

New Matter

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Fall 2005

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Women in Intellectual Property Law (WIPLA)

- Lynn C. Cameron lcameron@faegre.com
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President's Letter

(Reprinted from September 22 E-mail)



Greetings!

At our Annual Meeting held last year, I was honored by being elected President-Elect of this fine Association. I wish to thank you and welcome you to what I hope you'll agree is going to be a very exciting year to be a member of MIPLA.

I am optimistic that the upcoming months will establish MIPLA as the premier state intellectual property law association in the U.S.A. Since we won't achieve such lofty status unless we work together, I would like to recognize two that have helped the Association grow and prosper. First, our immediate **Past-President, John Gresens**, hands me an Association in great shape and possessing lots of momentum. Second, our **Vice-President/President-Elect, Catherine Klima-Silberg**, who I know will do a great job leading the Association next year!

As you may know, the president of MIPLA has the opportunity to appoint, "*during his or her term, the authority to appoint **Special Committees** to hold office during his or her term.*" Accordingly, I have decided to appoint three such Special Committees; namely, an **IP-Student Committee** led by **Jaelyn "Jacie" Sprtel**, a **Past Presidents Committee**, and a **Patent Agent Committee** led by **James Keogh**. During my term I hope that all the committees of MIPLA encourage participation and attendance at our various social- and professionally-oriented events, but in particular these committees should invigorate their respective members and the Association as a whole. Please consider whether you or one of your colleagues might benefit from joining one of the Special Committees.

MIPLA was founded in 1942 and the By-Laws haven't been reworked since, I believe the late 1980's. I plan to work with **David Peterson, Chair**, and other members of the **By-Laws Revision Committee** to bring MIPLA into the 21st Century. I hope that we would formally amend the By-Laws to officially implement: (i) **tele-presence** for example, video-conferencing, teleconferencing, and the like and (ii) **electronic voting** such as via e-mail or remotely via a computer network. Further, we need to amend the By-Laws due to a change in the structure of our state bar association, the MSBA. I invite you to join the committee and participate in this bit of "house-keeping" progress of the Association.

I would also like to take this opportunity to thank all my fellow officers and members of the Board of Directors for their support and assistance during the upcoming year.

Sincerely,

Paul H. McDowall
2005-2006 MIPLA President

Committee News

Women in the Legal Profession (WIPLA) Committee Report

*by Lynn Cameron and Gretchen Skarohlid
WIPLA Co-Chairs*

WIPLA, the Women's Committee of MIPLA, has gotten off to a great start this year. The committee hosted a social/networking event held at the offices of Faegre & Benson LLP on October 4. The next planned event will be a lunchtime session on the proposed USPTO rule changes. Date and time are still pending.

Our plans include four substantive events and at least a couple of social events distributed throughout the year until June 2006. Some of our goals for this year include increasing participation by in-house counsel and attorneys outside of downtown Minneapolis, as well as an outreach effort toward female IP law students at the four area law schools.

The WIPLA Random Lunch program provides an opportunity for female attorneys and/or law students, who are randomly matched up in small groups every couple of months, to meet for lunch and get to know each other in a social setting. This program is up and running again under the new leadership of Sandra Epp Ryan of Merchant & Gould. Please contact her at either (612) 332-5300 or seppryan@merchant-gould.com for more information or to join the list of participants.

We look forward to an exciting year. Please contact us with any questions or with any suggestions for activities or topics of discussion. Thank you!

Publications & Website Committee Report

by Eduardo Drake, Committee Chair

Thanks to all those who made this issue possible. The committee is grateful to all of the contributing members, and gives special recognition to Brad Forrest of Schwegman, Lundberg for graciously contributing his article on Business Method Patents. We are also deeply indebted to MSBA staffer Sue Bores for her work in putting this issue together. The major committee news

is that we continue to make progress, though slow, in our effort to remodel the MIPLA website. We hope to unveil it December or January.

In closing, the committee notes that the next New Matter is tentatively slated for March-April timeframe. Further details will be announced via email. In the meantime, comments on this issue and ideas or submissions for the next issue may be submitted via email to edrake@slwk.com or via telephone at 612-349-9593.

