



Angels Who Lost Their Wings Federal Trademark Owner Loses to Local Organization

By Jeffrey R. Kuester
Thomas | Kayden

We have all seen small airplanes flying around, and I occasionally wonder if my law partner, Dan McClure, might be flying one of them. Though he obtained his pilot's license as a hobby, he surprised me a few years ago when he told me that he also donates time and money by flying patients and their families to distant hospitals for treatment. Dan's generosity was not the part that surprised me since we both are committed to regular giving to our churches and other organizations, but I was surprised that there existed an organization that would facilitate free flights for people with medical needs. Dan called them "Angel Flights," and as a trademark lawyer hearing that particular organizational name, I remember thinking that it was a good choice for a trademark. As it turns out, Angel Flight is indeed a good trademark according to a recent court decision.

For those of us who litigate trademark, false advertising, and unfair competition disputes in state and federal courts, as well as those of us who obtain trademark registrations for our clients, much can be learned from *Angel Flight of Georgia, Inc. v. Angel Flight America, Inc.*, 522 F.3d 1200 (11th Cir. 2008). In this case, a Georgia non-profit corporation successfully defended its common law right to use its trademark, Angel Flight, against a national organization that was armed with a federal trademark registration covering the same words. The Georgia company (Angel Flight of Georgia, "AFGA") demonstrated a likelihood of confusion resulting from the national organization (Angel Flight America, "AFA") moving into Georgia in recent years. In addition, AFGA also convinced the Eleventh Circuit Court of Appeals to cancel AFA's federal trademark registration, resulting in a complete victory for the local organization.

Volunteer pilots in Georgia began operating through AFGA in 1983 to provide free flights for patients and donated organs using the name Angel Flight. When AFA began promoting its own activities in Georgia in 2001 under the same name, donors and news media began confusing the two organizations. While the Eleventh Circuit Court of Appeals found that the District Court for the Northern District of Georgia had improperly relied upon hearsay in establishing evidence of actual confusion, the Court of Appeals considered that evidence to be largely superfluous in the overall finding of infringement. In essence, the other standard factors in the likelihood of confusion analysis clearly showed that there was common law trademark infringement, *e.g.*, the marks, services, consumers, and advertising media were all identical, and AFA's intent was also determined to be improper.

One interesting insight from this case is found in the intersection between Georgia common law trademark infringement and federal trademark law. While the federal trial and appellate courts in this case explicitly applied state common law, they looked instead to federal case law as persuasive authority in view of the "paucity of Georgia cases addressing common law trademark infringement," citing similar reliance on federal case law by Georgia courts. Consequently, litigation experience in federal trademark cases continues to be useful in determining Georgia common law trademark infringement.



Patent Committee Chair Bradley Groff and Jeffrey Kuester at the presentation on standing and pre-suit considerations.

In this issue

- 1 Angels Who Lost Their Wings: Federal Trademark Owner Loses to Local Organization
- 2 Chair's Corner
- 3 *Minor v. Martin*: A Memory Game of Trade Secrets
- 4 IP Member In Focus: Roger Frost
- 6 *Egyptian Goddess v. Swisa*: The New Playing Field for Designs
- 8 Update on Domain Disputes
- 10 Copyright Committee Report
- 10 Litigation Committee Report
- 11 Trademark Committee Report
- 12 New Life for Opinions of Counsel?
- 12 Patent Committee Report
- 13 Upcoming Events Calendar
- 17 Ten Technology Questions Lawyers Should Ask
- 18 IP in Pictures, News & Notes
- 20 Letter From the Editors

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Chair's Corner

By Wab Kadaba
Kilpatrick Stockton LLP

I would first like to welcome all the new members and thank the current members for your continuing involvement in the IP Section. We are already off to an exciting bar year and are continuing a long tradition of providing insightful and topical programs for our members. Over the past several months the section leaders have been very active in planning such events. The Patent

Committee, Litigation Committee, Trademark Committee and Copyright Committee have all hosted presentations on a variety of intellectual property issues, such as the fair use doctrine in the context of digitally sampling music and the new standard for patentable subject matter under *In Re Bilski*.



Wab Kadaba and his wife Ami at the IP Institute 2008, held in Mexico.

In November we held another successful IP Institute in Cabo San Lucas Mexico. The event, which was once again sold out, provided three days of CLE programs and entertainment for over 100 section members and guests. We are also excited to be joining forces with the newly formed IP Section of the Atlanta Bar Association in hosting a holiday party for the local IP community on December 18.

We Georgians are fortunate to have a wealth of nationally recognized intellectual property attorneys within our community who are truly leaders in the field. The IP Section is dedicated to bringing that community together regularly so that we can share each others' wisdom and learn from our collective experiences. Over the course of the year, your section leaders will continue to plan both substantive and social events to foster this goal. We hope you will make an effort to attend some of these events and enhance the collegiality of our local IP community.

For those of you wanting to do more than just attend these events, there are many opportunities to get involved. Each of the committees needs active member participation to succeed. We are always interested in hearing your ideas for programming as well. Please feel free to share your suggestions by contacting the appropriate committee chair; we always welcome your input and involvement.

Finally, I would like to thank all of the members of the Executive Committee for assuming these important responsibilities and for contributing to the Section's well-being and success. ●

Minor v. Martin: A memory game of trade secrets

By Jonathan Goins
Kilpatrick Stockton LLP

In 1971, there was a short-lived television game show created by media mogul Merv Griffin called the Memory Game. Each of the five contestants had a certain amount of time to try to memorize a booklet containing questions and answers. They were then asked the same questions. The contestant with the best memory, who could correct answer the most questions won a monetary prize or car.

The Ohio Supreme Court recently created its own trade secrets-version of the Memory Game. Earlier this year the eight-member court unanimously ruled that when a former employee memorizes a client list to compete with a former employer then a trade secrets violation has occurred. See *Al Minor & Assocs. v. Martin*, 881 N.E.2d 850 (Ohio 2008). The court explained that the confidential information of the company was not lost because the former employee memorized 15 clients and solicited them for his own, newly-formed company.

The *Martin* case is in line with a majority of other states (including Arkansas, California, Illinois, Massachusetts, Oklahoma, Pennsylvania, Texas, and Washington among others) recognizing that memorized information of a trade secret can form the basis for a misappropriation claim.

This decision takes trade secrets law involving memory a step further, suggesting that *any* memorization of a trade secret is subject to Uniform Trade Secrets Act protection, intentional or not. The focus was not on the reasonable steps take by the employer to protect its confidential proprietary information. In fact, the employer had taken almost no steps. The employee did not sign any non-disclosure, non-compete, or non-solicitation agreements. The employer did not have in place a written policy protecting confidential information. Notwithstanding the absence of these protections, the case supports the applicability of the inevitable disclosure doctrine or, possibly, a company's right to control the use of a former employee's memory.

Companies seeking redress for trade secret violations in Georgia should not anticipate playing the Memory Game (i.e., applying the *Martin* case) anytime soon. Georgia requires trade secrets, such as customer lists, to be in written or other tangible form, to warrant trade secrets protection. (See O.C.G.A. § 10-1-760 *et seq.*) Merely memorizing information is likely to be insufficient to establish a claim.

Also, it can be difficult in Georgia to enforce the protection of confidential information by traditional means such as non-compete or non-disclosure agreements. Georgia is notorious for striking down restrictive covenants (based in large part on the underlying principle of the state's constitutional provision mandating that contracts having the effect to "defeat or lessen



competition" are "illegal and void"). The restrictions must be reasonably limited in time, scope, and geography.

