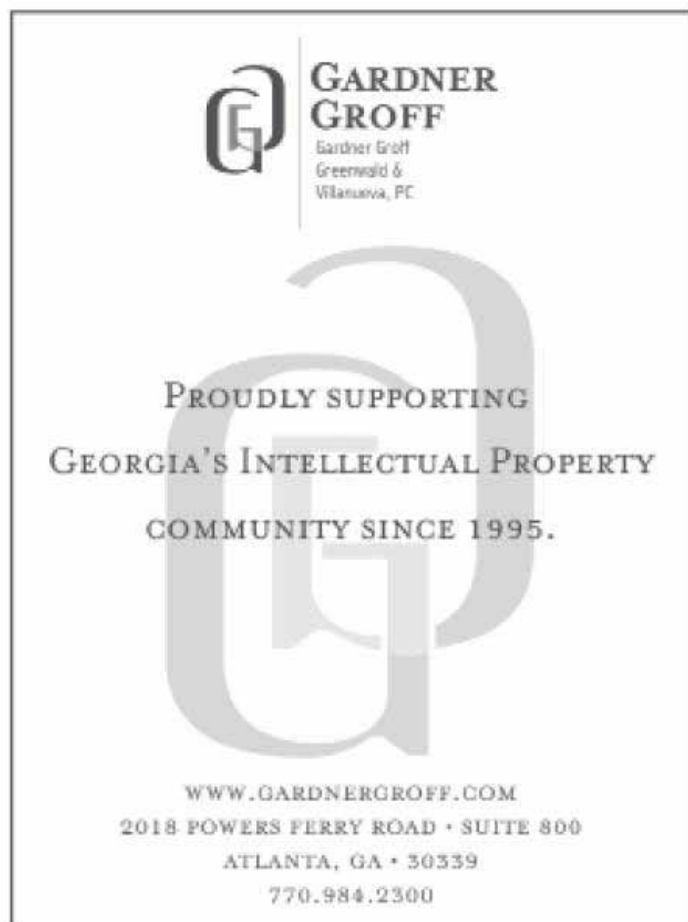
Cabbage Patch Kids were a wildly popular toy in the 1980's. The toys consisted of a baby with a cloth body and an outsized vinyl head made under license from Xavier Roberts who created the original hand made Cabbage Patch Kids and produced them through his company, Original Appalachian Artworks. Original Appalachian entered into an agreement with a licensing agent, Schlaifer Nance & Co., which sought the largest possible distribution and exposure for the Cabbage Patch Kids. Some of its actions offended the artistic sensibilities of its creator. Original Appalachian Artworks began to refuse to accept some projects that Schlaifer Nance proposed, and in response Schlaifer Nance sued. Each term in the license agreement, especially the grant clause, was hard-fought during the litigation. Ms. Taylor and her colleagues were involved because Bill Needle, Cabbage Patch Kids' regular counsel, was an important fact witness in the case. The experience of countering the licensing agent's boundary-stretching construction of the agreement schooled Ms. Taylor in how to properly craft a license agreement.

In the Cabbage Patch Kids case, the license included lists of enumerated categories in which the licensing rights were granted and the key issues revolved around Schlaifer Nance's efforts to expansively reinterpret the scope of those enumerated categories and to contend that the Licensor's approval rights should be narrowly construed. Ms. Taylor assisted Cabbage Patch Kids in winning summary judgment as to its interpretation of the agreement, and prevented Schlaifer Nance from stretching the language of the grant clause beyond its reasonable meaning.

Ms. Taylor aptly distilled the lessons of the Cabbage Patch Kids litigation thus: The lawyer's task is to focus on the heart of the matter, and guide the client into deciding about the important legal issues, which he or she likely would not have otherwise considered. Ms. Taylor made clear that these issues should be specific. For example, the lawyer may ask whether storybooks using the trademarks or copyrights of the client should be licensed, and if so, the kind of control the client wishes to maintain over the story. Naturally the issues to consider are dependent on the circumstances and the type of properties to be licensed, but these questions indicate the high level of specificity that the lawyer should seek answers to from his or her client. ●



This article is the second in a series devoted to the practical experiences of IP lawyers practicing IP law.



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IP in Action

On June 4, the Patent Committee of the IP Law Section sponsored a panel discussion entitled “The Patent Toolkit: Tools to Keep on Hand to Protect and Enforce Intellectual Property.” Held at the Offices of Kilpatrick Stockton LLP, the panel featured a diverse group of Georgia attorneys who offered insight on how to protect and enforce intellectual property rights in patents, trademarks, trade secrets, and copyrights. Panelists included David Lilenfeld of Manning Lilenfeld LLP, Michael Turton of Kilpatrick Stockton LLP, and Gene Luciani of Anderson Tate & Carr. Jeff Young, a partner at Alston & Bird LLP moderated the discussion, and Wilson White, an associate at Kilpatrick Stockton LLP served as the host.

On June 12, the IP Law Section's Social Committee presented the Annual IP Summer Associate Mixer, held at Park Tavern. The event provided a terrific opportunity for Atlanta summer associates to receive an introduction to the Atlanta Intellectual Property Bar and to meet many of its key practitioners. A panel discussion featured Mike Hobbs of Troutman Sanders, Todd McClelland of Alston & Bird, Tina McKeon of Fish and Richardson, and Lisa Moore of the Moore Firm, LLC. Each panelist offered wisdom on both their particular IP practice and also the Atlanta IP LegalCommunity in general. The event was sponsored by Troutman Sanders, Fish & Richardson, Thomas Kayden, King & Spalding, Sutherland, Kilpatrick Stockton, Alston & Bird, and Finnegan Henderson. ●



Todd McClelland, Tina McKeon and Mike Hobbs offer words of wisdom and answer questions at the Annual IP Summer Mixer.

