STATE BAR OF GEORGIA

INTELLECTUAL PROPERTY LAW SECTION
NEWSLETTER

W. Scott Petty, Chair | Fall 2001 | Schuyla Goodson-Bell, Editor

CHAIR'S COMMENTS

W. Scott Petty,
King & Spalding
Atlanta, GA

Thanks to the hard work and dedication of its members, our section continues to offer quality educational programs and friendly social events for the State's intellectual property community. Your Executive Committee for the State Bar year 2001-02 seeks to expand upon the success enjoyed last year under the leadership of our outgoing Chair, **Greg Kirsch**. In recognition of his outstanding service to the Section as Chairperson and member of the Executive Committee, I congratulate Greg for a job "well done!"

Building on the excitement of last year's CLE seminar in Costa Rica, the Section hosted the 7th annual IP Law Institute in Puerto Vallarta, Mexico on November 9-13. Over 70 Section members had fun in Puerto Vallarta while learning about recent developments in patent, trademark, copyright and licensing law. By scheduling this year's Institute jointly with the 13th Annual Southern Regional Entertainment & Sports Law Seminar, our members had the opportunity to mix with fellow E&S Law members while attending a day of combined IP and E&S law seminars and two days of programs focusing on IP law. Thanks to our speakers and attendees for excellent programs and a great time in Puerto Vallarta! We also appreciate the financial support and participation of our sponsors, InteCap, Thomson & Thomson and Kessler International.

Our committees are actively scheduling events on your behalf for the Fall and Winter months. Thanks to the efforts of **Griff Griffin** and the Patent Committee, the Section has hosted several Patent Roundtables covering a variety of patent law topics. Our Trademark Committee, headed by **Art Gardner**, has worked with **Michael Hobbs** and **Judy Dray** to coordinate our Section's sponsorship of "The Trademark Office Goes eGovernment," featuring a presentation on October 31 by Commissioner for Trademarks Anne H. Chasser. **Frank Landgraff**, Chair of our Licensing Committee, is working with the local chapter of the Licensing Executive Society (LES) to reschedule the planned September 12 presentation by the LES President on technology licensing trends. On behalf of our Copyright Committee, **Judy Dray** is planning a

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Spring 2002 luncheon featuring the Honorable Stanley Birch. **Todd McClelland**, Chair of our Social Committee, is busily making plans for a holiday function in early December. Also, please plan to join us at the Mid-year State Bar meeting in Atlanta on January 11, 2002 to attend a Section luncheon and an afternoon of IP CLE programs.

Most importantly, we want to work for you and offer programs and activities that will benefit you, your fellow members of the Section and the Bar. In this regard, we invite your suggestions, comments and support. In the event that you wish to contribute in a volunteer capacity, I encourage you to contact me or any member of the Executive Committee. I look forward to seeing you at a Section event. ◆

EDITOR'S COMMENTS

Schuyla M. Goodson-Bell
Troutman Sanders LLP
Atlanta, GA

I am excited about having the opportunity to serve the Intellectual Property Section as the Newsletter Editor for *A NOVEL EXPRESSION OF CONFUSION*. Despite several warnings about the challenges of publishing a newsletter, my experiences thus far have been great. I've had the opportunity to meet phenomenal members of the Bar and want to emphasize that this newsletter is "OURS." I use the word "OURS" because the success of this Newsletter is directly related to your submission of articles, commentaries, forthcoming events, and meetings and activities. In that spirit, I extend special thanks to Lesley Smith, Scott Petty, Jeff Kuester, Art Gardner, Doug Isenberg, Griff Griffin, Judy Dray, Frank Landgraff, Julie Sinor, Joan Dillon, Lisa Stinson, Sandy Evans, Andrew Noble, Jeff Brown and Lawrence Rosen for all their help in making this first edition a success.

In an effort to learn more about our diverse membership, *A NOVEL EXPRESSION OF CONFUSION* will spotlight "Women in Intellectual Property in Georgia" in an ongoing series of interviews with women IP practitioners through 2002. This edition of the Newsletter also includes: a 2001 member questionnaire that I encourage you to complete and return to my attention; reports from section committee chairs; two patent articles; a calendar of events; and Executive Committee contact information. Thanks to Jason A. Bernstein who initially prepared a similar member questionnaire in 1996.