While not being able to sue for misuse of memorized trade secrets as with the *Martin* case, companies in Georgia should nonetheless continue to employ reasonable safeguards in protecting its confidential information, including:

- (i) designate appropriate documents as HIGHLY CONFIDENTIAL;
- (ii) limit physical access to areas maintaining any confidential information, use video surveillance, and require security cards or ID badges at all times;
- (iii) establish firewalls, filters and other IT-related security systems that minimize cyber-hacking, monitor Internet use, and maintain bulletproof filing storage programs;
- (iv) implement a selective security team to manage and enforce compliance, confidential policies and reporting mechanisms for suspected violations; and
- (v) most importantly, employ a "prevent defense" strategy and avoid unnecessary distribution or disclosure.

Information relating to trade secrets should be disclosed only on a need-to-know basis! This includes keeping an eye out for low-level employees, a lesson almost learned the hard way when Joya Williams, the secretary to Coca-Cola's global brand director, obtained confidential documents and product samples, and conspired to sell them to rival PepsiCo for \$1.5 million (one of her co-conspirators actually exchanged info with an undercover FBI agent for 30k; they were convicted in February 2007).

Protecting trade secrets and other confidential proprietary information cannot be under-estimated, and in fact, can be quite costly. A U.S. Chamber of Commerce study, for example, found that from July 2000 to June 2001, Fortune 1000 companies reported stolen IP and proprietary information at a value of almost 60 b-b-b-billion dollars!

So by all means, take steps to minimize an employee's ability to play the trade secrets-Memory Game. ●



Jonathon Goins & Tanya Boyle
Goins at the IP Institute.

(Continued from page 1)

In addition, those of us who obtain federal trademark registrations for our business clients should note from this case that AFA's federal trademark registration was canceled because it was found to have been obtained through fraud. In keeping with a recent trend by courts in canceling federal trademark registrations on the basis of fraud for a variety of different reasons, this court found that AFA committed fraud on the U.S. Trademark Office by not disclosing the existence of other legitimate users of the Angel Flight mark, such as AFGA. Interestingly, this fraud finding was upheld even though AFA's first use (outside Georgia) occurred before AFGA's first use, making this another example of how a junior common law user may be able to cancel a senior user's federal trademark registration.

While this case ultimately shows that common law rights can overcome a federal registration in some instances, it should be remembered that common law rights never extend beyond their geographic areas of use. Consequently, while federal registrations are still useful in obtaining constructive nationwide protection if other uses have not yet begun, concurrent use federal registration

applications should be used in other circumstances to avoid the risk of fraud since federal trademark registrations for concurrent use are typically limited by geography.

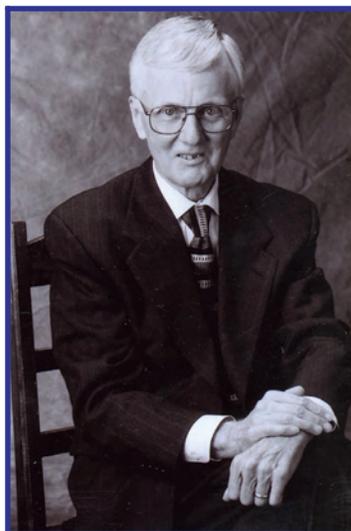
Furthermore, business law attorneys should also remember that the simple reservation of a corporate name through the Georgia Secretary of State's office never establishes trademark rights. In addition, unlike federal trademark registrations, it is settled law that Georgia trademark registrations also do not provide evidence of ownership rights. Consequently, enforceable trademark rights may be much more difficult to establish at trial without the benefit of a federal trademark registration.

In conclusion, it is unfortunate that these two worthwhile charitable organizations were unable to settle their territorial disagreements without resorting to our court system. Of course, these types of flights are desperately needed by people throughout our country, so we should all support their efforts. If you happen to be a pilot, please consider volunteering, and if you are not a pilot, please consider contributing. AFGA can be found online at www.angelflightsoars.org. ●

IP Member in Focus: Roger Frost

By Robert Neufeld
King & Spalding

As part of the continuing series profiling noteworthy members of the Section, in this issue of the newsletter we are focusing on Roger Frost. Mr. Frost is retiring from the practice of intellectual property law after more than forty years in the business. Mr. Frost graduated from the Georgia Institute of Technology in 1960 and received his law degree from Georgetown University Law Center in 1964. After working as an examiner at the U.S. Patent and Trademark Office ("PTO") and as in-house counsel at Lockheed Martin, Mr. Frost spent the majority of his career in private practice with the firm that came to be known as Jones & Askew. Mr. Frost developed a strong reputation among his colleagues as an expert in PTO procedure. Many members of today's Georgia Bar IP Section have had the opportunity to learn from Mr. Frost. The following are remarks from a few of the lawyers Mr. Frost influenced over the years.



Roger had a knack for prosecuting our most humorous inventions (and Roger delighted in playing with the humor). Who can forget the famous bedside alarm clock that at the appointed hour displayed on a bedside wall a short film clip of a steaming locomotive headed right for the bed -- together with all of the approaching train sounds and noises -- and the groggy sleeper sitting up in bed with arms outstretched and eyes bulging? It is my recollection that the application sailed through the office on a first action allowance.

Roger is a great friend and a legendary patent lawyer -- we all learned a lot of patent law from him while enjoying our time with him.

- Tony Askew

Roger was one of my most influential mentors in learning patent drafting and prosecution. He is an excellent attorney and teacher. His techniques have served my clients well for decades, and I still routinely pass them on to young attorneys. Roger also set an excellent example as a professional of unquestioned integrity, and loyalty to clients and colleagues. Like so many of my colleagues, I owe my success in significant part to the preparation and values Roger imparted to me. I am very grateful, and wish Roger and Maxine an enjoyable retirement.

- Jeff Young

Following the formation of Jones and Thomas in 1968 by Harold Jones and George Thomas, I was the first to join and Roger was the second. We lured Roger from Lockheed where he had practiced for many years as an in-house patent attorney. As a result, Roger was the fourth most senior member of the firm with Janet Peck following closely on his heels. Whenever we had airplane inventions (such as heads-up cockpit displays and landing gear tire pre-rotation), Roger could explain the fallacies with the ideas and the existence of a lot of prior art.

I first met Roger Frost on Thursday September 15, 1977. I remember that day well because it was the day I interviewed for a job with Jones, Thomas & Askew, which at that time was located in the Gas Light Tower of Peachtree Center. I received a phone call the next day from Tony Askew offering me a job and I reported for work the following Monday. I was the eighth lawyer in the firm, which at that time comprised Harold ("Deacon") Jones, George Thomas, Tony Askew, Roger Frost, Jeff Young, Gene Zimmer and Lou Isaf. I had no idea on that day

that I would spend the next three decades practicing law with most of those guys.

My immediate task upon joining the firm was to assist Tony with some litigation. However, I was also learning patent prosecution along the way and Roger was my mentor. I learned to write a patent application, how to prepare a response and the intricacies of an obviousness rejection at Roger's knee, or more accurately over a cheese steak at the Mad Italian. He taught me how to draft a patent claim using means for this and means for that. And, he instructed me in the judicious use of his infamous comma shaker. To this day, I still use the Roger Frost format for a patent application. But, Roger didn't teach just me. I suspect that half of the IP attorney's that started their IP practice in Atlanta were taught by Roger at one time or another.