Upcoming Events Calendar

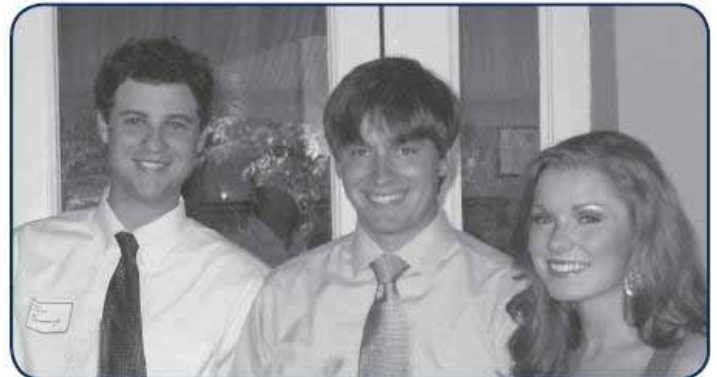
November 12 - 16

14th Annual Intellectual Property Law Institute
Presented by State Bar of Georgia, IP Section
Cabo San Lucas, Mexico

December 8 - 13

Patent Bar Review Course
Omni Hotel at CNN Center, Atlanta, Georgia
Presented by Patent Resources Group
Contact a PRG registrar at 434-974-1700 or
registrar@patentresources.com for more information

Visit www.GeorgiaIP.org for a full calendar of events.



Tyler Scarbrough, David Hansom and friend network at the Mixer.

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The Year's Top Ten Events in Trademark Law: A Year of Change

By James H. Johnson
Sutherland

As we reach the half way point of the 2008, it is time to take a fresh look at the recent top topics as these issues continue to dominate the trademark landscape.

Congress changes the face of dilution law: Trademark Dilution Revision Act of 2006

The TDRA was signed into law on October 6, 2006. The key highlights out of this legislation include: 1) Overturns Moseley: the standard for dilution is "likelihood of dilution" rather than "actual dilution;" and 2) Heightened Fame Standard: In order to be protectable under the new Act, a mark must be "famous among the consuming public of the United States." This eliminates niche fame of both types, market and geographic; Fair use is a defense to dilution and, in fact, non-trademark uses cannot amount to dilution.

Recent Cases Applying the TDRA:

1. *Nike v. Nikepal*, 84 USPQ2d (BNA) 1521 (Sept 17, 2007) (finding dilution).
2. *Verilux v. Hahn*, Slip Copy, WL 2318819 (D.Conn., Aug. 10, 2007) (holding niche fame could not support dilution claim).
3. *Pepsico v. #1 Wholesale*, Slip Copy, WL 2142294 (N.D.Ga., July 20, 2007)(finding dilution).
4. *Louis Vuitton Malletier v. Dooney & Bourke*, WL 1222589 (S.D.N.Y. Apr. 24, 2007) (marks not similar enough to sustain a dilution claim).
5. *Levi-Strauss v. Fox Hollow*, Slip Copy, WL 1140684 (N.D.Cal., Apr. 17, 2007) (finding dilution).
6. *Pet Silk v. Jackson*, 481 F.Supp. 2d 824 (S.D.Tex. 2007) (dilution by blurring).
7. *Century 21 Real Estate v. Century Ins.*, Slip Copy, WL 484555 (D.Ariz., Feb. 8, 2007) (finding no dilution because marks not identical).

Federal Circuit disallows recovery of awards for both patent and trademark infringement based on the same accused devices: *Aero Prods. Int'l, Inc. v. Intex Recreation Corp.*, 466 F.3d 1000 (Fed. Cir. 2006)

The Federal Circuit held that the award of patent infringement and trademark infringement damages constituted an impermissible double recovery because there was no evidence introduced at trial of Intex's use of the mark "ONE TOUCH" other than in connection with the sales of mattresses that formed the basis for Aero's patent infringement claim.

Practice Tip: In cases where a client is seeking damages for both patent and trademark infringement, make sure you show that the damages for each result from different facts.

Fourth Circuit upholds use of parody as a defense to trademark infringement and dilution: *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, . U.S. App Lexis 26334 (4th Cir, November 13, 2007)

Louis Vuitton Malletier ("LVM") sued Haute Diggity Dog ("HDD") for trademark infringement and dilution. HDD markets plush stuffed toys and beds for dogs under names such as Chewnel #5, Dog Perignon, Chewy Vuiton, and Sniffany & Co., and most are priced around \$10. HDD's "Chewy Vuiton" mark is an interlocking C and V with similar coloring schemes and patterns to the LVM mark. The Fourth Circuit determined that the HDD marks were a successful parody of the LVM marks and the distinctiveness of the LVM marks was not harmed. Turning the typical dilution scenario on its head, this holding suggests that famous marks are more vulnerable to a parody defense against a dilution claim.

Courts split on whether keywords/metatags are "use in commerce"

A number of recent cases address the issue of whether use of a trademark as a metatag or keyword constitutes use in commerce. There is a split in the circuits; on one side of that split are those courts which note that "there is no allegation that defendant places plaintiff's trademark on any goods, containers, displays, or advertisements, or that its internal use is visible to the public." See *Google v. American Blind*, 2007 U.S. Dist. LEXIS 32450 at * 10 (N.D. Cal. Apr. 28, 2007) (citing *Rescuecom Corp. v. Google, Inc.*, 456 F.Supp. 2d 393 (N.D.N.Y. 2006)). On the other side of the split are those courts which hold that Google's sale of the trademarked term constitutes use in commerce for Lanham Act purposes.

