



State Bar of Georgia

Intellectual Property Law Section

GRIFF GRIFFIN, CHAIR

OCTOBER 2006

ALISON DANACEAU AND HUNTER YANCEY, EDITORS



Note From the Chair

by Griff Griffin
Sutherland, Asbill & Brennan

Mark your calendars! We are a month away from our 12th Annual IP Institute, which will take place in Cancun, Mexico, Nov. 2-6. Currently more than 140 lawyers from the Intellectual Property Law Section and the Entertainment and Sports Law Section have signed up for this event. We have assembled an outstanding slate of presentations that provide 12 CLE hours, including one ethics hour, one professionalism hour, and three trial practice hours. If you have not registered, please do so soon because we have only a limited number of hotel rooms still available. Many thanks to our sponsors for this year's IP Institute, which include Gold Level sponsors Greg Aharonian and Computer Packages, Inc. (CPI), and Silver Level sponsors IPinvestments Group, LLC; Miller Ray Houser & Stewart, LLP; Navigant Capital Advisors, LLC; and PatPro, Inc. These sponsors were all secured through the hard work of Steve Wigmore, Greg Kirsch and Brad Groff, to whom the Section owes a great deal of gratitude.

The Section held its second annual Open House on Sept. 28. There was a great turnout for this event. If you were unable to attend but would like to participate in one of our committees, or are interested in speaking opportunities, please contact the appropriate committee chairs listed on page 6. The Section wishes to thank King & Spalding for once again providing the location and refreshments, and in particular, Shane Nichols, the social chair of the IP Law

Section, for his effort in organizing this event.

The Section's Patent, Copyright and Trademark Boot Camp was held the next day on Sept. 29. This full-day event was directed to both new attorneys and attorneys new to the practice of intellectual property law. Patent Committee Chair Philip Burrus and Trademark Committee Chair Brad Groff organized the boot camp. Brad also arranged for Lynne G. Beresford, commissioner for Trademarks at the United States Patent and Trademark Office, to give an update on current happenings at the Trademark Office at the Bar Conference Center on Oct. 3.

The Section is planning a one-hour CLE luncheon at the State Bar Midyear Meeting in Savannah. The luncheon will take place on Jan. 19, and the topic is "IP Law and Its Impact on Business Deals." The speakers at this event will be Shane Nichols and Brad Groff. Please sign up for this event if you are planning to attend the State Bar's 2007 Midyear Meeting.

Finally, I wish to thank all of the Executive Committee members for their continued efforts in organizing and planning events and for providing administrative support to the Section. In particular, I would like to thank Alison Danaceau and Hunter Yancey for their wonderful job in producing our monthly newsletter and maintaining our website.

Join us at the 2006 IP Institute!

**November 2-6
Cancun, Mexico**

Fiesta Americana Grand Coral Beach Resort

www.iclega.org
www.selaw.org

2006 IP Open House A Success



The IP Law Section Social Committee hosted the 2006 IP Open House at the new offices of King & Spalding at the recently opened Symphony Tower in Midtown Atlanta on Sept. 28. About 50 attorneys, both section members and non-members, attended the event to learn more about the IP Law Section and its committees. The Section would like to thank King & Spalding for co-sponsoring the event.

Left: Griff Griffin, section chair, welcomes attendees to the Open House.

Below: Scott Cochran, Carmen Lyle-Irving and Jay Myers



Chad Pannell, Shane Nichols, Tony Askew and Katrina Quicker



Luke Anderson, Chris Holland and Bob Walker

Join the In-House Counsel Committee

by Todd Mitchem
In-House Committee Chair

The mission of the In-House Counsel Committee is to serve the needs of attorneys working in-house for companies, organizations, and government agencies, and who practice in the field of intellectual property on a full-time or part-time basis or are simply interested in learning more about the field. Committee membership is open to any attorney who is “in-house” and a member of the State Bar of Georgia IP Law Section. The Committee takes a broad view

of what is “intellectual property” in order to be inclusive of in-house attorneys whose clients have a variety of intellectual property-related needs.

The In-House Committee meets, via teleconference or in person, every two to three months. If you are interested in participating in the In-House Counsel Committee please contact Todd Mitchem at 404-249-5850 or via e-mail at todd.mitchem@bellsouth.com.