In addition to teaching me the fine art of patent prosecution, Roger was also the PTO Rules guru. If anyone had a question about the Rules, they would immediately go to Roger and ask for his advice. Roger's response to these questions was always, "Have you checked the CFR yourself?" Although I did not say it at the time, the answer to that question was "Of course not, it is easier to just ask you." But, Roger would always pull out his self-annotated CFR and immediately point me to the appropriate code section. Thanks Roger for always being patient with the hundreds of questions you must have answered over the years.

I owe Roger a great debt of gratitude for teaching me how to prosecute patent applications and helping me to be the IP attorney that I am today. Over the years, we have shared joys and sorrows, births and deaths, good times and bad. Roger has been a boss, a mentor and a partner. But, most of all Roger has been a friend.

I wish Roger the best of luck as he starts this new phase of his life. Roger, your petition for a leave of absence is hereby granted.

- Bob Richards

I worked closely with Roger at Jones & Askew from circa 1981 through 1999 -- over 18 years. We had some wonderful times together and he always taught me a lot. I'll pass along a couple of anecdotes:

1. Roger would always seem to get one or more "pooper scooper" inventions every year, and he would pass them along to the next new associate coming into the firm as a training exercise. I was one of those lucky recipients as a newbie associate. The first patent application I got to write totally by myself was directed to one of those so-called inventions ... I can honestly say, "Roger often had to deal with a bunch of crap ...".

Here's that patent, which ultimately did issue: 4,363,508 "Animal Waste Collection Apparatus."

2. Roger was a veritable walking encyclopedia of the 37 CFR. He was so good at it everybody around him got lazy and would not look up the regulations. People (and me included) would generally simply get up from our desk, walk over to Roger's office, and ask "how do the regs say we are supposed to do this ... ?" And most of the time, Roger would graciously provide the answer -- the correct answer -- off the top of his head.

After having put up with this from an associate for a while (in my case, a couple of years), Roger would finally get exasperated and say, "I know the answer to that and how the Office will interpret that -- very strictly. Did you bother to look it up before coming here to ask me?" To which the associate (like yours truly) would sheepishly turn red-faced, say no I didn't, walk back to our office, and make sure we read the rule thoroughly and looked at the MPEP before asking Roger about the nuances.

3. One of my favorite sayings of Roger was, "Mystery Solved!" From time to time, a file could simply not be readily found when it was needed. And as many

patent practitioners will know, any file with a problem issue would never be in the right place on the shelf -- it was almost always out there somewhere, on somebody's desk, or misfiled.

I remember several occasions (not necessarily just involving yours truly) where an associate would be in a panic about some problem that just landed on their desk, frantically rushed out to the file room, couldn't find the file, look on all the secretary desks, and finally go to Roger and say, "I can't find the file ... we've got this huge problem ... it has to be handled today ... what do I do?" To which Roger invariably would march into the associate's office, stand there a minute, look on the floor, and finally bark out, "Mystery Solved!" ... while pointing to the file lying on the floor in the panicked associate's office. I will say I wasn't the only one this happened to -- many of his colleagues now at prestigious silk stocking firms were also culpable about such things. I heard him say it to many besides myself.

- John Harris

I count myself fortunate to be among the many who owe much to Roger Frost. Roger gave me my first project as an attorney. As a young law clerk at Jones, Thomas and Askew, Roger asked me to assist in the preparation of a brief at the Trademark Trial and Appeal Board. He guided me through that project, as he did so many others, with a steady constitution and a dash of humor. From "comma shakers" to the details of patent, copyright and trademark law, there is no better teacher. Roger knows the law like no other, and he is generous with his time, talent and knowledge. Roger does not discriminate. All who have been fortunate to encounter him, whether as co-counsel or opposing counsel, have benefited from the experience. As the saying goes, we stand on the shoulders of giants. Roger is a giant. I am thankful for the many things he taught me and the fond memories of working with him.

- Steve Schaezel

While my tenure at Jones & Askew LLP (J&A) was very short, I did have the opportunity to work with several of the great lawyers who are now practicing in all of the top IP firms in Atlanta. One of those great lawyers was Roger Frost. Early on, everyone asked if I knew Roger. He and I had similar backgrounds. He went to law school in Washington D.C. and so did I. He was a former patent examiner and so was I.

However, those are the end of our shared similarities. Roger was J&A's patent prosecution expert. He knew the Manual of Patent Examining Procedure (MPEP) like the back of his hand. I was told, "If you have a patent prosecution question, go see Roger." And I was able to take advantage of his knowledge on a few occasions during my brief tour at J&A. Roger's knowledge of patent prosecution was very influential to me. He has inspired me to become the lawyer that I am today. A colleague told me a year or two ago, "Steve, you are like our IP group's Roger Frost." I consider that a tremendous compliment given what we all know about Roger Frost. Roger, I wish you the best of luck on your retirement. It has been a pleasure working with you and knowing you.

- Steve Wigmore

As the foregoing remarks demonstrate, Mr. Frost has been a significant member of the intellectual property community in Atlanta and has had a deep and lasting impact on the attorneys who have practiced with him. We wish him an enjoyable retirement. ●

Egyptian Goddess v. Swisa: The New Playing Field for Designs

By Joe Staley

Gardner Froff Greenwald & Villanueva, P.C.

In the first design patent case ever litigated before the *en banc* United States Court of Appeals for the Federal Circuit, the Court breathed new life into design patents. The much anticipated ruling in *Egyptian Goddess, Inc. v. Swisa Inc.*, 543 F.3d 665 (Fed. Cir. 2008) set forth a new test for design patent infringement.



Joe Staley enjoys an evening event at the IP Institute.

Design patents were never in more need of resuscitation. Despite the fact that over 27,000 design patent applications were filed in 2007 and over 24,000 design patents were granted in the same time period, it has generally been the opinion of courts and industry alike that design patents offer the holder almost no scope of protection. In fact, a recent survey conducted by the Saidman DesignLaw Group noted that ever since *Markman* was applied to design patent claim construction in 1995, district courts have granted summary judgment of non-infringement in favor of the moving defendant (accused infringers) a whopping 72% of the time. In terms of the total number of design patent cases filed in that same time period, almost 50% were terminated by summary judgment in favor of the accused infringer.

If these statistics seem reasonable to you, contrast these numbers with the overall rate at which district courts have found infringement on summary judgment—only about 6% of the time. Clearly, design patent holders have been faced with a steep uphill climb in trying to enforce design patents. Fortunately for design patent holders, *Egyptian Goddess* has significantly leveled the playing field by eliminating the “point of novelty” test from the design patent infringement inquiry. The CAFC even took the additional step of counseling future courts against *Markman*-type claim constructions, making it easier for design patent holders to survive summary judgment motions.

State of the Case Law Prior to *Egyptian Goddess*

Design patents are granted for a term of fourteen years to “whoever invents any new, original and ornamental design for an article of manufacture.” 35 U.S.C. § 171. In considering the infringement of a design patent, design patent holders are uniquely afforded additional remedies under 35 U.S.C. § 289, which states in part that whoever “applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale...shall be liable to the owner to the extent of his total profit.”

