

NEWS FROM THE COUNCIL

Request for Proposals from Chief Judge Whitbeck of the State of Michigan Court of Appeals
Chief Judge William C. Whitbeck is seeking proposals from the various sections of the State Bar, including IPLS, regarding ways the Court of Appeals could improve its operations. The proposals should include the following:

- A concise description of the proposed improvement. For example, if the proposal involves a change in a court rule, a draft of the proposed new language would assist its consideration.
- A specific description of the expected result of the proposed improvement and the benefit to the lawyers and litigants who have matters before the Court of Appeals.
- An explanation of how the result can be measured.

The Court of Appeals intends to evaluate the proposals over the summer and to publicly recognize the proposal that would lead to the most improvement in the operations of the Court of Appeals.

The IPLS Council is asking for your feedback by May 1, 2005. If you have a proposal to suggest, please communicate it to the *Proceedings* editor: Catherine U. Brown, c/o Dow Corning Corporation, 2200 W. Salzburg Rd., Mail Code C01232, Midland, MI 48686-0994, Tel: 989-496-1725, E-mail: c.u.brown@dowcorning.com.

Upcoming Seminars

Spring Seminar

The IPLS Spring Seminar will be Monday, March 14, 2005 at the Kellogg Center in East Lansing. Please register by March 4, 2005. Contact ICLE toll free at 877-229-4350 or register online at <http://www.icle.org/springip>. The Spring Seminar topics include:

- Nominative Fair Use in View of *KP Permanent Make Up* by Uli Widmaier from Pattishall McAuliffe Newbury Hilliard & Geraldson LLP.
- PCT Practice by Carol Bidwell from the U.S. Patent and Trademark Office.
- Trademark Prosecution, Updates, Tips & Best Practices by Lisabeth H. Coakley from Harness Dickey & Pierce PLC.
- PTO Appellate Rule Changes by Jeff Nase from the U.S. Patent and Trademark Office.
- Update on Trade Secret Law in Michigan by Edward H. Pappas from Dickinson Wright PLLC.
- Willfulness and Discovery in the Wake of Knorr-Bremse by Richard J. McCormick from Patterson Belknap Webb & Tyler LLP.
- Avoiding Written Description Requirement Pitfalls by Richard H. Marschall from Michael Best & Frederich LLP.
- Global Filing Strategies for Trademarks by Mary M. Squyres from Brinks Hofer Gilson & Lione.
- How to Draft Licensing Agreements that Avoid Antitrust Problems by Alex Fowkes from Pfizer, Inc.
- Patent and Trademark Office Update by the U.S. Patent and Trademark Office, speaker to be announced.

The Round Table Discussion with Law Students will be moderated by John M. Naber from Foster Swift Collins & Smith PC. Costs this year are \$15 for law students, \$85 for IPLS Members, and \$185 for nonmembers of the Section.

31st Annual Intellectual Property Law Summer Institute

The 31st Annual Intellectual Property Law Summer Institute will be Thursday to Saturday, July 14-16, 2005 at the Grand Hotel in Mackinac Island. Topics include:

- Update on Trademarks by David Bernstein from Debevoise & Plimpton.
- Update on Patents by Thomas L. Irving from Finnegan, Henderson, Farabow, Garrett & Dunner, LLP.
- Update on Copyrights by Katherine C. Spelman from Piper Rudnick LLP.
- Ethics Issues for Intellectual Property Law Attorneys, speaker to be announced.
- Enforcing International Trade Commission Judgments by Steven E. Adkins from Shaw Pittman LLP.
- Trademarks and Copyright issues in China by Vivien Chan from Vivian Chan & Co.
- Complex Patent Litigation by Robert G. Krupka from Kirkland & Ellis LLP.
- Advertising: Top Ten Legal Problems by Tsan Abrahamson from Abrahamson Group PC.
- The Role of the Solicitor's Office at the Patent and Trademark Office by John Whelan from the Office of the Solicitor.

In addition to the regular sessions, there will be advanced topics presented in Trademark by David Bernstein, Patent by Thomas L. Irving, and Copyright by Kate Spelman. Enrollment is limited for the advanced topic sessions, so please register early. The advanced topics are:

- Trademark: Advanced Practice Tips from an UDRP Panel Member.
- Patent: Expert Strategies for Claim Construction in Drafting and Prosecuting US Patent Applications.
- Copyright: to be announced.

The Third Annual Corporate Counsel Roundtable Luncheon Discussion Between In-House and Outside Counsel and the Women in IP Networking Breakfast will be repeated this year. The annual meeting of the Section will also be held at the Summer Institute again this year.

