The State Bar of Georgia

Intellectual Property Law Section NEWSLETTER

A Novel Expression of Confusion

Jeffrey R. Kuester, Chair — Winter 2003 — N. Andrew Crain, Editor

Chair's Comments...

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

Thanks to the volunteering efforts of many people in our Intellectual Property Law Section, we have continued to stay very active over the last few months. On December 10th the Section hosted a large luncheon with Stephen Kunin, Deputy Commissioner for Patent Examination Policy with the United States Patent and Trademark Office. Two days later, on December 12th, the Section hosted its Holiday Party at Vinocity.

Kicking off the new year in grand style, our Section next hosted a large luncheon on "Pioneers in IP: A Female Perspective," followed by a very well-attended CLE presentation at the State Bar Mid-Year meeting on January 10th. On February 26th, at the new State Bar headquarters, the Patent Committee of the Section provided another Patent Roundtable, which was hosted by Finnegan, Henderson, Farabow, Garrett and Dunner and featured R. Bruce Bower as the speaker.

In addition to these recent events, it is also worthwhile to note that our Section is providing support in time and money to two different non-profit organizations. Our Section co-sponsored a Copyright Town Meeting with the National Initiative for a Networked Cultural Heritage (NINCH), www.ninch.org, which is a diverse coalition of organizations created to assure leadership from the cultural community in the evolution of the digital environment. In addition to our Section contributing $500 for co-sponsoring the Copyright Town Meeting, I provided welcoming remarks at the event. The Copyright Town Meeting informed participants of recent developments in copyright law and provided a forum for Atlanta's cultural community to share ideas about preserving cultural information online while complying with existing copyright laws.

Our Section also continued its support of the Georgia Lawyers for the Arts by contributing $1,000 and participating in its Fundraising Gala. The Gala was hosted at The Lowe Gallery, and the Honorary Chair was Atlanta Mayor Shirley Franklin. Our Section was a Gold Level Sponsor and was represented at the Gala by Mike Hobbs (Section Vice-Chair), Judy Dray (Copyright Committee Chair and a GLA Board Member), and Julie Sinor (Chair of the Communications/ Website Committee).

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USPTO's Stephen Kunin Speaks to IP Section

On December 10, 2002, the IP Section hosted a CLE luncheon at the Clubhouse restaurant at Lenox Square Mall, which was extremely well attended. The keynote speaker was PTO Deputy Commissioner of Patent Examination Policy, Stephen G. Kunin.

PTO Deputy Commissioner of Patent Examination Policy, Stephen G. Kunin

Stephen Kunin has over 30 years of experience within the USPTO and has served in posts throughout the organization. He holds both law and engineering degrees and has served as a guest lecturer to numerous law schools. He has received the prestigious Reinventing Government Hammer Award from the vice president as well as several top awards from the Department of Commerce.

Much of the discussion involved some of the recent changes to 35 U.S.C. § 102(e) and 374, as enacted by HR 2215. Mr. Kunin discussed how the enactment of HR 2215 completely replaces the old § 102(e), as set forth in the AIPA, and how it is also retroactively effective to the date of the AIPA, which was November 29, 2000.

Mr. Kunin discussed how § 102(e), after the enactment of HR 2215, is similar to the pre-AIPA § 102(e), with two major differences. The first difference, Mr. Kunin explained, provides that certain publications of U.S. and international (PCT) applications (IAs), in addition to U.S. patents, may now qualify as prior art references under 35 U.S.C. § 102(e). Additionally, certain international filing dates may be considered as priority dates under § 102(e), which means that those dates may be used as the prior art date of a reference to make rejections under § 102(e) and § 103(a).

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CALENDAR OF EVENTS*

Event	Date
Patent Roundtable	Spring 2003
Trademark Luncheon	April 2003
Patent Roundtable	Summer 2003
Copyright Luncheon *(with Entertainment Section)*	May 2003
Executive Committee Meeting	May 8, 2003
IP Speaker Event	May 22, 2003
Patent Litigation Seminar	TBA
Summer Associate Event	June 2003 *(Park Tavern)*
Licensing CLE Event	TBA (*tentatively September 2003*)

*** Be sure to check the web site for updates**

EDITOR'S NOTES

by N. Andrew Crain

Greetings and welcome to the late-Winter/early-Spring edition of the Intellectual Property Law Section Newsletter, A NOVEL EXPRESSION OF CONFUSION. I characterize it as "late-Winter/early-Spring" because even though Spring is here, this edition covers many events from the past Winter. We initially intended to publish this edition six weeks ago, but day jobs prevented that.