MIPLA Golf League Update

by Robin Sannes and Gary Speier



FORE FUN: The MIPLA Golf League completed its second golf season this fall at the Como Park Golf Course in Saint Paul. A block of tee times starting at 4:56 p.m. was reserved on Monday evenings for our league from mid May until late August. Last year there were 27 players, and this year there were 25 players.

The purpose of the MIPLA Golf League is to provide another opportunity to socialize with other MIPLA members in an informal environment. If you are interesting in joining the MIPLA Golf League, please watch for an e-mail in April 2006 or contact either Robin Sannes (rsannes@iplmgroup.com) or Gary Speier (gspeier@slwk.com) this spring. Depending upon the level of interest this spring, we may change the location to a northern/western suburb.

We are looking forward to another fun season!

Business Method Patents - Dealing With Rejection

by Bradley Forrest of Schwegman Lundberg Woessner & Kluth PA

Business method patents have been routinely rejected by the US Patent and Trademark Office over the last few years. Allowance rates as low as 12% have been published. That is about to change. This article describes the mechanisms by which such patent applications have been rejected, how to deal with such rejections, and why it is believed that the allowance rate will soon significantly increase.

A simple definition of a business method is offered. "A patent application that appears to claim something related to the way business is conducted, as opposed to inventions that are related to classical technology." Such patent applications have drawn public criticism, and responses from the USPTO that have resulted in examiners and supervisors being reluctant to allow them.

One reason for the low allowance rate is the second pair of eyes requirement prior to allowing a case. Examiners have perceived this review as confrontational and many times resulting in rejection. They have been hesitant to move cases forward. Just as the rest of the patent office appears to be implementing the second pair of eyes review, the art unit examining business methods is moving away from it toward a conference with the examiner, the supervisor, and another examiner. It is viewed as much less confrontational and likely to increase allowance levels.

Examiners have used many rejections that are reminiscent of the early software rejections to reject business method patent claims. One particularly vexing rejection is the "rolling 102/103" rejection. Art will be cited against the claims, and when overcome, new art will be cited in a non-final rejection. This process may repeat, and roll on for many years, leading to overall loss of patent term. One suggestion for dealing with these types of rejections is to file a request for pre-appeal brief conference, along with the notice of appeal for every rejection after the first rejection. This will stem the bleeding away of the patent term, and experience is showing, give the patentee a fair review. Of course, the extreme measure is to file a writ of mandamus to require the patent office to perform their examination duties properly. I suggest waiting until near retirement for this course of action.

Another rejection of business method patents is referred to as the "not part of the technological art" rejection under 35 USC 101. A set of guidelines issued by TC 2100 in April of 2005 is entitled a "\$101 Help Guide". It guided examiners to determine whether all steps in a claim be done by a person as a mental step or using pencil and paper. If so, the claim is said to be directed to abstract idea, and not tied to a technological art which would result in a useful, concrete and tangible result.

An easy way to overcome such a rejection is to make sure at least one element positively recites a computer. This is usually not a problem, but one must make sure that a computer is required to perform such an element in every practical implementation of the business method.

A recent expanded appeal board precedential decision, *In re Lundgren*, indicated that this is an improper rejection. Lundgren claimed a method of compensating a manager based on absolute and relative performance. No computer was required to perform the method. The board found that there was no basis for the technological arts rejection, and since the claim provided a useful, concrete and tangible result, the claim was statutory.

Within a week of this decision, on October 26, 2005, the USPTO posted interim guidelines for the examination of patent applications for patent subject matter eligibility. http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf. The guidelines provide a fairly clear framework for claiming business methods in a statutory manner. Judicial exceptions to subject matter are set forth - abstract idea, law of nature, or natural phenomenon. These exceptions, standing alone are not patentable. However, claims that recite such a judicial exception are patentable if a practical application is claimed. A practical application is further defined as something that physically transforms an article or physical object, "or" otherwise produces a useful, concrete and tangible result.

If one cannot find the transformation in the claim, a determination of whether the claim produces a useful, concrete and tangible result should be made. The guidelines make clear that it is the final result of the

claim that is at issue, not whether each element of the claim provides such a result.