Finally, I want to strongly encourage new members of the section to get involved. Feel free to contact me with your ideas, suggestions, topics of interest and of course articles and commentaries via email at schuyla.goodson@troutmansanders.com; via fax at 404-962-6572, via telephone at 404-885-3289 or by mail at Troutman Sanders LLP, 600 Peachtree Street NE, Suite 5200, Atlanta, Georgia 30308. ◆

Schuyla M. Goodson-Bell is a senior associate in the Intellectual Property Practice Group of Troutman Sanders LLP in Atlanta, Georgia. She earned her J.D. from Georgetown University Law Center in 1992. Prior to joining Troutman, Schuyla spent 3 years as a Trademark Examiner with the USPTO. She currently advises clients on the complexities associated with domestic and international trademarks, domain names, establishing a presence on the Internet and the impact of new technology on Intellectual Property portfolios.

SPOTLIGHT ON WOMEN IN INTELLECTUAL PROPERTY IN GEORGIA

Schuyla M. Goodson-Bell
Troutman Sanders LLP
Atlanta, GA

The forthcoming ongoing series of interviews focusing on women intellectual property attorneys in Georgia promises to be informative, enlightening and thought provoking. The women selected for this series come from exciting and diverse backgrounds. Some women started practicing law with law firms while others have solely practiced law in-house. There are women who have worked part-time and others who have only worked full-time. There are women who are managing successful practices with and without children. There are women who are divorced, single, and those who are married. There are women who are junior associates and others who are partners. There are women who created Intellectual Property Departments for large corporations and others who are using their expertise to educate, train and

advise others on the importance of brand recognition. There are women who are engineers, former USPTO examiners, scientists, artists, teachers, wives, mothers, grandmothers and single parents. There are also women who have invaluable years of IP experience and those who are just beginning their careers.

In 1992, an American Bar Association Commission on Women in the Profession Report stated that the association's intellectual property law section was one of only six sections with no women officers in its last term and the only one to have had no women on its governing counsel in the previous year. According to the State Bar of Georgia, an estimated 23% of the IP section's 2001 members are women. Although no one factor points to the increased number of women practitioners, certainly the information age and technology boom have helped transform the intellectual property arena. Today, Georgia women lawyers have become prominent players in the field of intellectual property. I hope you will be just as inspired as I have been at the end of this series. If you know of a woman who should be featured in our forthcoming series please feel free to forward their name and contact information to schuyla.goodson@troutmansanders.com.

SUMMARY REVIEW OF THE AUGUST PATENT QUARTERLY ROUNDTABLE

Andrew Noble
Troutman Sanders LLP
Atlanta, GA

Discussion Topic: "The Non-Infringement Opinion: Is it really effective in avoiding treble damages?"

The patent quarterly roundtable convened at the offices of Troutman Sanders LLP on August 29, 2001 for a discussion entitled, "The Non-Infringement Opinion: Is it really effective in avoiding treble damages?" The roundtable discussion focused on the circumstances in which a non-infringement opinion is most effective for disproving willful patent infringement and, as a result, for avoiding treble damages. The roundtable opened with a presentation divided into two major sections. The first section addressed various non-infringement opinion uses including minimizing a client's potential liability by assessing whether a court would find that the client's product infringes an issued patent. The second section addressed improving the legal effectiveness of non-infringement opinions from a damages mitigation standpoint, including recommendations on who should prepare an opinion, the timing for opinion preparation and opinion drafting recommendations.

The legal rules pertaining to patent infringement damages provided the framework for the first section of the presentation. When a court finds that a patent has been infringed, several factors are considered in the calculation of monetary damages. In particular, courts will consider whether the infringer willfully, or knowingly, infringed the rival patent. The test for willful infringement involves looking at all the circumstances that led the infringer to infringe the rival patent, but is based on the actual knowledge of the infringer, not the actions of the rival patent holder. Actual notice, which includes cease and desist letters, licensing offers and other attempts by the rival patent holder to inform the potential infringer, triggers a duty of care for notified persons to avoid infringing the rival patent. If a court finds that a patent has been willfully infringed, meaning the infringer has failed to satisfy this duty of care, the damages awarded to the patent holder could treble exponentially. A competent non-infringement opinion can be evidence that an infringer sought to exercise due care, and thus, can be a positive tool for avoiding treble damages. According to current law, a "competent" non-infringement opinion should give a client a reasonable belief that a court would hold a rival patent invalid, not infringed or unenforceable with respect to the client's product.