This edition includes two interesting articles authored by two female members of our Section, which actually dovetails nicely with the article on the Women in IP luncheon on page 6. Ms. Joan Dillon, who recently launched her solo practice, has been practicing intellectual properly law, and specifically trademark law, since 1966, and she wrote about the potential benefits/detriments of the Madrid Protocol. Ms. Cynthia Lee, an associate attorney at Thomas, Kayden, Horstemeyer & Risley, wrote an article about claiming protein three-dimensional structure in the U.S., Japan, and Europe. These ladies are two of the many reasons that our IP Section is such a dynamic and vibrant community with an extremely broad knowledge base. I extend my thanks to both Ms. Dillon and Ms. Lee for contributing to this edition. Ms. Lee also assisted in editing this edition, which is thoroughly appreciated.

I also would like to thank Ms. Theresa James in assisting in the preparation of this edition. As with prior editions, she did an outstanding job.

If you have an article that you would like to have published in the (later) Spring edition of the IP Section Newsletter, please contact me at andrew.crain@tkhr.com. The submission deadline is May 15, 2003.

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.

NOTICE...

We need your input

The Executive Committee is in the process of planning the 9th Annual Intellectual Property Law Institute - Seminar. In recent years, the event has been held in Puerto Vallarta, Mexico; however, new locations are being considered. Here is where we need your input.

Would you prefer this year's Annual Intellectual Property Law Institute to be in

JAMAICA or GEORGIA?

Please email your preference to

feedback@georgiaip.org

Stay tuned for the outcome.

THE MADRID PROTOCOL: IS THERE AN OVERALL BENEFIT TO ANYONE?

by Joan L. Dillon
Joan Dillon Law, LLC

Joan L. Dillon, Esq.

Much has been written about the Madrid Protocol, and most of what has been written appears simply to discuss the historical underpinnings of the legislation, to give a nod at the rationale behind the adherence to it, to analyze and dissect the legislation—most often contrasting it to its closest sibling, the Madrid Arrangement—to discuss concerns about the member countries' capability to implement the legislation, and to set forth some general guidelines on its workings. Most of the information available today is found on the websites of a number of firms having some International practice capability; however, of most interest to this writer is the fact that while almost all of the commentators exhibit some general understanding of the rationale for the plan, the basics of the legislation, and how the implementation is supposed to work, almost none of the commentators exhibit a strong opinion either in favor of or against the Protocol. Perhaps the reason for the lack of strong opinions is that whether the Protocol is beneficial or detrimental is a function of one's point of view, or one's role as a trademark owner or the representative of a trademark owner. One's viewpoint might also be influenced by the inherent registrability of the mark or marks that you will want to register under the Protocol. Many marks, registrable under one scheme of examination, are not registrable under another.

For many years, the Madrid Arrangement served as a unifying economic force in many countries, principally in Europe, wherein registration under this Arrangement was possible. Nationals of countries outside the Arrangement could not avail themselves of the central filing and deposit scheme offered, obtain the economies of the central filing, nor even take an Arrangement registration by assignment. The Arrangement placed such constraints on its membership as the inability to transfer registrations to nationals of countries who are not members of the Arrangement, the vulnerability of the extended deposits of registration to central attack on the home country registration, and the need for filings to be in French. The Madrid Protocol is seen as a close relative of, and a distinct improvement upon, the Madrid Arrangement. There are currently approximately 55 member countries, including the United States, which joined in November 2002.

In the final incarnation of the Madrid Protocol, and as a predicate to adherence to it by the United States, applicants are allowed the right to file in English or in French, and the voting rights issue was resolved by the European member states (which formerly could have 2 votes: one for being a member of the European Union and one for being a member of the Arrangement) giving up the double vote and agreeing that there would be no more votes than there were total members of the European Union. Presumably, issues such as the United States' requirement of a showing of use as a predicate to registration (extraordinarily novel as viewed by the rest of the world), were resolved. The United States, following quickly in the footsteps of Great Britain, Japan and Australia, adhered to the Protocol and bound itself to implement filings thereunder by November 2003.

Most of the current information about the Protocol deals principally with how it is supposed to work; nevertheless, a brief summary of the process is in order and a predicate to understanding the benefits that might be realized by the United States' trademark owner (Owner) or private trademark practitioner (Practitioner). An Owner files an application in English in the United States Patent and Trademark Office and applies for international registration in specified countries, paying an initial filing fee of a set amount (an amount to be set by the PTO, and expected to be in the neighborhood of $450) and a separate, nominal filing fee for each country in which deposit of the registration is requested. The PTO has two months within which to transmit the deposit to the World Intellectual Property Organization (WIPO) in order to maintain the priority of the original filing date. WIPO then examines the application for compliance with certain formalities, and if all is in order, issues a registration and notifies the trademark registries in each of the deposit countries of the designation.