Prior to the *en banc Egyptian Goddess* decision, the test for design

patent infringement incorporated two parts as explained in *Arminak & Assocs. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314 (Fed. Cir. 2007). First, the court construed the claim of the design patent at issue to determine the proper scope. Second, the court compared the construed claim to the accused product, which itself incorporated a two-prong approach: the “ordinary observer” test and the “point of novelty” test. Therefore, an accused infringer only needed to demonstrate that one prong of the infringement test was not satisfied in order to avoid a finding of infringement.

The ordinary observer test was first enunciated by the Supreme Court in *Gorham Manufacturing Co. v. White*, 81 U.S. 511 (1871), which held that “if, in the eye of an ordinary observer, . . . two designs are substantially the same if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.” In *Gorham*, the Supreme Court also made it very clear that the “ordinary observer” is a regular consumer, as opposed to an expert. Furthermore, the Supreme Court explained that the resemblance need not be identical, but that the general appearances of the two designs be “substantially the same.” In fact, the Supreme Court noted that many differences existed between the designs analyzed in *Gorham* but, nonetheless, found infringement on the premise that an ordinary observer would be confused.

The ordinary observer test was the state of the law until 1984, when the Federal Circuit made it more difficult for patent holders to enforce design patents against accused infringers by adding the “point of novelty” test to the infringement inquiry. See *Litton Systems v. Whirlpool, Corp.*, 728 F.2d 1423 (Fed. Cir. 1984). The point of novelty test was adopted by the Federal Circuit to protect accused infringers from a finding of infringement when the accused infringer adopted ornamental features from the prior art rather than the patented design. More specifically, the Federal Circuit held that “no matter how similar two items look, the accused device must appropriate the novelty in the patented device which distinguishes it from the prior art.” Therefore, in order for infringement to be found, the similarity between the patented design and accused design must be attributable to the novelty of the patented device, rather than features found in the prior art.

While the point of novelty test was easy to apply in simple cases in which the prior art was limited to one or two references, it became a barrier to enforcement for those cases that had several prior art references. Because most patented designs incorporate known design features or are simply a reconfiguration of known design elements, in practice it became very easy for accused infringers to avoid infringement by merely showing the existence of individual design features in the prior art. Additionally, the point of novelty became problematic for many courts, in that the more novel a design is—and the more novel features it incorporates—the more narrow the claim becomes (an accused infringer had to incorporate all or substantially all of the novel features to infringe). This

problem created an incentive for patent holders to only assert those points of novelty that the accused infringer incorporated.

By 1995 the Federal Circuit began applying *Markman* hearings to design patent cases. See *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995). The net effect of sanctioning *Markman* proceedings in the design patent context was that district courts construed the claims of a particular design patent by verbalizing the drawings of the patent. Determining the scope of a design patent claim by translating images into verbal descriptions proved to be problematic for district courts on many levels. Not only was it difficult, but it often unfairly prejudiced the court against a finding of infringement.

Egyptian Goddess I

Egyptian Goddess, Inc. brought a design patent infringement action in the U.S. District Court for the Northern District of Texas alleging that Swisa, Inc. had infringed U.S. Design Patent No. 467,389. The patent claimed a design for a nail buffer, consisting of a rectangular, hollow tube having a generally square cross-section and featuring buffer surfaces on three of its four sides.

Swisa's accused product consists of a rectangular, hollow tube having a cross-section, but featuring buffer surfaces on all four sides. The District Court verbally construed the claim and found that the Egyptian Goddess patent was limited in scope to:

A hollow tubular frame of generally square cross section, where the square has sides of length S , the frame has a length of approximately $3S$, and the frame has a thickness of approximately $T=0.1S$; the corners of the cross section are rounded, with the outer corner of the cross section rounded on a 90 degree radius of approximately $1.25T$, and the inner corner of the cross section rounded on a 90 degree radius of approximately $0.25T$; and with rectangular abrasive pads of thickness T affixed to three of the sides of the frame, covering the flat portion of the sides while leaving the curved radius uncovered, with the fourth side of the frame bare.

Once the District Court construed the claim of the patent as such, Swisa moved for summary judgment of non-infringement. The District Court granted Swisa's motion stating that the accused device did not incorporate the point of novelty of the '389 patent, which the Court identified as being a "fourth, bare side to the buffer." Egyptian Goddess argued that the point of novelty was actually a combination of multiple features.

A Federal Circuit panel affirmed the District Court's decision and stated that the point of novelty can be a single novel design element or a combination of features that are individually known in the prior art. However, the Federal Circuit panel decision held that in order for a combination to constitute a point of novelty, it must be a "non-trivial" advance over the prior art. Without further explanation, the decision (rather confusingly) asserted that the new "non-trivial" standard should not be equated with either anticipation or obviousness.

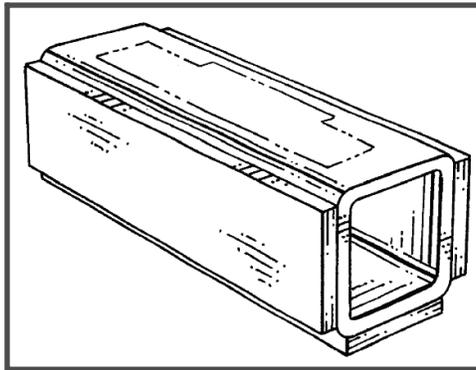
On November 26, 2007 the Federal Circuit granted a petition for rehearing *en banc* and vacated the panel's decision. The *en banc* order asked both parties and invited *amicus curiae* to brief the Court

on whether the point of novelty test should be retained, and whether claim construction should apply to design patents.

Egyptian Goddess II

In its *en banc* ruling, the Federal Circuit rejected the point of novelty test as a rigid approach that unfairly burdened patent holders and adopted a more flexible test for design patent infringement. In eliminating the point of novelty test the Federal Circuit also repudiated the "non-trivial advance" test. The Federal Circuit held that in accordance with *Gorham*, the ordinary observer test is the sole test for determining whether a design patent has been infringed. The *en banc* court pointed out that the creation of a separate and distinct test is unnecessary because the ordinary observer test already takes into account the prior art.

Specifically, the Federal Circuit noted that "when the differences between the claimed and accused design are viewed in light of the prior art, the attention of the hypothetical ordinary observer will be drawn to those aspects of the claimed design that differ from



the prior art." Thus, "small differences between the accused design and the claimed design are likely to be important to the eye of the hypothetical ordinary observer." The prior art gives the hypothetical ordinary observer a "frame of reference" in which to compare the claimed and accused designs. Employing the ordinary observer test—in the context of the prior art—the Federal Circuit affirmed the District Court's summary judgment ruling of non-infringement.

In guiding future litigants and judges, the Federal Circuit noted that while the patentee maintains the burden to prove infringement, the burden of production is on the accused infringer to identify the prior art that the ordinary observer would consider to distinguish between the patented and accused designs. Additionally, while not mandating such, the Federal Circuit pointed out that a "three-way visual comparison between the patented design, the accused design, and the closest prior art" may be helpful in evaluating infringement. In other words, if the accused product is closer in appearance to the patented design than to the prior art, infringement may be found. Finally, the Federal Circuit strongly cautioned against attempts to construe verbally the claim of a design patent because of the risk of placing undue emphasis on a particular feature.