News from the U.S. Patent and Trademark Office

The Consolidated Appropriations Act, 2005 ("Act") was enacted on December 8, 2004. This Act revises various patent and trademark fees. The Act revises certain patent application and maintenance fees; provides separate fees for a basic filing fee, a search fee, and an examination fee; and requires an additional fee for any patent application with a specification and drawings exceeding 100 sheets of paper (*i.e.*, application size fee). The new patent fees will remain in effect through U.S.P.T.O. fiscal year 2006.

The patent maintenance fee changes apply to any maintenance fee payment made on or after December 8, 2004, regardless of the filing or issue date of the patent for which the fee is submitted. The revised maintenance fees took effect on December 8, 2004. Any maintenance fee paid at any time on or after December 8, 2004 is subject to the revised maintenance fee amounts set forth in the Act. The new basic filing fee (or national fee), search fee, examination fee, and application size fee apply to national patent applications (other than provisional applications)

filed on or after December 8, 2004, and to international patent applications in which the basic national fee is paid on or after December 8, 2004. The new provisional application filing fee applies to any provisional application filing fee paid on or after December 8, 2004.

The filing, search, and examination fees are due on filing. If the filing fee is paid on filing, but either the search fee or the examination fee is missing, the U.S.P.T.O. will issue a notice requiring that any missing search fee and examination fee be paid within a specified period of time to avoid abandonment. Thus, if at least the full basic filing fee under the Consolidated Appropriations Act is paid on or after December 8, 2004, the U.S.P.T.O. will issue a notice requiring any balance of the search fee and the examination fee (but no surcharge).

The remaining patent application fee changes, including the excess claims fees, extension of time fees, and appeal fees, apply to any fee payment made on or after December 8, 2004, regardless of the filing date of the application for which the fee is submitted.

Links to the new patent and trademark fees are on the U.S.P.T.O. website at:
<http://www.uspto.gov/web/offices/ac/qs/ope/fee2004dec08.htm>.

Update on the IPLS By-Laws Amendment Allowing Patent Agents to Join the Section

The amendment to the IPLS by-laws that would allow patent agents to join the section was approved by the Section members at the annual meeting in July, 2004. The full text of the IPLS By-Laws, as amended, may be found on the IPLS website at:

<http://www.michbar.org/ip/pdfs/IPbylaws.pdf>. The amendment has been forwarded to State Bar of Michigan for review, and the Council is waiting for approval by the State Bar before the amendment can be implemented.

Amicus Brief

In September 2004, the Section joined on the amicus brief filed by the New York Intellectual Property Law Association (NYIPLA) on *Phillips v. AWH Corp.*, 363 F.3d 1207, 70 USPQ2d 1417 (Fed. Cir. 2004) (67 PTCJ 576, 4/16/04). The case deals with matters of patent claim construction, and the brief specifically addresses whether the specification or dictionaries should be relied upon to glean the meaning of claimed terms. A copy of the brief is available on the IPLS website at http://www.michbar.org/ip/pdfs/Amicus_Phillips_AWH.pdf.

Council Meetings

The council reminds the membership that all section members are invited to attend Council meetings. Council meetings are generally held on the second Thursday of each month at 9:30 a.m. Meetings are usually either conducted by teleconference or held at the Sheraton at 925 Creyts Road, Lansing. Members wishing to attend a Council meeting are advised to contact one of the council members one week before the meeting for the exact time and location. Dates and locations for upcoming events are listed in the IPLS Planning Calendar in each issue of *Proceedings*.

Corrections

The IPLS liaison to the Board of Commissioners is no longer D. Andrew Portingaa. The new Commissioner liaison is:

Stephen J. Murphy, III
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IPLS PLANNING CALENDAR

WHAT WE'VE DONE ... WHAT WE'LL DO

December 9, 2004.....Council Meeting, Contact a council member for the time and location.

January 13, 2005.....Council Meeting, Contact a council member for the time and location.

February 10, 2005.....Council Meeting, Contact a council member for the time and location.

March 10, 2005.....Council Meeting, Contact a council member for the time and location.

March 14, 2005.....IPLS Spring Seminar, Kellogg Center, East Lansing.

April 14, 2005.....Council Meeting, Contact a council member for the time and location.

May 12, 2005.....Council Meeting, Contact a council member for the time and location.

June 9, 2005.....Council Meeting, Contact a council member for the time and location.

July 14-16, 2005.....31st Annual Intellectual Property Law Summer Institute, Grand Hotel, Mackinac Island.