See *Google v. American Blind*, 2007 U.S. Dist. LEXIS 32450 at * 10 (citing *800-JR Cigar, Inc. v. GoTo.com, Inc.*, 437 F.Supp. 2d 273 (D.N.J. 2006)).

Second Circuit says famous marks doctrine cannot save abandoned mark: *ITC Ltd. v. Punchgini, Inc.*, No. 05-0933-CV, 2007 WL 914742 (2d Cir. Mar. 28, 2007)

The Second Circuit noted that U.S. trademark rights are acquired by and dependent upon use in the U.S., so absent some use of its mark in the U.S., a foreign mark holder generally may not assert priority rights under federal law. The Second Circuit held that the statutory scheme of the Lanham Act did not permit it to adopt the famous marks doctrine and that it had to refuse to grant judicial recognition to the famous marks doctrine simply as a matter of sound policy.

The TTAB holds The Pan-American Convention confers priority absent use in U.S.: *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 2007 TTAB LEXIS 34 (TTAB 2007)

An owner of a prior used mark in the United States was unsuccessful in opposing an application for a mark based on applicant's trademark priority established in a country that is a signatory to the Pan-American Convention. Thus, based on ownership of an application filed under the Pan-American Convention, or presumably other conventions, a party may claim priority over a mark first used in the United States.

Practice Tip: It may be worthwhile to ask a client whether a new proposed mark was inspired by another's.

The TTAB holds applied for flavor mark is functional and does not serve source identifying function: *In re N.V. Organon*, 79 U.S.P.Q. 2d 1639 (TTAB 2006)

Applicant filed an application to register "an orange flavor" as a trademark for "pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills." The TTAB affirmed Examiner's refusal and stated that medical ingredients in pharmaceuticals generally have a disagreeable taste that may be masked so that patients will be more likely to take the medicine; therefore, flavor performs a utilitarian function that cannot be monopolized without hindering competition in the pharmaceutical trade

The TTAB continues to follow *Medinol's* strict liability stance on fraud

The TTAB continues to uphold ruling in *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003) which held that an applicant or registrant who falsely claims use of its mark in connection with goods or services identified is charged with fraud. Proof of specific intent is not required for a finding of fraud: "the appropriate inquiry is ... not into the registrant's subjective intent, but rather into the objective manifestations of that intent."

The TTAB changes procedural rules

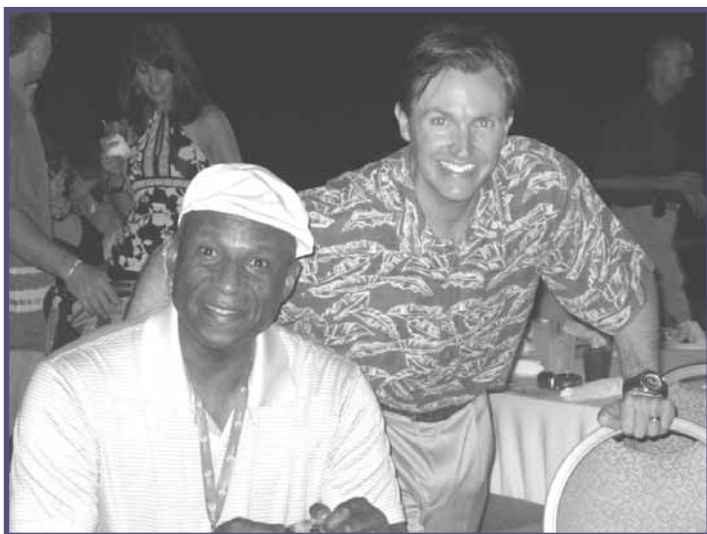
August 1, 2007: TTAB substantially changed the procedural rules for trademark oppositions and cancellation actions. The changes are intended to facilitate early settlements. Most of the new rules went into effect November 1, 2007, with some specific rules going into effect August 31, 2007, and others applying immediately to pending cases. These changes will affect docketing of deadlines. The purpose of the new rules is to promote settlement and, perhaps, to discourage the use of the TTAB.

The highlights of the changes are: 1) Protective order applies to all proceedings unless the parties agree otherwise; 2) Proceeding may be initiated by electronic means if the party has given the TTAB its email address; 3) Service may be done by any means described in Section 2.1119; 4) Parties to proceedings must now conduct an initial discovery conference as per F.R.C.P. 26(f).

The Trademark Office announces new attorney authorization requirements

An attorney who appears in person or signs a document on behalf of an applicant/registrant will be recognized by the USPTO as the authorized representative of the applicant/registrant — submission of formal power of attorney is not required. Any change in representation can only be made upon written request signed by the applicant/registrant.

If applicant/registrant is represented by an attorney qualified to practice before the USPTO in trademark cases, the USPTO will conduct business only with the attorney until that representation is terminated. An applicant/registrant may not authorize examiner's amendments, and USPTO will not accept responses signed by applicant/registrant. Applicant/registrant must file revocation or attorney must file request to withdraw before any submissions by applicant/registrant will be accepted. ●



Steve Wigmore congratulates James Johnson on a great speech at the IP Symposium.

Summary of *Quanta Computer, Inc. v. LG Electronics, Inc.*

__S.Ct.__, 2008 WL 2329719 (U.S.) (June 9, 2008)

By Drew Greene and John Dragseth*

Fish & Richardson

The Supreme Court, in a unanimous opinion, recently reversed a Federal Circuit decision addressing the doctrine of patent exhaustion. Patent exhaustion limits patent rights that survive a first authorized sale of a patent item.