Conclusion

In rejecting the point of novelty test, the *Egyptian Goddess* decision significantly levels the playing field for design patent litigants and is likely to result in more favorable treatment of design patents at the summary judgment stage. The *en banc* ruling greatly simplifies the design patent infringement analysis. It is also expected to allow more design patent cases to get past summary judgment, likely leading to more trials or settlements more favorable to patentees. While the Federal Circuit is likely to clarify and expand upon this ruling in the future, for the time being the playing field has been leveled, and the value of design patents enhanced. ●

Update on Domain Name Disputes

By Douglas M. Isenberg

The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC

I recently returned from my annual meeting in Geneva, Switzerland, for the World Intellectual Property Organization (“WIPO”), where I serve as a domain name panelist. The meeting was attended by 63 domain name panelists from 22 countries. Below are some of my thoughts about the meeting.

First, a few statistics, some of which clearly show that domain name disputes are growing in importance:

- So far this year, more than 1,900 domain name cases have been filed at WIPO, making 2008 already the second-busiest year ever for domain name disputes. If the trend continues, the number of domain name disputes filed at WIPO in 2008 likely will set a record.
- Again in 2008, the most active filers of domain name disputes are from the United States, representing more than 44% of the total, followed by France (about 10.6%), the United Kingdom (about 7.5%), Germany (about 5.7%), Switzerland (about 5%) and Spain (about 4.6%).
- More domain name complaints are filed by companies in the biotechnology and pharmaceutical industry than by any others, followed by banking and finance; Internet and IT; retail; food, beverages and restaurant; entertainment; media and publishing; hotels and travel; fashion; and telecom.
- The .com global top-level domain (“gTLD”) accounts for more than 78% of all WIPO gTLD cases, followed distantly by .net, .org and .info.
- The .fr (France) country-code top-level domain (“ccTLD”) is the most popular ccTLD in WIPO disputes, followed by .ch (Switzerland), .tv (Tuvalu), .es (Spain) and .au (Australia).
- Eighty-four percent of WIPO cases result in a decision transferring the disputed domain name to the complainant that filed the case.

This record-setting level of domain name disputes is being fueled largely by the continued rise of “domaining” as an industry, whereby individuals and companies exploit ways to monetize their domain name registrations, often at the expense of trademark owners.

Also, we discussed at WIPO the forthcoming expansion of the number of new gTLDs, which could result in an explosion of new top-level domains to compete with .com, such as (according to some speculation): .web, .nyc, .paris, .perfume, .sports – and virtually anything else one might imagine. ICANN (the Internet Corporation for Assigned Names and Numbers) is slowly releasing details about how the new gTLD process will work, but at least

one thing is clear: New gTLDs will create new opportunities for cybersquatters, thereby creating new headaches for brand owners in protecting their trademarks on the Internet. Fortunately, ICANN and WIPO are working together on dispute processes related to the new gTLDs, and I already have begun advising clients on how to deal with the new top-level domain process. Companies of all sizes will need to be more proactive, reactive and vigilant than ever in safeguarding their brands online.

Finally, I want to share with you the exciting personal news that I have been selected as one of 37 domain name panelists worldwide to join the Czech Arbitration Court (“CAC”), which will begin offering UDRP services in January. CAC has some interesting plans to expedite the UDRP process, including an online filing system, which should reduce the time and expense associated with domain name disputes, and a potential “class complaint” process. In addition to serving as a CAC panelist, I will certainly consider filing UDRP complaints with CAC on behalf of my own clients and am happy to discuss this possibility with you.

My new experiences that will be forthcoming at CAC, combined with my work at WIPO, ICANN and in domain name disputes generally for a dozen years, give me confidence that bad actors on the Internet always can be fought, and that combating cybersquatting is an important and necessary way to ensure the ongoing vitality of the Internet itself. •

Local Attorneys’ IP Blogs

We have found several local intellectual property-related blogs. They include: Jackie Hutter of the Hutter Group in Decatur, Georgia characterizes herself as a “recovering patent attorney” and publishes a blog entitled IP Asset Maximizer Blog. (See <http://www.ipassetmaximizer.com>).

William Heinze’s website, I/P Updates provides “News and Information for the Sophisticated Intellectual Property Practitioner.” See <http://ip-updates.blogspot.com>).

Thomas (Terry) Williamson of Williamson Intellectual Property Law LLC calls his blog a “Patent Blog about Patent Law and the Patent Community in Atlanta.” (See <http://atlanta-patent-attorney.com>).

Finally, we found the Georgia Patent Law Blog, which reports on patent cases from the Northern District of Georgia. (See <http://www.georgiapatentlaw.com>). The Georgia Patent Law log is published by Coby Nixon (IP Section member) of Alston & Bird LLP.

Are there other local blogs we should know about?

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2008-2009 IP Section Officers and Committee Chairs



Front row (left to right): Kevin Glidewell (In-house Committee Chair); Steven Wigmore (Section Vice Chair); Wab Kadaba (Section Chair); Andrew Crain (Section Chair Elect). Back row (left to right): Philip Walden (Copyright Committee Chair); Philip Burrus (Section Treasurer); Tina Williams McKeon (Communications Committee Co-chair); Bradley Groff (Patent Committee Chair); Jim Johnson (Trademark Committee Chair); Lauren Estrin (Social Committee Chair); Shane Nichols (Section Secretary). Not pictured: Alison Danaceau (Communications Committee Co-chair); Andria Beeler-Norholm (Licensing Committee Chair); Wilson White (Litigation Committee Chair).

Copyright Committee Report

Chair: Philip Walden
Turner Entertainment Group, Inc.

The Copyright Committee of the IP Law Section of the Georgia Bar and the Southeast Chapter of the Copyright Society hosted a luncheon/panel on December 4, 2008, at Kilpatrick Stockton. The all-star panel of copyright luminaries discussed recent developments in the doctrine of transformative fair use and how these developments may impact and alter the negative treatment that musical sampling has received in federal courts since the use of samples by musicians became widespread in the 1980s. •

Litigation Committee Report

Chair: Wilson White
Kilpatrick Stockton LLP

The Litigation Committee has plans to host four events this year. The first of our events, held on December 4 at the Sutherland offices in midtown, was a lunch presentation on standing and other pre-suit considerations in patent, trademark, and copyright cases. Our next event will be on January 9, in conjunction with the State Bar's mid-year meeting, where the Litigation Committee will host a two-hour panel discussion on ethical conflicts in IP prosecution and litigation. Both events promise to be interesting and informative.

We would like to thank the following committee members for their hard work on behalf of the Litigation Committee thus far this year: Ann Fort (Sutherland), David Lilenfeld (Manning Lilenfeld LLP), Tiffany Williams (Kilpatrick Stockton LLP), Jennifer Liotta (Alston & Bird LLP), Kristin Goran (Sutherland), Darcy Jones (Sutherland), Nicole Morris (Kilpatrick Stockton LLP), Lauren Linder (Kilpatrick Stockton LLP), and Louise Rains (Kilpatrick Stockton LLP). •