The designated deposit country registry has either 12 or 18 months to examine the application for extension, according to its own locally-established registration criterion and time frame. If the application is approved, it is published for opposition in those countries having the opposition procedure and is registered in those that do not require publication. If the application is opposed, it must be opposed within the time designated for review and approval; otherwise, the registration will be considered extended. If the application is opposed within the time set for review, an additional seven months may be granted for disposition of the opposition.

If the process functions as intended, the Owner has filed a single application, paid a reasonable filing fee and deposit fees, and has gained a conglomeration of national registrations serving to protect his mark throughout a very broad world market—and has done so all in a single filing, either pro se or through one Practitioner. Further, he has assured himself that renewal of the registration will be easy. The Owner may renew his registration simply by making a central filing with the International Bureau rather than with several trademark offices through a myriad of trademark agents or counsel.

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While there appear to be few drawbacks to this apparent boon, these drawbacks are significant.

In the first instance, the Owner places the priority his application may enjoy in the hands of his national registry. If the registry is not efficient, or makes a timing error and does not forward the application to WIPO within the three months allotted, the extensions of the application will lose priority.

The Owner suffers from an inability to make a valid assignment of his registration to a national of a country outside of the Protocol member countries.

The Owner's International registration is dependent upon the viability of his home country application and registration. If an application fails in the examination process or a registration is cancelled for any reason, the Owner loses his entire world portfolio of registrations. This devastation is sought to be remedied by a procedure called "transformation." Within three months of the failure of a home country application or canceled registration, the Owner may seek independent national registrations in the deposit countries by paying additional fees and hiring and empowering local counsel to file, thus essentially rebuilding his portfolio at substantial cost. While "transformation" was also one of the lures that convinced the United States to adhere to the Protocol, one wonders if it makes sense to suffer the risk that this capability will be necessary. One also wonders if the short amount of time available for the discovery of the cancellation and the preparation of powers and instruction to counsel—who certainly will be happy to charge a substantial sum upon realizing that they are the last resort for the Owner—even makes use of "transformation" particularly feasible.

The "economical" filing fee may not be so economical after all. Since the filing fee for a basic United States application is expected to be about $450 and the deposit fee per country is expected to be about $50 for each country designated, these numbers can add up rapidly. An Owner who utilizes the process for 50 countries might find himself paying about $3000 in filing fees alone.

The Owner may also find that his mark is registrable in the United States when the mark is only suggestive or descriptive, but may not be registrable without a showing of acquired distinctiveness under the tougher scrutiny of other registries, such as the United Kingdom or Australia. A mark may fail for other reasons of inherent registrability under the guidelines of other countries.

Finally, the Owner of the United States home country application is held to a much higher standard than the owner of applications in the majority of the Protocol countries. In the United States, the Owner is required to state with almost excessive specificity the goods or services covered by his mark. In most of the world, use of more general terms, or even Classification headings, is allowed. The United States requires the Owner to prove use of his mark prior to registration; however, most Protocol countries do not require a showing of use as a prerequisite. Finally, once a registration is issued, most countries require that use be made, but the registry does not take the initiative of canceling the registration if use is not made, and it remains for an interested party to file a petition for cancellation. In the United States, the registrant has an affirmative duty to file a use affidavit between the fifth and sixth years of registration to prevent the PTO from canceling his registration. Presumably, since the affidavit need not be filed until after the fifth anniversary of the registration, deposit country registrations will not be affected by the failure of a registration in its sixth year.

So, whether the Protocol is a boon or a bust for the trademark Owner depends upon a number of factors, all of which must go well for the Owner lest he suffer the loss of his priority, or his registrations, or is called upon to pay substantial additional fees.

So what about the trademark Practitioner? Does the fact that foreign nationals may file in the United States through WIPO rather than through local counsel auger ill for the economics of the prosecutionist? In truth, probably not. In the application stage, the non-U.S. Owner without a high level of knowledge is likely to fall into the trap of misdescribing the goods or services. Even if the greatest care is taken in the description of a trademark, such descriptions often prompt Office Actions that require the retention of a Practitioner to negotiate the application through the examination procedure. Office Actions can contain other bases for rejection. There is likely to be rejections based upon descriptiveness, or even informality of the drawing. In these situations, local counsel must be retained to do business with the PTO on behalf of the unsophisticated or inexperienced applicant. One can only suppose too that the Practitioner will then be required to submit the Section 8 and 15 Affidavit on behalf of the non-U.S. owner. Ideally, the Madrid Protocol allows that renewal may be made by a central filing to WIPO, but one can only believe that the PTO will also require use of the mark, a specimen, and the intervention of the local Practitioner. Finally, the Practitioner must be certain that his docketing system has kept up with the changes in time mandated by the Protocol.

