

CHAIR'S COMMENTS...



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

Welcome to a new year with the State Bar of Georgia Intellectual Property Law Section! I am very excited about this year for the Intellectual Property Law Section, especially since I am privileged to work with so many great people in the new Executive Committee for the Section. With additional contact information located elsewhere in this Newsletter, I am very thankful for the people who are leading the Section this year as members of the Executive Committee.

In the Officer positions, **Scott Frank**, with BellSouth Intellectual Property Management Corporation, is serving the Section this year as *Chair-Elect*. **Mike Hobbs**, of Troutman Sanders, is serving as *Vice-Chair*. **Doug Isenberg**, of GigaLaw.com, is serving as *Secretary*, and the newest officer this year is **Griff Griffin**, of Sutherland Asbill & Brennan, serving as *Treasurer*.

The Committee Chairs include the following: **Andrew Crain**, Thomas, Kayden, Horstemeyer & Risley, *Newsletter Committee Chair*; **Julie Sinor**, King & Spalding, *Website Committee Chair*; **Todd McClelland**, Alston & Bird, *Social Committee Chair*; **Schuylla Goodson**, Coca-Cola, *Trademark Committee Chair*; **Wab Kadaba**, Kilpatrick Stockton, *Patent Committee Chair*; **Judy Dray**, Turner Entertainment Group, *Copyright Committee Chair*; and **Frank Landgraaf**, GE Power Systems, *Licensing Committee Chair*

Are you missing important e-mail announcements from the State Bar IPL Section? If so, you may update your e-mail address online at:

<http://www.gabar.org/addchange.htm>

It's easy! Do it right now!

If you are interested in becoming more involved in the Section, please contact one or more of these people as soon as possible since planning for the year is already underway. In addition, if you are interested in becoming an officer of the Section, active involvement in committee activities is the best way of showing your interest in the Section.

I also want to thank **Scott Petty** for his leadership last year. As you may be aware, our Section recently won a State Bar Award of Achievement. This award was presented at the State Bar Annual Meeting in Amelia Island this year, and **Scott's** leadership is one of the main reasons that the Section received this award.

The biggest event of the year for the Section is our annual seminar, so please mark your calendar for **November 13th - 17th** for a trip to Puerto Vallarta, Mexico. We are again teaming up with those fun Entertainment lawyers, and if you have never been to one of these seminars, you have really missed out on one of the best and most reasonably priced CLE events available. More details regarding the seminar and other Section information are online at our section website at www.georgiaip.org. Please join us for loads of fun and an entire year of CLE credit.

Finally, I know that you will definitely want to read the rest of this newsletter since it includes some outstanding information that others are sure to be talking about. Thanks again for your interest in the Section!

INSIDE THIS ISSUE...

IP Section Growth	p. 2
Supreme Court Decides Festo	p. 3
Women in IP in Georgia	p. 5
Summer Associate Party	p. 8
European Official Addresses Section	p. 8
Annual Report - IP Section	p. 9
Patent Committee Activity	p. 10
IP Section Partners with GLA	p. 10
Puerto Vallarta 2002 announcement	p. 12
Calendar of Events	p. 15
Editor's Notes	p. 15

INTELLECTUAL PROPERTY SECTION GROWTH

On August 27, 1964, The Patent, Trademark, and Copyright Law Section of the Georgia Bar was created. However, the section actually traces its beginning to even before the creation and establishment of the State Bar of Georgia, which occurred on December 6, 1963. The Georgia Bar Association, which preceded the State Bar of Georgia, included a special committee known as the Patent, Trademark, and Copyright Committee.

When the Section was founded, it had ten members. However, since the Section's early beginnings, membership has skyrocketed. Today, the membership for the Section is 843, and much of that growth has occurred over the last ten years.

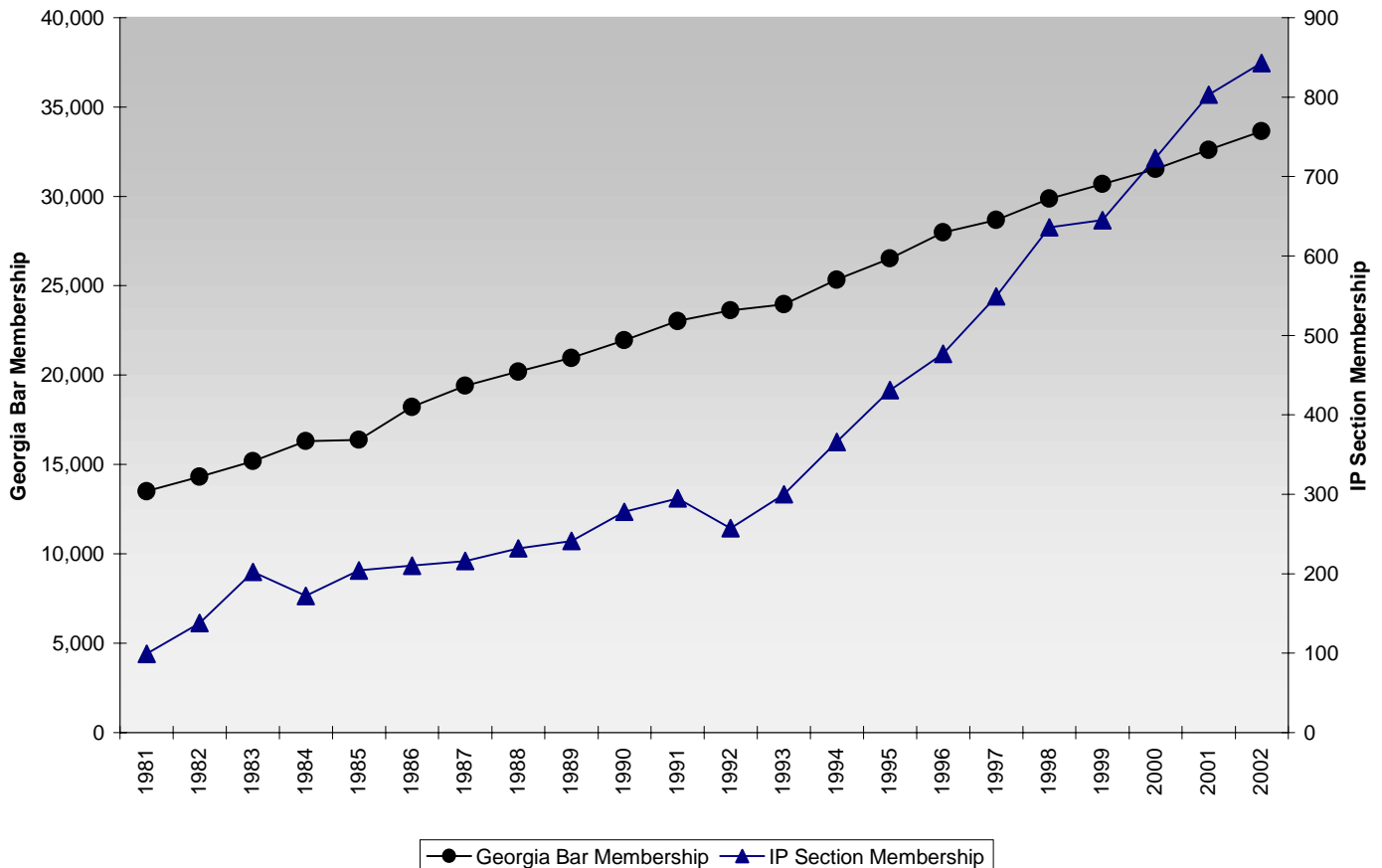
The chart below depicts the rapid growth of the IP Section over the last ten years plotted against the steady membership growth of the whole State Bar of Georgia. The membership of the entire bar is represented as a line with solid-filled circles, while the membership of the IP Section is represented as a line with solid-filled triangles.

As is evident from the chart below, the State Bar of Georgia has enjoyed steady growth over the last 20 years from just under 15,000 to over 33,500 in 2002. The growth, as shown on the graph below for the State Bar of Georgia, is nearly a straight line over the twenty years graphed.

In contrast, however, since 1992, the growth for the IP Section has been at a much higher rate than the State Bar. The IP Section has grown by 228 percent during that time, while the State Bar has only grown by 42 percent. In fact, the IP section has averaged almost 60 new members each year since 1992, which represents an average growth of nearly 13 percent each year.

With the technology boom of the 1990s, the membership of the IP Section has grown proportionally. It will be interesting to observe the next few years to see what, if any, effects recent economic events has on the Section's membership. Hopefully, we will continue growing.