Trademark Committee Report

Chair: James H. Johnson

Sutherland, Asbill & Brennan LLP

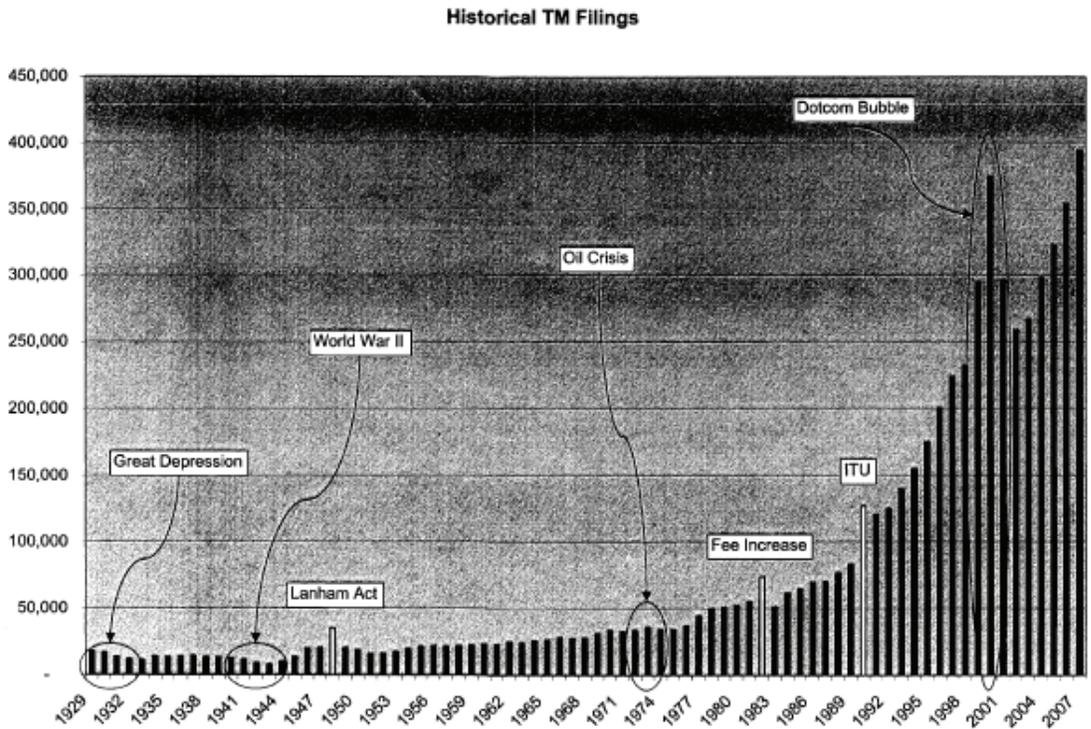
The Trademark Committee is planning a series of joint presentations with other committees of the Bar to highlight the relationship between trademarks and other practices, e.g., corporate law, bankruptcy.

Our first seminar is scheduled for January 14, 2009, at lunchtime at the Georgia Bar Building. This event will be 1hr Lunch and Learn CLE cosponsored by the Entertainment and Sports Law Section. So please save the date. As soon as the speakers are confirmed, these will, of course, be communicated to the Bar. Also, if you have any ideas or suggestions for presentations, please contact the chair James Johnson.

James Johnson serves on The Public Advisory Committee for US Trademark Office and he invites members of the Bar to bring any problems or issues that you may have with the Trademark Office to his attention and he, when appropriate, see if the matter can be resolved.

The Trademark Office sends out a newsletter about Trademark Office events, policy changes and rulings. If you would like to receive a copy by email, please send an email with your email address to Michelle King of INTA at Mking@inta.org and request that you are put on the mailing list.

Finally, the committee thought that it may be of interest to the IP Community to see a historical graph of the trademark filings and how major events, such as the Depression, impacted the filings (above right). The Chart was provided by the US Trademark Office. ●



Graph shows trademark filings since 1929, including events that impacted filing rates. (Provided by U.S. Patent and Trademark Office).



Jim Johnson, Lauren Staley, and Chris Holland at the IP Section Holiday Party.

New Life for Opinions of Counsel?

By Jennifer Liotta
Alston & Bird

The Federal Circuit recently issued an important patent ruling that impacts the role of opinions of counsel, particularly in the context of the intent requirement for inducement of infringement. The Federal Circuit decision in *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, which published on September 24, 2008, establishes that, even though opinions of counsel are no longer critical in defending against willful infringement claims, clients may be well-advised to obtain such opinions to defend against claims of inducement of infringement.

Qualcomm and Broadcom are competitors in the market for chipsets used in cell phones and similar mobile devices. Broadcom accused Qualcomm of infringing three of Broadcom's patents. The patents at issue related to video compression technology on cell phone devices, technology allowing cell phone to participate simultaneously on multiple wireless networks with a single transceiver, and to telephones having the circuitry to couple selectively to two networks of different bandwidth.. The district court, ten days before the *en banc* decision in *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007), held that Qualcomm willfully infringed various claims of both Broadcom patents either directly or indirectly.

The Federal Circuit in the *Broadcom* decision held that whether a defendant obtains an opinion of counsel on infringement is relevant to whether the defendant had the specific intent to induce the direct infringement by others. In denying Qualcomm's request for a new trial based on the district court's pre-*Seagate* jury instructions, the Federal Circuit held that the jury instructions at issue were proper insofar as the instructions identified opinions of counsel as a relevant factor in determining inducement of infringement. The Appeals Court clarified that *Seagate*--which held that opinions of counsel were not relevant to the question of willful infringement---was not applicable to inducement of infringement, as the two claims are distinct. A claim for inducement of infringement requires a showing that (1) there has been direct infringement, and (2) the alleged infringement knowingly induced infringement and possessed specific intent to encourage another's inducement." With respect to the intent element, the Federal Circuit noted that it may be inferred from all of the circumstances and requires a showing that the defendant (1) intended to cause the acts that constitute direct infringement, and (2) knew or should have known that its actions would cause another to directly infringe. The court held that opinion-of-counsel evidence remains relevant to the second prong of the intent analysis, i.e., whether the accused infringer "knew or should have known" that the induced acts would constitute infringement. •

Patent Committee Report

Chair: Brad Groff
Gardner Groff Greenwald & Villanueva, P.C.

The Patent Committee is planning an active year of programs for the 2008-09 Bar year. Our Committee members include: Shari Corin, Kilpatrick Stockton LLP; Karen Borelli Etheridge, Newell Rubbermaid Inc.; Joseph Gleason, Alston & Bird, LLP; Brad Groff, Gardner Groff Greenwald & Villanueva, P.C.; Rivka Monheit, Pabst Patent Group, LLP; and Ryan Pumpian, Powell Goldstein, LLP.

Please contact Brad Groff (bgroff@gardnergroff) if you would like to join our committee, or if you have suggestions for programs.

Our first program of the new Bar year was held at the State Bar Center on October 29, 2008. Joe Staley and Art Gardner of Gardner Groff discussed the effect of the *Egyptian Goddess* en banc decision from the Federal Circuit on design patent prosecution. We had a full house and enthusiastic participation from the audience, and we debated how elimination of the "point of novelty" test would affect prosecution practice as well as enforcement of design patents.

On December 9, 2008, Karen Borelli Etheridge of Newell Rubbermaid and T.J. DoVale of the Needle & Rosenberg IP Practice of Ballard Spahr presented a program at the State Bar Center on patent practice after the *In Re Bilski* decision from the en banc CAFC. This was a very informative and topical program.

Topics under discussion for upcoming programs include stem cell patents, patent interferences, ITC proceedings, revisions to the Northern District Local Patent Rules, and written description issues related to chem and bio patents. We are also working with the Patent Resources Group to try to bring another one of their "expert-level" CLE programs to Atlanta soon. •



Brad Groff and Jeffrey Young at the IP Holiday Party.

Upcoming Events Calendar

LOCAL EVENTS

January 14, 2009

Joint IP Section and Entertainment & Sports Law Section Lunch and Learn * 1 CLE credit

State Bar of Georgia Headquarters, Atlanta, GA
More information at http://gabar.org/public/pdf/09-Jan14_IP.pdf

February 6, 2009

PRG Seminar: Inequitable Conduct Under Current Federal Circuit Law.