Whether the Protocol will benefit or impede the Owner depends on the Owner's sophistication in maneuvering through system, the inherent registrablity of his mark, the timeliness of his filings, and the strength of his applications and registrations. The Practitioner is unlikely to suffer from the lack of problem applications in need of prosecution. In either case, the implementation guidelines are expected by November, and, in all likelihood, will require substantial study.

Joan Dillon has been practicing trademark law since 1966; initially, as in-house trademark counsel to Ralston Purina Company, United States Steel and Levi-Strauss & Co. She entered private practice in San Francisco, in a small patent and trademark boutique, and later became a partner in a 27 attorney boutique in Washington, D.C. For the last 11 years she has served as a trademark counsel and partner in 2 of Atlanta's largest firms. Having done everything else, she has started her own practice.

A NOVEL EXPRESSION OF CONFUSION

CLAIMING PROTEIN THREE-DIMENSIONAL STRUCTURE IN THE U.S., JAPAN, AND EUROPE

by Cynthia J. Lee
Thomas, Kayden, Horstemeyer & Risley L.L.P.

Cynthia J. Lee, Esq.

On November 29, 2002, the U.S. Patent and Trademark Office (USPTO) announced the publication of a report, prepared and issued in conjunction with the Japanese Patent Office (JPO) and European Patent Office (EPO), that provides guidance for filing patent applications related to three-dimensional protein structures in each of the Offices. The report is helpful to patent practitioners filing for protection on proteomics-based inventions both here and abroad.

Proteins are extremely complex combinations of amino acids and are essential constituents of all living cells. Proteins regulate biological function and play a vital role in developing new pharmaceuticals. Computer modeling and screening algorithms applied to data can now define a protein by its complex three-dimensional (3-D) structure to aid in designing potential pharmaceuticals. By using computer modeling and screening algorithms to define proteins, the drug discovery process can be sped up and its associated costs reduced.

As more 3-D structures are elucidated, both for proteins and other chemical structures, the three Patent Offices expect that increasing number of applications will be filed relating to such 3-D structural information. Nearly 90% of the world's patents are issued through the U.S., Japanese and European Patent Offices. Given their expectation of the emerging importance of 3-D structural information, the three Offices conducted a comparative study to enhance understanding amongst the Offices and practitioners concerning the examination of 3-D structure related claims.

The three Offices have similar requirements with respect to patentability in general, *i.e.*, novelty, inventive step (or "nonobviousness" in the U.S.), industrial applicability (or "utility" in U.S.), description and enablement of the disclosure, and clarity (or "definiteness" in U.S.) of claims. The Offices differ in their definitions of what constitutes patent eligible subject matter. In the study, the Offices examined eight exemplary cases in which the prior art, specification and claims were briefly described. For each of the cases, each Patent Office answered the same questions relating to whether the case involved patent eligible subject matter, and whether its requirements for patentability had been met. Additionally, the Offices were invited to submit comments for each of the cases on the kind of evidence, argument and/or claim amendment that may overcome any rejection they may give based on the patentability requirements.

The eight cases examined were: (1) 3-D structural data of a protein *per se*; (2) computer-readable storage medium encoded with structural data of a protein; (3) a protein defined by its tertiary structure; (4) crystals of known proteins; (5) binding pockets and protein domains; (6) a first case of *in silico* screening method directed to a specific protein (with one type of method claim and a certain specification); (7) a second case of *in silico* screening method directed to a specific protein (with different types of claims from that of the first case, and a different specification); and (8) pharmacophores and pharmacophore-defined compounds (pharmacophores defined by the distance between atom groups). A pharmacophore is a molecular framework that carries the essential features responsible for a drug's biological activity.