LG Electronics, Inc. (LGE) purchased a portfolio of three computer technology patents in 1999: U.S. Patent Nos 4,939,641 ('641 patent); 5,379,379 ('379 patent); and 5,077,733 ('733 patent) (LGE Patents). The '641 patent discloses a system for ensuring that current data are retrieved from a main memory by monitoring data requests and updating main memory from a cache when stale data are requested. *LG Electronics, Inc. v. Bizcom Electronics, Inc.* 453 F.3d 1364, 1377 (Fed. Cir. 2006). The '379 patent relates to an efficient method of coordinating requests to read from, and write to, main memory. *Id.* at 1378. The '733 patent addresses the problem of managing data traffic on a bus connecting two computer components, so that no one device monopolizes the bus, by establishing a rotating priority system. *LG Electronics, Inc. v. Asustek Computer, Inc.*, No. C 01-02187 CW et al., Order Construing Disputed Terms and Phrases, p. 42 (ND Cal., Aug. 20, 2002).

LGE licensed the LGE Patents to Intel Corporation and, in the cross-licensing agreement, permitted Intel to manufacture and sell microprocessors and chipsets that use the LGE Patents. Included in the licensing agreement was a limitation that no license "is granted by either party...to any third party for the combination by a third party of Licensed Products of either party with items, components, or the like acquired ... from sources other than a party hereto, or for the use, import, offer for sale or sale of such combination." The licensing agreement did not purport to alter the usual rules of exhaustion. In a separate master agreement, Intel agreed to give written notice to its customers that, while it had obtained a license from LGE, the license did not extend to a product made by combining an Intel product with a non-Intel product.

Quanta purchased microprocessors and chipsets from Intel with the notice required by the master agreement. Quanta subsequently manufactured computers using Intel parts in combination with non-Intel memory and buses in ways that practiced the claimed methods of the LGE Patents. LGE filed a complaint against Quanta, asserting that the combination of parts in Quanta's computer systems infringed the LGE Patents. The District Court first granted summary judgment to Quanta, finding that, although the Intel products did not fully practice any of the patents, they had "no reasonable noninfringing use and therefore their

authorized sale exhausted patent rights in the completed computers under *United States v. Univis Lens Co.*, 316 U.S. 241 (1942)."

However, the District Court subsequently held, on reconsideration of the motion for summary judgment, that patent exhaustion does not extend to method or process claims that describe operations to make or use a product. The District Court then ruled that rights in LGE's system claims were exhausted, and although rights in the method claims were not exhausted, those claims were not infringed by the use of the accused products.

The Federal Circuit agreed that exhaustion did not apply to method claims, but ruled that exhaustion also did not apply to the system claims. It also reversed all of the district court's rulings on the merits of infringement.

Method Claim Exhaustion

The Supreme Court granted certiorari and, after reviewing 150 years of exhaustion case law, determined that methods could be exhausted. The Court relied on *Univis* and stated "the traditional bar on patent restrictions following the sale of an item applies when the item sufficiently embodies the patent -- even if it does not completely practice the patent -- such that its only and intended use is to be finished under the terms of the patent." The Court further pointed out that "[i]t is true that a patented method may not be sold in the same way as an article or device, but methods nonetheless may be "embodied" in a product, the sale of which exhausts patent rights.... Eliminating exhaustion for method patents would seriously undermine the exhaustion doctrine." The Court reasoned that a patent drafter could accomplish an end-run around exhaustion "[b]y characterizing their claims as method instead of apparatus claims, or including a method claim for the machine's patented method of performing its task."

Exhaustion of the Patented Thing or More?

The Court next considered the extent to which a product must embody a patent to trigger exhaustion, and opined that exhaustion is not limited only to situations in which the patented product itself is sold. Rather, "[j]ust as the lens blanks in *Univis* did not fully practice the patents at issue because they had not been ground into finished lenses...., the Intel Products cannot practice the LGE Patents -- or indeed, function at all -- until they are combined with memory and buses in a computer system." The authorized sale of the chips that had no real use other than infringing computer systems created exhaustion of

patents on the systems, and the chips embodied “essential features” of the inventions: “[t]he relevant consideration is whether the Intel Products that partially practice a patent — by, for example, embodying its essential features — exhaust *that* patent.” (emphasis in opinion). Interestingly, the Court distinguished situations in which the inventive aspects are held within the item sold (with which the Court tagged LGE) from situations in which the invention was the combination of all the claim elements (as in *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336 (1961)).

Exhaustion Via “Authorized Sale”?

Finally, the Court held that the LGE-Intel-Quanta situation exhausted LGE’s patent rights. Specifically, the Court reasoned that the LGE-Intel licensing agreement did nothing to limit Intel’s right to sell chips, so its sales were “authorized sales” even though the chips were (presumably) burdened by a restriction: “To be sure LGE did require Intel to give notice to its customers, including Quanta, that LGE had not licensed those customers to practice its patents. But neither party contends that Intel breached the agreement in that respect. [citation omitted] In any event, the provision requiring notice to Quanta appeared only in the Master Agreement, and LGE does not suggest that a breach of that agreement would constitute a breach of the License Agreement. Hence, Intel’s authority to sell its products embodying the LGE Patents was not conditioned on the notice or on Quanta’s decision to abide by LGE’s directions in that notice.” While LGE pointed out that the license agreement specifically disclaimed any license to third parties to practice the patents by combining licensed products with other non-licensed products, “the question whether third parties received implied licenses is irrelevant because Quanta asserts its right to practice the patents based not on implied license but exhaustion. And exhaustion turns only on Intel’s own license to sell products practicing the LGE Patents.” The Court expressly noted in footnote 7 that it was not opining on whether LGE could recover contract damages.