After the introduction of the legal concepts, the roundtable presentation continued with a discussion of additional reasons why business professionals would want to consider investing in non-infringement opinions for their product ideas. The treble damages presentation made it clear that while there are no hard and fast rules to prevent a finding of willful infringe-

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(Summary Review of the August Patent Quarterly Roundtable, continued from page 3)

ment, the non-infringement opinion represents a key component in damages mitigation strategy. In addition to damages mitigation, a non-infringement opinion can be used strategically in preparation for a patent infringement trial. Furthermore, non-infringement opinions can also be used for measuring a client's chances for success and for making decisions on whether or not to settle a case before going to trial. Even prior to a trial situation, non-infringement opinions can be used for product risk assessment before a client enters a new market and for helping product engineers to design around a rival patented invention.

The second section of the presentation focused on strategies for making non-infringement opinions more effective legal documents. Legal practitioners at the roundtable were presented with suggestions for when and how, from a litigation strategy point of view, a non-infringement opinion should be prepared for the maximum positive impact. Various court decisions were cited in support of the recommendations. For example, case law indicates that the timing of when a non-infringement opinion is prepared should depend on how the document will be utilized. A non-infringement opinion prepared for trial is not as effective as an earlier prepared opinion as evidence for disproving willful infringement because an earlier prepared opinion provides more convincing evidence of an infringer's attempt to exercise due care.

For maximum positive impact, non-infringement opinions should be prepared by outside counsel patent attorneys. Ideally, these patent attorneys should be skilled in the scientific or engineering field corresponding to the rival patent's subject matter. A written opinion should be prepared that clearly indicates, by description or summary, that the patent attorney has a full understanding of the proposed product and the rival patent. Conversely, non-infringement opinions prepared by in-house attorneys, non-patent attorneys, patent agents or patent attorneys not skilled in the relevant technical arts have a negative impact on the perceived legal competency of the opinion. Client influence in the preparation of non-infringement opinions also has potentially adverse effects for damages mitigation.

The practitioner related portion of the presentation also included a discussion of non-infringement opinion drafting formalities, particularly the basics of good legal opinion writing. Drafters should refrain from using sweeping, general or blanket statements, particularly in an opinion's conclusion. The non-infringement opinion should be confidential and addressed to the client. Structurally, there should be client-reviewed summary indicating the practitioner's full understanding of the proposed product and a discussion of relevant patent infringement case law. The analysis section should be divided into two subsections. Initially, there should be a literal infringement analysis wherein the product under consideration must contain each element of a claim from the rival patent to infringe. Next, there should be a doctrine of equivalents analysis wherein the product under consideration can infringe the rival patent if it contains the equivalent of each element of a claim. While the details of the legal "doctrine of equivalents" were beyond the presentation's scope, the client should know that their product could still infringe a rival patent, and treble damages could still be awarded, if there are no functional differences between their product and the claims of the rival invention.

The roundtable presentation concluded with a discussion on the potential impact of recent changes in patenting procedure, specifically, the new early publication rules for pending applications. At present, it is not easy to tell what the ramifications of the recent rule changes will be, but they will certainly be a factor in how future non-infringement opinions are drafted and utilized in court. These recent patent law changes and a series of sample court decisions provided a focal point for the subsequent roundtable discussion that sought to establish an effective strategy guide for the use of non-infringement opinions in damages mitigation. From the presentation, it was apparent to the roundtable that many factors can influence the effectiveness of non-infringement opinions for avoiding treble damages.