The term "useful" is described as something having utility. Utility is a requirement of every patent application, although rarely an issue in the predictable arts. The basic requirement is that the utility be specific, substantial and credible as described in MPEP 2107. A "tangible" result is described as reciting more than one of the judicial exceptions - abstract idea, law of nature, or natural phenomenon. It also produces a real world result, and is the opposite of abstract. Okay, that was real helpful, but we don't see that as being used often for a rejection, as a final number representative of the value of multiple accounts was found to be a tangible result in State Street.

Finally, the guidelines attempt to describe a "concrete" result as substantially repeatable and the opposite of unpredictable. This appears to relate more to the enablement requirement than anything else. Enablement in computer implemented inventions and other business methods in general has not been a problem in the past, and is not anticipated to be problematic going forward.

The guidelines also make clear that it does not matter if a human performs some or all of the steps of a method claim, or whether any of the steps can be performed in the human mind. They reiterate that the test is whether the claim as a whole produces a practically application - a physical transformation, or a useful, concrete and tangible result.

If one of the judicial exceptions is claimed, along with a practical application, a final hurdle is that the claim cannot preempt every substantial practical application. To reject a claim using this final hurdle, the "examiner must identify the abstraction, law of nature or natural phenomenon and explain why the claim covers every substantial practical application thereof."

The US Supreme Court may soon have a say in the matter patentable subject matter. They have agreed to hear a case (Laboratory Corporation of Americal Holdings, DBA LabCorp v. Metabolite Laboratories, Inc., et al.) that involves several issues, one of which is whether a claim can cover a step of a claim that is performed in the mind. The Supreme Court requested the advice of the United States (USPTO) as to whether

claim 13 of US Patent No. 4,940,685 is "invalid because one cannot patent 'laws of nature, natural phenomena, and abstract ideas.'" The US Amicus Curiae brief on the petition for write or certiorari mirrored the reasoning of the interim guidelines. The US indicated that the issue was not considered by the lower courts, and that such an important issue should be decided based on a full record where the issue was properly raised, litigated and decided below.

Claim 13 recites: "A method for detecting the deficiency of cobalamin or folate in warm-blooded animals comprising the steps of: Assaying a body fluid for an elevated level of total homocysteine; and correlating an elevated level of total homocysteine in said body fluid with a deficiency of cobalamin or folate." The petitioner indicates that the claim as interpreted prevents "...doctors from even thinking about a basic medical fact..." There is little support if any in their petition for why this makes the claim unpatentable. The petition does set forth several other grounds for cert, including stating a conflict within panels of the CAFC regarding inducement of infringement. Given the US position that the issue is not fully developed, and the clear lack of any lower court discussions of issues of subject matter patentability, it is unlikely that the US Supreme Court would decide the case on that issue.

Conclusion:

Business method patents are more likely to be allowed in view of the interim guidelines. Patent examiners now have some clear guidance on how to examine business method patents and other patents that appear to have claims falling within the judicial exceptions. If a practical application is present, as evidenced by finding a useful, concrete and tangible result of the entire claim, and the claim does not preempt all substantial applications, it should be found statutory. The guidelines, while interim and not binding, appear to be based on the same reasoning as the US Amicus Curiae brief in the Metabolite case, as well as consistent with *In re Lundgren*. Thus, examiners would be well advised to follow them. In addition, the business method art unit has implemented a more examiner friendly review process, which should lead to less reluctance to allowing business method patents.

The ABA Section of Business Law Intellectual Property Desk Book Project

Professor Sharon Sandeen, Director of the Intellectual Property Law Program at Hamline University School of Law, is working on an IP Deskbook Project for the Intellectual Property Committee of the Business Law Section of the ABA and is looking for one or more Twin Cities based attorneys to write chapters of the book.

Below is a memorandum that explains the project. Interested volunteers should contact Professor Sandeen at either (651) 523-2762 or ssandeen@gw.hamline.edu.

MEMO TO: Interested Members of the IP Committee

FROM: Sharon K. Sandeen, Co-Chair of IP Desk Book Working Group
Associate Professor of Law
Hamline University School of Law

DATE: October 14, 2005

RE: Proposed Topics and Draft Introduction

At the meeting of the Intellectual Property Desk Book Working Group held in Chicago in August of this year, the purpose of an Intellectual Property Desk Book was explained and potential areas of coverage were identified. In this memorandum, I set forth my recollection of that meeting as a basis for advancing this project to the drafting stage. To begin the drafting process, I present a draft "Preface" as a way of documenting the intent behind the IP Desk Book. After you have had an opportunity to review what follows, your suggested changes and additions would be very much appreciated.