The Offices shared common views on nearly every claim set. The study was particularly helpful in identifying cases where the patentability requirements were *not* met. In particular, the Offices agreed that the following did not constitute patent eligible subject matter: computer models of proteins; data array comprising atomic coordinates of a protein; computer-readable storage medium encoded with atomic coordinates of a protein; database encoded with data comprising names and structures of compounds; and pharmacophores. In cases where no references teach or suggest the 3-D structure of a protein, but there is enough reason to expect that the claimed protein would be *prima facie* identical to a protein of the prior art, the claim for the protein itself having the structure defined by the structural coordinates does not comply with requirements of novelty. In cases where a protein was previously known, the claim for an isolated and purified molecule comprising a binding pocket of the protein defined by the structural coordinates did not comply with any of the patentability requirements.

A claim for compounds or their salts in general defined by a certain pharmacophore does not meet one or more of the requirements of enablement, support, clarity and/or written description because a pharmacophore, an abstract concept, does not define a specific compound. Additionally, the Offices found that it would require undue experimentation, beyond what is expected of a person having ordinary skill in the art, to envision a ligand structure other than the ones described concretely in the examples, and to make such a compound.

With respect to *in silico* screening methods, a claim for compounds in general identified by *in silico* screening methods does not comply with enablement, support, clarity and/or written description. Further, in a case where the description gives no work-

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MID-YEAR MEETING LUNCHEON SHEDS LIGHT ON FEMALE IP SUCCESS STORIES

Contrary to today's statistics, only a short time ago females formed only a small fraction of law school graduates. Consequently, women practicing in the world of IP were far and few between. Couple that with the statistics on females graduating with science or engineering backgrounds, and that left an even slimmer pool of female patent law candidates. It is the unique perspective of women who broke into IP law during this time that became the focus of this year's Mid-Year luncheon.

The luncheon, held January 10, 2003, was hosted by the Intellectual Property Law Section on the topic of "Pioneers in IP: A Female Perspective." The three guest panelists were Virginia S. Taylor of Kilpatrick Stockton, LLP; Joan L. Dillon of Joan Dillon Law, LLC; and Marla Church of Thomas, Kayden, Horstemeyer, and Risley, LLP. Combined, the three panelists represented a vast amount of experience with IP concentrations in Trademark, Copyright, and Patent Law.

Judith Dray of Turner Broadcasting System, Inc. guided the panel's discussion. Each panelist took a trip down memory lane to share her personal experiences. The discussion topics included success stories, career memoirs, greatest challenges, most esteemed mentors and influences, and the vision for the future of women in IP.

For example, when asked about her greatest challenges, Ms. Taylor submitted that she is not presented with challenges, but rather a vast number of opportunities to succeed. In relation to beneficial experiences, Ms. Dillon perceived her time working in-house as extremely advantageous, giving her unique insight into the needs of her clients. When asked about her career beginnings, Ms. Church related her experience assisting counsel with a patent disclosure while employed as a laboratory scientist. It was this pivotal encounter that sparked her aspiration to become a patent attorney. These are merely examples of the anecdotal moments that encompassed the engrossing accounts of these exceptional women.

Judith Dray, Treasurer-elect, moderated the discussion

The lunch provided yet another opportunity to collect a unique perspective from fellow attorneys. The accounts of the panelists brought recognition to how far women have progressed in the profession. Certainly, these successful panelists have helped pave the way for generations of women who follow behind them. Those in attendance could truly appreciate the challenges these women faced making their name in a male-dominated field, balancing their family with work, and ultimately achieving success and recognition that only the best in our field realize.

The panelists include (from left to right): Virginia S. Taylor, Joan L. Dillon, and Marla Church

IP SECTION HOLDS INTELLECTUAL PROPERTY LAW UPDATE CLE AT MIDYEAR MEETING

Panelists from left to right: Michael Hobbs, James Trigg, Steven Park and Shane Nichols

The IP Section hosted its Annual Intellectual Property Law Update CLE Seminar during the State Bar of Georgia's Midyear meeting held in Atlanta on January 10, 2003. Attendees received three CLE hours and learned about recent developments in patent, trademark, and copyright law. The same speakers from the IP Section's prior Puerto Vallerta trip (last November) have in recent years delivered the CLE presentations at the Midyear meeting, and this year was no exception.

Michael Hobbs of Troutman Sanders delivered the Trademark Law Update. Michael Hobbs has been a member of the section for over ten years, and he is currently the Section's Vice-Chair. Michael's presentation was extremely informative and well received.

Just like last year, James Trigg, of Kilpatrick Stockton, gave the Copyright Law Update. Although James began his presentation with a disclaimer that 2002 was probably not as exciting, at least in regard to significant copyright law decisions, as 2001 when Napster and other decisions came down, he still indicated that there were still many interesting developments. James did discuss, however, the Supreme Court's *Eldred* decision (123 S. Ct. 769). James discussed how *Eldred* held that the Copyright Term Extension Act, which enlarged the duration of copyrights by 20 years, did not violate the First Amendment or the Copyright and Patent Clause of the Constitution.