The patent roundtable meets quarterly to discuss relevant patent law practice topics. For further study on the effective use of non-infringement opinions for limiting monetary damages awards, there are several authoritative articles that compliment and provide depth to the roundtable presentation subject matter. They include: The Perils of Practitioners Penning Patent Opinions, Protecting Privileges, Preventing Production, and other Ponderous Problems, Doug Salyers, Practising Law Institute, Patent Litigation

2000 (619 PLI/Pat 955); Enhanced Damages in Patent Cases: Willfulness and Opinions of Counsel, Charlene M. Morrow and Brent K. Yamashita, Practising Law Institute, Patent Litigation 2000 (619 PLI/PAT 887); Understanding Willfulness in Patent Infringement: An Analysis of the "Advice of Counsel" Defense, Shashank Upadhye, Texas Intellectual Property Journal, Fall, 1999 (8 Tex. Intell. Prop. L.J. 39); and The Unpredictable Scope of the Waiver Resulting from the Advice-of-Counsel Defense to Willful Patent Infringement, Jared Goff, Brigham Young University Law Review (1998 B.Y.U.L. Rev. 213) ◆

LICENSING COMMITTEE REPORT

Frank A. Landgraff, Committee Chair
The Coca-Cola Co.
Atlanta, GA

Purpose

The purpose of the Licensing Committee is to create a forum within the IP Section where members can receive new or important information and education relating to IP licensing and interact on an informal basis with other members of the IP Section on topics such as best practices in IP licensing.

Past Activities and Future Goals

The Licensing Committee has only been an active committee for the past couple of years. The Committee has focused on member education and informal interaction amongst members. The Committee has historically presented one or two presentations at the annual IP Institute. Additionally, the Committee has two or three annual events (typically in Atlanta) where a leader in the area of IP licensing speaks on a variety of important licensing issues. These two or three annual events are generally scheduled as luncheon presentations to allow for more member interaction and participation.

In the future, the Committee will continue to coordinate and support the activities as mentioned above. I am hopeful that with future presentations we may also be able to have the luncheon meetings CLE accredited. The Committee welcomes anyone that is interested in IP licensing to join and appreciates member suggestions as to future conference or luncheon topics. ◆

COPYRIGHT COMMITTEE REPORT

Judy Dray, Committee Chair
Greenberg Traurig
Atlanta, GA

The Copyright Committee is planning several events for 2002 including the Spring Luncheon featuring the Honorable Stanley Birch from the U.S. Court of Appeals for the 11th Circuit. ◆

TRADEMARK COMMITTEE REPORT

Arthur A. Gardner, Committee Chair
Gardner, Groff, Mehrman & Josephic, PC
Marietta, GA

The Trademark Committee is planning several Social Events in 2002 as well as a substantive presentation which may include CLE credits. ◆

PATENT COMMITTEE REPORT YEAR IN REVIEW

Griff Griffin, Committee Chair
Alston & Bird LLP
Atlanta, GA

The Patent Committee would like to report the completion of another successful year in 2001. Most recently, the Patent Committee held its final Roundtable discussion of the year on October 12, 2001. The topic was "EPO Software Guidelines and Strategy", and the event was sponsored by Sutherland Asbill & Brennan LLP. This was the sixth Roundtable in 2001, and the eleventh Roundtable held within the last two years. Some of the topics covered by recent Roundtables include Non-Infringement Opinions,

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(Patent Committee Report Year in Review, continued from page 5)

Festo, Markman Hearings, International Oppositions, the Inventors Protection Act, and Business Method Patents. The Patent Committee would like to recognize the following firms that sponsored recent Roundtables: Morris Manning & Martin, Thomas Kayden, King & Spalding, Merchant & Gould, Alston & Bird, Kilpatrick Stockton, Finnegan Henderson, and Troutman Sanders. The Patent Committee is already planning its Roundtable schedule for 2002, which includes a half-day CLE seminar. If a firm is interested in sponsoring a Roundtable discuss in 2002, please contact me at the number or e-mail address provided below.

In addition to the Roundtables held this past year, the Patent Committee sponsored an IP Summer Associate Social at the Park Tavern where several local practitioners spoke to a group of summer associates about the practice of intellectual property law in the city of Atlanta. This event was a huge success, and will undoubtedly become an annual event.

The Patent Committee also participated in the planning of the 7th Annual IP Institute, particularly with regard to the patent-related presentations. As with last year's IP Institute held in Costa Rica, this year's IP Institute included speakers on a number of patent-related topics, including the CAFC Patent Year in Review, Deposing a Patent Damages Expert and IP Due Diligences. We hope that those in attendance found the topic informative and useful, and we encourage member input as to topics for future IP Institutes.