Note: Footnote 6 dismisses LGE’s assertion that the chips had noninfringing uses, either by being sold overseas or by having the relevant features disabled: “But *Univis* teaches that the question is whether the product is ‘capable of use only in *practicing* the patent,’ not whether those uses are infringing. Whether outside the country or functioning as replacement parts, the Intel Products would still be *practicing* the patent, even if not infringing it. And since features partially practicing the patent are what must have an alternative use, suggesting that they be disabled is no solution. The disabled features would have no real *use*.” (emphasis in opinion). This note may raise questions about whether sales by a patentee outside the U.S. could result in exhaustion. ●

**At the time this summary was prepared, Drew Greene was a summer associate at Fish & Richardson. John Dragseth is a principal in the Minneapolis office of Fish & Richardson.*

Litigation Committee Report

Chair: Brad Groff

Gardner Groff Greenwald & Villanueva, P.C.

I would like to thank all of the speakers and program organizers who put in the time and effort to make the Litigation Committee programs so successful this year. Also, thanks to everyone who came out and participated in our programs. But most of all, I really want to give a special thanks to the following members of our Committee for all of their great ideas and hard work over the past year:

Ann Fort, Sutherland Asbill & Brennan, LLP
Kristin Goran, Sutherland Asbill & Brennan, LLP
Darcy Jones, Sutherland Asbill & Brennan, LLP
David Lilenfeld, Manning Lilenfeld LLP
Jennifer Liotta, Alston & Bird, LLP

Following is a summary of the programs our IP Litigation Committee hosted this year:

Underwater Devices Dries Up? Life After *In Re Seagate*: September 27, 2007

Moderator:

Daniel A. Kent, Fish & Richardson

Panelists:

James L. Ewing IV, Kilpatrick Stockton, LLP
Steven P. Wigmore, King & Spalding
Bernard L. Zidar, McKesson Technology Solutions

A panel discussion of the Federal Circuit’s *en banc Seagate* decision and its impact on the attorney-client and work-product privileges, willfulness and enhanced damages, and opinion practice. The panelists’ varied backgrounds and experience made for a very enlightening discussion, providing viewpoints from the in-house, outside opinion counsel and litigators’ perspectives, as well as a discussion of the historical development of patent willfulness doctrine, general patent policy, and whether the pendulum has swung too far in the anti-patent direction.

Intellectual Property Damages: Recent Developments And Reform Implications: December 4, 2007

Glenn W. Perdue, Crowe Chizek & Company LLC,
Accredited Valuation Analyst

Mr. Perdue’s analysis of IP litigation damages analysis in general, and the specific implications of recent case law developments (including the *eBay*, *MedImmune*, and *KSR* cases from the U.S. Supreme Court) and proposed legislative reform and rule changes led to a lively discussion of trends in IP damage awards, litigation strategies, and patent reform economics.

The “So What” Defense: Fair Use In Copyright And Trademark Disputes: January 23, 2008

(Presented in partnership with the Copyright Committee)

David M. Lilienfeld, Manning Lilienfeld LLP
Joseph M. Beck, Kilpatrick Stockton LLP

Mr. Beck discussed the copyright side of “fair use”, with specific examples based on the Google Book Search litigation and other recent cases, evaluating the fair use factors, and in particular the role of parody and “transformative” use, per the Supreme Court’s *Campbell v Acuff-Rose* decision, and the 11th Circuit’s *SunTrust v. Houghton Mifflin* decision. Mr. Lilienfeld discussed fair use from the trademark perspective, both in terms of the statutory fair use defense, and “nominative” fair use, with reference to the 9th Circuit’s *KP Permanent Make-up* decision, the 11th Circuit’s *International Stamp Art* case, and other recent decisions relating to personal names and parodies.

Patent Obviousness: Post-KSR Developments in Patent Litigation and Prosecution: March 25, 2007

Angela Payne James, Alston & Bird, LLP
Scott Brient, Alston & Bird, LLP
Jennifer Liotta, Alston & Bird, LLP

The Supreme Court’s *KSR v. Teleflex* decision made headlines when it was handed down in 2007, with commentators raising the alarm that the sky was falling on patents due to the looser obviousness standards the case announced. With the benefit of almost a year’s worth of hindsight reconstruction, this panel reviewed subsequent developments on obviousness and presented some insightful practice pointers, from the perspective of both patent litigators and patent prosecutors.

Our Committee is taking the summer off for some much needed R&R (that’s Reading and Research, if anyone asks). But look for programs to kick off again in late summer or early fall. In the meantime, if you have ideas for program topics or would like to get involved with the IP Litigation Committee, please email me at bgroff@gardnergroff.com. ●



Melissa Howard, Phillip Burrus, Wab Kadaba, and friends and spouses all congratulate Todd McClelland on a successful year.

Licensing and In-House Committee Reports

Licensing Chair: Andria E. Beeler-Norrholm, Alston & Bird, LLP

In-House Chair: Kevin Glidewell, Turner Broadcasting System, Inc.

On April 22, 2008, the Licensing Committee and the In-House Committee co-hosted a panel discussion entitled “If Only You’d Asked: The Litigator’s Perspective On Drafting Intellectual Property Agreements.” The panelists included:

Martin J. Elgison, Alston & Bird LLP
John P. Hutchins, Troutman Sanders
Edward B. Krugman, Bondurant, Mixson & Elmore, LLP
Lawrence K. Nodine, Needle & Rosenberg, PC

The panelists provided their insights on clauses and phrases commonly used in IP agreements (e.g., patent, trademark and software licenses, IP development agreements, proprietary information agreements, etc.). Panelists also discussed courts’ interpretations of these agreements and the practical effects of particular clauses and phrases in the event of a dispute. The event took place at Alston & Bird LLP and one CLE credit hour was available. The event seemed very popular and was well-attended (approximately 75 pre-registered attendees and many more on-site registrants). The Licensing and In-House committees would like to thank the panelists as well as everyone who attended. ●