Intellectual Property Event Calendar



STATE BAR OF GEORGIA | OCTOBER 2006

INTELLECTUAL PROPERTY LAW SECTION & OTHER IP EVENTS

OCT. 25 — IP LAW SECTION LITIGATION COMMITTEE LUNCHEON

12 p.m. - 1:30 p.m.

The Basics for New Patent Litigators: Patent Rules in the Northern District of Georgia

State Bar of Georgia Conference Center

104 Marietta St., 3rd floor, room 5

NOV. 2-6 — IP INSTITUTE

Fiesta Americana Grand Coral Beach Resort

Cancun, Mexico

Institute registration: www.iclega.org

Travel registration: www.selaw.org

OTHER IP EVENTS OF INTEREST

OCT. 17 — TECHNOLOGY LAW INSTITUTE

The 21st Annual Technology Law Institute (TLI), co-sponsored by the Technology Law Section and ICLE, will be held Tuesday, Oct. 17, at the State Bar Conference Center. This day-long program will offer seven CLE credits, including one Ethics and two Trial Practice credits, and will feature nationally and internationally known speakers such as Ian Ballon, Nick Holland and Sean Carter.

Registration: www.iclega.org/programs/6387.html

Litigation Committee Report

by Tina McKeon

Litigation Committee Chair

The Litigation Committee is looking forward to a panel discussion at noon on Oct. 25 regarding the patent rules in the Northern District of Georgia. Chief Judge Jack T. Camp has agreed to participate in the discussion, along with Steven D. Moore (Kilpatrick Stockton) and Claus Melarti (Duane Morris). The panel discussion will target “new” patent litigators or “old” patent litigators who are new to the Northern District.

The luncheon event will be held at the State Bar of Georgia Conference Center. Space is limited to the first 30 people with advance registration, and we are reaching capacity quickly. If you are interested in attending this panel discussion, please send a check (\$20 for IP Section members/\$25 for nonmembers) to Johanna Merrill at the State Bar of Georgia, 104 Marietta Street NW, Atlanta, Georgia

30303 and provide your name, Bar number, and e-mail address. It is unlikely that we will be able to accept walk-ins, so please register soon and encourage others to do so. Thanks to Claus Melarti, Litigation Committee member, for all his efforts in spearheading this event.

We look forward to additional events related to intellectual property litigation in 2007. If you have topics of particular interest, we are open to your suggestions. Please feel free to contact Tina Williams McKeon (tmckeon@fr.com) with your ideas.

Update from the Patent Committee

by Philip Burrus
Patent Committee Chair

On Sept. 29, the Patent Committee and Trademark Committee held a Patent, Trademark, and Copyright Boot Camp. The event included practical pointers and advice for new attorneys and those new to the practice of intellectual property. The morning session covered patent prosecution, from interviewing inventors and drafting claims to prosecution and amendment drafting. The afternoon session included Trademark prosecution, counseling, and dispute resolution, as well as an hour on copyright practice. (See update from the Trademark Committee on page 5.)

Mitch Katz of Needle and Rosenberg opened the event with a quote from Yogi Berra: “In theory, theory and practice are the same. In practice, they are not.” This quote set the stage for the day – each lecture was intended to give practical advice on patent matters that is not likely to be covered in law school. Mitch then spoke for the first hour about interviewing inventors and drafting claims in patent applications.

Using the example claim “A conductive composition comprising copper and gold,” Mitch first discussed the purpose of claims. He discussed claims as licensing assets, sales assets, investment assets, pricing tools, and enforcement tools. After reviewing the statutory requirements for claims, Mitch provided a thorough discussion of the structure and elements of a claim, as well as practical techniques and check lists used in claim drafting practice.

Mitch also discussed interviewing inventors – a technique often overlooked, yet critical, in the practice of law. Mitch discussed extracting the invention from the inventor, determining commercial embodiments, and determining goals for the patent. He also gave insightful anecdotes about the on-sale bar.

Mike Baldauff of Hope, Baldauff, and Hartman then followed with a discussion of specification drafting and drawing creation. Mike reviewed the technical requirements of drawings, as well as stylistic techniques used by seasoned attorneys. Mike suggested using a reference designator



Art Gardner of Gardner, Groff, Santos and Greenwald speaks about patent prosecution during the Patent, Trademark and Copyright Bootcamp on Sept. 29.

scheme that corresponds with the drawings and flows with the specification. By way of example, Mike advised starting with the number “100” when labeling figure 1, and then counting by twos. “When you count by twos, you have room to go back and add elements without breaking the flow of the specification.” Mike also gave advice on flow chart construction and drawing element labeling.