The success of the Patent Committee is largely due to the participation of the Committee members. The Committee members for 2001-2002 include: David Kerven, Patrick Elsevier, John Hamann, Kean DeCarlo, Kristin Johnson, Kristin Mallatt, Mark Seigel, Michael Turton and Wab Kadaba. As Chair of the Patent Committee, I personally wish to thank each and every member for their contribution to the Committee over the past year, with particular gratitude to Wab Kadaba for his involvement in a number of events. If someone would like to join the Patent Committee, please contact me at (404) 881-7832 or via email at *ggriffin@alston.com*. ◆

JOINT STUDY COMMITTEE REPORT

Jeffrey R. Kuester
Thomas, Kayden, Horstemeyer & Risley, LLP
Atlanta GA.

A Joint Study Committee has been formed by the Intellectual Property Law Section and the Technology Law Section of the State Bar of Georgia. The Joint Study Committee has been studying SB 214, the Georgia Database Protection and Economic Development Act, which was passed by the Georgia Senate earlier this year.

The purpose of the Joint Study Committee is to fully evaluate the legislation and any proposed amendments in order to make recommendations to the leadership of the Sections regarding a planned proposal to the State Bar Advisory Committee on Legislation. In this regard, the Joint Study Committee is interested in hearing your opinion regarding this legislation and whether the State Bar should support or oppose the legislation in any form, including amendments that address federal concerns.

Of course, your opinion would be most effectively considered if you would be willing to join the Joint Study Committee and work with us to fully consider the various issues surrounding this legislation. In addition, we will be organizing further discussion of this legislation in the near future.

Please contact me if you are interested in joining the Joint Study Committee or if you have any other comments or concerns regarding this legislation at (770) 933-9500 or via email at *jeff.kuester@tkhr.com*. ◆

INTELLECTUAL PROPERTY LAW SECTION TREASURER'S REPORT

Doug Isenberg, Section Treasurer
GigaLaw.com
Atlanta, GA

The Intellectual Property Law Section of the State Bar of Georgia, which enjoyed tremendous growth throughout the 1990s, remains a very strong section in the new millennium. As of September 4, 2001, the IP Section has 776 members. Although this figure is slightly below the 2000-01 fiscal year's high of 803 members, the section typically adds members as the year progresses — so the IP Section's ranks could swell to another record high before next spring!

For comparison, the IP Section ranks 11th in size among the State Bar's 33 sections. The Technology Law Section (formerly known as the Computer Law Section) and the Entertainment & Sports Law Section — each of which attracts many members who also join the IP Section — have 622 and 433 members, respectively. The largest section is the General Practice & Trial Section (2,084 members), and the smallest is the Agriculture Section (47 members).

As of August 31, 2001, the Intellectual Property Law Section has a fund balance of $38,503.56, although this amount includes deposits from sponsors of the section's annual Intellectual Property Law Institute, which will be spent to subsidize events at the November program in Puerto Vallarta, Mexico. The section also spends funds for educational programs, social events, pro bono activities, the website (*http://www.georgiaip.org/*) and this newsletter, among other things.

Membership dues for the Intellectual Property Law Section have not been increased this year and remain at $25 per fiscal year (July 1-June 30). (For those who join after January 1, dues are half price.) Dues notices for the 2001-02 fiscal year were sent out in April. If you have not renewed your membership or you know someone who wants to become a member, here's all you have to do:

- Send a check for the proper amount ($25 between July 1 and December 31; or $12.50 between January 1 and June 30), payable to the "State Bar of Georgia"
- Indicate that the check is for membership in the Intellectual Property Law Section
- Include your name, state bar number and mailing address
- Send the check and above information to: State Bar of Georgia, Membership Department, 800 The Hurt Building, 50 Hurt Plaza, Atlanta, Georgia 30303

If you have any questions or comments about membership in the Intellectual Property Law Section or this treasurer's report, please contact Doug Isenberg, treasurer, by phone (404-256-0610) or e-mail (*disenberg@GigaLaw.com*).