The patent law update was delivered Shane Nichols of King & Spalding and Steven Park of Finnegan Henderson Farabow Garrett & Dunner. Shane spoke about several Federal Circuit decisions that came down in 2002. Steven focused much of his presentation on a recent Supreme Court case, *Vornado Air* (121 S. Ct. 189), that held that the Federal Circuit's jurisdiction over appeals from district court patent rulings covers only cases where the patent claim is in the complaint and does not extend to disputes in which a patent claim is only raised in a responsive pleading.

As seen in these pictures, the CLE was well attended and yet another opportunity for section members to network with each other.

Claiming *(Continued from page 5)*

ing examples of identifying compounds using the atomic coordinates of the protein, and the difference between the prior art and the claimed invention as a whole is limited to atomic coordinates stored on a machine, the claim for an *in silico* screening method does not comply with one or more of patentability requirements.

The Offices also identified a few instances in which their patentability requirements had been met. A claim for a crystalline form of a protein meets all of the requirements since a protein is a composition of matter that is patent eligible subject matter, with certain caveats. It must be well established in the art that the crystalline form of the protein has utility or industrial applicability, without any particular guidance as to how to crystallize the protein. In the prior art, however, there must not be a reference that teaches or suggests a crystal of the protein or related proteins. Further, the specification must teach how to make the claimed crystals, and one skilled in the art must be able to use the protein crystal without undue experimentation. Additionally, the claim itself should include a characterization of the crystal structure, *e.g.*, identifying cell unit dimensions.

Also found to meet the requirements of patentability was a claim for an isolated and purified polypeptide consisting of a portion of a protein with certain signaling activity. The Offices found such a claim to be patentable because it is limited to a fragment of the protein that contains the binding pocket, as long as the specification shows that the polypeptide retains the binding activity and signaling activity of the protein, as well as a significantly higher signaling activity compared to the entire protein. Additionally, the prior art must not teach a polypeptide which consists of the claimed specific part of the protein, or methods to specify parts of the polypeptide.

The report from the three Offices presents a good starting point for biotechnical patent practitioners seeking to draft patent applications for 3-D chemical structures. It clearly sets forth certain pitfalls to avoid, as well as the types of information that need to be included in the specification in order to properly support the claims. The full report, detailing each of the cases studied, can be downloaded from the USPTO website at:

http://www.uspto.gov/web/tws/wm4/pdf/wm4_3d_report.pdf.

Cynthia Lee is an associate with the firm Thomas, Kayden, Horstemeyer & Risley, LLP. Cynthia is a registered patent attorney before the U.S. Patent & Trademark Office. Cynthia's practice focuses on chemical and biotechnical patent prosecution, trademark prosecution, and intellectual property litigation.

PTO's Kunin Speaks to Section *(Continued from cover)*

If a U.S. Patent issues from, or claims the benefit of, an international application (IA), the U.S. patent's prior art date could be the filing date of the IA in each of the following three conditions are satisfied: (1) the IA was filed on or after November 29, 2000 (the retroactive enactment date of HR 2215); (2) the IA designated the U.S.; and (3) the IA publication (by WIPO) was in English. If each of these conditions are met, then the IA filing date is considered the U.S. filing date for § 102(e) purposes. For U.S. application publications, they too may be considered prior art as of their IA's filing date if the same three conditions are satisfied.

As another change, a WIPO publication of an IA may also be considered § 102(e)(1) prior art as of the IA's filing date if the IA was filed on or after November 29, 2000; the IA designated the US; and the IA was published in English. Each of these three requirements are readily available on the face of the WIPO publication.

Mr. Kunin explained that the new §102(e) provisions must immediately be applied in examining any application, or patent application reexamination. However, for IAs filed before November 29, 2000, the old § 102(e), which existed before the AIPA's enactment, governs the determination of prior art date. In this situation, the prior art date of such a patent usually is the § 371 (c)(1), (2), and (4) date of fulfillment.

In applying this new rule, Mr. Kunin stressed the importance of determining whether there is an IA, and whether the IA's filing date is before or after November 29, 2000. To illustrate application of the rule, Mr. Kunin walked through several examples of the rule's application and fielded questions about each scenario. Mr. Kunin also provided handouts flowcharting application of this new rule to simplify the application.