Presented by the Patent Resources Group (PRG) and IP Section Patent Committee. *6 CLE credits available.
State Bar of Georgia Headquarters, Atlanta, GA
More information: www.patentresources.com

May 8-9, 2009

SpringPosium. Presented by Atlanta Bar Association IP Section and the Georgia State University College of Law. * 8 CLE credits available. Barnesly Gardens, Adairsville, GA

July 28, 2009

5th Annual Southeastern Intellectual Property Job Fair
Georgia State University College of Law, Atlanta, GA

NATIONAL AND INTERNATIONAL IP EVENTS

January 6-9, 2009

17th Annual Advanced Licensing Institute
Franklin Pierce Law Center, Concord, NH
More information: www.piercelaw.edu/ali

January 28, 2009 – February 1, 2009

AIPLA Mid-Winter Institute

Presented by the American Intellectual Property Organization
Marriott Doral Golf Resort & Spa, Miami, FL
More information: <http://www.aipla.org/>

February 5-6, 2009

ABA Antitrust Program: “Strategic Choices, Evolving Standards, and Practical Solutions”

Presented by the American Bar Association Section of Intellectual Property Law
Boalt Hall, UC Berkeley School of Law, Berkeley, CA
More information: <http://www.abanet.org/>

February 5-7, 2009

CSUSA 2009 Mid-Winter Meeting

Presented by the Copyright Society of the USA
Hotel Monaco, San Francisco, CA
More information: <http://www.csusa.org/>

[midwinter_meeting_2009.cfm](#)

February 9-10, 2009

INTA Trademark Law and the Internet

Presented by the International Trademark Association
Hyatt at Fisherman’s Wharf, San Francisco, CA
More information: <http://www.inta.org/>

February 12-14, 2009

AUTM 2009 Annual Meeting

Presented by the Association of University Technology Managers
Orlando World Center Marriott Resort and Convention Center, Orlando, FL
More information: <http://www.autm.net/events/>

February 26, 2009

Technology Show and Tell

*6 CLE credits available
State Bar of Georgia Headquarters, Atlanta, GA
More information: <http://iclega.org/schedule.html>

April 1-4, 2009

“What IP Lawyers Need to Know”

ABA 24th Annual Intellectual Property Law Conference
Crystal Gateway Marriot Hotel, Arlington, VA
More information: <http://www.abanet.org/intelprop/spring2009/>

May 13-15, 2009

AIPLA Spring Meeting

American Intellectual Property Institute
Hotel Del Coronado, San Diego, CA
More information: <http://www.aipla.org>

May 16-20, 2009

INTA 2009 Annual Meeting

International Trademark Association
Washington State Convention Center, Seattle, WA
More information: <http://www.inta.org>

June 7-9, 2009

CSUSA 2009 Annual Meeting

Presented by the Copyright Society of the USA
The Sagamore Hotel, Bolton Landing, NY
More information: <http://www.csusa.org/events.htm>

* CLE credits applied for

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

Georgia Lawyers for the Arts Fundraising Gala, November 7, 2008



Georgia Supreme Court Justice Carol Hunstein congratulates Lisa Moore on a successful fundraising effort.

On November 7, 2008, the Georgia Lawyers for the Arts (GLA) held its 33rd Annual Gala. The IP Section was an event sponsor.

GLA is a nonprofit organization led by Executive Director Lisa Moore. The organization has over 500 volunteer attorneys who provide legal assistance and educational programming to artists and arts organizations in Georgia.



Mike Hobbs and Fred Hewitt tour the art gallery.



Contributing Artist Theresa Sicurezza displays her work.

The Georgia Bar IP Institute Mexico, November 13-16, 2008

The Intellectual Property Section held its fourteenth Annual Intellectual Property Law Institute on November 12-16, 2008, in Cabo San Lucas, Mexico. The Institute, held jointly with the Annual Entertainment and Sports Law Conference, provided CLEs and entertainment for over 100 IP Section members and their guests.



Lauren Estrin updates attorneys on recent trademark law developments.



Mary Jo Schrade enjoys a Mexican meal.



Federal Court Justices Pannell and Garcia join Chad Pannell for dinner by the sea.

Final rule: Representation of Others Before the USPTO

A final rule governing the conduct of individuals registered to practice before the US Patent and Trademark Office requires a practitioner to pay an annual maintenance fee. The rule, effective December 17, 2008, enables the Office to maintain an updated list of registered practitioners. The fee is \$118 for agents in active status. There is a \$50.00 fee for late payment of the annual fee. Those choosing not to maintain active status may elect to become voluntarily inactive for a reduced annual fee of \$25. Those on involuntary inactive status are not required to pay a fee unless they choose to return to active status. To return to active status, the Office will impose various fees (as follows):

- Voluntary Inactive Status—\$25
- Fee for requesting restoration to active status from voluntary inactive status—\$50
- Balance due upon restoration to active status from voluntary inactive status—\$93.
- Administrative reinstatement fee—\$100

For further details see <http://www.uspto.gov/web/offices/com/sol/notices/73fr67750.pdf> and <http://www.uspto.gov/main/homepagenews/2008nov18.htm>.

Midyear Meeting: Ethics Seminar



At the State Bar of Georgia Midyear Meeting on Jan. 9, 2009, the Litigation Committee, chaired by Wilson White, provided a seminar related to ethics in intellectual property prosecution and litigation.

The panel included David Hricik (Mercer Law School) (shown right) and David Stewart (Alston & Bird) (shown left), along with Scott Brient (Alston & Bird), Candace Decaire (Kilpatrick Stockton). Jennifer Liotta (Alston & Bird) provided a summary of the rules and Tiffany Williams (Kilpatrick Stockton) moderated the panel.

The panel discussed various ethical scenarios and recent case law relevant to intellectual property practice. You can view Dr. Hricik's recent article entitled "Conflict & Liability in Patent Practice" at <http://www.hricik.com/AIPLA.pdf>.

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Ten Technology Questions Lawyers Should Ask

By Chad Graves
Graves Technology

Technology is becoming more important to lawyers. There was a time not long ago when attorneys relied solely on paper files, legal pads, and the telephone. When a client called at four in the afternoon on Tuesday, a return call at eight in the morning on Wednesday was considered timely. Those days are gone.

With the advent of electronic mail, laptop computers, servers, the Internet, and “smart phones” such as the iPhone® and Blackberry® handheld devices, providing a response the next day is no longer acceptable. Many clients expect an e-mail sent or phone call made to their attorney at ten in the evening to be answered within minutes. Attorneys today must have instant access to electronic files, correspondence, and colleagues. Information technology makes this possible. Information technology gives attorneys the “freedom” to work anywhere, any time, in or out of the office. Information technology can even allow attorneys to work in a more environmentally friendly manner, as electronic records are increasingly taking the place of paper files. Attorneys today who do not understand and embrace information technology find themselves unable to provide the level of service that today’s client demands.

With this new dependence upon technology, there are questions that every attorney should ask of their information technology staff. While sending an e-mail on a Blackberry® device can seem simple, information technology is often a difficult issue to understand and control. The interrelationships between servers, networks, IP addresses, packets, and databases can be difficult to understand. Some attorneys practicing today went to college before the age of the Internet and did not have the benefit of information technology courses. However, those same attorneys may worry about issues such as data security, system compatibility, and electronic data liability. With that in mind, here are ten questions every lawyer should ask their firm’s information technology specialist.