DRAFT PREFACE:

The purpose of the *Intellectual Property Desk Book* is to look beyond the basic principles of intellectual property law and examine the myriad ways that intellectual property issues arise in the business context. It is the culmination of an effort initiated by the Intellectual Property Committee of the Business Section of the American Bar Association and reflects the work of numerous Business Section members.

In the *Intellectual Property Desk Book* you will find a collection of articles by practicing attorneys and academics on topics such as intellectual property representations and warranties, security interests in intellectual property, estate planning for intellectual property owners and the protection of intellectual property rights in outsourcing transactions. The goal of each chapter is to identify the key intellectual property issues that business attorneys should consider in the course of their work on various transactional matters and to discuss potential traps for the unwary.

While the *Intellectual Property Desk Book* contains a general discussion of applicable law, because the analysis of intellectual property law is very fact intensive it focuses more on identifying issues than on explaining the intricacies of the law. To assist lawyers in conducting a more fact-driven analysis of the identified legal issues, the *Desk Book* includes a bibliography of articles and books on the subject of intellectual property law that members of the Business Section have found useful.

PROPOSED CHAPTERS:

1. Intellectual Property Issues for Business Start-ups
2. Security Interests in Intellectual Property
3. The Licensing of Intellectual Property Rights
4. Antitrust Concerns
 - a. Related to the Licensing of Intellectual Property Rights
 - b. Related to Mergers and Acquisitions
5. Intellectual Property and Pre-Bankruptcy Planning
6. Protecting Intellectual Property in Outsourcing Transactions
7. Estate Planning for the Intellectual Property Owner
8. Intellectual Property Representations and Warranties
9. Employment Policies
10. Other?

Once we have finalized the foregoing list of proposed chapters, we can begin to identify individuals who are willing to spearhead the preparation of each chapter. Rather than starting from scratch, it is anticipated that we will rely heavily on materials that have been prepared in conjunction with recent Business Section presentations. As drafts of the various chapters are prepared, I am hoping that a common format will emerge and that all chapters can be edited to conform to that format.

PROPOSED DEADLINES:

Assuming that we want to complete a draft of the *Desk Book* before the Business Section Spring Meeting scheduled for April 6 through April 9, 2006, I propose the following deadlines:

- | | |
|--------------------|---|
| October 31, 2005: | Finalize chapter topics and identify all authors |
| December 15, 2005: | First drafts of chapters to be submitted to Sharon Sandeen for review, suggested changes and formatting. |
| January 15, 2006: | Suggested changes/additions to drafts due to authors. |
| February 28, 2006: | Second drafts of chapters to be submitted to Sharon Sandeen. |
| March 2006: | Further review/editing of chapters, cite checking, formatting, etc.... in order to prepare mock up for review by at the Spring Meeting. |

Law School News

PCT Symposium 2006

The Patent Cooperation Treaty and the International Patent System

Saturday, February 11, 2006

9:00 a.m. - 6:00 p.m.

Where: William Mitchell College of Law, 875 Summit Avenue, St. Paul, Minnesota 55105

Cost: \$100 for practitioners; \$20 for non-William Mitchell students

CLE Credits: 6.75 Standard (Minnesota and Wisconsin)

For more information and registration go to: www.wmitchell.edu/lectures or call Meg Daniel at (651) 290-6425

Description:

William Mitchell College of Law is partnering with the World Intellectual Property Organization and the executive director of the Office of the PCT, Jay Erstling, for this one-day intellectual property conference to examine the role that the PCT plays as a tool for obtaining patent rights worldwide allowing a company the ability to better leverage its intellectual assets.

Sponsored by Minneapolis law firm Fredrikson & Byron, the symposium will feature six international speakers including representatives from the Office of the PCT, European Patent Office, U.S. Patent and Trademark Office, Japan Patent Attorneys Association, and Shanghai Patent and Trademark Law Office. Ten additional patent law practitioners from around the world will join the symposium as commentators.

