

NEWS FROM THE COUNCIL

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Upcoming Seminars

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 LLP.
- 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, John W. Allen from Varnum Riddering Schmidt & Howlett LLP.
- 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 - Lessons Learned from a \$500 Million Dollar Patent Case by Robert G. Krupka from Kirkland & Ellis LLP.
- Advertising: Common Pitfalls and Latest Legal Developments by Tsan Abrahamson from Abrahamson Group PC.
- The Role of the Solicitor's Office at the Patent and Trademark Office by John M. Whealan from the Office of the Solicitor.
- Best Practices for Collecting Confusion Evidence by Robert Jacobs-Meadway from Ballard Spahr Andrews & Ingersoll LLP.

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: Open Source Software.

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.

AIPLA Town Hall Meeting on Patent Reform Held in Chicago on March 4, 2005

Patent reform is the latest hot topic in intellectual property, and will dramatically affect practitioners if enacted. The reform effort is spearheaded by the National Academies' Board on Science, Technology and Economic Policy (NAS); the American Intellectual Property Law Section; and The Federal Trade Commission (FTC). These groups recently sponsored a series of "Town Hall" meetings this past winter in San Jose, California; Chicago, Illinois; and Boston Massachusetts. Future Town Hall meetings are planned for other locations, including Washington, D.C. All of the sessions have the same goal, though, which is to present the group's collective proposed legislative advocacy positions, and to obtain feedback from interested parties. Council members Beverly Bunting and Laura Slenzak recently represented the Section at the Town Hall meeting held on March 4, 2005, in Chicago.

The potential need for reform is captured by the title of an October 2003 report by the FTC: "To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy." The FTC report *continued on page 2 . . .*

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contains several recommendations. First, implement a first-inventor-to file system in the United States. This change would require wholesale changes to 35 USC 102, of course, since 102 deals primarily with various nuances on who “invented” first versus what was “known” or “filed” first. According to the FTC report, such a change would benefit small entities, including independent inventors. The other benefit touted is enhanced global harmonization in a global economy.

The second recommendation is to broaden post-grant opposition proceedings in the United States. Support for this reform is based on the rapid growth in patent applications, the limited resources of the PTO, the knowledge of competitors, and the expense and time of litigation. The goal of post-grant opposition proceedings reform is to test questionable patents early and at a reasonable cost.

The third recommendation is for litigation reform. With regards to willfulness it was recommended that enhanced damages awards for infringement be eliminated, and that the willfulness standard be narrowed to provide a safe harbor through a written notice of infringement. With regards to inequitable conduct, it was recommended that the doctrine be eliminated, award fees to the successful patentee, allow enforceability claim only after patent held invalid due to a misrepresented fact and PTO involvement in resolving issues. It was also suggested that intervening rights in continuation applications not be supported. The AIPLA supports amending the present prior use statute (35 U.S.C. 273) to not be limited to methods, delete requirements that prior use be reduced to practice one year prior to the effective filing date and include substantial preparation as an act to prior use.

The fourth recommendation surrounds the experimental use exemption. Biotechnology is particularly affected by this proposal. The NAS suggests that some research use of patented inventions be shielded from infringement liability. The AIPLA proposed making an exception for using a patented invention for purposes related to scientific, research or experimental inquiries if done to determine validity of a patent, to discover features of other characteristics of an invention, novel methods of making or using a patented invention or novel substitutes. They also propose an exception for making or using the invention in activities incidental to the commercialization of a non-infringing alternative.

The fifth recommendation is that the PTO receive adequate funding. The NAS believes enhanced funding will improve the output of the PTO.

At the Chicago meeting, US Patent Office director Jon Dudas also announced a three part plan for improving the PTO. The first part of the plan is the right of the applicant to request a pre-appeal brief conference after filing a notice of appeal, and before submission of an appeal brief. The second part of the plan is to reduce the backlog of pending ex parte patent reexamination cases by instituting a panel review process to consider each reexamination action on its merits. The third part of the plan is improved patent searches through the use of a “search template”.

In summary, the FTC report suggests that PTO efficiency and effectiveness can be improved through 18 month publication, post grant review and improved PTO financing. The NAS report agrees with the FTC report and also recommends a first inventor to file system and the elimination of subjective elements from patent litigation. The AIPLA support both the FTC and NAS recommendations, and the implementation of “best practices” to achieve patent reform.

While the idea of “patent reform” has been bantered about for many years, this time there is significant muscle behind the efforts. Senator Orrin Hatch and others are contemplating drafting bills for consideration during this session of Congress. Bottom line, the implementation of these “best practices” will essentially mean a complete overhaul of the U.S. Patent system, and guaranteed employment for patent lawyers.

More information about the town hall meetings is available at AIPLA’s website at <http://www.aipla.org/Template.cfm?template=/ContentManagement/ContentDisplay.cfm&ContentID=7974>.

Patent Agents Can Now Join the Section

The amendment to the IPLS by-laws allowing patent agents to join the section was approved by the State Bar of Michigan. The full text of the IPLS By-Laws, as amended, may be found on the IPLS website at: www.michbar.org/ip/pdfs/IPbylaws.pdf. The admission process will be announced in a future issue of Proceedings, once the process is finalized.

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 the *Proceedings* editor or one of the other 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*.

IPLS PLANNING CALENDAR

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

- May 19, 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.
- August 11, 2005** Council Meeting, Contact a council member for the time and location.
- September 8, 2005** Council Meeting, Contact a council member for the time and location.

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