Membership of the State Bar of Georgia v. the IP Section



A NOVEL EXPRESSION OF CONFUSION

THE UNITED STATES SUPREME COURT DECIDES *FESTO*

by A. Shane Nichols – King & Spalding

If you heard a loud, unexplained thud in May, it may have been the sound of the proverbial other shoe dropping in the form of the Supreme Court's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* ("*Festo*").¹ On May 28, 2002, the United States Supreme Court rendered its highly anticipated decision in this patent infringement case that required the high court to examine the relationship between the doctrine of equivalents and the doctrine of prosecution history estoppel. A unanimous Supreme Court reversed an *en banc* decision² rendered by the Court of Appeals for the Federal Circuit ("CAFC") that had threatened to dramatically limit the application of the doctrine of equivalents in patent infringement suits. Last year's reports of the demise of the doctrine of equivalents, it turns out, were exaggerated.

The Supreme Court's *Festo* decision preserves the important but controversial doctrine of equivalents, which enables a patent holder to enforce a patent against a broader scope of infringements than merely literal infringements. Literal infringement of a valid patent claim is prohibited by statute.³ However, the doctrine of equivalents was devised by the courts at least as early as the nineteenth century to prohibit an infringer from "stealing the benefit of the invention"⁴ by making insubstantial changes that avoid the literal scope of the patent claims.⁵ Obviously, the doctrine of equivalents is beneficial to patent holders ("patentees") because it allows them to expand the scope of legal protection beyond the literal claim language. However, there are limitations on the application of the doctrine of equivalents, including the application of a countervailing patent law doctrine, the doctrine of prosecution history estoppel. This was the setting for the *Festo* battle.

The Battle of the Doctrines

The doctrine of equivalents was created to remedy the limitations inherent in describing the boundaries of a patent through words. As the *Festo* Court observed, "the nature of language makes it impossible to capture the essence of a thing in a patent application...[t]he language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty."⁶ The Court further acknowledged that "if patents were always interpreted by their literal terms, their value would be greatly diminished."⁷

Protecting the interests of patent holders, however, is not the only objective of the patent laws. Another function of a patent is to put the public on notice as to what is and what is not an infringement. The *quid pro quo* for granting a patent is the disclosure to the public of the patentee's invention. The public not only has a right to use the patented technology after the patent expires, but also has the right to practice anything that is not claimed by the patent. If the claims of a patent are not clear, then it may be unnecessarily difficult for the public to exercise its right to produce non-infringing,

competitive products⁸ with certainty. There is, therefore, an inherent tension in patent law between motivating innovation through strong patent protection and providing public notice by requiring clarity in a patent's claims. An overly broad application of the doctrine of equivalents may unnecessarily chill innovation by discouraging the development of similar, but non-infringing products. On the other hand, an overly narrow application of the doctrine of equivalents may also hinder innovation by limiting the scope and value of a patent.

The "prosecution history" of a patent is the official record of the statements and/or amendments that the patent holder made to the Patent and Trademark Office (PTO) while seeking the patent as a patent applicant. When a patentee's competitor seeks to design around a patent,⁹ the competitor will typically look to the patent's prosecution history as well as to the patent's claims. The doctrine of prosecution history estoppel provides that when a patent applicant makes a narrowing amendment to the claims in order to distinguish the claimed invention from the prior art, the patent holder is not permitted later (e.g., in a litigation) to extend coverage of the amended claim to cover the surrendered subject matter.

However, the CAFC went a step further than this by holding, in its *Festo* decision, that the doctrine of equivalents may not be applied at all to a claim element narrowed for any reason related to patentability.¹⁰ The CAFC's so-called complete bar is not intuitive, for example, in cases where a patentee is barred from applying the doctrine of equivalents to extend an amended claim element to cover an accused equivalent that is not related to the subject matter surrendered by the amendment. The CAFC's decision was considered by many to be draconian because the vast majority of patentees have amended their claims at least once during the prosecution process.¹¹ In addition, most patentees had amended their claims in reliance on the availability of the doctrine of equivalents. Because the CAFC decision would have had retroactive effect, the decision threatened to compromise the scope of protection and the value of many existing patents.

The Supreme Court's Analysis

Festo presented two questions on appeal to the Supreme Court: 1) whether prosecution history estoppel should be applied to every amendment that helps the patent comply with the Patent Act, or just those amendments that avoid the prior art, and 2) whether prosecution history estoppel completely bars the use of the doctrine of equivalents for amended claim elements.

The Supreme Court agreed with the CAFC on the first question, affirming that "a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel."¹²

FESTO - Continued on page 4

FESTO - Continued from page 3

While noting that many earlier cases had focused on claim amendments made to avoid the prior art, the Court held that the CAFC's broader approach was consistent with Supreme Court precedent.¹³

The second question presented to the Supreme Court was whether a patentee would be prevented from applying the doctrine of equivalents in all cases where a claim element was narrowed to meet patentability requirements. Before the CAFC's decision in *Festo*, courts applied a flexible approach when determining whether the prosecution history prohibited a patent holder from raising a doctrine of equivalents claim. Depending on the nature of the amendment, the patent holder may have been permitted to claim infringement by equivalence if the equivalent in question was not specifically surrendered in the prosecution history. The CAFC overruled this longstanding precedent, holding that any narrowing amendment to a patent claim element completely barred application of the doctrine of equivalents to that element.

Invoking the age-old policy that words are often not sufficient to fully describe a patented invention, the Supreme Court rejected the CAFC's complete bar:

*The narrowing amendment may demonstrate what the claim is not; but it may still fail to capture precisely what the claim is. There is no reason why a narrowing amendment should be deemed to relinquish equivalents unforeseeable at the time of the amendment and beyond a fair interpretation of what was surrendered. Nor is there any call to foreclose claims of equivalence for aspects of the invention that have only a peripheral relation to the reason the amendment was submitted.*¹⁴

By refusing to adhere to an inflexible rule holding patentees to the literal claim elements of their amended patents, the Supreme Court reversed what would have amounted to a sea change in patent law. However, the Court imposed a burden on the patent holder to demonstrate that the amended claim element did not surrender a specific equivalent.¹⁵ For example, a patentee may be permitted to apply the doctrine of equivalents to an amended claim element, where the patentee is able to show that an accused infringement constitutes an unforeseeable equivalent to an amended claim element. This "foreseeable bar" approach had been suggested by both the United States and the Institute of Electrical and Electronics Engineers in their respective amicus briefs. While less severe than the complete bar formulated by the CAFC, this approach is, nevertheless, more restrictive than the pre-*Festo* flexible bar.¹⁶

Not Out of the Woods Yet

For patentees, the Supreme Court's decision in *Festo* appears at first blush to be a marked improvement over the CAFC's opinion. However, it is clear that the Supreme Court contemplates a more restrictive application of the doctrine of equivalents than that of

the pre-*Festo* era. While an amended claim element is no longer subject to a complete bar against the application of the doctrine of equivalents, the Supreme Court held that a narrowing amendment creates a presumption that the doctrine of equivalents cannot be applied to the amended claim element. The patentee will be permitted to rebut the presumption if the patentee can show that the equivalent in question was not specifically surrendered or that the amendment had no more than a tangential relation to the equivalent in question.¹⁷ Alternatively, the patentee may show that at the time of the amendment, one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the equivalent or that there is some other reason that the patentee could not reasonably have been expected to have described the equivalent in question.¹⁸

As expected, there has been quite a lot of debate regarding the significance and likely application of the Supreme Court's *Festo* decision. Some have heralded the Court's decision as a triumph for patentees, claiming that patents are more enforceable than they would have been under the CAFC approach.¹⁹ Others, however, view the decision to be a much more limited victory for patentees, noting that the presumption established by the Supreme Court may be difficult for patent holders to overcome.²⁰ It will take some time to collect empirical evidence and to form conclusions as to how the Supreme Court's *Festo* decision is interpreted and followed by trial courts and by the CAFC.

In the meantime, patentees and their counsel should proceed as cautiously as ever when preparing patent applications and specifically when drafting claims. Careful attention to initial claim drafting may avoid the necessity of narrowing amendments. When the need for amendments arises during the application process, applicants should make amendments sparingly and thoroughly document reasons for the amendments in the prosecution history. A patent application's specification should provide definitions for claim terms that are broad enough to include substantially all foreseeable equivalents. When attempting to design-around a patent claim, a comprehensive analysis of the patent should identify all surrendered subject matter, such that non-infringing designs can be proposed that incorporate only surrendered subject matter.