With respect to specifications, Mike’s advice was directed in large part to the various embodiments of the invention set forth in the specification. He suggested that one generally should have multiple embodiments in the specification, while avoiding absolute terms such as “always,” “shall,” and “required.” “Some of our clients require that we never use the word ‘invention,’” Mike said. The discussion concluded with a talk about strategies regarding the structure and content of the summary section in a patent application.

Art Gardner of Gardner, Groff, Santos, and Greenwald then followed with a lively discussion of patent prosecution. Art’s engaging talk was filled with anecdotes that set off practice pointers in a very real, and tangible way.

Art began his talk by discussing proper amendment drafting. “Always be respectful to the patent office...almost as if you’re addressing the court,” Art said, telling the audience

that the attorney is not in an adversarial relationship with the patent examiner. Art said that the attorney is actually in a cooperative relationship, but that the attorney may find his or herself in an adversarial position if they fail to treat patent examiners with the decorum and respect required.

A fundamental point that Art continued to point out was that you should never argue in amendments anything that is not recited in the claims. “Don’t do it!” he said. Art noted that in his opinion practice, he continually sees attorneys – both new and seasoned – who argue point after point in an amendment when none of the points argued are present in the claims.

Art gave tips for working on “problem cases” that seem to be stuck in prosecution. Art suggested that handing the case to a new attorney, having the case looked at with a new pair of eyes and a fresh perspective, is a very effective way to get the case moving again. Art was also an advocate of both in person and telephone interviews with examiners.

Each speaker was gracious enough to permit his or her lecture to be recorded. The Patent and Trademark Committees plan to have each presentation available as podcasts for those who were unable to attend. The podcasts may be found at the IP Section website: www.gabar.org. If you have questions or comments about the Patent Committee, please feel free to e-mail Philip Burrus at pburrus@burrusiplaw.com.



Trademark Committee Report

by Brad Groff
Trademark Committee Chair

The Trademark Committee is off to a great start this year. On Sept. 29, we joined with the Patent Committee in hosting an “IP Bootcamp” program for new attorneys and attorneys new to the practice of intellectual property law. An audience of about 45 turned out, including a good number of attorneys-to-be and future IP Law Section members. (Bar exam results come out this month, in case you were wondering why those first-years at your firm are a bit on edge lately). Special thanks go out to Christine James of Kilpatrick Stockton for her presentation on “Trademark Selection, Searching and Registration,” Larry Nodine of Needle & Rosenberg for his presentation on “Trademark Dispute Resolution,” and Creighton Frommer of Hill Kertscher & Wharton for his presentation on “Copyright Basics.” All three of the presentations were very interesting and packed with useful information.

Also, thank you to Philip Burrus for making portions of the “Bootcamp” presentations available for listening at www.georgiaip.org/Podcasts/Podcast/Podcast.html. Our March 2006 program, “Effective Use of Surveys in

Trademark Proceedings,” starring Charlie Henn and Jerre Swann of Kilpatrick Stockton, and Gerald Ford of Ford Bubala & Associates is also available at that link.

I hope you joined us for our luncheon program on Oct. 3 with Commissioner of Trademarks Lynn Beresford, of the U.S. Patent and Trademark Office. We greatly appreciate Commissioner Beresford taking time out of her schedule to visit us in Atlanta. Thanks also go out to Congressman Tom Price for his assistance in arranging Commissioner Beresford’s visit.

Upcoming events being planned by the Trademark Committee include programs on trademark enforcement through Customs and the International Trade Commission, and trademark filings under the Madrid Protocol. Our committee is always looking for new members with an interest in trademark law, and for trademark-related topics for future programs. Please contact Brad Groff (bgroff@gardnergroff.com) if you would like to get involved.



Seated, L-R: Philip Burrus, Griff Griffin, Todd McClelland and Todd Mitchem.

Standing, L-R: Tina McKeon, Shane Nichols, Brad Groff, Steve Wigmore, Alison Danaceau, Wab Kadaba and Michelle Tyde

Not pictured: Andrew Crain, Melissa Howard, Doug Isenberg and Hunter Yancey

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