Trademark Committee Report

Chair: James H. Johnson, Sutherland, Asbill & Brennan LLP

On March 4, 2008, the Trademark Committee hosted an event entitled “A Discussion of Current Happenings at the Trademark Office.” The featured guest was Lynne Beresford, Commissioner for Trademarks. Ms. Beresford provided an overview of the state of the PTO as well as a discussion of recent case law and legislative updates. One item of much interest was the PTO’s work-from-home program, where Examiners worked away for the PTO’s offices in Washington D.C. The PTO was hoping to eliminate the requirement that the participants in the work-from-home program come to Washington once a pay period. By eliminating the requirement, one could examine anywhere in the world. According to the state bar personnel, there were 58 attendees to the presentation. ●

Patent Committee Report

Chair: Philip Burrus

Burrus Intellectual Property Law Group, LLC

European Invasion – EPO Practice Seminar in Atlanta. On April 15, 2008, the Patent Committee held a seminar on Opposition Practice before the European Patent Office (EPO). The seminar, which was a three-hour CLE event held at the Georgia State Bar Headquarters, covered a broad array of EPO-related topics. The discussion included an overview of EPO practice, comparisons of EPO practice with U.S. practice, and a thorough analysis of opposition practice before the EPO. The speakers included Mitch Katz of Needle and Rosenberg, PC, Michael Stenger, EPO Examiner from Munich, Germany, and William Neobard of Kilburn and Strode (London, England). Greg Kirsch of Needle and Rosenberg, PC, moderated the panel.

After a brief overview by Greg, the day began with a discussion of the EPO and how it handles patent applications. It was a rare treat to have an Examiner from the EPO describe how patent applications flow through the EPO. Michael Stenger discussed the various stages of prosecution, and even included numerical analyses. For example, Michael was able to provide statistics regarding how many applications the EPO receives, how many issue, how many get to the opposition stage, and how many are handled with oral arguments.

The discussion then turned to the topic of the day – patent oppositions. The audience heard perspectives of oppositions from three distinctly different angles – that of a U.S. attorney, that of a European attorney acting as local counsel for a U.S. client, and that of an Examiner who participates in opposition hearings. Michael Stenger began with a discussion from the Examiner's prospective. Michael started by giving an overview of relevant articles of the EPC, including Article 99 (Oppositions), Article 100 (Grounds for Opposition), and Article 101 (Examination of the Opposition). Michael's discussion included avoiding mistakes commonly seen by the EPO. He then described amendment practice and oral hearings.

Bill Neobard then followed with his take on opposition practice. Having handled numerous oppositions as EPO counsel for international clients, Bill's discussion was full of practice tips and anecdotes from his experiences with the EPO. Not only did Bill cover the technical issues relating to oppositions, his insight also included strategies regarding when opposition practice should be used. He also provided suggestions for making the opposition process more efficient.

Mitch Katz then followed, discussing oppositions from U.S. counsel's perspective. Mitch included suggestions for U.S.

counsel when engaging in opposition practice, including how best to work with European counsel. Mitch also included a discussion of oral proceeding practice that included tips on working with the panel of judges and making amendments under severe time constraints. Mitch then touched on a comparison of EPO opposition practice and the opposition practice set forth in the currently pending Patent Reform Act.

Bill Neobard then took the audience through an actual opposition. This insightful talk highlighted the documents filed during oppositions and suggestions for arguments. One of the most interesting points Bill made was that of broadening amendments. Bill noted that the removal of one adjective could be enough to broaden the scope of the claims such that they are not supported by the disclosure in the specification. Bill provided tangible examples of how this broadening can be used against the patentee in opposition hearings. Greg Kirsch then led a roundtable question and answer session to wrap the day.

One of the interesting aspects of prosecuting territorial patents is that one must be versed in patent laws from many different countries. This seminar provided IP Section members with insight and knowledge relating to patent practice before the EPO. The Patent Committee extends sincere thanks to all the members of the panel. A special thanks goes to Greg Kirsch. Without Greg's help, the event would not have been possible.

Another event was held on June 4, 2008, which was entitled "The Patent Toolkit: Tools to Keep on Hand to Protect and Enforce Intellectual Property." This event was held at the offices of Kilpatrick Stockton and offered insight on what steps should be taken to protect patents, trademarks, trade secrets, copyrights, and how to enforce intellectual property rights and defend against claims of intellectual property infringement. The panelists included David Lilenfeld (Manning Lilenfeld), Michael Turton (Kilpatrick Stockton), Gene Luciani (Andersen, Tate, & Carr). Jeff Young (Alston & Bird) moderated the panel. Wilson White (Kilpatrick Stockton) is entitled to a special thanks from the committee for coordinating the event.

The Patent Committee extends sincere appreciation to the staff at the Georgia Bar, especially Johanna Merrill for helping with all our events. Thanks also to Dan White at ICLE, for helping to coordinate the event and for making CLE credit possible. ●

Patent Reform Act Update

By Philip Burrus, Chair, Patent Committee
Burrus Intellectual Property Law Group, LLC

On March 18, 2008, the Patent Committee held an event on the Patent Reform Act at the offices of Arnall Golden Gregory. Tony Figg, of Rothwell, Figg, Ernst & Manbeck in Washington, D.C., who is also the Chair of the American Bar Association's Patent Law Reform Task Force, gave a detailed presentation of both the contents and status of the bill to the members of the Intellectual Property Section. At that time, the bill had passed the full House, and had passed from committee in the Senate. Mr. Figg suggested that a floor vote in the Senate may soon occur. He noted, however, that if it did, there was a substantial likelihood that the bill would be changed by amendment.