In the patent infringement litigation context, parties accused of infringing by equivalence should prepare arguments directed to raising the presumption that all narrowed claim elements are not entitled to the application of the doctrine of equivalents. When the presumption is properly raised, the patentee will bear the burden of rebutting the presumption by proving, for example, that the equivalent in question was not foreseeable. If the patentee is unable to rebut the presumption, the complete bar will apply. On the other side of the courtroom, patentees intending to enforce a patent under the doctrine of equivalents should identify and analyze any narrowed claim elements before bringing suit to

A NOVEL EXPRESSION OF CONFUSION

FESTO - Continued from page 4

determine the exposure to risk of losing the ability to assert infringement by equivalence. For all narrowing amendments, patentees should establish a reason for the amendment, and an argument as to whether those amendments are related to patentability.

The Supreme Court's *Festo* decision was authored by Justice Anthony Kennedy. The opinion is a clear and concise quick read and can be found on the Internet at:

<http://www.supremecourtus.gov/opinions/01pdf/00-1543.pdf>.

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, No. 00-1543 (S. Ct. May 28, 2002).

² *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000).

³ 35 U.S.C. § 271.

⁴ *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950) (citing *Royal Typewriter Co. v. Remington Rand*, 168 F.2d 691, 692 (2d Cir. 1948)).

⁵ *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

⁶ *Festo*, slip. op. at 6.

⁷ *Id.*

⁸ This article refers to infringing "products" only for simplicity and does not imply that only apparatus claims are affected by the *Festo* decision. The *Festo* decision is applicable to all claim varieties, including method and process claims.

⁹ "Designing around" is the purposeful design of a competing product that seeks to avoid infringing the claims of a patent.

¹⁰ Including both prior art related amendments made to comply with 35 U.S.C. §§ 102, 103 and formal amendments made to comply with 35 U.S.C. § 112.

¹¹ According to the Association of Patent Law Firms, 1 million of the 1.2 million patents in force today were amended prior to issuance. Sabra Chartrand, *The Supreme Court and Patents*, The New York Times on the Web, June 3, 2002, available at <http://www.nytimes.com/2002/06/03/business/03PATE.html>.

¹² *Festo*, No. 00-1543, slip. op. at 11 (emphasis added).

¹³ *Id.* at 10.

¹⁴ *Id.* at 13.

¹⁵ *Id.* at 15.

¹⁶ *Id.*

¹⁷ *Id.* at 16

¹⁸ *Id.*

¹⁹ Tony Mauro, *Justices Shed Some Light on Cloudy Patent Law*, Fulton County Daily Report, June 3, 2002, at 1.

²⁰ *Id.*

This article was prepared and presented by Shane Nichols, an associate in the Intellectual Property department of King & Spalding who specializes in all aspects of the firm's patent practice, including litigation, client counseling, and prosecution.

SPOTLIGHT ON: WOMEN IN I.P. IN GEORGIA

Sandy Evans recently retired from the position of Vice President & General Counsel with BellSouth Intellectual Property Management Corporation. Ms. Evans is a phenomenal woman who is a trailblazer in the Intellectual Property arena. This edited interview was conducted prior to her retirement and provides a glance at her professional career with BellSouth.

Schuylla Goodson is now Trademark Counsel at The Coca Cola Company, and the current Trademark Committee Chair for the I.P. Section of this Bar. At the time of this interview, Schuylla was newsletter editor to this publication. The Section is grateful to her for her time and efforts in obtaining this interview and transcript.

Goodson: *Tell me a little about yourself and how long you've been with BellSouth.*

Evans: I am the first General Counsel of BellSouth Intellectual Property Management Corporation. I've been with BellSouth since 1977 when I graduated from the University of Georgia Law School. At that time, it seemed that corporate law departments were just waking up to the idea of having women in their ranks and there were several in-house jobs available in town. I skipped the law firm route and went in-house for Southern Bell. I've been here 24-1/2 years.

Goodson: *Wow! How have things changed for women practitioners since 1977?*

Evans: Things have changed in a lot of ways and in a lot of ways, things haven't changed. In my opinion, today is a better time for women. I think that there may be more real opportunities by virtue of the fact that some women (but not enough) have finally achieved some stature in our law firms and in corporations. When I first started practicing, I was in the first law class that had any measurable number of women. A quarter of the people in my class were women. We were really the first class that came out into the marketplace in real numbers. I've been disappointed over the years to see that many of the women who graduated with me have not risen to partner and/or corporate officer level the same as their male counterparts. We're still not where we should be after all these years.

Goodson: *In your opinion, why are we still not there?*

Evans: I would say we still aren't there because of a combination of choices and circumstances. I think it's largely due to the challenges manifested in our society, although it's getting better.

EVANS - Continued on page 6

INTELLECTUAL PROPERTY LAW SECTION NEWSLETTER

EVANS - Continued from page 5

Goodson: *You said that some of the challenges are the same and some are different. Explain what you mean by that?*

Evans: I've been in Intellectual Property since 1986. I started out in the State Office where I concentrated on car wrecks, Workers Comp and directory disputes. I then went to Headquarters and specialized in third party leasing and computer and software contracts. After the break from AT&T in 1984, I worked in setting up the procurement department and through computer law developed a great interest in IP. In 1986 I became the lawyer in charge of IP matters.

There's a world of difference between today and 1986 in Intellectual Property. It has gone from a back-house specialty in virtually everybody's minds, except for the people who were practicing it, to one of the most sought after and premier kind of practices that you could have. It's come a long way, by virtue of the fact that we've gone from manufacturing widgets to selling services. IP has changed with the way the economy has changed, and I just happened to be in the right place at the right time.

Goodson: *What's your typical day like?*

Evans: I'm in a leadership position. I have two lawyers, four paralegals and a large staff reporting to me. A typical day for me involves collaborating with those folks and the clients and doing my own substantive work, which consists of a wide variety of IP and litigation work.

I manage a lot of trademark and other IP litigation, which is handled in-house or through outside counsel. I answer and assess a lot of BellSouth intellectual property ownership issues and contract issues. IP indemnities in contracts are very important to us. I deal with a fair number of trademark issues in a day. We have a large foreign trademark practice that is the primary responsibility of one full time paralegal. Another full time paralegal handles U.S. trademark selection, prosecution and infringement. The third paralegal does patent administration and the fourth paralegal swings between practice areas. I also do some work with patent infringement matters. Then there are many administrative duties, like rating people and giving reviews and doing all the things that are required in managing within a large corporation.

Having said all that, there's really no typical day whatsoever, which is why it is so much fun.

Goodson: *What would you advise the first year practitioner right out of law school?*

Evans: As I said before, IP is a fabulous practice today, especially for women. I don't see that a lot of the old barriers still in existence.

You will probably *not* be able to get directly in with a corporation because they generally don't hire right out of law school. In fact, I don't know of any corporation that's hiring attorneys right out of law school now. When I seek intellectual property lawyers, I look for people who have practiced for about four years and who have a broad range of experience in intellectual property. If you want to go into patent law, you need to pass two bar exams. You also need to litigate. You also need to get in on the commercial aspects of IP, because those are all very, very, very good experiences. If you don't have one of them, you going to come up short. It's best to work with as good a firm as you can get with and go for it! If you're not getting the full range of practice, go and practice with the volunteer IP lawyers for the arts or something like that, and get in some solid copyright training along the way. I also think it's important to call people who have been practicing in the area for a while and just talk to them about the practice. I have had innumerable calls from people and I am always willing and anxious to meet people with an interest in IP.

Goodson: *What do you love most about your job right now?*

Evans: What I love most is being in-house and having the relationships that I can have with my client group. For example, we are co-located with our clients. The president of my company is a former patent lawyer with Troutman Sanders and several attorneys from various local firms are working for him in a non-lawyer capacity. So the clients are all top notch and understand the advice they are being given by my group. All of the clients are in the suite, all of the lawyers are in the suite, and we literally run this business together...that's what makes *my* practice really so much fun from day to day. I am not just sitting there running a legal department I'm partnering in running a whole business. The thing I like the least is the administrative side of it – the management side of it.

Goodson: *Where would you like to see yourself in five to ten years?*

Evans: I would see myself retired with a house in Maine and a place in North Georgia where I would spend half of the year in one and half of the year in the other.

Goodson: *If you weren't here at BellSouth, what do you think you would be doing?*

Evans: I would want to go out and consult in Intellectual Property. I believe that law firms, *per se*, do not have the experience to appreciate and understand the business of intellectual property management. They know the statutes and various rules of the law, but they don't know how to put it all together within a corporation in a way that will work. My thought would be that I would consult with a law firm or with several law firms and help

EVANS - Continued on page 7

A NOVEL EXPRESSION OF CONFUSION

EVANS - Continued from page 6

them to advise their clients on how to maximize their intellectual property within the corporate context.