Doug Isenberg is treasurer for 2001-02 for the Intellectual Property Law Section of the State Bar of Georgia. An attorney who practices intellectual property and Internet law in Atlanta, Doug is also the founder and publisher of GigaLaw.com.
E-mail: disenberg@GigaLaw.com ◆

U.S. SUPREME COURT LIMITS TRADE DRESS PROTECTION TO NON-FUNCTIONAL PRODUCT FEATURES

Arthur A. Gardner
Gardner, Groff, Mehrman & Josephic, PC
Marietta, GA

It seems that the steady expansion of trade dress rights allowed by the federal courts in recent years has stopped and the pendulum is starting to swing back in the other direction. Most laymen and some lawyers are not familiar with the term and would ask what is "trade dress?" Trade dress is the distinctive packaging or overall image of a product that, in some circumstances, comes to operate as a designation of source, much like a trademark. At one time, trade dress referred only to how a product was packaged and marketed. In more recent years, this has been expanded to include the product configuration itself (e.g., the shape of the product). Over the years, courts have expanded the protection afforded to trade dress, to the dismay of some commentators.

On March 20, 2001 the United States Supreme Court handed down an important decision in trademark and trade dress law in Traffix Devices, Inc. v Marketing Displays, Inc., 121 S. Ct. 1255, 2001 U.S. Lexis 2457, 58 USPQ2D 1001 (2001). A *unanimous* Supreme Court held that where a party asserts unregistered trade dress rights (which are akin to trademark rights under the law) in features of a product which were claimed in an expired utility patent, the party asserting the trade dress rights has a **heavy burden** to show that the features are not functional in order to be afforded the protection of trade dress. The Court stated:

A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. (emphasis added)

In determining whether a product feature is functional, the Court pointed out that, contrary to the decision by the lower court (the Sixth Circuit Court of Appeals), a feature is functional if exclusivity in the feature would put competitors at a significant non-reputation-related disadvantage. The Court took pains to point out, however, that this does not mean that the feature has to be a "competitive necessity" in order to be functional. Rather, the Court noted that a feature is functional when any of the following is true:

1) it is essential to the use of the article, or
2) it is essential to the purpose of the article, or
3) it affects the cost of the article, or
4) it affects the quality of the article.

The Court was not impressed with efforts to turn functional features into valid trademarks or trade dress by extensive use or advertising, stating:

The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

Some intellectual property lawyers had expected the Supreme Court to apply a rigid *per se* rule barring trademark or trade dress protection whenever there exists a utility patent claiming the feature now asserted as a trademark or trade dress. However, the Supreme Court stopped short of applying a rigid per se rule, apparently finding it unnecessary to do so in light of the rather remote possibility that a trademark or trade dress could be held to be valid under such circumstances following the Supreme Court's rationale. In this regard the Court said:

> If, despite the rule that functional features may not be the subject of trade dress protection, a case arises in which trade dress becomes the practical equivalent of an expired utility patent, that will be time enough to consider the matter.

The Supreme Court has, in handing down this decision, made a subtle but important change in the law regarding the interplay between patents and trademarks. Courts **in the past** had looked to the following factors in evaluating whether a product feature is functional and therefore ineligible for trademark protection:

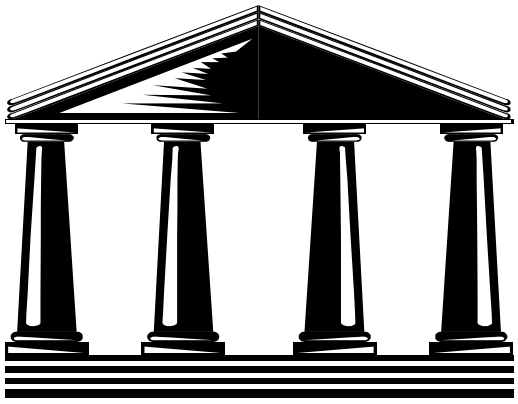
1. The existence of a utility patent disclosing the utilitarian character of the feature;
2. The existence of advertising or promotion touting the functional and utilitarian advantages of the feature;
3. The existence of alternative designs that perform the utilitarian function equally well; and
4. Whether or not the feature results from a comparatively simple, cheap or superior method of manufacturing the article.