About that time, Senators Patrick Leahy (D-VT), Arlen Specter (R-PA), and Orrin Hatch (R-UT) proposed amending the bill and scheduling a floor vote. Senate Majority Leader Harry Reid (D-NV) placed the bill on the Senate calendar for debate on the floor. Senator Reid initially scheduled the debate to occur sometime in June or July of 2008. The Bush Administration advocated support of the bill in a letter to Senator Leahy. Specifically, the Bush Administration expressed support for applicant quality submissions and a post-grant review procedure.

The Patent Committee then began work to meet with both Georgia Senators — Senator Saxby Chambliss and Senator Johnny Isakson. The Patent Committee Chair contacted both offices expressing an interest in meeting with each Senator to discuss the bill. The Patent Committee was unsuccessful in meeting with Senator Isakson. However, with the gracious help of Anne Russell in Senator Chambliss's Office, the Patent Committee was able to meet with Senator Chambliss's Chief of Staff, Mr. Charlie Harman, on May 27, 2008.

Philip Burrus, Patent Committee Chair, and Brad Groff, Litigation Chair, met with Mr. Harman at the Senator's Atlanta office. Details of the bill were discussed, as well as the general state of affairs of intellectual property in metro Atlanta and across the state of Georgia. Mr. Harman was



Brad Groff (l) and Philip Burrus (r) discuss patent reform with Mr. Charlie Harman, Senator Saxby Chambliss's Chief of Staff.

most gracious, and the conversation was beneficial for all involved.

From the conversation, it would appear that there is indeed a split among the Senator's constituents regarding support of the bill. Some support the bill, while others oppose the bill. Both sides include large organizations and corporations. It would appear at this time that many in the Senate would prefer a compromise bill — one that could garner more universal support — rather than voting on the bill as currently written. To that end, Senator Reid has removed the Patent Reform Act from the Senate calendar.

The Patent Committee extends thanks to Senator Chambliss's Office for their time discussing the bill with the Intellectual Property Section. Should any Intellectual Property Section members have questions about the bill, please feel free to e-mail Philip Burrus at pburrus@burrusiplaw.com.

Note also that the Patent Committee is always looking for new and interesting events for its members. If you have ideas for an event, or if you are interested in hosting an event, please contact Philip Burrus at pburrus@burrusiplaw.com. ●

SAVE THE DATE!

20TH ANNUAL SOUTHERN REGIONAL
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Charles A. Pannell, Jr. (District Court Judge, ND Georgia), Chad Pannell, and Arthur J. Gajarsa (Circuit Court Judge, Federal Circuit), enjoy a break at the IP Symposium.



Michael Hobbs, Shane Nichols, and wives and friends enjoy a festive dinner during the IP Symposium.

Copyright Committee Report

Chair: Melissa C. Howard, Turner Broadcasting System, Inc.

The Copyright Committee has held two successful CLE events so far this year. First, on January 23, the Copyright Committee joined the Litigation Committee to host a lunch presentation on the fair use defense in copyright and trademark cases. Joe Beck, a partner at Kilpatrick Stockton, discussed the fair use defense in the context of copyright cases, and David Lilenfeld of the firm Manning Lilenfeld LLP discussed the fair use defense in trademark matters.

Then on March 5, the Copyright Committee hosted a panel discussion at King & Spalding on “Music in the Digital Age.” The program included a discussion of the music litigation, clearance and licensing issues, and featured speakers James Trigg, a partner with Kilpatrick Stockton; Charmaine Williams, a shareholder with Greenberg Traurig; and Noni Ellison-Southall, senior counsel with Turner Broadcasting System, Inc. Both events were very interesting, informative and well-attended. The Copyright Committee thanks all of the speakers and attendees. ●

intangible. For example, 35 U.S.C. § 271(f) (1) states that supplying a component of a patented invention outside the United States is an act of infringement. In *Eolas Technologies, Inc. v. Microsoft Corp.*, the Federal Circuit affirmed a lower court's finding of infringement under § 271(f) based on classifying a CD containing allegedly infringing software as a "component of a patented invention." 399 F.3d 1325 (Fed. Cir. 2005). The Federal Circuit in *Eolas* stated that there was "no principled reason for treating process inventions different than structure products," and that "[h]ardware and software . . . are practically interchangeable in the field of computer technology." In *Minton v. National Association of Securities Dealers*, a software invention was treated as a tangible invention, and not as an intangible process, when conducting an invalidity analysis. 336 F.3d 1373 (Fed. Cir. 2003). In that case, the Federal Circuit allowed licensing of software to trigger the on-sale bar to invalidate a patent, even though processes can typically be licensed without triggering the on-sale bar. In the recent Federal Circuit opinion, *Tivo, Inc. v. EchoStar Communications Corp.*, the court rejected any distinction between hardware and software as a basis for arguing noninfringement. See 2008 WL 249155 (Fed. Cir. 2008).

However, courts have applied the marking statute to patents protecting software the same as the statute has been applied to patents protecting other types of inventions. Specifically, in cases involving patents with method and apparatus claims, courts have applied the "tangible item" test requiring tangible items associated with the software to be marked in order for the patent owner to recover damages. For example, in *IMX, Inc. v. LendingTree, LLC*, the District of Delaware limited the patent owner's damages because there was not a "tangible item" associated with the asserted method claim that was marked. See 79 U.S.P.Q.2d 1373 (D. Del. 2005). The court emphasized that both system and method claims were asserted, thus the "tangible item" test was controlling. Accordingly, the website that was used to download the patented software was a "tangible item" that needed to be marked in order for the patent owner to recover presuit damages. Notably, the website was not part of the patented invention, but the court found that it was "intrinsic to the patented system."

In cases involving patents with method only claims protecting software, courts have consistently refused to require any type of marking. For example, the Southern District of California in *Lucent Technologies, Inc. v. Microsoft Corp.*, quoted *Condotte*, emphasizing that "[w]e have not previously held that a patent containing only method claims is examined to see if something could have been marked in order to assess whether the notice provision applies, and we decline to do so now." 2008 WL 410692 (S.D.Cal. 2008).