Goodson: *Tell me about the development of corporate IP policies and practices at BellSouth.*

Evans: BellSouth's policies and practices keep changing to stay abreast of what is happening in the marketplace, and tend to be broad because it became pretty clear very early that what we could *not* do is make policies that would cover all of the potential scenarios or problems.

In terms of the Internet, for example, we have primarily just registered our major marks as domain names. When we challenge infringers, the infringing domain name often ends up being assigned to us. We have a lot of domain names that we are redirecting toward the BellSouth.com site. We also decided to go ahead and register "BellSouth" in the top-level .com and .net domains as well as in the country code top level domains in many countries. However, the foreign domain name registration process is an extremely expensive process. Whether we will go forward and register other top-level extensions internationally, I don't know. Probably not, because in my opinion, the registration of potential infringements for defensive purposes isn't something that you can stay ahead of and is only of marginal benefit at best.

Goodson: *How do you get those who don't practice in the IP arena to understand the importance of protection and management of corporate IP assets?*

Evans: We developed a whole business around IP protection, licensing and management at BellSouth, and we're pretty proud of where we are today. About three years ago, we established the BellSouth Intellectual Property Management Corporation and some associated corporations that have all been set up to protect or market BellSouth's intellectual property. Before that, there were only three people in the whole corporation doing intellectual property — one colleague, me and one client. Those were the hard days. We had to get people to understand what IP ownership meant to the corporation and how important the trademarks were. Three years ago, we were able to put together a business plan that was attractive to the top management that said if you let our team do this right, we can get an excellent return on your investment in that Intellectual Property by reselling it to third parties. With our business plan now implemented, we've now got 30 people working in IP!

An important element of our success is that we have created an aggressive employee education program. A large number of employees go through IP training so they come out understanding and appreciating IP assets and how to manage and protect them. They now can identify IP issues enough that they can bring them

to the attention of the IP management group; We also publish IP-related articles in employee newsletters and try to keep IP on the front burner.

Evans: One of our greatest achievements in IP has involved BellSouth's non-management employees. We've always had management employees agree to certain practices relating to intellectual property, but we hadn't included non-management employees in the program. Within the last several months, BellSouth, in partnership with the union, has rolled out an intellectual property agreement for new non-management employees so that they are now partners in protecting these incredibly important assets of BellSouth.

Goodson: *What would you change, if anything, about your career path?*

Evans: I possibly could have been more aggressive at forcing change for myself. I believe that by staying in the same company for 24 years my career probably didn't progress as much as it could have if I had moved around to find opportunity. Pushing the IP ball up hill for so many years was difficult. Having said that, I'm glad I did stay because I was able to do what I liked to do and now have a great sense of accomplishment.

Goodson: *Can women lawyers have it all? Can we be great mothers, great wives, and great leaders?*

Evans: I think it's ridiculous to think we can do it all at the same time. To do any one of these things the best, you have to make sacrifices in the other. You can be *pretty* good at it all, but you can't have it all at the same time. Women should get over it and start setting realistic goals, because they're going to go crazy trying to do everything.

Goodson: *Thank you.*

The Trademark Committee is looking for YOU!!!

We're planning an exciting year and want you to be a part – contact Schuylla Goodson at 404-676-0582 or sgoodson@na.ko.com for more information.

SUMMER ASSOCIATE COCKTAIL PARTY



The Patent Committee held its Annual Summer Associate Cocktail party on June 10, 2002 at the Park Tavern Brewery & Restaurant. The Patent Committee invited summer associates working with firms throughout the greater Atlanta area that have an interest in a career in intellectual property law.

The event was attended by more than 45 summer associates and attorneys. The summer associates were given the opportunity to mingle with IP attorneys from most of the local firms. In addition, a panel of prominent local IP attorneys spoke on the vibrant “IP” community in Atlanta and the many opportunities in the Atlanta area to practice IP law in a private firm (both full service and boutique) or within a legal department of a corporation. The panel of speakers included Frank Landgraff of GE Power Systems, Jim Ewing of Kilpatrick Stockton LLP and Roger Taylor of Finnegan, Henderson, Farrow Garrett & Dunner LLP.

The Patent Committee would like to thank Kristin Mallatt and Wab Kadaba for their efforts in organizing the event.

EUROPEAN OFFICIAL ADDRESSES SECTION

On July 16th, 2002, the Intellectual Property Law Section sponsored a luncheon with Alexander S. Clelland, a member of the Board of Appeals of the European Patent Office in Munich Germany. Since 1990, Mr. Clelland has been with the Electricity I Board, which is responsible for appeals in the telecommunications and computing fields, including business methods and software.

The event was hosted at Maggiano’s, and many members of the Section attended. The food was outstanding, and attendees received two (2) hours of CLE credit. Mr. Clelland addressed several topics, including general European Patent Office procedures, software and business method developments, and the opposition and appeal processes. The event included a very helpful powerpoint presentation by Mr. Clelland, as well as detailed written materials.

If you did not know about that event, please remember to check your e-mail address at the State Bar website to make sure that you are receiving all of the latest announcements.



Alexander S. Clelland, Member of the Board of Appeals of the European Patent Office in Munich, Germany, addressing the Section at a recent luncheon.

INTELLECTUAL PROPERTY LAW SECTION - STATE BAR OF GEORGIA

ANNUAL REPORT - 2002

Immediate Past Chair: W. Scott Petty

The Intellectual Property Law Section (the "IP Section") continues to expand its membership among State Bar members, as membership has increased from 803 members in 2001 to over 830 members in 2002. Membership in the IP Section has easily doubled in size over the past 10 years, which is representative of the explosive growth in the practice of patent, trademark and copyright law in Georgia. This is at least the ninth consecutive annual record high for section membership. The Executive Committee of the IP Section in 2001 - 2002 includes a slate of elected officers, **Scott Petty** (Chair), **Jeff Kuester** (Incoming Chair), **Scott Frank** (Vice-Chair), **Michael Hobbs** (Secretary) and **Doug Isenberg** (Treasurer), as well as seven active committees responsible for the areas of Patents, Trademarks, Copyrights, Licensing, Web and Newsletter Communications, Social and Pro Bono (*new* in 2002). The finances of the Section remain strong, with over \$20,000 in funds available to support Section activities.

NEW COMMUNITY OUTREACH PROGRAM

The IP Section initiated a new public outreach program in 2002 by establishing a Pro Bono committee, headed by **Michael Hobbs**, to assist in identifying and coordinating Section pro bono legal services. The Pro Bono committee is now coordinating our members' active support of the Georgia Lawyers for the Arts (GLA), which provides education and free or reduced fee legal services to Georgia's arts community. Representative services include seminars covering intellectual property issues of interest to the arts community, one-on-one legal counseling, and financial support.

CLE SEMINARS

The IP Section hosted the 7th Annual Intellectual Property Law Institute in Puerto Vallarta, Mexico in November 2001. Over 100 attendees took advantage of this 3-day CLE opportunity, co-sponsored by ICLE, to achieve a full year of CLE credit by attending seminars on patent, trademark, copyright and licensing issues. The IP Section coordinated the scheduling of this CLE event to coincide with the Entertainment and Sports Law Section's annual Southern Regional Entertainment & Sports Law Seminar and offered combined CLE seminars and social events attended by members of both sections. The Section's expenses for hosting daily social functions (including a scenic boat tour of Puerto Vallarta's coastline) and dinners over the 3-day CLE event were fully covered by financial sponsorships contributed by national IP service providers, including **InteCap**, **Thomson & Thomson**, and **Markman**.

Building on the excitement of the 7th Annual Intellectual Property Law Institute, the IP Section sponsored with ICLE a 3-hour CLE Program covering Patent, Trademark and Copyright Law Updates at the Mid-Year State Bar meeting in Atlanta on January 11, 2002. **Jeff Kuester** (Patent Prosecution), **John Fry** (Patent Litigation), **Michael Hobbs** (Trademark), and **James Trigg** (Copyright) provided excellent presentations on recent IP law decisions. This IP CLE Program attracted over 75 attendees, which represented the largest attendance of a CLE seminar at the 2002 Mid-Year State Bar meeting. In further support of

the Mid-Year State Bar meeting, the Section also hosted a luncheon featuring presentations by **Rodgers Lunsford**, **Miles Alexander**, **George Thomas** and **Bob Kennedy** on a historical view of the practice of intellectual property law in Georgia. **Art Gardner**, Chair of the Trademark Committee, served as the moderator for the engaging panel discussions.