A pre-conference retreat is also being offered in northern Minnesota at the Rainbow Resort in Waubun, Minnesota on February 8-10.



left to right: SIPLA Officers Jim Rieke, Jacie Sprtel, Ben Tramm, and Andrew Michaelson

The William Mitchell College of Law Student Intellectual Property Law Association, Office of Career Development, and Office of Alumni Relations wish to thank all the Law Firms and Lawyers who attended our recent "Meet the IP Employers" event.

Minnesota Inventors Congress



Greetings from the Minnesota Inventors Congress (MIC).

What does an independent inventor; economic development and consumer protection have in common? The Minnesota Inventors Congress!

Through an appropriation from the Minnesota Legislature and the Minnesota Department of Employment and Economic Development, the MIC office is once again able to guide the independent inventor through the product development process, by referring them to reliable resources. Most independent inventors have no knowledge of how to take that first step, let alone have a Research and Development Department behind them. Throughout its 48 years, the MIC has promoted the fact that new ideas and products lead to new markets and how new markets create jobs. We were promoting 'economic development' long before it became a catch phrase. The novice inventor is not aware of how many marketing firms there are that targets them specifically because of their emotional connection to their idea.

Our two major programs are:

1) The Minnesota Inventors Congress Annual Expo. Since 1958, this event has been held in Redwood Falls; where inventors can showcase their product before the general public, attend seminars and network with consultants and other inventors. The oldest annual invention convention is proud of the fact that MIPLA has been a resource partner for 48 years. Thank you to all of you that have volunteered your time and expertise over the years. The next event is scheduled for June 9-11, 2006.

2) The year round Inventors Resource Center. Since 1986, we have provided guidance to the independent inventor. A typical day involves contact with someone looking for a specific manufacturer or a company that will sponsor their idea. After a few questions, it becomes obvious that what they really need is Inventing 101. Many have been targeted by invention promotion firms or they have called one and don't know what to do next. No matter where they are in the process we can direct them to the appropriate resources. No government agency or private business is designed to carry them through from the beginning to the end. We provide technical assistance on what steps to take, the order to take them in and when spending money, who to spend it with. Our definition of Inventing 101: Documenting and protecting their intellectual property, conducting a neutral product evaluation to determine if there is a market for their idea, conducting a preliminary patent search and helping them understand the importance of being an educated inventor working with a patent attorney will help them create the most solid patent application.

As a professional, your time is very valuable and my goal is to share with you a little about what we do and let you know that we would welcome referrals from inventors who just don't know what to do after they come up with that great idea.

Best regards,

Deb Hess
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Strategic Uses of Means-Plus-Function Claims

by Eduardo Drake of Schwegman Lundberg Woessner & Kluth PA

In the kingdom of patents, means-plus-function and step-plus-function claims (collectively MPF claims) are second-class citizens. Being an underdog myself, I've always had a soft spot in my heart for other underdogs, whether they live down the hall, down under, or down deep in a box of patent-making tools. Witness that some prolific and astute corporate patent filers in America have policies discouraging or forbidding use of MPF claims. Such policies signal, at least to me, a likely under-appreciation for the strategic power of this claim type, and a corresponding need to trumpet the beauty of an arguably endangered species. So, I offer the following list of 17 strategic uses to awaken the zealots among us to view MPF claims, not as dusty relics of a by-gone era, but as top-drawer, strategic tools with the immediate potential to add significant value to our work as patent makers and advocates:

1. Use in independent claims to obtain broad U.S. coverage based on broad disclosure.
2. Use in independent claims to obtain broad international protection, particularly in EP applications.
3. Use in independent claims to bolster case that other non-means claim elements (with functional language) are not subject to 35 USC 112P6 by virtue of claim differentiation doctrine.
4. Use in dependent claims to drive broad interpretation of elements in independent claims based on doctrine of claim differentiation.
 - a. The device of claim X, wherein the rotator comprises means for rotating.
 - b. The method of claim Y, wherein coagulating comprises a step for coagulating.
5. Use to reduce risk of non-infringement rulings in summary judgment motions based on factual questions of equivalents under 35 USC 112P6.
6. Use as a hedge against loss of doctrine of equivalents, since 112P6 guarantees that MPF elements will have some scope of equivalents even if narrowed during prosecution.
7. Use for alternate coverage of synergistic aspects of an invention that stem from cooperation of multiple elements. For example, if components A, B, C cooperate to reduce a surface temperature of a microprocessor to room temperature, recite "means for reducing operating temperature of the processor to room temperature." This approach may have value in chemical context.
8. Use to secure apparatus claims based on intended use or to secure apparatus claims based on new use.
9. Use to mitigate risk of publicly dedicating disclosed, but unclaimed subject matter; particularly with dense specifications.
10. Use to enhance likelihood of recovering pre-issuance damages based on publication under 35 USC 154 (d)(2).
11. Use as a wrapper for overly broad structural elements to gain broad non-means coverage; for example, means, including first and second rigid orthogonal structures, for supporting a shelf.