In re Morton Norwich Products, Inc. 671 F.2d 1332, 1340-41 (C.C.P.A. 1982); Disc Golf Association, Inc., v. Champion Disks, Inc., 158 F.3d 1002, 1006 (9th Cir. 1998). However, the new decision by the Supreme Court makes clear that the third of these four factors no longer is relevant except in cases involving "aesthetic functionality" (where a competitor needs to copy a look in order to effectively compete). The Supreme Court stated in Traffix that when a design is functional because it is essential to the use or purpose of the device or when it affects the cost or quality of the device, "there is no need to proceed further to consider if there is a competitive necessity for the feature." Thus, the courts now should look to the following factors to evaluate whether the mark is functional:

1. The existence of a utility patent disclosing the utilitarian character of the feature (which constitutes "strong evidence" of functionality);
2. The existence of advertising or promotion touting the functional and utilitarian advantages of the feature; and
3. Whether or not the feature results from a comparatively simple, cheap or superior method of manufacturing the article.

CONCLUSION

The pronouncement by the Supreme Court signals that the pendulum is swinging back in the other direction, toward a more restrictive view of the availability of trade dress or trademark protection for product features and configurations. One can expect district courts and courts of appeals to take their cue from the Supreme Court and therefore be more cautious about expanding trade dress rights in the future. For clients, this means that a careful evaluation should be made of what types of protection are available for a product and its packaging. If the feature can be patented, one should do so for courts are unlikely to find patentable features to be the proper subject matter for trade dress protection in the future. ◆



CALENDAR OF EVENTS

IP Law Section Holiday Party
December 13th, from 6:30 p.m. - 9:00 p.m.
Coohill's - 1100 Peachtree Street NE, Atlanta, GA
Check out http://www.coohill.com/coohills/ for directions.

Mid-year State Bar Meeting
Section Luncheon
IP Best Practices CLE
January 11, 2002
12:00 Noon - 1:30 pm

IP Law Updates/CLE Program
Trademark, Copyright and Patent Law Updates
January 11, 2002
1:30 - 4:30 pm
3 hours CLE credits
Swissotel, Atlanta, GA
contact Scott Petty for further details

IP Social Events
End of January, 2002 & March, 2002
Location TBA

Patent Roundtable
February 7, 2002 - 11:45 am,
Alston & Bird,
43rd floor, One Atlantic Center,
1200 West Peachtree Street.
Atlanta, GA
Topic "Understanding The On-Sale Bar,"
presented by Jeff Young
Pre-registration is required

Licensing Event
February 2002
Check out http://www.georgiaip.org for further details or contact Frank Landgraff

Copyright Luncheon Meeting
March 20, 2001-12:00 Noon-2:00 p.m.
Four Seasons Hotel
Atlanta, Georgia
The Honorable Stanley Birch
Check out http://www.georgiaip.org for further details or contact Judy Dray

Patent Roundtable/CLE
March 2002-11:45 a.m.
Pre-registration is required
Check out http://www.georgiaip.org for further details or contact Griff Griffin

Summer Associate Cocktail Party
June 6, 2002
Check out http://www.georgiaip.org for further details. ◆

2001 IP CASES OF INTEREST

Jeff Brown
Kilpatrick Stockton LLP
Atlanta, GA

Trademark Law

- *TCPIP Holding Co., Inc. v. Haar Communs. et al*, 244 F.3d 88 (2d Cir. 2001).
- *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372 (E.D. Pa. 2001).
- *Dial one of the Mid-South, Inc. et. al. v. BellSouth Telecomms.*, 2001 U.S. App. LEXIS 22481 (5th Cir. 2001).
- *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001).

Copyright Law

- *A&M Records Inc. v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001).
- *Lois B. Morris v. Bus. Concepts, Inc.*, 259 F.3d 65 (2d Cir. 2001).

Patent Law

- *Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041* (Fed. Cir. 2001).
- *Amazon.com, Inc. v. Barnesandnoble.com*, 239 F.3d 1343 (Fed. Cir. 2001).
- *Bayer AB v. Housey Pharms. et al*, 2001 U.S. Dist. LEXIS 17905 (D. Del. 2001).

Domain Name/E-Commerce

- *Harrods Ltd. v. Sixty Internet Domain Names*, 157 F. Supp. 2d 658 (E.D. Va. 2001).
- *Ford Motor co. v. Texas Dept. of Transp.*, 264 F.3d 493 (5th Cir. 2001).
- *Shields v. Zuccarini*, 254 F.3d 476 (3rd Cir. 2001).

GEORGIA STATE BAR IP LAW SECTION EXECUTIVE COMMITTEE 2001-2002

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