For the first time in several years, the IP Section has elected to take an active educational role at the State Bar's Annual Meeting, this year at Amelia Island, Florida, by sponsoring a 3-hour CLE program on June 15, 2002. The CLE program covers basic intellectual property issues faced by general practitioners and will feature presentations by **Pete Burke**, **W. Swain Wood**, **N. Andrew Crain** and **Doug Isenberg**. The IP Section is also a financial sponsor of the State Bar's social function scheduled for June 14, 2002 for members of all State Bar Sections and their families.

PATENT COMMITTEE

Thanks to the efforts of **Griff Griffin** and the Patent Committee, the IP Section hosted a series of four patent roundtables in 2001 - 2002. An August 29, 2002 patent roundtable, hosted at Troutman Sanders, covered the topic of non-infringement opinions and the avoidance of trebled damages in patent infringement actions. An October 2001 patent roundtable, hosted at Sutherland Asbill, featured discussions on European software patent practices. A February 7, 2002, hosted by Alston & Bird, covered recent decisions on "On-Sale Patent Bar" issues, while a patent roundtable hosted at the Thomas Kayden firm on March 28, 2002 included discussions on patent claim interpretation issues. The Patent Committee, in connection with ICLE, also coordinated a well attended, half-day CLE seminar on Patent Litigation on May 9, 2002.

TRADEMARK COMMITTEE

The Trademark Committee, headed by **Art Gardner**, hosted a trademark "Lunch and Learn" CLE program covering trademark opinion and counseling issues on May 10, 2002. The IP Section was pleased to co-sponsor a Trademark Program featuring the Commissioner for Trademarks, the Honorable Anne H. Chasser, as a speaker on October 31, 2001 at Georgia State University. The Commissioner for Trademarks spoke on "The Trademark Office Goes eGovernment," while representatives of the U.S. Patent & Trademark Office presented seminars on the electronic filing of trademark applications. In connection with the ABA Section of Intellectual Property Law Young Lawyers Committee, the IP Law Section also co-sponsored a Trademark Litigation Seminar at Georgia Tech in May 2002.

LICENSING COMMITTEE

Frank Landgraff, Chair of the Licensing Committee, directed a March 14, 2002 CLE program on "Ethics and Professionalism Issues in Licensing" that attracted a standing room only audience. This 1-Hour Professionalism Credit Seminar featured **Pat O'Reilly**, a Partner in the Washington D.C. office of Finnegan, Henderson. In connection with the Atlanta Chapter

REPORT - Continued on page 10

INTELLECTUAL PROPERTY LAW SECTION NEWSLETTER

REPORT - Continued from page 9

of the Licensing Executive Society (LES), the Licensing Committee also co-sponsored a licensing seminar on September 12, 2001 featuring **Jim Malackowski**, President Elect, of LES. This meeting was rescheduled to a later date as a result of the tragic events of September 11, 2001. A joint CLE seminar, co-sponsored by the IP Section and LES, is also scheduled for June 20, 2002 and will cover patent valuation and licensing issues.

COPYRIGHT COMMITTEE

On behalf of the Copyright Committee, **Judy Dray** organized a March 20, 2002 luncheon featuring the Honorable Judge Stanley Birch of the U.S. Court of Appeals for the 11th Circuit on copyright issues arising from the Internet and advances in electronic copying capabilities.

SOCIAL COMMITTEE

Todd McClelland, Chair of our Social Committee, coordinated a busy calendar of social functions for IP Section members. As an outreach program to summer associates at Atlanta firms, the IP Section hosted a panel discussion featuring local practitioners discussing IP law practice issues at a popular Midtown Atlanta location, the Park Tavern adjacent to Piedmont Park, on June 25, 2001. The IP Section hosted a holiday party on December 13, 2001 at a Midtown Atlanta restaurant, Coohills, which was attended by over 45 guests. The Section also hosted a casual get together for

all Section members at the Midtown Atlanta location of Jocks-N-Jills on Thursday, April 18, 2002.

SECTION COMMUNICATIONS - WEB SITE and NEWSLETTER

Thanks to the efforts of **Julie Sinor**, the Section's Webmaster, the Section enjoys the benefits of an updated Web site at www.georgiaip.org featuring an event calendar, membership information, and past newsletters. In her capacity as Newsletter Editor, **Schuylla Goodson**, has published a pair of newsletters for our membership in 2001-2002. The Fall 2001 edition of the IP Section's newsletter featured a Member Questionnaire to survey the interest of our membership. The Spring 2002 newsletter edition includes committee reports and a spotlight on "Women in Intellectual Property Law in Georgia."

LEGISLATIVE ACTIVITIES

Members of the IP Section also actively participated in the drafting and individual support of proposed legislation in the form of SB 214 entitled "Georgia Database Protection and Economic Development Act." In cooperation with the Technology Law Section, **Jeff Kuester** and the IP Law Section hosted a meeting of interested parties in November 2001 to collect comments on and discuss possible amendments to an early version of SB 214, which covered database legislation. The Section's organized support of SB 214 concluded in response to a decision by the State Bar Advisory Committee on Legislation (ACL) that the State Bar's formal support of SB 214 was outside the scope and purpose of the organized bar.

PATENT COMMITTEE ACTIVITY...

by Wab Kadaba

The Patent Committee of the Intellectual Property Section of the State Bar of Georgia held its first meeting of the year on August 7, 2002. The Patent Committee determined it will organize four roundtable discussions during the next year, the first to be held in early October. The remaining roundtable discussions will be held in the winter and spring of 2003 and focus on a mix of patent prosecution, litigation, and management issues.

In order to increase attendance at these roundtable discussions, the committee members decided that at least one will be multi-firm sponsored and consist of a panel, with an open discussion format to follow. The Patent Committee will also attempt to sponsor an event next spring with a prominent speaker, perhaps one or more district and/or appellate court judges.

Patent Committee members include Patrick Elsevier of Alston & Bird, John Greenwald of Gardner, Groff & Mehrman, Shane Nichols of King & Spalding, Judi Jarecki-Black of Merial, Ltd, and Kristin Mallat, Kris Johnson, Brenda Holmes, and Wab Kadaba all of Kilpatrick Stockton. If you are interested in joining the Patent Committee, please contact Wab Kadaba at 404-532-6959 or wkadaba@kilpatrickstockton.com.

STATE BAR INTELLECTUAL PROPERTY SECTION PARTNERS WITH GLA

by Michael D. Hobbs, Jr.

The Intellectual Property Section of the State Bar has announced a partnership with the Georgia Lawyers for the Arts (GLA). The GLA provides education and pro bono legal services to Georgia's arts community. In furtherance of this commitment, and in recognition of the special role the GLA plays in the lives of Georgia artists, the IP Section has made a \$1,000 donation to the GLA.

As part of the partnership, the IP Section will also help coordinate educational workshops, staff walk-in clinics and assist artists with legal issues. A training seminar for lawyers on particular aspects of representing artists was held on June 13. The Section anticipates scheduling additional training sessions in the fall.

More information regarding the Georgia Lawyers for the Arts is available at their web site, located at www.glarts.org. For more information about volunteering for the GLA, please contact Michael Hobbs at Michael.hobbs@troutmansanders.com or Lisa Kincheloe, the executive director of the GLA, at lisa@glarts.org.

14th Annual
Southern Regional Entertainment
& Sports Law Seminar

8th Annual
Intellectual Property
Law Institute

Present

PUERTO VALLARTA 2002

NOVEMBER 13-17, 2002

**THE WESTIN REGINA RESORT
PUERTO VALLARTA**

CO-SPONSORS:

Entertainment & Sports Law Section, State Bar of Georgia
Intellectual Property Law Section, State Bar of Georgia
Entertainment, Arts and Sports Law Section, The Florida Bar
The Tennessee Bar

SOCIAL SPONSORS

Alex Smith and Tom Slade, Morgan Keegan & Company
BMI
InteCap
United Mellon National Bank
Register.Com

**12 CLE HOURS INCLUDING
1 ETHICS HOUR, 1 PROFESSIONALISM HOUR
AND 1.5 TRIAL PRACTICE HOURS**



INTELLECTUAL PROPERTY LAW SECTION NEWSLETTER

Nestled between the green foothills of the Sierra Madre Mountains and the crystal blue waters of Bandera Bay, Puerto Vallarta leads the tranquil enchantment of a Mexican fishing village with cosmopolitan activities and amenities.

The Westin Regina Resort is a deluxe ocean front resort set on a lush tropical 21-acre site. All 280 rooms have view balconies and elegant Mexican décor. The resort has four outdoor swimming pools, tennis and a full fitness center. Additional activities at the resort include windsurfing, deep-sea fishing, jeep tours, horseback riding and an 18-hole golf course within walking distance.