Conclusion

The general rule regarding the application of the marking statute to software inventions is no different than the application of the rule to other inventions. The embodiment of system claims must be marked, whereas the embodiment of method claim only needs to be marked where there is a tangible item associated with the method claim. If the patent contains only method claims, the notice provision likely does not apply.

However, patent owners should consider the Federal Circuit's recent treatment of software inventions, when deciding whether to mark their software inventions. In areas of patent law including infringement and invalidity analyses, the courts have begun treating software more like a tangible item, and less like an intangible process. Although the district courts have been consistent in their application of the "tangible items" test to software inventions, the Federal Circuit has not addressed the specific issue of marking software inventions protected by only method claims.

Additionally, there is little downside to marking patented inventions. The cost of marking a software invention is nominal. The patent owner must be careful to avoid false marking, but that calculus of risk is the same as with system claims. Thus, although the current law is still that software protected by patents with only method claims need not be marked, the downside to marking software inventions is so minimal that marking should be encouraged. ●



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IP in Pictures, News & Notes



Wilson White and Virginia Taylor.



Filip Kowalewski and Michael Brignati.



Wab Kadaba and his wife Ami.



Lauren Fernandez Staley (l) and Joe Staley (r) thank their successful website developer.

Copyright Office Begins E-filing: The U.S. Copyright Office is accepting e-filings of copyright applications (“eCO”). Anyone can use eCO to register basic copyright claims, e.g., literary works, visual arts works, performing arts works, sound recordings, motion pictures, and single serial issues. The following cannot be filed through eCO: renewals, corrections, mask works, vessel hulls, groups of serial issues, groups of newspaper/newsletter issues, groups of database updates, and groups of contributions to periodicals. Electronic filing offers a \$10 discount per application, faster application processing time, and online status tracking. For details see the U.S. Copyright Office eCO Webpage: www.copyright.gov/eco/.

Registered Practitioners to Update Contact Information via New Online System: The USPTO will soon introduce a system for registered practitioners to update their official contact information online. The Office of Enrollment and Discipline soon will send letters containing the practitioners user identification numbers and instructions for obtaining a

password to use the system. In the meantime, you can check the official roster at <https://oedci.uspto.gov/OEDCI/>. If your contact information is not current, go to www.uspto.gov/web/offices/dcom/olia/oed/addchangefrm.pdf, complete a Change of Address Form, and mail it to Mailstop OED, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

USPTO Deputy Director to Leave Agency: Margaret J.A. Peterlin, deputy under secretary of Commerce for Intellectual Property and deputy director of the United States Patent and Trademark Office (USPTO) has announced she will be leaving office in August. ●



Alison Danaceau, Steve Wigmore, Tina McKeon, Brenton Hund, and Todd McClelland.

Letter from the Editors

By Tina Williams McKeon (Fish & Richardson) and Alison Danaceau (Carlton Fields)

This newsletter marks one of the last official acts of the Communications Committee of IP Section for the 2007-2008 year. Our goals for this past year were to revamp the website and to produce two high-quality newsletters. The new website will be live by the time you read this letter, and this newsletter is our second. We take this moment to reflect and to look to the next year.

We encourage you to visit the website at GeorgiaIP.com and to visit it often. We expect you will find more content and more useful information than our previous websites have provided. For example, we plan to update the website and to keep a current calendar of various IP events of interest to our members. Some of the events on the calendar will be section events and others will be non-section events. We still have podcasts available for downloading and hope to have more once new Section events resume in the Fall. As we strive to keep the website current, we encourage you to let us know if there are events or activities we need to include on the calendar or if you would like to prepare a podcast for the site.

This newsletter includes a substantive article about patent marking in the context of software method claims, a case summary of the recent *Quanta* decision, a top-ten list of events in recent trademark law, a profile of one of our Section members (Virginia Taylor of Kilpatrick Stockton), and Section committee reports (including a summary of a recent visit by the Section to the office of U.S. Senator Saxby Chambliss to discuss patent reform). You will also notice the newsletter includes a new Section logo, which you will see repeated at the website as well. We hope you like the new look and feel, and we encourage you to consider providing content for newsletters in the future.

Many thanks go to all who contributed this year to the Communications Committee activities. Todd McClelland of Alston & Bird has been a very supportive and enthusiastic Section Chair. The rest of the Section Officers and Committee Chairs have also been extremely helpful. We particularly like to watch Brad Groff of Garner Groff Greenwald & Villanueva and Phil Philip H. Burrus IV of Burrus Intellectual Property Law Group race to be the first to meet a request for Committee reports.

We are also grateful for the contributions of the Communications Committee members. Chris Glass (Morris Manning & Martin), Chris Curfman (Needle & Rosenberg), Colin Webb (Hexagon Group), and Lauren Fernandez Staley (Gardner Groff Greenwald & Villanueva) have all been generous with their time and ideas this year. We particularly want to acknowledge Lauren, who has done much of the heavy lifting on the new website.

Also, we are grateful to those who contributed substantive content to this newsletter. They contributed with little to no arm-twisting or bribes on the part of the Communications Committee. Nonetheless, the Committee reserves the right to utilize such tactics in the future.

With the help of many, we believe we have accomplished the Communications Committee goals this year. There is no time, however, to sit back and congratulate ourselves or to recite, "Mission accomplished." Even as we see a new slate of Section Officers and Committee Chairs look to the 2008-2009, we must continue to provide timely, useful communications to the IP Section members. To that end, please let us know what information and features you would like to see in the Section website and in future newsletters. ●

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