12. Use to bolster depth and effectiveness of provisional applications.
 - a. MPFs can outline and succinctly describe the invention.
 - b. MPFs implicitly organize material, such as related patents, that may include alternative corresponding structure for recited functions.
 - c. Any claims would act as hedge against any foreign resistance to recognizing U.S. provisionals as bonafide patent applications.
13. Use as hedge against invalidity, since MPF claims might be the last claims standing.
14. Use to add uncertainty to claim scope that may not only help with negotiations and deterrence effect, but also drive up infringer's cost of analysis.
15. Use after identification of allowable subject matter to reduce potential for estoppel (based on arguing issue of equivalents.)
16. Use in linking claims to reduce need for divisional filings.
17. Use to overcome omission of specific claimed element from original drawings.

For helping me grow this list to its current length, I thank my colleagues at Schwegman Lundberg and members of the Iowa Intellectual Property Law Association to whom I spoke on this topic. Lastly, I invite you to contact me via email at edrake@slwk.com or via telephone at 612-349-9593 with your thoughts and comments on other uses of the MPF format.

Member News

NEW MINNEAPOLIS INTELLECTUAL PROPERTY LAW FIRM

Curtis Hamre, Michael Schumann, Douglas Mueller and James Larson are pleased to announce the formation of Hamre, Schumann, Mueller & Larson P.C. (HSML) in Minneapolis, Minnesota. All four attorneys were formerly with Merchant & Gould P.C. in Minneapolis, where Mr. Hamre, Mr. Schumann and Mr. Mueller were partners and Mr. Larson was an associate. Joining HSML as attorneys are Kristina Foudray, formerly an associate with Merchant & Gould, and Dwight Holmbo.

HSML represents clients in all aspects of intellectual property including U.S. and international patent and trademark prosecution; reexaminations and interferences; patent novelty, infringement and validity opinions; trademark searches, trademark registrability and use opinions, trademark oppositions and cancellations; trademark infringement opinions; copyrights; Internet law; IP acquisition and licensing; and counseling clients with respect to IP portfolio management and business strategies.

JOHN A. CLIFFORD JOINS
INTERNATIONAL TRADEMARK ASSOCIATION'S PANEL OF NEUTRALS



John A. Clifford of intellectual property law firm Merchant & Gould has been appointed to the International Trademark Association's (INTA) Panel of Neutrals.

The Panel of Neutrals is part of INTA's Alternative Dispute Resolution (ADR) Program. The Panel is a select group of highly qualified individuals with experience in trademark matters that help parties resolve trademark and unfair competition disputes without litigation. Clifford is only the third Minnesotan to serve on the Panel of Neutrals.

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Application for Membership/Address Change

Please Check:

- Address Change
 Application for Membership

Name _____

Business Address _____

or

Home Address _____

Business Telephone _____

Fax _____

Home Telephone _____

E-mail Address _____

1. Class of Membership Active Student/Graduate

2. Are you admitted to practice US PTO? Yes No

3. Are you admitted to the bar? Yes No
State(s) _____

4. Are you actively engaged in practice of intellectual property law? Yes No

5. Are you a member in good standing of the Minnesota State Bar Association? Yes No

6. For Student/Graduate membership: _____

Law school and year of graduation.

Annual dues in the amount of:

- \$100 Active Member \$10 Student
 \$ 50 Active Member (from January 1 thru June 30)

Return to: Minnesota State Bar Association,
Attn: MIPLA Administrator,
600 Nicollet Mall, Suite 380, Minneapolis, MN 55402.