SPACE IS LIMITED! THIS WILL BE A SELL-OUT!

PACKAGE INCLUDES

- Round trip airfare and departure tax
- 4 nights accommodations (double occupancy), including baggage portorage and housekeeping gratuities
- Round trip transfers between the airport and resort
- Welcome cocktail party on Wednesday evening with hot hors d'oeuvres sponsored by the Westin Regina
- Dinner and cocktails on Thursday evening sponsored by Alex Smith and Tom Slade, Morgan Keegan & Company
- Cocktail party and dinner extravaganza on Saturday evening sponsored by BMI
- Seminar refreshment breaks sponsored by ICLE
- Buffet breakfast daily in the El Palmar Restaurant

LAND ONLY PACKAGE: \$359 double, \$547 single, before 8/9/02 or \$434 double, \$622 single, after 8/9/02.

The group rate applies to three days before and three days after the seminar dates on a space-available basis.

INDEPENDENT TRAVEL ARRANGEMENTS: \$30 per person charge (paid in advance) to attend sponsored events only.

PACKAGE COSTS: Does not include seminar fee. Rates from other cities are available.

PAYMENT: DUE IN FULL AT TIME OF RESERVATION. A MINIMUM OF 1 PERSON PER ROOM MUST BE REGISTERED FOR THE SEMINAR. To register with full payment is due no later than August 9, 2002. Total package regular registration with full payment is September 9, 2002. Package registration will be handled on first come-first serve basis. Early registration is advised.

TRAVEL PACKAGE CANCELLATION POLICY: AIRFARE — nonrefundable once ticketed; ACCOMMODATIONS — Cancellations received before September 9 to a \$100 administrative cancellation fee and vendor penalties. No refund on cancellations received after October 1. ALL CANCELLATIONS MUST BE RECEIVED BY GEORGIA INTERNATIONAL TRAVEL.

If you have any questions about the travel package, please contact Donna Robertson, Georgia International Travel, (404) 851-9166 or at (404) 814-9166.

Optional travel insurance is available - Call Donna Robertson for details.

CUSTOMS REQUIREMENTS: citizens need a valid passport or birth certificate with a raised seal and a picture ID.

TRAVEL PACKAGE RESERVATION																																														
<p>NAME: _____ (Passenger Name, Proof of Citizenship & Frequent Flyer Name Must Match)</p> <p>GUEST/SPOUSE: _____</p> <p>FIRM NAME: _____</p> <p>BUS. ADDRESS: _____ (For Overnight or Courier delivery.)</p> <p>CITY/STATE/ZIP: _____</p> <p>PHONE: (Office) _____ (FAX) _____ E-MAIL _____</p> <p>Name on Credit Card: _____ Exp. date: ____/____/____</p> <p>Credit card Type and No.: _____</p> <p>Signature: _____</p> <p>I authorize Georgia International Travel to charge my credit card listed above for \$ _____.</p>	<p style="text-align: center;">TOTAL PACKAGE COST (per person)</p> <table style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th></th> <th style="text-align: center;">Early By 8/9/02</th> <th style="text-align: center;">Regular Between 8/9/02 & 9/9/02</th> </tr> </thead> <tbody> <tr> <td><input type="checkbox"/> From Atlanta</td> <td></td> <td></td> </tr> <tr> <td>Double Occupancy</td> <td style="text-align: right;">\$1023</td> <td style="text-align: right;">\$1098</td> </tr> <tr> <td>Single Occupancy</td> <td style="text-align: right;">\$1211</td> <td style="text-align: right;">\$1286</td> </tr> <tr> <td><input type="checkbox"/> From Miami</td> <td></td> <td></td> </tr> <tr> <td>Double Occupancy</td> <td style="text-align: right;">\$974</td> <td style="text-align: right;">\$1049</td> </tr> <tr> <td>Single Occupancy</td> <td style="text-align: right;">\$1162</td> <td style="text-align: right;">\$1237</td> </tr> <tr> <td><input type="checkbox"/> From Nashville</td> <td></td> <td></td> </tr> <tr> <td>Double Occupancy</td> <td style="text-align: right;">\$1258</td> <td style="text-align: right;">\$1333</td> </tr> <tr> <td>Single Occupancy</td> <td style="text-align: right;">\$1446</td> <td style="text-align: right;">\$1521</td> </tr> <tr> <td><input type="checkbox"/> From New York</td> <td></td> <td></td> </tr> <tr> <td>Double Occupancy</td> <td style="text-align: right;">\$999</td> <td style="text-align: right;">\$1074</td> </tr> <tr> <td>Single Occupancy</td> <td style="text-align: right;">\$1187</td> <td style="text-align: right;">\$1262</td> </tr> </tbody> </table> <p style="text-align: center;">LAND PACKAGE RATES (per person)</p> <table style="width: 100%; border-collapse: collapse;"> <tbody> <tr> <td><input type="checkbox"/> Double occupancy (Land package only) at</td> <td style="text-align: right;">\$359</td> <td style="text-align: right;">\$434</td> </tr> <tr> <td><input type="checkbox"/> Single occupancy (Land package only) at</td> <td style="text-align: right;">\$547</td> <td style="text-align: right;">\$622</td> </tr> </tbody> </table> <p>We are holding a limited number of seats from Atlanta on American and Continental. They are priced the same and flight times are similar. Every attempt will be made to accommodate your request, but seats are subject to availability at time of registration - BOOK EARLY. Please indicate your airline preferences in order: 1) _____; 2) _____</p> <p style="text-align: center;">SEND PACKAGE RESERVATION FORM TO: Georgia International Travel, 6195 Barfield Road, Suite 250, Atlanta, GA 30328. FAX: 404-851-1987</p>		Early By 8/9/02	Regular Between 8/9/02 & 9/9/02	<input type="checkbox"/> From Atlanta			Double Occupancy	\$1023	\$1098	Single Occupancy	\$1211	\$1286	<input type="checkbox"/> From Miami			Double Occupancy	\$974	\$1049	Single Occupancy	\$1162	\$1237	<input type="checkbox"/> From Nashville			Double Occupancy	\$1258	\$1333	Single Occupancy	\$1446	\$1521	<input type="checkbox"/> From New York			Double Occupancy	\$999	\$1074	Single Occupancy	\$1187	\$1262	<input type="checkbox"/> Double occupancy (Land package only) at	\$359	\$434	<input type="checkbox"/> Single occupancy (Land package only) at	\$547	\$622
	Early By 8/9/02	Regular Between 8/9/02 & 9/9/02																																												
<input type="checkbox"/> From Atlanta																																														
Double Occupancy	\$1023	\$1098																																												
Single Occupancy	\$1211	\$1286																																												
<input type="checkbox"/> From Miami																																														
Double Occupancy	\$974	\$1049																																												
Single Occupancy	\$1162	\$1237																																												
<input type="checkbox"/> From Nashville																																														
Double Occupancy	\$1258	\$1333																																												
Single Occupancy	\$1446	\$1521																																												
<input type="checkbox"/> From New York																																														
Double Occupancy	\$999	\$1074																																												
Single Occupancy	\$1187	\$1262																																												
<input type="checkbox"/> Double occupancy (Land package only) at	\$359	\$434																																												
<input type="checkbox"/> Single occupancy (Land package only) at	\$547	\$622																																												

A NOVEL EXPRESSION OF CONFUSION

THURSDAY, NOVEMBER 14, 2002

- A.M.
7:30 **REGISTRATION (All attendees must check in upon arrival)**
- 7:50 **WELCOME**
Darryl B. Cohen, Chair, Conference Joint Executive Committee; *Cohen & Cooper*, Atlanta
Scott L. Kenley, Entertainment & Sports Law Seminar Chair; VP, Business & Legal Affairs, Compendia Music Group, Nashville, TN
Jeffrey R. Kuester, Intellectual Property Seminar Chair, Thomas, Kayden, Horstemeyer & Risley, Atlanta
- 8:00 **TODAY'S INTERNET LAW FOR ENTERTAINMENT, SPORTS AND INTELLECTUAL PROPERTY ATTORNEYS**
Moderator: *Douglas M. Isenberg*, GigaLaw.com, Atlanta
Panelists: *Peter Corrigan*, McGuire Woods, New York, NY
Robert A. Rosenbloum, Greenberg Traurig, LLP, Atlanta
David J. Stewart, Alston & Bird LLP, Atlanta
- 9:30 **"YEAH, YOU'RE STUCK IN THIS ETHICS CLASS AGAIN." WAKE UP! ITS YOUR LICENSE!**
Moderator: *Anthony B. Askew*, Kilpatrick Stockton LLP, Atlanta
Panelists: *Hon. Carol W. Hunstein*, Justice, Supreme Court of Georgia, Atlanta
Julee L. Milham, Law Office of Julee L. Milham, St. Petersburg Beach, FL
Richard M. Nolen, Warner, Mayou, Bates, Nolen & Collins, P.C., Atlanta
- 10:30 **BREAK**
- 10:45 **LITIGATING INTELLECTUAL PROPERTY AND ENTERTAINMENT LAW CASES**
Moderator: *Richard Wolfe*, Pathman Lewis, LLP, Miami, FL
Panelists: *Karl Braun*, Hall, Booth, Smith & Slover, Nashville, TN
Brian Kaplan, Goodkind, Labaton, Rudoff, Sucharow, New York, NY
Daniel A. Kent, Needle & Rosenberg, Atlanta
Paul V. LiCalsi, Sonnenschein Nath & Rosenthal LLP, New York, NY
- P.M.
12:15 **RECESS**
- 7:30 **COCKTAIL PARTY AND DINNER
COURTESY OF ALEX SMITH AND TOM SLADE, MORGAN KEEGAN & COMPANY**