Question One: Are you taking advantage of Microsoft Exchange Server®?

The Microsoft Exchange Server® product is a messaging, calendaring, and collaboration software product that facilitates a central exchange for e-mail, calendars, contacts, and tasks. Exchange allows attorneys to collaborate with colleagues and staff at their firm by sharing e-mail, calendars, contacts, and tasks. Exchange also provides “Public Folders” which give attorneys a central repository for sharing Outlook folders.

The Exchange product is a viable option for both large and small firms. Solo practitioners and small firms may think Exchange is expensive or difficult to implement. However, Microsoft Windows Small Business Server™ offers Exchange functionality at a reasonable cost. Further, many third-party service providers are now offering Hosted Exchange solutions that require no information technology hardware or software capital investment.

Question Two: What are you doing about spam?

Nothing is more frustrating than an e-mail inbox that is clogged with junk e-mail and spam. However, there are solutions available to mitigate this issue. Numerous companies offer services that will filter your e-mail for unwanted messages and viruses before they hit your mailbox. To ensure that an important e-mail is not accidentally marked as Spam, these companies will send a weekly or bi-weekly report identifying which messages were flagged to give the attorney the opportunity to un-flag non-spam e-mail.

Question Three: Why are you still on DSL?

Many companies now offer T1 services at comparable rates to yesterday’s DSL. Upgrading to a T1 will provide a more stable connection and allow you to utilize a more remote workforce.

Question Four: What are you doing about backups?

Did you know that studies have shown approximately eighty percent of small businesses fail after a loss of data from a disaster. In the practice of law, it is conceivable that a catastrophic loss of data could even result in a malpractice claim. Files should be backed up daily, both on-site and off-site. Copies of back-up files should be moved offsite.

Question Five: Is your network protected?

A firewall is a device that must be installed in every network. Firewalls block unwanted traffic from entering your network and can also block certain traffic from leaving. Ask your information technology expert what types of firewalls are in place at your firm.

Question Six: Are your desktops protected?

Without question, all computers should be receiving regular Windows and Antivirus updates. One virus can disrupt the performance of many computers. Billable hours are quickly lost when partners and associates are unable to work due to computer related down time. Another way to ensure the privacy of your data is to “lock” your computer when you leave or step away.

Question Seven: Are you utilizing multiple monitors?

Stop printing those documents! How many attorneys do you know who print reams of paper because they do not like flipping through multiple windows on a computer? Most all modern desktop and laptop computers provide the capability of using multiple monitors to view files. Make use of a second or a third monitor will save time, save money, and save a tree.

Question Eight: Why do you still have a paper calendar?

When you lose a paper calendar, you lose everything. When you lose a properly configured smart phone, you lose the tool but not the data. When used in conjunction with Microsoft Exchange Server® functionalities, Windows Mobile® software, Blackberry® devices, or even the new iPhone® devices, electronic calendars allow the remote synchronization of email, calendar, contacts and tasks.

Question Nine: Are you sending confidential information via email?

New regulations are coming that could prevent anyone from sending certain types of confidential information through email. This will require firms to adopt new portal technology to allow external users to retrieve their sensitive data on demand. Is your information technology department prepared?

Question Ten: Are you wasting time troubleshooting tech issues?

Your time is too valuable! A proficient technology provider will

be able to free your time and ensure that all of the above items are being addressed. Make sure that you have the support you need to bill hours, not troubleshoot e-mail. ●

Chad Graves is the founder of Graves Technology, a technology consulting firm that implements small and large computer networks for its clients. Graves Technology's objective is to translate an increasingly complex technical language into a business-oriented dialogue. Graves Technology concentrates on communicating in a fashion understandable to its clients. Graves Technology prides itself on listening to client needs, and sharing its knowledge as it implements and manages the client's information technology network.

IP in Pictures, News & Notes



Steve Hill and Andrew Crain at the Section Open House.



Joe Beck and Arvind Reddy at the Section Holiday party.



Thad Kodish, Ben Thompson, and Darin Bielby at the IP Holiday Party.



David Lilenfeld, Ann Fort, Darcy Jones, and Wilson White at the presentation on standing and pre-suit considerations.

USPTO 2008 Fiscal Year-End Results

The USPTO released fiscal year-end numbers that they say met or exceeded its patent pendency, production, and quality targets. USPTO's FY 2008 Performance and Accountability Report can be found at www.uspto.gov/web/offices/com/annual/2008/2008annualreport.pdf. A few of the available statistics are provided.

- Fourteen percent more patent applications were examined in FY 2008 as compared to FY 2007.
- A record number of utility patent applications were filed electronically (332,617), achieving a record rate (72.1 percent) of all applications.
- Patent applications had an average first action pendency of 25.6 months and an average total pendency of 32.2 months.
- The total number patent application filings through the Accelerated Examination Program reached 1,765. A 12-month or less pendency rate was also maintained for these applications, with an average time to final action or allowance of 186 days (six months).

USPTO Issues Clarification re Appeals and Interferences

The USPTO has issued a clarification on a final rule that amends the rules governing practice before the Board of Patent Appeals and Interferences (BPAI). The rule took effect on December 10, 2008. The final rule applies to all appeals in which an appeal brief is filed on or after this effective date.

The Office recently discovered that several appeal briefs had been filed in the new required format but they were held to be non-compliant because they were filed prior to the effective date of the new rule. This was not the intent of the rule, so appellants who have received such a notice may request it be withdrawn, so long as the sole reason for noncompliance is that the appeal brief was presented in the new format.



Joe Beck and Miles Alexander at the Section Open House with a portrait of other of Kilpatrick's leaders in the background.



Andrew Crain and Lauren Estrin. . .



. . .Clovia Hamilton and Stacy Harris enjoy the Section Holiday party.

Letter from the Editors

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

This newsletter marks a significant transition as we turn from 2008 to 2009. Amid the recent elections and economic turmoil, the IP Section has continued with its many activities. We have offered many informative CLE seminars, including the IP Symposium, and have hosted, along with the Atlanta Bar IP Section, a well-attended holiday party at the Four Seasons in December 2008. We look forward to continuing the same pace in 2009.

We are turning the calendar at the Section website as well by updating the pictures and calendar of activities. We encourage you to visit our website at www.georgiaip.org and to visit it often, so that you know when events are happening and attend them whenever you are available. Some of the events on the calendar are section events and others are non-section events. There are also podcasts available for downloading. We continue to encourage you to let us know if there are events or activities we need to include on the calendar for 2009.

Many thanks go to all who contributed in 2008 to the Communications Committee activities. Wab Kadaba of



Tina Wililams McKeon and Alison Danaceau prepare the newsletter.

Kilpatrick Stockton has been a very supportive and enthusiastic Section Chair. We are also grateful for the contributions of the Communications Committee members. Chris Glass (Morris Manning & Martin), Chris Curfman (Needle & Rosenberg), Bob Neufeld (King & Spalding), 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. We look forward to working together in 2009.

As you welcome in the new year, we hope that you read and enjoy the substantive content to this newsletter. We thank the contributors and encourage you as the readers to provide us with any feed-back you may have. Please send any articles you would like us to include in the Spring/Summer 2009 newsletter.

To all of us, as well as our clients, families and friends, we wish a prosperous year. ●

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