Mr. Kunin furthermore noted that while applications that have been published as U.S. or WIPO application publications, or patented in the U.S., may have proper priority claims to foreign applications per 35 U.S.C. §§ 119(a)-(d) or 365(a), the foreign applications' filing dates may never be used as the prior art dates of such publication or patent references. This would, similarly, preclude usage of international filing dates when they are claimed as foreign priority dates under 35 U.S.C. § 365(a).

All of the materials that Mr. Kunin provided and the slideshow that Mr. Kunin used for his presentation are available for IP Section members. Mr. Kunin's slideshow is available at http://www.georgiaip.org/december_ip.ppt. The flowcharts, as well as additional information on this topic (including a mirrored link to the slideshow) are available at http://www.uspto.gov/web/offices/dcom/olia/aipa/whatsnew.htm.

* * *

2002 Holiday Party

IP Section's Holiday Party was held on December 12, 2002 at Vinocity in Midtown Atlanta. Several members of the section were in attendance, and an excellent time was had by all.

The IP Section provided an excellent array of some of Vinocity's best hors d'oeuvres. As evidenced in these pictures, it is clear that the party was an excellent opportunity to meet new people and pick up on prior conversations with existing friends.

If you have not taken the opportunity to attend one of the IP Section's many social functions held throughout the year, you are really missing out. Plan to attend the next social or CLE, as you never know what benefit you might receive. Plus, you might even have a good time as well.

The IP Section has the highest percentage (83.9%) of current and active e-mail addresses for its membership of all the sections in the State Bar of Georgia. However, if you are in the 16.1% who do not receive e-mail announcements from the section, please update your e-mail address online at: www.gabar.org/addchange.htm

PATENT ROUNDTABLE ROUNDUP

On February 26, 2003, the Patent Committee of the Intellectual Property Law Section hosted its quarterly patent roundtable discussion at the State Bar headquarters in downtown Atlanta. The roundtable speaker was Bruce R. Bower. The topic of the discussion was "Waiver of Litigation Counsel's Attorney/Client Privilege and Work-Product Immunity When Defending A Charge Of Willful Infringement." The roundtable luncheon was extremely well attended with approximately 70 attendees at the meeting.

Mr. Bower's discussion included an overview of willful patent infringement issues that commonly arise in litigation. Mr. Bowers explained that reliance on an advice of counsel opinion can be used to rebut a finding of willful patent infringement. Mr. Bower discussed too that juries may be allowed to make a negative inference that no written opinion was obtained or that a negative opinion was obtained if the accused infringer opts not to introduce the opinion at trial.

Mr. Bower covered some of the basic requirements that an advice of counsel opinion should include. For example, he stressed that the opinion must be in writing and from a patent attorney, and that the opinion must generally consider the prosecution history and all claims. Mr. Bower cautioned that the advice of counsel opinion should not be conclusory, but should rather be objective and detailed. Mr. Bower explained that whether an opinion is ultimately correct may not defeat the intended purpose of the opinion, which typically is to rebut a finding of willful patent infringement.

Speaker, Bruce R. Bower, of Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, (shown left) with Patent Committee Chairman, Wab Kadaba of Kilpatrick Stockton

The majority of Mr. Bower's discussion focused upon the waiver of attorney client privilege and work product immunities. As the narrow view, Mr. Bower described that waiver in some instances may only be extended to the work product communicated to a client. This is generally based on the theory that it is the state of

mind of the accused infringer and not the attorney that is relevant to the issue of willful infringement. One of the more noteworthy cases of this view point is *Thorne EMI N. Am., Inc. v. Micron Tech., Inc.*, 837 F. Supp. 616 (D. Del. 1993).

In contrast, Mr. Bower also described the broad view of waiver, which generally holds that injecting advice of counsel into the case waives all work product. This broad view is based on the theory that the state of mind of the attorney may indeed shed light on the state of mind of the client.

Finally, Mr. Bower discussed a moderate view, which is that injecting advice of counsel into a case waives work product of information that serves as the factual predicate of the exculpatory opinion whether or not communicated to the client. This is based on the theory that "objective" evidence, like facts, should be discoverable while "subjective" evidence, like preliminary drafts, should not be discoverable. Mr. Bower cautioned the group to be mindful of all three viewpoints, as even contrary viewpoints may be found within the same judicial district, as is the case in Delaware.