FRIDAY, NOVEMBER 15, 2002

- A.M.
8:00 **TRADEMARK LAW UPDATE**
Michael D. Hobbs, Jr., Troutman Sanders LLP, Atlanta
- PRODUCER AGREEMENTS WITH ARTISTS : "IS THE SKY THE LIMIT?"**
Moderator: *Alan S. Clarke*, Clarke & Anderson, Atlanta
Panelists: *Steven Drimmer*, President, Silver Light Entertainment, Los Angeles, CA
Pam Klein, Serling Rooks & Ferrara, New York, NY
Kent Marcus, Zumwalt, Almon & Hayes, Nashville, TN
Ephraim L. Michael, Greenberg Traurig, LLP, Atlanta
Steven S. Sidman, Greenberg Traurig, LLP, Atlanta
- 9:15 **BREAK**
- 9:20 **WHAT'S NEW IN INTELLECTUAL PROPERTY ASSET MANAGEMENT?**
Moderator: *Michael W. McLaughlin*, Managing Director, InteCap, Atlanta
Panelists: *Scott M. Frank*, President, BellSouth Intellectual Property Management Corp., Atlanta
David A. Kennedy, InteCap, Atlanta
Howard B. Krass, Intellectual Property Development, Inc., Coral Gables, FL
James A. Malackowski, Duff & Phelps Capital Partners, Chicago, IL
Gregory S. Smith, LAVA Group, Inc., Atlanta
- THE FUTURE OF AMERICA'S PASTIME**
Moderator: *Kim Kolback*, Attorney at Law, Miami, FL
Panelists: *Don M. Fehr*, Executive Director, Major League Baseball Players Association, New York, NY
Alan Fertel, Ferrell Schultz Carter Sumpiano & Fertel, Miami, FL
Gordon I. Kirke, Goodman & Carr, LLP, Toronto, Canada
Mike Maulini, Steinberg, Moorad & Dunn, Miami, FL
Scott A. Shapiro, Massey, Shapiro & Neiman, P.A., Miami, FL

TV AND FILM AS LAWYERS SEE THEM

- Moderator: *Darryl B. Cohen*, Cohen & Cooper, Atlanta
Panelists: *Michael Collyer*, Cascone, Cole & Collyer, New York, NY
Terry S. Freedman, Attorney at Law, Atlanta
Sofia Ioannou, Senior VP, Business Operations & General Counsel, MTV Latin, Miami, FL
Andrew J. Velcoff, Greenberg Traurig, LLP, Atlanta
- 10:35 **BREAK**
- 10:45 **PATENT LAW UPDATE**
Steven L. Park, Finnegan Henderson Farabow Garrett & Dunner LLP, Atlanta
A. Shane Nichols, King & Spalding, Atlanta
- MUSIC DEALS: THINKING OUTSIDE THE BOX**
Moderator: *James Zumwalt*, Zumwalt, Almon & Hayes, Nashville TN
Panelists: *Sandy Fox*, President, Fox Law Group, Los Angeles, CA
Scott Kenley, VP, Business & Legal Affairs, Compendia Music Group, Nashville, TN
Suzanne Kessler, VP, Business Development, Mercury Records/Lost Highway, Nashville, TN
Mark Stollman, Stollman & Grubman, BocaRaton, FL
- 12:15 **RECESS**

SATURDAY, NOVEMBER 16, 2002

- 8:00 **ADVANCED LICENSING ISSUES**
Moderator: *Jeffrey E. Young*, Alston & Bird LLP, Atlanta
Panelists: *Natalie Butto*, Counsel & Assistant Secretary, Tropicana, Bradenton, FL
Robert A. Currie, Georgia-Pacific, Atlanta
William B. Marianes, Troutman Sanders LLP, Atlanta
- RECORD AND PUBLISHING COMPANY ECONOMICS**
Moderator: *Michael Olsen*, COO, Compendia Music Group, Nashville, TN
Panelists: *Ivan Alvarez*, President, Universal Publishing Latin, Miami, FL
Gary Haber, Haber Corporation, Los Angeles, CA
Philip M. Walden, Jr., Jones & Walden LLC, Atlanta
Mark Watson, President, DM Records, Pompano Beach, FL
- 9:15 **BREAK**
- 9:20 **STRATEGIC PATENT LITIGATION ISSUES**
Moderator: *Stephen R. Risley*, Thomas, Kayden, Horstemeyer & Risley, Atlanta
Panelists: *James L. Ewing, IV*, Kilpatrick Stockton, LLP Atlanta
L. Norwood ("Woody") Jameson, Duane Morris, Atlanta
William M. Ragland, Jr., Powell, Goldstein, Frazer & Murphy LLP, Atlanta
- PLAYING THE LEGAL GAME IN FOOTBALL**
Moderator: *Bedelia C. Hargrove*, Biggins & Associates, Atlanta
Panelists: *Sylvia Krainen*, Adorno & Voss, P.A., Miami, FL
Lisa Lazarus, Labor Relations Counsel, NFL Management, New York, NY
Kimarie Stratos, Attorney at Law, Miami, FL
James J. Thomas, II, McKenna Long & Aldridge LLP, Atlanta
- LITERARY PUBLISHING DEALS ANALYZED**
Anthony W. Morris, Arnall Golden & Gregory, LLP, Atlanta
Andrew J. Velcoff, Greenberg Traurig, LLP, Atlanta
- 10:35 **BREAK**
- 10:45 **COPYRIGHT LAW UPDATE**
James A. Trigg, Kilpatrick Stockton LLP, Atlanta
- RECORDING DEALS—STRETCHING THE ENVELOPE: "HOW FAR WILL RECORD COMPANIES ACTUALLY GO IN TODAY'S MARKET?"**
Moderator: *Andrew Tavel*, Greenberg Traurig, LLP, New York, NY
Panelists: *Orville Almon*, Zumwalt, Almon & Hayes, Nashville, TN
J. Reid Hunter, Serling Rooks & Ferrara, New York, NY
Jess L. Rosen, Greenberg Traurig, LLP, Atlanta
Kathy Woods, VP, Business and Legal Affairs, RCA Label Group, Nashville, TN
- P.M.
12:15 **ADJOURN**
- 7:30 **COCKTAIL PARTY AND DINNER AT THE WESTIN REGINA RESORT
COURTESY OF BMI**

INTELLECTUAL PROPERTY LAW SECTION NEWSLETTER

Please submit a **copy** of this registration form if you wish to keep the agenda on the reverse side of this page intact.

PUERTO VALLARTA 2002 SEMINAR • NOV. 13-17, 2002 • 5165

NAME _____
GEORGIA BAR MEMBERSHIP NUMBER _____ OFFICE PHONE (_____) _____
MAILING ADDRESS _____ ZIP + 4 _____ - _____
STREET ADDRESS _____ ZIP + 4 _____ - _____
(Street address necessary — advance delivery of books is by UPS)

SEMINAR REGISTRATION FEE — ON OR BEFORE 8/30/02: \$210 AFTER 8/30/02: \$235 ON-SITE: \$275

- A guest will accompany me. Guest's Name: _____
- I am unable to attend. Please send program materials and bill me for the cost of materials only. (BOOK AND PRICE unavailable until AFTER the seminar.) Sorry, no phone orders! COMPLETE ENTIRE FORM and address book orders to ATTN: Publications.
- I have enclosed a check for the following amount: \$ _____
- I authorize ICLE to charge my MASTERCARD VISA AMERICAN EXPRESS DISCOVER for the following amount.

Total amount to be charged \$ _____. Account #: Exp. Date: ____/____

Signature: _____

We cannot accept phone registrations. Your registration may be faxed or mailed - Duplicate registrations may result in multiple charges to your account. A \$15 administrative fee will apply to refunds required because of duplicate registrations.

✉ MAIL REGISTRATIONS TO: P.O. BOX 1885, ATHENS, GA 30603-1885 (make checks payable to ICLE)

☎ FAX REGISTRATIONS TO: 706-354-4190 (credit card payment must accompany fax to be processed)

Visit us on-line at www.iclega.org

© 2002 Institute of Continuing Legal Education in Georgia

Questions? Call ICLE Toll Free: 1-800-422-0893 • Athens Area: 706-369-5664 • Atlanta Area: 770-466-0886



INSTITUTE OF CONTINUING LEGAL EDUCATION IN GEORGIA
P.O. Box 1885
ATHENS, GA 30603-1885

PLEASE NOTE:

REGISTRATIONS RECEIVED AFTER

SEPTEMBER 9

WILL BE FILLED BASED ON AVAILABILITY

CALENDAR OF EVENTS

Copyright Roundtable	Fall 2002
Electronic Trademark	October 10, 2002
Filings: A New Reality with the PTO	at Troutman Sanders 11:45 a.m. - 1:30 p.m.
Patent Roundtable	October 2002
	at King & Spalding 11:45 a.m. - 1:30 p.m.
Executive Committee Meeting	November 7, 2002
	at Jocks & Jills - Midtown 5:30 p.m. - 6:30 p.m.
Section Social	November 7, 2002
	at Jocks & Jills - Midtown 6:30 p.m.
Annual Institute	November 13 - 17, 2002
Section Holiday Party	December 12, 2002
Executive Committee Meeting	January 8, 2003
Patent Roundtable	Winter 2003
Women in IP Spotlight	Spring 2003
Trademark Luncheon: Domain Name/Internet Issues	February 2003
Mardi Gras Section Social	March 2003
Executive Committee Meeting	March 5, 2003
Patent Roundtable	Spring 2003
Trademark Luncheon	April 2003
Patent Roundtable	Summer 2003
Executive Committee Meeting	May 7, 2003



EDITOR'S NOTES

by N. Andrew Crain

Greetings and welcome to the (late) Summer issue of the Intellectual Property Law Section Newsletter, *A NOVEL EXPRESSION OF CONFUSION*. I hope that you find this issue informative and interesting, as it is my first opportunity to publish the newsletter for the section.

First and foremost, I would like to thank Jeff Kuester, Chair of the IP Law Section, for inviting me to serve as the newsletter's editor. I would also like to thank Ms. Lesley Smith, State Bar of Georgia Section Liaison, for her efforts in helping to prepare and distribute the newsletter to all of the members of the section. Ms. Smith provided information used in the piece charting the explosive growth of our section, which is found on page 2. Thanks also to Ms. Gayle Baker; State Bar of Georgia, Director of Membership; who also contributed raw data used to generate the membership chart on page 2. Of course, this newsletter would not have gotten off the ground without the efforts of Mrs. Theresa James who created the layouts that matured into this final version. Mrs. James also endured several rounds of back-and-forth edits.

I also would like to thank Ms. Schuylla M. Goodson, immediate past newsletter editor. Ms. Goodson did a substantial amount of the early work in creating this issue of the newsletter, and she also contributed an outstanding piece on *Women in I.P. in Georgia*. This issue's piece features Ms. Sandy Evans, recently retired Vice President and General Counsel at BellSouth Intellectual Property Management Corporation. Look for additional *Women in I.P. in Georgia* articles in future issues of the newsletter highlighting other women in Georgia's IP community.

This issue contains an interesting article by Shane Nichols of King & Spalding about *Festo*. The article discusses the battle between the doctrine of equivalents and the doctrine of prosecution history estoppel and also provides a thorough analysis of the Supreme Court's decision. Mr. Nichols' article offers practical guidance for patentees and accused infringers in light of the Court's decision.

This issue also reports on several recent events that have occurred in our section as well as several upcoming events. More specifically, if you have not reserved your spot for Puerto Vallarta in November, check out pages 11-14, which include the official registration form. Please note, however, that any registrations received at this point will be filled based on availability. Therefore, if you are interested in going, complete and submit this registration form today.

Finally, if you have an article that you would like to have published in a future issue of the IP Section Newsletter, please contact me at andrew.crain@tkhr.com. Submission deadlines for future issues are as follows:

Fall issue – October 15, 2002
Winter issue – January 15, 2003
Spring issue – April 15, 2003

We will also consider reprinting recent, timely, and interesting articles previously published in other periodicals *if* permission is obtained from the previously publishing periodical.

Andrew is an associate with the intellectual property law firm of Thomas, Kayden, Horstemeyer & Risley, LLP. Andrew's practice is concentrated on patent and trademark preparation and prosecution and related litigation in a wide range of electrical and electromechanical arts, including computers, software, and telecommunications. Andrew earned both this B.S. in Electrical Engineering and his J.D. from the University of Alabama.

INTELLECTUAL PROPERTY LAW SECTION NEWSLETTER



*Standing
(from left to right):
Wab Kadaba,
Todd McClelland,
Griff Griffin,
Jeff Kuester,
Doug Isenberg,
Mike Hobbs,
Frank Landgraff,
and Andrew Crain*

*Sitting:
Schuylla Goodson,
Julie Sinor,
Judith Dray*

*(Not Pictured:
Scott Frank)*

The
State Bar
of
Georgia

Intellectual
Property Law
Section

Executive Committee

Jeffrey R. Kuester (jeff.kuester@tkhr.com)
Thomas, Kayden,
Horstemeyer & Risl ey LLP *Chair*
100 Galleria Parkway, Suite 1750
Atlanta, GA 30339
Tel: 770/933-9500
Fax: 770/951-0933

Scott M. Frank (SCOTT.FRANK@BELLSOUTH.COM)
Bell South Intellectual Property
Management Corp. *Chair-Elect*
1155 Peachtree St., Suite 500
Atlanta, GA 30309
Tel: 404/249-3345
Fax: 404/249-2822

Michael D. Hobbs, Jr.
(michael.hobbs@troutmansanders.com)
Troutman Sanders LLP *Vice-Chair*
600 Peachtree Street, Suite 5200
Atlanta, GA 30308-2216
Tel: 404/885-3330
Fax: 404/962-6588

Douglas M. Isenberg (disenberg@GigaLaw.com)
GigaLaw.com *Secretary*
5310 South Trimble Road
Atlanta, GA 30342
Tel: 404/256-0610

Griff Griffin (ggriffin@sablaw.com)
Sutherland Asbill & Brennan LLP *Treasurer*
999 Peachtree Street, Suite 2300
Atlanta, GA 30309-3996
Tel: 404/856-8233
Fax: 404/853-8806

N. Andrew Crain (andrew.crain@tkhr.com)
Thomas, Kayden,
Horstemeyer & Risl ey LLP *Newsletter
Committee Chair*
100 Galleria Parkway, Suite 1750
Atlanta, GA 30339
Tel: 770/933-9500
Fax: 770/951-0933

Julie Sinor (jsinor@kslaw.com)
King & Spalding *Website Committee Chair*
191 Peachtree Street, N.E.
Atlanta, GA 30303-1769
Tel: 404/572-4991
Fax: 404/572-5128

Todd S. McClelland (tmcclelland@alston.com)
Alston & Bird *Social Committee Chair*
One Atlantic Center
1201 West Peachtree Street
Atlanta, GA 30309-3424
Tel: 404/881-4789
Fax: 404/881-7777

Schuylla Goodson (sgoodson@na.ko.com)
The Coca-Cola Company *Trademark
Committee Chair*
Trademark Counsel
P.O. Drawer 1734
Atlanta, GA 30301
Direct: 404/676-0582

Wab Kadaba (wkadaba@kilpatrickstockton.com)
Kilpatrick Stockton LLP *Patent
Committee Chair*
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309-4530
Tel: 404/815-6500
Fax: 404/815-6555

Judith Dray (judith.dray@turner.com)
Turner Broadcasting *Copyright
Committee Chair*
Turner Entertainment Group, Inc.
1050 Techwood Dr., NW., 3rd Floor
Atlanta, GA 30318
Tel: 404/575-6079
Fax: 404/885-2136

Frank A. Landgraff (frank.landgraff@ps.ge.com)
GE Power Systems *Licensing Committee Chair*
4200 Wil dwood Parkway
Atlanta, GA 30339
Tel: 678/844-5494