The final portion of Mr. Bower's presentation focused upon issues involving when litigation counsel may have either written or been involved in the preparation of advice of counsel opinion in preparation of the exculpatory opinion. A number of issues exist in this situation, and the consensus of the attendees seemed to indicate that the most preferable situation is to have completely

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NORA'S NOTES

By Nora Tocups

Do-gooders - I remember the late Gene Zimmer admonishing us at Jones & Askew to contribute financially to *pro bono* services because as patent lawyers we were not going to do indigents much good in the courtroom. Nonetheless, there were a few of my colleagues at Jones & Askew who participated in true *pro bono* activities. To name just a couple, Hugh Barnhardt (now at Scientific Atlanta) and Scott Petty (now at King & Spalding) participated in the Thousand Lawyers for Justice Program, which was instituted, in part, to alleviate the backlog in processing persons being held in Fulton County Jails. I participated as well, and remember introducing myself at a criminal hearing to a judge of the Fulton County Superior Court as a "patent lawyer with the Thousand Lawyers for Justice". The judge was very receptive. And so was the Assistant District Attorney - in fact, at one point, the ADA added to my argument on behalf of the defendant based on the ADA's much greater experience.

Debbie Segal, the *pro bono* director at Kilpatrick Stockton, has drawn much deserved praise for her work involving KS lawyers in *pro bono* activities. IP lawyers at KS have also been active in *pro bono* cases.

Wab Kadaba of KS represented an artist, referred to Wab through Georgia Lawyers for the Arts. The artist's work was used by a greeting card company without her permission. The negotiated settlement enabled the artist to start her own business, a jeans company. KS is pursuing trademark and patent protection on behalf of the new company.

Ted Davis, James Trigg, Alex Fonoroff and John Renaud of KS have filed a complaint in federal court (Northern District of Georgia) on behalf of an independent filmmaker known as Quinn. The case involves a dispute about the ownership of the copyrights in an avant-garde movie called The Kindling Point, and the revenues derived from sales and rentals of the videocassettes of the movie. The parties are currently involved in settlement negotiations.

I am sure there are other IP lawyers involved in *pro bono* cases. If you send me the particulars, I am happy to pass on word of the good deeds. At least, if you are not getting paid, a little publicity couldn't hurt! Moreover, the "talk" about *pro bono* work may encourage other IP lawyers to get involved.

Profile - Turning to the topic of profitable business, Wayt King is a former patent lawyer whose entrepeneurial spirit helped launch a successful technology company that has survived into the new millenium. Wayt worked as a patent lawyer at Alston & Bird and at King & Spalding. In 2000 Wayt formed a software company called N2 Broadband with some technical gurus from Scientific-Atlanta. N2 Broadband did some pioneering work with Time Warner Cable in the area of plug-and-play compatibility so that cable systems can mix-and-match equipment and software and content from multiple suppliers. N2 Broadband then "bet the farm" on video-on-demand (VOD). According to Wayt, N2 Broadband now is the top provider of VOD infrastructure for the cable TV industry.

Even though Wayt's original roots lie in patent work, Wayt now describes himself as a "plain-vanilla general counsel." For the first two years of N2 Broadband Wayt spent most his time raising venture capital in the face of pretty stiff competition. N2 Broadband is profitable with revenue of $20M and it employs 140 people. Wayts find the most fulfilling aspects of his job are helping those 140 people get things done quickly (rather than getting in the way), and providing a good salary and great benefits to 140 people and their families.

Wayt's final comments may cause IP lawyers to reconsider their career options. Wayt says the variety of business and legal issues that he faces makes the job with N2 Broadband the most fun "job" he has ever had.

* * *

Patent Roundtable Roundup **(Continued from page 12)**

separate attorneys and firms involved in preparing the opinion and also in litigating the case. (Ms. Nora Tocups expressed her approval for this notion, as a solo practitioner extremely interested in serving as opinion counsel.) However, the group also agreed these issues are not always cut and dry due to the fact of timing of when an opinion may be rendered and when the case may be ultimately litigated. Nevertheless, Mr. Bower indicated that the scope of waiver will probably be narrower in cases when litigation counsel has no involvement in the preparation of the exculpatory opinion.

Mr. Bower advised the group that opinions should be obtained promptly when the circumstances warrant. However, Mr. Bower pointed out that the Gustafson case (Gustafson, Inc. v. Intersystems Indus. Prods. Inc., 897 F.2d 508 (Fed. Cir. 1990)) suggests that an opinion may not be necessary in all circumstances.

As a final point, Mr. Bower advised that after a client receives an opinion, the client should document the decisions made to proceed and follow the opinion which may include continuing in the accused activity. Both Mr. Bower and the group commented that opinions rendered in an opinion should be revisited if the facts or the law change after the opinion as initially issued.

* * *

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

Sitting: Schuyla Goodson, Julie Sinor, Judith Dray

(Not Pictured: Scott Frank)

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